

Applying for Patent Protection of Faculty Intellectual Property- a Quick Guide for Vanderbilt University

I have a concept or prototype for an invention, biological material, software, or document/content (“matter”) that I think may have commercial potential and should therefore be legally protected as intellectual property. What should I know and what should I do?

Document the conceptualization and development of your “matter” in writing (as in a lab notebook) or some other medium. While generally no longer required in the US, it remains a good idea to date and sign such documentation.

As soon as your matter is developed in conceptual detail and/or actually fleshed out in tangible form (“reduced to practice”), file a Disclosure with the Vanderbilt Center for Technology Transfer and Commercialization (CTTC, <https://cttc.co/inventors/invention-disclosure-resources>). There are 4 types of disclosure forms: for patentable innovations, for software/ apps, for content (written document, music, video, etc.), and for biological materials. If in doubt about whether and what type of disclosure to file just contact CTTC at cttc@vanderbilt.edu. They will be most happy to advise you. It is never too early to contact them. This guide is written mostly with patentable innovations and biological materials in mind, but CTTC can also help you with software/apps and content.

CTTC will work with you to determine if a patent application, copyright application, or other form of protection is appropriate. If so, they will work with you to prepare/submit such applications. There is no expense to you for filing such applications. Other important things to know:

- Should I keep my idea confidential?
 - You can discuss with and present your matter to other VU/VUMC personnel, although they should be aware of the imperative not to broadcast information on the matter beyond the Vanderbilt community.
 - Avoid discussing, publishing, and/or presenting your matter in significant detail to non-VU/VUMC personnel or media (journals, non-VU/VUMC presentations, web sites, dissertations, etc.) before it is protected unless covered by a formal confidentiality agreement. In the case of a Ph.D. dissertation, it is possible to write, defend, and submit the completed dissertation, but place a hold on its public release until a patent application (or an application for some other form of protection) is submitted.
 - Just because you have discussed your matter with someone outside of VU/VUMC does not mean that you cannot file a disclosure with CTTC. In most cases, the level of such discussion will not be an “enabling disclosure”. However, discussion providing key details that would allow someone to replicate your work (an enabling disclosure) *would* be a problem. Public disclosure of “enabling” information may cause forfeiture of rights in most non-U.S. jurisdictions, although there exists a one-year grace period in the U.S.
 - When in doubt, contact CTTC.
- Who are the inventors?
 - The inventor is the person (or persons) who originally conceived the matter and can also include (as co-inventors) those who contribute by conceptualizing the enabling innovations required to “reduce to practice” the overall invention. Disclosures can be co-authored.
 - If a student, other trainee, or staff member was involved in conceptualization of the project, then they should be listed as a co-inventor.
 - It is OK to involve students, other trainees, and staff in development of a protectable matter that you have conceived. Participation in development does not confer co-inventor status. However, the involvement of students or others in development should be reported when you file a disclosure. When relevant, students and postdocs should be made aware that they are working on a project for which the faculty advisor plans to seek IP protection because publication of their results from this project could be delayed until a patent application is filed (see below).
 - If students, trainees, and/or staff are involved in the development of your matter, do not worry that your life will suddenly involve a complicated web of conflict of interest (COI) disclosures and oversight. COI issues will usually be minimal; at least until your matter is either licensed and/or results in formation of a company in which you hold equity.
 - If your matter was co-conceived by you and non-VU personnel (faculty at another university, for example) and/or if your matter has relied on components (reagents, for example) that came to you from outside of the university you can still file a disclosure but should declare all outside involvement.
 - Ultimately CTTC will work with you to determine whether any others beside you merit “inventor” status and/or may have a legal right to a share of commercial revenues. A patent attorney will comprehensively assess all contributions and ensure that the inventor list is correct.

- Will this process interfere with my academic work (grants, papers, talks, etc.)?
 - Once a first patent application has been filed it is OK to submit a paper on your matter for publication. Patents may be able to be filed after submission, but the timeline for filing is compressed, as patent rights outside of the US are no longer available if publication occurs before a patent application is filed.
 - The time period between disclosure and decision about a patent application is often short (a few weeks) and can be expedited if needed. Accordingly, disclosure and applications for protection often do not result in major delays of publications and presentations. However, one possible outcome is that your disclosed project is deemed to be on the path to being viable for a patent application, but not until backed up by additional results that will take time and effort to procure and submit for consideration of CTTC.
 - It is OK if your matter is directly related to research being supported by existing or proposed federal grants. It is the University's responsibility to facilitate commercial development stemming from federally supported research (Bayh-Dole Act), and they are well prepared to assist you with the disclosure of inventions and other matter to funding agencies as a standard component of grants reporting. Federal statutes require universities to protect, commercialize and report to the Government funding agency any inventions made using Government funding.
- Fiscal considerations?
 - The cost of disclosure and subsequent applications for patent or copyright protection is covered by CTTC. All effort, and legal fees associated with marketing, licensing and enforcing intellectual property rights are also university expenses.
 - As the initiator/inventor of protected matter, you are entitled to receive a significant fraction of any income generated by the licensed use, sale or any other transaction involving your matter. Indeed, Vanderbilt has a very generous policy regarding royalties, sharing nearly half of licensing income with the inventors.
- What if the University CTTC Office decides not to file a patent application?
 - Sometimes the university reviews an invention disclosure, but decides not to file a patent application. In this case you are free to pursue intellectual property rights on your own by working with experts outside of the university (a patent law firm, for example). In this case you will have to pay the various fees. There is a Vanderbilt "return of rights policy" for such cases: <http://cttc.co/inventors/policies/vu-return-rights-policy>.
- What if I want to start a company to commercialize my matter?
 - You will need to work out a license to any intellectual property rights with CTTC. To facilitate the process, CTTC has developed a start-up license agreement that they will review with you.
 - CTTC can help with company formation if necessary, and can help identify investors, executives, and advisors that can help the company launch and grow. More information can be found at <http://cttc.co/startup-support>.
 - The Wond'ry (<https://www.vanderbilt.edu/thewondry/>) has a plethora of resources to help build and test new company concepts
 - The Office of Conflict of Interest Management can provide guidance and help build and approve a conflicts management plan to address the time and effort you and (possibly) members of your lab commit to the new company.
- When the invention was developed in part using federal grant funds (e.g., NIH), what does the government have a claim to?
 - The government does not have a claim to revenue, but does have a claim to a free license to the invention for government purposes alone. When CTTC gets a disclosure that indicates government funds have been used, this is reported to the government agency funding the research. There are then many follow ups with the government agency to ensure that CTTC fulfills: (1) issuing a free government license, (2) formally claiming ownership of the invention, (3) reporting on all patenting activities, (4) reporting the decision not to pursue patenting, and (5) reporting all licensing efforts and all revenues that Vanderbilt receives. These government compliance obligations are handled by CTTC.
 - For the most part, government reporting falls to CTTC (point above), where CTTC reporting needs to match whatever the inventor happens to report on his/her progress reports and closeout reports to the agency funders. It is no more complicated for the inventors to file a patent for an invention that was government funded – it is just critically important for CTTC to add a sentence acknowledging government sponsorship of the work at the beginning of the patent.