

FAQ

AND GUIDE

TECHNOLOGY TRANSFER

PATENTS

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TRANSFER

COMMERCIALIZATION

UCLA / OIP-ISR

The Office of Intellectual Property and Industry Sponsored Research (OIP-ISR) supports UCLA's research, education, and service mission. Working with OIP-ISR is a complementary approach to traditional publishing that can facilitate the translation of UCLA discoveries into new products and services that have the potential to broadly benefit the public. Our office manages a large portfolio of technologies and license agreements, and has a rich history of start-up company formation that we continue to build upon.

We encourage you to contact OIP-ISR to discuss your research and the possibility of patenting or copyrighting your ideas. All of our contacts are on our website at

oip.ucla.edu

innovation@research.ucla.edu

What is technology transfer?

Technology transfer is the process of transitioning technologies from the research lab to the marketplace. This activity is complimentary to the process of publishing research findings.

How does technology transfer fit within the University's mission?

Part of The University of California's public service mission is to ensure that the results of its research are made available for public use and benefit. This is accomplished in many ways: through educating students, publishing results of research and ensuring that inventions are developed into useful products and services for the benefit of the public. Since The University of California is not in the business of making and selling new products and services, we look to partner with industry to commercialize these inventions.

What are the typical steps in the process?

Research—Research often leads to discoveries and inventions with commercial potential. These discoveries or inventions may comprise intellectual property that would benefit from protection through patents, copyright, and occasionally trademarks. Early contact with the Office of Intellectual Property and Industry Sponsored Research (OIP-ISR) when you believe you have an invention is important.

Invention Disclosure—Inventions are disclosed to OIP-ISR by submitting an Invention Report. This submission formally begins the technology transfer process, although you should feel free to contact us before you even start to fill out an Invention Report. The Invention Report is a confidential document and we ask that you provide a full description of your invention, including how to make and use it, and any supporting experimental data that you have generated. The Invention Report will be assigned to a licensing officer, assigned a tracking number and OIP-ISR will report the invention to sponsors of the research that led to the invention and/or any institutions that may be co-owners, as applicable. You will be notified of this information via email. The Invention Report can be found at <http://oip.ucla.edu/invention-report>

Assessment—Our office will work with you to evaluate your invention's commercial potential, including its novelty and utility, and to help identify potential applications. Faculty inventors can check the status of their invention(s) at any time by going to <http://piportal.research.ucla.edu> using their UCLA login.

Patent Protection—a provisional patent application may be filed if the invention is sufficiently developed, has commercial potential, appears to be patentable, and where a patent position on the invention will facilitate finding a partner to commercialize the technology.

Marketing—When the invention is ready to be marketed our office will develop marketing materials to help highlight the licensing opportunity to potential industry partners, which will likely include generating a non-confidential description of your invention. Your input in the development of this one-page document is very valuable as it helps refine and craft the message for industry. A list of target companies, investors, etc. for marketing the invention is compiled from many sources including our contacts database, market research and your industry contacts.

Licensing—A license agreement is a contract between The Regents of the University of California and a third party in which The Regents' rights to a technology (intellectual property and property rights) are licensed for commercial development and use. In exchange, UCLA and the inventors receive financial remuneration (generally in the form of upfront payments, milestone payments and royalties on the sale of products and service that make it to market). Our office enters into license agreements with both startup and established companies. Often times, prior to entering into a license agreement we will implement a Letter of Intent (LOI) which is a short term, easy to execute agreement that allows a company to "lock up" the technology for a short period of time while negotiating the license, raising capital, etc.

How do I know that I have an "invention"?

An "invention" can be anything from a new material, device, research tool, mouse model, to a novel algorithm and even a new use for a known drug. We encourage you to contact the Office of Intellectual Property and Industry Sponsored Research even before filling out an Invention Report and we can talk through your idea and how we might best proceed.

When should I file an invention disclosure?

It's never too early to talk to our office about an invention that you think might have commercial potential. **You should disclose your invention to OIP-ISR before the work is published or publically presented.** Although we may still be able to secure an intellectual property position in the US if a patent application is filed within one year after a public disclosure, the ability to secure foreign patent protection is invariably lost. With some exceptions, submission of a manuscript to a journal is generally not considered a disclosure, but with many journals rapidly publishing online following acceptance, it is important to be aware of the actual publication

dates. As always, feel free to contact us before filing an Invention Report or if you have questions as what constitutes a public disclosure.

Can I publish my work and still protect the intellectual property?

Yes, but since patent rights may be affected by publications that precede a patent application filing, is it best to submit an Invention Report well before any public communication or other disclosure of the invention. Such disclosures can include presentations, lectures, posters, abstracts, thesis defenses, and publications either online or in print. Research proposal submissions are generally not considered public disclosures but it is important to understand if the proposal will become publically available when the grant is awarded. Feel free to contact us even before filing an Invention Report so that we can map out a strategy for your invention.

What if the work was done in collaboration with someone at another research institution or company?

The invention may be jointly owned by UCLA and the other institution or company. Each inventor must disclose the invention to his or her home institution. OIP-ISR will work with the other institution or company to create an agreement that will determine who will take the lead in managing the invention.

Do I have to disclose inventions that I make in my spare time or under a consulting agreement?

Yes. All UCLA employees sign a Patent Acknowledgement Agreement that requires them to disclose any potentially patentable inventions, whether or not UC resources are utilized. If, however, the invention is created in your spare time, without using UC resources and is outside of the scope of your employment, UCLA may relinquish rights to the invention. For more information on consulting, please go to <http://oip.ucla.edu/policies-forms> Section A.

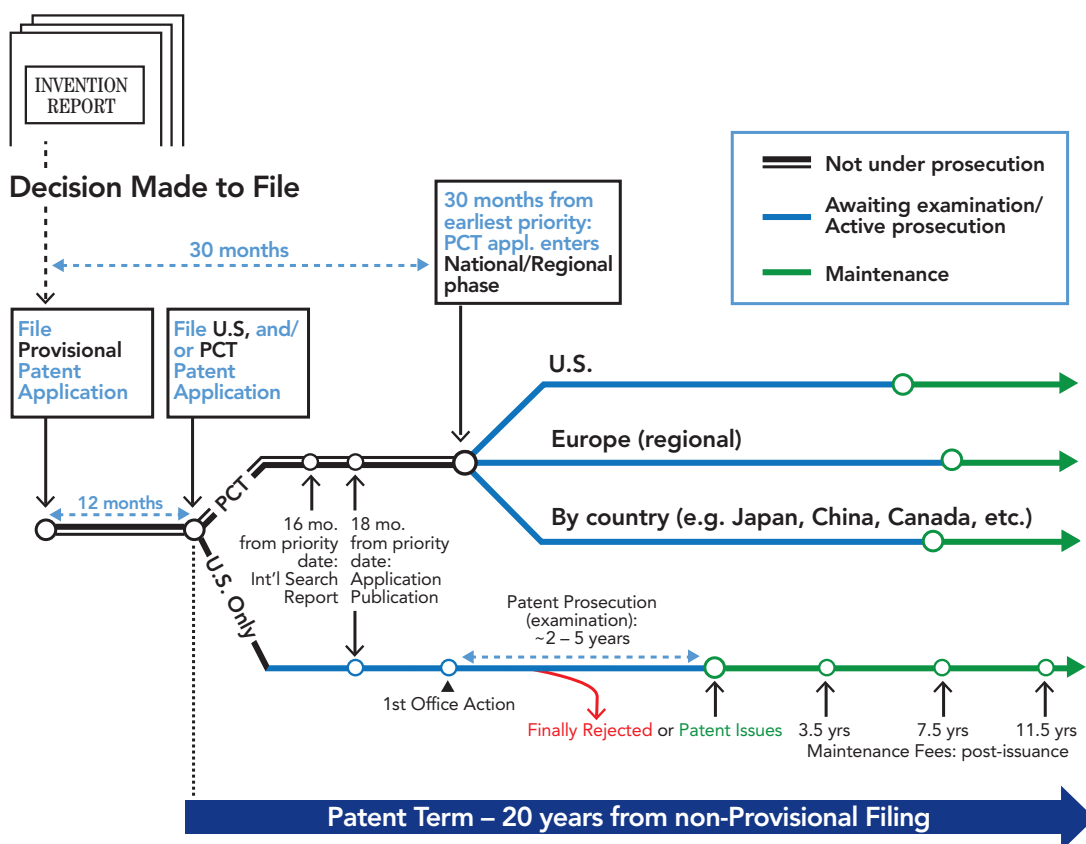
What is the definition of an inventor and who determines this?

Under U.S. patent law, an inventor is a person who is involved in the conception of an invention as claimed in a patent application. This is a legal determination that is distinct from authorship on a paper and is determined by our outside patent counsel. Correctly naming inventors on a patent is important for patent validity so you should list all individuals on the Invention Report who may have made an inventive contribution and outside patent counsel can then determine who qualifies as inventors.

Can I share royalties with an individual who worked on the invention but is not an inventor?

Yes. If there is a person that you feel has contributed towards the development of an invention (but whose contribution does not rise to the level of inventorship) and you would like to reward them, you can designate a percentage of your royalties to be given to them. We have a letter agreement that the parties sign to memorialize this understanding.

What is the timeline for patenting an invention?



Will UCLA file a patent even before a licensee has been identified?

Absolutely. Our goal is to file patents broadly and aggressively to protect UCLA inventions and maximize the possibility that these inventions will eventually be commercialized. UCLA will often make the investment to convert a provisional application to a full patent application before a licensee has been identified, especially when the technology appears promising as outlined below.

Why file a provisional patent application rather than a non-provisional patent application?

A provisional patent application is a very useful step in the patent process that has many benefits. Because a provisional application has fewer formal filing requirements than a non-provisional application, a provisional application allows an inventor to more quickly and easily obtain an effective filing date, while retaining the opportunity to supplement the provisional application over the year that follows with additional data that further supports the invention. A provisional application also has significantly reduced filing fees as compared with a non-provisional application. Lastly, a provisional application does not start the clock in calculating the 20-year term of any issuing patent (the clock begins when the subsequent non-provisional is ultimately filed, effectively extending the patent term by an additional year).

How does OIP-ISR prioritize its resources for patenting and marketing of inventions?

Our office tries to actively patent and market all technologies that appear to have potential commercial value and are ready for marketing. There are several key factors that help determine this:

- Does the technology have the potential to address an unmet commercial need?
- Is the invention well-differentiated from competing solutions on the market or in development?
- Are patent rights obtainable and enforceable?
- Have clear technology development milestones been identified that would make the invention of interest to industry?
- Is the inventor actively engaged in developing the technology?
- Will having intellectual property protection facilitate the technology being commercially developed?

How are licensees found?

Studies have shown that 70% of licensees were known to the inventors. Thus research and consulting relationships that the inventors have are often a valuable source of potential licensees and we strongly encourage you to let us know about your industry contacts. Licensees are also identified through existing relationships within the OIP-ISR office. We continually attempt to broaden these relationships through various forms of networking and market research.

What role does OIP-ISR play in starting companies based on UCLA technologies?

While OIP-ISR cannot play any direct role in company formation, we seek to support company formation by providing introductions to potential investors, business mentors, and service providers (For more information please see <http://www.research.ucla.edu/tech/entrepreneurFAQ.pdf>). We also seek to lower the hurdles for start-ups wanting to license technology by licensing in a phased approach that starts with a simple Letter of Intent (LOI).

Our Startup in a Box program was created to equip UCLA entrepreneurs with the tools they need to found and grow prosperous companies. Current offerings are listed below and include pre-negotiated packages with local law firms and banks, with further partnerships to be added over time. (For more information and a link to the application please see <http://oip.ucla.edu/ucla-startup-box>)

The Startup in a Box program offers:

- Legal services for entity formation
- Commercial bank accounts
- Mentorship
- SBIR/STTR workshops
- Pitch coaching

What is a non-confidential disclosure?

A non-confidential disclosure (NCD) is a short description of your invention that can be used to market the opportunity to potential licensees without disclosing confidential information. The description of the invention focuses on the benefits of the invention rather than underlying technology. OIP-ISR writes these NCD's, however your input and assistance with the content is very valuable.

What if a company wants to know confidential information?

If a company is interested in obtaining more details about your invention for further evaluation, we can execute a Confidential Disclosure Agreement (CDA) to ensure that proprietary information remains confidential and that any information disclosed is not deemed to be a public disclosure for the purposes of patenting. To avoid risking your patent rights, always contact OIP-ISR before having any discussions with individuals outside of the UCLA community where you plan to disclose your invention.

How can I help the process?

Your active involvement can dramatically improve the chances of finding a licensee. Once interested companies are identified, the inventor is the best person to describe the details of the invention and its technical advantages. Typically companies are most interested in licensing technology where the inventor is invested in moving the technology toward commercialization.

What is a “letter of intent”?

A Letter of Intent (LOI) is a simple three-page agreement giving the licensee a time limited exclusive right to negotiate an option or license agreement.

What is an option agreement?

An option agreement provides a company the right to make and use (but not offer for sale or sell) the technology purely for internal research and evaluation purposes, with an option to enter into negotiations for a license for a fixed period of time.

What is a bailment agreement?

A bailment agreement is the transfer of tangible materials (for example a mouse model) for commercial purposes. Companies often pay fees or royalties for these materials.

Can there be more than one licensee for a single invention?

Yes, an invention can be licensed to multiple licensees, either non-exclusively to several companies, co-exclusively to a defined and limited number of companies, or exclusively to several companies with each having a unique field-of-use or geography.

How are license terms determined?

License terms are tailored to the specifics of the technology, market and business plans of the licensee. General terms found in most licenses include an upfront license fee (cash or cash and equity), royalties, diligence terms, milestone/maintenance fees, indemnification, insurance and reimbursement of historical and ongoing patent costs.

How is licensing revenue distributed?

Per UCLA policy, revenues from licensing fees, royalties and equity—minus any unreimbursed legal expenses—are shared with the inventors. The inventors' share is set per their signed Patent Agreement. Please see <http://oip.ucla.edu/royalty-income>

What is a Material Transfer Agreement (MTA)?

An MTA is a written contract entered into by a provider and a recipient of tangible research material that specifies terms and conditions for the transfer and use of these materials. At UCLA, OIP-ISR negotiates and signs all incoming and outgoing MTAs since intellectual property rights can be endangered if materials are used without a proper MTA. In particular, incoming MTA's may contain clauses that compromise the value of future patent rights arising from the use of the material.

What is a copyright?

Copyright law protects original works of authorship that have been fixed in a tangible format in which the work can be recreated. This includes software code, literary, dramatic, musical, artistic, and certain other intellectual works. Copyright protection is automatic upon creation of the work, but registration is necessary before filing a legal action against any party infringing the copyright.

For more information, please see <http://oip.ucla.edu/all-about-copyright>

What copyrightable materials do I need to disclose to OIP-ISR?

Any work created in the course of a sponsored project, needs to be disclosed to OIP-ISR. A sponsored work is a work first produced by or through the University in the performance of a written agreement between the University and a sponsor.

Scholarly or aesthetic works do not need to be disclosed to OIP-ISR. The UC Copyright policy on ownership (see <http://oip.ucla.edu/all-about-copyright>) grants ownership of scholarly and aesthetic works to the

creator. A scholarly/aesthetic work is a work originated by a designated academic appointee resulting from independent academic effort. An example would be an article for a journal.

Undergraduate student work, unless it is a sponsored work or was created as a result of work done as a University employee, does not need to be disclosed to OIP-ISR.

Work created by University Staff, or Institutional work, should be disclosed to OIP-ISR.

If you are unclear on which category your work falls under or where ownership resides, please see <http://oip.ucla.edu/copyright-who-owns-what> and contact our office for additional information.

What are some examples of how copywritten materials have been commercialized?

A broad range of works of authorship have been successfully commercialized by OIP-ISR. Some examples include:

- Software
- Literary Materials
- Educational materials
- Sound Recordings
- Survey Instruments
- Sounds
- Photographs
- Websites
- Visual Works
- Dramatic Works

How do I disclose my work that I want to copyright?

All copyrightable materials should be disclosed to OIP-ISR using the Copyright Disclosure Form. Please see <http://oip.ucla.edu/invention-report>



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We are here to support all members
of the UCLA community in their
entrepreneurial, research and industry-
partnering activities and look forward
to working with you. Don't hesitate
to contact any of us anytime.

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