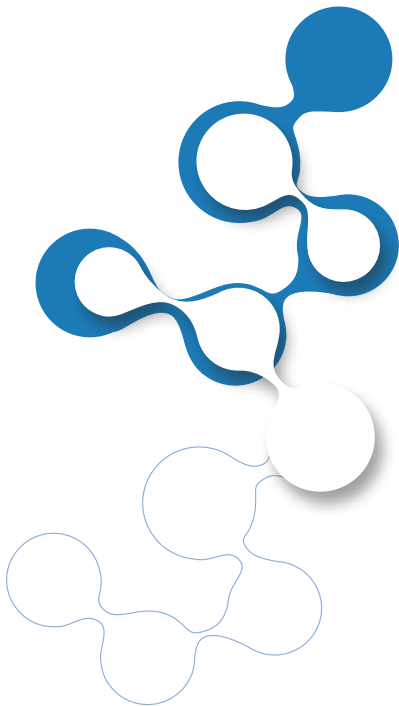


GUIDE TO PATENTS

Information for Inventors at the
University of Vienna







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Your Technology Transfer Office (TTO) is ready to provide you with a wealth of information and advice. Contact details are available on page 23.

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WHAT IS AN INVENTION?



Inventions are new ideas designed to help solve technical problems. They are different from discoveries – such as x-rays or a new animal species – as these can be discovered but not invented.

Your Roadmap to a Patent

This brochure compiles valuable information for researchers about the advantages of applying for a patent. The road to successfully acquiring a patent can be compared to a journey into the unknown. This brochure aims at serving as a guidebook to accompany you on this journey.

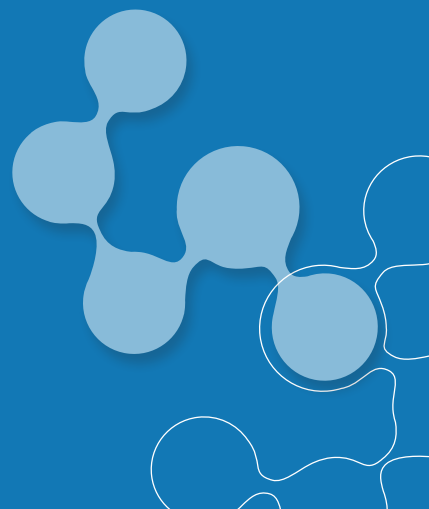
For you as a researcher, patents can be an excellent way to bring your research into the commercial arena. For legal purposes, patents are also important when it comes to acknowledging an invention's commercial value. Start-up companies are, for example, more likely to be successful with a solid patent portfolio.

In short: patents can legally protect your professional knowledge and expertise, helping you to achieve commercial success.

Your TTO will provide you with professional guidance and support on the patenting process.

Patents are industrial property rights, like trade marks and designs.

Filing a Patent Application can be the first step toward commercialisation of your know-how. It is a way to put ideas, inventions and technologies into practice and make it accessible to the public, consumers, the market and to specific fields of trade.





Inventions at the University

- Inventions created by university employees are referred to as “employee inventions”.
- All inventions must be reported to the TTO (the invention disclosure form is available on the TTO website). The university has three months from the date of reporting to claim the invention.
- Similar to private companies, the inventions belong to the university. This certainly does not mean that the inventor will be overlooked. On the contrary, an invention can only become truly successful when the inventor and the university work together. As an inventor working together with the TTO, you will play a pivotal role in commercializing the invention.
- For you as an inventor, this means you do not have to pay the patent application fees or the legal fees and you may be entitled to **inventor remuneration** if the university successfully licenses the patentable/patented invention.

Invention Evaluation: Once an invention has been formally reported, the university has three months in which to assess the patentability and market value of the technology and decide whether or not to claim it. The TTO will evaluate the invention, working closely with the inventors. The invention must be kept confidential by the university and by the inventors. If the invention is not claimed by the university within this three month time limit, ownership of the invention reverts to the inventors, who are free to commercialise it as private individuals.

IP Protection: If suitable, the TTO will arrange for Intellectual Property (IP) protection. The term Intellectual Property Rights (IPR) comprises all intellectual creations and absolute rights to intangible goods. This includes industrial property rights (patents, utility models, trademarks, etc.) and copyright.

Software and other IP: The university actively encourages its scientific researchers to consider opportunities to commercialise non-patentable technologies developed at the university.

Examples include:

- Biological materials, such as cell lines, animal models, etc.
- Software: this involves the commercial licensing of unique software, algorithms, or programs developed by university researchers.
- Data/Database: gathering extensive data sets or creating detailed databases. Commercialization might involve licensing the right to access, use, or analyze it.
- Know-how.



The protection of software and databases primarily falls under copyright, which guarantees the creator's rights while allowing for potential commercial exploitation.

Every case is different, and in some instances, software can also be patented. Please get in touch with your TTO for clarifications specific to your situation.

Points to consider in the Evaluation

You can facilitate the evaluation process of the TTO by providing

1. A patent search (see page 11)
2. Answers to the following areas:

- **Applications:**
What can this invention be used for?
What are the potential areas of application?
What are the competitive advantages or the potential disadvantages of your invention compared to the available products on the market (e.g. cheaper, easier to scale, etc.)?
- **Market and customers:**
Does the invention meet a customer need?
What is the benefit for the customer when using the invention?
What kinds of future trends are important?
How will the market and customer demand develop?
- **Further steps:**
What are the necessary next steps in bringing the technology to the market?
What resources are needed for these steps?

PATENTS: ON THE ROAD TO SUCCESS

What is a Patent?

A patent is a set of exclusive rights enabling the patent holder to exclude others from commercial use. In exchange, the invention must be publicly disclosed. For an invention to be patentable, it must be new in the field of technology, it should not be too similar in resemblance to other products, and should be commercially viable. Patents are valid for a maximum of twenty years.

Patent Search Engines

To avoid duplication of research results, it is essential to perform a patent search at the beginning of each research project (in addition to searching scientific literature). This can be done online in publicly available databases free of charge. You can use keywords but also specific patent classifications to enhance the quality of search results. All databases offer information files, tutorials, or even webinars to help you with the search for prior art in patent literature. When you believe that you have invented something, it is also important to search for prior art to determine whether your invention is novel and provides an inventive step.

Criteria for patentability:

- Novel
- Contains an inventive step
- Industrial applicability

These are the most important sources of patent information with free online access...

- Espacenet: <https://worldwide.espacenet.com>
- Google Patents: <https://patents.google.com/>
- Depatisnet: <https://depatisnet.dpma.de>
- United States Patent and Trademark Office: <https://www.uspto.gov/>

PLEASE NOTE!

Any kind of publication about the invention - even if communicated orally by the inventor - could be detrimental to the novelty aspect. If the invention is patentable, any information about it must not be published or otherwise disclosed beforehand.

Contact your TTO

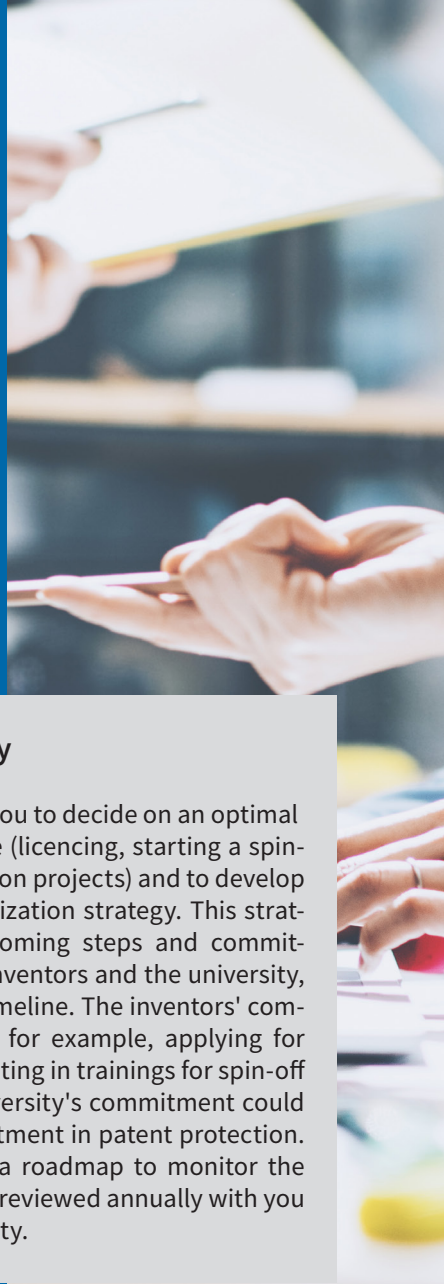
If you need to arrange a confidential disclosure agreement/non-disclosure agreement (see page 21) with any company or external collaborator.

Why consider getting a Patent?

Patents are crucial for the commercialization of inventions as they grant exclusive rights to use them, providing a competitive advantage in the marketplace.

Valorization strategy

The TTO will work with you to decide on an optimal commercialization route (licencing, starting a spin-off or industry cooperation projects) and to develop the corresponding valorization strategy. This strategy will detail the upcoming steps and commitments for both for the inventors and the university, key milestones, and a timeline. The inventors' commitment could include, for example, applying for new funding or participating in trainings for spin-off founders, while the university's commitment could include additional investment in patent protection. The strategy serves as a roadmap to monitor the patent's progress and is reviewed annually with you to ensure ongoing viability.



Patent Application Checklist

The following could be detrimental to the novelty of your invention and could prevent the grant of a patent:

- Past publications in a scientific journal
- Conference presentations
- Public presentations with no confidentiality agreement (such as a classroom lecture)
- A featured story on radio or television
- Online publication
- Former patent applications, even if they have not yet been published

In particular, bear in mind that:

- Master's theses or doctoral dissertations can be detrimental to the novelty factor if the author has not prohibited access to the paper and its contents.
- Publications can be submitted but will negatively affect the novelty factor as soon as the content is published. You should therefore exercise caution with regards to submitting applications and publications. Ask yourself: Do I want people to know about my findings?

Not detrimental to novelty:

- Communication, providing a non-disclosure agreement (NDA) has been signed
- Expert review provided by the Patent Office about the most recent technological developments
- Consultation with the university TTO

Roadmap to Patent Applications

Month
0

Invention Notification

By law, all employee inventions must be officially reported to the university. The university has a three month period from the date of reporting to decide if it wants to claim the invention or not.

Initial Application

If the university decides to back the invention and file a patent application, it will take care of drafting the patent specifications and filing the initial application. The date of filing this first application is called the priority date.

Priority year*

Month
12

Patent Applications in other Countries

Within a twelve-month period from the initial filing (= priority year*):

- EP – European Patent: patent applications within Europe
- PCT – Patent Cooperation Treaty: International patent application**
- Additional individual countries

*A patent application with the same priority date can be filed in other countries within the twelve-month period.

**PCT: The choice of this patent application secures the right to select the countries in which the patent protection is sought up to 30 months after filing the first application.

Our tip: We recommend filing the patent application in countries where there is a market or a suitable production location. Start thinking about these things as early as possible!

Month
18

Publication

After 18 months, the patent office will publish the patent application and (if available) a report on patentability.

Month
30

Nationalisation phase for PCT applications filed in month 12.

Examination

The patent office will review patentability and may require further information.

Patent Granted

The patent term is twenty years, starting from the date the application was filed.

Patent Not Granted



FAQs

☐ **Can I submit my paper for publication right after handing in the invention disclosure form?**

No, only after the patent application has been filed.

☐ **When am I allowed to publish a paper about the invention?**

After the university grants approval.

☐ **As the inventor, do I have to pay for the patent?**

No, as long as the university has claimed ownership.

☐ **Do I still have to notify the University about my invention even if I do not wish to apply for a patent?**

Yes.

When does patent protection come in to effect?

If a patent is granted, patent protection is retroactive, becoming effective starting on the date of patent application.

Who owns the invention?

The university, providing the university claims the invention within three months.

Do I still have to inform the university about my invention even if the rights have already been given to, say, a company?

Yes. The university will still need to claim the rights to the invention to then pass them on to the collaborating company.

Will I receive inventor remuneration?

When the university successfully licenses a particular patentable/patented invention, it distributes some of the net income generated to the inventors as inventor remuneration. Ask the TTO for more information.



**Can software be protected?**

Yes, in some cases where software solves a technical problem, software can be patent-protected. Please get in touch with the TTO for your specific case.

**Can I publish the software open source?**

Yes, the University supports an open-source policy. To publish the open-source software, we recommend you check any third-party requirements, contributions from all authors, and any incoming licenses within the software.

**Can I commercialize software which is published open-source?**

Yes, there is always a possibility. If you have questions in this regard, please get in touch with your TTO.

OPPORTUNITIES AFTER FILING

Your patent journey will consist of several opportunities to get the most out of your invention. Finding a successful option depends on what you want to do as well as the circumstances.

Which Route to Success best suits your Journey?

There are different routes to commercialising an invention. Depending on the technological area, the characteristics of the invention and the interests and personality of the inventor/s, some routes are more advisable than others. Your TTO will give you guidance.

1. License:

The patent is made available to one or more companies for a fee.

- + Lower financial risk
- Little control, lower profit

2. Industry Cooperation Projects:

A patent supports a cooperation effort together with a company.

- + Higher chance to acquire additional external funding and better market access
- Risk of selling below value or becoming dependent on the collaboration company

3. Starting your own Spin-off Company:

Start a company based on the patent.

- + Potentially large profits
- High degree of risk



Do you have an Entrepreneurial Personality?

Consider where you most likely see yourself and the invention in the future.

If you answered 'yes' to questions 1-3, then you should consider starting a business!

If you answered questions 3 and 4 with 'yes' then you should consider discussing with your TTO if a joint project combined with a license or an option agreement might be suitable.

If you only answered question 4 with a 'yes', then licensing the patent could be promising options!

1

Do I want to spend time commercialising my invention?

2

Do I want to bear the financial risk and burden?

3

Do I want to continue actively developing the invention?

4

Are there potential company partners interested in the invention?

Not sure? Your TTO is happy to meet with you to answer all of your questions.

Routes

1. Licenses

Most commonly, the university makes technologies available to companies by licensing its intellectual property. The company receives the right to use the technology in return for appropriate remuneration.

2. Working with Companies: Cooperation Projects

Cooperation projects with one or more companies might be an interesting option for exploiting your research results and gaining access to their expertise. Before starting negotiations with a company, please reach out to the contact point for Industry Relations as soon as possible (contact details on page 23). For the desired outcome, be well prepared (know your costs, project plan and potential project outcome i.e. impact). Our team will help you with budget calculations and contracts relating to industry projects as well as intellectual property, including:

- **Confidentiality Agreements:** Revealing confidential information to third parties such as other research institutions or companies can jeopardise later patent filings. The best protection is to set up a short written agreement between the parties, called CDA (Confidential Disclosure Agreement) or NDA (Non-disclosure Agreement) beforehand.
- **Material Transfer Agreement:** If you are planning to send or receive materials from other laboratories, research centres or companies, the rights and duties of the parties have to be formalised with a Material Transfer Agreement (MTA).

3. Starting your own Spin-off Company

A spin-off company commercializes intellectual property of the University of Vienna. For success it is crucial that you work with the TTO to develop a valorization strategy. The TTO will also arrange the necessary licence agreement to grant your spin-off the right to commercialize the intellectual property. The TTO and entrepreneurship team will help you to:

- protect your intellectual property
- evaluate market potential
- identify competitors and collaborators
- acquire entrepreneurial competences
- identify funding opportunities
- connections to relevant stakeholders

Entrepreneurship @ Uni Vienna

Do you have an idea that can make a difference in the world? Are you ready to transform your innovative idea into a thriving venture? Do you want to commercialize an invention? The Entrepreneurship Team will support you every step of the way. From expert guidance to resources and tools, we are here to help you make a meaningful impact.

Contact:

<https://entrepreneurship.univie.ac.at/>
entrepreneurship@univie.ac.at

Contacts

If you have any questions please contact the responsible units mentioned below.

Industry Relations:

wirtschaft.kooperation@univie.ac.at

<https://forschungsservice.univie.ac.at/en/industry-relations/>

Technology Transfer Office:

techtransfer@univie.ac.at

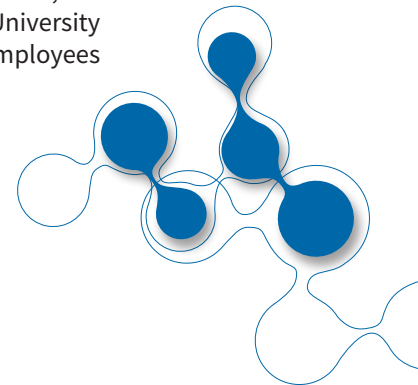
<https://transfer.univie.ac.at/>

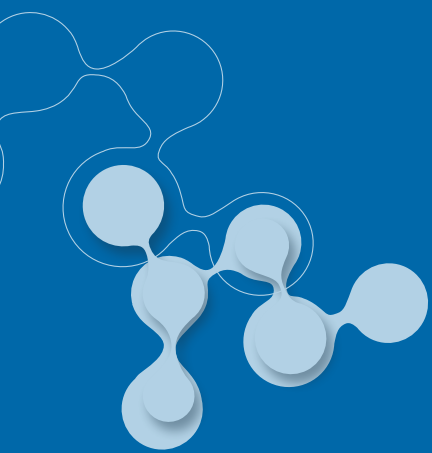
Entrepreneurship:

entrepreneurship@univie.ac.at

<https://entrepreneurship.univie.ac.at/>

The regulations in this guide are based on the applicable national and international legal framework and the university's policies. These include, among others, the Austrian Patent Law and Copyright Law and in particular the right of the University of Vienna to claim and exploit intellectual property and inventions of its employees in accordance with section 106 of the Universities Act.





Ready?

- ✓ Contact your university TTO.
- ✓ Provide them with any relevant information and contracts that you are aware of.
- ✓ Prepare any questions you might have for the initial meeting and think about your expectations regarding your technology.

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