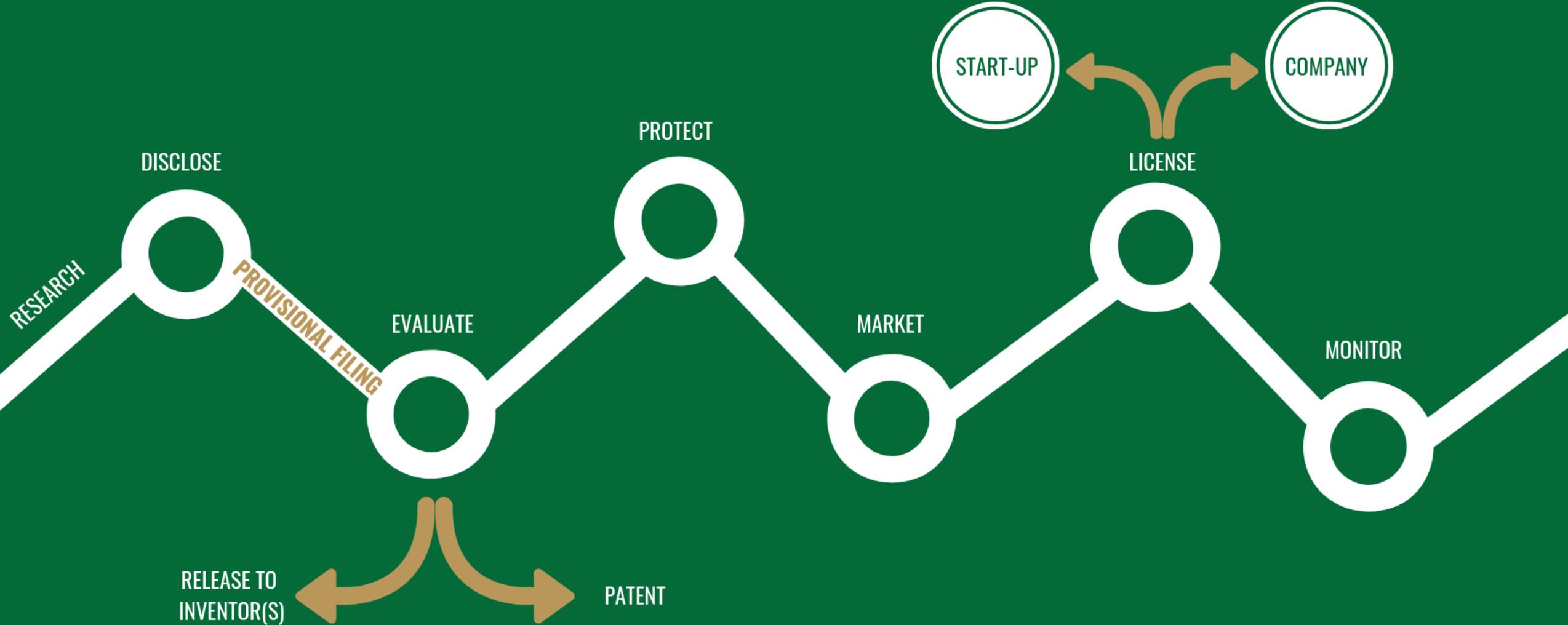


# **INVENTOR'S GUIDE TO COMMERCIALIZATION**

**OFFICE OF RESEARCH COMMERCIALIZATION  
AND DEVELOPMENT**



# INTELLECTUAL PROPERTY PROCESS





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# General Invention and Patent Questions

## What can be patented?

In the United States, a new composition, tool, machine, system, or process is patentable if it is:

- Novel (new)
- Useful (solves a technical problem), and
- Nonobvious (should not be a minor or routine change)

An idea or discovery cannot be patented if it was previously known, sold, or used by others or by the inventors themselves. The idea or discovery cannot be obvious to a person with ordinary skill in the area of technology related to the invention. Abstract ideas, laws of nature, or physical phenomena cannot be patented. In addition, a patent application must describe the invention in explicit and sufficient detail to allow someone to reproduce the invention without undue experimentation.

Final patentability decisions are made by the United States Patent and Trademark Office and foreign patent offices as applicable. If you are unsure whether you have a potentially patentable invention, contact us.

# General Invention and Patent Questions

When should I contact the Office of Research Commercialization and Development [ORCD] about an invention?

Please Contact us whenever you have questions about disclosing or protecting intellectual property (it's better to be too early than too late).

For example, when:

- You wonder if your idea or discovery is intellectual property that should be disclosed to the University or a project sponsor.
- You have an idea for a new product or service that fills an unmet or underserved market need with potential for substantial revenue.
- You have a working prototype of your idea.
- You are planning to or already did disseminate your research results in a grant proposal, publication, poster presentation, dissertation, or even a casual conversation.
- Your research has federal funding or is sponsored by industry, and may have resulted in intellectual property.
- There may be commercial interest in your discovery or if a company has contacted you to find more about your research.
- You want to send or receive research tools or materials to or from another institution.
- You want to start a company with your idea.

# General Invention and Patent Questions

## What's in it for me?

Introducing new and valuable technology from the University out into the marketplace serves an important role in our society. Often times the best way to do this is through the patent and licensing process. Should the University receive any income for commercializing your invention, the University's patent policy specifies 50% of that income will be shared with the inventor with the rest divided between the inventor's research fund, the inventor's home department, the inventor's college, and the University.

## What happens if the invention has federal funding?

The Bayh-Dole Act allows small businesses, nonprofits, and universities to own inventions that result from federally funded research. In exchange, universities are required to report each disclosed invention to the funding agency.

Since the act was passed in 1980, the number of technologies patented, licensed, and commercialized through University technology transfer offices has grown rapidly. The Act allows the University to use licensing revenues to support patenting and licensing, pursue additional research and education, and provide proceeds to inventors.

## Will the patent process slow down my publication or presentation plans?

It is best to always file a patent application prior to any public disclosure of the new invention such as a paper publication or presentation at a conference. At UNC Charlotte we can often file a new provisional type patent application within 1-2 business days so the patent process should not impact or slow down an inventor's publication plans.

# Invention Ownership Questions

## Who owns my invention and patents?

The University patent policy, as well as UNC Board of Governor's policy, specifies ownership of inventions made by University faculty, staff, and students. In general, the University maintains ownership of inventions made by faculty, staff, and students that involve substantial amounts of University material, equipment, or information not available to the public. The University may also claim ownership of inventions that are created within the scope of the inventor's employment at the University and even during the summer months for 9-month faculty. It is always best to speak with our office in advance if you have questions about invention ownership. For ownership of inventions created under a consulting agreement, please [click here](#).

## What if I don't agree with the university's claim to ownership

University inventors have the option to request a waiver or release of the university's claim to ownership of an invention. The Executive Director for the Office of Research Commercialization and Development will make the first determination of University ownership. Should the inventor disagree with this initial decision, they shall have the opportunity to present their case to the faculty patent committee.

# Sponsored Research, External Collaborations & Consulting Questions

Can a company own inventions created at the University if they are paying for the work?

The UNC Board of Governor's policy specifies that the University (not the company) shall generally own inventions made by University employees, even in the case of sponsored research agreements. The University has worked with 1,000s of companies to facilitate this process and in most instances the University is able to negotiate terms that are satisfactory to the company to allow the sponsored research project to proceed.

What about inventions created during consulting projects?

UNC Charlotte supports faculty who engage with external companies through a consulting or other service roles. External activities resulting in inventions are subject to disclosure requirements specified in the University's [External Professional Activities Policy of Faculty and Other Professional Staff](#) and the University's [Policy on Conflicts of Interest and Commitment](#), as applicable. University employees who provide services to third parties should review and follow the steps outlined in the [Recommendations Regarding Intellectual Property and Consulting](#). Inventions created within an employee's consulting role may be waived by the University and owned by the company in instances where the employee has followed all appropriate steps outlined in the document including disclosing each invention to the University for review and not using University material, resources, or background intellectual property during their consulting work. Decisions about University ownership of inventions shall be determined by the Executive Director for the Office of Research Commercialization and Development in consulting with the faculty patent committee, as appropriate.

# Marketing and Licensing Questions

## How does the University market new technologies?

The University uses several free and paid online databases and technology portals to promote technologies that are available for licensing. Additionally, the Office of Research Commercialization and Development regularly attends industry licensing events to pitch university innovations to industry attendees. Despite these efforts, we have found the most successful way to attract industry collaboration is through our own faculty, staff, and student connections with companies and alumni. A team effort is needed between both the Office of Research Commercialization and Development and our university inventors to achieve successful partnerships and licenses with industry.

## How does the University commercialize new inventions?

The University uses a “licensing” process to license patent and other rights the University holds to a private company. These can either be licenses to a new spin-out company such as a faculty/student created company or licenses an existing company. There are many flavors and ways to structure a license and the Office of Research Commercialization and Development has the expertise and experience to help negotiate a license that both benefits the university and that does not place undue burdens or restrictions on our business partners who are trying to bring this technology forward.