Welcome to Innovation Ecosystem’s first Learn & Connect Event

1. **Tell us about you!**
   - Drop your name, role, and research & clinical/operational affiliations in the chat

2. **Take the quiz!**
   - Use the QR code below or the link in the chat to test your pre-event knowledge
   - Keep the quiz open when you’re done – we’ll come back to it later
The Innovation Ecosystem (IE)

Mission: Facilitate innovation by preparing CHOP faculty & staff via opportunities to strengthen community, build connections, and increase capacity & training around innovation & entrepreneurship.
Series aiming to create training, skill-building, networking, and resource-sharing opportunities for all CHOP faculty & staff.
Today’s topic: The Basics of Intellectual Property in University Settings

CHOP Resources:

- https://www.research.chop.edu/office-of-technology-transfer
- at.chop.edu/research/tech-transfer
- techtransfer@chop.edu

Academic Entrepreneurship content:

- Intellectual Property: Ownership and Protection in a University Setting
- Intellectual Property: Commercializing in a University Setting
Commercialization and Intellectual Property

IP INTRO FOR THE UNIVERSITY ENTREPRENEUR

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CHOP LEARN AND CONNECT
OCTOBER 12, 2021
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DETKIN IP AND TECHNOLOGY LEGAL CLINIC - OVERVIEW

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Detkin Clinic Client Work

Subject Matter:
◦ Setting and implementing IP protection strategy
◦ Patent, copyright, trademark, trade secret, privacy

We represent ventures, usually post-license

How to Become a Client?
◦ Apply at [www.pennipc.com](http://www.pennipc.com)
◦ Next intake in December 2021
Pop Quiz answers
Intro to IP concepts

Hypothetical

Discussion/Questions
Copyright

Covers fixed expression – manuscripts, websites, software (code...)

Long Term: life of author plus 70 years

Rights are automatic; more if you register

But only covers expression, not ideas

CHOP Patent & IP Policy: academic writings owned by Author (some carveouts)
Trademarks

Source identifier: covers names, logos, taglines, etc.

Perpetual, so long as used in commerce

Rights are automatic; more if you register

U.S. is use-based

Must not be another mark that would cause likelihood of confusion
Patents

Covers machines, processes, formulas, plants…and sometimes software

Requirements: patentable subject matter, enabled, new, nonobvious

Term: 20 years from filing

First to file

Claims: method/device/system/composition of matter; address different infringers

Filing: Provisional/non provisional/PCT

CHOP Patent & IP Policy: Patentable inventions owned by CHOP; can secure license or waiver in some cases
Trade Secret

Can cover formulas, business plans, customer lists, data, etc.

May be the only protection available for data

Perpetual, so long as reasonable efforts to keep secret

Most useful if creation is not easily reverse engineered
You are guided by the CHOP Patent & IP Policy:

- Scope of coverage
- Ownership
- Rights and revenues

Role is not passive

- Avoid disclosure; Technology Disclosure Form
- Guide patent claims drafting
- Identify prior art and licensees
- May secure a licensee or waiver if want to protect/productize
- If you decide to productize yourself, your challenges mimic those of any other entrepreneur
Hypo
Safeguard against disclosure

- Important for both patent and trade secret
- Audit on a schedule (always before publications) – file TDFs with OTT
- Set a policy about third party disclosure for team
- Watch time clocks (US only)
- NDAs
Ownership/Inventorship

Guided by the CHOP Patent and IP Policy
Who is subject to the CHOP Policy?
Mindful of third-party ownership
Keep track of terms in funding agreements
When collaborating, alert OTT
Be careful: others may be encumbered
Penn and CHOP
Continue to keep lab notebooks
Interference proceedings
Protection Strategies

Which tools are possible/advisable?
- Patent?
  - Patentable subject matter, new and nonobvious? Base tech? Improvements?
- Copyright?
- Trade secret?
  - Establish “reasonable measures” to keep secret
Moving Forward

- Providing patent support
- Divulge all information about competitors, freedom to operate, prior art
- Do additional prior art research?
- Guide on benefits of invention and help with office actions
- Guide on licensors
- Own the process
Commercializing as a Start-up

- IP Issues for the start-up
  - Waiver? Or license?
  - Are all applications/registrations sound?
  - Are there contracts with founders, employees and contractors?
    - Founders’ agreements that discuss IP contribution
    - Assignments granting all IP to company
    - Employment/consulting agreements with assignments for future IP
  - Decide on freedom to operate
Questions
Thanks for coming!

❖ Stay in touch with IE
  o Join our listserv – email ecosystem@chop.edu
  o Check out our atCHOP site: at.chop.edu/sites/innovation

❖ Access CHOP resources on IP
  o at.chop.edu/research/tech-transfer
  o https://www.research.chop.edu/office-of-technology-transfer
  o techtransfer@chop.edu

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