# Publishing Research and Protecting Intellectual Property

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# *Isn't that an oxymoron?*

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# Agenda

- **Publish or protect**
  - Can one do both?
  - When and why should one do both?
- **Intellectual Property (IP) Ownership**
- **IP Protection**
- **Lab Notebooks**
- **Literature and Patent Searching at RIT**

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# Oxymoron

- a combination of contradictory or incongruous words (as *cruel kindness*); *broadly* **:** something (as a concept) that is made up of contradictory or incongruous elements

…… Merriam-Webster Dictionary

- **Does publishing or presenting at a conference mean I can't protect and commercialize my work?**
- **Does bringing something to the marketplace mean I can't publish or present my work at a conference?**

# No and No

- You *can* publish, present, protect and commercialize
- It's a matter of timing

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# How can you publish, present, protect and commercialize?

- **As inventor/author you need to be cognizant of:**
  - Patenting statutory bars
  - The CREATE Act
  - Appropriate use of Non-Disclosure Agreements
  - When to mark grant proposals as proprietary

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# Patenting Statutory Bars

- **Enabling disclosure bar - US**
  - A patent application must be filed in the US within one year of the first enabling disclosure.
- **On Sale bar - US**
  - A patent application must be filed in the US within one year of the first commercialization (including offer for sale) of the invention.
- **Foreign patenting**
  - A patent application must be filed in most other countries *before* the first enabling disclosure or first offer for sale of the invention.

# Enabling Disclosure

- **A disclosure in sufficient detail that one skilled in the art could then reproduce your invention.**
- **Understanding the date of publication:**
  - Does a journal web publish *before* the print publication is released?
  - Poster presentations
  - Cataloging and shelving of a thesis
  - Award of a grant

# The CREATE Act

- **Federal Act enacted in December 2004**
- **Requires that *all* research collaborations be set forth in a written agreement *before* collaborative work starts or else discussions *between* collaborators are considered public disclosures and ability to patent is compromised or lost.**

**What this means:**

- **Don't collaborate on a hand shake or a verbal**

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# Non-Disclosure Agreements

- Sharing of information under a Non-Disclosure Agreement does not count as an enabling disclosure for patenting purposes.
- Recommend using NDAs if intention is to seek patent protection and commercialize the technology/work.

# Keeping Proprietary Information Proprietary

- **A Non-Disclosure Agreement (NDA) should be put in place *before* information is exchanged.**
  - Who can sign a NDA?
- **A NDA between RIT and a company *does not* cover RIT students unless they are being paid by RIT to work on the project in question.**
- **A NDA should *only* be used to evaluate information for a specific purpose (e.g. to enter into a collaborative research agreement). New work should *not* be done under a NDA.**

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# Marking Information as Proprietary

- **Grant proposals become public information when a grant is awarded. The proposals could become public pre-award through a FOIA request.**
- **Thus to keep information proprietary it is necessary to mark appropriate sections of a grant proposal as proprietary.**
  - SRS can assist you in understanding the marking provisions for each funding agency.

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# INTELLECTUAL PROPERTY – Ownership

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# How to Determine Who Owns the IP?

- **RIT owns IP you generate in the course of your employment with a few exceptions. See Policy C3.0 and C3.1 for details.**
- **Questions to ask:**
  - Was the work done as part of your employment?
  - If the work was done as a RIT employee:
    - Was the work in your annual Plan of Work?
    - Was the work a commissioned work?
    - Did you use RIT facilities and resources?
    - Did RIT or other sponsors fund the work?

# Students and IP Ownership

- **RIT does not own student IP unless:**
  - The student was paid by RIT to perform the work that led to the IP
    - As part of RIT employment
    - Through grant or contract funding secured through RIT
  - The student and RIT entered into an agreement otherwise before the work started
    - Done in certain cases where there is a corporate sponsor for student projects
- **RIT cannot use student IP without first obtaining permission from the student**
- **RIT cannot give away student IP (ownership or rights to use) without first obtaining permission from the student**

# DETERMINING INVENTORSHIP

- **Inventorship defined by US Patent Act**
  - Handled differently than authorship of a publication
  - Each inventor must have contributed to the creativity of at least one claim in the patent application
- **What happens if a student and a RIT employee are joint inventors?**

# The Inventor's/Author's Role

- To promptly and completely disclose creations to RIT
- To be a team member in assessing the commercial potential of the creation and then in the marketing and actual commercialization
- To share in resulting licensing fees and royalties
  - 50% after deducting allowable expenses

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# INTELLECTUAL PROPERTY – An Overview

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# Forms of Intellectual Property

- **Trade Secrets**
- **Patents**
  - United States
    - Provisional
    - Full application
  - International
- **Copyrights**
- **Trademarks**
  - Trademark
  - Service Marks
  - Trade Name

# Trade Secrets

- **Definition**
  - Confidential, unpatented information that is protected by keeping the information secret
- **Factors in determining if it is a trade secret**
  - Extent information is known in industry
  - Extent measures taken to safeguard secrecy
  - Value of information to owner and competitors
  - Ease/difficulty in independent development

# Trade Secrets

- **Advantages**
  - Easy to control
  - Easy and inexpensive (relatively) to protect
  - Indefinite term (determined by degree of protection)
  - No patentability requirements to qualify
- **Disadvantages**
  - Limited ability to exploit information
    - Reverse engineering
  - No protection against independent development
  - No statute law protecting trade secrets
- **Remedy**
  - Injunction or damages
  - Onus is on owner to establish case

# Patents

- **What is patentable?**
  - Any new and useful art, process, machine, manufacture or composition of matter or any new and useful improvement
  - Includes software and mask works
- **Key elements:**
  - Novelty
  - Utility
  - Non-obviousness

# U.S. Patents

- First to invent vs. first to file in rest of world
- Term is 20 years from date of application
- One year grace period for prior disclosure
- Application published 18 months after filing

# Software Patents

- **Software-based inventions**
- **Patentability criteria evolving and include:**
  - Produces new/useful data interpretation
  - Controls device performing new/useful function
  - Solves computer-related problem
  - Improves existing computerized process

# What Can One Copyright?

- **Protects manner of expression; not the idea, process or concept**
- **Precludes actual copying**
- **Exists automatically on creation of work**
  - Legal registration enhances protection
- **Term**
  - author's life + 70 years;
  - lesser of 95 years from first publication or 120 years from creation for works for hire
- **Creations and works of art**

| | | |
|---|---|---|
| drawings/prints | musical works | text |
| architectural plans | motion pictures | software |
| multimedia works | internet-distributed content | |

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# Copyright

- Owned by RIT as “work for hire” of RIT employee
- RIT policy gives ownership to authors for scholarly articles
- CREATE by authorship
- DESTROY only by express dedication to public

# Trademarks

- **Definition**
  - Identifying mark, word, logo or symbol used by someone in commerce to identify or distinguish their goods and services from all others
  - Sometimes confused with “tradename” which is the company name under which business is conducted.

# LAB NOTEBOOKS

# Importance of Lab Notebooks

- Establishes a permanent record of what was done, by whom and when.
- Important for establishing inventorship.
- Important in the US for establishing who was first to invent.

# Maintaining a Good Lab Notebook

- **Use a bound book**
- **Make all entries in permanent ink**
- **Do not skip pages**
- **Date all entries**
- **Provide complete information**
- **Attach any photos, drawings or loose pieces of page in a permanent manner and indicate date attached.**
- **Don't erase.  Cross out information that requires correction.**
- **Have a knowledgeable, objective person witness, sign and date entries on a regular basis**
  - Don't use a team member

***Good reference:***
***http://otl.stanford.edu/inventors/resources/labnotebooks.html***

# LITERATURE AND PATENT SEARCHING

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# Literature Review Resources in the RIT Library

- **Online Resources** to search across multiple types of literature and subject areas
- **Subject Specialists** to help narrow down which resources to target and keep you up to date on search strategies and techniques as products change over time
- **ConnectNY provides** 2 day delivery from 13 college libraries in New York State
- **Inter-Library Loan** allows you to order materials not available in our collection
- **Access Borrowing Card** allows you to borrow materials from other local libraries

# Online Electronic Resources at RIT Library

- Academic and trade literature across all RIT subject areas
- Full-text, abstract, and index sources
- Remotely accessible electronic resources
- ISI Web of Knowledge/Journal Citation Reports
- Endnote Web for organizing research
- Subject Specialists can direct you to the appropriate online resources for your topic

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# Subject Specialists at the RIT Library

- Subject specialists can help researchers refresh a literature search as online products change over time
- Working with a subject specialist can help a researcher update his/her individual search strategy and target the most up to date resources for a research topic

# Subject Specialists at the RIT Library

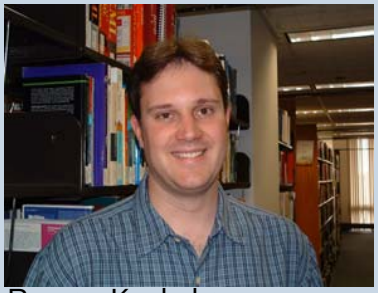
Adwoa Boateng
Science, Patents


Linda Coppola
Liberal Arts

Jennifer Freer
Business
Hospitality Service Management

Kari Horowicz
Arts, Photography,
Film, Animation

Linette Koren
Engineering, Patents



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Susan Mee
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Deafness, Disabilities,
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# Subject Specialists with Patent Searching Experience

- Adwoa Boateng
- Linette Koren
- Roman Koshykar

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# ConnectNY Service


- Provides 2 day delivery of books from 13 other colleges in New York State including Adelphi, Bard, Canisius, Cazenovia, Colgate, LeMoyne, Pace, RPI, St. Lawrence, Siena, Union, United States Military Academy and Vassar
- Connect NY libraries can be searched from within the RIT Library catalog or directly at http://www.connectny.info

# Information Delivery Services

- **Campus Delivery Service**
  Faculty can request items from our collection, ConnectNY, or those ordered via Inter-Library Loan to be delivered to their office.
  Place orders for Campus Delivery at http://library.rit.edu/myaccount/delivery.html
- **Inter-Library Loan**
  Materials not available in our immediate collection can be ordered via ILL at http://ill.rit.edu/

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# Access Borrowing Cards from RIT Library

- Access Borrowing Cards can be issued to RIT faculty needing extensive use of another cooperating library after RIT Library's resources have been fully utilized and exhausted.
- Participating libraries include:

Eastman Kodak Company
Finger Lakes Community College
George Eastman House
Hobart & William Smith Colleges
ITT Industries
Medaille College
Monroe Community College
Nazareth College
Roberts Wesleyan College
Rochester City School District
Rochester Institute of Technology
Rochester Museum & Science Center
St. John Fisher College
Strong Museum
SUNY Brockport
SUNY Geneseo
SUNY Resource Center
University of Rochester/Rush Rhees Library
Xerox Corporation

**To obtain a card or apply online at http://library.rit.edu/services/access/index.html**

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# Resources

- **US Patent and Trademark Office**
  - www.uspto.gov
- **US Copyright Office**
  - www.loc.gov/copyright/
- **Good IP Site**
  - www.ipmall.fplc.edu
- **Technology Licensing Office**

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**“To share an asset, usually it must first be divided. But knowledge is one of the few assets that multiplies as it is shared.”**

***. . . . . Indian proverb***

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