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

Presentation to Prairie View A&M University

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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

Provisional Patent Application → 1 year → Regular Patent Application - US or PCT

~2 years ~3-6 months ~2-4 months

US Office Action Response Allowance

PCT National Stage

~3-6 years
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
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• 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
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.tamus.edu
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.

**DOWNLOADABLE DISCLOSURE FORMS**

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

**Software Disclosure Form**
Commercialization Process

- System-Wide Inventions
  - Invention Disclosure: 3 days
  - Quick Assess: 3 wks
  - Deep Assess: 3 mths
  - Enhance
  - Address Commercialization Challenges
  - Close Innovation Project
  - Commercialization Advisory Committees
  - Commercialization Planning
  - License
  - NewCo

Commercialization Planning

- Commercialization Advisory Committees
- License
- NewCo
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)

- 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)
Questions?

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