



**INTELLECTUAL PROPERTY
POLICY**



**TECHNOLOGY TRANSFER
HANDBOOK**

This handbook is intended to provide background and insight into the technology transfer process, the process by which the results of research and other scholarly activity are documented, protected and disseminated to the public.

The University has established the Intellectual Property Policy to ensure that the benefits of research and scholarship are fairly and fully realized and are disseminated in ways that will realize these benefits for the public as well. The University aspires to create an intellectual environment that motivates and honors the creative efforts of faculty, students and staff. Roosevelt seeks also to realize financial opportunities, consonant with the public interest, that will generate recognition and resources in support of the University's mission.

What is Intellectual Property (IP) and what is Technology Transfer?

Intellectual property is intangible property from original thought, such as ideas, expressions, formulas, or any other creation of the mind. This original creative work can be manifested in a tangible form, like tangible real or personal property, and may be bought, sold or leased. These major types of intellectual property include patents, copyrights, trademarks and trade secrets.

Technology transfer is the transfer of knowledge and discoveries (IP) to the public. It can occur through publications, educated students entering the workforce, exchanges at conferences, and relationships with industry, among other things. Technology transfer, for purposes of Roosevelt University's IP policy, refers to the formal licensing of technology to third parties by the University.

Why does Roosevelt University need an Intellectual Property Policy and Technology Transfer Process?

Because research can lead to the development of commercial products, there are accepted procedures that facilitate an orderly and efficient pathway to patents, licensure and commercialization. Roosevelt University has established an IP policy and technology transfer supports in order to protect the intellectual properties that researchers (faculty, staff and/or students) may produce. Having an IP policy also opens opportunities to collaborate with other individuals and agencies and can lead to greater grant opportunities. Other related reasons may include:

- Making a positive impact on society
- Achieving recognition and financial rewards
- Generating additional lab/departmental funding
- Attracting research sponsors
- Creating educational opportunities for students
- Linking students to future job opportunities

What is the Bayh-Dole Act and why is knowledge of this Act important?

The United States Bayh-Dole Act of 1980 allows universities and other nonprofit institutions to have ownership rights to discoveries resulting from federally funded research, provided certain obligations are met. These obligations include making efforts to protect (when appropriate) and commercialize the discoveries, submitting progress reports to the funding agency, giving preference to small businesses that demonstrate sufficient capability, and sharing any resulting revenues with the inventors. The Bayh-Dole Act is credited with stimulating interest in technology transfer activities and generating increased research, commercialization, educational opportunities, and economic development in the United States. Please note that the IP policy and technology transfer also applies to discoveries resulting from research that is not federally funded.

SECTION A:
**OWNERSHIP OF
 INTELLECTUAL
 PROPERTY**

Who owns what I create?

Ownership depends on the employment status of the creators of the invention and/or their use of Roosevelt University resources. Considerations include:

- What is the source of the funds or resources used to produce the invention?
- What was the employment status of the creators at the time the IP was made?
- What are the terms of any agreement related to the creation of the IP?

As a general rule, Roosevelt University owns and protects inventions made by Roosevelt University employees that are produced within the scope of their employment or using University resources. This becomes a joint venture.

Who owns rights to discoveries made while I am consulting?

The ownership of inventions made while consulting for an outside company depends on the terms of your consulting contract. It is important to clearly define the scope of work within consulting contracts to minimize any issues with ownership of inventions created from University research.

Can a student contribute to an invention?

Yes, many students work on inventions at Roosevelt under a wide variety of circumstances. Roosevelt University promotes student research and participation in such activities, and students can be named as inventors and are subject to the same rules and receive the same benefits as University employee inventors. In general,

AUTHORS OR INVENTORS OWN THE RIGHTS TO ...	THE UNIVERSITY OWNS THE RIGHTS TO ...
Musical scores	Inventions
Articles	Lab notes
Works of artistic imagination	Works using significant University resources
Popular novels	
Poems	
Textbooks	
Lectures	
Lecture notes	
Musical exercises	
Study guides	

SECTION B:
**TECHNOLOGY
 TRANSFER
 PROCESS**

How is technology transferred? What are the typical steps in the process?

Technology transfer activities at Roosevelt are a joint activity undertaken by the Office of the Provost and the Office of Government Relations and University Outreach (collectively referred to as the Technology Transfer Office, or "TTO") in partnership with the University's external partner agency, UNeMed. (See Appendix A for a description of UNeMed and how UNeMed will work with Roosevelt University to implement the technology transfer process.)

The process of technology transfer is summarized below. Note that these steps can vary in sequence and often occur simultaneously.

Research: Work developed through the use of University resources or the specific direction or instruction of the University.

Pre-Disclosure: An early contact with TTO personnel to discuss the invention and to provide guidance with respect to the disclosure, evaluation and protection processes.

Invention Disclosure: The written notice of invention that begins the formal technology transfer process. An Invention Disclosure Form (IDF) remains a confidential document and should fully document the invention so that the options for commercialization can be evaluated and pursued.

Assessment: The period in which the IDF is reviewed, patent or other IP searches are conducted, and the market and competitive technologies are analyzed to determine the invention's commercialization potential.

Protection: Patent protection, a common legal protection method, begins with the filing of a patent application with the U.S. Patent and Trademark Office and, when appropriate, foreign patent offices.

Marketing to find or form a licensee: UNeMed staff identifies candidate companies that have the expertise, resources and business networks to bring the technology to market.

Either Existing Business or Form Start-up: If creation of a new business start-up has been chosen as the optimal commercialization path, assistance may be available to the founders in planning, forming and finding funding for the start-up.

If one or more appropriate existing companies are selected as a potential licensee, the appropriate financial and diligence terms will be developed with the licensees to fully commercialize the technology.

Licensing: A license agreement is a contract between the University and a third party in which the University's rights to a technology are licensed (without relinquishing ownership) for financial and other benefits.

Commercialization: The licensee continues the advancement of the technology and makes other business investments to develop the product or service.

Revenue: A portion of revenues received by the University from licenses are distributed to inventors according to the IP policy.

Reinvest in Research and Education: Technology is typically transferred through a license agreement in which a university grants its rights in the defined technology to a third party for a period of years, often limited to a particular field of use and/or region of the world. The licensee (the third party licensing the



technology) may be an established company or a new business start-up (which may be founded by the researcher). Licenses include terms that require the licensee to meet certain performance requirements and to make financial payments to the University. These payments are shared with the inventors and are also distributed to the schools/colleges, departments/units, and central administration.

How do I work with the Technology Transfer Office (TTO)?

As a first step, researchers are encouraged to contact the TTO during their early research activities to be aware of the options that will best leverage the commercial potential of their research. The TTO will assist with questions related to evaluation of the IP, marketability, commercial partners, and patenting as well as other protection methods. You will have access to a toolkit of resource documents, including an Invention Disclosure Form (IDF) and the interinstitutional agreement template. The TTO will assist you in accessing the tools you need and in mapping out a plan of action.

What is the Advisory Committee on Intellectual Property (the “Committee”), and what does it do?

The Committee is comprised of the University Provost, a college dean (selected by the Council of Deans), Vice President for Government Relations and University Outreach, Associate Provost for Grants and Research, and Office of Technology Transfer Administrative Liaison. The Committee advises the University relative to the implementation of the IP policy and technology transfer activities.

How is technology transfer funded?

The University provides the up-front funding necessary to review, assess and pursue patent costs. Once revenue is generated on a technology, funds go to recover the University’s up-front investment prior to the distribution of any net revenue.

How long does the technology transfer process take?

The process of protecting the technology and finding the right licensing partner may take months—or even years—to complete. The amount of time will depend on the development stage of the technology, the market for the technology, competing technologies, the amount of work needed to bring a new concept to market-ready status, and the resources and willingness of the licensees and the inventors.

How are license revenues distributed?

The TTO is responsible for managing the expenses and revenues associated with technology agreements. Per Roosevelt University’s IP policy, net revenue is shared as follows:

Net Revenue*	Office of the Provost	Inventor	Department	College
% Breakdown	40%	40%	10%	10%

*Funds after expenses.

Invention Disclosure Forms

What is an Invention Disclosure Form (IDF)?

An IDF is a written description of an invention or development that is provided to the TTO. The IDF should list all collaborating sources of support and include all of the information necessary to begin pursuing protection, marketing, and commercialization activities.

Why should I submit an IDF?

There are at least three reasons. First, as an employee of Roosevelt University, you are required to do so. Second, if the research was conducted using federal funds, investigators are required to report inventions to the University, and the University, in turn, is required to report to the government (failure to do so can actually jeopardize future federal funding). Finally, disclosure starts a process that could lead to the commercialization of your technology. This may involve beginning the legal protection process and working to identify outside development partners.

How do I know if my discovery is an invention?

One good measure is if you have a research finding or development that may solve a significant problem. Or perhaps it is something totally novel, and not yet in the literature.

When should I complete an IDF?

You should complete an IDF whenever you feel you have discovered something unique with possible commercial value. This should be done well before presenting the discovery through publications, poster sessions, conferences, press releases, or other communications. Once publicly disclosed (i.e., published or presented in some form), an invention may have restricted or minimal potential for patent protection. Differences exist between the U.S. and other countries on the impact of early publication on a potential patent. Be sure to inform the TTO of any imminent or prior presentation, lecture, poster, abstract, website description, research proposal, thesis, publication, or other public presentation referencing the invention.

Should I report research tools to the TTO?

Yes, you should if your new tools would benefit other researchers and you are interested in providing them to those researchers and other third parties. Typically, research tools are materials such as antibodies, vectors, plasmids, cell lines, mice, and other materials used as “tools” in the research process. Most research tools do not necessarily need to be protected by patents to be licensed to commercial third parties and/or generate revenue for a laboratory. If you have research tools that you believe to be valuable or wish to provide to others (including research collaborators), the TTO will work with you to develop the appropriate protection, licensing and/or distribution strategy.

How do I submit an IDF?

A toolkit of resource forms will be publicly available. Or you can simply request the IDF from the TTO.

After I have submitted my IDF to the TTO, what happens next?

The TTO reviews the research disclosures, not for content, but for inclusion of the required elements that will allow the IDF to be reviewed for patent-ability. The TTO then works with Roosevelt's partner agency (UNeMed) which has expert staff qualified to assess the IP patentability and potential for licensing and commercialization. UNeMed experts will examine each IDF to review the novelty of the invention, protect-ability and marketability of potential products or services, relationship to related IP, size and growth potential of the relevant market, amount of time and money required for further development, preexisting rights associated with the IP, and potential competition from other products/technologies. This assessment may also include consideration of whether the IP can be the basis for a new business start-up. The TTO, the Advisory Committee on Intellectual Property, and the appropriate designees (collectively "Reviewers") will evaluate all disclosures of inventions. The inventor will generally be notified within three (3) months of the date of disclosure of the University's decision.

Should I list visiting scientists or scientists at other institutions on my IDF?

All contributors to the ideas leading to a discovery should be mentioned in your disclosure, even if they are not Roosevelt University employees or students. The TTO, along with legal counsel, will determine the rights of such persons and institutions. It is prudent to discuss with the TTO all working relationships (preferably before they begin) to understand the implications for any subsequent inventions.

**What is a patent?**

In the U.S., a patent gives the holder the right to exclude others from making, using, selling, offering to sell, and importing the patented invention. A patent does not necessarily provide the holder any affirmative right to practice a technology since it may fall under a broader patent owned by others. Instead, it provides the right to exclude others from practicing the invention. Patent claims are the legal definition of an inventor's protectable invention.

What type of subject matter can be patented?

Patentable subject matter includes processes, machines, compositions of matter, articles, some computer programs, and methods (including methods of making compositions, methods of making articles, and methods of performing business).

What is the definition of an inventor on a patent, and who determines this?

Under U.S. law, an inventor is a person who takes part in the conception of the ideas set forth in the claims section of a patent application. Thus, inventor-ship of a patent application may change as the patent claims are changed during prosecution of the application. An employer or person who only furnishes money to build or practice an invention is not an inventor. Inventor-ship is a legal issue and may require an intricate legal determination by the patent attorney prosecuting the application.

Who is responsible for patenting at Roosevelt University?

The TTO contracts with outside technology transfer and patent counsel for IP protection, thus ensuring access to patent specialists in diverse technology areas. Inventors work with the patent counsel in drafting the patent applications and responses to patent offices in the countries in which patents are filed.

What is the patenting process?

Patent applications are drafted by a patent attorney. The TTO and the patent attorney will ask you to review a patent application before it is filed. At the time an application is filed, the inventor(s) will sign a Declaration (indicating that he is/they are an inventor) and an Assignment (which formally assigns the application to Roosevelt University). Two or three years later, the United States Patent and Trademark Office (USPTO) will send the patent attorney written notice as to whether the application and its claims have been accepted in the form as filed. Usually, the USPTO rejects the application because either certain formalities need to be cleared up, or the claims are not patentable over the “prior art” (anything that workers in the field have made or publicly disclosed in the past). The communication sent by the USPTO is referred to as an “Office Action.”

If the application is rejected, the patent attorney must file a written response, usually within three to six months. Generally, the attorney may amend the claims and/or point out why the USPTO’s position is incorrect. This procedure is referred to as patent prosecution. Often it will take two Office actions and two responses by the patent attorney—and sometimes more—before the application is resolved. During this process, input from the inventor(s) is often needed to confirm that the patent attorney understands the technical aspects of the invention and/or the prior art cited against the application. Patent prosecution ends when the USPTO sends notice that the application is allowable or when the TTO and the patent attorney determine that the USPTO will not allow any subject matter.



What is a copyright and how is it useful?

Copyright is a form of protection provided by the laws of the United States to the creators of “original works of authorship.” This includes literary, dramatic, musical, artistic, and certain other intellectual works, as well as computer software. This protection is available to both published and unpublished works. The Copyright Act generally gives the owner of copyright the exclusive right to conduct and authorize various acts, including reproduction, public performance and making derivative works. Copyright protection is automatically secured when a work is fixed into a tangible medium (such as a book, software code, video, etc.). In some instances, the University registers copyrights, but generally not until a commercial product is ready for manufacture.

How do I represent a proper University copyright notice?

Although copyrightable works do not require a copyright notice, we recommend that you use one. For works owned by Roosevelt, use the following notice: © 200X Roosevelt University. All rights reserved.”



- Email techtransfer@roosevelt.edu when you believe you have created or discovered something unique with potential commercial or research value or with any questions as you engage in research activities.
- Complete and submit the Invention Disclosure Form (IDF) before publicly disclosing your invention or submitting a manuscript for review and publication.
- To avoid risking your patent rights and possibly hindering the opportunity to market your invention, you must avoid public disclosures prior to rights being pursued. Fortunately, simple steps can protect your invention before you publish abstracts or manuscripts, or present at meetings.
- Keep the TTO informed of upcoming publications or interactions with companies related to your IP.
- On an IDF include companies and contacts you believe might be interested in your invention or who may have already contacted you about your invention. Studies have shown that more than 70 percent of all licenses are executed with commercial entities known by the inventor, so your contacts can be extremely useful.
- Respond to the TTO, UNeMed and outside patent counsel requests. While some aspects of the patent and licensing process may require significant participation on your part, we will strive to make efficient use of your valuable time.

End Note

IP Toolkit: During the process from disclosure of inventions to commercialization, various documents, forms, agreements and guidelines may be required that are relevant to carry out the process effectively and efficiently. These are available in a toolkit in template format suitable for modification and/or use as needed and appropriate. Please contact the Office of Technology Transfer at techtransfer@roosevelt.edu for assistance in the completion of these documents. Relevant forms and documents can be found at roosevelt.edu/techtransfer.

This Handbook uses and adapts information from the University of Michigan's "Inventor's Guide to Technology Transfer," with adaptations for University of Nebraska Medical Center and the TTO. We are extremely appreciative of Ken Nisbet, Robin Rasor, Mark Maynard, and the rest of the staff of the U-M Office of Technology Transfer for their kind permission to use their excellent material and to the University of Michigan for permission to use its copyright.

Appendix A: UNeMed

UNeMed is a for-profit corporation owned by the Board of Regents of the University of Nebraska that is responsible for a spectrum of technology transfer activities, including protecting, marketing and commercializing Roosevelt inventions.

UNeMed will provide technology transfer support services for Roosevelt University on an as-needed basis. As inventions/creations are disclosed, the assessment of the potential of the IP for commercialization will be conducted by UNeMed. If Roosevelt University decides to pursue a patent, UNeMed may be brought in again to help facilitate the patent process and other processes going forward as needed. Fees/arrangements for service will be agreed upon prior to each engagement, and the partnership between Roosevelt University and UNeMed will be evaluated annually.

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