



## BULLETIN

### › COMMERCIAL TECHNOLOGY LICENSING AND INTELLECTUAL FREEDOM

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## Does commercialization conflict with intellectual freedom or the academic mission?

In most cases, the answer is no. Many investigators have the impression that any research endeavor with commercial ties cannot be published. The contrary is true. Successful technology transfer typically requires publication of the research in the most prestigious journal possible. Many licensing transactions are the result of business development executives following the literature, attending meetings, or researching issued patents. These industry technology 'scouts' identify research with commercial potential from such widely distributed public disclosures and often backtrack to the principle investigator.

Deliberation is necessary if you intend to commercialize your research. Typically, the commercial value of a particular technology lies in the breadth and geographic extent of patent protection. Premature disclosure jeopardizes the ability to obtain patent protection, especially internationally. However, proper filing, followed by publication is a powerful tool for marketing novel technology and realizing its intrinsic value.

### Filing For Patent Protection Prior to Publishing

The first step in obtaining patent protection is drafting and filing a provisional patent application. This document, which is prepared by outside legal counsel, can range in thoroughness from a complete patent application, to a cover sheet on a manuscript (which is done in emergency situations). The provisional patent application essentially establishes a place in line for a particular invention. After filing a provisional application, publication will not put foreign patent rights at risk.

#### PUBLICATION AND PATENTS

Generally, the clock for US patent filing deadlines starts from the date of initial *public disclosure*. This means a public disclosure of an invention does not prevent obtaining patent protection in the US. However, if you publish, foreign patent protection cannot be obtained.

**Once proper patent applications have been filed, expeditious publication is often as desirable for commercial purposes as it is for academic purposes.**

#### BENEFITS OF TECHNOLOGY COMMERCIALIZATION

- An alternative approach to creating professional and societal benefit beyond instruction and publication.
- Royalty revenues can support discretionary research projects and lab activities
- Alternative research support from industry sponsors and collaborators can result
- Attraction of top students
- Reputational value of working with innovative firms

The next step is to file a regular patent application; the provisional patent application must be converted to a regular patent application within one year of filing. Upon conversion to a regular patent application there are many possible actions that can accelerate or postpone issuance of a patent.

## Realizing the Academic and the Commercial Merit of Your Work

There are many simple practices that can advance your academic aims while preserving the commercial value of your technology. These are some fundamental measures for all researchers to consider.

**Ensure that industry interactions do not jeopardize your intellectual freedom or intellectual property.** Without proper protection interactions such as consulting, collaboration, sponsored research, and transfer of research materials can jeopardize IP rights. The TTO can ensure that your IP is protected with regard to publication, follow-on research, confidentiality, and IP rights.

**Avoid losing foreign patent rights.** Disclose your invention to the technology transfer office as soon as you feel you have innovations that you suspect might be patentable. The more time the TTO has to evaluate the invention prior to planned publication, the more likely success will be realized.

**Envision all possible commercial and research uses of your technology and include them in the disclosure.** This creative exercise can sometimes shed light on potential new research questions and solutions to problems.

**Maximize the commercial potential of the IP.** Work with the TTO and the patent attorney to ensure the application embodies all of the uses, processes, and manifestations of your invention.

**Use the TTO to ensure optimum societal benefit of innovations.** Assays, analytical protocols, designs, materials, processes, and other tools that result from your research might be suitable for products and services that are most efficiently transferred to the private sector via commercial development and distribution. Not all inventions require a patent.

### WHAT IS PUBLIC DISCLOSURE?

- Abstracts, Posters, and Talks
- Departmental Seminars
- Website Posting
- Peer Review
- Theses and Dissertations
- Grant Review (usually)
- A conversation without a nondisclosure agreement
- Journal Papers

## Advancing Your Academic Goals

Participation in the technology commercialization process can expand and advance your academic aspirations in many ways. The common goal of basic research and commercial endeavor is to develop products and services that benefit society. Realizing the intrinsic economic value of a basic discovery or innovation is often a byproduct of a well-formulated research plan coupled with regular collaboration with TTO's experienced and scientifically trained technology transfer professionals.

Commercialization of your technology often means broader availability, greater utility, and further improvement and development - truly a win-win scenario for academic scientists and society.

To download forms: <http://www.cusys.edu/techtransfer/disclose/index.html>

To submit a disclosure, send emails to your campus TTO contacts.