Disclosing your invention to the University of Cincinnati’s Technology Accelerator for Commercialization (“UCTAC”)

Commercializing University of Cincinnati inventions is a necessary first step toward developing products and services from the basic research conducted on campus. These products and services often produce outcomes like saving lives, improving the quality of life and enhancing productivity and global competitiveness, and fall within one of the core missions of the university.

UCTAC serves to spur innovation and business creation by providing the guidance, education and tools necessary to bring the results of your cutting-edge research to the commercial sector. Among our responsibilities are the following:

- Evaluate new inventions created by our faculty/staff/students to identify promising new devices, technologies, discoveries, etc. (inventions)
- File for patent protection on the most promising inventions
- Foster the formation of startup companies
- Grant licenses to commercial partners
- Provide proof-of-concept funding to advance promising discoveries
- Educate the UC community on commercialization and entrepreneurship (via this tutorial, for instance)

We address here the evaluation of new inventions. Inventions can include results, technical innovations, processes, materials (including chemical compositions and microorganisms), apperati, technology and discoveries, as well as writings and other information in various forms, including computer software.

“Creating a new entity is the work of human transformation, requiring skill, knowledge, and not just effort.”

In accordance with UC policy and Ohio law, all inventions created by UC employees in the course of their employment and/or using substantial UC resources are owned by UC. Moreover, **UCTAC is the only entity legally allowed to manage UC inventions and associated intellectual property on behalf of the university.**

**Why Report Your Invention?**

Under UC policy, all new inventions must be reported to UCTAC, and this is done by completing and submitting an Invention Disclosure Form (“IDF”). The IDF is the important first step in the process of documenting your new invention to UCTAC, as it allows the UCTAC staff and its patent attorneys to make an initial determination of novelty, commercial relevance, patentability, as well as determine whether any obligations exist to the sponsors of your research that led to the invention.

Completing the IDF reduces the invention to writing, identifies the inventors and provides our office with notice of which government funding was used to create your invention, all of which can be important during the patenting process. The IDF is a confidential document, and both you and UCTAC must take steps to ensure ongoing confidentiality.
One important thing to always be aware of is that the ability to file for a patent will be severely limited if you publish your invention beforehand, or otherwise make what’s called a public disclosure before filing your patent application. Such disclosures include, but are not limited to any kind of publication, presentations/seminars that are open to the public, posters, conference abstracts, blog postings or even meetings with colleagues. If the main concept, idea, inventive step, etc. is publicly disclosed in enough detail to allow anyone with ordinary skill in the art to make and use the invention, the right to patent protection has been seriously compromised.

The Process
The IDF boilerplate can be downloaded from the UCTAC website:
http://commercialization.uc.edu/docs/default-source/Forms/idf.pdf?sfvrsn=0

The IDF asks a few critical questions necessary for a rapid, but thorough evaluation:

1) **A title** that identifies the actual invention.
2) **A detailed description.** This will take the bulk of your time when completing the IDF. Here, we ask that you clearly explain what the invention is. In particular, how it works, how it is actually novel, the problem it solves or how discovery came about. Complete this step without the use of scientific/engineering jargon. We require an explanation of the invention in such a way as to be clear to one who is not familiar with it.
3) **All funding and other resources** used in the creation of the invention. This is important because we *always* have obligations to organizations that support your research, and they must be notified, without exception.
4) **Prior Disclosures** will tell us who else, outside of your lab, knows about the invention. We also need to know if there are any upcoming publications, so that we can address that immediately.
5) **UC Inventors.** Every inventor must be identified and must sign the IDF without exception. If you are unsure about who might have invented, list everyone who played a role in the invention/discovery. Later, a patent attorney may be used to verify inventorship, and the matter will be cleared up at that time.
6) Finally, we need to know if any **outside inventors** were involved. They will have rights, too, under United States patent law. We will then contact the home institution(s) or company(ies) of those inventors, and make any arrangements with them.

All UC inventors are required to sign the IDF, so you must print, complete and submit a hard copy to UCTAC. Upon receipt, the IDF will receive a disclosure number and then it will be assigned to a licensing officer who has relevant experience in the general field of the invention.

**Evaluating the Invention**
The assigned licensing officer will typically take up to thirty days to review the IDF and conduct the appropriate background research on the invention, including meeting with you and other inventors. Inventors are urged to keep the licensing officer apprised of any action they are contemplating, especially any publications or other public disclosures that might affect rights in the invention. In addition, you should let your licensing officer know right away if you’ve made any improvements to or new discoveries relating to your original invention. After evaluation, some inventions will not be pursued - it may have been publically disclosed already; it may already exist, or was discovered by
others; there may not be a clear inventive step; it offers just an incremental improvement over what is already in the market; or there may not be a market for the invention. If UCTAC determines that your invention qualifies for further consideration, we will initiate marketing efforts to see if there is an actual commercial need for the invention, and to identify qualified licensee(s). The goal here is to assess commercial interest in the invention. Assuming patentability and commercial viability appear positive, the IDF may be referred to a patent attorney or other outside entity to conduct a prior art search, and render a preliminary opinion on patentability, or to draft and file a patent application.

When we reach a final decision on how to proceed with your invention, you will be notified. If we elect to proceed with the invention, the licensing officer will take you through the possible next steps, as outlined below. However, in the event UCTAC decides not to move forward with your invention, for reasons mentioned above, the rationale for that decision will discussed with you, and we will assist you if you wish to gain ownership of the invention from UC so that you may pursue commercialization independently of the university.

Where do we go From Here? (creating value from your invention)
After having evaluated your invention for its patentability and commercial potential, the UCTAC staff will also make a determination as to its commercial readiness. The invention may or may not be ready to commercialize based on several factors, and there are options on how to proceed.

**Commercial-ready** We have two paths at this point- grant a license to the invention (or the patent rights associated with it) to an existing company, or work directly with you to found a startup company in order to pursue further development leading to commercial success.

- **License** Licenses are the mechanism by which UCTAC partners with a company to allow that company to further develop, and ultimately sell products or services based on your invention. A license may be exclusive, just one company gets a license, or non-exclusive, in which case we license a single invention to multiple companies. Royalties and other income received from licenses are shared with you and the other UC inventors in accordance with UC policy.

- **Startup** Sometimes an invention is too early stage to be desirable to industry, while other times, it may be so out of current industry trends to be disruptive. A startup company may be a viable option of pursuit, provided that you are willing to take a vested interest in working with the startup to develop your invention. UCTAC provides both training and funding (see below) to help make this happen.

**Accelerator Funding**
If your technology fills an unmet need and has a clear path to market, but still requires some additional development, UCTAC can provide translational funding. This can occur in two phases, with phase I offering up to $40,000, and phase II offering up to $75,000. In some cases, where there may be an industry partner willing to fund this research, we will work with UCRI to set up the necessary agreement.

**Not commercial-ready**
Your invention may not fit into the existing commercial space- it is too early in its development, or there is no apparent path to market. Here, a little extra research assessing the relevant market space, can help make your invention commercial-ready. UCTAC will help you apply for funding from I-Corps Ohio to
perform commercial validation work, which provides valuable insight as to whether or not to pursue translational research.

This tutorial is by no means exhaustive. It is intended to provide an overview of one of the important services offered by UCTAC to the UC community. For additional information on UCTAC or on applying for Accelerator funding, please contact our office using the information on this web site.