

- Our requirements come from:
- UT System Policy UTS 125
 - UT System Regents' Rules 90101
 - US Bayh-Dole Act
 - US and international patent law

Inventions & Patents—The Details

Contact us for training or to disclose an invention
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<https://www.utrgv.edu/got-ip>

Invention Info

- The Board of Regents owns all faculty inventions and software. This applies to any invention within scope of employment, on university time, using state funds, or using university resources.
- Invention must be disclosed to ORT **prior** to **any** publication or disclosure.
- Royalties are shared (after recovering patent costs) 30-50% to creator(s) and 50-70% to institution.
- Students (including graduate students) own their own inventions unless they are: paid; work-for-hire; encumbered by a grant or an agreement; or if the invention was jointly created with faculty. Senior design courses can be an issue, and ORT can help.
- Software copyrights are treated like patentable inventions, but the Board of Regents won't assert copyright claims on educational materials, artwork, music, or professional/academic literary works.
- If an invention is released to the inventors, it may **not** be further developed in university facilities.
- Joint research with other institutions must have a research collaboration agreement in place before an invention happens, and an inter-institutional agreement once an invention is disclosed.

Patent Info

- Foreign patents require absolute novelty, no prior public disclosures are allowed.
- US patents may be submitted after a public disclosure, but only within a 1-year grace period.
- Invention must be novel, useful, and non-obvious.
- Invention is the conception, not the reduction to practice. No prototype is needed for a patent. Thus, validation, prototyping, and testing don't count as inventing. Similarly, suggesting a line of research is not inventing. However, a tester could contribute an original idea that qualifies as part of an invention, so you must have agreements in place **before** hiring or collaborating with other parties.
- Patent application must include enough information for "a person of ordinary skill in the art to be able to reproduce the invention without undue experimentation."
- When disclosing an invention to UTRGV, supporting documentation can include publication manuscripts, schematics showing critical components and their connections, descriptions of system operation, descriptions of process parameters and their ranges, molecule descriptions, etc.
- Inventorship is **not** authorship. The list of authors on a publication may include many people, but the list of inventors on a patent must correspond exactly to those that contributed the patent claims.
- Inventorship may change as the invention evolves or improves. Inventors may be added or deleted from a patent application as the claims change or if prior art is found.
- Prior art can be any description in any media from any time including fiction, inventors' own prior publications, or foreign publications.

Patent Process

- In general, the invention idea is described in detail as a list of claims, plus supporting data and examples. The claims are the heart of the patent.
- Often, a provisional patent will be filed initially instead of a full patent.
- The USPTO will accept the application establishing the “priority date”. Any similar inventions that appear after that date cannot be considered prior art.
- If the filing was provisional, the USPTO will wait 12 months allowing the inventor to research further and refine the invention before proceeding. Within 12 months, it must be converted to a normal utility patent application.
- USPTO will issue “office actions” as it discovers prior art or rejects claims. The inventor (UTRGV in our case) has an opportunity to respond to each office action. This process can take several months to a few years.
- If the patent is issued, the inventor (UTRGV in our case) can license the patent to a company or build a new company around the technology.

Tech Transfer Process at UTRGV

- 1) First, the inventors must prepare an invention disclosure form and submit it to ORT.
- 2) ORT will review the invention to search for prior art in patent databases, scholarly articles, general media, and more. ORT will ask for clarification from the inventors to understand how their invention differs from the prior art. ORT will also conduct market studies to estimate the commercial suitability of the invention.
- 3) If the invention still looks novel after that search, ORT submits it to one of the patent law firms allowed by the State Attorney General, to draft a provisional patent and submit it to USPTO. If it appears the patent may not pass novelty tests, or if it is demonstrably not economically feasible, the invention may be released back to the inventors to pursue independently from the university.
- 4) If the patent issues, ORT will find potential licensees using UT System resources, trade groups, contacts at other universities, and suggestions by the faculty inventors.
- 5) A license gets negotiated, approved by the VP for Research, and executed.
- 6) Royalties are collected by UTRGV. The university recovers patent and licensing costs first, then begins to distribute the shared royalties to inventors.
- 7) Royalty audits, milestones, patent maintenance fees, sublicense negotiations, and other maintenance work are handled by ORT for the life of the patent.

Federal Law

ORT helps ensure compliance with the 1980 Bayh–Dole Act that affects inventions from federally funded research. To keep ownership of an invention, UTRGV must:

- Require employees to agree in writing to protect the government's interest in subject inventions.
- Report subject inventions to the sponsoring agency.
- File its initial patent application within one year after our election to retain title.
- Notify the government if we will not continue prosecution of an application, or let a patent lapse.
- Include a specific patent rights clause in any subcontracts.
- Conduct a program of education for employees regarding the importance of timely disclosure.
- Grant to the government a nonexclusive, nontransferable, irrevocable, paid-up license.
- Report on the utilization of subject inventions.
- Share royalties with the inventor.
- Use the balance of royalties after expenses for scientific research or education.
- Agree to allow the government to “march in” and require licenses to be granted, or to grant licenses, in certain circumstances.