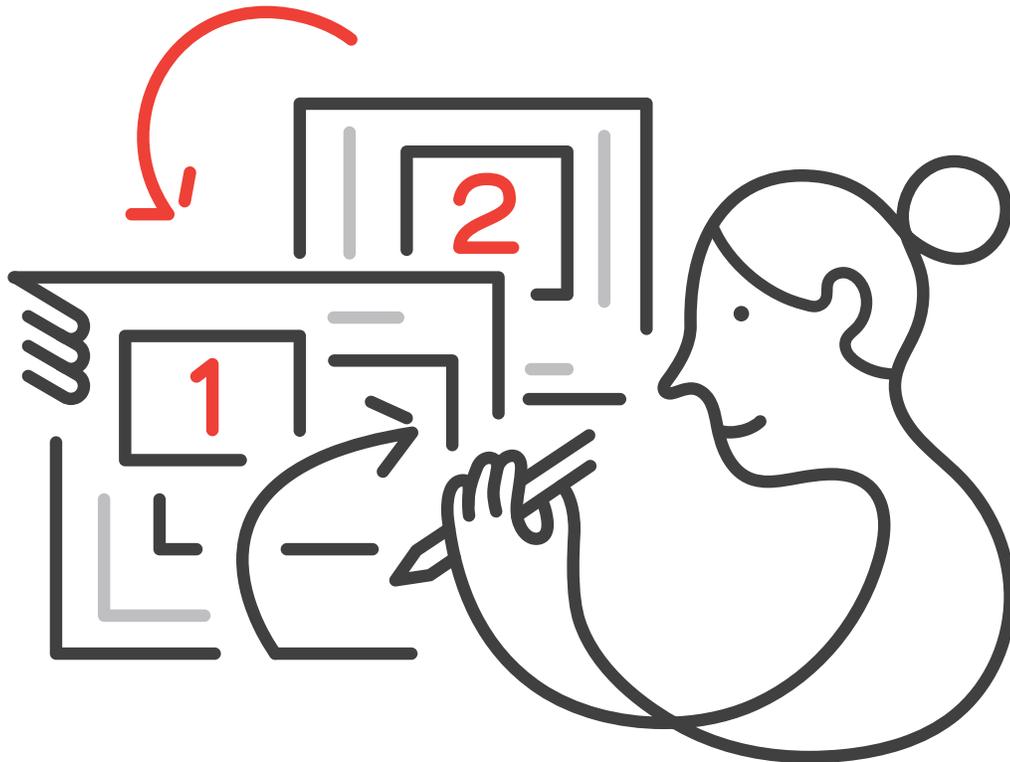


Invention & Commercialization

Protecting Intellectual Property



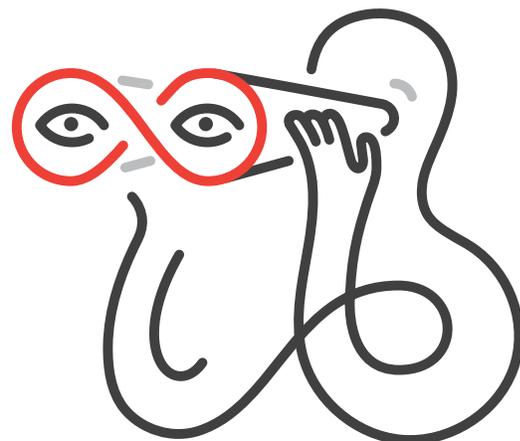
Introduction

Anyone who has innovated before can likely relate to the feeling of staring into the great unknown. Imagine embarking on a trek through the wilderness without a map, trail, or guide. You might have an idea of the direction to go, maybe a few tools in your backpack and a hazy vision of your final destination, but it's probably safe to say that your chances of getting lost are fairly high.

As you can imagine, without a proper appraisal or an informed initial approach, the odds of an idea's survival--let alone its ability to thrive in the marketplace once it gets there -- are usually not in its favor. Fortunately for UH employees, UH Ventures offers inventors an assessment and, if applicable, an accompanying commercial strategy for any invention disclosed to our office. While all ideas are different in size, scope, and subject matter, UH Ventures uses a process and a set of universal questions that must be understood by all parties before embarking on the commercialization journey.

As such, the Innovation & Commercialization booklets are designed to give our inventors a general sense of the traditional tests that nearly every idea will need to pass in this phase (i.e. assessments of intellectual property, market competition, and paths to market). Our hope is that these booklets can not only help to educate, but that they can also help inventors to form and strengthen their ideas as soon as they are conceived.

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Intellectual Property Protection

To continue the analogy of the wilderness trek, intellectual property protection is akin to purchasing a reliable tent. It can feel like a big investment, and there are all kinds of fun, luxurious features to consider, but the decision often always comes down to a less-than-glamorous measure of durability.

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8 Things to Know About IP

1. Always disclose to UH Ventures first
2. Patent filing is a process
3. Know what you're getting
4. Need to sleep on it? Consider a provisional application
5. There are two types of patents: Utility and Design
6. To get issued patent claims, be ready to answer three questions
7. There are other forms of IP protection
8. IP protectability does not equal commercial viability

1. Always disclose to UH Ventures first.

Any kind of disclosure via publication, presentation, or even a conversation with a third party prior to filing a patent could seriously hinder the ability to ever secure a patent, and therefore the ability to pursue commercialization. When in doubt, talk to UH Ventures!

2. Patent filing is a process.

The typical timeline for securing a patent takes nearly 3 years from first filing to final issue. Total patent prosecution costs can range from \$15,000-\$35,000. Once we file, there will be numerous interactions between attorneys, UH Ventures, the United States Patent and Trademark Office (USPTO) – and international patent offices when appropriate – and most importantly, the inventors. So hang in there.



Invention & Commercialization: Protecting Intellectual Property

3. Know what you're getting.

A patent filing is essentially the following contract: "I agree to share the details of my invention with the world, in order to potentially gain the right to use legal means to keep others from selling it without my consent for the next 20 years." In other words, at its core, an issued patent is a piece of paper that gives us the right to enforce the protection of our property. It's up to the inventor and UH Ventures to give that paper some value.

4. Need to sleep on it? Consider a provisional application.

Patent filing is a big decision. Once we go down that road, there is a lot of work to be done and money to be invested until a patent is issued. But at the same time, we also don't want to wait to file, especially if we intend to start conversing with academic peers or industry contacts. In these cases, UH Ventures can work with you to file a high-level, non-confidential application in order to buy exactly one year from the filing date to decide if you wish to file patent claims. This can also help to establish an invention's "priority date" which is important in the USPTO's system for determining which inventor was the "first to file."

5. There are two types of patents.

Utility Patents: This is the most common type of patent granted by the USPTO. These describe an apparatus or method that can be used to accomplish a task or generate a specific result.

Design Patents: This type of patent covers a unique shape or design of a non-naturally occurring object, rather than the utility. While design patents can sometimes be easier to obtain, they are often difficult to enforce.

6. To get issued patent claims, be ready to answer these three questions.

Is it Useful? If it's a Utility Patent, we'll have to prove that, in theory, the invention helps to achieve a desired result.

Is it Novel? It must be a new idea, not yet expressed in the form of a product, publication, presentation, or formerly filed patent claims.

Is it Non-Obvious? We'll have to prove that the invention wouldn't be obvious to someone of ordinary skill in the field.

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7. There are other forms of IP protection.

Trademarks: These are words, phrases, or symbols that can be consistently representative of a product or method. There is no application process to begin using a trademark. “Trademarking” is as easy as simply adding the “TM” symbol after each word, phrase, or symbol that you’ve created. This mark will at least give you standing if you reasonably suspect another entity copied your name, phrase, or logo. In order to legally enforce this protection to all parties in your industry, regardless of intent, we may want to consider getting a registered trademark (®) through the USPTO.

Copyrights: Similar to a trademark, copyrights grant the right to prevent others from using original works of written and graphical materials. Any creator can begin marking their works with a “©”, which can at least prevent others from copying without retribution. Registering a copyright with the USPTO expands the creator’s rights to preventing anyone, however inadvertently, to use or distribute original content. In addition to written copy, or audio/visual works, copyrights can be important for protecting software code.

Trade Secrets: As discussed above, the cost of filing a patent (besides the attorney fees) is your agreement to share the details of your invention with the world. There may be instances where patents don't make the most sense, even for a medical device. For example, if you came up with a novel and beneficial manufacturing process for an albeit commonplace device, it might be better to keep that proprietary and call it a "trade secret." The mechanisms for protecting that trade secret will be up to the inventor or entity.

8. IP protectability ≠ Commercial viability.

As you can see above, there are a fair number of avenues to walk down when it comes to protecting IP. But it's important to remember that just because we *can* protect it, doesn't always mean we will. While it can be very difficult in the healthcare industry to commercialize drugs and devices without a patent, there is a bit of an open playing field when it comes to information technology, processes, content, and other forms of know-how. So while a patent can often help, UH Ventures considers commercial viability with or without protectable IP.

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Conclusion

The UH Ventures Approach: During an IP assessment, UH Ventures will take a preliminary look at the patent landscape by using public resources like USPTO.gov and Google Patents, or just by perusing the internet for products already on the market. If there appears to be space, and it's deemed to have potential value after considering the market and its potential path to the market, UH Ventures will consult with attorneys to initiate the patent filing process.

Please never hesitate to reach out. We look forward to collaborating with you.

Reach out to UH Ventures today!

Visit our website at: ventures.UHhospitals.org



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Health Voyagers Podcast Series

