

The background features a red grid of small dots with several larger dots connected by thin red lines, forming a network pattern. This is overlaid on a large, semi-transparent red circle. The text is centered within this circle.

# UH Technology Bridge

Office of Technology Transfer and Innovation

# Introductions



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Director of Technology Commercialization  
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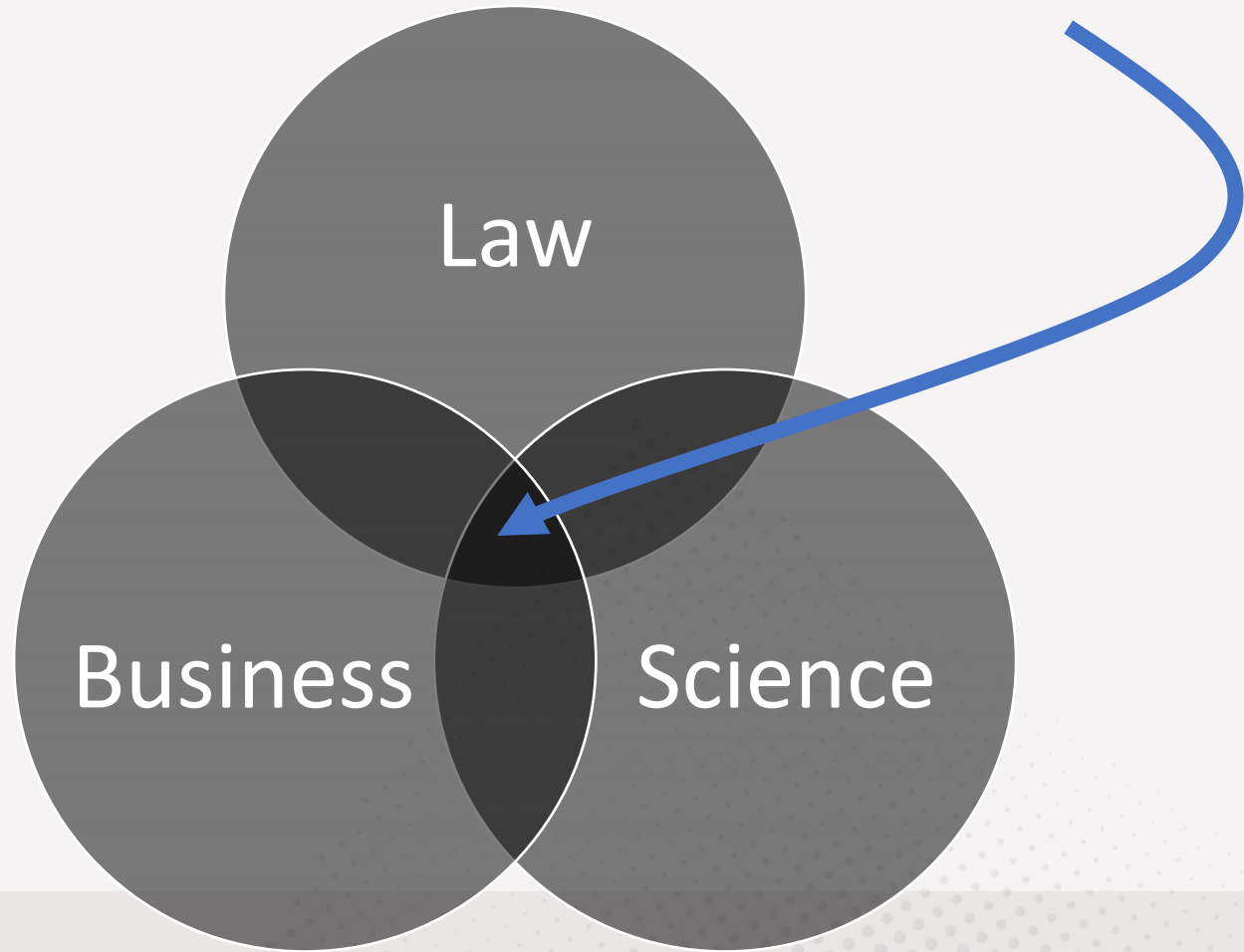
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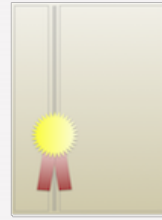
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# University Technology Transfer



# University Technology Transfer



**Intellectual  
Property  
Management**



**Entrepreneurship  
Innovation**



**Technology  
Acceleration**

# Types of Intellectual Property

# Types of Intellectual Property

## Patent

Protects ideas, concepts, inventions, function, compositions of matter, and design

## Copyright

Protects expression and communication of ideas reduced to a tangible form

## Trademark

Protects identifying symbols, used in trade to indicate origin or distinguish products and services

## Trade Secret

Protects proprietary material which, if kept secret provides a commercial advantage to the owner

## Right of Publicity

Protects an individual's image and name from being misappropriated

# Types of Intellectual Property

Type	<b>Patent</b>
Advantage	Clear Protection Position
Disadvantage	Costly

- Provides a monopoly on the invention that is claimed in the patent
  - Utility patent 20 year monopoly
  - Design patent 14 year monopoly
  - Plant patent 20 year monopoly
- You don't have to practice your invention, but you can stop others from practicing it
- Requirements for Patentability
  - Useful
  - Novel
  - Non-Obvious

# Types of Intellectual Property

Type	<b>Patent</b>
Advantage	Clear Protection Position
Disadvantage	Costly

- What is Patentable?
  - Composition of Matter
  - Machine/Device
  - Method/Process
  - Item of Manufacture
  - An Improvement Technology
- What is NOT Patentable?
  - Laws of nature
  - Physical phenomena
  - Abstract ideas
  - Products of nature that are not altered by human intervention



# Types of Intellectual Property

Type	<b>Copyright</b>
Advantage	Cheap to Register & Maintain
Disadvantage	Potentially Difficult to Enforce

- Protection of an original work of authorship fixed in a tangible medium
- Protects the expression of the idea, not the idea itself
- Copyrights are a SET of rights:
  - Reproduction
  - Distribution
  - Adaptation
  - Performance
  - Display

# Types of Intellectual Property

Type	<b>Copyright</b>
Advantage	Cheap to Register & Maintain
Disadvantage	Potentially Difficult to Enforce

- Copyrightable works include the following categories:
  - literary works
  - musical works, including any accompanying words
  - dramatic works, including any accompanying music
  - pantomimes and choreographic works
  - pictorial, graphic, and sculptural works
  - motion pictures and other audiovisual works
  - sound recordings
  - architectural works

# Types of Intellectual Property

Type	<b>Copyright</b>
Advantage	Cheap to Register & Maintain
Disadvantage	Potentially Difficult to Enforce

- Copyright Considerations
  - Patentability
  - Ownership
  - Coding Language
  - Open Source
  - Executables

# Types of Intellectual Property

Type	<b>Trademark</b>
Advantage	Never Expires
Disadvantage	Less Valuable at Early Stage

- Word, symbol, name, device, color or combination thereof that identify the origin of goods or services
  - Trademarks – identify goods
  - Servicemarks – identify services
  - Trade dress – identifies the look of the brand
- Designed to protect the CONSUMER and prevent confusion in the marketplace
- Most likely are only going to be part of an agreement that includes other intellectual property (ex. patents or copyrights)
- Register the trademark before starting any marketing activity


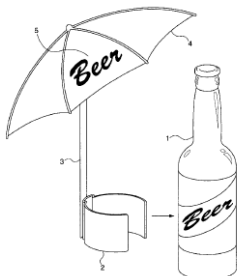
# Types of Intellectual Property

Type	<b>Trade Secret</b>
Advantage	Competitive Market Advantage
Disadvantage	Limited Protection

- Information that is generally not known and is not discoverable, which, if kept secret, provides an economic advantage to the owner
- Examples:
  - Formula for KFC chicken
  - Chanel No. 5
  - Coke Recipe
  - Software distributed in Object Code form
  - Customer lists
  - Formulas
  - Business plans
  - University, as a public institution, cannot have these – we must disclose information
- May be the only IP available
- Monetization is difficult unless you can tie it to other IP

# Protection of Intellectual Property

# Patents

 US006637447B2																																																													
(12) <b>United States Patent</b> <b>McMullin et al.</b>	(10) Patent No.: <b>US 6,637,447 B2</b> (45) Date of Patent: <b>Oct. 28, 2003</b>																																																												
(54) <b>BEERBRELLA</b> (76) Inventors: <b>Macon Scott McMullin</b> , #7 Ridgecrop St., St. Louis, MO (US) 63117; <b>Robert Platt Bell</b> , 8033 Washington Rd., Alexandria, VA (US) 22308; <b>Mark Andrew See</b> , 8033 Washington Rd., Alexandria, VA (US) 22308	<table border="0"> <tr><td>5,058,757 A</td><td>*</td><td>10/1991</td><td>Proa</td><td>.....</td><td>220/739</td></tr> <tr><td>5,089,712 A</td><td>*</td><td>2/1992</td><td>Clark</td><td>.....</td><td>108/561,2</td></tr> <tr><td>5,115,539 A</td><td>*</td><td>5/1992</td><td>Pfister</td><td>.....</td><td>220/705</td></tr> <tr><td>5,186,196 A</td><td>*</td><td>2/1993</td><td>Gorka et al.</td><td>.....</td><td>135/16</td></tr> <tr><td>5,365,966 A</td><td>*</td><td>11/1994</td><td>McLaren</td><td>.....</td><td>135/16</td></tr> <tr><td>5,366,615 A</td><td>*</td><td>8/1995</td><td>Bonner</td><td>.....</td><td>135/16</td></tr> <tr><td>D361,018 S</td><td>*</td><td>8/1995</td><td>Drape et al.</td><td>.....</td><td>D78/19</td></tr> <tr><td>5,544,283 A</td><td>*</td><td>8/1996</td><td>Caughlan</td><td>.....</td><td>220/735</td></tr> <tr><td>D394,589 S</td><td>*</td><td>5/1998</td><td>King</td><td>.....</td><td>D77/07</td></tr> <tr><td>5,823,496 A</td><td>*</td><td>10/1998</td><td>Foley et al.</td><td>.....</td><td>248/314</td></tr> </table>	5,058,757 A	*	10/1991	Proa	.....	220/739	5,089,712 A	*	2/1992	Clark	.....	108/561,2	5,115,539 A	*	5/1992	Pfister	.....	220/705	5,186,196 A	*	2/1993	Gorka et al.	.....	135/16	5,365,966 A	*	11/1994	McLaren	.....	135/16	5,366,615 A	*	8/1995	Bonner	.....	135/16	D361,018 S	*	8/1995	Drape et al.	.....	D78/19	5,544,283 A	*	8/1996	Caughlan	.....	220/735	D394,589 S	*	5/1998	King	.....	D77/07	5,823,496 A	*	10/1998	Foley et al.	.....	248/314
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(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 33 days.																																																													
(21) Appl. No.: <b>09/981,966</b> (22) Filed: <b>Oct. 19, 2001</b> (65) <b>Prior Publication Data</b> US 2003/0075208 A1 Apr. 24, 2003 (51) <b>Int. Cl.</b> <sup>7</sup> ..... <b>A45B 11/00</b> , A45B 13/00, A45B 23/00 (52) <b>U.S. Cl.</b> ..... <b>135/16</b> , 220/694; 206/217 (58) <b>Field of Search</b> ..... 135/16; 220/694; 220/703; 215/386; 400; D33/5; 248/519; 534; 231/81; 230/7; 206/217 (50) <b>References Cited</b> <b>U.S. PATENT DOCUMENTS</b> 973,731 A * 10/1910 Watkins 2,199,915 A * 5/1940 Howard 2,556,439 A * 6/1951 Pearson ..... 215/386 4,188,965 A * 2/1980 Moran ..... 135/16 4,638,645 A * 1/1987 Simla ..... 62/457 4,871,141 A * 10/1989 Clee ..... 248/314	* cited by examiner <b>Primary Examiner</b> —Robert Canfield <b>(74) Attorney, Agent, or Firm</b> —Robert Platt Bell (57) <b>ABSTRACT</b> The present invention provides a small umbrella ("Beerbrella") which may be removably attached to a beverage container in order to shade the beverage container from the direct rays of the sun. The apparatus comprises a small umbrella approximately five to seven inches in diameter, although other appropriate sizes may be used within the spirit and scope of the present invention. Suitable advertising and/or logos may be applied to the umbrella surface for promotional purposes. The umbrella may be attached to the beverage container by any one of a number of means, including clip, strap, cap, foam insulator, or as a counter or the like. The umbrella shaft may be provided with a pivot to allow the umbrella to be suitably angled to shield the sun or for aesthetic purposes. In one embodiment, a pivot joint and counterweight may be provided to allow the umbrella to pivot out of the way when the user drinks from the container.																																																												
<b>10 Claims, 5 Drawing Sheets</b>																																																													
																																																													

- Requires full disclosure (enablement) so that someone of ordinary skill in the art could practice it
- 3 main sections
  - a cover page which presents bibliographic information,
  - a specification, which describes the invention and the best way of making or using it, and
  - claims, which define the scope of the invention from which the patent owner has the right to exclude others

# Legal Requirements for Patenting

## The Invention Must Be ALL of the Following:

- Useful
  - the invention has “utility” or has “industrial application”
- Novel
- Non-Obvious
  - to one of ordinary skill, taking into account what was known in the technical field at the time (the “prior art”)



# Statutory Bars to Patenting

## US Applications

- A US patent is barred if any of the following occurs before the application is filed:
  - Invention is patented or described in a printed publication anywhere in the world
    - Unless the publications are made by the inventors, in which case there is a one year grace period whereby the inventors own publications cannot count as prior art against their application
  - Invention is in public use
  - Invention is offered for sale

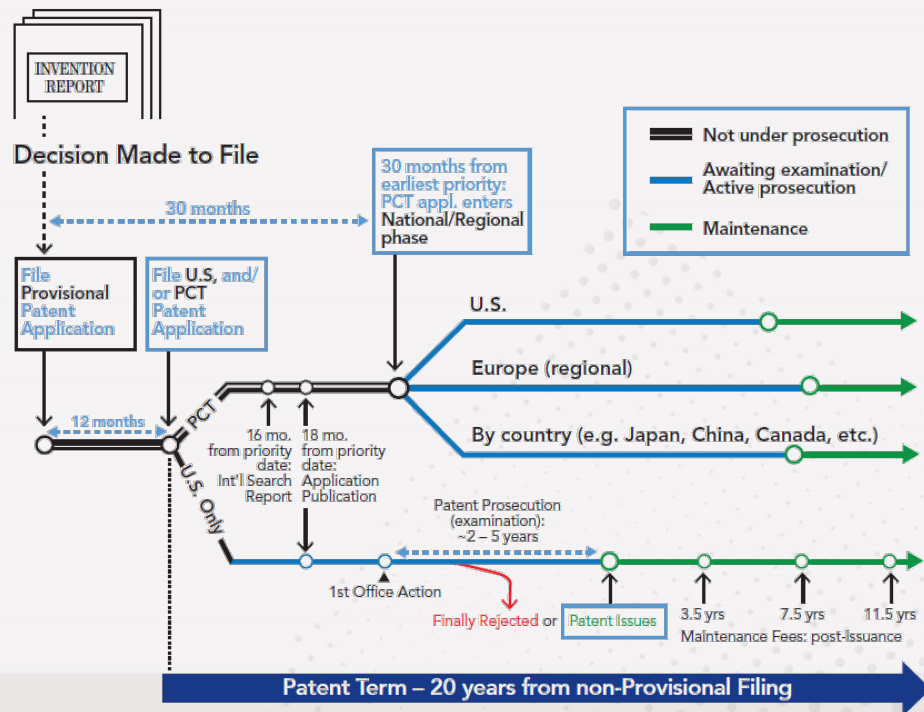
## Foreign Applications

- Require absolute novelty
- Patent application must be filed before ANY enabling public disclosure, public use, or offer for sale

# What Constitutes a Public Disclosure?

- Abstract
  - on-line or in print
- Poster presentation
- Public presentations
  - e.g. thesis defense, conference presentation
- Published and shelved thesis
  - potential art even if nobody has taken it off the shelf
- Manuscript
- Awarded Grants
- Public use
- Offer for sale

# Patent Prosecution Process



# How do you get a copyright?

- Federal Copyright protection is inherent in creation of a work
  - You create it, you get it
  - Marking with © is not required (but is a good idea)
- Federal registration is optional, but required if you are going to sue for copyright infringement
- Registration gets you additional benefits if you sue for infringement (statutory damages and attorney fees)

# How long does a copyright last?

- For new works (post 1978):
  - Personal works = Life of the author + 70 years
  - Works for hire = Lesser of 95 years from publication, or 120 years from creation
- Protections can go back further, but get complicated!

# Myths about Copyright

- If it doesn't have a copyright notice, it's not copyrighted
- If I give credit I don't need permission
- Since I'm only using a small portion of the original work, I don't need permission
- I don't need permission because I'm going to adapt the original work
- If I don't charge for it, it's not a violation
- If it's posted on the internet it's in the public domain
- If you don't defend your copyright you lose it
- If I make up my own stories, but base them on another work, my new work belongs to me.
- I can always obtain permission later
- I can mail myself something to prove the date I copyrighted it

# How do you get a trademark?

- Start using it! <sup>™</sup> (common law mark)
- Federal registration possible <sup>®</sup> (federally registered mark)
- US recognizes rights based upon usage, most other countries base rights upon registration
- Trademark must be used in interstate commerce (or used within 1 year of filing) before it can be federally registered
- As long as you use it, you have it

# How do you lose a trademark?

- Use of a trademark as a verb or a noun to mean a generic version of the product or service
  - Just GOOGLE it...
  - Just TIVO it...
  - Give me a KLEENEX...
- Under U.S. law, genericide is a form of abandonment. A mark will be deemed to be “abandoned” if: (1) its use has been discontinued for three years with intent not to resume such use; or (2) when the mark becomes the generic name for the goods or services on or in connection with which it is used
- Kills a trademark forever – very difficult to recapture
  - escalator, aspirin, granola, etc...



# Protecting Trade Secrets

- Need to be kept under lock and key
- Once out, value is lost
- Can be used as a marketing tool (ex. Coca-Cola)
- Tremendously valuable as long as private!
- Commonly used with software (object code vs. source code)

# Commercialization of Intellectual Property

# Commercialization Options

## Manufacturing & Distribution

- “Self-Publishing”
- Most institutes don’t carry the liability!
- Greatest risk/reward

## Sale or Assignment

- May lose out on ability to conduct additional research
- May lose out on future rights
- Might be the only option in some cases

## Licensing of IP Rights

- Most common institutional commercialization option
- Provides all necessary commercial rights

# Open Source



**open source  
initiative<sup>®</sup>**

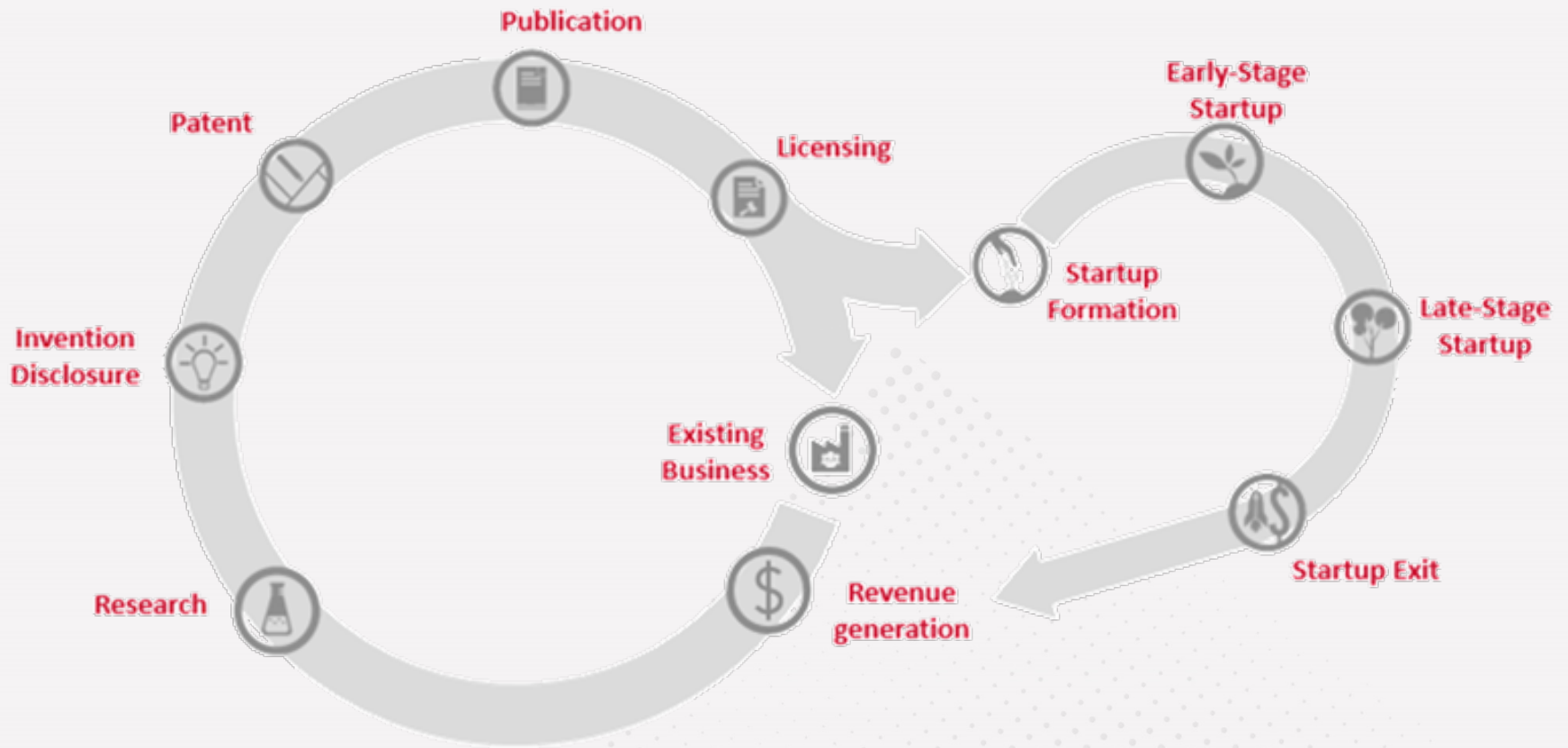
## The Open Source Definition

Open source doesn't just mean access to the source code. The distribution terms of open-source software must comply with the following criteria:

1. Free Redistribution
2. Source Code
3. Derived Works
4. Integrity of The Author's Source Code
5. No Discrimination Against Persons or Groups
6. No Discrimination Against Fields of Endeavor
7. Distribution of License
8. License Must Not Be Specific to a Product
9. License Must Not Restrict Other Software
10. License Must Be Technology-Neutral

No provision of the license may be predicated on any individual technology or style of interface.

# University Commercialization Cycle



# Why do Technology Transfer?

- Academic research and creativity is critical to a nation's innovation and R&D capacity
- The patent system is the vehicle which permits much delivery of the resource to the public
- It is in the public interest to place stewardship of research results in the hands of institutes and small business
- Strong incentive for research collaborations with industry
- Financial support to faculty and institution
- It is often the law

# Technology Assessment

# Technology Assessment

Technology

Market

Team

IP



# Come see us! (virtually ;)

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## UH Technology Bridge

Community ▾ The Park ▾ Technologies ▾ Industry ▾ Houston Innovation ▾

CONNECTING  
PEOPLE + IDEAS

Get Connected