



# How do I protect my research that is potentially valuable?

## PRESERVING PATENTABILITY

### Tech Transfer Tips & Tricks

Premature public disclosure of a new invention or discovery can prevent you from obtaining a patent later:

- **Prior to a patent application**, your idea, invention, or discovery is generally not protected – public disclosure now can prevent you from obtaining a patent later.
- **Posting your work online**, through video, blog, social media announcements or explanations, count as public disclosures;
- **Presentations at conferences or in classrooms**, count as public disclosures;
- **Take precautions** and only speak generally about your research, keeping critical components or key steps confidential if you intend to file a patent.
- **Request advising** from the Office of Technology Transfer to learn more about preparing non-confidential presentations, using confidentiality agreements, and filing patent applications.



### REMINDERS & RESOURCES

- **November 16th – Concept Paper deadline** for Limited Submission for the Mountain West Clinical & Translational Research Infrastructure Network (MW CTR-IN) Program Pilot Grant (Single Institution) Phase 2. To access the Limited Submission: <https://infoready.uidaho.edu/#competitionDetail/1827330>
- Watch a short introductory course on **Intellectual Property basics**, from the University of Idaho Techn Transfer Officer (1 hr): <https://event.webinarjam.com/login/k3kl4u9fns2s1sv>
- **Upcoming Technology Commercialization Webinar** SBIR/STTR Phase II: Moving Your Innovative Idea Towards Commercialization. Thursday, November 12th, 2020, at 1pm PDT/ 2pm MDT. Register here: <https://event.webinarjam.com/register/42/gmypkixq>
- **Access a free mentor network** or academic entrepreneurs, get business advising, and get help with an SBIR/STTR application through the ASCEND Hub – an NIH-funded project. Learn more: [http://ascendhub.org/index.php?option=com\\_content&view=article&id=216&Itemid=630](http://ascendhub.org/index.php?option=com_content&view=article&id=216&Itemid=630)

[Click here](#) to request service from the Office of Technology Transfer

**208-885-4550 | [OTT@UIDAHO.EDU](mailto:OTT@UIDAHO.EDU) | [www.uidaho.edu/research](http://www.uidaho.edu/research)**

# ? Learn more about IP and PATENTS



**Tips & Tricks** | VOL. 1.10.2021 |

To subscribe  
email: [ott@uidaho.edu](mailto:ott@uidaho.edu)

**VISIT THE OTT SERVICE PORTAL:** <https://support.uidaho.edu/TDClient/40/Portal/Requests/ServiceDet?ID=789>

An excellent online video series about Intellectual Property and Patents was produced by Bryce Pilz, now the Director of Licensing in the office of Tech Transfer at the University of Michigan. Here are three out of several in his series, in which he discusses some of the basics on Patents.

## Anatomy of a Patent

Bryce demonstrates with the example of the 2005 court ruling in the case “Gillette Company v. Energizer Holdings, Inc.” (Energizer). Gillette sued Energizer, alleging their QUATTRO®, a four-bladed wet-shave safety razor, infringes on certain claims of Gillette’s 1977 patent. Bryce breaks down the significance of each of the actual parts of the Gillette Patent: the patent number, date of issue, the Inventors, the Assignees, the PCT, the name of the Prior Art Examiner, the law firm representing Gillette, the Abstract, the Summary, the drawings and the Claims of the Patent. To watch this video: **Click Here.**

## What are Patent Rights?

The Claims of the Patent” are the most important part of the Patent and absolutely defines one’s rights. The patent owners rights exclude anyone else from making, using, selling or offering to sell any product or service that meets each and every element of this Claim. Bryce explains that although owning a patent allows you to exclude others from using your patented technology, it does not necessarily allow you to use that technology, because there could be overlapping patent rights from earlier issued patents, which need to be investigated first. To watch this video: **Click Here.**

## Public disclosures and what is Prior Art?

The key factor indicating if something is Prior Art, is if the technology has been made publicly available in any way prior to filing the patent application, in which someone with the technical expertise could produce the technology or invention. Generally, a Patent must be new and non-obvious—not an obvious derivative of an existing patent. Bryce discusses the old US patent law description of prior art; the new US patent law description that was passed on March 16, 2013; and the European Patent Convention. To watch this video: **Click Here.**

## REMINDERS & RESOURCES

- **ASCEND Hub Webinar, “Entrepreneurship”**, will be presented by the University of New Mexico, May 27, 1pm PT/2pm MT. **To register for this webinar, click here.**
- **“Bio Digital 2021,”** June 10 & 11, 14-18, 2021. Three good reasons to attend: 1) **CONNECT** with partners to grow your business; 2) **LEARN** about key Educational Pillars at the intersection of science, business, and policy from global thought leaders; 3) **GET A STEP AHEAD** by visiting the Innovation Stage, a new interactive forum that showcases the hottest companies in biotech. Presented by NMBio. **To learn more click here.**



**208-885-4550 | [OTT@UIDAHO.EDU](mailto:OTT@UIDAHO.EDU) | [www.uidaho.edu/research](http://www.uidaho.edu/research)**

# Online **learning** about **Technology Transfer**



**Tips & Tricks** | VOL. 1.9.2021 | To subscribe,  
email: [ott@uidaho.edu](mailto:ott@uidaho.edu)

**VISIT THE OTT SERVICE PORTAL:** <https://support.uidaho.edu/TDClient/40/Portal/Requests/ServiceDet?ID=789>

## **National Academy of Inventors, Courses**

The Intellectual Property (IP) course developed by the Michelson Institute teaches critical knowledge about America's intellectual property protection system and how it can work for you. This online IP course consisting of 12 video modules and 38 lessons. Find the course on Intellectual Property at this link: **Click Here.**

## **Idaho Women's Business Center, Courses**

The Idaho Women's Business Center (IWBC) serves women in Idaho to help them meet their professional and entrepreneurial goals. They have training materials and many online courses to assist women in their small business ventures. See all the Small Business courses at the *IWBC Online Learning Center*: **Click Here.**

## **ASCEND Hub commercialization webinars**

The University of Idaho Office of Technology Transfer is a collaborator on the NIH-funded ASCEND Hub (Accelerating Solutions for Commercialization and Entrepreneurial Development) program, a Regional Technology Transfer Accelerator Hub for the seven Mountain West IDeA States: Alaska, Hawaii, Idaho, Montana, Nevada, New Mexico, and Wyoming. **Click here to access the full webinar series.**

## **REMINDERS & RESOURCES**

- **ASCEND Hub Webinar, "Shedding a Light on Managing Conflicts of Interest,"** April 29, 1pm PT/2pm MT. Ellen Purpus, PhD, will discuss managing real and perceived conflicts to protect students and patients and avoid running afoul of policies, laws, and the court of public opinion. **To register for this webinar, click here.**
- **"StartUp Stories,"** an Office of Technology Transfer speaker series, will interview Dr. Chris Nomura, vice president of the UI Office of Research & Economic Development, Thursday, May 6, 2pmPT/3pm MT. **To join us on Zoom, click here.**



**208-885-4550 | [OTT@UIDAHO.EDU](mailto:OTT@UIDAHO.EDU) | [www.uidaho.edu/research](http://www.uidaho.edu/research)**

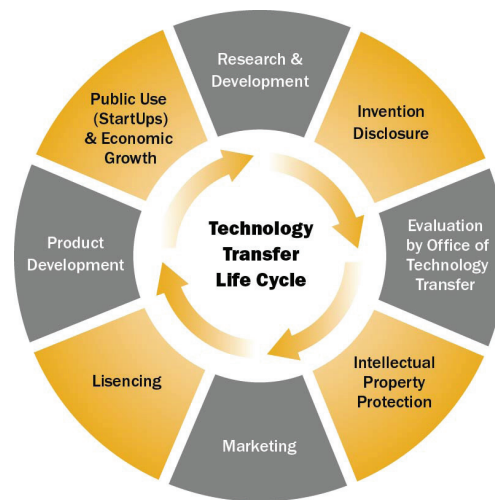
# What is Tech Transfer? And how does it work?



University of Idaho  
Office of Technology Transfer

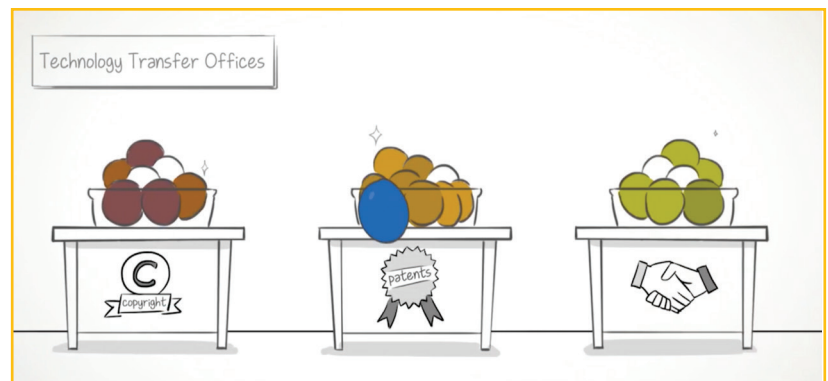
## Tips & Tricks | VOL 1.8 • 2021 | To subscribe, email [ott@uidaho.edu](mailto:ott@uidaho.edu)

**1 Technology Transfer (TT) Life Cycle Diagram** shows the process of commercializing research into patentable technologies. After the research and development phase, an Invention Disclosure is filed. The Tech Transfer office evaluates the discovery's patentability. Once the determination is made, a provisional patent application can be filed. After the patent is issued, the patented technology can be developed, marketed and licensed.



**2 Tech Transfer is a process** of evaluating, protecting and transferring intellectual property from the lab to the marketplace.

**Click here to watch this 1:37 minute video about Tech Transfer.**



**3 Idaho Small Business Development Center (SBDC)** is a university-based organization with six locations in Idaho. It helps small businesses succeed by providing guidance in developing and growing a successful business. SBDC connects higher education with the private business community, and federal, state and local government. **Click here to visit the Idaho SBDC**





# Confidentiality

## Tips & Tricks

VOL 1.7 • 2021

To subscribe to *Tips & Tricks*  
email: [ott@uidaho.edu](mailto:ott@uidaho.edu)

# What is a Non-Disclosure Agreement (NDA)?

In your role at the university you may need to utilize or share confidential information. A Confidentiality Agreement, or a Non-Disclosure Agreement (NDA), is a legally enforceable contract to facilitate the exchange of confidential information between parties.

- 1. Protects confidential information.** The agreement defines how parties are allowed to use confidential information, and any specific restrictions against using the information.
- 2. Defines what is confidential information, versus what can be disclosed.** A general description of the information that the parties wish to share under confidence is included, helping to limit the scope of claimed confidentiality.
- 3. Helps protect patent rights.** Public disclosure is the fastest way to ruin your chances at obtaining a patent for an invention or discovery. UI investigators are strongly advised to contact Office of Technology Transfer (OTT) regarding confidentiality before discussing unpublished research with others.
- 4. Legally binding.** If you receive a NDA from another organization, please be advised that you are not allowed to sign it in your capacity as a member of the faculty or staff. ALL of these agreements must be reviewed, negotiated and signed by the official signatory in OTT.

## REMINDERS & RESOURCES

- The UI Office of Technology Transfer (OTT) Support Service ticketing system. To use this Service you must be logged into your UI account. To find this Service portal, go to the main UI Support portal [web page here](#). Here is the direct link to the OTT Service [page here](#).



University of Idaho  
Office of Technology Transfer

208-885-4550 | [OTT@UIDAHO.EDU](mailto:OTT@UIDAHO.EDU) [www.uidaho.edu/research](http://www.uidaho.edu/research)



# How do I use the NEW OTT TDX Service Portal?

**Tips & Tricks | VOL 1.6 • 2021 |** To subscribe email [ott@uidaho.edu](mailto:ott@uidaho.edu)

The UI Office of Technology Transfer (OTT) has a newly minted Tech Transfer Support Service ticketing system. This online service portal was developed to expedite support for UI Faculty and Staff interested in Patenting their research or innovation. The system enables the necessary preparatory filings of Invention Disclosures, Material Transfer and Confidentiality (Non-disclosure) Agreements.

**1. Request assistance** from the Office of Technology Transfer by using our ticketing system, **Click here.**

**PRO TIP:** You can also look for the golden “Request Service” button throughout the OTT website.

**2. Provide basic information** about your request or project using the online form.

**PRO TIP:** for the fastest possible service, fill in as much detail as possible.

**3. Reply to UI Support Ticket via email** to requests that come from the UI system, “University of Idaho Support” ([tdx-replies@uidaho.edu](mailto:tdx-replies@uidaho.edu)).

Add [tdx-replies@uidaho.edu](mailto:tdx-replies@uidaho.edu) to your Safe Senders list in Outlook to ensure the messages don’t get sent to junk.

**PRO TIP:** follow the link at the bottom of any tdx email to view more detail on a current ticket, or to review past service requests.

**If you have questions,** you may contact: Office of Technology Transfer Email: [ott@uidaho.edu](mailto:ott@uidaho.edu)

## REMINDERS & RESOURCES

- **The UI Office of Technology Transfer (OTT) Support Service ticketing system.** To use this Service you must be logged into your UI account. To find this Service portal, go to the main UI Support portal **web page here.** Here is the direct link to the OTT Service **page here.**
- **ORED Announces New Internal Funding Program: *Operation Resubmission Success*** assists UI faculty members looking to resubmit competitive federal grant proposals that received favorable reviews but were not funded. Funds may be requested to address specific actionable issues raised during the review of a grant proposal by a federal sponsor to enhance the competitiveness of a resubmission. Faculty salary support is not allowed. **Read more here.** Please reach out to Dr. Carly Cummings ([ccummings@uidaho.edu](mailto:ccummings@uidaho.edu)), Director of Research and Faculty Development, with any questions.





# WHAT is an Invention Disclosure?



**Tips & Tricks | VOL 1.5 • 2021 |** To subscribe email [ott@uidaho.edu](mailto:ott@uidaho.edu)

IN 1980, THE BAYH-DOLE ACT WAS PASSED BY CONGRESS to allow universities and businesses to protect, retain ownership of and benefit from intellectual property, developed at their institutions. It also allow universities to retain the right to continue research and development of the idea, as well as to use it to educate their students.

Before that Act, although approximately 28,000 patents were owned by the Federal Government, only 5% had been implemented into practical applications. The Act has enabled universities to protect discoveries, patent and license them to businesses, often in close proximity to the institutions—thereby stimulating the economies of the region around them. Since implementation of the Act, over 4,000 patents have been issued to universities and small businesses.

## **An Invention Disclosure is the first step taken toward filing a patent to protect an innovation or discovery.**

- **Reach out to the Office of Technology Transfer (OTT) to begin an assessment to determine if your innovation could be patentable.** Find the UI Invention Disclosure Form and seek advising on our new TDX Service Request page here:  
<https://support.uidaho.edu/TDClient/40/Portal/Requests/ServiceDet?>
- **File an Invention Disclose early** with as much data as you can—to protect your discovery. Reach out to OTT to begin an assessment to determine whether or not your discovery is patentable.
- **Before making any public announcement** of any kind—whether video, verbal, graphic or written—request advising with OTT to find out how to do that discretely without revealing key patentable information and to protect your discovery with an Invention Disclosure.
- **Invention Disclosures enable inventors to provide timely notification** of their inventions, and to access services from OTT.

## **REMINDERS & RESOURCES**

- **Watch this webinar**, by the Director of the OTT, Jeremy Tamsen, “Filing Invention Disclosures to Identify and Protect IP”: <https://event.webinarjam.com/t/click/q1536i6kb62bq0srllfnhrva7>
- **See real examples of innovations:** <https://autm.net/about-tech-transfer/advocacy/legislation/bayh-dole-act/bayh-dole-innovations>
- **To understand the regulations and implementation** around Invention Disclosures, see more information on the Bayh-Dole Act: <https://autm.net/about-tech-transfer/advocacy/legislation/bayh-dole-act>
- **For more information on Patents** see: <https://www.uidaho.edu/research/faculty/license-your-technology/additional-resources>
- **See the Faculty Handbook 5300** on Copyrights, Protectable Discoveries and other Intellectual Property: [www.webpages.uidaho.edu/fsh/5300.html](http://www.webpages.uidaho.edu/fsh/5300.html)



**University of Idaho**  
Office of Technology Transfer

**208-885-4550 | [OTT@UIDAHO.EDU](mailto:OTT@UIDAHO.EDU)**  
**[www.uidaho.edu/research](http://www.uidaho.edu/research)**



# WHAT IS THE SBIR/STTR PROGRAM?

## WHAT RESOURCES ARE AVAILABLE?

- **The Small Business Research (SBIR) and the Small Business Technology Transfer (STTR) programs** are U.S. federal grant programs that encourage domestic small businesses to engage in federally funded research. Unlike typical federal research awards, domestic small businesses are the only eligible awardees, while a partnering university may contribute as a sub-contractor.
- **There are three phases to the SBIR program grants to U.S. small businesses:** **Phase I**, to evaluate technical merit, feasibility, and commercial potential of the idea (\$50,000 - \$250,000 for 6 months for SBIR, or 1 year for STTR); **Phase II**, to continue the R/R&D efforts initiated in Phase I, and typically only Phase I awardees are eligible for a Phase II award (generally \$750,000 for 2 years), and; **Phase III**, business to pursue commercialization objectives resulting from the Phase I/II R/R&D activities (no R&D funding, but the small business may be eligible to be a sole-source provider to the U.S. Federal Government).
- **To help first-time applicants develop and submit SBIR/STTR proposals**, the U.S. Department of Energy (DOE) is currently offering a “Phase 0” program. Visit DOE SBIR Phase 0 Program: <https://doephase0.dawnbreaker.com/>
- **Universities participate in thousands of projects every year** that directly help small businesses advance to the next stage of commercialization; Universities may contribute to SBIR/STTR projects by receiving funding from the business to complete up to 30% of an SBIR project, or up to 40% of an STTR project.
- **An idea that began within the University or within a small business**, may be funded by a SBIR/STTR grant. The goal is to help a small business to profit from developing and deploying a new product or service. The small business simply must have sufficient commercial rights in the new idea to be developed – whether through an option or license agreement with the university, or through established ownership by the company.
- **Relationships develop between the University and small businesses**, which spur future collaborations on ideas that can result in more funding for the University. Small businesses benefit, and the projects also meet the express R&D needs of the U.S. Federal Government.
- **For help starting a company, see:**  
<https://idahosbdc.org/about-the-idaho-sbdc/>  
<https://www.uidaho.edu/law/academics/practicalskills/clinics/entrepreneurship-law-clinic>
- **To see examples of successful SBIR/STTR projects, visit:** <https://www.sbir.gov/sbirsearch/award/all>



## University of Idaho

Office of  
Technology Transfer

---

### Tips & Tricks

---

VOL 1.4 • 2021

---

To subscribe email [ott@uidaho.edu](mailto:ott@uidaho.edu)

---

### REMINDERS & RESOURCES

- Visit [www.SBIR.gov](http://www.SBIR.gov) for information on the SBIR and STTR programs.
- **Recent SBIR Funding Opportunity Announcements (FOA):**
  - *DOE Small Business Innovation Research (SBIR) Phase I Funding Opportunity–Topic Webinar 11/16*, FOA issued 12/18, Letter of Intent 01/04, Application 02/22. Full info: <https://science.osti.gov/sbir/Funding-Opportunities>
  - *NASA Small Business Innovation Research (SBIR) Phase I Funding Opportunity–Released 11/09*, Application 01/08. Full info: <https://sbir.nasa.gov/solicitations>
  - *DOD SBIR Phase I (21.1) – Pre-Release 12/08*, Open 01/14, Close 02/18. Full info: <https://www.dodsbirsttr.mil/submissions/>

**208-885-4550**  
**OTT@UIDAHO.EDU**  
**[www.uidaho.edu/research](http://www.uidaho.edu/research)**





# How can ASCEND Hub help me commercialize my invention?

**Tips & Tricks | VOL 1.3 • 2020 |** To subscribe email [ott@uidaho.edu](mailto:ott@uidaho.edu)

## What is ASCEND Hub and how can ASCEND Hub can help me:

- ASCEND Hub stands for **Accelerating Solutions for Commercialization and Entrepreneurial Development**
- ASCEND Hub is a **regional technology transfer accelerator hub** for Idaho and six other states
- ASCEND Hub boosts entrepreneurship and commercialization of basic **medical science** to improve human health
- ASCEND Hub gives **free monthly webinars** that help innovators take their ideas from the lab to business and Industry through technology transfer.
- ASCEND Hub provides other **resources** and archived webinars on their website: [ASCENDHub.org](http://ASCENDHub.org).

## REMINDERS & RESOURCES

- **Data Science Research: Personal Health Libraries for Consumers and Patients (R01 Clinical Trial Optional)** \$1 Million award. Notice of Intent for NIH Limited Submission. Internal deadline: 01.12.2021; Agency deadline: 01.19.2021. For more information see this page: <https://infoready.uidaho.edu/#com petitionDetail/1823085>
- **Postbaccalaureate Research Education Program, PREP (R25-Independent Clinical Trial Not Allowed)** \$2 Million award. Notice of Intent for NIH Limited Submission. Internal deadline: 01.13.2021; Agency deadline: 01.27.2021. For more information see this page: <https://infoready.uidaho.edu/#com petitionDetail/1825681>





# PATENTS

## Tips & Tricks

VOL 1.2 • 2020

To subscribe to *Tips & Tricks*  
email: [ott@uidaho.edu](mailto:ott@uidaho.edu)

## What type of inventions are eligible for Patents?

To qualify for a patent, an invention must be a “new and useful”:

- **process**, an act or a series of steps, such as a procedure;
- **machine**, a device used to perform a function, produce a certain effect or produce a certain result;
- **manufacture**, an item produced from other raw or prepared materials;
- **composition of matter**, a composition of two or more substances combined through a mechanical mixture or chemical bonds,

### REMINDERS & RESOURCES

- **Access a free mentor network** for academic entrepreneurs; get business advising, and get help with an SBIR/STTR applications through the ASCEND Hub – an NIH-funded project. Learn more here: [Ascendhub.org](http://Ascendhub.org)
- **NSF Funding Opportunities Explained: NSF CAREER and NSF EPSCoR Track-2, Track-4**, online seminar, November 25th, 2020, 9a.m. PT/10 a.m. MT with Dr. Kelvin Chu, VP, The Implementation Group. Q&A to follow. Email Vanessa Henry ([vanessa@uidaho.edu](mailto:vanessa@uidaho.edu)) at Idaho EPSCoR office to register.



University of Idaho  
Office of Technology Transfer

208-885-4550 | [OTT@UIDAHO.EDU](mailto:OTT@UIDAHO.EDU) [www.uidaho.edu/research](http://www.uidaho.edu/research)