



# INVENTOR GUIDE



[BAYLOR.EDU/INNOVATION](https://baylor.edu/innovation)

# Baylor Colleagues,

Here at the Office of Innovation & Economic Development, we strive to support institution-wide efforts to increase innovation, generate startups, and promote job creation in the greater Waco area. We seek to achieve this and to support the Baylor mission by disseminating innovations resulting from faculty research into broader society. To do this, we partner with faculty members and the Office of General Counsel to protect the intellectual property resulting from faculty research. We also work with faculty to implement appropriate development opportunities such as licensing agreements, sponsored research agreements, and business startups.

By engaging with our office, faculty members can create opportunities to increase the societal impact of their research while also driving resources to their departments and individual research programs. Our office is committed to guiding and supporting faculty members with entrepreneurial goals as well as those who are solely interested in fundamental research. We invite faculty to reach out to us with any questions about intellectual property, technology commercialization, or the role of our office.

Please feel free to reach out to us by contacting Sarah Anderson directly at [sarah\\_anderson11@baylor.edu](mailto:sarah_anderson11@baylor.edu).

Sincerely,

The Office of Innovation & Economic Development Team

Jeremy Vickers, Ph.D. – Associate Vice President  
John Crandall – Business Development Director  
Sarah Anderson, Ph.D. – Licensing and Patent Associate  
Lesley Swartz – Program Manager  
Kit Riehl – Associate General Counsel  
Christopher Egbunike – Patent Attorney



## Table of Contents

- 1 INVENTION
- 2 DISCLOSURE
- 3 IP PROTECTION
- 4 ASSESSMENT
- 4-5 COMMERCIALIZATION

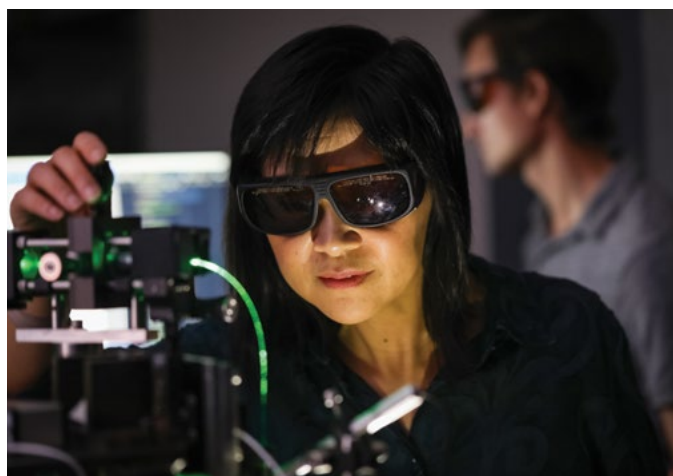


# Invention

The Office of Innovation & Economic Development manages all intellectual property generated by Baylor University with the goal of positively impacting society and furthering the Baylor mission through the commercialization of technologies. This is achieved through the technology transfer process that starts with Baylor inventors and their research efforts.

Baylor inventors are those faculty, students, and staff who develop an invention, discovery, advancement, or innovation that they feel may address a larger societal issue or have commercial potential. The Office of Innovation & Economic Development works with Baylor inventors throughout the technology transfer process to protect, market, and commercialize their inventions.

By participating in this process, inventors advance the transfer of scientific achievements to broader society and promote a competitive economy of innovation. Inventors can also increase funding for their research and department, create student research opportunities, and receive external financial awards by engaging in the technology transfer process through the Office of Innovation & Economic Development.



## HISTORICAL CONTEXT

Most Research 1 universities and many smaller institutions have similar technology transfer offices that assist inventors in commercializing their work.

In the United States, university technology transfer as we know it today was made possible by the 1980 Bayh-Dole Act. This act amended patent and trademark law by allowing universities and other non-profits to own, patent, and commercialize discoveries resulting from federally funded research. Prior to the Bayh-Dole Act, discoveries made using federal funding were the property of the federal government and were often left undeveloped.

By allowing universities to retain the rights to discoveries, the Act decentralized the handling of discoveries from the federal government to universities and created an incentive for private industry to engage with federally funded research. Ultimately, the Act led to the development of the university technology transfer field and is reported to have led to substantial economic growth and job creation in the United States.





# Disclosure

## INVENTION DISCLOSURE FORM

Baylor University researchers are encouraged to disclose any invention, discovery, advancement, or innovation that they feel may address a larger societal issue or have commercial potential to the Office of Innovation & Economic Development. Researchers may disclose an invention to the Office of Innovation & Economic Development by submitting an Invention Disclosure Form (IDF).

Disclosure is an essential step in the university technology transfer process. It is vital that inventors submit a completed disclosure form to the Office of Innovation & Economic Development so that the office can protect and market the invention appropriately. By submitting this form, inventors begin the technology transfer process that could lead to an invention being commercialized. It is best practice to submit an invention disclosure form prior to publicly disclosing the invention in conference presentations or publications so that the Office of Innovation & Economic Development can work to develop a plan to protect the invention.

In the invention disclosure form inventors are asked to provide basic information about the invention itself including the title of the invention, the contact information of the inventor(s), and an abstract that summarizes the invention without disclosing confidential information. Inventorship for patented intellectual property differs from scientific authorship and is defined by law as a person who contributes to the conception of the invention.

When completing the invention disclosure, inventors are also asked to provide information on funding and prior agreements related to the invention as well as any prior or upcoming public disclosures (including conference presentations and publications) that relate to the invention. Importantly, inventors are also asked to provide information on any companies that may be interested or have expressed interest in the invention as well as any known competitors or products that include similar inventions. Typically, the most successful technology commercialization leads come from inventors because they are experts in their fields and familiar with ongoing, related work.

Inventors should go to [baylor.edu/innovation](https://baylor.edu/innovation) to complete an invention disclosure form. Inventors are encouraged to reach out to the Office of Innovation & Economic Development with any questions related to completing a disclosure form. After receiving an invention disclosure form, the Office of Innovation & Economic Development will contact the inventor(s) to schedule a meeting with the goals of gathering supplemental information related to the invention and answering any questions the inventor(s) may have about the technology transfer process at Baylor University.

# IP Protection

After receiving an invention disclosure form and meeting with the inventor, the Office of Innovation & Economic Development works with the Office of General Counsel, and outside counsel to file a provisional patent application for patentable inventions. Non-patentable inventions may be eligible for other forms of legal protection including copyright and trademark protections. If the invention is patentable, the provisional patent application provides some intellectual property protection for the invention for a period of twelve months.

To successfully complete any patent application, it is imperative that the inventor remain responsive to inquiries from the Office of Innovation & Economic Development, the Office of General Counsel, and outside counsel to provide the scientific expertise required to describe the invention thoroughly and



accurately. While the provisional patent application is in place, it is best practice for the inventor to continue working on the invention by gathering additional data, furthering any prototypes, and/or conducting related activities that further advance the commercial potential of the invention. During this time, it is also important that the inventor continues to update the Office of Innovation & Economic Development on any upcoming public disclosures of the invention, such as publications and conference presentations.

While the provisional patent application is in place, the Office of Innovation & Economic Development works with the Office of General Counsel and a third party to assess whether the invention is eligible for

further protection. If the Office of Innovation & Economic Development determines that the invention is eligible for further protection, it will work with the inventor, the Office of General Counsel, and outside counsel to file for additional protection. If by the end of the provisional application period, it is determined that the invention warrants longer-term protection, the Office of Innovation & Economic Development, the Office of General Counsel, and outside counsel will work with the inventor to submit a U.S. nonprovisional patent application and any relevant foreign patent applications.

Each of these applications can cost several thousand dollars and typically take a year or more to initially process within a given patent assessment agency. In addition to the initial application fees required for each patent application, in some countries, annual annuity fees are required to keep the patent application active. Further, after the patent has been issued in the U.S. and in foreign countries, Baylor must pay periodic maintenance fees to continue to keep the patent protection in place. The Office of Innovation & Economic Development carefully considers the commercial potential and potential societal impact of an invention when deciding what level of intellectual property protection to pursue.



# Assessment

After filing a provisional patent application to protect the invention, the Office of Innovation & Economic Development works with an external consulting group to evaluate the commercial potential of the invention. The consulting group identifies potential commercial applications, competitive advantages, development directions, and potential regulatory issues associated with the technology. The group also generates a list of potential industry partners and competitors to supplement the information provided by the inventor in the invention disclosure form. The Office of Innovation & Economic Development uses this information to market the invention for specific commercial applications and as a starting point for reaching out to potential commercial partners.



# Commercialization

The university technology transfer process typically leads to one of four outcomes for a given invention: licensing, industry partnership for sponsored research, business startup, or additional non-sponsored research. The Office of Innovation & Economic Development works with inventors to continue supporting the development of the invention in each of these four pathways. The Office of Innovation & Economic Development and the Vice Provost of Research are responsible for making the final decision in determining which pathway is best suited for each invention. The Office of Innovation & Economic Development works with the Office of General Counsel to negotiate all agreements on behalf of the inventor.



## **LICENSING**

Licensing is the most common outcome for inventions that are commercially advanced at academic institutions, and licensing is typically a good fit for any invention that improves upon an existing product or process. Licensing agreements give an existing company permission to use Baylor intellectual property to develop a product or process in exchange for a share of the financial return from the license.

Per the Baylor Intellectual Property Policy, inventors are entitled to a share of this financial return after Baylor recoups the initial investment made to protect and find a commercial licensee for the invention. The Office of Innovation & Economic Development selects licensees by assessing the likelihood that the licensee will be able to commercialize the invention. After an agreement is reached with a licensee, the inventor may still need to be available to provide scientific expertise as commercialization efforts are being made by the licensee.

The Office of Innovation & Economic Development works to find potential licensees by promoting the invention broadly and taking a targeted marketing approach by reaching out directly to potential external partners. Inventors are asked in the disclosure to provide information for any contacts that they have already made or industry partners who they think might be interested in the invention. Importantly, the most successful commercialization leads typically come from the inventor. If a company reaches out seeking more information about an invention, the Office of Innovation & Economic Development may ask the inventor to provide additional or clarifying information.

## **INDUSTRY PARTNERSHIP (SPONSORED RESEARCH)**

Industry sponsored research can also advance inventions towards commercialization. In this scenario, an industry partner invests time and resources to improve the commercial readiness of an invention alongside the inventor. Industry partners are motivated to fund early-stage university research with the goal of advancing the university invention to a stage that is licensable by the company. Industry partnerships are common in the pharmaceutical space where new drugs need extensive resources to reach a stage of development that is licensable.

## **BUSINESS STARTUP**

The Office of Innovation & Economic Development may decide with the inventor to form a startup business around an invention. Startup businesses are typically formed around well-developed inventions that have broad-reaching applications. Baylor has numerous resources and facilities designed to facilitate the movement of inventions from university research to the broader market. The primary space for this work is the Baylor Research and Innovation Collaborative (BRIC), a 330,000-square-foot facility with spaces optimized for research and advanced prototyping including both wet and dry labs.

## **ADDITIONAL RESEARCH**

The Office of Innovation & Economic Development may decide through conversations with the inventor and potential industry licensees or partners that the invention needs further development in the lab before pursuing commercialization. If an invention is not developed enough to be granted a nonprovisional patent, the inventor may need to collect additional data before pursuing commercialization. If industry sponsored research is not available for the invention, the Office of Innovation & Economic Development can assist inventors in finding relevant grant funding from programs specifically targeted to generate funds for innovation.



[BAYLOR.EDU/INNOVATION](https://baylor.edu/innovation)