UHS Intellectual Property Policies and Procedures

Office of Intellectual Property Management

Email: oipm@central.uh.edu
Importance of IP

• Exclusive rights - exclude others from making, using or selling the invention (in that country) during the life of the patent. Reduces competition.

• Licensing -provides income for both the inventor and institution.

• Commercialization- a patent may be necessary, without it, industry may not invest to develop, market, and commercialize the invention.

• Funding - may include patent related requirements. Failure to meet these requirements can hinder receipt of future funding.

• Brings recognition to researcher/institution, resulting in the formation of relationships that bring in more research dollars to the lab/institution.

TYPES OF INTELLECTUAL PROPERTY

• Copyright
• Trademark
• Patent

COPYRIGHT PROTECTION

• Copyright protects “original works of authorship” that are fixed in “a tangible form of expression”
• Copyright protects the expression but not the ideas or facts expressed
• Rights begin at the moment of “fixation”

COPYRIGHTABLE WORKS INCLUDE

• Literary works (lecture notes, manuals, tests, web pages)
• Musical works (songs, musical plays)
• Dramatic works (dramatic readings)
• Pantomimes and choreographic works
• Pictorial, graphic, and sculptural works (paintings, photographs, cartoon characters, maps)
• Motion pictures and other audiovisual works (slides)
• Computer programs and documentation
• Architectural works (building design, blueprints)
NEED COPYRIGHT PERMISSION TO

- Make and distribute copies of the copyrighted work
- Perform the work publicly (plays, film, or music)
- Display the work publicly (art display, or material used on the internet or television)
- Make "derivative works" (modifications, adaptations, new uses of a work, or translating work to another media)

COPYRIGHT PERMISSION EXCEPTIONS

- FAIR USE
- TEACH Act
- For preservation by libraries

FAIR USE

- Allows limited copying, use, and quoting for research, education, criticism, news reporting, and parody
- Allows copies of very short excerpts for class handouts
- Allows quoting for purposes of reporting the news or criticizing or commenting on a particular work of art, writing, speech or scholarship

TEACH Act

- Allows performance or displays of copyrighted material as part of instructional activities...as part of an accredited non-profit educational experience

Length of Copyright Protection

- Single author works – life of author plus 70 years
- Joint works- life of last surviving author plus 70 years
- Works for hire – 95 years from date of publication or 120 years from date of creation, whichever expires first
UH System Ownership of Copyrights

**UHS will assert ownership of copyrights developed by faculty, staff, or graduate students for:**

1. Films, audiovisual works, slide programs, film strips
2. Sound and/or video recordings containing original performances
3. Programmed instruction materials
4. Computer programs, software, and documentation

**UHS will assert ownership of copyrights developed by faculty, staff, or graduate students for:**

1. UH supported work
2. Extramurally supported work
3. UH commissioned work

**UHS will NOT assert ownership of copyrights developed by faculty, staff, or graduate students for:**

1. Books, journal articles, texts, study guides, lab manuals, tests
2. Lectures and unpublished lecture notes
3. Musical works
4. Dramatic works
5. Works of visual art
6. Architectural works
7. Undergraduate student copyrights that are created in the course of their education (“for credit”)

**How To Obtain Protection**

Submit completed and signed IP Disclosure Form to OIPM via e-mail at oipm@central.uh.edu

Disclosure form is found at: [http://www.uh.edu/research/tech-transfer/](http://www.uh.edu/research/tech-transfer/)

**Trademarks**

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<th>Word</th>
<th>Slogan</th>
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UH System Trademarks and Patents

- UHS owns any and all trademarks relating to the University of Houston System
- Contact Office of General Counsel regarding trademark protection

Patents

A patent is an intellectual property right granted by a country's government to an inventor “to exclude others from making, using, or selling the invention in that country or importing the invention in that country” for a limited time in exchange for public disclosure of the invention when the patent is granted.

Types of Patents

- **UTILITY:** any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement.

- **DESIGN:** a new, original, and ornamental design for an article of manufacture protects the appearance of the product.

- **PLANT:** any asexually reproduced distinct and new variety of plant.

Patentability Requirements

- Useful – the invention must have a function.

- Novelty – the invention must be new and not previously patented or disclosed (published or publicly known) anywhere in the world.

- Non-obviousness – the invention must produce unexpected or surprising results to one “skilled in the art”. Published or publicly known information must not teach or suggest how to make the invention.

Length of Patent Protection

- Utility and Plants: 20 years from the earliest filing date
- Design: 14 years from the date of issue

UH System Ownership of Patents

- UH owns any inventions by faculty or staff utilizing UH resources that is discovered while performing employment responsibilities.
- UH owns any inventions by graduate students conceived or first reduced to practice in graduate research or graduate thesis preparation credit courses.
- UH does not own inventions by under-graduate students that is created in the course of their education (“for credit”).
- Under-graduate students can assign IP to UH and then be treated in the same manner as faculty, staff and graduate students.
How To Obtain Patent Protection

• Submit completed and signed IP Disclosure Form to OIPM (oipm@central.uh.edu)
• OIPM analyzes disclosure and decides whether to file Provisional application (PPA)
• Inventor works with outside counsel to prepare PPA
• 9 months post PPA filing, inventor provides updated information to OIPM/IP Committee (IPC)
• IPC recommends whether to continue IP protection or to return invention to inventor

IP Disclosure Form

• Title/Abstract/Detailed description
• Novelty/improvement over existing technology
• Inventors/contributors (% contribution)
• Sponsorship (grant funding)
• Public disclosures (past & future)
• Technology(s) related to invention

Inventor-ship

• Inventor-ship is a legal issue and is different from authorship

• An inventor is any person(s) who conceives of or contributes to the conception of the invention, not one that merely acted under the direction and supervision of the conceiver(s)

• An inventor is the one with “intellectual domination” over the inventive process, and not merely one who assists in its reduction to practice

Consequences of Incorrect Inventor-ship

• Incorrect inventor-ship, can result in invalidation of the patent
• Invalidation of the patent results in the loss of licensee(s), commercialization, and royalties

Office of Intellectual Property Management (OIPM)

• OIPM is responsible for managing the intellectual property assets of UH by translating research into products for public benefit through licensing, collaborations, and the promotion of entrepreneurship and innovation.
OIPM Services

• Patenting and intellectual property (IP) management
• Receives invention disclosure forms
• Commercially evaluates new technologies
• Assesses patentability and commercial value
• Manages prosecution of patents
• Markets and licenses inventions
• Negotiates license agreements
• Provides startup support to UH faculty
• Engages industry to facilitate research collaboration
• Manages the Technology Gap Fund
• Receives and distributes royalties

Royalty Distribution of Licensed IP

• Inventor – 40% *Net Income
• UH - 40% Net Income
• Dept/Center – 13% Net Income
• College – 7% Net Income

*Net Income – Gross revenue less taxes and/or legal fees related to obtaining & commercializing IP

Technology Gap Fund

• Provides funds for development of technologies that have licensing and commercialization potential. The fund supports the development of prototypes or through final proof of concept (not for basic research)

• ELIGIBILITY - UH faculty and staff who have filed at least a provisional application (via OIPM) that is specifically related to the proposed project

• TIMELINE - Proposed work must be accomplished within 12 months of funding

• AWARD AMOUNT - Award range is up to $50,000

• REPORTING REQUIREMENTS - A report that describes progress towards commercialization of the project must be submitted at the end of 6 and 12-month period

DOR and WCE Partnership

• Partners faculty inventors with student teams from the WCE undergraduate class, and external business mentors
• Student teams use inventor’s IP as the basis for developing a business plan/commercialization pathway. The plans are used in national level business plan competitions.
• Ultimate goal is to create entrepreneurial teams that can lead to the formation of UH start-up companies
• Newly formed start-up companies have the option to be incubated at the UH Innovation Center located at the UH-Energy Research Park (UH-ERP)
OIPM Contact Information

e-mail: OIPM@central.uh.edu
Website (with Disclosure Form): http://www.uh.edu/research/tech-transfer/