U2 Patent Basics
Who is an inventor?

Education

Experience

Employment

EVERYONE
What is a patent?

A patent is the right – granted by the government – to exclude for a limited time others from practicing the protected invention (i.e., infringing the patent).

The patent holder may sue and seek damages from any party that infringes a patent while it is in force.
Sounds great…can I get one?

• New
• Useful
• Non-obvious
• Apparatus
• Process
• Method
• “Anything under the sun that is made by man” – US Senate (1952)
Patents vs. Copyrights vs. Trademarks

• Patents protect inventions

• Copyrights protect original artistic expressions fixed in a tangible medium

• Trademarks protect brand identity and customer good will
Idea ➔ Invention?

• Does it need to be perfected?  
  NO
• Should I believe that I can make it work?
• Should I be able to explain it sufficiently?
• If practical, could I build a prototype?
• If practical, could I draw or diagram it?
• Can there still be room for improvement?  
  YES
I’m ready!

• Employees and students: *Stick around – you’ve come to the right place!*

• Non-employees, non-students, employees and students in their personal capacity: *You’re on your own, but…*

• Here are some pointers to get you on your way.
Search it!

• Formal searches
  – Contact a patent attorney
  – Search of issued and pending patents and applications, US and foreign
  – Very thorough and reliable (not perfect)
  – Typically includes a patentability opinion
  – Can take up to a few weeks
  – $400 and up
Search it!

• Informal searches
  – Google® can be invaluable
  – Visit a patent depository
  – Such as the one located right here at UND
    Chester Fritz Library
    Room 130A, 1st floor, West
  – Typically not as thorough as a formal search
  – Complex classification system to navigate
Getting a patent

• May take 2-5 years or longer
• Costs (including attorney fees) will typically run $9,000-$14,000 or more
• Your application will be examined to determine patentability
• No guarantees of success
• The rules can change in the middle of the game (e.g., business methods)
I got my patent…now what?

• Naturally, the government will hit you up
  – Issue fee
  – Maintenance fees over the life of the patent
  – Potentially a taxable asset

• So what’s the good news?
  – You can practice the invention yourself *
    • Your patent is not a defense to infringement
    • It’s a good idea to mark your goods or advertising
More good news

– You can license others to practice the invention
  • Collect licensing fees
  • Collect royalties

– You can sell the patent
  • Can structure the deal to provide royalties

– Invent some more!
  • Improvements as well as related technologies

– Build your empire!
Employees & Students

The University wants needs YOU!

Your ideas, innovations and creativity.
IP and Academic Research

• A patent is not a bar to publication.
• But the inverse may be true!
• In many cases, protecting intellectual property goes hand-in-hand with or complements scholarly work.
• IP protection may be required under your grants or sponsored research agreements.
What’s in it for me?

• Income Generation
  – Licensing Revenue from Use or Products
    • Inventors share 40 – 50% of net licensing revenue

• Fosters Technical / Business Relationships
  – Sponsored Research Funding, Joint Ventures, New Businesses
    • Inventors can get research funding
What’s in it for me?

- Enhances your resume or CV
- No out of pocket costs = no risk
- The University will partner with you
- Opportunity to form a start-up to commercialize your own technology
  - Center for Innovation
  - REAC
How do I get started?

- Contact the Office of Intellectual Property Commercialization and Economic Development
- Prepare a written disclosure
- Your invention will be evaluated for both patentability and commercialization potential
What if the University is not interested in my technology?

- If the University elects not to pursue your invention, all rights revert to you as the inventor.
- You may pursue a patent and/or commercialization on your own.
Yours or Mine?

- Students and employees may wonder whether the University has an ownership claim over their inventions.
- Unfortunately, there is no one-size fits-all solution to this question.
- The answer will usually turn on WHEN, WHERE, HOW and under WHAT CIRCUMSTANCES the invention arose.
Student Work

• Ordinarily, inventions made under the following circumstances belong to the University:
  – Under a sponsored research agreement
  – As part of a specific course project
  – In conjunction with a professor or other University employee
  – Utilizing University resources
Student Work

• Hypothetical # 1
  – Undergraduate student, sitting in her dorm, invents a new data compression protocol that has the potential to overtake the MP3.

• Hypothetical # 2
  – Graduate student is working on a grant in a biochemistry laboratory and, in conjunction with her professor, develops a new screening assay for detecting cancer.
Employee Work

• Typically, inventions made under the following circumstances belong to the employer:
  – In the course of one’s employment
  – At the specific direction of one’s employer
  – At work and/or during working hours
  – Utilizing employer resources
  – Directly related to employment and/or duties
Employee Work

• Hypothetical # 1
  – Dining hall employee spontaneously invents a new type of collapsible bleacher design that could be used at the Ralph Engelstad Arena.

• Hypothetical # 2
  – Facilities employee responsible for clearing snow on campus tinkers around in his home garage and invents a snow plow controller that enables more precise plowing around parked cars.
Contact Information

- Office of Intellectual Property Commercialization and Economic Development
- Twamley Hall, Room 102
- 777-6772
- Michelle Meyer, Marketing and Legal Assistant
- Tara Kopplin, Licensing Assistant
- Jason Jenkins, Patent Attorney
- On the web: www.und.edu/dept/ipcomm
Thank you.
Upcoming U2 Seminars

• Trademark Basics
  – Tuesday, April 13, 9:00 a.m.

• Copyright Basics
  – Tuesday, May 11, 9:00 a.m.

• Office of IP Commercialization & Economic Development – What Does it Do
  – Tuesday, June 1, 9:00 a.m.

• All sessions meet here in Swanson 16-18