IP Committee Meeting

UofL Innovation

Office of Research & Innovation

(502) 852-2965

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Overview of Presentation

- Introductions - 10 min
- Review Scope of Committee Work - 5 min
- Review Structure of Innovation Programming at UofL - 5 min
- Primer on Patenting Basics - 10 min
- Introduce Policy Update - 5 min
- Set meeting schedule for year - 5 min

Our Committee Members

Name/title	Position on committee
Laura Savatski, Executive Director Innovation & Commercialization	X Chairperson
Katherine Brown, Intellectual Property Officer	X Officer or designee of ULRF
Larry Benz, Trustee University of Louisville	X Board of Trustee Member
Shannon Pipes, University Counsel, Sr. Assoc	X Staff – University Counsel
John Klapheke, Graduate student at Brandeis studying law, current intern	X Graduate student
Michael Menze, Professor, Arts & Sciences	X 1 of 2 Faculty (previously served)
Patrick Harris, Professor, Physiology	X 1 of 2 Faculty senate (2022-25)
Rachel Howard, Assoc Professor, Libraries	X 1 of 2 Faculty senate (2023-26)
Ramesh Gupta (excused),Professor, Pharmacology	X 2 of 2 Faculty (previously served)

Laura Savatski, MBA, CLP, RTTP

Laura brings more than 20 years of experience in technology transfer to her role as Executive Director of Innovation & Commercialization for the University of Louisville. There she leads a team responsible for the identification, evaluation, protection, and commercialization of research discoveries.

Laura has a diverse background as a research scientist, entrepreneur, and start-up advisor, and broad experience bringing inventions to market. Laura's early career in medical research focused on vaccine trials, molecular virology, stem cell biology, transplant/oncology, and cellular assays. Her past roles include Vice President and Chief Operating Officer for Prodesse, a company she co-founded. Prodesse, now part of Hologic, created the first clinical multiplex-PCR test and a suite of infectious disease products for clinical diagnosis. Laura has served on boards for start-ups and non-profits like the Alliance of Technology Transfer Professionals (ATTP) the organization that awards the Registered Technology Transfer Professional (RTTP) credential for the profession. For five years she served on the AUTM board and was AUTM Chair in 2021.

Review Scope of Committee Work

- **5. OVERSIGHT OF POLICY**
  a. Intellectual Property Committee. The Senior Vice President for Research of the University shall appoint an Intellectual Property Committee (“Committee”) consisting of nine members. The Senior Vice President for Research or designee shall serve as Chairperson. Members shall consist of an officer or designee of the ULRF, a Trustee of the University, and six others (four faculty members, one staff member, and one professional/graduate student member). The faculty, staff, and student members shall be appointed for staggered three-year terms but shall continue as members until their successors are appointed. Two of the faculty members shall be selected by the Senior Vice President for Research from a list of at least four candidates provided by the Faculty Senate. Any member shall cease to be eligible for membership and shall cease to serve the Committee upon termination of his or her respective relationship with the University or the ULRF. The Committee may consult with others as it sees fit; however, the University Counsel or his or her designee shall act as legal counsel to the Committee. All members of the Committee shall execute confidentiality agreements to ensure that all information concerning Intellectual Property that is disclosed to the Committee is held confidential until protected or made public.
- a. The Chairperson shall convene a special meeting of the Committee within twenty (20) days upon written request from any two or more Committee members to discuss matters related to this Policy.

b. Duties. The Committee shall:

- Periodically review for the President of the University all activities of the Technology Director and shall issue an annual report to the President on its activities and the status of the University's Intellectual Property holdings;
- Review and evaluate procedures to encourage the development and commercialization of the University's Intellectual Property;
- Review this policy every five years for necessary revision; and
- Review disputes between the Creator or appeals by faculty, staff, other employees, or students subject to this Policy and recommend resolution. The Committee shall convene a meeting within thirty (30) days of receipt of a dispute or appeal and shall recommend resolution to the Senior Vice President for Research within sixty (60) days thereafter.

Innovation Program Structure at UofL

Research

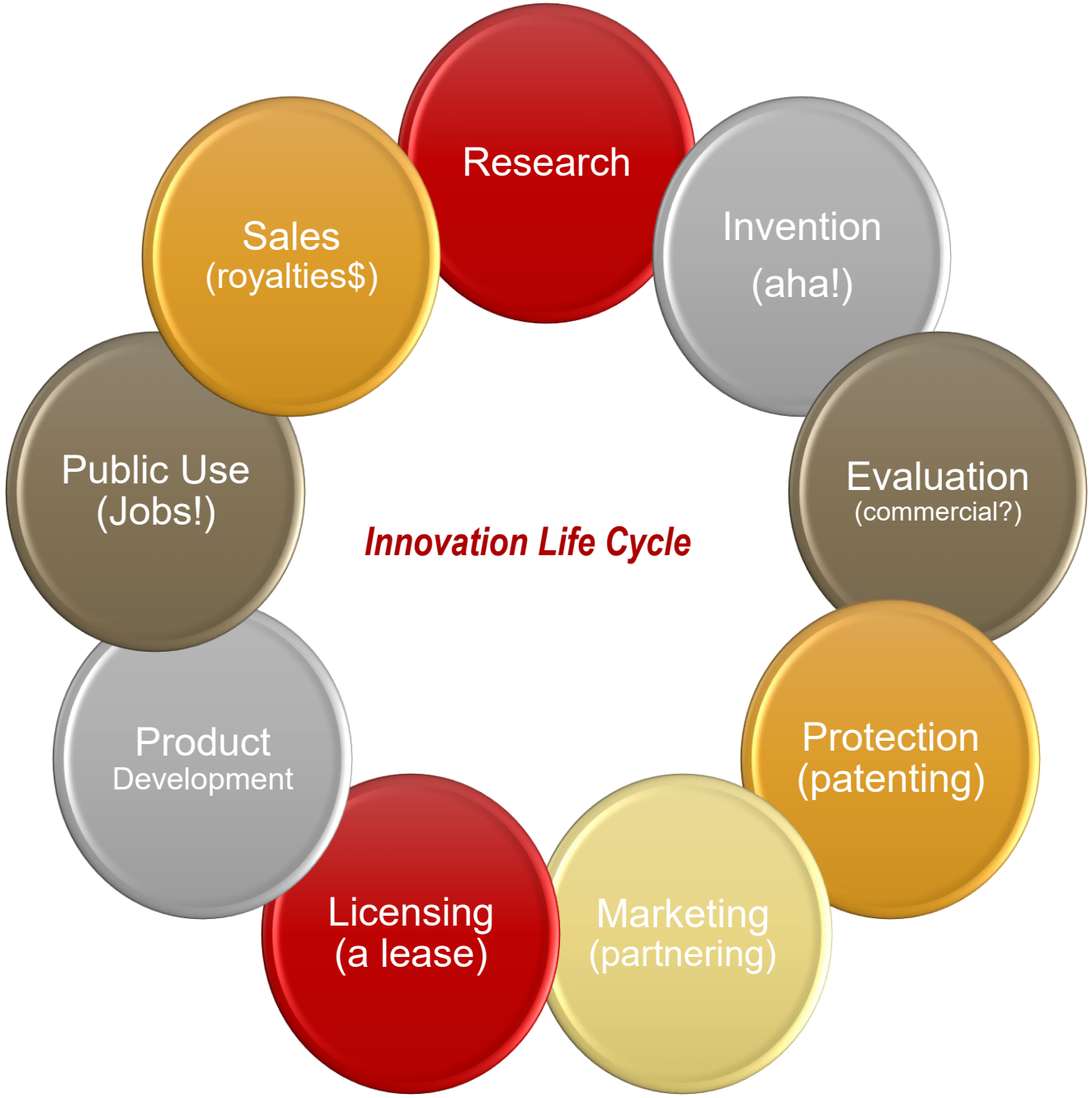
- SPA or Sponsored Programs handles Grants
- Research administration of human & animal subjects (IRB, IACUC)
- Administrative functions like Conflict of Interest and Research Security
- Industry collaborations (MEP and new projects)
- Digital transformation center (recently added)

Innovation

- **Innovation & Commercialization (aka Tech Transfer)**
- New Ventures (aka entrepreneurial activity)

Technology Transfer:

"The process of transferring scientific findings from one organization to another for the purpose of further development and commercialization."



Primer on Patenting Basics

What is Intellectual Property (IP)?

- Creations of the mind (intangible assets)
  - Inventions (product, process, etc.)
  - Literary and artistic works (including software code)
  - Symbols/names/images used in commerce
  - Customer discovery focus

How can IP be protected?

Patent **

- Rights to exclude others from making/using/selling claimed invention for limited term (20 years)

Trademark

- ID's unique source of goods or services; good for as long as registration is maintained (Business holds trademarks for its own business)

Copyright **

- Protects copying of original works ("fixed expression") (for life of author + 70 years)

Trade Secret

- protects as long as secret is held **(NOT at Public Universities)**

****UofL Innovation Office supports Patents and Copyright**

What can be patented?

- Machine
- Article of Manufacture
- Composition of Matter
- Process
  - Medical procedures
  - Manufacturing methods
  - Some Business methods
- Ornamental Designs
- Asexually reproduced plants

Statutory Requirements

1. **New** (In U.S., not made public more than a year prior)
2. **Useful**
3. **Not Obvious** (when viewing what is already publicly exists or is publicly known as of the filing date).

What does a patent grant you?

Rights of a Patent Owner:

- The ability to **exclude** others from:

  Making, Using, Selling,
  Importing, or Offering to Sell
  the ***CLAIMED*** invention for ~20 years from the filing date.

- **Jurisdictional**: Only have protection in the country with the patent.

What does a patent NOT grant you?

However… a patent does not give the patentee a right to practice the patented invention, and it does not grant a right to practice the related patented inventions of others*.

*Patent rights do not include *Freedom-to-operate*.

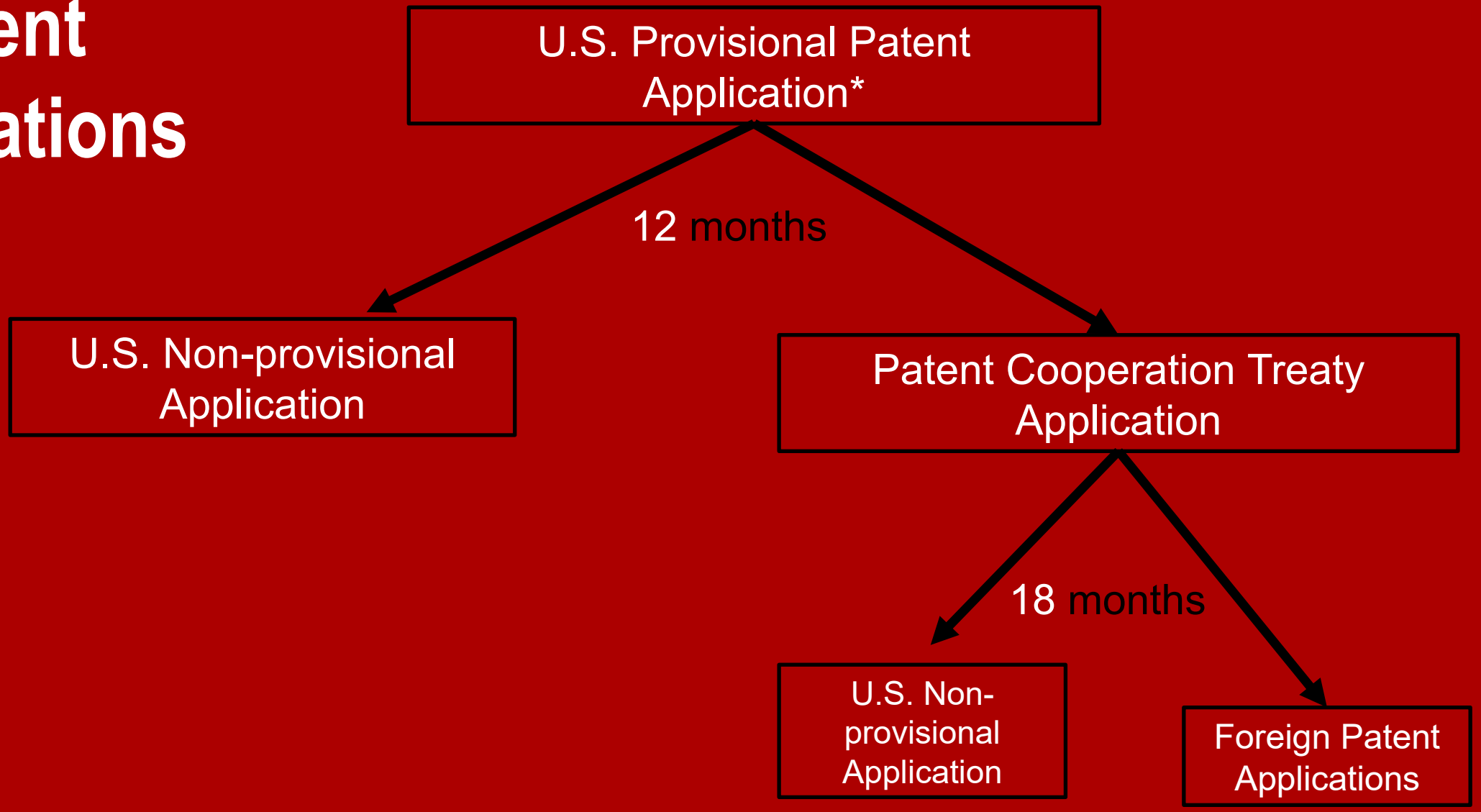
Anatomy of a Patent

A Patent Claim

This is “the invention”

Preamble and transitional phrase	A writing instrument for making a mark on a writing surface, the writing instrument comprising:
Element A	an elongate protective sheath with a central cavity extending along a length of the elongate protective sheath;
Element B	a solid material disposed within the central cavity so that a person can grip the protective sheath and guide a tip of the solid material extending out of a first distal end of the elongate protective sheath to make the mark on the writing surface; and
Element C	an eraser disposed adjacent to a second distal portion of the elongate protective sheath opposite the first distal end.

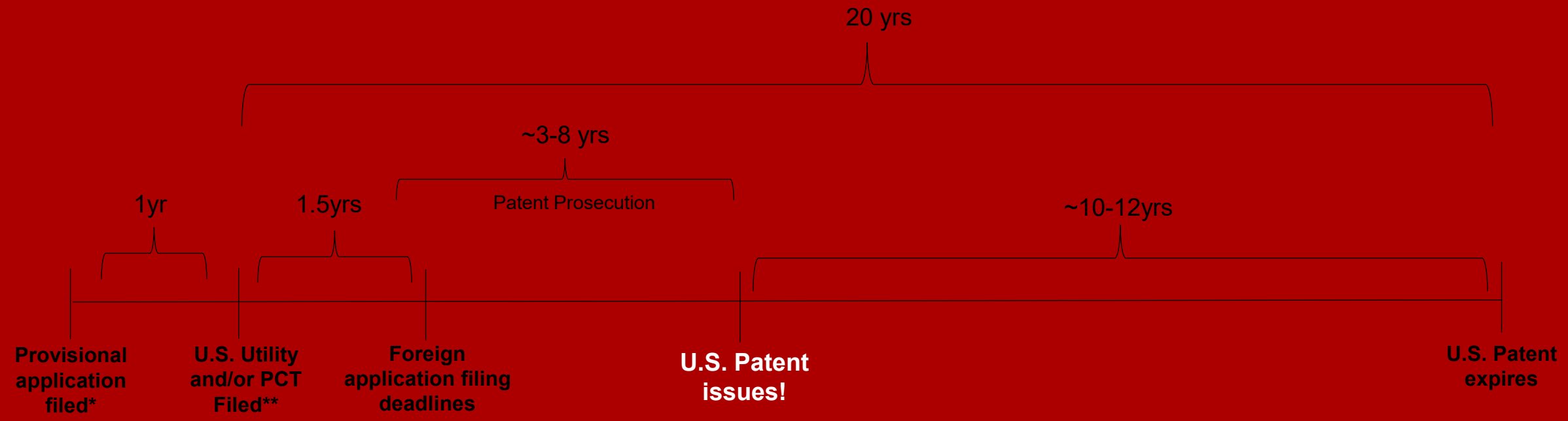
Patent Applications



*Secures Filing Date

Patents take some time to prosecute

It may be up to four years before an application is even reviewed by a patent examiner.



*The first filing may be a provisional patent application

Cost/Benefit Considerations

- Pursuing a Patent is typically EXPENSIVE
  - A U.S. utility patent application may cost upwards of $10k-$20k to draft and file, and another $10k+ to get issued.
  - Individual foreign applications cost an additional $5k-$15k to file, plus substantial prosecution and maintenance fees

Total $$ = Tens of thousands *for U.S. only* (~$50k)
Hundreds of thousands for foreign (~$250k)

Who makes discoveries?

Inventors! And it is a legal definition

- By law, an inventor must contribute to the conception of the idea of at least one claim that is filed with a patent application.
- If there are several claims, an inventor need only contribute to one of those claims to be named.
- Inventorship focuses on the claimed invention, not on the body of the patent application.
- Keep in mind that if invention claims that are specific to "Inventor A" are ultimately not allowed, "Inventor A" would no longer be considered an inventor on the patent.
- Regardless of how brilliant or helpful someone's related idea may be, if that idea or contribution is not directed to the invention as it is being claimed in the patent application, that person is not an inventor.
- Egos can get in the way of listening.

Introduce Policy Update

- Click Here for Our Current Policy – from 2005

Issues:

- Difficult to read
- Outdated practices
- Mixture of policy and day to day procedures

Goals in Policy Update:

- Make it more streamlined so it can be read and understood
- Update practices (revenue distribution & start-up policy)
- Limit to policy only and pull out procedures to other documents

Set meeting schedule for year

It takes a village:

Contact UofL's Innovation Team

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Market Potential is KEY

Just because the invention is patentable doesn't mean anyone will buy the product…

- Commercial potential of the technology?
- Product from the technology?
- Market need? Target market?
- Substitute products?
- Barriers to entry into the market?
- Better, faster, cheaper.