Introduction to the Office of Technology Transfer (OTT) and the WVU Intellectual Property Process

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OTT Team

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OTT Mission

- Encourage Invention and Innovation at WVU
- Generate Income for Research, Education, and Inventors
- Contribute to Economic Development and Local, State, Regional, and National Business Competitiveness
PLANNING YOUR RESEARCH

- Agreements are required when proprietary information or tangible research materials are exchanged with an external party
  - Non-Disclosure Agreements (NDAs)
  - Material Transfer Agreements (MTAs)
  - Inter-Institutional Agreements (IIAs)

- Must be executed by
Motivation to Disclose Intellectual Property (IP)

- University requires it¹
- U.S. Government requires it for sponsored work²
- You receive a major share of the revenue generated from the IP **without personal risk**
- Academic Studies³ have shown
  - Sustains high scholarship level
  - Greater student success
  - Increases research funding opportunities

¹: BOG Governance Rule 1.5 – Intellectual Property Rule for Patent, Copyright, and Trademark Rights
³: Technol Innov. 2014 Nov 1; 16(1): 75-84
**Example Scenario**

- Dr. Jones receives $1M federal grant to design a technology to cool megawatt-scale power generators with no net water consumption\(^1\)
- Dr. Jones invents a new cooling system technology and discloses it to OTT
- WVU files a patent application that eventually results into an issued patent.
- GE buys the patent rights from WVU for $100K to incorporate the patented technology into their existing power plant product lineup.

**Revenue Breakdown**
- Sale Income: $100,000
- Patent-Related Expenses: $20,000
- Net Revenue: $80,000
  - $32,000 (Inventor)
  - $32,000 (University)
  - $8,000 (College or School)
  - $8,000 (Department)

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1: 2020 DOE ARPA-e Advanced Research in Dry Cooling (ARID) Program
INTELLECTUAL PROPERTY OWNERSHIP: INVENTION

YOU CONTRIBUTED TO AN INVENTION

WITHIN THE SCOPE OF UNIVERSITY EMPLOYMENT?

NO

USING MORE THAN AN INCIDENTAL AMOUNT OF UNIVERSITY RESOURCES?

NO

WITHIN THE SCOPE OF SPONSORED RESEARCH?

NO

YOU OWN THE INVENTION

YES

YES

THE UNIVERSITY OWNS THE INVENTION

SUBMIT AN INVENTION DISCLOSURE

Note: See BOG Governance Rule 1.5 – Intellectual Property Rule for Patent, Copyright, and Trademark Rights for Official Interpretation
**Intellectual Property Ownership: Copyright**

**YOU CONTRIBUTED TO AN ORIGINAL, CREATIVE (NON-PATENTABLE) WORK**

**DID YOU GRANT A THIRD PARTY AN INTEREST IN THE WORK?**

- **YES**
  - **A THIRD PARTY MAY OWN THE WORK**
  - THE UNIVERSITY MAY PURSUE RIGHTS FROM THE THIRD PARTY TO USE THE WORK

- **NO**
  - **IS IT AN INSTITUTIONAL WORK?**
    - **YES**
      - THE UNIVERSITY OWNS THE WORK
    - **NO**
      - **IS IT COMPUTER SOFTWARE?**
        - **YES**
          - THE UNIVERSITY RETAINS THE RIGHT TO USE THE WORK
        - **NO**
          - YOU OWN THE WORK

**Note:** See BOG Governance Rule 1.5 – Intellectual Property Rule for Patent, Copyright, and Trademark Rights for Official Interpretation
**What is Intellectual Property?**

- Property created by intellect, not naturally occurring
- Although intangible, IP is property in the sense that it can be owned, sold, licensed (rented), willed, etc.
- Types of Intellectual Property
  - Copyrights
  - Patents
  - Trademarks
  - Trade Secrets
COPYRIGHTS

• The idea is not protected, but a **tangible expression of the idea** is
• Exists immediately whenever an expression is **fixed in a tangible medium**; **Common Law Copyright**
• **Rights excludes others** from copying, distributing, displaying publicly, or making a derivative from original work
• **Copyright Registration is not necessary** to create right, but recommended for enforcement in court
• Copyright Period: Author +70 years, as Work for Hire 95 years from publication or 120 years from creation, whichever comes first

Example: © 2018 John Doe. All Rights Reserved
Temporary monopoly extended to patent owner by the government

Monopoly is granted in exchange for full disclosure of new technologies – incentivizes innovation disclosure

Right to exclude others from making, using, selling, or importing that which is patented

- Does not give the owner the right to practice making, using, selling or importing that which is patented
- Your patented technology may still infringe other patents

Owner maintains control of technology
Deters others from entering marketplace
May sue infringers for damages
May stop infringers from making, using, selling
Earn licensing fees and royalty income
**Patentable Technology**

- To invent, there must be **conception** of an idea and a **reduction to practice**
- The inventor’s **best mode** to make and use the invention should be disclosed
- Must haves for patentability
  - **Meet a Statutory (Legal) Class** (composition, article, machine, process)
  - **Usefulness** (have any utility)
  - **Novelty** (at least 1 element new to world)
  - **Non-obviousness** to one of ordinary skill in the art
**Types of and Timelines for Utility Patents**

**Provisional Patent Application**
- Inexpensive way to *establish filing date* and patent pending status
- “place holder” application to establish official priority date held for 1 year in USPTO
- Never examined nor issued into a patent

**Non-Provisional Patent Application**
- Standard patent application that may issue into a patent in time
- Time to issuance varies from 1.5 to 5 years
- Patent term length is **20 years** from date of non-provisional application filing

**Legal Timeline**
- **NOT PATENTABLE:** > 1 YEAR Since Public Disclosure or Offered for Sale
- **LESS IDEAL:** < 1 YEAR Since Public Disclosure
- **IDEAL:** Prior to Public Disclosure or Public Use
INVENTION DISCLOSURE FORM

• Used for **all technology reporting**
• **Downloadable** from WVU OTT Website
• Should take **less than 1-hour to complete**
• Key Elements
  • Contributor(s)
  • Public Disclosure History
  • Detailed Description
OTT RESOURCE SUMMARY

Agreement Assistance
• Need to request a Non-Disclosure Agreement (NDA) with an external party?
  - [https://techtransfer.research.wvu.edu/nda-request](https://techtransfer.research.wvu.edu/nda-request)
• Need to request any type of agreement other than NDA with an external party?
  - Email Request Specifics to TechnologyTransfer@mail.wvu.edu

Intellectual Property/Commercialization Assistance
  - Engineering Sciences: Chris.Menchini@mail.wvu.edu / MRB 345A
  - Health Sciences: Hamid.Bhatti@mail.wvu.edu / CRRB 726
  - IP disclosure forms downloadable at [https://techtransfer.research.wvu.edu/forms](https://techtransfer.research.wvu.edu/forms)

More Information: [https://techtransfer.research.wvu.edu](https://techtransfer.research.wvu.edu)
General Inquiries: TechnologyTransfer@mail.wvu.edu | 304-293-7539
WVU IP Policy (Finalized BOG Rule 1.5): [https://policies.wvu.edu/finalized-bog-rules](https://policies.wvu.edu/finalized-bog-rules)
OTT Fall 2020 Lunch and Learn Series

• **Introduction to the Office of Technology Transfer and the Intellectual Property Process**
  - Presented by: Jim Dottavio, Chris Menchini & Hamid Bhatti
  - Tuesday, September 1st – 12:00 – 1:00pm

• **Connecting with WVCTSI: Services and Resources to Support your Biomedical Research**
  - Presented by: Meghan Reeves, Emily Morgan & Wes Kimble
  - Tuesday, September 15th – 12:00 – 1:00pm

• **Introduction to the Encova Center for Innovation and Entrepreneurship**
  - Presented by: Tara St. Clair & Anna Carrier
  - Tuesday, September 29th – 12:00 – 1:00pm

• **Vantage Ventures in the Innovation Ecosystem**
  - Presented by: The Vantage Ventures Team
  - Tuesday, October 13th – 12:00 – 1:00pm

• **Introduction to the NSF I-Corps Short Course Program**
  - Presented by: Erienne Olesh
  - Tuesday, October 27th – 12:00 – 1:00pm

• **Introduction to the Statler College Innovation Hub**
  - Presented by: Gene Cilento, Josh Bintrim, Kelsey Crawford & Kolin Brown
  - Tuesday, November 10th – 12:00 – 1:00pm

• **ABC's of OSP: Proposal Submission, Award Negotiation, and Award Initiation Basics**
  - Presented by: Katie Stores, Molly Superfesky, Tiffany Lutskus, Rachel Humberson, Andrea Taylor & Keeleigh Utt
  - Tuesday, December 1st – 12:00 – 1:00pm
In an effort to build out a resource center to help prepare and submit competitive SBIR/STTR’s from our researchers, clinicians and small business partners across the state, we, in partnership with Vantage Ventures, are hosting agency-specific webinars. These webinars are presented by agency representatives on best practices when applying for these grants. Please see below for dates and mark your calendars. Additional details to follow.

- **NASA, SBIR / STTR Program**  
  Thursday, September 17th, 12:00-1:00pm

- **Department of the Navy, SBIR / STTR Programs**  
  Thursday, October 1st, 12:00-1:00pm

- **United States Department of Energy (DOE), Office of SBIR / STTR Programs**  
  Thursday, October 15th, 12:00-1:00pm

- **America’s Seed Fund, powered by the National Science Foundation (NSF)**  
  Thursday, November 5th, 12:00-1:00pm