

Intellectual Property

Office of Intellectual Property
Vice-Presidency for Research and Technology
University of Puerto Rico

January 2007





Office of Intellectual Property

**The Office of
Intellectual Property of
the University of
Puerto Rico**



Office of Intellectual Property

Reports to the Vice President for Research and
Technology of the University of Puerto Rico

Primary Functions:

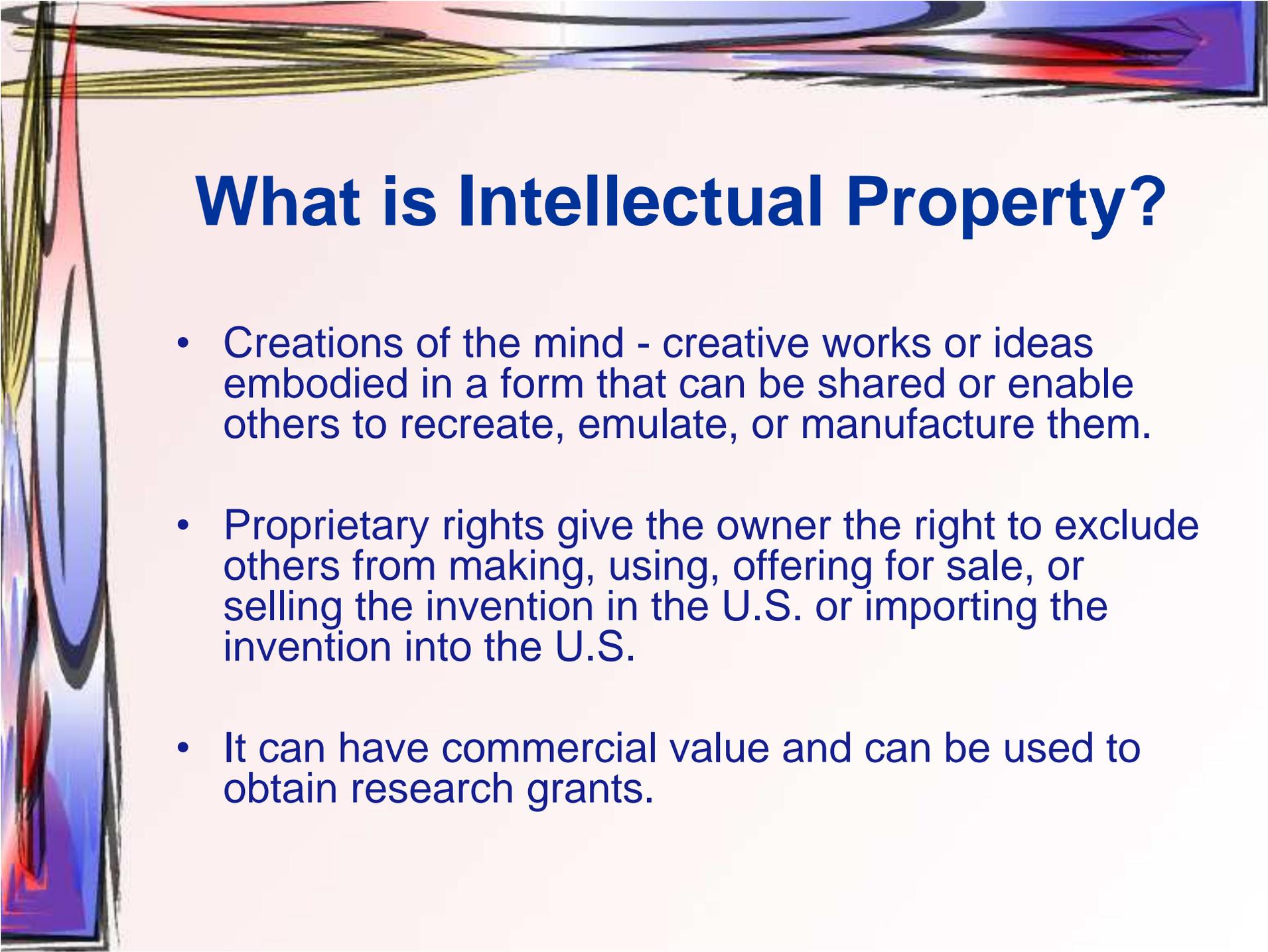
- Disseminate intellectual property related information to faculty, students and other UPR personnel.
- Identify and evaluate UPR patent prospects.
- Help protect intellectual property developed by the faculty, students, and staff of the UPR.
- Process patent applications.
- Coordinate with Patent Law Firms the legal services.
- Offer consulting services to the community, private sector, and other entities.



Office of Intellectual Property

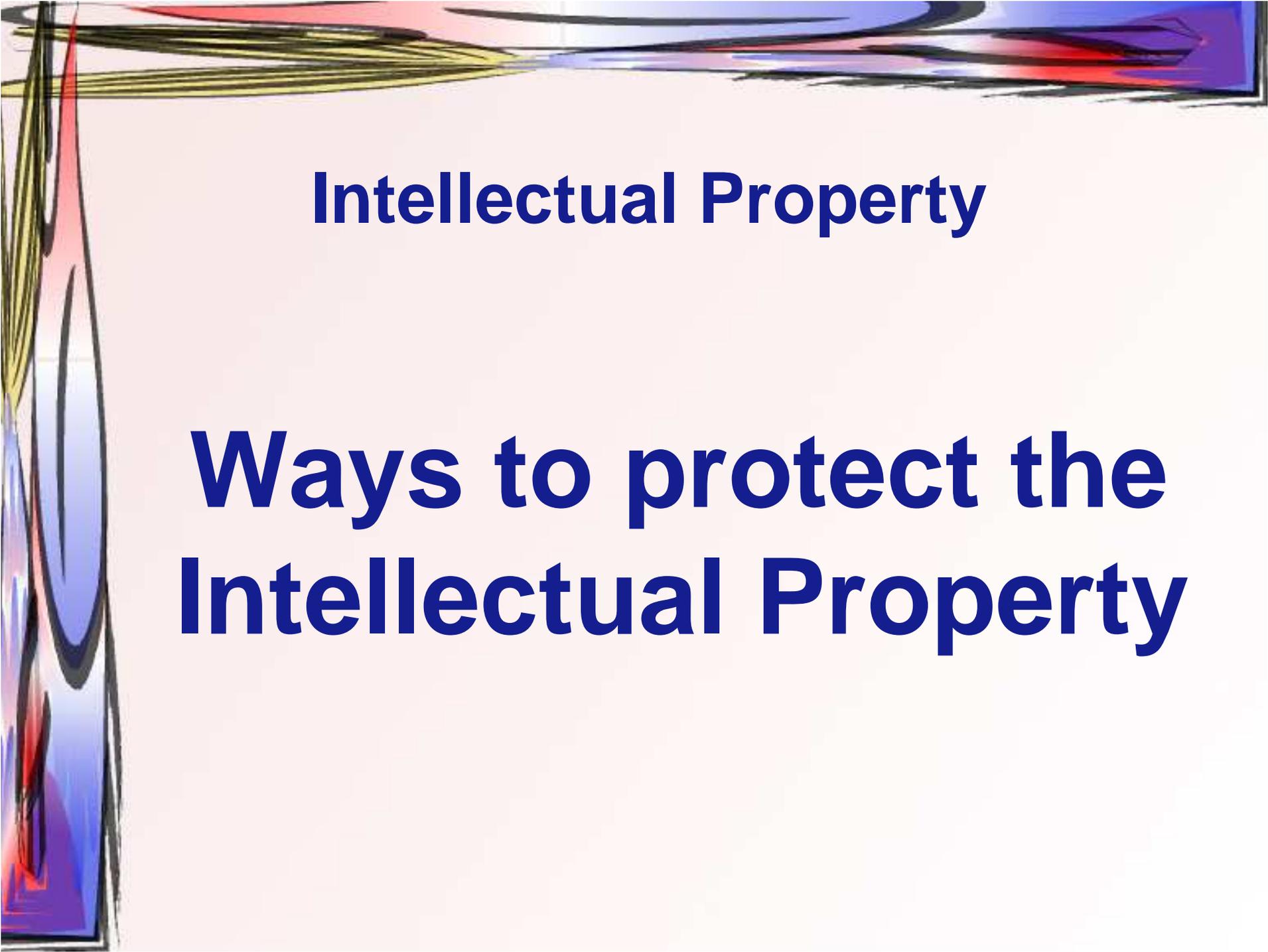
Major Activities:

- Seminars and workshops to faculty, students, and staff.
 - Seminars and conferences to the Puerto Rican community.
 - Manage the UPR Portfolio.
 - Identify marketing and patent licensing opportunities.
 - Participate in commercialization strategies.
- 



What is Intellectual Property?

- Creations of the mind - creative works or ideas embodied in a form that can be shared or enable others to recreate, emulate, or manufacture them.
- Proprietary rights give the owner the right to exclude others from making, using, offering for sale, or selling the invention in the U.S. or importing the invention into the U.S.
- It can have commercial value and can be used to obtain research grants.



Intellectual Property

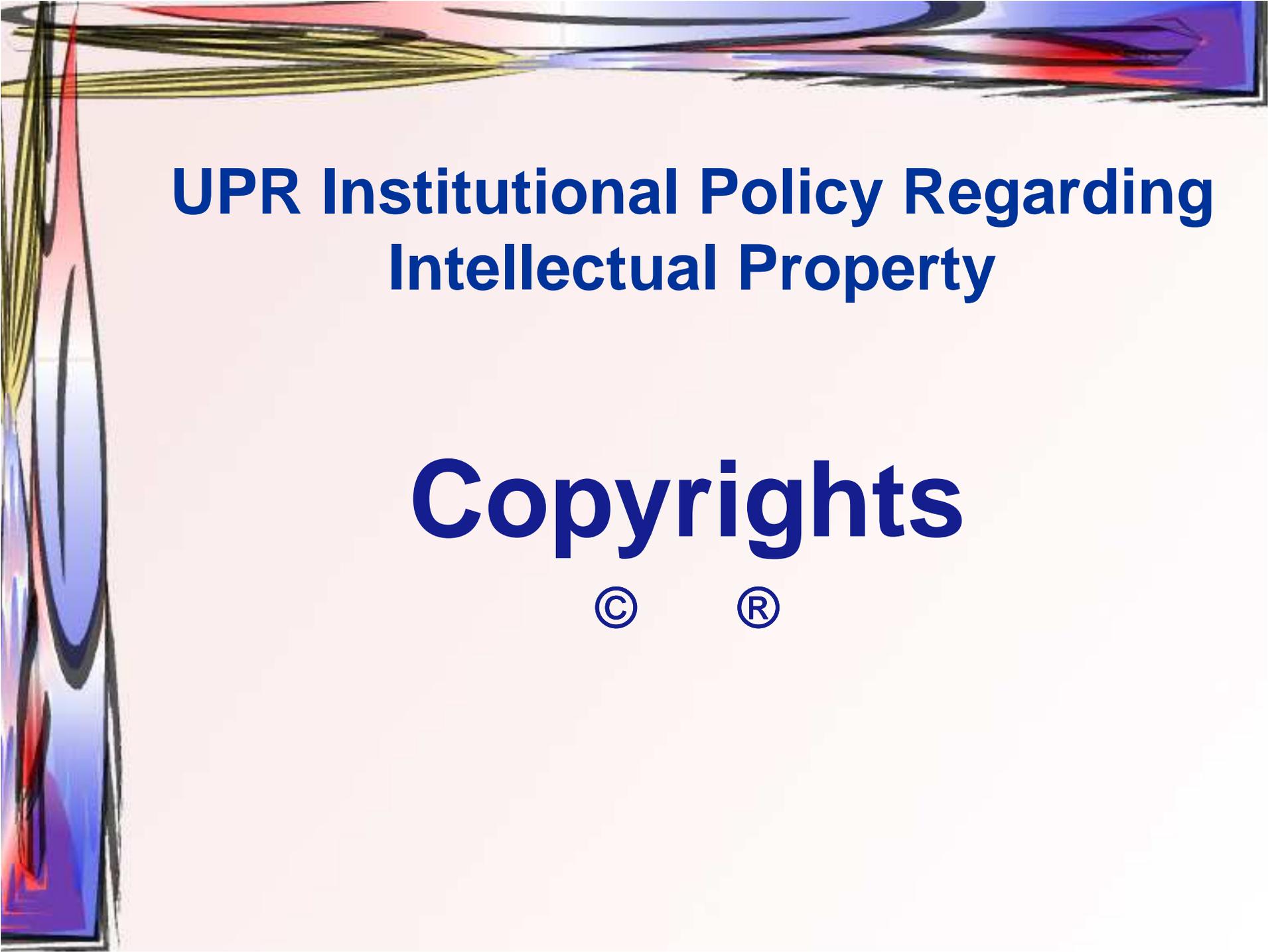
Ways to protect the Intellectual Property



Ways to protect the Intellectual Property

There are four ways to protect intellectual property:

- **Trademarks** TM SM ®
- **Trade secrets**
- **Copyrights** © ®
- **Patents** U.S. Patent No.

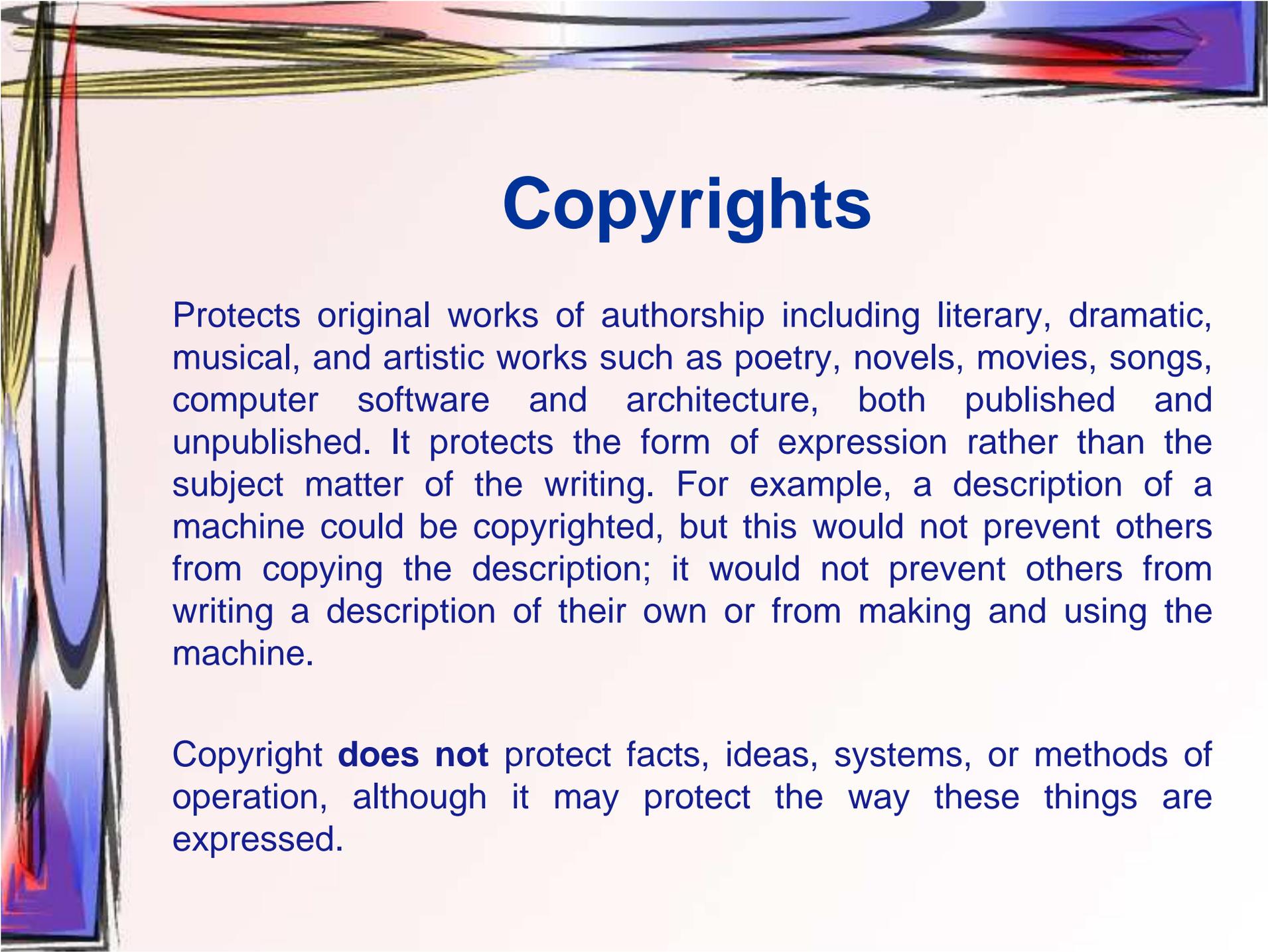


UPR Institutional Policy Regarding Intellectual Property

Copyrights

©

®



Copyrights

Protects original works of authorship including literary, dramatic, musical, and artistic works such as poetry, novels, movies, songs, computer software and architecture, both published and unpublished. It protects the form of expression rather than the subject matter of the writing. For example, a description of a machine could be copyrighted, but this would not prevent others from copying the description; it would not prevent others from writing a description of their own or from making and using the machine.

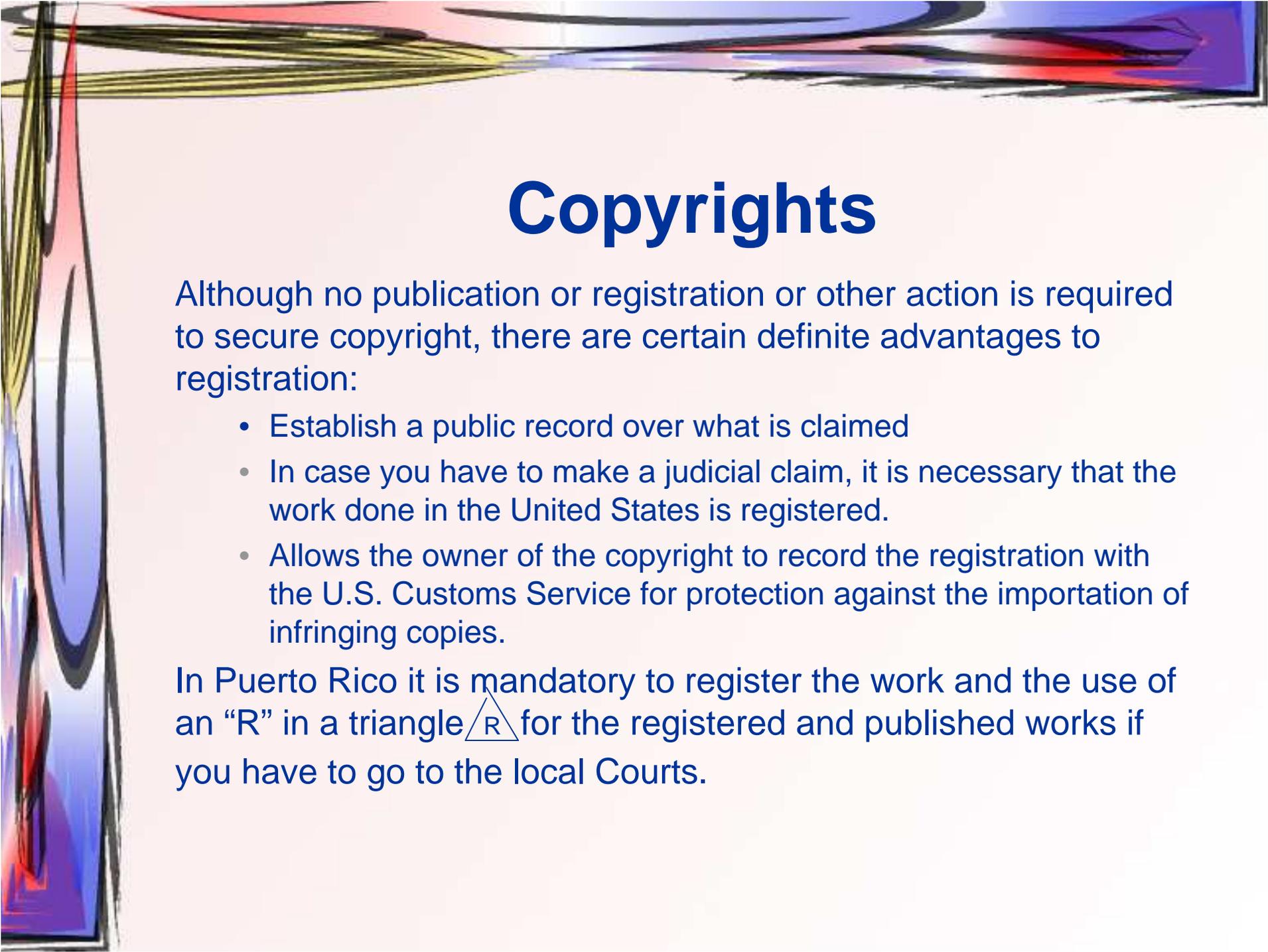
Copyright **does not** protect facts, ideas, systems, or methods of operation, although it may protect the way these things are expressed.



UPR Institutional Policy Regarding Intellectual Property

1993 – The Institutional Policy Regarding Intellectual Property was established and approved by the Council of Higher Education through Certification Number 93-140 (92-93).

- It establishes that the academic personnel and the students will be the owners of the work created in their academic activities, except when otherwise agreed.
- The ownership of the work does not exempt him/her of the responsibility to acknowledge the University.
- It will be the sole responsibility of the professors and the students to register and protect their work.



Copyrights

Although no publication or registration or other action is required to secure copyright, there are certain definite advantages to registration:

- Establish a public record over what is claimed
- In case you have to make a judicial claim, it is necessary that the work done in the United States is registered.
- Allows the owner of the copyright to record the registration with the U.S. Customs Service for protection against the importation of infringing copies.

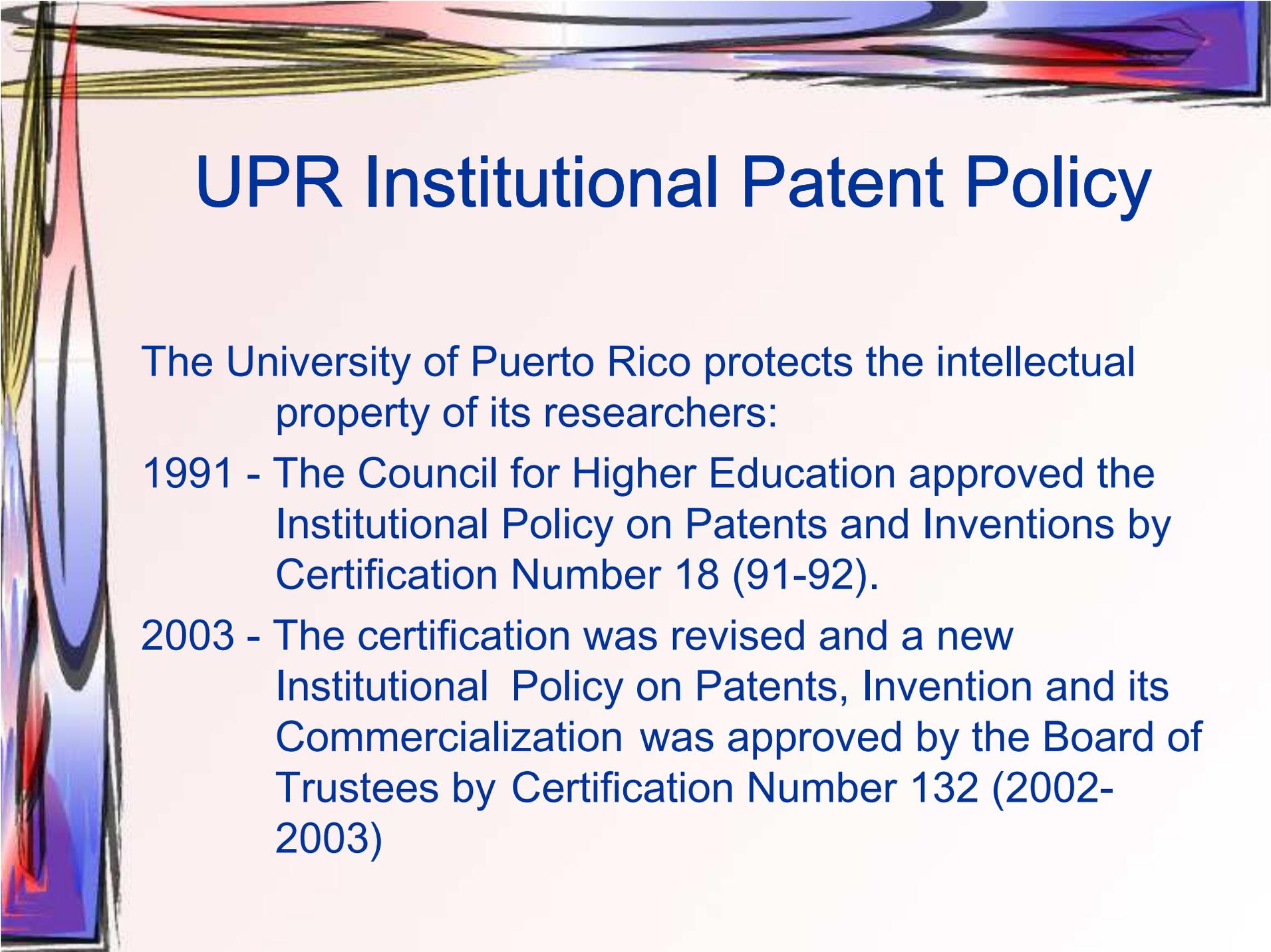
In Puerto Rico it is mandatory to register the work and the use of an “R” in a triangle  for the registered and published works if you have to go to the local Courts.



UPR Institutional Policy on Patents, Inventions and Commercialization

Patents

U.S. Patent No.

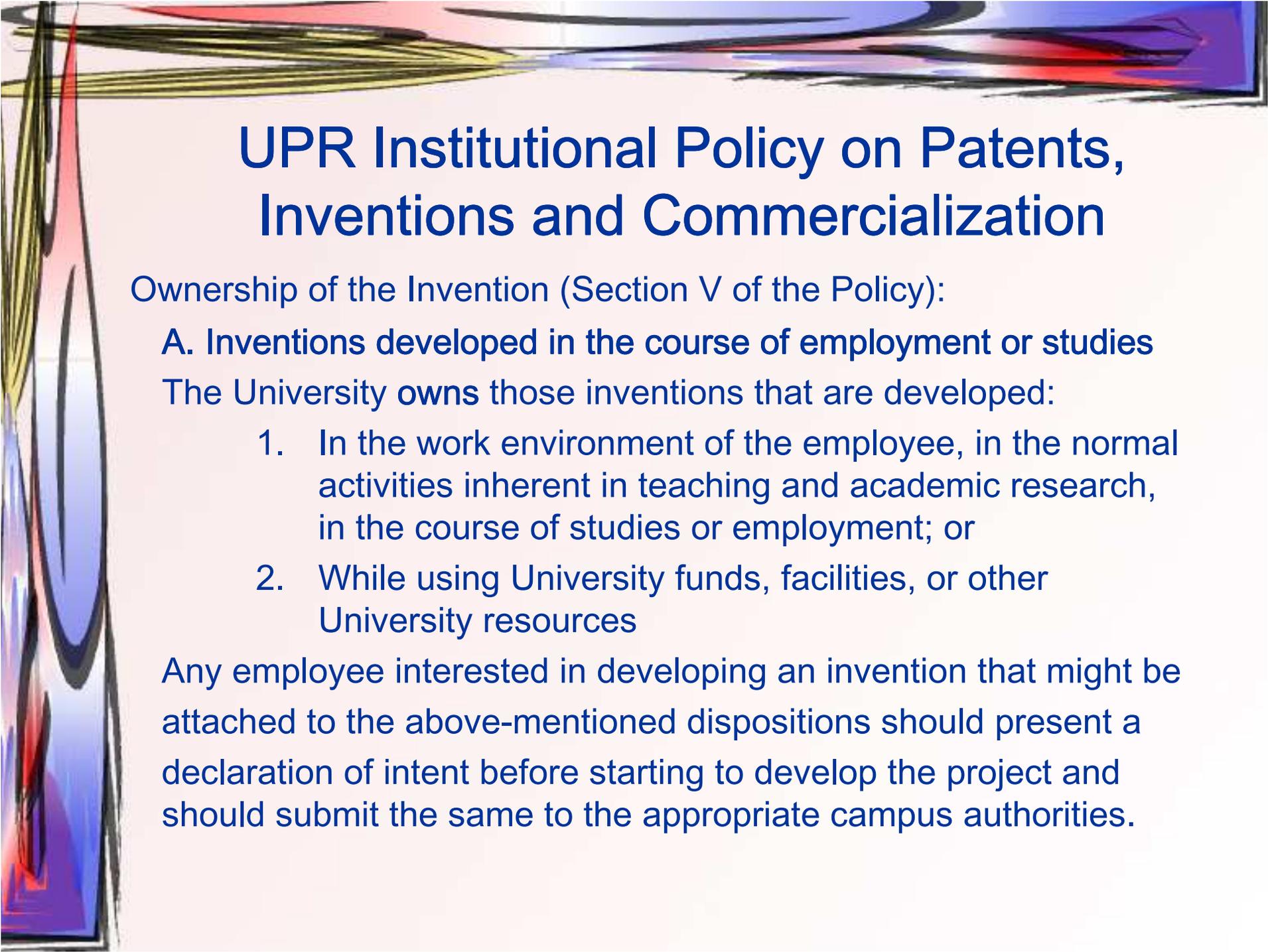


UPR Institutional Patent Policy

The University of Puerto Rico protects the intellectual property of its researchers:

1991 - The Council for Higher Education approved the Institutional Policy on Patents and Inventions by Certification Number 18 (91-92).

2003 - The certification was revised and a new Institutional Policy on Patents, Invention and its Commercialization was approved by the Board of Trustees by Certification Number 132 (2002-2003)



UPR Institutional Policy on Patents, Inventions and Commercialization

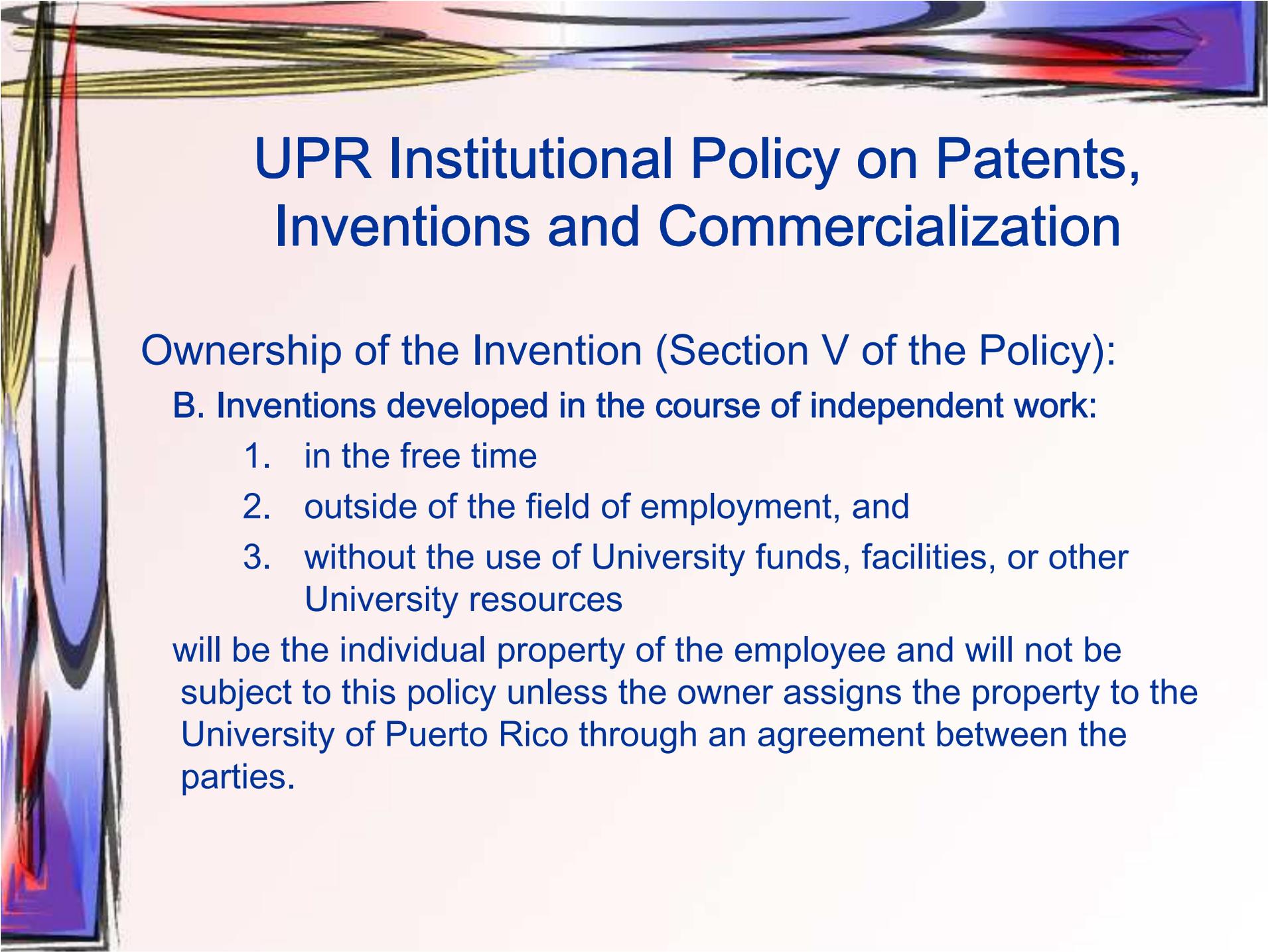
Ownership of the Invention (Section V of the Policy):

A. Inventions developed in the course of employment or studies

The University owns those inventions that are developed:

1. In the work environment of the employee, in the normal activities inherent in teaching and academic research, in the course of studies or employment; or
2. While using University funds, facilities, or other University resources

Any employee interested in developing an invention that might be attached to the above-mentioned dispositions should present a declaration of intent before starting to develop the project and should submit the same to the appropriate campus authorities.



UPR Institutional Policy on Patents, Inventions and Commercialization

Ownership of the Invention (Section V of the Policy):

B. Inventions developed in the course of independent work:

1. in the free time
2. outside of the field of employment, and
3. without the use of University funds, facilities, or other University resources

will be the individual property of the employee and will not be subject to this policy unless the owner assigns the property to the University of Puerto Rico through an agreement between the parties.

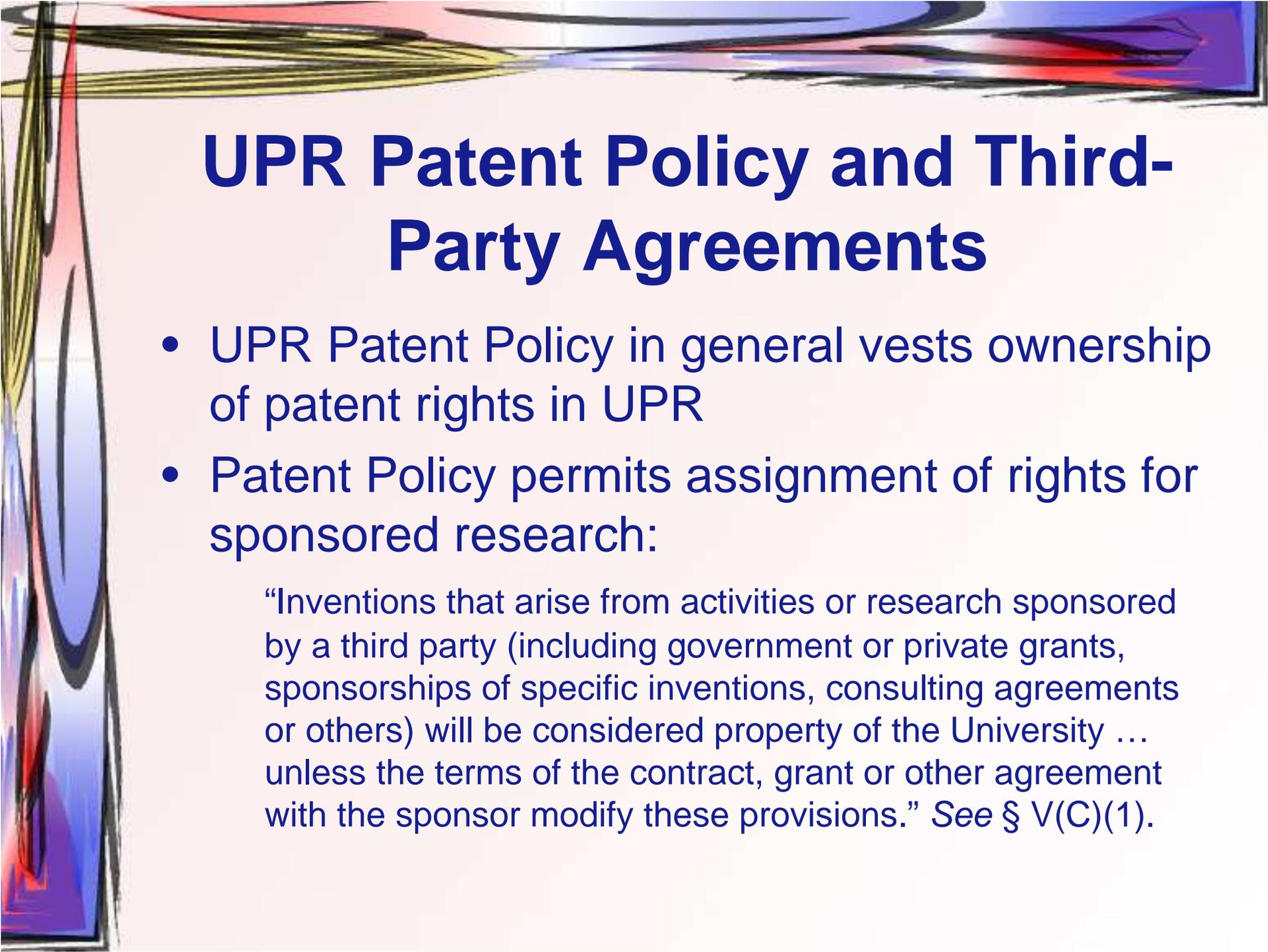


UPR Institutional Policy on Patents, Inventions and Commercialization

Ownership of the Invention (Section V of the Policy):

C. Inventions resulting from work sponsored by a Third Party (including government or private grants, sponsorships of specific inventions, consulting agreements, or others) **will be considered property of the University above, unless terms of the contract, grant or other agreement with the sponsor modify these provisions.**

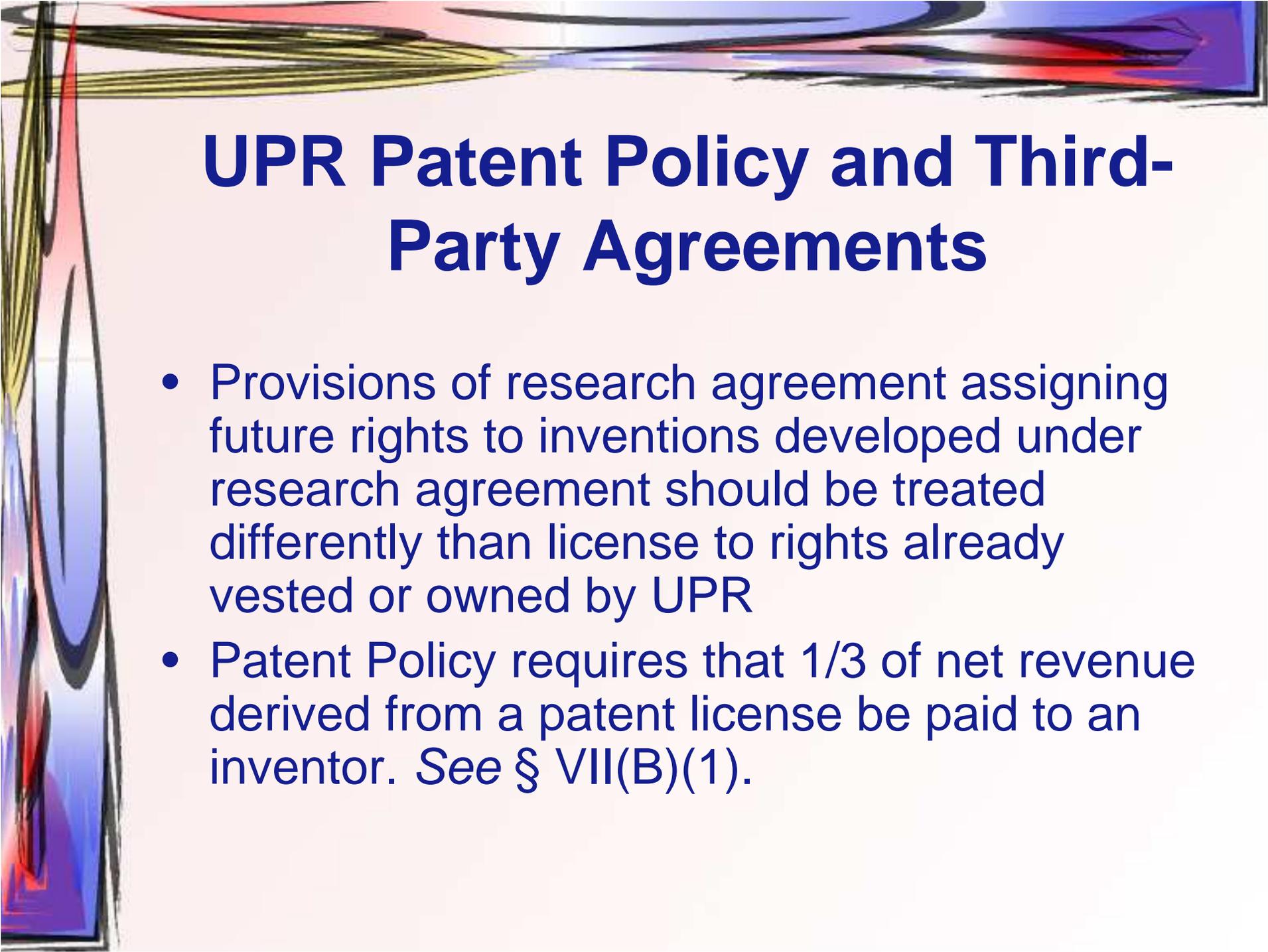
Any person interested in beginning a project sponsored by a third party shall submit a proposal contract to the campus authorities so they can determine if the proposed agreement is consistent with the mission of the University, the particular campus, and this Policy.



UPR Patent Policy and Third-Party Agreements

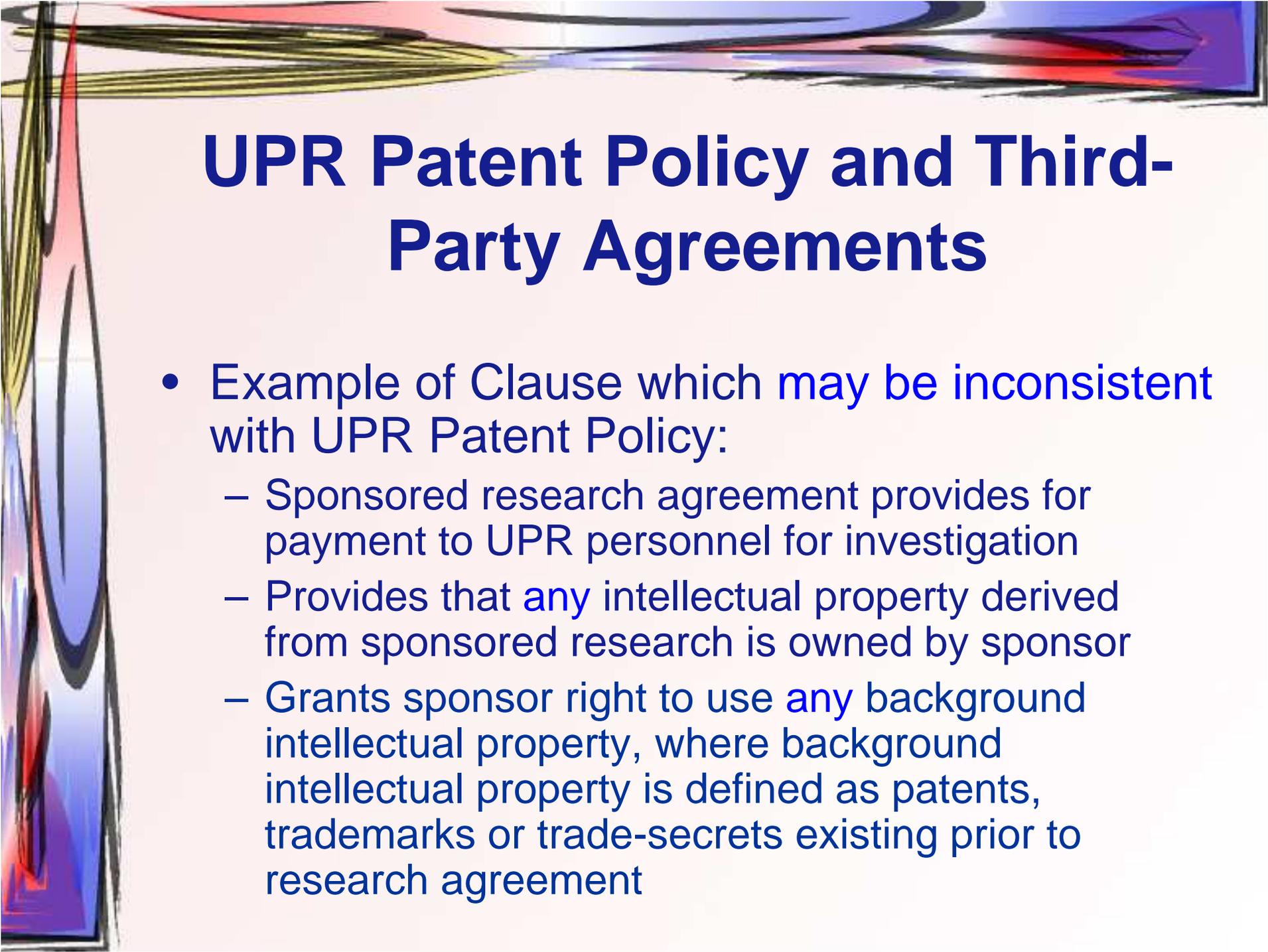
- UPR Patent Policy in general vests ownership of patent rights in UPR
- Patent Policy permits assignment of rights for sponsored research:

“Inventions that arise from activities or research sponsored by a third party (including government or private grants, sponsorships of specific inventions, consulting agreements or others) will be considered property of the University ... unless the terms of the contract, grant or other agreement with the sponsor modify these provisions.” See § V(C)(1).



UPR Patent Policy and Third-Party Agreements

- Provisions of research agreement assigning future rights to inventions developed under research agreement should be treated differently than license to rights already vested or owned by UPR
- Patent Policy requires that 1/3 of net revenue derived from a patent license be paid to an inventor. See § VII(B)(1).



UPR Patent Policy and Third-Party Agreements

- Example of Clause which may be inconsistent with UPR Patent Policy:
 - Sponsored research agreement provides for payment to UPR personnel for investigation
 - Provides that **any** intellectual property derived from sponsored research is owned by sponsor
 - Grants sponsor right to use **any** background intellectual property, where background intellectual property is defined as patents, trademarks or trade-secrets existing prior to research agreement



UPR Copyright Policy and Third-Party Agreements

- Unlike patent policy, copyright policy generally vests ownership in author:
“Teaching personnel and students of the University of Puerto Rico will retain the title to works created in the normal course of their academic activities and study, unless otherwise provided.” See § VII.
- Like background patent rights, research agreements **cannot license background copyrights** which are not owned by UPR.



LEGAL REQUIREMENTS

Applicable Federal Laws

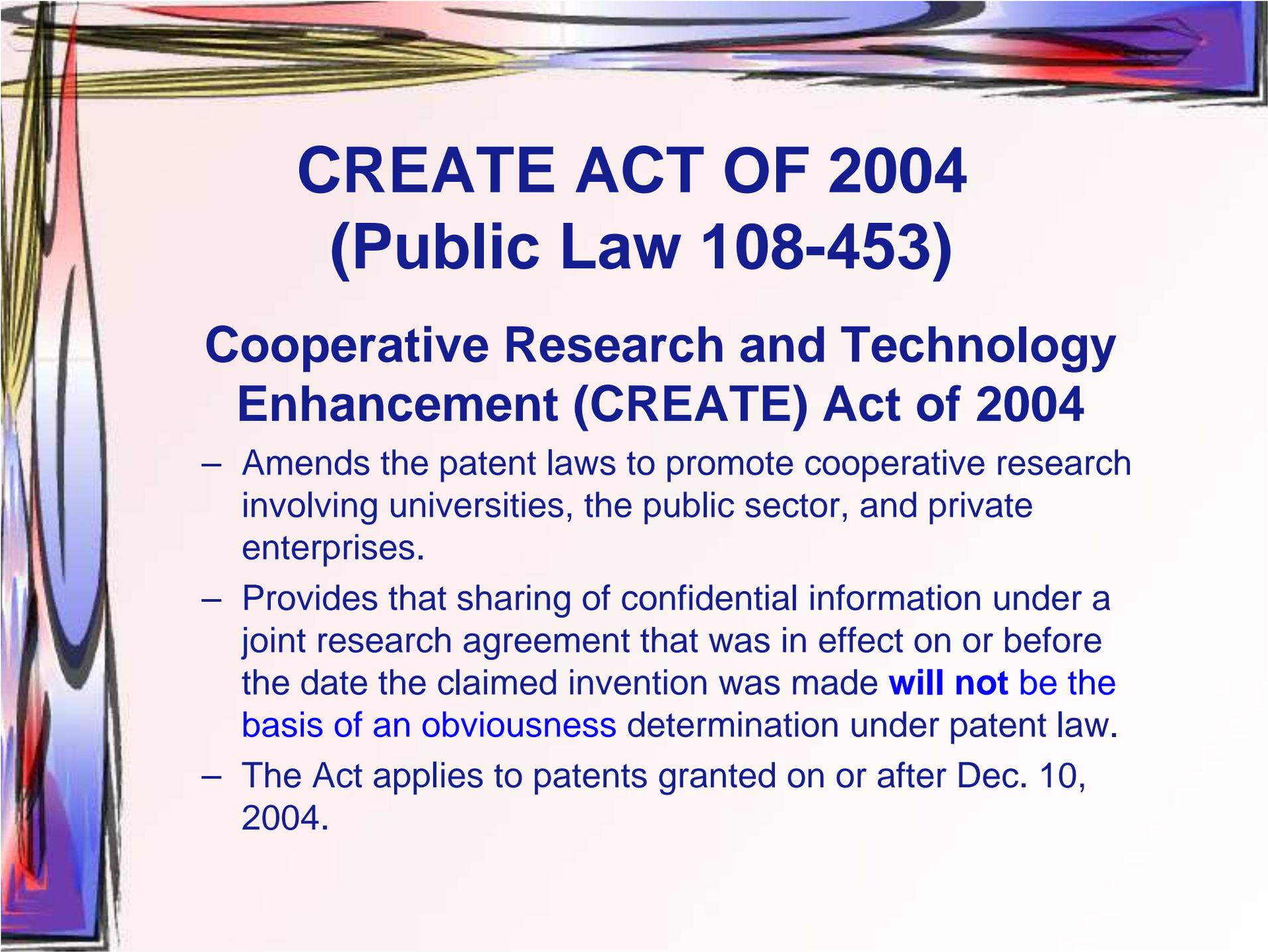


Applicable federal laws

The University of Puerto Rico, or any entity that receives federal money for research, has to comply with the following laws that relates to the patent laws:

- CREATE Act of 2004
- Bayh-Dole Act

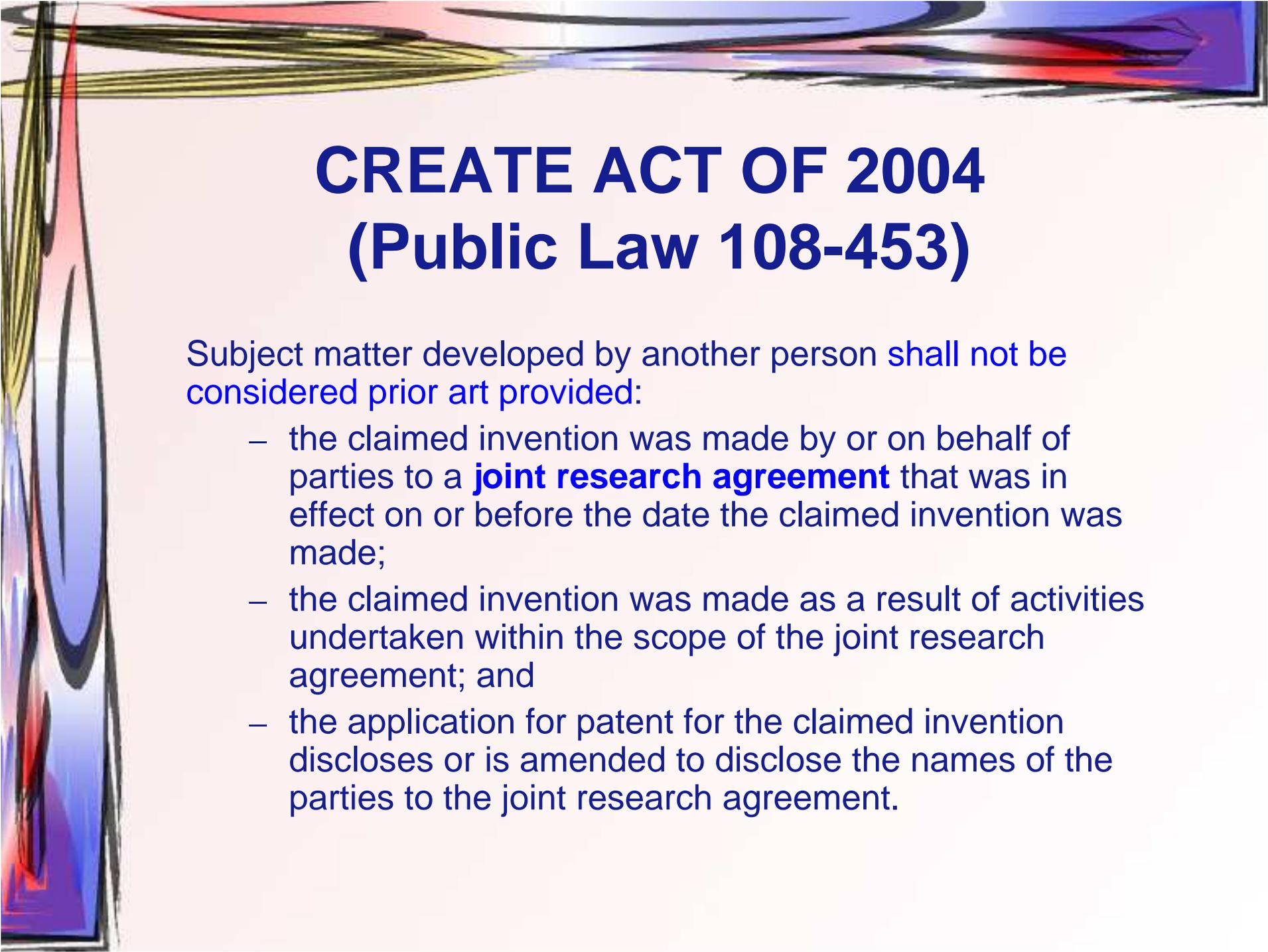
Also with all the regulations of the federal agencies that sponsors the research



CREATE ACT OF 2004 (Public Law 108-453)

Cooperative Research and Technology Enhancement (CREATE) Act of 2004

- Amends the patent laws to promote cooperative research involving universities, the public sector, and private enterprises.
- Provides that sharing of confidential information under a joint research agreement that was in effect on or before the date the claimed invention was made **will not** be the **basis of an obviousness** determination under patent law.
- The Act applies to patents granted on or after Dec. 10, 2004.



CREATE ACT OF 2004 (Public Law 108-453)

Subject matter developed by another person shall not be considered prior art provided:

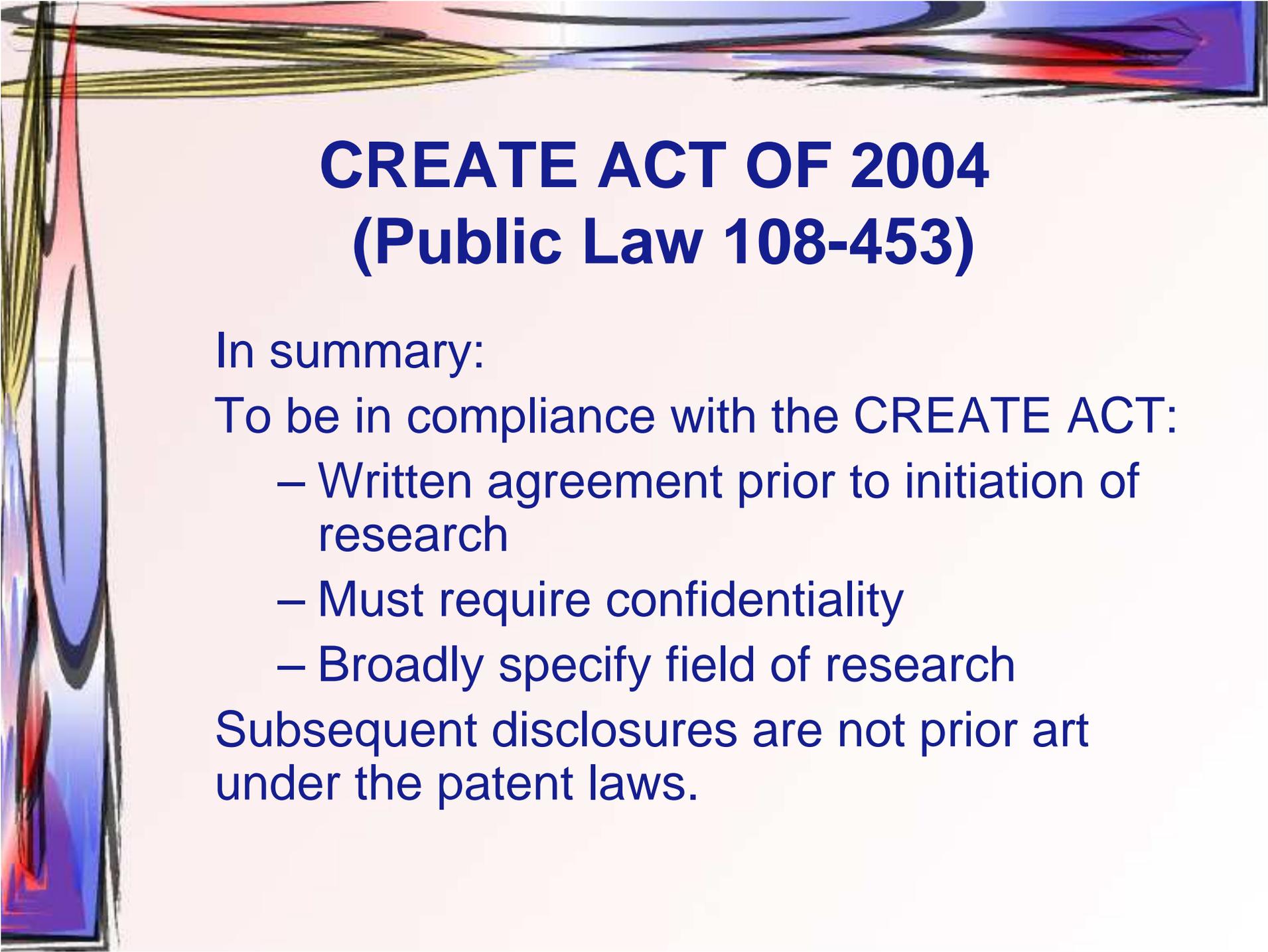
- the claimed invention was made by or on behalf of parties to a **joint research agreement** that was in effect on or before the date the claimed invention was made;
- the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and
- the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.



CREATE ACT OF 2004 (Public Law 108-453)

A joint research agreement is:

- A written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.
- Should include the names of the parties to the Agreement, the effective date, and a concise statement of the field to which the joint research applies.
- It is very important that **everyone on the team** understands the Agreement and the field of research.



CREATE ACT OF 2004 (Public Law 108-453)

In summary:

To be in compliance with the CREATE ACT:

- Written agreement prior to initiation of research
- Must require confidentiality
- Broadly specify field of research

Subsequent disclosures are not prior art under the patent laws.

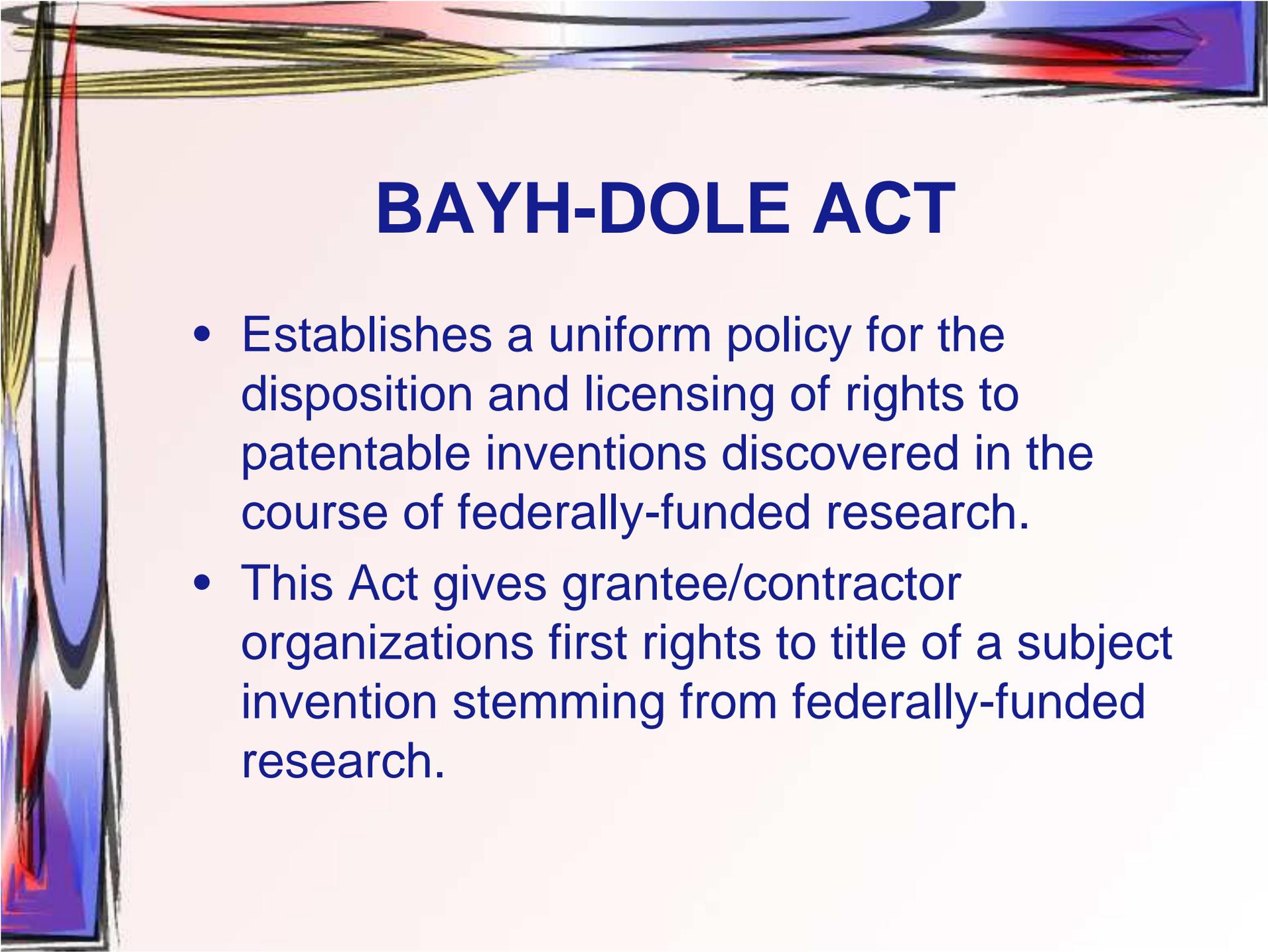


BAYH-DOLE ACT

35 U.S.C. § 202 (c)(1)

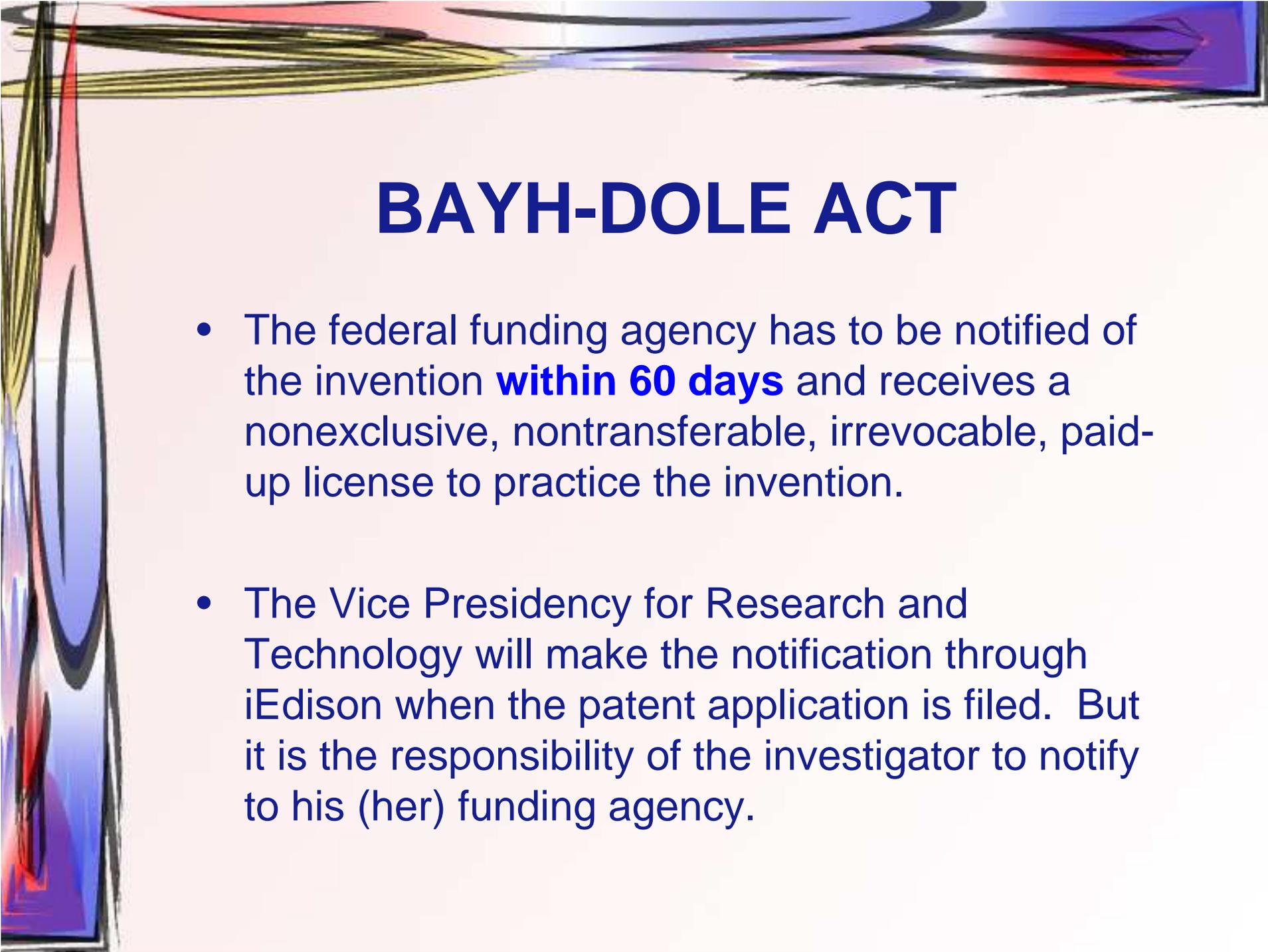
The Bayh-Dole Act, and its subsequent amendments, created incentives for the government, universities, and industry to work together in the commercialization of new technologies for the public benefit.

It gives the opportunity to develop new industries.



BAYH-DOLE ACT

- Establishes a uniform policy for the disposition and licensing of rights to patentable inventions discovered in the course of federally-funded research.
- This Act gives grantee/contractor organizations first rights to title of a subject invention stemming from federally-funded research.



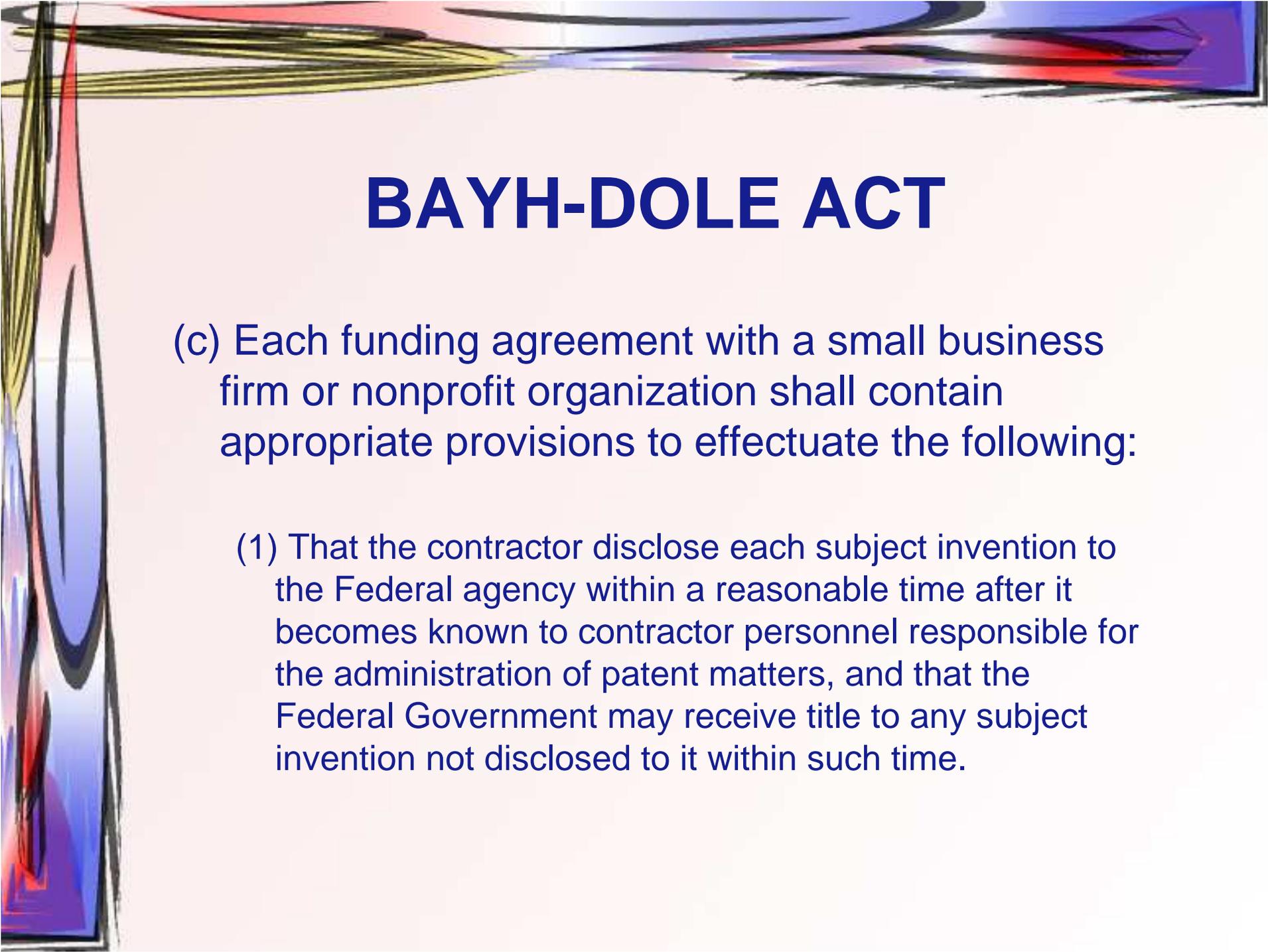
BAYH-DOLE ACT

- The federal funding agency has to be notified of the invention **within 60 days** and receives a nonexclusive, nontransferable, irrevocable, paid-up license to practice the invention.
- The Vice Presidency for Research and Technology will make the notification through iEdison when the patent application is filed. But it is the responsibility of the investigator to notify to his (her) funding agency.



BAYH-DOLE ACT

- The federal agency support is acknowledged in any related patent application, and commercialization is actively pursued.
- In their marketing of an invention, universities must give preference to small business firms and, to the extent possible, products are to be manufactured in the U.S.
- University must share with the inventor(s) any revenue received from licensing the invention.



BAYH-DOLE ACT

(c) Each funding agreement with a small business firm or nonprofit organization shall contain appropriate provisions to effectuate the following:

(1) That the contractor disclose each subject invention to the Federal agency within a reasonable time after it becomes known to contractor personnel responsible for the administration of patent matters, and that the Federal Government may receive title to any subject invention not disclosed to it within such time.



Why is Bayh-Dole Act important to the University and the Technology Transfer Program?

Bayh-Dole promotes:

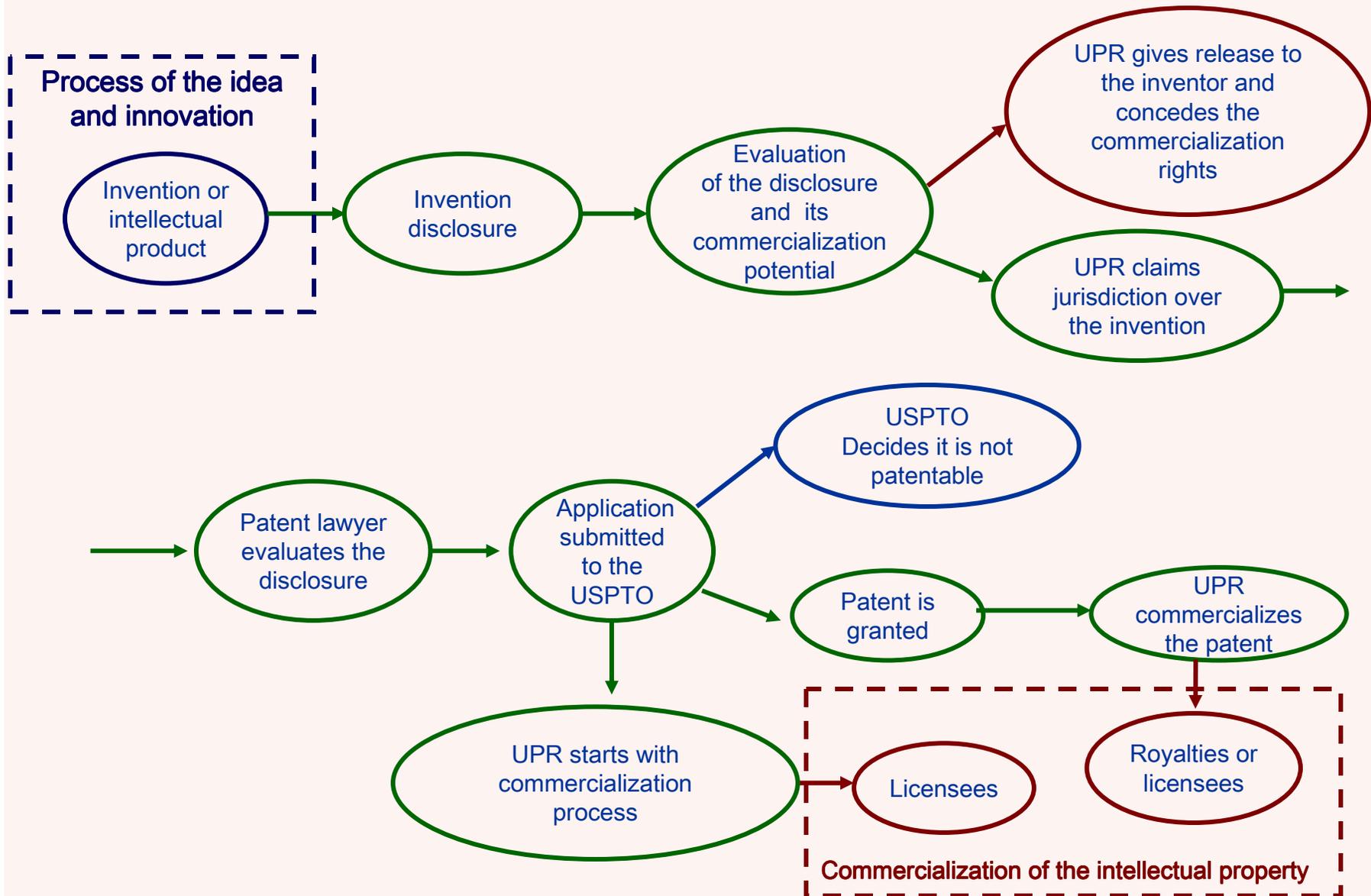
- Universities to patent, market and license inventions
- Collaborations between commercial and nonprofit organizations
- Free competition and enterprise
- Commercialization and public availability of inventions made in the U.S. By U.S. Industry and labor
- The fact that the Federal government has a nonexclusive right to make or use the invention for government purposes



Patenting at the UPR

Process to submit a patent at the University of Puerto Rico

Patenting and Commercialization Process





Documents to be submitted to the UPR Office of Intellectual Property

What to submit:

- UPR Invention Disclosure
- If a third party is involved, copy of the signed Agreement
- Copy of the funding agreement or the proposal
- Copy of the Disclosure of Invention to the funding agency

When ready to present the application to the USPTO:

- Assignment document
- Royalty Sharing Agreement (if more than one inventor)
- Conflict of Interest documents



Commercialization at the UPR

**Process to commercialize
a patent at the University
of Puerto Rico**



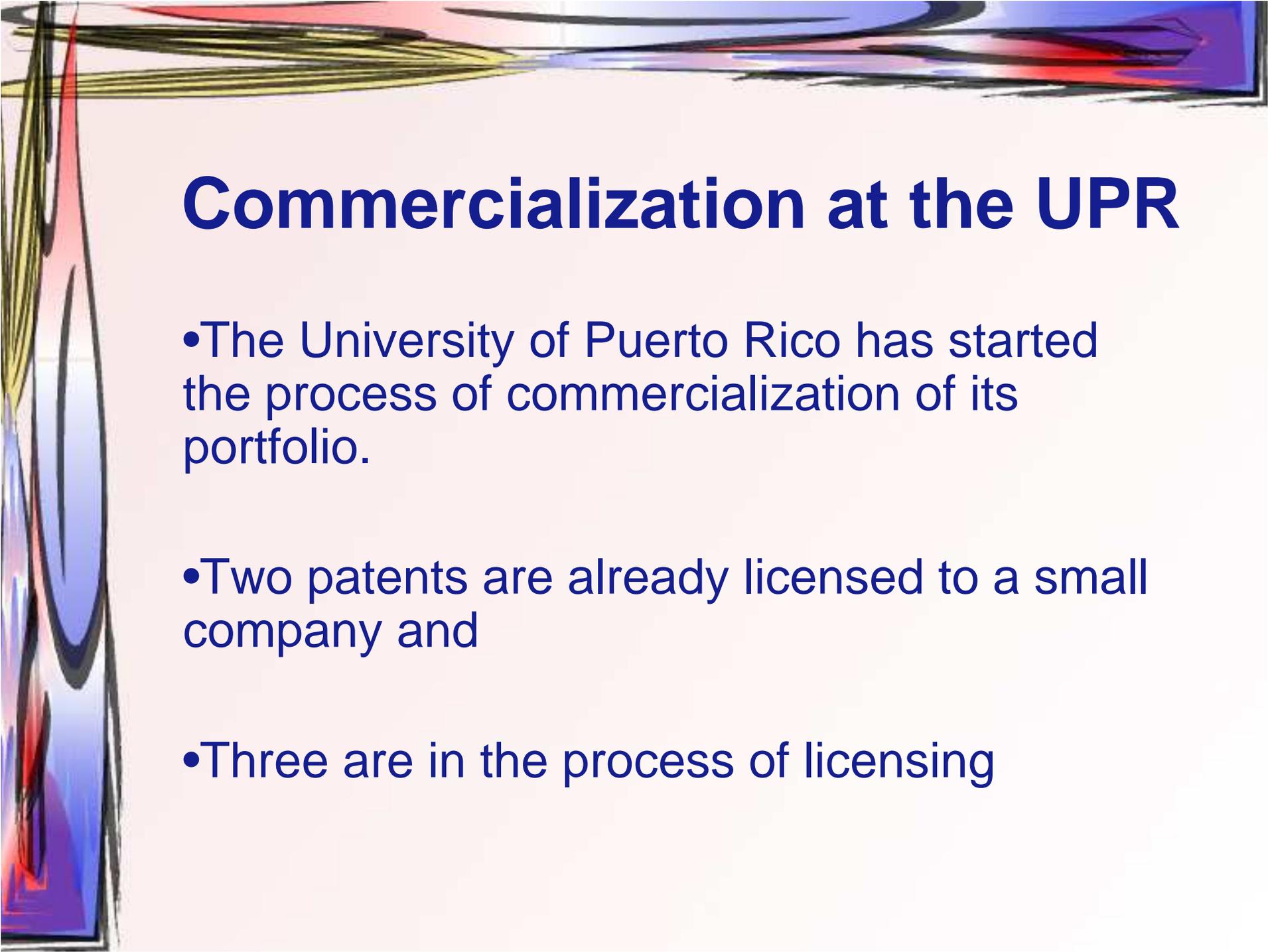
Commercialization at the UPR

- The inventor contact the Office of Intellectual Property at the Vice Presidency for Research and Technology, through the legal office of his(her) campus, to inform about entities interested in commercializing the product.
- The inventor or the OIP (as decided) contact the company that might be interested in licensing the product to sign a confidentiality agreement.
- After signing the agreement, the company submits a licensing proposal to the UPR.



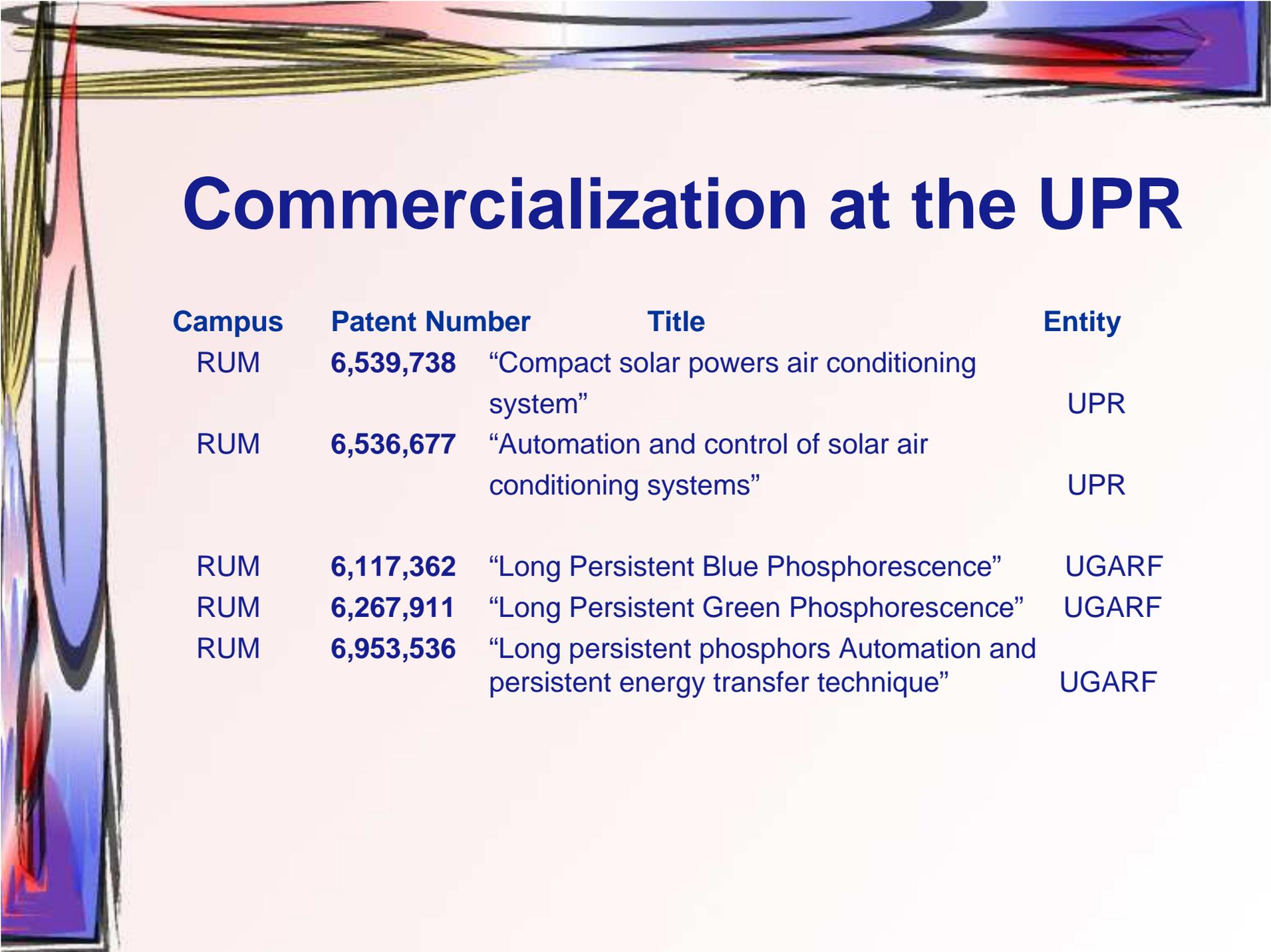
Commercialization at the UPR

- The proposal is evaluated and discussed with the legal office and the UPR patent lawyer.
- The negotiations begin between the company and the legal office of the UPR.
- A license agreement is signed.



Commercialization at the UPR

- The University of Puerto Rico has started the process of commercialization of its portfolio.
- Two patents are already licensed to a small company and
- Three are in the process of licensing



Commercialization at the UPR

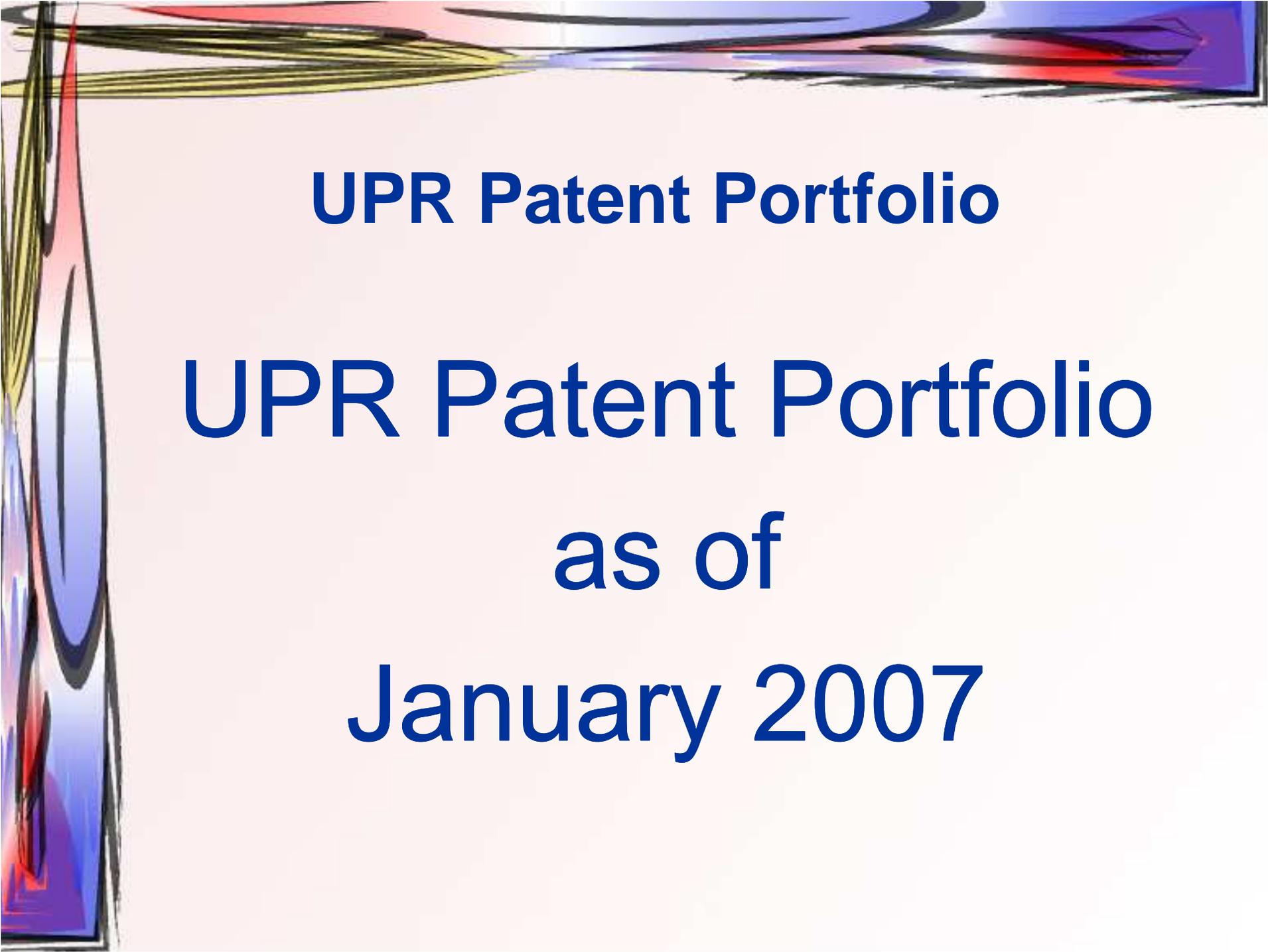
Campus	Patent Number	Title	Entity
RUM	6,539,738	“Compact solar powers air conditioning system”	UPR
RUM	6,536,677	“Automation and control of solar air conditioning systems”	UPR
RUM	6,117,362	“Long Persistent Blue Phosphorescence”	UGARF
RUM	6,267,911	“Long Persistent Green Phosphorescence”	UGARF
RUM	6,953,536	“Long persistent phosphors Automation and persistent energy transfer technique”	UGARF

Commercialization at the UPR



**Technology Transfer Unit
UPR-PRIDCO
Alliance**

- **Develop a Technology Transfer Unit for Puerto Rico**
 - Integrate academia into local ecosystem innovation
 - while protecting IP under US law



UPR Patent Portfolio

UPR Patent Portfolio

as of

January 2007



UPR Portfolio

The UPR has 33 issued patents by the Patent and Trademark Office (USPTO):

- UPR at Mayagüez 19 ¹
- UPR at Río Piedras 9 ²
- Medical Sciences Campus 1
- FILIUS 3 ¹
- UPR at Humacao 5 ²

¹ 3 of the patents are shared

² 1 of the patents is shared between RRP & Humacao y dos con UCC



USPTO Depository Libraries

- **University of Puerto Rico at Mayagüez**
(within the General Library)
(787) 832-4040 ext. 2307 - Prof. Ronaldo Martínez,
Director

ronaldo@rumlib.uprm.edu

- **University of Puerto Rico at Bayamón**
(within the General Library)
(787) 993-0000 - Prof. Mildred Pérez, Director

milperez@uprb.edu



Electronic addresses

**United States Patents and Trademark Office
(USPTO)**

<http://www.uspto.gov>

United States Congress Library

<http://www.copyright.gov>

Puerto Rico's Department of State

<http://www.estado.gobierno.pr>



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