Inventions and technologies created by faculty, staff, and students of the University of South Carolina (USC) are assets of the University that represent the fruits of valuable and time-consuming research efforts. Many discoveries offer benefits to our society that are worthy of assertive efforts to make them widely available. Since 1997, The University of South Carolina Research Foundation (formerly the South Carolina Research Institute) has been responsible for the management of the university’s intellectual property portfolio. Our mission is to help USC faculty, staff, and students identify, protect, and commercialize the University’s intellectual property assets so that they can benefit society and spur economic growth in the state’s economy.

Two primary objectives are:

- to respond to the needs of both the faculty and industrial partners so that promising technologies can be fully exploited for the benefit of industrial partners, the University, and the faculty.

- to foster relationships with industrial partners that broaden the opportunities for faculty to engage in collaborative or sponsored research.

We also negotiate material transfer agreements (MTA). Under such agreements, investigators share research materials (cells, reagents, or other organisms, etc.) with colleagues in other universities or industry.

Our staff also reviews the intellectual property terms in sponsored research agreements with industry. Importantly, the professionals in the office are also a resource to the campus on a wide variety of intellectual property matters.

USCRF coordinates all of the various aspects required to protect technologies created by members of the university community including:

- disclosure of inventions
- record keeping and management
- evaluation and marketing
- patent prosecution
- negotiation and drafting of license agreements
- management of active licenses.

In order to assist you, we have crafted a website that serves as a vital resource for information on protection and commercialization of your inventions and developments.

[http://ip.research.sc.edu/](http://ip.research.sc.edu/)
Bayh-Dole Act

The Bayh-Dole Act, passed by Congress in 1980, created a uniform patent policy among federal agencies that fund research in the non-profit and small business sectors. The Act provided recipients of federal research and development funds with the right to retain ownership of their patents and charged them with the responsibility to ensure commercial use of inventions created with federal financial support.

Bayh-Dole permits universities to retain title to inventions that are conceived in the performance of a federal grant, contract, or cooperative agreement in exchange for certain obligations on the part of the contractor. The underlying tenet of the Bayh-Dole Act is that federally funded inventions should be licensed for commercial development in the public interest. That principle is reflected in virtually all university policies whether or not the invention is federally funded.

By accepting federal funds in support of a research project, recipient institutions assume responsibility for complying with the requirements of the Act. These obligations are not trivial. They explain why universities and non-profit institutions must make serious resource commitments to supporting the personnel and infrastructure required to comply with the federal regulations that implement the Act. Additional information regarding Bayh-Dole may be found at www.cogr.edu/bayh-dole.htm.

Main Provisions

• Provides title of Federally supported inventions vests with the grantee/contractor organization
• Requires the grantee/contractor to demonstrate progress toward transfer of technology
• Requires acknowledgement of the government's involvement and license
• Provides incentive to inventors and more rapid development and commercialization

Copyrights

According to the US Copyright office, a Copyright is a form of protection provided by the laws of the United States (title 17, U.S. Code) to the authors of “original works of authorship,” including literary, dramatic, musical, artistic, and certain other intellectual works. This protection is available to both published and unpublished works. As indicated by section 106 of the 1976 Copyright Act, the act generally gives the owner of copyright the exclusive right to do and to authorize others to do the following:

⇒ To reproduce the work in copies or phonorecords;
⇒ To prepare derivative works based upon the work;
⇒ To distribute copies or phonorecords of the work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
⇒ To perform the work publicly, in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works;
⇒ To display the copyrighted work publicly, in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work; and
⇒ In the case of sound recordings, to perform the work publicly by means of a digital audio transmission.

For more detailed information on copyrights, please visit the US Copyright Office web page (http://www.copyright.gov/)

For information on the University's policy: http://www.sc.edu/policies/acaf133.html
What is a Patent?

A patent for an invention is the grant of a property right to the inventor, issued by the Patent and Trademark Office. The term of a new patent is 20 years from the date on which the application for the patent was filed in the United States or, in special cases, from the date an earlier related application was filed. Patent grants are effective only within the United States. The right conferred by the patent grant is, in the language of the statute and of the grant itself, “the right to exclude others from making, using, offering for sale, or selling” the invention in the United States or “importing” the invention into the United States. What is granted is not the right to make, use, offer for sale, sell or import, but the right to exclude others from making, using, offering for sale, selling or importing the invention.

What can be patented?

Many inventions are patentable - a process, a composition of matter, a machine, or a manufactured article. Improvements in any of these items or processes also may be patentable. Some intellectual property, by definition, cannot be patented (e.g., a naturally occurring article). Intellectual property can have commercial value and be marketed effectively without a patent.

Basic Patent Requirements

To be patentable, an invention must be new, useful, and not obvious to a person who possesses “ordinary skill in the art” that relates to the invention. For an invention to be considered new, it cannot have been invented earlier by someone else. The written description of the invention included in the patent application should enable a person skilled in the art to make and use the invention. That’s why it is important to make your description of the invention clear, concise, and complete.

Bars to Patenting

Certain factors can prevent you from obtaining a valid patent. In the United States, you are not eligible for a patent if:

- your invention was described in a printed publication or a public oral presentation by anyone more than one year before applying for a U.S. patent.
- your invention was in use or on sale in the United States more than one year before the U.S. patent application.
- another person in the United States created the notion earlier.

Steps to assist inventors with the protection and commercialization of their technology:

**Invention Disclosure:** Completion of an invention disclosure form. This form provide information about the invention, the inventors, the funding sources, anticipated bars to patenting (such as publications), and other data (such as likely candidates for licensing). [http://ip.research.sc.edu/forms.htm](http://ip.research.sc.edu/forms.htm)

**Disclosure Review:** USCRF will review the invention disclosure to develop a basic understanding of the invention. The review process will often include an interview with the inventor. This initial review will be used to outline marketing and intellectual property plans.

**Invention Reporting:** USCRF then takes action to ensure that the newly disclosed intellectual property will be handled in compliance with federal and university policies.

**Marketing:** An non-confidential summary is sent to companies that are likely to be interested. If a company expresses interest, they will be asked to sign a Confidentiality Agreement prior to receiving detailed information from the university. If the company continues to be interested after reviewing the confidential information, an agreement with the company is negotiated. This can be a letter of intent; an option; or a license.

**Intellectual Property Protection:** When appropriate, steps will be taken to protect intellectual property. This may include copyright or patent protection. The inventor will typically work with USCRF and an intellectual property attorney on this effort.

**Licensing:** Successful marketing typically involves identifying a company willing to obtain a license for the invention. A variety of factors are used to craft licensing agreements. Consideration is given to the value of sponsored research, licensing fees, ongoing royalties and other factors. The Research Foundation will serve as the point of contact for all license negotiations.

For information on the University’s patent policy: [http://www.sc.edu/policies/acaf133.html](http://www.sc.edu/policies/acaf133.html)
USC Research Foundation is an element in the University’s strategy for research growth, supporting faculty efforts, and helping the University faculty with their scholarship goals.

New Addition... .

Dr. Michael Muthig joins our Research Foundation as a senior licensing officer. Dr. Muthig comes to USC from Concurrent Technologies Corporation where he served as a Principal Technical Staff Member leading projects to assess, develop, transfer, and commercialize emerging technologies. He brings with him to USC significant experience in contracting with some of USC’s major sponsors to include DoD, EPA, and DOE. Dr. Muthig received a Bachelor of Science degree in Geology from USC and continued his education at the University of Kentucky receiving a Masters degree in Geology in 1984. Dr. Muthig returned to USC in 1986 and received a Doctoral degree in Geology in 1991. He can be reached at 777-4031 or via e-mail at muthigm@gwm.sc.edu.

For more information on Intellectual Property, please visit our website: http://ip.research.sc.edu/