Managing Your Intellectual Property

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IPIRA

Office of Intellectual Property
& Industry Research Alliances

IPIRA and OITA

- UCB Industry Alliances Office
  - Handles incoming research funding, materials and data and works with industry to establish and support research relationships
- UCB Office Of Technology Licensing
  - Performs IP management, develops IP and marketing strategies, negotiates IP contracts and also handles outgoing intellectual property such as materials and data
- UCSF's Office of Innovation, Technology & Alliances
  - The two offices work in the same way for UCSF community

What We Do at IPIRA

- The IAO completed 345 industry sponsored research agreements in FY 2014
- And signed 314 Material Transfer agreements for research materials
- In FY 2014 the OTL managed:
  - 198 patent invention disclosures
  - 1,531 total active inventions
  - 344 active license agreements
  - 687 active U.S. patents
  - 610 active foreign patents
  - Total income was $6,718,000

Ownership of IP

- The University owns all IP created using campus resources and created under University grant or contract funding
- All UC employees sign the Patent Acknowledgment when they are hired and assign IP to the campus

- Student work, not falling in one of the above categories, is owned by students

Patent Facts

- A patent does not create “freedom to operate”
- You have freedom to operate if no one else has the right to stop you (blocking IP) from using a technology or invention
- Patents provide a “negative right” that gives the holder the right to prevent others from using an invention
- UC patents technology, but does not make, use or sell products-UC always looks for a licensee
- Most companies do not share royalties with employee inventors, but Universities do.
- At UC 50% of net royalty income goes to the University, 35% is shared by the inventors, 15% goes back to the inventor’s department.

More Patent Facts

- Who is or who isn't an inventor is a matter of patent law and is determined by patent lawyers based on who makes an inventive contribution to conception or reduction to practice
- To be patentable an invention must be novel, unobvious and useful
  - "Obvious" - could a person of ordinary skill come up with what you've invented?
- If the University does not file a patent application:
  - The technology goes into public domain if published, and further work can be performed to further the invention
  - In rare cases, the University could assign the technology back to inventor
- UC licenses only patented technologies, and does not license know-how

Utility Patent

- Approximately 90% of the patents issued by the USPTO in recent years have been utility patents, also referred to as "patents for inventions”.
- A Utility Patent is issued for the invention of a new and useful process, machine, manufacture, or composition of matter, or a new and useful improvement.
- It generally permits its owner to exclude others from making, using, or selling the invention for a period of up to twenty years from the date of patent application filing, subject to the payment of maintenance fees.

To Patent or Not to Patent

- If an invention is patentable, is it marketable and of interest to a licensee?
- Evaluate the overall potential of the IP
  - Is there an industry sponsor on hand to license?
  - How does the technology stack up against competitors?
- Develop IP strategy
  - Should we file?
  - Where should we file? (U.S, International)
  - Type (Provisional, Non-provisional)
- Determine when and how to market and license

Patent Costs

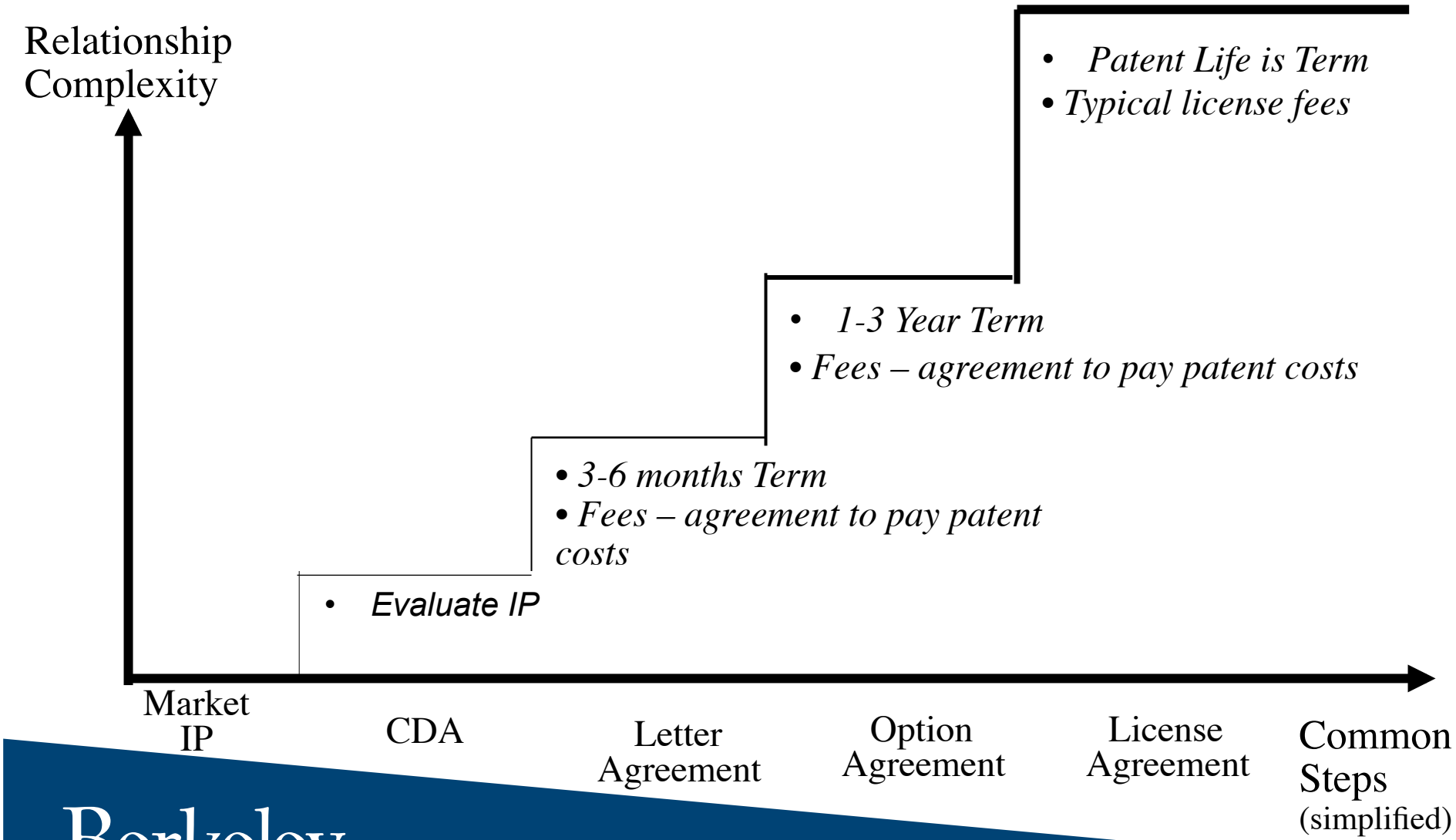
- A provisional patent lasts for one year and usually costs between $3K and $10K (fees paid primarily to patent law firm)
- A patent application costs from $20K per country
- An issued patent can cost from $40K for filing and prosecution per country

- At UC, inventors don't pay patent costs, since UC owns the IP UC pays and is reimbursed if licensed

Licensing Strategy

- Exclusive vs. non-exclusive
  - Significant investment required to reach market?
  - Early stage?
- Field of Use
  - Can it be used in multiple industries?
  - Applications (e.g. research, diagnostics, therapeutics)
- Territory/Geographies
  - Limited vs. worldwide

Licensing: Incremental Steps



Best Practices

- Plan ahead. Always keep your PI in the loop.
- If you think an invention will result from your work, call your Technology Transfer Office before you submit a publication or disclose the invention to the industry sponsor.
- Disclose your invention to the TTO - the TTO does not delay publication, but protects your invention and IP rights.
- Publication before filing will result in a public disclosure, US patent law provides limited ability to patent after publication, almost all other countries bar patent rights if published first.

Ways to Connect with Industry

- Use the Bio-E Alumni Network
- Later stage students can join the Berkeley Post-Doc Industry Exploration Program (PIEP) http://piep.berkeley.edu/
- Talk to your PI, talk to your fellow students

Contact Us With Questions!

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