

## WHAT IS INTELLECTUAL PROPERTY?

*Intellectual property* refers to certain tangible and intangible products of University research and other activities—principally copyrightable works and patentable ideas or products.

*Technology transfer* refers to the process of commercializing the products of research for economic and social benefit.

SIUC's Intellectual Property Policy governs the disclosure and disposition of intellectual property generated with University support. The Office of Research Development and Administration (ORDA) works with University faculty and staff to protect their intellectual property and to transfer new technologies to the marketplace.

*Patentable works* include, but are not limited to, inventions/products, processes, discoveries, materials, plant varieties, and sometimes computer software. *Copyrightable works* include, but are not limited to, writings of all kinds (published or unpublished), classroom materials, educational courseware, television/radio programs, films and videos, musical compositions, dramatic works, and artwork. For a fuller discussion of copyrightable and patentable works, and for the text of SIUC's Intellectual Property Policy, see the Technology Transfer web site, [www.techtransfer.siu.edu](http://www.techtransfer.siu.edu).

## PUBLIC DISCLOSURE VS. UNIVERSITY DISCLOSURE: WHY IT MATTERS

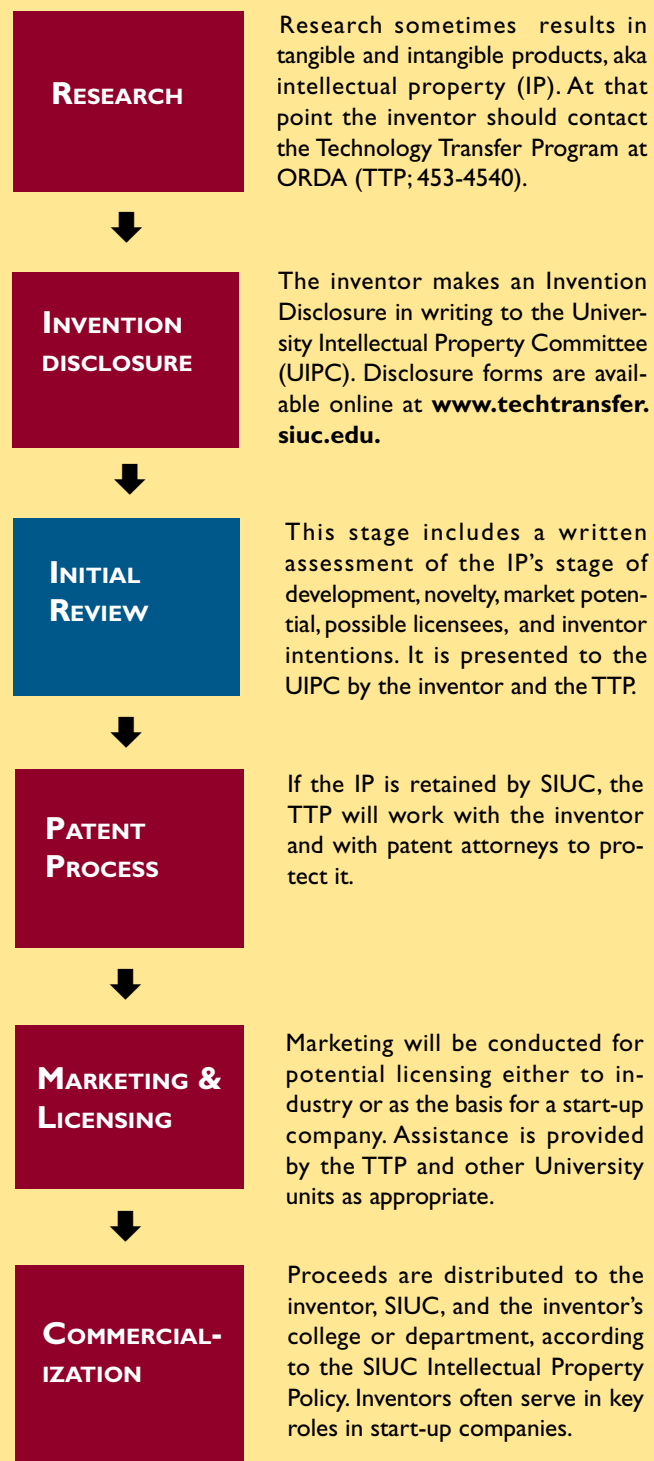
A key difference between copyrights and patents is that copyright is an automatic consequence of authorship or artistic production (see "Why Register Copyrights?"), whereas patents must be applied for—and in a timely way. To preserve U.S. patent rights, a patent application must be filed **within one year of any public disclosure** of the patentable idea. To preserve international patent rights, a patent application must be filed **before any public disclosure** has occurred.

Many things can constitute public disclosure, including some that might not seem obvious. Presenting research results at a conference, posting data online, submitting an article to a journal, even speaking with journalists—all of these usually "start the clock running" on the patent application process.

If you think that your research is leading to results that may be patentable, consult ORDA's Technology Transfer Program (TTP) early on. There are steps you should be taking to safeguard and preserve your data.

Also, **the sooner you can disclose intellectual property to the University, the sooner you can publish your research results without compromising your patent rights.** Disclosure to the University is not public disclosure.

## TECHNOLOGY TRANSFER PROCESS



## WHAT INTELLECTUAL PROPERTY MUST I DISCLOSE TO SIUC?

SIUC's Intellectual Property Policy requires that you disclose the following to the University:

- Patentable inventions, products, processes, discoveries, or plant varieties created with University support.
- Materials including DNA libraries, bacterial strains, chemicals, and other compositions of matter created with University support.
- Copyrightable works created with "significant University support" (see the definition of this phrase in section II.G. of the Intellectual Property Policy, which is linked from the Technology Transfer web site).
- Any intellectual property that may be required to be disclosed as part of the terms of a third-party agreement with the University, such as a grant or contract.

These types of intellectual property belong jointly to the University and the faculty/staff member (unless a grant agreement stipulates otherwise; see below), but the University controls their disposition.

Disclosures are made in writing to the University Intellectual Property Committee (UIPC) through ORDA. For disclosure forms, see [www.techtransfer.siu.edu](http://www.techtransfer.siu.edu).

## GRANTS AND INTELLECTUAL PROPERTY

The terms of most sponsored project award agreements set forth the ownership of any intellectual property arising from the grant/contract project and the subsequent obligations of the University and the funding agency. If the agreement doesn't address this issue, any intellectual property arising from the grant or contract is subject to University policy.

## HOW DO I MAKE AN INTELLECTUAL PROPERTY DISCLOSURE?

Disclosures are made in writing to the University Intellectual Property Committee through Jeff Myers, ORDA's senior technology transfer specialist. Disclosure forms are available online, and should be filled out, signed and dated by the inventor(s), and forwarded to the Technology Transfer Program at ORDA. Contact Jeff Myers at ORDA, (618) 453-4540, [jmyers@siu.edu](mailto:jmyers@siu.edu), or refer to the University's Intellectual Property Policy for more information.

## WHAT HAPPENS AFTER DISCLOSURE?

Upon receipt, your invention disclosure is assigned a technology ID number and flagged for the next step of the process: the initial review. Together with the inventor, the assigned technology transfer specialist prepares an initial review which includes concise information about the invention's stage of development, novelty, market potential, possible licensees, and inventor intentions. The initial review and invention disclosure are forwarded to the UIPC.

The inventor presents the invention to the UIPC with respect to the discovery/invention's merit and potential importance, commercial possibilities, and so forth. The UIPC may recommend (1) to send the invention back to the lab for more research/data, (2) to release the invention to the inventor, (3) to license it to a research sponsor for development, or (4) to pursue a patent. This process should take no longer than four months from the submission of the disclosure to the TTP, depending on TTP and inventor workload.

The committee's recommendation as to the disposition of the intellectual property is reviewed by the Vice Chancellor for Research, who makes the final decision in the matter.

## WHAT IS THE PATENT PROCESS LIKE?

Filing for a patent can be a time-consuming and expensive proposition. Research must establish the patentability and potential marketability of the invention, and a detailed patent application must be filed. The inventor and the TTP work closely with a patent law firm to file all the necessary documents in a timely manner and to optimize the patent position. This process can take as long as five years or more.

## WHAT DOES LICENSING ENTAIL?

Taking into consideration the assessment and IP development, marketing will be undertaken to result in licensing either to (1) industry or (2) a start-up company.

Assistance at this stage is provided by the TTP and other University programs as appropriate. This process can take from months to years, depending on the invention and the stage of development of the technology and market. The TTP will assist you with finding prospective licensees for your new technology and negotiating licensing agreements with industry.

## WHY REGISTER COPYRIGHTS?

Most of ORDA's endeavors in the area of intellectual property concern patents, since the University stakes a claim to few copyrightable works and since copyright protection accrues automatically to those works. But protecting your own copyrightable work can be important to your professional reputation.

Although a work need not be registered with the U.S. Copyright Office or even carry the copyright mark to be considered copyrighted, registering your works with the Copyright Office puts you in a much stronger position to defend against copyright infringement.

For more information, see [www.techtransfer.siu.edu](http://www.techtransfer.siu.edu).

## TECH TRANSFER SERVICES

To recap, ORDA's Technology Transfer Program can assist you in many ways. Our services include:

- negotiating materials transfer agreements.
- working with industry on applied research collaborations.
- negotiating grant/contract agreements that protect your intellectual property rights.
- assessing the impact of publication or other public disclosures on your intellectual property rights.
- evaluating the patentability and marketability of your new technology.
- acting as liaison between you and the University Intellectual Property Committee after you've filed a disclosure.
- working with attorneys to file patent applications.
- finding prospective licensees for your new technology.
- negotiating licensing agreements with industry.
- assisting with spin-off business start-ups.

## For more information:

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# Intellectual Property & TECHNOLOGY Transfer



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