What We Do

We transfer UAB’s discoveries from the laboratory to market through licensing or start-ups

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Our Goal: To develop a collaborative working relationship with faculty and students to find commercial partners and create successful start-ups
What Is Intellectual Property (IP)?

1. IP is NOT necessarily tangible property.
2. IP can be protected by patent, copyright, trademark and/or trade secret.
3. Patent protection and trademark protection are both obtained from the USPTO in the United States.
4. Copyright protection is inherent in the property when created and reduced to a tangible form; U.S. copyright registration is done with the Library of Congress.
IP Examples

Discoveries
(e.g., a way to improve child nutrition via a survey)

Artworks

Inventions
(e.g., a set of curricula training first responders serving autistic patients)

Publications
(e.g., impact of simulation that mimics socioeconomic realities)

Websites; Software
Why Is IP Important?

- Protects important assets from theft, exploitation or abuse
- Identifies contributions by the company or inventor to the field
- Secures monetary compensation for the company (and sometimes the inventor)
- Sometimes all a company has to leverage is its IP
How Do We Protect IP?

**Copyright protection**
Available for original works of authorship; copyrights may be registered with the Library of Congress.

**Trademark protection**
Available for words, names, symbols, or designs used to represent the origin of a product. Trademarks may be registered with the USPTO.

**Trade secrets**
Afford protection of information and ideas by the maintenance of secrecy. There are strict legal requirements for the protection of intellectual property as a trade secret.

**U.S. patents**
Granted by the U.S. Patent and Trademark Office (USPTO) and include utility, design, and plant patents. Foreign jurisdictions also grant patents.
What Can Be Patented?

- Eligible Subject Matter (i.e., man made)
- Useful
- Novel (No patents or publications, cannot be commercially available)
- Non-Obvious to One Skilled in the Art
- Adequately Described
What is a Patent?

A patent, is a government (USPTO) grant to the inventor of **property rights** for an invention.

What is granted is the right to exclude others from making, using or selling the invention without first obtaining a license from the patent holder.

The term of a new patent is **20 years** from the date on which the application was filed.
Patent Prosecution

The patent "prosecution" process is a negotiation between the patent attorney and the U.S. patent examiner in which the attorney, with the inventor’s assistance, must justify the invention by proving that it satisfies the basic criteria for the issuance of a patent: **novelty, utility, and non-obviousness**.

The patent prosecution process will take at least two to five years and will usually cost over $30,000 - $50,000 for the US patent. Foreign patent costs of between $50,000 and more than $100,000 are not unusual depending on how many foreign applications are made.
The 1978 Copyright Act gives the owner of copyright the exclusive right to reproduce, prepare derivatives, distribute copies, and publicly perform or display “original works of authorship”.

A copyright protects the form of expression rather than the subject matter or idea of the writing. Materials covered by copyright protection include literary, dramatic, musical, artistic, computer software, DNA sequences, and certain other intellectual works, both published and unpublished. In software, copyright protects the actual code.

Copyrights are registered by the Copyright Office of the Library of Congress (© - symbol used to denote copyright).

Duration: varies, but up to the life of author + 70 years.

It arises automatically but must be registered before an owner can enforce the copyright.
Protection of Software Specifically

**Patent?**
- Higher standard of scrutiny to pass
- Must be novel algorithm and likely must meet “machine or transformation test” (i.e., be tied to a particular machine or operate to transform an article to a different state or thing)
- Expensive!
- By the time you receive an issued patent, the software may be obsolete
- Greater protection if you can get it!

**Copyright?**
- Coverage is narrow
- Based on the expressive or arbitrary lines, not the functional elements
- Can redact a certain amount of code, but that is often not really helpful
- Fair Use Defense – difficult to overcome
- Can still be reverse-engineered
- (Virtual identity rule and independent creation)
Who is an Inventor?

- Someone Who Made an Inventive Contribution to the Invention Resulting in a Claim
- Different Than Authorship
- A patent naming the incorrect inventors can be invalidated
- A patent omitting true inventors may be unenforceable against infringers
Early Formation & Growth

Innovate Birmingham
Innovation Depot
Economic Development

UAB Innovation Pipeline

Early-Stage Commercial Support
Accelerate
Commercialize

HIIE

UAB Innovation Ecosystem
UAB Commercialization Accelerator
Steered by External Advisory Board

HIIE
Increase licensing
Increase spinout

Innovation Champion Support
Accelerator Support
Mentor Support
How to Submit an Intellectual Property Disclosure (IPD)

https://www.uab.edu/research/innovation/