



TEXAS A&M UNIVERSITY

Innovation Partners

Timing and Strategizing Intellectual Property Commercialization

Presented To:

Foundations of Cancer Therapeutics

August 16th, 2022

“Meaning and mystery are inseparable, and neither can exist without the passing of time. Certainty may be instantaneous; doubt requires duration; meaning is born to the two.”

- John Berger

Texas A&M University Innovation Partners

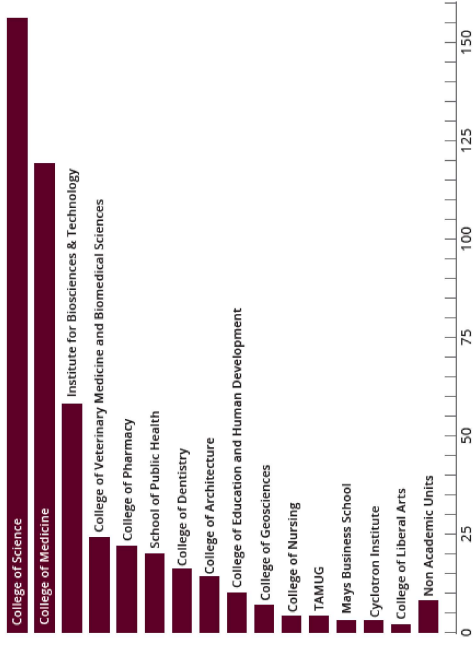
by the numbers

FY 2021

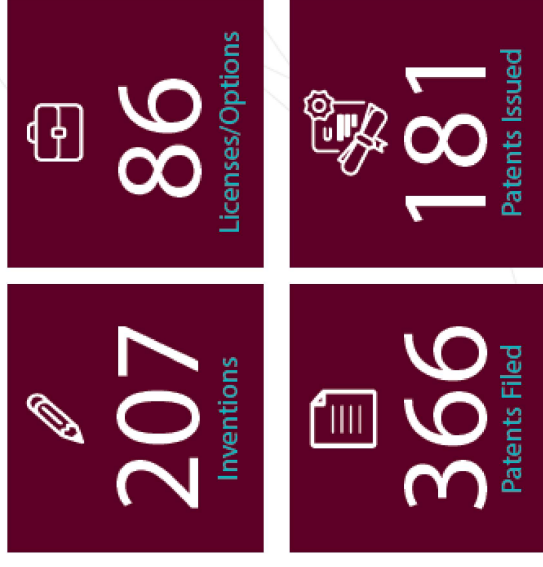
40	20	58	51
Invention Disclosures	Licenses/Options*	Patents Filed	Patents Issued

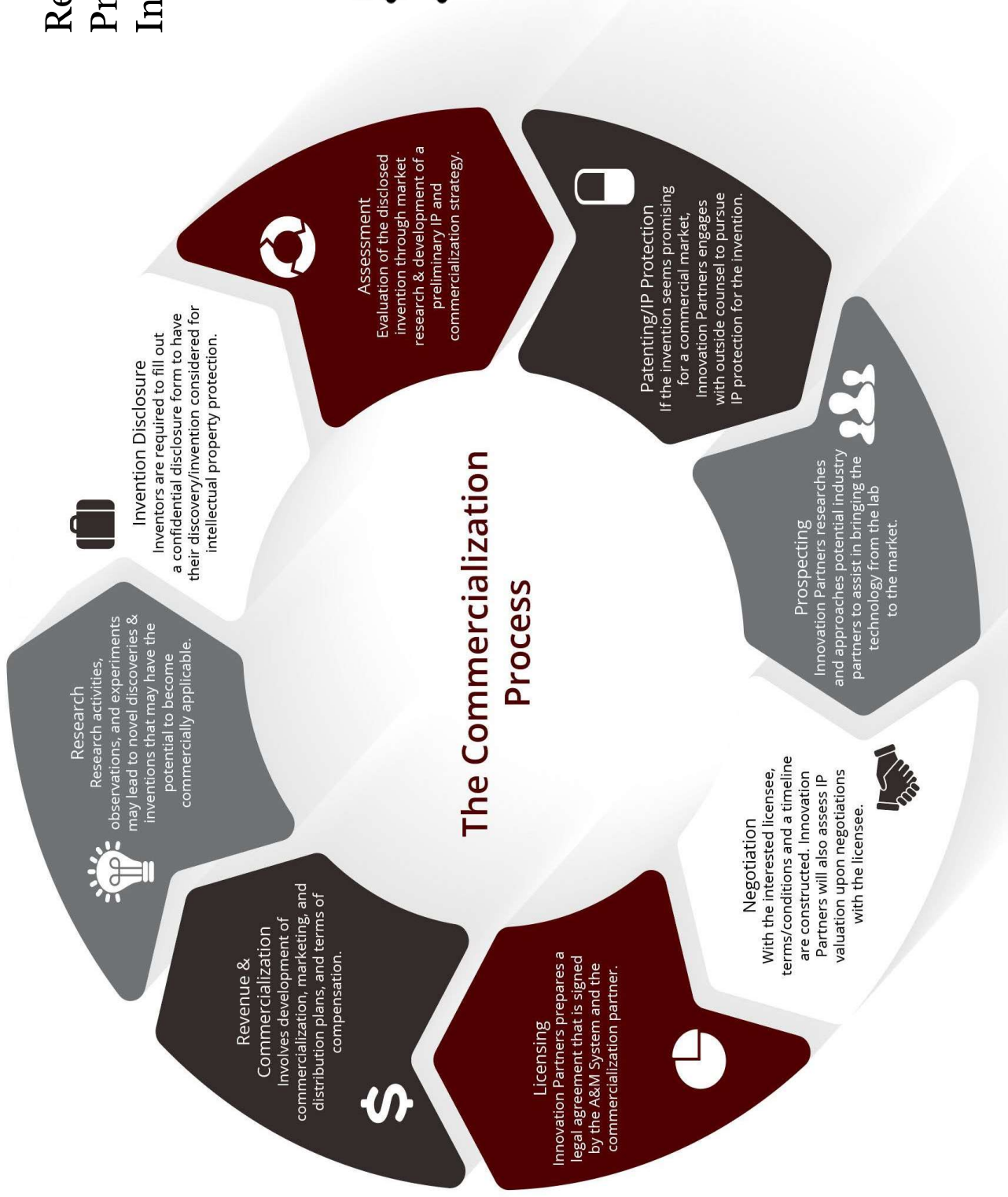
*Includes externally-licensed agreements for IP that is jointly-owned with another institution

Active Technologies by College



Fiscal Years 2017-2021





Research
Pre-disclosure
Invention Disclosure

- Screening
- Assessment

Licens
Licens
Produc
Comm

Benefits of Disclosing Inventions

- Meet obligations of federal/state research grants, and become more competitive at winning future grants (!)
- We can fund patent costs, perform market & patentability analysis, and actively market your invention(s) to industry
- Gain access to unique resources to further your research/comm. efforts (TIF, New venture assistance, etc.)
- Opportunity to start or participate in a new business venture
- Attract industry funding partners
- Bring additional funds to your lab, and College (through royalties)
- Potential to make a positive impact on general public and stimulate the regional/national economy (TLED)
- *Potential to obtain personal financial rewards from the success of inventions in the marketplace*
- Achieve commercial and public recognition

Invention Disclosure

Best time to disclose

- Report the invention to your institution
- Provide internal documentation
- Initiate your TTO's workflow
- Conception of invention – know how invention can be implemented

Scientific Research

Best time to publish

- Publication – to promote and advance research and technology ultimately to improve society
- Novelty – unpublished discoveries
- Sufficient disclosure
 - enough data to allow readers to understand and to follow through with scientific results and progress
- Worldwide

Patent Application

Best time to file a patent application

- Publication – in exchange for the t limited exclusivity known as pater protection
- Novelty – not found in literature, i use, or on sale
- Sufficient disclosure
 - Enabling – enough information to m perform the invention
 - Written description – the breadth o be commensurate with the inventio contribution to the art
- Only enforced country-by-country

Invention

Identification

- Find inventive feature in publishable results
 - What can be practically/technically done or achieved with the results of the research?
- Definition by US patent law – a process, machine, manufacture or composition of matter

Invention

3 key time points

- Conception is complete when the inventor is able to make a disclosure which enables a person of ordinary skill in the art to construct the apparatus without experimental
- Reduce to practice
 - Implementation of the conceived idea into a workable process
- Filing a patent application serves as a public disclosure of the invention. The application describes the invention in enough detail to enable a person of ordinary skill in the art to practice the invention and to construct a device or process that embodies the invention.

Patent

Enablement/sufficiency

- Sufficient information to enable a person to practice the technical matter of the disclosed subject matter
- Considering the common general knowledge in the field
- At the relevant date
- **Must provide**
- A detailed description of at least one way of carrying out the invention
- Any features essential for carrying out the invention

Patent

Written description/support

- To ensure
 - The inventor had possession of the subject matter claimed
 - The scope of patent right to exclude over-reach the scope of its contribution the field of art as described in the specification
- Provide additional explanation of terms or features as mentioned in claims

Patent

Strategies

- Include prophetic examples
- Add data generated during the grace period at conversion
- File declaration – only if it is already credible from the disclosure
- Limit the scope of the claims
- Design the structure and construction of the claims to clearly define the application to clearly define the relevant person of skill in order to avoid misinterpretations of the support

License of Patents

- You can license individual rights
- combination of the rights of a
 - Make, have made, use, sell, have offer to sell, import
- You can license Fields of Use a geographic locations for a patent
 - Field of use for bovine
 - Field of use for municipal solid waste
 - Within the State of Texas

License of Patents

Opportunity assessment

- An opportunity is the res being able to provide an inv or discovery that can so problem
- The value of the opportunity how important the problem the marketplace, and how invention addresses it
- The marketplace may think the importance of the pr differently than you do

License of Patents



Stage of development

- Published patent application
- Issued patent
- De-risk to increase value
- Market readiness
- Upfront patent expenses

License of Patents

Plan

- Providing rights in the invent
- What intellectual property rig
needed?
- How will those rights be obtai
- Who will we partner with?
- How will we find the right
partner(s)?
- What rights will be provided t
partner(s)?

License of Patents

Partners

- Companies can support commercialization through partnerships with academic institutions to:
 - License intellectual property rights
 - Attract investment
 - Sponsor research
 - Enter into teaming agreements with other sources of funding

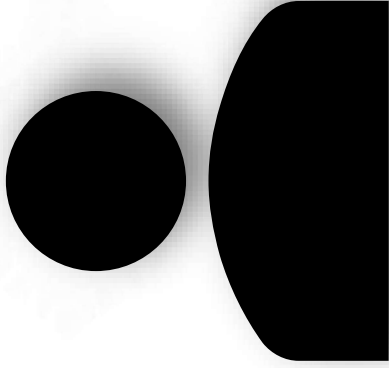
License of Patents

Exclusive/non-exclusive
licensing/option

- Exclusive worldwide field of use are typical of university licenses
- Grants the company all the freedom needed to exploit the technology
- Grants sublicense rights with restrictions
- Technology improvements and inventions may be added to the agreement

Partner With Us

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