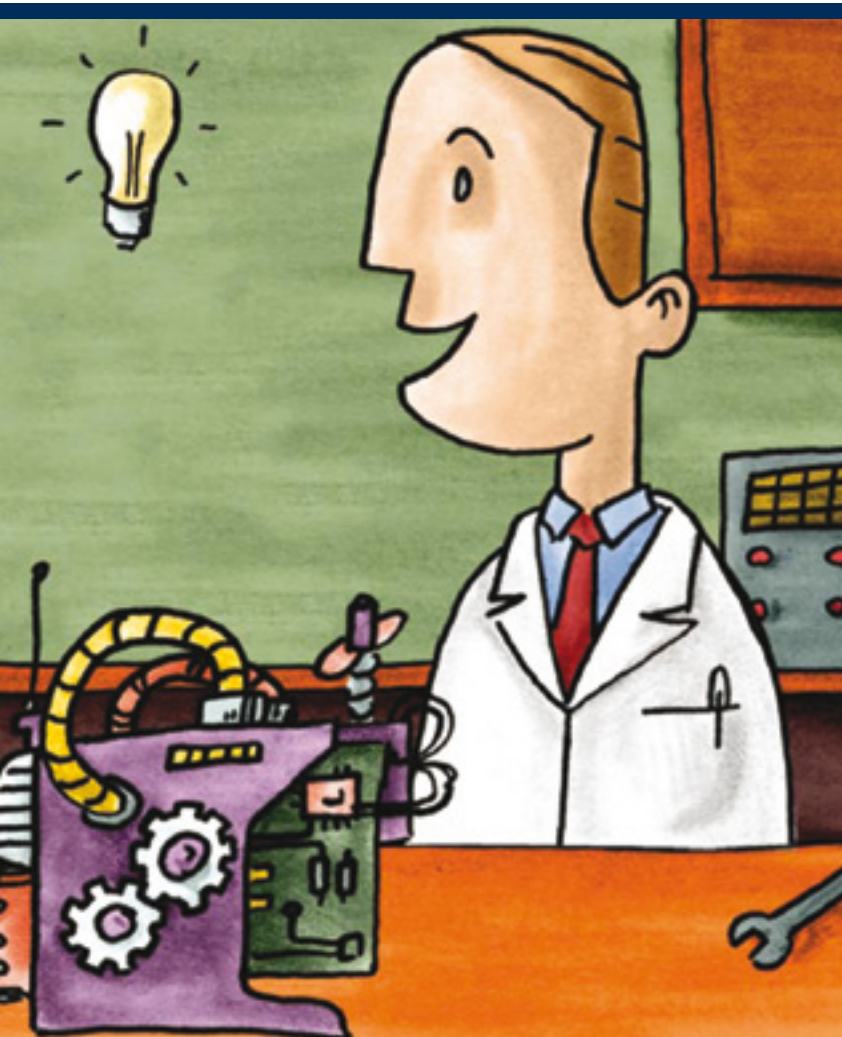


PATENTING & LICENSING YOUR DISCOVERY



Patenting and Licensing

TIMING OF DISCLOSURE

It's important to notify a WiSys Intellectual Property, Licensing or Regional Associate as soon as possible with a new discovery.

The WiSys IP management team is an important resource for UW System inventors. They are experienced in the fields they support and experts in Intellectual Property Management. The WiSys Associate acts as a catalyst between cutting-edge research and commercialization, and can answer even your most basic questions early in the process. *It is important to speak with your WiSys Associate early, before discussing your idea in public via a presentation, manuscript, meeting, etc., or some patent rights will be lost.*

After a patent application is filed with the U.S. Patent and Trademark Office, it is published, then undergoes a thorough examination. The examiner reviews the application with questions in mind regarding your invention's utility (Is it useful?), novelty (Is it new or innovative?), and obviousness (Is it something other people in the field would have known or expected?).

The examiner also will determine whether the patent application provides enough information to enable someone else in the field to make and use the invention. It should!

OFFICE ACTIONS

The patent examiner enters into a correspondence with WiSys through a patent attorney, issuing comments and opinions called office actions. These actions may include rejecting all or some of the patent's claims, which distinguish the protectable aspects of the invention. WiSys's IP team will manage the interface with the patent attorney, and will often reach out to inventors in order to address any queries that may arise.

PATENT PROSECUTION

The patent attorney responds to the office actions by defending or trying to adjust the claims and convince the examiner to accept them. This rebuttal and allowance process may take several years. If, after this back and forth process, your application is deemed acceptable by the examiner, a notice of allowance will be issued. Finally, the patent issues and a final version of the patent is published.

PATENT TERM

An issued U.S. patent has a life of 20 years from the date the application was filed.

LICENSING

Active marketing of your invention can begin as soon as a patent application has been filed. Once filed, the patent application enables a company to assess the value of your invention. It's a good idea to keep your WiSys Associate informed about any industry inquiries you receive about your invention.

The licensing process entails marketing the new technology to companies that may be interested. The terms in a licensing agreement may include equity, payment of upfront fees and running royalties.

The license agreement may be exclusive, meaning that only one company can make, sell and/or use your invention, or non-exclusive, meaning more than one company may hold a license to your invention.

The WiSys licensing team has technical knowledge as well as industry experience in sales and negotiations. They serve as your business partners—commercialization consultants who work to find the best market and/or market application for your invention.

WiSys works with knowledgeable legal counsel throughout the licensing process to ensure resulting agreements conform to applicable laws.

ONGOING CONTRACT MANAGEMENT

WiSys also provides license agreement administration, supplied by an experienced contract manager. Services include scheduling and monitoring a calendar of fees and royalty details, payment dates and development plans, as well as ensuring the obligations of the licensee and of WiSys are met.

ROYALTY DISTRIBUTION

WiSys shares royalty revenue generated by a licensed invention with you as the inventor. Your campus also receives a portion of the revenues, along with the UW System.



About WiSys

WiSys Technology Foundation was established in 2000 and is an independent, nonprofit supporting organization for the UW System. As the officially designated technology transfer office for the UW System Comprehensive Campuses, UW Colleges and UW-Extension, WiSys advances scientific research throughout the UW System by patenting technologies from the universities and licensing these inventions to companies capable of developing them to benefit Wisconsin and beyond.

Revenues from WiSys licensing activities are distributed back to the inventors, the UW Campuses and the UW System. The strong partnership between WiSys and the UW System helps the UW campuses fulfill their roles as twenty-first century leaders in research, discovery and innovation.

OUR PATENTING & LICENSING PROCESS

RESEARCH & DISCOVERY

1



Conceive and start to develop your idea for a new technology or an improvement to an existing technology.

INVENTION DISCLOSURE

2



Make your idea known to WiSys.

- Submit a Confidential Invention Disclosure Report.
- Meet with a WiSys Associate.
- Explain your idea to WiSys.

WISYS DECISION

3



The WiSys Disclosure Committee assesses your idea. The committee accepts about half of all new disclosures. Among other things, the committee asks:

- Is it protectable?
- Is there market/commercial potential?
- Can we license it?

Some disclosures may be too early to patent. These are called "predisclosures." WiSys will reconsider your predisclosure if you decide to develop the technology further and may have development funds available.

INVENTOR IS NOTIFIED BY WISYS

4



- We accept or don't accept the invention; either way there's a UW System Equity Review, which determines funding sources and ownership rights to the invention.
- If we accept, you sign a Memorandum Agreement in which you assign your technology to WiSys and WiSys agrees to share 20 percent of licensing royalty revenue with the inventor group.
- If we decide not to move forward, we will indicate our reasoning. We are always open to further discussion.

PATENTING

5



- You meet with your WiSys Intellectual Property Associate and a patent attorney who is retained by WiSys.
- An experienced patent attorney drafts the application with your input.
- The application process includes a review of relevant patents and literature, and drafting and filing the application with the U.S. Patent and Trademark Office.
- The application is examined by the USPTO. (Note: this takes 3–5 years.) The examination may include office actions, responses or amendments, wherein the patent's claims are adjusted or argued until allowed.
- If all goes well, a patent issues and the inventor is notified.

MARKETING

6



Once the patent is filed, marketing of the technology gets underway. With the help of the faculty/inventor, a WiSys Licensing Associate identifies companies that may be interested in the invention and proactively markets the technology to those companies.

- A summary of the technology is written and posted on the WiSys website.
- Other marketing materials may be developed.

LICENSING

7



- A patent license is negotiated with a potential licensee.
- A patent license is a contract between the patent owner (WiSys) and a commercial partner that gives the licensee permission to make, use, sell or import the invention.
- Licensing revenue is returned to the inventor and the university, where it is used to support further research.

Friendly and Knowledgeable Help Is On Hand

For more detailed information on patenting and licensing through WiSys, visit www.wisys.org or call (608) 316-4037. An experienced WiSys Representative is always on hand to answer your questions and address your concerns.