Intellectual Property

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Learning Objectives

- Learn what intellectual property is and the benefits of intellectual property laws.
- Identify and distinguish between the primary types of intellectual property.
- Understand why intellectual property is important generally and in research administration.

Drilling Down

- What is intellectual property?
- What are the benefits of IP laws and the system they create?
- Primary types of IP
- Why IP matters in research administration

What is Intellectual Property?

- Creations of the mind: inventions; literary and artistic works; and symbols, names and images used in commerce.
- Property (as an idea, invention, or process) that derives from the work of the mind or intellect.
- Intangible creations of the mind that can be legally protected.
- A property interest in intangibles.

The Creation, Not The Thing

- It is the design and process by which the IPhone is created, not the device.
- It is the formula and process by which Dr. Pepper products are made, not the soft drink.
- It is the aesthetic expression of the artist's talent that painted the image, not the portrait.
- It is the brand name that embodies the reputation of the product and its manufacturer, not the refrigerator.

Benefits of IP Laws

- International treaties, federal and state laws, and contracts recognize ownership interests and provide exclusive rights to the owners.

- Policies supporting protection of IP are myriad and at times contrary to other important policies such as competition.

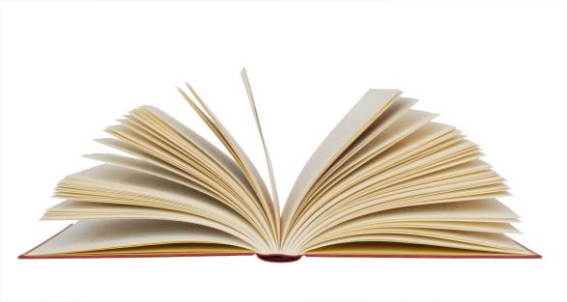
Benefits of IP Laws

- To allow the creators or owners of the IP to benefit from their own work or investment in a creation by allowing them to control its use.
- To give an incentive for people to develop creative works that benefit society by ensuring that they can profit from their works without fear of misappropriation by others.

Benefits of IP Laws

- Rewards creativity and human endeavor, which fuel the progress of mankind.

  - **Multibillion dollar film, publishing and software industries** would not exist without copyright protection.



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Benefits of IP Laws

Without the rewards provided by the patent system, researchers and inventors would have little incentive to continue producing **better and more efficient products** for consumers.

Consumers would have no means to **confidently buy products or services** without reliable trademark protection and enforcement mechanisms to discourage counterfeiting and piracy.

Types of IP

- Copyrights: Original Expressions
  - Writing, music, film, architecture and other original intellectual artistic expressions
- Trademarks: Source Indicators
  - Symbols, names and slogans that identify goods and services
- Patents: Exclusive rights to use or transfer
  - New inventions, machines, technological improvements, manufactured goods
- Trade Secrets: Internally protected

© 101

- Legal right of authors to exploit and receive the benefits of their work.
- Copyrights protect the expression of the idea, not the idea itself.
- In research administration, software and sometimes drawings and scientific works.

© 101

- Copyright is produced through the act of creating the work.
  - © TerriMinatra2016

- Work must be:
  - Original
  - Work of Authorship
  - Fixed in a tangible medium

© 101

- Author has exclusive rights to:
  - Reproduce the copyrighted work
  - Prepare derivative works
  - Distribute copies of the work to others
  - Perform the work in public
  - Display the work in public

- May be registered with U.S. Copyright Office.*

© 101

- Types of works that may be copyrighted include:
  - Literary works
  - Musical works including accompanying word
  - Dramatic works, including any accompanying music
  - Pantomimes and choreographic works

Continued

© 101

- Pictorial, graphic and sculptural works
- Motion pictures and other A/V works
- Sound recordings
- Architectural works

No copyright subsists in U.S. Government works created by government employees; however they can be created by contractors.

Trademarks 101

- Definition: one or more words, devices or symbols, or some composite of both, which someone uses to:
  - Distinguish his or her goods or services from those of others
  - Restrict others from using confusingly similar marks

Trademarks 101

- Protects a distinctive name or design which others identify as representative of the **goodwill** of the business.
  - Provides quality assurance to purchasers.

Trademarks 101

- Types of Marks
  - **Trademark**: source of goods
  - **Service marks**: source or origin of services
  - **Collective marks**: members of an organization or group vs. non-group members
  - **Certification marks**: Products or services meets certain characteristics or function levels

Trademarks 101

- First user of an inherently distinctive mark that has acquired secondary meaning can exclude others from:
  - Using the mark in a confusingly similar manner
  - Using confusingly similar marks
  - Diluting the value of the mark

Trademarks 101

- Mark may be registered with US Trademark and Patent Office ("USTPO") or state offices.
  - If the user registers the mark and makes continuous usage of the mark for 5 years, the user's right to continued use of the mark may become uncontestable.

Patents 101

- A patent is a written instrument issued by the U.S. Trademark and Patent Office, an agency of the Department of Commerce.

- Types of Patents
  - Plant
  - Design
  - Utility

Patents 101

Government-granted monopoly giving an inventor the right to exclude all others from practicing the invention for 20 years.

Patent owners may license or sell invention rights to someone else.

Once the patent expires, protection ends and the invention enters the public domain and is available for commercial exploitation by others.

Patents 101

- Who may apply: any person who invents or discovers any new and useful:
  - Process
  - Machine
  - Manufacture
  - Composition of matter
- Or a new and useful improvement of these 4 things.

Patents 101

- "Anything under the sun that is made by man"
- Laws of nature, physical phenomena, abstract ideas not patentable
- Patents are issued for THINGS, not ideas or thoughts or the expression of an idea like a copyright

Patents 101

- The inventor must make an application to the PTO and submit to an examination process.
  - Background and description of the invention in clear language and in enough detail that a person with an average understanding of the field could use or reproduce the invention
    - AND MORE!

Patents 101

- The invention has to be:
  - USEFUL
  - NEW
    - Not described in printed publication or in public use, on sale or otherwise available to the public before the filing date.
  - NON-OBVIOUS

Patents 101

- Time-consuming, often expensive process.
- At least 2 years, frequently 4 or more.
- Patent applications are accessible by the public with some exceptions for national security.

Rights in Patents Under Government Contracts

- Government became primary R & D funding sponsor after WW II.
- 1980 Bayh-Dole Act created a uniform patent policy among the many federal agencies that fund research.
  - Enabled universities, nonprofit research institutions and small businesses to retain title to inventions they made using federal research funding. FAR 52.227-11
  - Extended to for profits and large businesses in 1983.

Rights in Patents Under Government Contracts

- Disclosure to agency
- Election of title within 2 years
- Filing of a patent application
- Use of domestic licensing – “substantially manufactured” in U.S.

Rights in Patents Under Government Contracts

- When contractor takes title, government is granted a non-exclusive, nontransferable, irrevocable paid up license to the invention

- If contractor doesn't elect title or comply with procedural requirements, government can take title and contractor will receive a license

Rights in Patents Under Government Contracts

- Alternate FAR 52. 227-13 requires the contractor to assign title to the government, subject to a license back
  - Contractor not in U.S., no place of business
  - Contractor is subject to the control of a foreign government
  - Invention relates to foreign intelligence or counterintelligence
  - Other exceptional circumstances

Rights in Patents Under Government Contracts

- There are Bayh-Dole equivalents in many international countries, including Brazil, China, Denmark, Finland, Germany, Italy, Japan, Norway, Philippines, Russia, Singapore, South Africa, South Korea and United Kingdom.

Why IP Matters In Research

- Universities, hospitals and research centers conduct a lot of research that generates ground breaking inventions that save lives, and improve the way we live, work and play.
- That research has to be developed into a product that can be marketed and distributed.
- Legally protected IP maximizes options for that commercialization.

Why IP Matters in Research

Technology transfers get research from the lab into corporate product development.

- Identifying new technologies.
- Protecting them through patents & copyrights.
- Forming development and commercialization strategies such as marketing and licensing to existing private sector companies or creating a new startup.

Why IP Matters in Research

- $518 Billion impact on USGDP from university/nfp licensing from 1996-2013.
- 3.8 million jobs created same time period.
- 914 start-ups in FY 2014; 5,000 since 1980.
- 965 new products based on research discoveries introduced to market in FY 2014.
- >80,000 patents issued to research institutions in last 20 years.

Takeaways

- IP consists of intangible creations of the mind.
- IP system balances competing policies.
- 2 types of IP most important in research administration are patents and copyright. Patents are granted by the government; copyrights are produced when the work is created.
- Technology transfers get research from the lab to commercial development and protecting IP is crucial to the process.

Comments and Questions

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