

Scientific Software Engineering Center – 2024 Workshop

Collaboration with Georgia Tech Open Source Program Office (OSPO)

Sustainable Software in Academia

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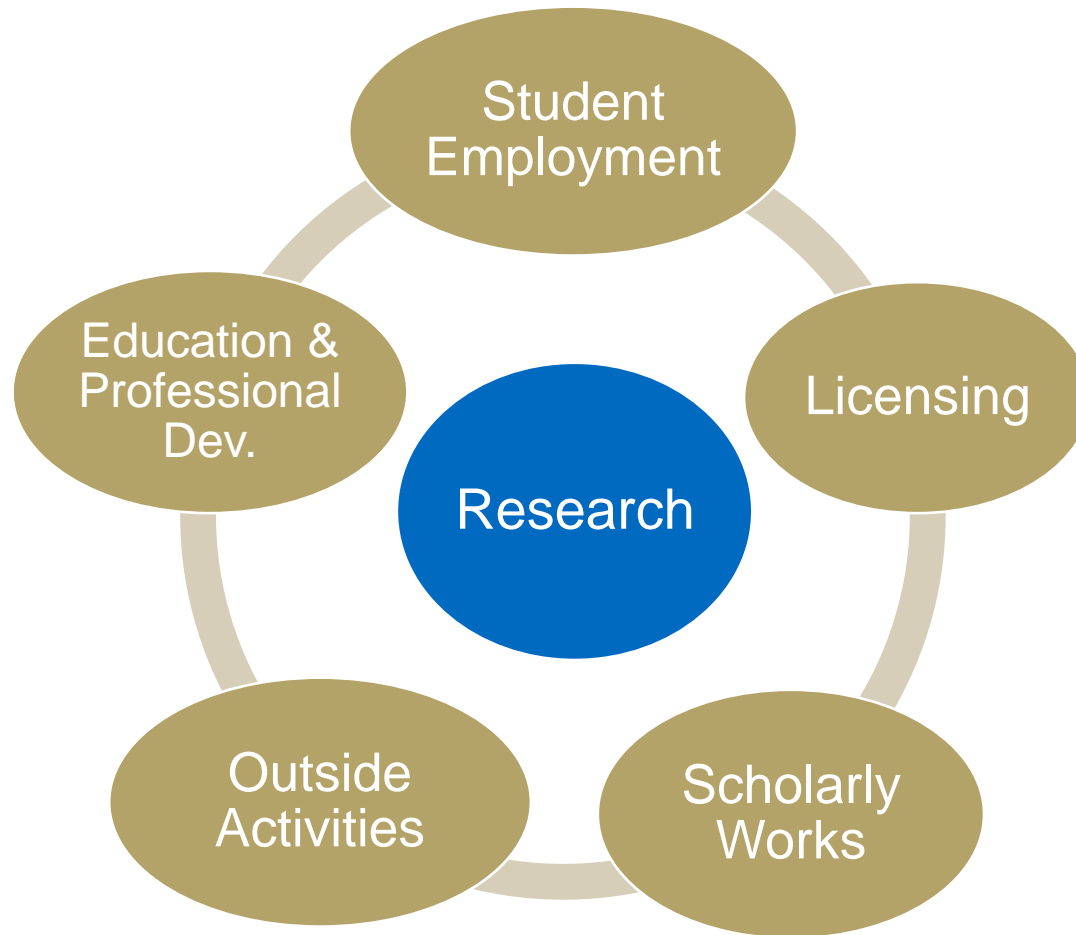
Office of Technology Licensing (OTL),
Georgia Tech



Office of Technology Licensing



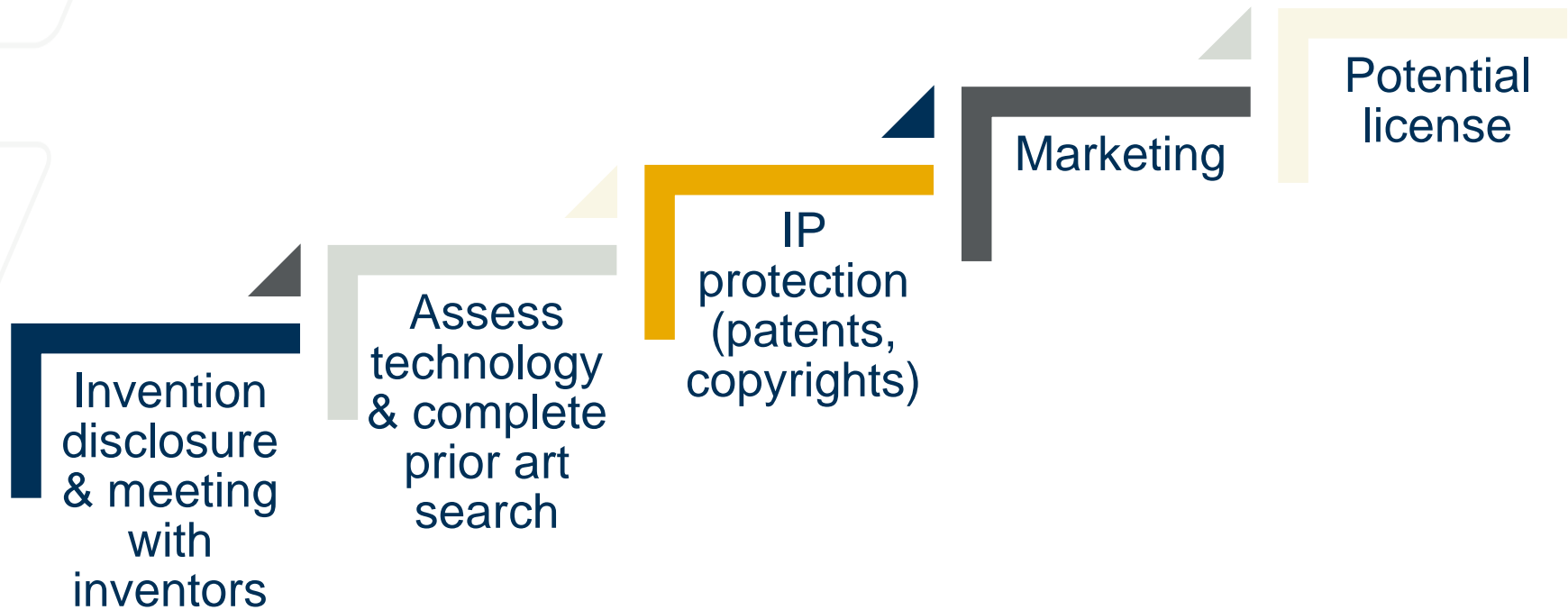
Technology Transfer



Types of Intellectual Property (IP)

- Copyrights (software, literary works etc.).
- Trademarks.
- Trade secrets.
- Patentable inventions, whether formal patent protection is sought or not.

What does GTRC do with Invention Disclosures?



Steps and Timeline – Initial Disclosure

- Invention/software disclosed to OTL via online portal.
- Inventor/Creator meeting with Licensing Associate to discuss details of the invention/software.
- Technology assessment.
- Go or No-Go patenting decision within 60 days.

Georgia Tech Employee IP Rights

- As part of our hiring package all employees sign an IP agreement assigning IP rights to GTRC for any IP they generate in the course of their employment.
- As a condition of federal (and some other) grants, you are required to assign your rights to GTRC.

Ownership of Student IP at GT

Students shall be required to execute an IP Agreement only:

1. When working on a research project funded by an entity other than GIT, the Georgia Tech Foundation, or the Board of Regents,
2. When employed by GIT,
3. In the case when the student anticipates or engages in more than incidental use of GIT equipment and/or resources that are not available to the general public, or
4. When required by the Office of the Provost. Such requirement may be recommended by a faculty member who has students working in faculty-directed research.

For the purpose of this policy, this assignment requirement does not apply to students who participate in entrepreneurship activities, such as senior design, CREATE-X, InVenture Prize, or use equipment obtained by Student Tech Fees.

Open-Source Process for GTRC Owned IP

GT IP Policy 5.4.5

J. Alternative Disposition of Rights. Unless the terms of any agreements that supported or governed the work prohibit and notwithstanding other provisions in this policy (including but not limited to the IP Agreement), a Creator (acting collectively when there are more than one) is free to place an invention or a creation in the public domain upon written notification to GTRC signed by all Creators of Record. GTRC will not assert intellectual property rights when Creator(s) have placed their inventions or creations in the public domain.

Open-Source License Considerations

- **Seek assistance from the Georgia Tech Open Source Program Office (OSPO).**
- When selecting an open-source license, select one that is either: (a) silent as to granting of patent rights or (b) explicitly excludes the granting of patent rights.
- If the Creators of Record choose to open-source, GTRC will likely forgo patent filing.
- If your software includes 3rd party open-source code, you may be under an obligation to release your own code open source depending on the license.
- If your software was developed under a Sponsored Research Agreement, review the agreement for any restrictions on open-sourcing.
- OTL's procedures for handling open-source code is still evolving so keep an eye out for additional guidance.
- **Please submit a software disclosure to OTL via OTL's online IP disclosure portal before releasing GTRC software under open-source.**

Open-Source License Considerations

- <https://choosealicense.com/appendix/> (see snippet below)
- Example:
 GNU 2.0 – generally yes,
 GNU 3.0 – Probably no.
- **Contact OSPO for assistance in selecting a license that fits your needs.**

License	Commercial use	Distribution	Modification	Patent use	Private use	Disclose source	License and copyright notice	Network use is distribution	Same license	State changes	Liability	Trademark use	Warranty
GNU General Public License v2.0	●	●	●		●	●	●		●	●	●		●
GNU General Public License v3.0	●	●	●	●	●	●	●		●	●	●		●
MIT License	●	●	●		●		●				●		●
Creative Commons Attribution 4.0 International	●	●	●	●	●		●			●	●	●	●

What does a Patent Grant the Owner?

The right conferred by a patent grant is the **right to exclude** others from making, using, offering for sale, or selling the invention.

Types of Patents

- **Provisional Patent Application** – Place holder – provides priority date that lasts for 1 year. (\$2K - \$7K).
- **Utility Patent (Non-Provisional)** – Effective for 20 years from filing date. (expensive, filing costs ~ \$15K to \$25K).
- **Non-U.S. Patents (PCTs).**

Patentability

In the United States to be patentable, an invention must be:

- ✓ **Statutory Qualification** – a process, machine, manufacture, or composition of matter (NOT abstract ideas, mental processes, fundamental economic practices, laws of nature).
- ✓ **Novel** - Not already known to the public;
 - ✓ in the U.S., cannot be publicly disclosed, used, or offered for sale more than 1 year prior to filing (only applies to disclosures by you).
 - ✓ If another person discloses your invention before you file your patent application, no patent will be issued to you (i.e., your invention is not novel).
- ✓ **Non-obvious** - Not considered an obvious improvement over the prior art to “one of ordinary skill in the art.”
- ✓ **Useful** - Performs an intended function.

Types Of Public Disclosure

Written publications
(e.g., journal article,
thesis, book chapter,
etc.)

Oral presentations
without expectation
of confidentiality

Offer for sale, sale,
or public use

Publicly available
video recordings

Public meetings and
other
communications
such as email or
websites

Who is an Inventor?

- Ultimately, inventorship is determined by U.S. patent law. Any individual who made a substantial inventive contribution to at least one claim of an allowed patent is an inventor as to that patent.
- Inventorship is not authorship.

When Should You Disclose to OTL?

Before you make a public disclosure!

Inventions should be disclosed using OTL's Web Disclosure system.

<https://licensing.research.gatech.edu/>

Steps and Timeline – Patent Filing

- File provisional application, before publication.
- Market technology **or** hold to market after patent conversion.
- Decision on filing utility – 9 months post provisional filing.
- File U.S. or PCT application 12 months post provisional filing.

Timeline - Licensing

- Marketing – active and passive.
- License, 1-5 yrs, if at all.
- Patent issuance, 3-5+ yrs.



QUESTIONS?

**Please disclose your
latest invention!**



licensing.research.gatech.edu



Georgia Tech
Technology
Licensing

**PLEASE CONTACT US IF
YOU HAVE QUESTIONS**

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