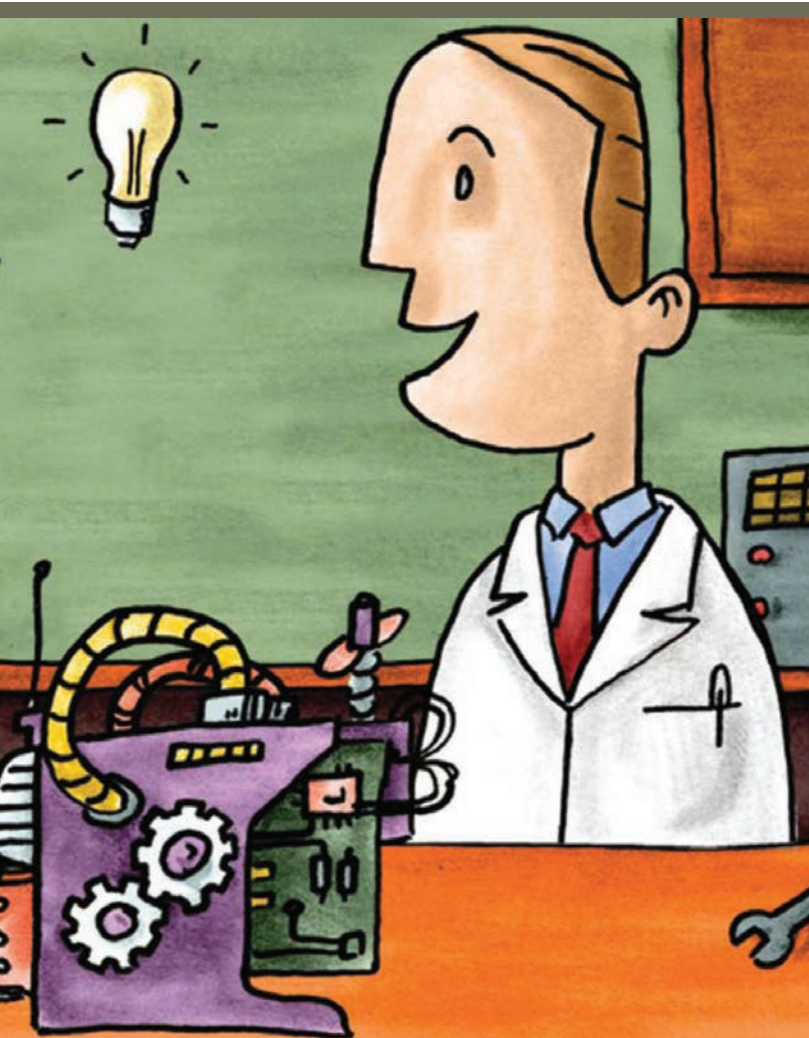




# WANT TO KNOW MORE?

## PATENTING & LICENSING YOUR DISCOVERY



### Patenting and Licensing Detail

#### TIMING OF DISCLOSURE

*It's important to notify a WARF Intellectual Property Manager as soon as possible.*

The WARF IP management team is an important resource for UW–Madison faculty members. IP Managers are experts in the fields they support; most hold graduate degrees and are registered patent agents. The IP Manager 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 IP Manager early, before discussing your idea in public, or some patent rights will be lost.*

After a patent application is filed with the U.S. Patent and Trademark Office, it 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 WARF through the 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. WARF's IP team will coordinate the interface with the patent attorney.

#### 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. In fact, a patent may never be issued, and if it is issued, may not include some of the claims that were initially filed in the application. If the application is granted, 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 Licensing Manager 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 a payment of upfront and royalty fees.

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

The WARF 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.

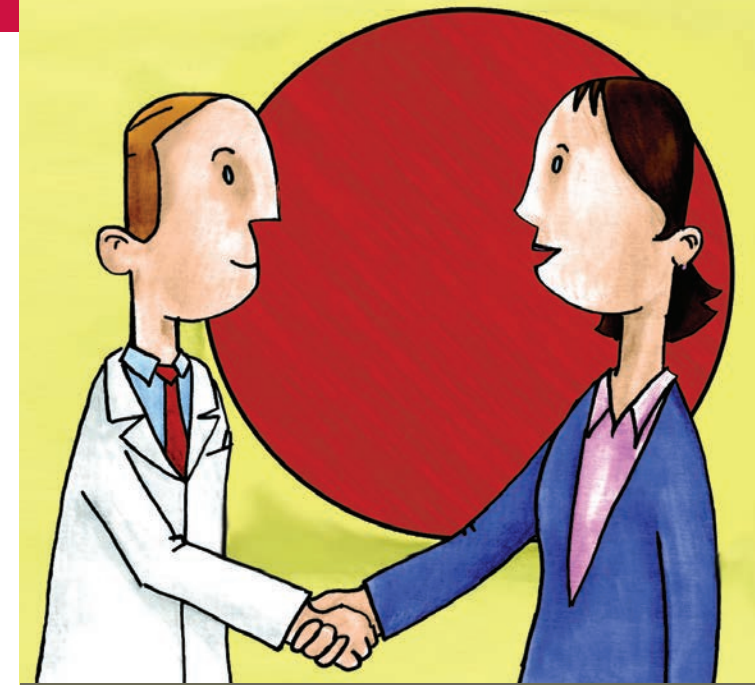
WARF works with knowledgeable internal legal counsel throughout the licensing process to ensure resulting agreements conform to applicable laws.

#### ONGOING CONTRACT MANAGEMENT

WARF also provides license agreement administration, supplied by an experienced contract management team. 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 WARF are met.

#### ROYALTY DISTRIBUTION

WARF shares royalty revenue generated by a licensed invention with you as the inventor. Your department also may receive a portion of the money WARF gives to UW–Madison.



### About WARF

The Wisconsin Alumni Research Foundation (WARF) was established in 1925 and is an independent, nonprofit supporting organization for UW–Madison and the Morgridge Institute for Research. As the officially designated technology transfer office for UW–Madison and the Morgridge Institute, WARF advances scientific research at UW–Madison by patenting technologies from the university and licensing these inventions to companies capable of developing them to benefit humankind.

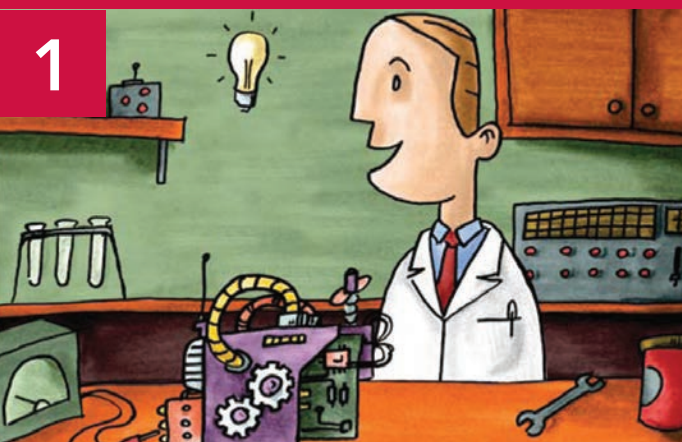
Revenues from WARF's licensing activities are combined with interest generated by WARF's professionally managed endowment and distributed back to the university in the form of an annual "margin of excellence" gift. This annual gift supports research projects, graduate fellowships and faculty recruitment and retention, and provides matching funds for federal grants. The strong partnership between WARF and the university helps UW–Madison to fulfill its role as a twenty-first century leader in research, discovery and innovation.



[www.warf.org](http://www.warf.org)

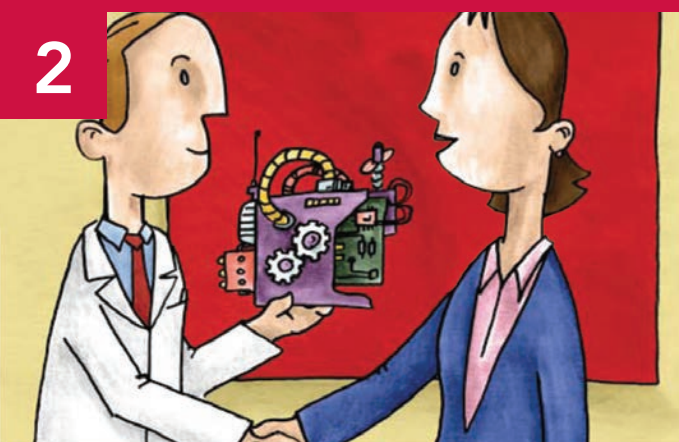
# OUR PATENTING & LICENSING PROCESS

## 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 WARF.  

- Submit an Invention Disclosure Report.
- Meet with a WARF Intellectual Property Manager.
- Explain your idea to WARF.

## WARF DECISION



3  
The WARF Disclosure Committee assesses your idea. The WARF committee accepts about half of all new disclosures. The committee asks:  

- Is it protectable?
- Is there a market for it?
- Can we license it?

Some disclosures may be too early to patent. These are called "predisclosures." WARF will reconsider your predisclosure if you decide to develop the technology further.

## INVENTOR IS NOTIFIED BY WARF



4  

- We accept or don't accept the invention; either way the university conducts an 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 WARF and WARF 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 WARF Intellectual Property Manager and a patent attorney who is retained by WARF.
- 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  
With the help of the faculty/inventor, a WARF Licensing Manager 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 WARF 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 (WARF) 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 WARF, visit [www.warf.org](http://www.warf.org) or call (608) 263-2500. An Intellectual Property Manager is always on hand to answer your questions and address your concerns.

To find out more about the invention disclosure and equity review process at UW–Madison, contact Research Services in the Office of the Vice Chancellor for Research and Graduate Education at (608) 263-2877.