



TEXAS A&M
INNOVATION

“Supporting Inventors and Commercializing Innovations Across The Texas A&M University System”

Presentation to Prairie View A&M University

Pete O'Neill: Chief Innovation Officer

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Intellectual Property (IP)

- “intangible creations of the human intellect”
- Patent
- Copyright: ©
 - Works of art, software code,
 - “The Simpsons”, “The Fountainhead”.
- Trademark: ®
 - Company names, product names,
 - Kleenex, Sheetrock.
- Proprietary Information/Trade Secrets:
 - Coke recipe.

Patent

- Called-out in USA Constitution.
- Temporary monopoly in exchange for sharing inventions with society,
 - Right to prevent others from practicing issued claims during patent life.
- Utility, Design, Plant.
- Novel, Not Obvious, Useful.
- Independent claims,
 - Dependent claims.

Patentable – Freedom to Operate

- $A+B+C$ is already patented.
- $A+B+C+D$ can be a new patent:
 - May not be able to practice that patent, because infringes $A+B+C$,
 - Fails freedom to operate,
 - *Gillette v. Schick*.
- $A+B+D$ can be a new patent, and does not infringe $A+B+C$.

Inventor – Assignee

- Under U.S. patent law, “invention” has two aspects:
 - Conception is the formation of a definite and permanent idea of the complete and operative invention in the mind of the inventor.
 - Reduction to practice is the process of showing that the claimed invention works for its purpose.
- An inventor must contribute to the conception of the invention.
 - MPEP 2137.01(II) states: “The threshold question in determining inventorship is who conceived the invention. Unless a person contributes to the conception of the invention, he is not an inventor.”
- An inventor needs not contribute to reduction to practice.
- Inventors do not need to contribute to every patent claim.
 - In fact, a contribution to only one claim suffices.

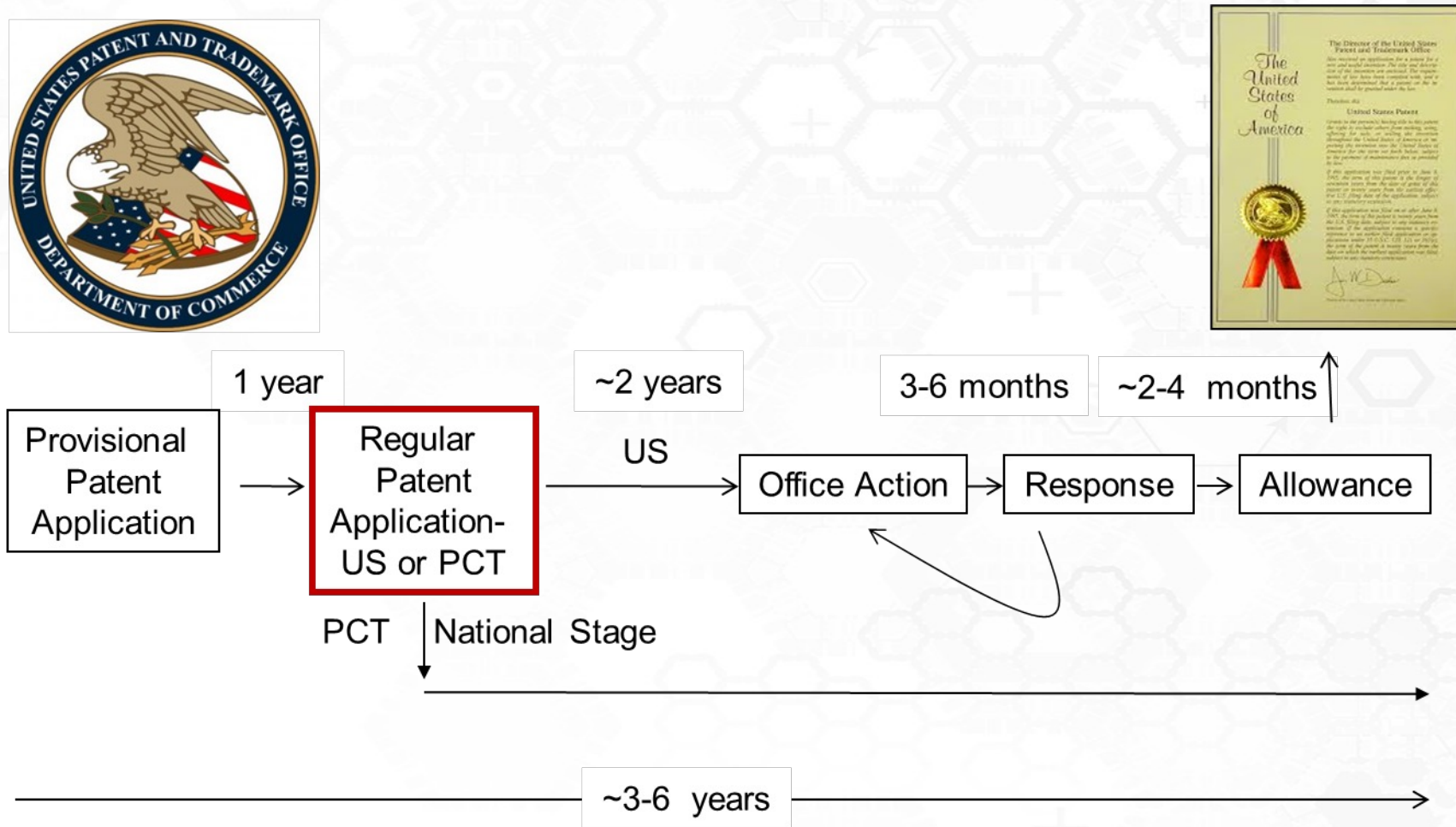
Inventor – Assignee

- Assignee = who owns patent
- Joint inventions
- Bayh-Dole Act of 1980,
 - Universities granted the right to elect to take title conceived or reduced to practice in the performance of a federal grant, contract, or cooperative agree.
 - Obligations:
 - Disclose each new invention,
 - File US & international patent applications,
 - Attempt to license inventions to develop the technology,
 - Share license revenues with inventors,
 - Use remainder to support research & education.

Inventorship – Authorship

- A common issue in a university setting is whether all of the authors of a journal article should be named as inventors of a corresponding patent application.
- Inventorship on a patent application and authorship on a research publication are distinct.
 - For example, a coauthor on a journal article may be a thesis advisor, a department or laboratory head, a graduate student, or a technician or research collaborator who carried out instructions. These individuals may not be co-inventors.
- Inventorship must be correct, or can invalidate patent,
 - Leave-off person who should be inventor,
 - Include person who should not be inventor.

Patent Process and Time



Commercialization

- Translate technology into products.
- Technology solution for a market need,
 - Technology push,
 - Market pull.

Benefits of Commercializing

- Deliver impact from researcher discoveries.
- Establish long-term industry relationships.
- Promote economic growth.
- Reward, recruit, and retain faculty.
- Generate resources for additional research and education.

Why not just publish

- Many development projects require IP protection to justify investment.
 - Investor funds are required to develop commercial products,
 - Translate research,
 - Even government translational funds (SBIR) require IP protection.
 - Investors expect return on their investment.
- Barrier to competition.

Why not just give IP to Sponsors?

- Sponsored research can be important ingredient for technology development.
- Sponsors could be commercialization partners.
- IRS – Tax Free Bond Act – prohibits use of tax-exempt financed buildings for “private use.” Private use includes transferring IP ownership to sponsors at less than “Fair Market Value”.
- The intellectual property rights usually requested by sponsors /collaborators (ownership of or preferential license rights to IP) would cause research to be deemed “private use” of facilities.

Invention Disclosure – Public Disclosure

- Invention disclosure submitted to our office.
 - A form with questions to capture information about invention,
 - Initiates process.
- Public Disclosure share info to company or other public presentation,
 - Confidential disclosure agreement,
 - Coversheet provisional.

Innovation Changes



**TEXAS A&M
INNOVATION**

Innovation Changes

- Innovation consolidated to single System office
 - Leverage System-wide assets for benefit of inventors
- Culture and Brand
- Customer Service Approach
- Partners in creating value
- Innovation Results

Messaging

- Website
- Newsletter
- Department Meetings, Roadshow
- Entrepreneur Networking
 - TNVC
- Innovation Workshops



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New Ventures

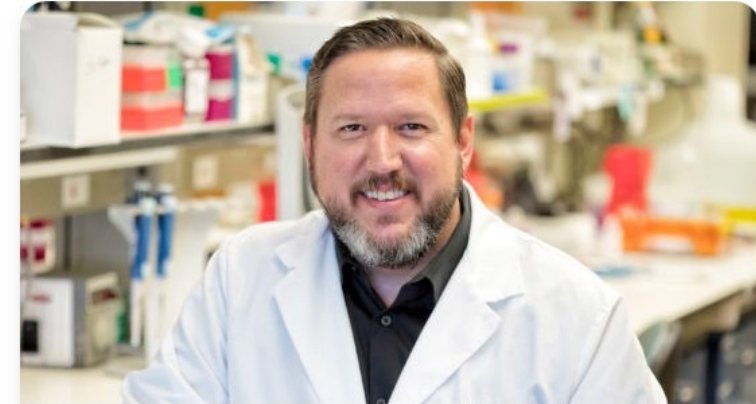
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Supporting Inventors and Commercializing Innovations Across The Texas A&M University System

FEATURED INVENTOR



Scott V. Dindot, Ph.D.

Dr. Dindot is an associate professor in the Department of Veterinary Pathobiology at the Texas A&M School of Veterinary Medicine & Biomedical Sciences. He and his team have developed a novel therapeutic candidate to treat a rare disorder, Angelman syndrome, which has been recently acquired by Ultragenyx Pharmaceutical, Inc. to further develop the treatment.

[Learn more about Dr. Dindot](#)

<https://innovation.tam.us.edu>





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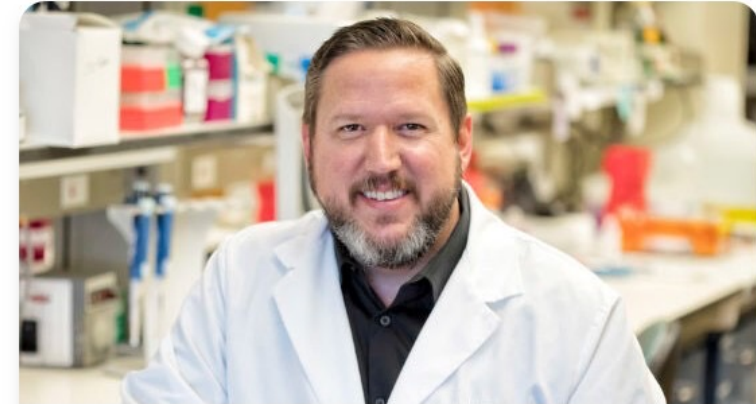
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Inventors

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If you are an employee of the Texas A&M System or any of its member agencies or institutions and are ready to submit your invention, software, or plant disclosure, you may do so here and a member of our team will be in contact with you shortly.

[Submit an Online Disclosure](#)

↓ DOWNLOADABLE DISCLOSURE FORMS

Invention Disclosure Form

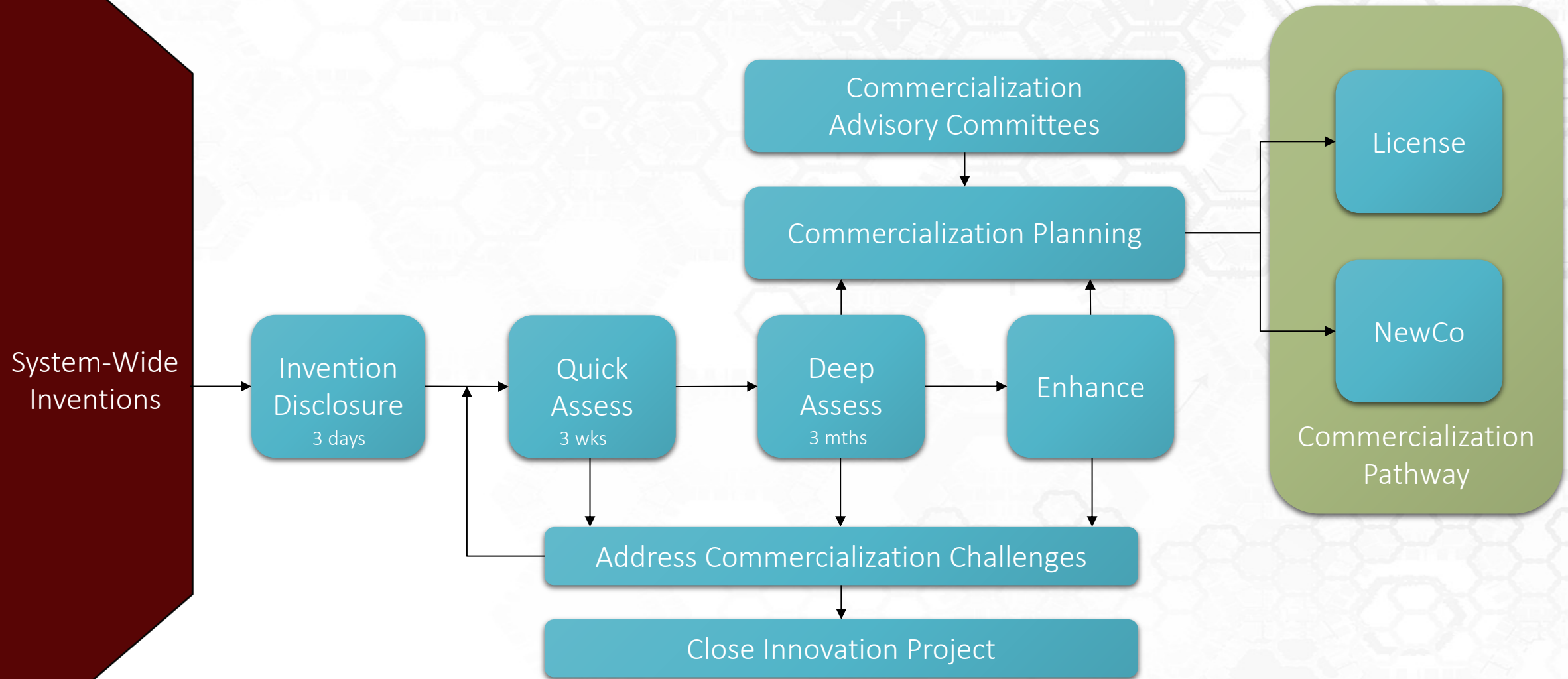
If your creation is considered an invention, please use this form to submit your disclosure.

[↓ Download Invention Disclosure Form](#)

Software Disclosure Form



Commercialization Process



License of IP Rights

- Agreement with partner commercialize.
- Grant of rights (similar to lease to house),
 - Exclusive,
 - Non-exclusive.
- Startup company will still require a license.
- Terms:
 - Signing fee (milestone payments),
 - Royalties,
 - Equity, sublicensing,
 - Minimum royalties, other “diligence” terms.

Development Funding Support

- Advancing Discovery to Market (ADM):
 - \$5M/year supported by University and System
 - Type 1 = \$100K projects
 - Type 2 = \$500K projects
 - About to announce first year awards
 - Work with Innovation team to prepare proposals for next round
 - [Advancing Discovery to Market – Division of Research \(tamu.edu\)](https://www.tamu.edu)
- Translational Investment Fund (TIF)
 - 1 year projects to develop and de-risk disclosed inventions
 - 3 Funding Rounds since 2020 launch
 - Funding up to \$75K
 - [Translational Investment Fund - Texas A&M Innovation \(tamus.edu\)](https://www.tamus.edu)



Questions?

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