



# Intellectual Property Fundamentals

## INTELLECTUAL PROPERTY PRIMER AND REFERENCE FOR UNIVERSITY RESEARCHERS

### Patent Basics

#### Patent

- Legal monopoly granted by the government
- Negative right—right to prevent others
- One way to protect and register your work (a personal, intangible asset)

#### Bars to Patenting

An invention must be (1) novel (2) non-obvious and (3) useful

Foreign (non-US) patents must meet absolute novelty

You have 1 yr from public disclosure to seek US patent rights

#### Public Disclosure

Communication of enabling information to members of the public

A lot of hypotheticals and potential scenarios  
Be conservative

#### CDA / NDA

#### Confidentiality Non-Disclosure Agreement

Protect you from Public Disclosure  
Typically specify Non-Use of info shared  
May be bilateral

#### Patent Applications Types

- **Provisional**  
Expires in 1 yr, not examined
- **Utility**  
Examined by patent office issued p
- **PCT**  
Can be nationalized in ~120 countries

### Invention Disclosure Process

STEP ONE - Submit an Invention and Technology Disclosure (ITD) form.

Complete as much information as possible on this form, contact OTT (1-4551) w/ questions  
Sign the submitted version, route to PI and dept. chair/dean, mail or deliver to OTT

**STEP TWO - We'll follow up with you, meet and discuss , determine filing, publication, marketing**

**STEP THREE - Determine if there is sufficient reason to pursue a patent** (when: provisional deadline, roll?)

Patent as an economic tool—cost can be considerable \$30-\$50K, potential return

Return of rights to inventor(s)

### Common Considerations

#### University IP policy

Can be found @ [policy.nd.edu](http://policy.nd.edu)  
Inventor royalty sharing  
Definition of University IP

University Inventors assign ownership of their invention to ND

#### Jointly Owned IP

Two or more inventors w/o common assignment

All parties can practice the claims of a patent without accounting to the others

#### Inventorship

Legal definition :: any individual having original, creative thought which expresses a portion of the whole invention (invention is defined by the claims of a patent)

Can invalidate a patent :: incorrect person is named or the right person isn't

Conception of the idea is key

Reduction To Practice is not sufficient

#### Lab Notebooks

Typically property of the university

Good Practices for Notebooks

- Bound and Numbered Pages
- Record chronologically—don't skip or remove
- Use pen (one that doesn't bleed)
- Don't Obliterate
- Date when work was performed
- Document WHY you did something
- Sign and Date
- Have colleague (not co-inventor) Sign and Date

# OFFICE OF TECHNOLOGY TRANSFER

## Functions of the office

Help commercialize ND technologies

Provide proactive outreach to Notre Dame researchers to enhance, protect, and commercialize innovations and to facilitate economic development

Patent, market, and license the University research products

Increase the impact of the research endeavors undertaken at Notre Dame

Provide guidance in matters relating to University IP

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