



Intellectual Property

UCOP Research Policy Analysis & Compliance

UC ANR Statewide Conference

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University of California

Agriculture and Natural Resources

Cooperative Extension

If you discovered the “next big thing” tomorrow...

How does an invention get from a notebook to the public marketplace?

-PCR (1985)
- disposable contact lenses (1987)
- Seedless Watermelon (1988)
- GPS (1993)
- DVD (1995)
- Prozac (1998)
- Google Maps (2005)

What can be protected as IP?

How does UC manage IP assets?

What is IP?

- Real Property
 - Land
 - Fixtures
- Personal Property
 - Tangible
 - Intangible (intellectual):
patents, copyrights,
trademarks, trade secrets



Common Attributes:
own, buy/sell, lease, mortgage,
attach/lien, inherit

Types of IP

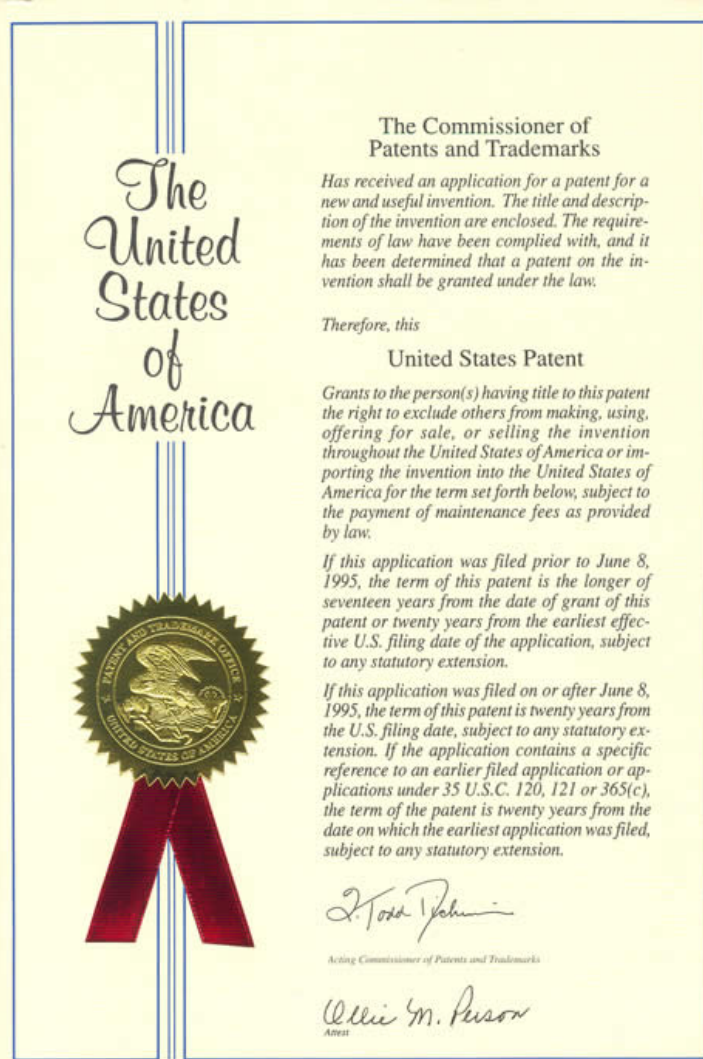
Intangible personal property which is *a product of the intellect*

- Patent
 - Protects new and useful ideas
- Copyright
 - Protects original expression
- Trademark
 - Protects name/logo used to identify goods
- Trade Secret
 - Protects a secret, as long as it is kept a secret



Focusing on Patents

- Patent *applications* not enforceable.
- Grant by fed gov't of the right to EXCLUDE others from practicing an invention (what is covered by claims)
- Protection for 20 years from filing date
- Not self-enforcing (may require court action)
- Not permissive (may be dominating patents)



Why is a patent important?

Development of new products require a large investment of time and money.

Companies may not invest in developing an invention w/out a good R.O.I.

A time-limited monopoly on a product creates the environment for return on investment. Patent protection provides such a monopoly.

Similar reasoning applies to other forms of IP.



3 Types of Patents

1. Utility patent
2. Design patent
3. Plant patent

However, before you can pursue a patent – you need an invention...

Can also protect certain plant varieties through a Plant Variety Protection (PVP) Certificate, which is not a patent and not examined by the U.S. Patent and Trademark Office.

What is an invention?

An invention is (1) a conception (a complete and operative idea) that is (2) “reduced to practice” – either actually (physical making or performance) or constructively (filing of a patent application)

Who owns it?

Inventors first own their inventions.



Who is an inventor?

An inventor is an *intellectual contributor* (more than an implementer or “a pair of hands”)

- Authorship is not always equal to inventorship.
- Once inventorship is established, evaluate whether inventors had an obligation to assign the invention rights to someone else (such as an employer). This determines ownership.

Joint ownership occurs when some inventors assign to one entity and other inventors of the same invention assign to a second entity.


UC Patent Policy

(Effective October 1, 1997)

- > Mandatory obligation to *report* all inventions
- > Inventor *assigns* title to UC for inventions where campus funds or resources used, or where invention is within inventor's scope of work
- > Distribution of Net Income (per '97 policy):
 - 35% to inventors
 - 65% to campus for research-related purposes

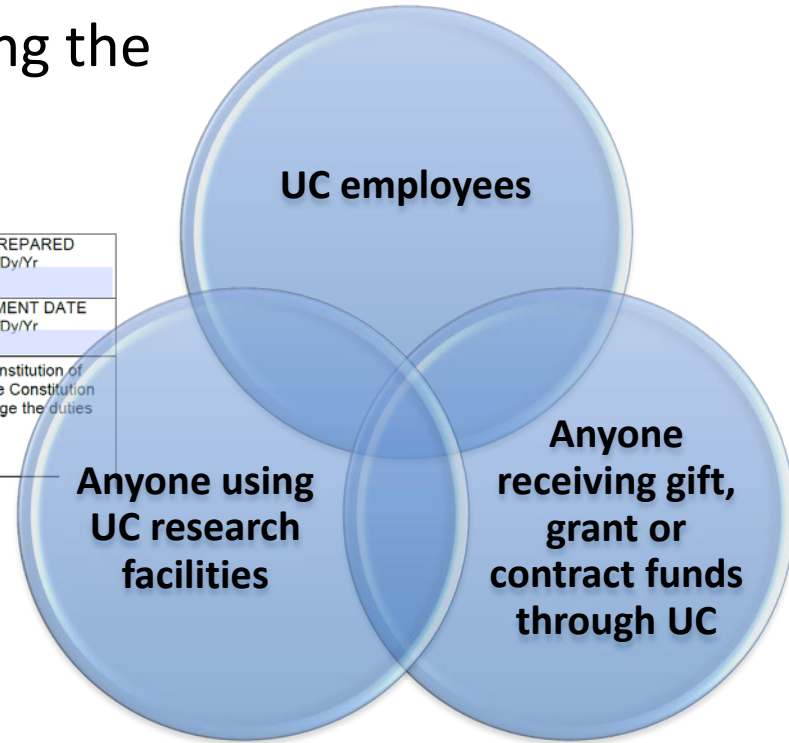
Acknowledgment of the UC Patent Policy

The UC Patent Policy is effected by signing the Patent Acknowledgement

	UNIVERSITY OF CALIFORNIA STATE OATH OF ALLEGIANCE, PATENT POLICY, AND PATENT ACKNOWLEDGMENT	EMPLOYEE'S NAME (Last, First, Middle Initial)		DATE PREPARED Mo/Dy/Yr
	UPAY585 (R 11/2011) E0420 71443-180	EMPLOYEE ID	DEPARTMENT	EMPLOYMENT DATE Mo/Dy/Yr

STATE OATH OF ALLEGIANCE I do solemnly swear (or affirm) that I will support and defend the Constitution of the United States and the Constitution of the State of California against all enemies, foreign and domestic; that I will bear true faith and allegiance to the Constitution of the United States and the Constitution of the State of California; that I take this obligation freely, without any mental reservation or purpose of evasion; and that I will well and faithfully discharge the duties upon which I am about to enter.

Taken and subscribed before me on: _____ Signature of Officer or Employee: _____
Mo / Dy / Yr



PATENT ACKNOWLEDGMENT

This acknowledgment is made by me to The Regents of the University of California, a corporation, hereinafter called "University," in part consideration of my employment, and of wages and/or salary to be paid to me during any period of my employment, by University, and/or my utilization of University research facilities and/or my receipt of gift, grant, or contract research funds through the University.

How to disclose

Complete a Record of Invention form (specific to your campus) and contact your technology transfer office (TTO).

- Describe the invention
- List inventors
- Imminent publications
- 3rd party funding or materials



We fully support your right to publish!

We also want you to know that once you publicly disclose your invention, patent rights are lost!

Some countries (i.e., U.S., Canada, Japan) have a limited grace period. In the U.S. we can still file a patent application within 12 months of your public disclosure. (However, if someone else publicly discloses your invention, we lose all U.S. rights.)

What does the TTO do?

Assess Patentability

U.S. requirements:

- *Patentable Subject Matter* (process, machine, article of manufacture, composition of matter, improvement)
- *Useful*
- *Novel*
- *Non-Obvious* (would not have been obvious at the time to a person of ordinary skill in the art by combining known things)



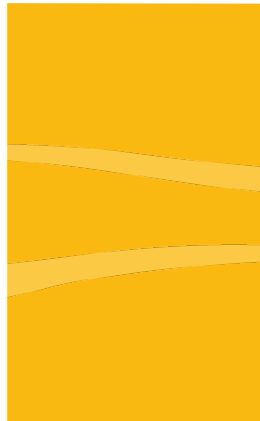
What does the TTO do?

Assess Marketability

Understand the technology and the manufacturing process

Research the state of market (market needs)

Research and understand product life cycle and regulatory environment



UC TTOs strive to license UC patent rights to industry partners with the capacity to bring the invention to the public marketplace.

UC's Licensing Guidelines require:

- Reserving rights for academic and non-profit institutions to practice the invention for research and educational purposes.
- Seeking fair consideration
- Fixing specific diligence milestones to ensure that licensee gets a product or service to market in a timely manner.

UC's Patent Policy requires:

- Licensing revenue is first used to reimburse UC for sunk patent costs.
- Remaining revenue is distributed 65% to the campus for reinvestment in research and 35% split equally among inventors.

Some metrics

“UC Inventions at a Glance”

- In 1980, the federal gov't held title to ~ 28,000 patents. Fewer than 5% were licensed to industry for development of commercial products...
- In 2015, the University of California system alone:
 - Held title to 9,454 issued patents (U.S. & foreign);
 - Managed 12,203 inventions (applications included); and
 - Managed 1,749 active license agreements for utility patent rights.
- In the last 5 years, 397 start-ups formed around UC technologies...

Thank you!

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UC Office of the President

