Zen and the Art of Invention Reporting

Welcoming remarks will begin at 11:55 a.m. Eastern Time.

The formal presentation will begin at Noon Eastern

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Zen and the Art of Invention Reporting

Speaker:
David Englert, Marketing Manager,
UR Ventures, University of Rochester

June 2, 2015

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Questions?

We will be taking questions at the conclusion of the presentation.

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David Englert
UR Ventures
University of Rochester
Zen

AND THE ART OF

INVENTION REPORTING

Today's Learning Objectives:
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- To understand how invention reporting came about and why it’s necessary
- To look at the basic mechanics of invention reporting and to share some best practices
Today’s Learning Objectives:

- To understand how invention reporting came about and why it’s necessary
- To look at the basic mechanics of invention reporting and to share some best practices
- To learn to embrace – and not fear – invention reporting

“Invention Reporting!?! Why did you have to mention Invention Reporting?”
We fear things in proportion to our ignorance of them.
-- Christian Nestall Bovee

Relax
Invention reporting is simply one of the steps in the technology transfer process.

Technology Transfer
Technology Transfer

Eureka!

Discovery/Disclosure

IP Protection

Intellectual Property

Assignee hereby accepts

Applications
Technology Transfer

Discovery/Disclosure  IP Protection  Marketing/Licensing

Technology Transfer

Discovery/Disclosure  IP Protection  Marketing/Licensing  Collect Loot & Glory
Technology Transfer

Discovery/Disclosure

Report it!
Technology Transfer

Discovery/ Disclosure  \rightarrow  IP Protection

Report it!
Report it!

Technology Transfer

Discovery/ Disclosure  \rightarrow  IP Protection  \rightarrow  Marketing/ Licensing

Report it!
Report it!
Report this one, too!
Sponsored Research Life Cycle

Funding Source

Research

Technology Transfer

= ?

Discovery/ Disclosure → IP Protection → Marketing/ Licensing

Sponsored Research History
Sponsored Research History

1820s

Charles Babbage

... and his fabulous Difference Engine
Sponsored Research

History

1820s

“What shall we do to get rid of Mr. Babbage and his calculating machine?” Robert Peel, British Prime Minister (1834-5 and 1841-6)

Charles Babbage
Sponsored Research History

1930s

President Roosevelt

Sponsored Research History

1930s

President Roosevelt
Sponsored Research
History

1930s

Sponsored Research
History

1930s
Sponsored Research History

1930s
Sponsored Research History

1930s

+ = ?

Sponsored Research History

1930s
1940s

+ =
Sponsored Research History

1930s  1940s  1950s

Sponsored Research History

1930s  1940s  1950s
Sponsored Research History

1930s
1940s
1950s
1960s
1970s
Sponsored Research

History

1930s
1940s
1950s
1960s
1970s

Federal funding of research is the norm.

But . . .
Federal funding of research is the norm. Anything arising from sponsored research belongs to the government.
Sponsored Research History

1930s
1940s
1950s
1960s
1970s

- Federal laboratories
- Public institutions
- Private universities

Federal funding of research is the norm.
Anything arising from sponsored research belongs to the government.
Federal funding of research is the norm. Anything arising from sponsored research belongs to the government.
By the late 1970s, the federal government held 28,000 patents.*

*Source: GAO Report (on Technology Transfer) to Congressional Committees May 1998
Sponsored Research History

1930s
1940s
1950s
1960s
1970s

Birch Bayh (D) U.S. Senator from Indiana (1963 – 1981)

Bob Dole (R) U.S. Senator from Kansas (1968 – 1996)

Bayh-Dole Act (35 USC §§ 200 – 212)
12 December 1980
A New Era Dawns

The Bayh-Dole Act
The recipient institution may retain rights to inventions arising from federally-sponsored research,

providing that the recipient institution notifies the funding agency of all
A New Era Dawns

The Bayh-Dole Act

The recipient institution may retain rights to inventions arising from federally-sponsored research, providing that the recipient institution notifies the funding agency of all Disclosed Inventions.

Disclosed Inventions

Patent Applications
A New Era Dawns

The Bayh-Dole Act
The recipient institution may retain rights to inventions arising from federally-sponsored research, providing that the recipient institution notifies the funding agency of all Disclosed Inventions, Patent Applications, and Issued Patents.
A New Era Dawns

The Bayh-Dole Act

The recipient institution may retain rights to inventions arising from federally-sponsored research, providing that the recipient institution notifies the funding agency of all

<table>
<thead>
<tr>
<th>Disclosed Inventions</th>
<th>Licenses</th>
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<td>Patent Applications</td>
<td>Products</td>
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<td>Issued Patents</td>
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Decisions to discontinue process
A New Era Dawns

The Bayh-Dole Act

The recipient institution may retain rights to inventions arising from federally-sponsored research, providing that the recipient institution notifies the funding agency of all

- Disclosed Inventions
- Patent Applications
- Issued Patents

Licenses
Products
Decisions to discontinue process

and ...

A New Era Dawns

The Bayh-Dole Act

The recipient institution may retain rights to inventions arising from federally-sponsored research, providing that the recipient institution acknowledges the government’s right to a royalty-free license to the invention when deemed in the interest of the United States (march-in rights).
A New Era Dawns

The Bayh-Dole Act
The recipient institution may retain rights to inventions arising from federally-sponsored research, providing that the recipient institution acknowledges the government’s right to a royalty-free license to the invention when deemed in the interest of the United States (march-in rights).

and ...

A New Era Dawns

The Bayh-Dole Act
The recipient institution may retain rights to inventions arising from federally-sponsored research, providing that the recipient institution makes every effort to advance the science and make the discovery available to the public.
A New Era Dawns

The Bayh-Dole Act
The recipient institution may retain rights to inventions arising from federally-sponsored research, providing that the recipient institution makes every effort to advance the science and make the discovery available to the public.

and ...

A New Era Dawns

The Bayh-Dole Act
The recipient institution may retain rights to inventions arising from federally-sponsored research, providing that the recipient institution shares the financial benefits of licensing the discovery with the discovering scientist.
That’s the “Why” of Invention Reporting.

Take a deep breath and contemplate what we have learned ...

Now let’s consider “how” Invention Reporting can be done without undue stress.
Invention Reporting: A Quick Overview

✓ Pre-Disclosure (IPA)
Invention Reporting: A Quick Overview

✓ Pre-Disclosure (IPA)
✓ At Invention Disclosure

✓ Pre-Disclosure (IPA)
✓ At Invention Disclosure
✓ At 1 – to – 2 years (Elect Title)
Invention Reporting: A Quick Overview

- Pre-Disclosure (IPA)
- At Invention Disclosure
- At 1 – to – 2 years (Elect Title)
- At patent filing (non-provisional)

**Government Clause**
Invention Reporting: A Quick Overview

- Pre-Disclosure (IPA)
- At Invention Disclosure
- At 1 – to – 2 years (Elect Title)
- At patent filing (non-provisional)
  - At Government Clause
- At patent issuance

Invention Reporting: A Quick Overview

- Pre-Disclosure (IPA)
- At Invention Disclosure
- At 1 – to – 2 years (Elect Title)
- At patent filing (non-provisional)
  - At Government Clause
- At patent issuance
  - At technology licensing
Invention Reporting: A Quick Overview

- Pre-Disclosure (IPA)
- At Invention Disclosure
- At 1 – to – 2 years (Elect Title)
- At patent filing (non-provisional)
  - Government Clause
- At patent issuance
- At technology licensing
- **When product becomes publicly available**

- And every year thereafter (Utilization Report)
Invention Reporting: A Quick Overview

- Pre-Disclosure (IPA)
- At Invention Disclosure
- At 1 – to – 2 years (Elect Title)
- At patent filing (non-provisional)
  - Government Clause
- At patent issuance
- At technology licensing
- When product becomes publicly available
  - And every year thereafter (Utilization Report)
- Whenever we cease moving the technology forward

Invention Reporting: A Quick Overview

Pre-Disclosure
  - Part of the institution’s IP Policy
Invention Reporting: A Quick Overview

Pre-Disclosure

- Part of the institution’s IP Policy
- All faculty/researchers/likely potential inventors sign acknowledgment form when accepting employment offer

At Invention Disclosure
Invention Reporting: A Quick Overview

At Invention Disclosure
Invention Reporting: A Quick Overview

At Invention Disclosure

Creating an Invention Record
Invention Reporting: A Quick Overview

Elect Title
within one year (or two years)

Invention Reporting: A Quick Overview

At (non-provisional) patent filing

Main Menu

- Create an Invention Report
- To report a PVP application please refer to the PVP In Procedure
- Create a Patent Report
- Create a Utilization Report
- Upload Edison Invention Report Datastream
Invention Reporting: A Quick Overview

Creating a Patent Record

Invention Reporting: A Quick Overview

Creating a Patent Record, Parent – child relationship
Invention Reporting: A Quick Overview

When licensed and publicly available

Creating a Utilization Report

[Image of Main Menu]

[Image of Utilization Report]
Miscellaneous

Government Support Clause:

“This invention was made with government support under grant(s) [number(s)] awarded by [funding institution(s)]. The government has certain rights in the invention.”
Miscellaneous

Confirmatory License:

Fax this to (301) 480-0272

License to the United States Government

Invention Title:

Inventor(s):

Patent or Application Serial No.:

U.S. Filing/Issue Date:

Grant/Contract Identification Number(s):

Foreign Applications filed/intended in (countries):

The invention identified above is a Subject Invention under 35 U.S.C. 200, et seq., and the Standard Patent Rights clause at 37 CFR 401.14 or FAR 52.227-11, which are included among the terms of the above-identified grant/contract award from the United States Government. This document is confirmatory of:

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Miscellaneous

Waiving/Closing an Invention Record:

It’s simply a matter of changing the Invention Status field from “Elect Title” to one of the “Waive” statuses and selecting the reason for the waiver.
Miscellaneous

Waiving/Closing an Invention Record:

But . . .

- Make sure to update the Patent Status field in all patent records FIRST!
Miscellaneous

Waiving/Closing an Invention Record:

- Make sure to update the Patent Status field in all patent records FIRST!

Once an Invention Record is waived, you are locked out from making additional changes. The patent records will remain open and the notices will keep coming.

...Always remember...

...iEdison is an imperfect system.
. . . Always remember . . .

Mistakes are going to happen. The NIH Administrators are there to help.
Take a deep breath.
Take a deep breath.

Do your best.

It's going to be all right.
Take a deep breath.

Do your best.

It’s going to be all right.

I promise.

Questions?

David Englert
Marketing Manager
UR Ventures
david.englert@rochester.edu
www.rochester.edu/ventures
Discussion and Q&A

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Financial Conflicts of Interest
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  - June 24

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