

Frequently Asked Questions

1. A company wants to talk with me about my work. What should I do?

Contact the Technology Transfer Office (TTO) before disclosing to the company details about your research. We will move as appropriate to protect the patentability of any intellectual property.

2. Are there special rules for patenting and licensing federally funded research?

The Bayh-Dole Act gave universities the right to own patent rights to inventions developed with U.S. government funds. Under this act:

- Universities must report inventions arising from federally funded projects
- Universities must share revenues with inventors
- Universities have constraints on how technology is commercialized
 - the intellectual property must be licensed to a company that will exploit it to the advantage of the public
 - preference for licensing to U.S. companies
 - preference for licensing to small companies

3. Do I have to wait until a patent issues to publish my research?

No. Patents can take several years to issue. Once the patent is applied for, you can speak publically about your invention. In some cases, you can submit your paper before the patent is applied for – this must be done in coordination with the TTO to avoid unintended public disclosure. You can speak openly to other CSM personnel about your invention, as that is not as a public disclosure.

4. Doesn't patenting contribute to an air of secrecy and impede the free-flow of scientific information?

No. It is possible to both publish and patent an idea. While TTO would like ample time to assess an invention before applying for a patent, in some cases, this is not an option. The TTO will work with the inventor to make sure that commercialization of the invention does not in any way impede academic progress.

5. I want to publish an article. How can I avoid loss of patent rights?

Contact the TTO as early as possible. In some cases, the TTO can file a patent within a day. The ideal situation is that we would have at least a month to assess the invention before making a decision, but we will work with the inventors to make sure they can publish their results.

6. What constitutes public disclosure? What can I tell my colleagues and still retain my patent rights?

A public disclosure occurs when information that would allow someone skilled in the art to replicate your invention is made available to the public through any means. If a public disclosure occurs before a patent application is filed, all foreign patent rights are lost and you have just one year from the date of the disclosure to file a US patent.

If you discuss your invention with personnel inside CSM, it is not a public disclosure. If you want to discuss it with colleagues outside of CSM, we can put a confidentiality or non-disclosure agreement in place, which will allow you to share the details of your invention without damaging your patent rights.

7. Why should research institutions and researchers care about patents?

- To move inventions into the commercial realm, IP protection must be in place to enable companies to retain exclusivity in the marketplace.
- To provide companies sponsoring research - they must be able to recoup their investments in the technologies.
- To ensure inventions have practical applications and improve quality of life for citizens.
- Because Federal law (Bayh-Dole Act) requires that results from federally funded research be developed to benefit taxpayers.
- To attract and retain top faculty.
- To increase institutional revenues (shared with inventors).
- To promote economic development for the state.
- To generate income to promote and support teaching and research.
- To provide opportunities for more sponsored research

8. Who owns the inventions?

CSM owns all invention created by researchers in their areas of expertise. This includes all intellectual property developed through projects sponsored by the state, federal agencies or private industry. CSM does not assert ownership of traditional scholarly works such as articles, books, works of art and music or inventions made outside of the research field of expertise for which they were hired.

9. How do I know if my idea is worth protecting?

If you think there may be a possibility that the invention merits protection, please contact TTO and fill out an invention disclosure form as soon as possible. Doing the research to determine the fitness of the invention for commercialization is one of the primary duties of the TTO. We will work with you to help you understand and the potential paths for protection and commercialization.

10. How do I disclose my results to the OTT?

Fill out and sign the invention disclosure form at [\(insert hyperlink\)](#). The more complete the disclosure, the faster and more efficiently we can assess your invention. Please make sure all inventors are listed.

11. Who is an inventor?

An inventor is one who was the first to form, in his or her mind, a definite perception of the claimed invention or design.

- NOT AN INVENTOR - A person who:
 - contributes to an obvious element of the invention
 - merely suggests an idea
 - simply follows instruction
 - explains how or why an invention works
 - adopts information derived from another

- JOINT INVENTION
 - need not have physically worked together or at the same time
 - need not make an equal contribution
 - need not contribute to the subject matter of every claim

It is important that a US patent application name the correct inventors. Failure to name the proper inventors or including people who are not inventors could invalidate your patent. You can recognize contributors who are not inventors by sharing licensing revenues with them. Inventorship is a legal determination that we ask our patent attorneys to make.

12. What does the TTO do once it receives a technology disclosure?

The TTO will research the technology, explore the uses/markets for the technology, identify the inventive elements and assess the patentability and commercial viability of the invention.

13. What is a patent and what does it do?

A patent enables the owner of the patent to exclude others from making, using, or selling the invention for twenty years from the date of filing the

application. Patentable material includes new processes, devices, instruments, formulations, machines, manufactures, composition of matter, and any new or useful improvements of the former.

14. What are the criteria for obtaining a patent?

To obtain a patent, an invention must be novel, non-obvious, and have utility.

Novelty means that one cannot patent something that is already known. If the invention is described or sold anywhere in the world, or if it is sold anywhere in the world, it is not novel.

Non-obvious means that the invention could not have been conceived by someone “having ordinary skill in the art” without undue experimentation. In other words, if someone puts two pieces of prior art together that anyone in the field could do and it is potentially not patentable. This is a legal determination made by the patent examiner and can be contested if so desired.

Utility means that an invention must perform some function, be operable, and must be beneficial to society.

15. How do I obtain a patent?

If after assessing your invention disclosure report and talking to the inventor(s), the TTO feels the invention has commercial potential, we assign your invention to outside patent council to prepare a patent application. The inventor(s) should be available to the patent attorneys to answer any technical questions. Once filed, it can take some time before the patent is issued.

16. How do I search for inventions that are similar to mine?

Most likely this will have already been done in preparing an academic paper or presentation and we will rely on the inventor to provide us with these references. OTT will also do a prior art search and share the results with both the inventor and the patent attorneys. Failure to provide known prior art can lead to invalidation of the patent.

17. How should I keep my lab notes?

It is extremely important to keep good, detailed and dated lab notebooks. This documentation is crucial should your patent ever be challenged.

18. How much time and effort do the researchers have to put into patenting and commercialization?

While there is some time and effort needed to discuss the invention at the initial stages with the TTO and the patent attorney, the time demands on inventor(s) is minimal after that. The TTO may ask you to discuss the invention with potential licensees, but the TTO will market and negotiate the inventions for you and CSM.

19. What special considerations are associated with industry-sponsored research?

Because of the nature of business arrangements, there are several issues that both the inventors and industry need to be aware of:

- Ownership – As a state institution, CSM owns all intellectual property developed by its employees. However, the sponsor may have an exclusive option to any intellectual property developed. The sponsor may exercise that option for a exclusive or non-exclusive license, depending on their preference.
- Pre-valuing intellectual property – Because the intellectual property has not been developed at the time of the signing of a research agreement, assigning a value to that intellectual property is impossible. As such, CSM agrees to negotiate in good faith the value of the intellectual property, once its created and the sponsor has determined they wish to pursue a license agreement.
- Maintaining publication and research rights – CSM must always retain the ability to use the results of sponsored research in publications (subject to a short review by the sponsor) and for further research and educational purposes.

20. What is a confidential disclosure agreement (CDA) and what do I need to know about them?

A confidentiality or non-disclosure agreement allows researchers to talk to people outside of CSM while maintaining the patentability of the invention. If you need a CDA please contact the TTO or the Office of Research Administration. Under no circumstances should a researcher sign a CDA.

21. What is a material transfer agreement (MTA) and what do I need to know about them?

A material transfer agreement allows researchers to:

- Send materials to colleagues outside of CSM
- Receive materials from colleagues outside of CSM
- When you want to bring materials from another institution to CSM
- When you want to take materials to another institution from CSM

MTAs protect researchers at CSM by:

- Defining the material
- Setting the rules about how the materials will be used and distributed
- Defining any intellectual property and publication rights

If you need an MTA please contact the TTO or the Office of Research Administration. Under no circumstances should a researcher sign a MTA.