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Greenberg Traurig – LLP (Patent Counsel)
Office of Innovation and Entrepreneurship
“A one-stop shop for technology development, protection and commercialization”
MISSION

AUTM Tech Transfer Video

OIE
Structure and Functions of the new Office of Innovation and Entrepreneurship

- Provost

- Office of Innovation and Entrepreneurship
  - Vice Provost
    - Education Integration of I&E in the Curriculum
    - Faculty /Students Entrepreneurship Support
    - Technology Licensing, Spin offs
Today's Lesson

Class, today's lesson on sharing has been canceled. It will be replaced by a lesson called "Protecting Intellectual Property."
IP in the News
What is IP?

- Patents
- Copyrights
- Trademarks
- Trade Secrets

Should we publish or protect?
NEW PRODUCT INTRODUCTION

PATENTS
- Shape of chair
- Materials in chair
- Computerized back stress relief
- Method of assembly

COPYRIGHTS
- Chair marketing literature
- Chair design CAD
- Chair stress relief software

TRADE SECRETS
- Metal brazing temperature

TRADEMARKS

Chair Model No. 042940
Stress reliever ®
Does it Pass These Requirements?

**Useful**
- Can it be used?
- (It does not have to be better)

**New**
- Was it ever done before in its entirety? (Search! Search! Search)

**Non-obvious**
- Is it an obvious variation of prior art?
Patent Value Test

- Does it pass the “So What Test”?
- Must develop a Value Proposition
- Clearly articulating (Layman terms)
  - Value e.g. reduce cost
  - Benefit e.g. faster, more efficient
Critical elements of a patent

- Specifications
- Drawings
- Preferred Embodiment
- Claims
- Within 1 year of publication
- Within 1 year of public use
- Within 1 year from an “offer to sell”

IF “ready for patenting;” i.e.,

1. Reduced to practice, OR
2. Described sufficiently to allow a person skilled in the art to practice the invention

Time Restraints (For filing a Patent)
IP/Patent Process
Stevens
## How much does a US Patent Cost?

<table>
<thead>
<tr>
<th>USPTO - Basic Fees</th>
<th>Avg. Approx.</th>
</tr>
</thead>
<tbody>
<tr>
<td>Filing/Basic National Fee</td>
<td>$1,000</td>
</tr>
<tr>
<td>Claims</td>
<td>500</td>
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<tr>
<td>Examination</td>
<td>500</td>
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<tr>
<td>Issue Fee</td>
<td>1,500</td>
</tr>
<tr>
<td>Appeal Fees/Office Actions</td>
<td>4,000</td>
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<tr>
<td>Maintenance</td>
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<tr>
<td>3 Year</td>
<td>1,000</td>
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<tr>
<td>7 Year</td>
<td>2,500</td>
</tr>
<tr>
<td>11 Year</td>
<td>4,000</td>
</tr>
<tr>
<td><strong>Attorney Fees – Prep Appl &amp; Prosecution</strong></td>
<td>10,000</td>
</tr>
<tr>
<td><strong>Total</strong></td>
<td><strong>$25,000</strong></td>
</tr>
</tbody>
</table>
What’s New in the USPTO:

- Effective Date: March 16, 2013.

“First to File”

Vs.

“First to Invent”

America Invents Act
What’s New: Details, Details,

1. “First-Inventor-to-File” system
   - Effective Date: March 16, 2013.

3. Post-grant procedure – includes post-grant review request that may be filed with PTO within 9 months of patent’s issuance, followed by *inter partes* reexamination request that may be filed after this timeframe.
   - Effective Date: March 16, 2013.

5. Third parties may submit prior art patents or publications, PTO or court statements by the applicant to patent examiner during pendency of patent application.
   - Effective date: One year after enactment of the Act, and applicable to any patent application, regardless of its filing date.

4. Prior Commercial Use Defense – prior user rights would apply to any technology, with a showing of prior commercial activity.
   - Effective date: Will apply to any patent issued on or after the date of the enactment.

5. Allows assignees (e.g., universities) to file patent applications and eliminates the current requirement that an individual inventor be listed as the applicant.
   - Effective Date: Applies to applications filed on or after September 16, 2012.

7. Eliminates “failure to disclose the best mode” as a basis for invalidity of an issued patent.
   - Effective Date: Applies to cases commenced on or after September 16, 2011.
- Inventions made by student(s) **belong** to the student(s)

  Exceptions:
  - Employed by Stevens
  - Research Project

- Office of Innovation & Entrepreneurship (OIE) will assist/support student in seeking patent protection
  - Documentation & Patent Attorney
  - Preparation Invention Disclosure Form

- Student may assign invention to Stevens (SIT Policy)
  - Stevens Patent Committee – Accept / Reject
  - Stevens pays for patent prosecution
  - Inventors/students receive 33% net royalties

**SIT Patent Policy/ Process Student Inventions**
Stevens Invention Disclosure Form

http://www.stevens.edu/entrepreneurship/guide/forms.html

**Definition** – a written report describing an invention in sufficient detail to permit the patentability and commercial prospects of the invention to be evaluated

- Inventor Name(s)
- Date
- Title of Invention
- General Description of Invention
- Utility – useful purpose
- Novelty – difference from known uses
- Advantages
- Limitations
- Proof of Concept – experimental verification
- Prototypes/Samples
- Publications
- References
- Sponsorship
- Possible means of commercialization – markets & applications
- Potential partners / licensees
- Signatures
• Google Patent Search
  http://www.google.com/patents

• United States Patent & Trademark Office - USPTO
  http://patft.uspto.gov/

• Literature and Patent Search
  http://www.scopus.com/home.url

• Frost & Sullivan – Market Research
  http://www.frost.com/prod/servlet/frost-home.pag

Patent Search
Disclosures to Patent Committee versus Approved for Prosecution

*Approved for Filing - AUTM Trend ~60%

- FY09: 20
- FY10: 24
- FY11: 15
- FY12: 14
- FY13: 19
- FY14: 21
Issued Patents, FY 2009 - 2014
IP Portfolio - Cumulative

Patents Statistics: Total IP 120, Items (49 Issued/71 Pending)
Top 10 Companies
2012 US Patent Recipients
Top 10 Universities

2011 US Patent Recipients

1. University of California System
2. Stanford University
3. Massachusetts Institute of Technology
4. University of Wisconsin-Madison
5. University of Texas System
6. California Institute of Technology
7. University of Illinois System
8. University of Michigan System
9. Cornell University
10. Georgia Institute of Technology
SIT – IP Deals

1) Bio-medical devices
   • Back pain diagnosis
   • Endotrachial & Capnography
   • Spinal/Prosthesis/Goniometers
   • Vein Locators
   • In-Vitro Diagnostics
   • Multi-Lumen Thoracic Catheters
2) Underwater Acoustic Sensors
3) Multi-Band Radio Communication
4) Mass Spectronomy
5) AntiMicrobial Coatings
SIT – IP Deals

6) Cancer Inhibitors
7) Flexible Superconductors with Graphene
8) Nano Microgels / Drug Delivery
9) Mathematical Interface / Problem Solving Solutions
10) Detecting Text Deception
Goals

1. Identify **protected technologies** that have commercial potential
2. Find a source of **money** to create a company or license the technology
3. Find the **right people** to develop the technology commercially
4. Balance **risk/reward** to make the right connections and generate revenue and respect!
1. Invention

2. Document & Disclose

3. Technical Evaluation

4. Business Assessment

5. Competitive Eval

Invention starts everything!
Oliver Wendell Holmes Jr.

“ I wouldn’t give a fig for the simplicity on this side of complexity, but I would give my right arm for the simplicity on the other side”

Thomas Alva Edison

“to invent, you need a good imagination and a pile of junk”

Curtis Carlson - CEO SRI International

“innovation that happens from the bottom up tends to be chaotic but smart. Innovation that happens from the top down tends to be orderly but dumb”
Questions?

End.