

INVENTOR'S GUIDE

A GUIDE TO GROW THE IDEAS OF THE INVENTORS TO THE MARKET



UNIVERSIDAD
SAN SEBASTIAN
PROYECTO HUMANISTA CRISTIANO

OTLUSS

Oficina de Transferencia
y Licenciamiento

ABOUT THE OTL - USS

The Transfer and Licensing Office of the San Sebastián University is constituted as a support for the entire university community, in matters related to intellectual property and knowledge transfer with an impact on society. The new challenges posed by our institution guide us to encourage the development of science-based innovation, the generation of knowledge for our students and researchers, and at the same time to be protagonists of the future of our country

Information and Questions

If you require more information about this Inventor's guide or any questions in general, you can contact:

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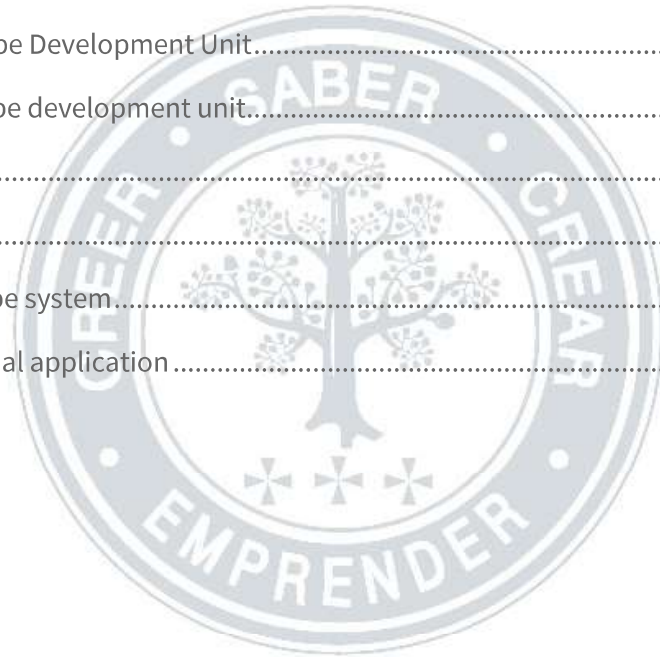
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1. What do we understand by Transfer?

Transfer is the process by which a transmission or transfer of knowledge that results from scientific and non-scientific research, the means and exploitation rights is carried out, towards society in general, to transform or create new products, processes or the provision of new services thus contributing to social welfare. Likewise, as a necessary element for the Transfer to materialize, it is necessary to define the role of innovation, which aims to create and provide added value to processes, products or services, forms of organization and business models, transforming them into tangible assets and commercially exploitable intangibles in each market. All the above cannot be carried out without Research and Development (R&D), which is the prior activity necessary to transform the results into innovations that will have an impact on society. The challenge is to identify the needs of the national industry and society in general so that these results achieve the expected benefits.

2. What is Intellectual Property?

In the broad and modern sense, intellectual property includes the rights relating to every creation of the human mind and ingenuity, such as inventions, utility models, industrial designs, industrial drawings, trademarks, appellations of origin, plant varieties, business secrets, topography of integrated circuits, geographical indications, literary and artistic works, etc. In Chile, two concepts are commonly used to encompass the different protected matters: Industrial Property and Copyright. Industrial Property: includes invention patents, utility models, trademarks, and geographical indications and appellations of origin. In Chile, the institution in charge of registering industrial property rights is the National Institute of Industrial Property (INAPI). The regulations that govern these rights are found in Law 19.039, and its respective Regulations.

Copyright: Copyright includes all rights related to the creation of works of the human intellect in the literary, artistic, and scientific domains, whatever their form of expression. Related rights protect the rights of performers over their performances, the rights of producers of phonograms over their recordings, and the rights of broadcasters over their radio and television programs.

In Chile, the institution in charge of the Register of copyright and related rights is the Department of Intellectual Rights, dependent on the Directorate of Libraries, Archives and Museums (DIBAM), of the Ministry of Education. Copyright and related rights are regulated in Law No. 17,336, on Intellectual Property and its respective Regulations.

2.1 What is an Invention Patent?

The patent is a right granted by a certain State to the applicant, so that the latter can manufacture, commercialize, and use the matter claimed in the patent exclusively in the market, for a specified time (general rule of 20 years).

The exclusive right is granted by a state institution that in Chile is called the National Institute of Industrial Property (hereinafter INAPI), in the United States of America it is called USPTO (United States Patent Office) and in Europe it is called EPO (European Patent Office) granting a commercial monopoly to the inventor, for the duration of said patent.

2.2 Other Types of Protection

Intellectual property comprises several figures to provide protection to the creations of the intellect, the following types of protection interact with each other and are essential in the process of technology transfer and in research and development (R&D).

2.2.1 Business Secrets:

All knowledge about products or industrial procedures that is not protected by a patent, whose maintenance in reserve provides a company or institution with a competitive advantage in the market.

2.2.2 Integrated Circuit Topographies:

It consists of an arrangement or three-dimensional scheme of elements that make up an integrated circuit. The architecture of the scheme and order of elements obeys the electronic function that said integrated circuit is going to perform.

2.2.3 Industrial Designs:

Includes any three-dimensional shape associated with any article, be it artisanal or industrial, for the elaboration of other units. The design must be distinguished from its peers by its geometric configuration and give rise to a special appearance.

2.2.4 Industrial Drawings:

Consists of an arrangement or set of figures, lines or colors that are developed in a plane (two-dimensional) for their incorporation into an industrial product.

2.2.5 Utility Models:

Any apparatus, instrument, tool, device and object or part thereof in which both its form and its function can be protected, if it produces a certain utility. Therefore, it only must be novel and have an industrial application.

2.2.6 Trademarks:

These are signs that allow the consumer to distinguish products, services, industrial and commercial establishments in the market in which they are marketed.

2.2.7 Plant Varieties:

The current legislation recognizes the right of every breeder, whether national or foreign, over his variety, granting him the exclusivity to multiply and commercialize the seed or plant of the protected variety during the term of the protection. The registration of a new variety is carried out in the Registry of Protected Varieties. Administered by the Agricultural and Livestock Service (SAG).

2.2.8 Geographical Indications:

They identify a certain product as originating from a place, region or country provided that they have a quality, reputation or other characteristic attributable to their geographical

2.3 What is considered an invention?

An invention is defined as: ANY SOLUTION TO A TECHNICAL PROBLEM THAT ORIGINATES AN INDUSTRIAL JOB (Law 19.039). This concept is understood in its broadest meaning and regardless of the economic feasibility to put it into practice.

The main characteristic of an invention is that it has to solve a problem of a technical or functional nature, and not of an aesthetic, artistic nature, etc. The main legal instrument to protect an invention is through an invention patent.

2.4 Requirements of a Patentable Invention

Not all inventions are patentable, for an invention to be patentable, it must meet 3 fundamental requirements: novelty, inventive level, and industrial application.



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a) It must be novel:

An invention is considered new or novel when it does not previously exist in the state of the art. The state of the art will include everything that has been disclosed or made accessible to the public, anywhere in the world,

through a publication in tangible form, sale, or commercialization, use or any other means, before the date of filing the patent application in Chile or the priority claimed according to the Paris Convention. Likewise, a patent application filed and published before INAPI or anywhere in the world prior to the application that is being examined and that has been published subsequently will be part of it.

b) Must have inventive level:

An invention is considered to have inventive level if, for a person normally skilled in the corresponding technical matter, it is not obvious nor would it have been derived in an obvious way from the state of the art. That is, the invention cannot be deduced from documents or other applications previously submitted by the technician or expert in the field. This is the most difficult requirement to apply as it is quite subjective.

c) It must have industrial application:

An invention is capable of industrial application when the claimed matter, in principle, can be produced or used in any type of industry. In these cases, the industrial term will be understood in its broadest sense, including activities such as: manufacturing, mining, construction, crafts, agriculture, forestry, and fishing.

2.5 Non-Patentable Matters

According to what is established in the Industrial Property Law No. 19,039, the following will be excluded from all protection by means of a patent:

a) **Discoveries, scientific theories, and mathematical methods.**

Discovery: Discovery of what was secret or hidden.

It is not considered an invention and therefore it is not patentable.

b) **Plants and animals.**

Except for microorganisms that meet the general conditions of patentability. (3 conditions of patentability: novelty, inventive level and industrial application).

c) **Essentially biological procedures to produce plants and animals are not patentable either.**

But if the microbiological procedures to produce plants and animals are patentable. For these purposes, an essentially biological procedure is one that consists entirely of natural phenomena, such as crossing and selection.

d) **The systems, methods, principles or economic, financial, commercial, business or simple verification and control systems, methods, principles or plans are not patentable; and those referring to purely mental or intellectual activities or to gambling matters.**

e) **Surgical or therapeutic treatment methods of the human or animal body are not patentable, as well as diagnostic methods applied to the human or animal body, except for products intended to put one of these methods into practice.**

f) **f) The new use, change of shape, change of dimensions, change of proportions or change of materials of articles, objects or elements known and used for certain purposes is not patentable.**

In any case, the new use of known articles, objects or elements may be patentable, provided that said new use solves a technical problem without prior solution, to the extent that it meets the requirements of novelty, inventive level and industrial application and that it requires of a change in the dimensions, in the proportions or in the materials of the article, object or known element to obtain the quote.

g) Part of living beings as they are found in nature, natural biological processes, biological material existing in nature or that which can be isolated, including genome or germplasm.

However, they will be susceptible to protection:

1. the procedures that use one or more of the biological materials listed above; and
2. the products directly obtained by them.

As long as:

1. which satisfy the novelty, inventive level and industrial application.
2. that the biological material is adequately described and
3. that the industrial application of the same is explicitly stated in the patent application.

Finally, inventions whose commercial exploitation must necessarily be prevented in order to:

1. Protect public order, state security, morals and good manners, health or life of people or animals,
2. Preserve plants or the environment, provided that this exclusion is not made only because there is a legal or administrative provision that prohibits or regulates said exploitation.

2.6. Rights Conferred by a Patent

The rights conferred by a Registered Patent are the following:

- a) The exclusive manufacture and commercialization of the protected product or process.
- b) The exclusive use of the invention.
- c) The authorization to third parties of its use through a license.
- d) The exercise of civil and criminal actions pertinent to the protection, compensation for the damage caused and for the seizure and destruction of merchandise that infringes the patent.
- e) The commercial monopoly in the countries where the invention is protected.

3. Presentation and Processing of a Patent Application for Invention

The San Sebastián University Transfer and Licensing Office (OTL USS) will be the body in charge of coordinating and supervising the presentation and processing of an application for an invention patent or other means of protecting intellectual property. The application for an invention patent may be processed in Chile before INAPI, as well as in other countries according to the market that interests the applicant or owner. To apply for a patent abroad there are two conventions that regulate it: the Paris Convention and the Patent Cooperation Treaty (PCT).

3.1 Processing before the National Institute of Industrial Property

Obtaining a patent requires compliance with a series of formalities and requirements, which constitute a procedure with different stages (figure 1).

Stages before INAPI

1. Presentation of the application

Background Contents:

The application for an invention patent consists of the following documents:

Application Sheet and Technical Sheet

The Application Sheet and Technical Sheet forms that are for sale at INAPI or printed via the web, free of charge.

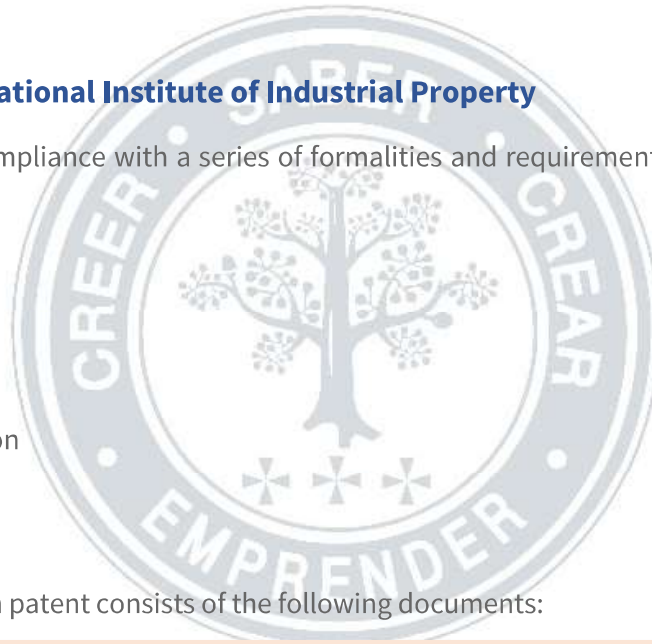
• Descriptive memory

It is a document that contains a clear and complete description of the matter to be protected through the patent.

- Description of what is known on the subject
- Description of the accompanying drawings if they exist.
- Detailed description of the invention.
- Application example, where applicable.

• List of claims

It is a document that comprises the set of clear and concise descriptions that define the technical matter



2. Examination of Form

The National Institute of Industrial Property must carry out a preliminary examination aimed at verifying that the required documents have been accompanied and that they meet the minimum formal requirements to continue with the processing.

In the Preliminary Exam it may happen that:

a) There are observations: The applicant must answer the observations within a period of 60 business days, making the necessary corrections or accompanying the documents required by the authority. In case of not answering the observations, the request will be considered as not submitted. Once corrected, it is published within 60 business days from the resolution ordering its acceptance.

b) There are no observations: The applicant must request the publication of an extract of the application to the Official Gazette within a period of 60 business days, counted from the date of acceptance for processing.

3. Publication of the Application

If the request is not published within the 60-day period, said request remains ABANDONED. The unarchiving of the application may be requested within 120 business days after the abandonment resolution. Otherwise, the request is permanently archived.

Opposition

Within a period of 45 days, from the publication of the extract of the application in the Official Gazette, any interested third party may file opposition to the application for an invention patent, invoking one of the grounds established in the law. (Article 5 Law No. 19.039).

Payment of the Expert Fee

Within a period of 60 days once the period for filing an opposition has expired, the applicant must pay the amount corresponding to the expert's fees and accredit his payment in INAPI. If the payment is not credited, the request will be understood as Abandoned.

4. Appointment of the Expert

After paying the expert fee, INAPI proceeds to appoint an expert, an expert in the technical area of the application. Once the position is accepted by the Expert, he must issue an expert report within a period of 60 days, with the technical analysis of the application and compliance with the patentability requirements.

5. Examination of Merits - Expert Report

The substantive examination consists of a technical analysis of the application, aimed at verifying whether they meet the patentability requirements established in Law No. 19,039.

The expert must issue his report within a period of 60 business days, counted from the date in which he accepted the position.

The substantive examination may or may not contain observations on the request that must be notified. The expert report makes observations

In turn, the expert report may contain observations from the expert, in this case the applicant

You have 60 business days to respond to the expert's observations.

If there are no observations, the request goes to formal review and is ready to be accepted.

6. Final Resolution

If the application meets the patentability requirements established in Law No. 19,039, the National Director of INAPI will proceed to issue the resolution of acceptance to registration that grants industrial property law.

Definitive Acceptance

Once the formal review is concluded, the National Director of INAPI issues the resolution granting the

invention patent.

Payment of rights and Accreditation

Once the patent application is accepted, the applicant must pay and credit within 60 business days from the notification of the acceptance resolution.

If the payment and accreditation are not made within said period, the patent application will be in the abandoned condition.

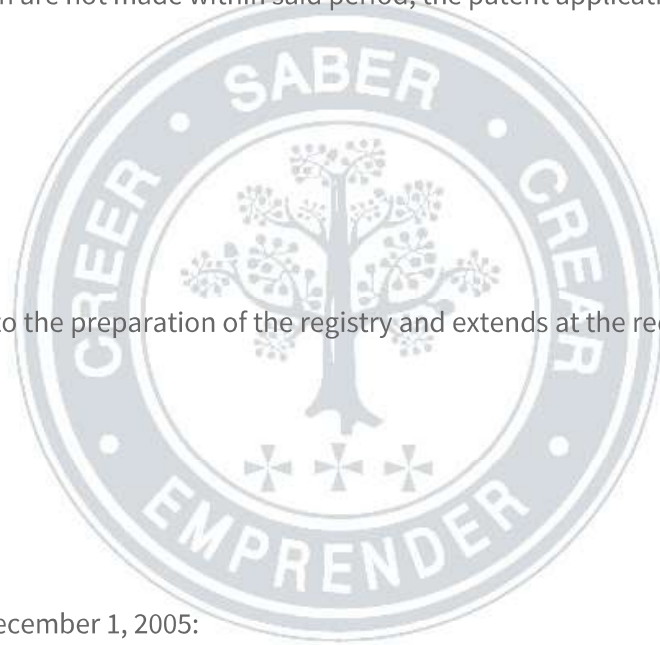
Qualification

Consecutively, INAPI proceeds to the preparation of the registry and extends at the request of the interested party the title that

7. Term of Validity

Applications submitted since December 1, 2005:

The validity of an invention patent is 20 YEARS from the filing date of the application in INAPI.



3.2. Processing of a Patent Application - Paris Convention

The Paris Convention of 1883 broadly regulates industrial property, since it includes regulations on patents, trademarks, industrial designs, utility models, trade names, geographical names, and unfair competition. This Agreement for the Protection of Intellectual Property was ratified by Chile in 1991.

The Convention establishes the traditional way to apply for patents worldwide. This means that the applicant must file independent patent applications in each territory or country subscribed to the Paris treaty.

Also, the granting of a patent in a contracting state does not oblige the other contracting states to grant a patent as each contracting country acts independently.

According to Article 5 of the Convention, the applicant for an application for an invention patent in one of the contracting countries, will enjoy, to make the deposit in the other countries, a right of priority.

The right of priority is that the applicant can claim the priority of an earlier application over applications subsequently filed abroad, but the latter must be filed within 12 months from the date of the first application.

The foregoing means that in practice the interested party must file patent applications in all countries in which he wishes to protect his invention within 1 year after filing the first application.

3.3 Processing of a PCT Invention Patent Application

The Patent Cooperation Treaty is an international convention that efficiently complements the Paris Convention. As a consequence, the 12-month priority period was extended, which was estimated to be very short, given the increase in the number of patents worldwide, the technical documentation for preliminary searches was increased, and an international search for the same invention was implemented. Essentially through the PCT treaty the priority was extended from 12 to 30 months.

The PCT agreement gives the applicant a period of 30 months from the filing date of the first application (priority) to apply to the national (or regional) patent offices of each of the countries in which you want to process an invention patent.

The processing of a PCT patent application is divided into two phases.

I. The International Phase that is processed before the receiving Office, the International Office (WIPO) and the Administration in charge of the international search and international preliminary examination.

II. The National Phase takes place before the offices designated by the PCT applicant.

I. International Phase.

Filing the PCT application: The applicant files an international application with a national patent Office or with WIPO (all of the above called “Receiving Office”).

International Search Report (ISR-International Search Report) and the Written Opinion of the Administration in charge of the search: The Administration in charge of the international search or ISA (International Searching Authority) issues a non-binding opinion on whether the matter protected by the application it is capable of being protected through a patent and if it complies with the patentability requirements (only the novelty and inventive level are analyzed).

If the International Search Report (ISR-International Search Report) is favorable for the submitted application, the Transfer and Licensing Office may decide to continue processing the respective application and considering the non-binding opinion of the ISA as a guide.

In the event of an unfavorable Report (ISR) with respect to the matter claimed in the application, the applicant has the right to make the necessary modifications to the claims to adjust them to what is determined in the report. Such modifications must be submitted to the International Bureau of WIPO or else the applicant may decide to abandon the procedure.

The applicant may request, if he deems it necessary, another international search with respect to those documents of the state of the art that were not found in the first search carried out by the Authority.

Publication of the PCT application and the Search Report (ISR): The content of the international application filed is published and disclosed after 18 months from the filing of the first application. The publication is produced on the WIPO website called Patentscope and the ISR is published jointly.

International Preliminary Examination of Patentability: The purpose of the exam is to analyze the PCT application for the second time according to the same criteria used in the Written Opinion issued by the Administration in charge of the international search.

At this stage, the applicant can still modify the PCT application in order to adjust and correct the observations that were made according to the International Search Report and the Written Opinion of the Administration, before entering the national phase of the PCT processing.

Once these steps have been taken, the Administration in charge of the international search will issue an international preliminary report on patentability (IPRP).

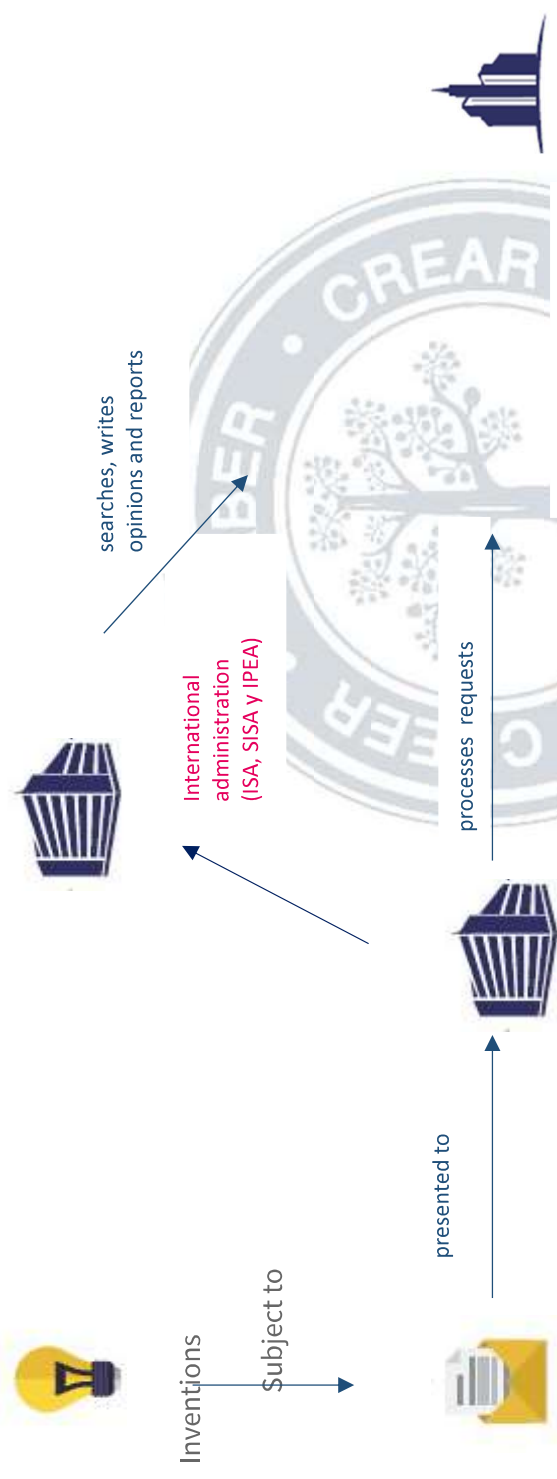
The IPRP contains a preliminary and non-binding opinion that analyzes whether the claimed matter meets the requirements of novelty, inventive level and is susceptible to industrial application. The foregoing gives a clear report to the applicant of the possibility of continuing with the process of patenting the invention.

II. National Phase

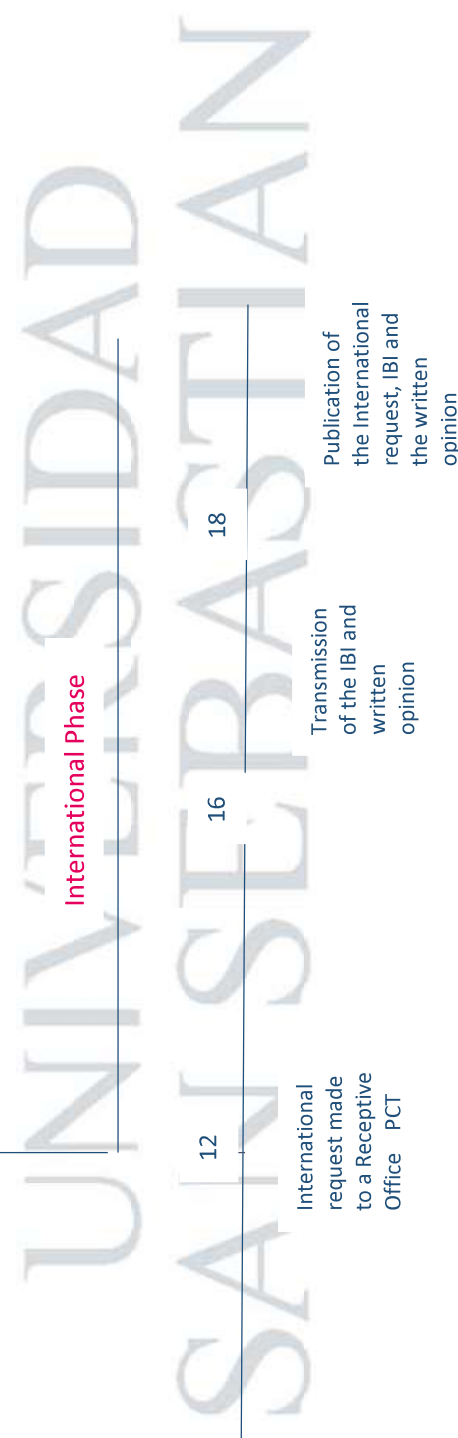
Once the applicant decides to continue with the processing of the PCT application and has designated the countries or states of her choice, he must comply with the requirements established by each national Patent Office.

Some national requirements some are for example.

- Payment of national fees;
- The submission of translations of the application;
- The appointment of a representative or local representatives.



As from the priority date:



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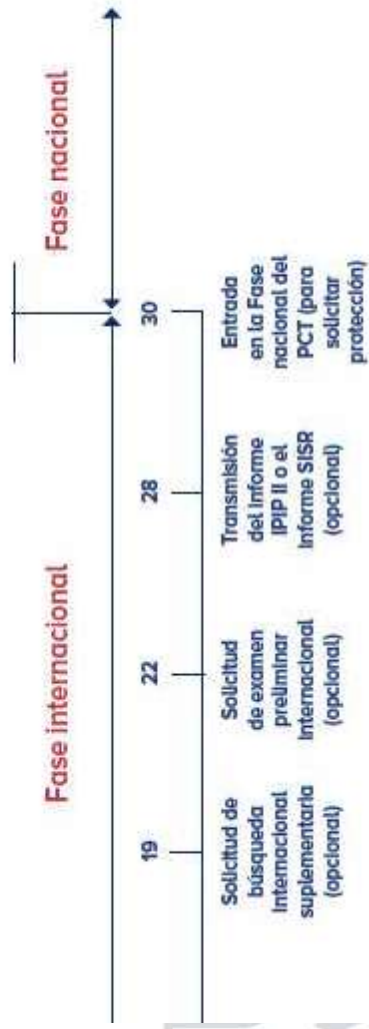
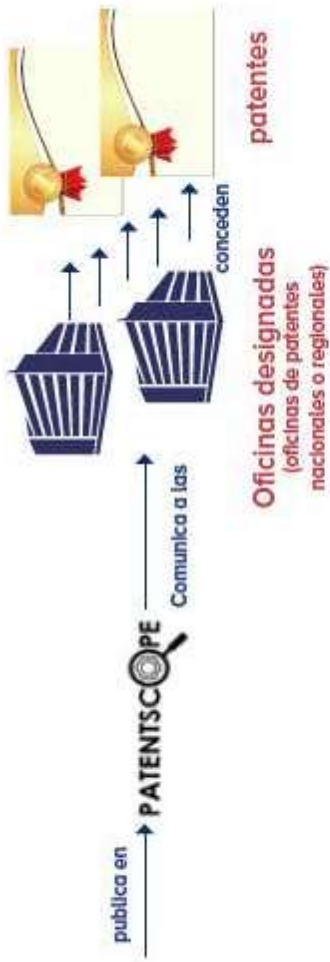


Fig 2. Tramitación de una solicitud de patente de invención vía PCT (Patent Cooperation Treaty)

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4. Procedures Prior to Submitting an application

4.1 Declaration of Invention Form

The form is a document that contains the detailed description of the invention (Annex 1). This form must be sent to the OFFICE OF TRANSFER AND LICENSING, which will be the authority in charge of determining the feasibility of protecting the intellectual property related to the invention and its possible commercial applications (Art. 11, DR No37 / 2017).

The form is a confidential document.

4.2 Why should I submit a Declaration Form?

It is vital to inform the Transfer and Licensing Office about a potential invention, since it begins a process that could culminate in the commercialization and licensing of the technology, to make the transfer of a technology or Know How possible.

4.3 Who is the Owner of the Created?

As a general rule, the University owns all intellectual property rights over the creations of its officials. The foregoing is provided by the Intellectual Property Regulations of the University. Art. 2 DR No37 / 2017)

4.4 What Benefits Does the Inventor Get?

If the invention is commercialized and licensed, a benefit mechanism is established in favor of the Inventor treated in the Intellectual Property Regulation. (Art.14 DR No37 / 2017)

4.5 The Role of the Transfer and Licensing Office

The Office of Transfer and Licensing is a unit dedicated to the transfer, licensing, and commercialization of the one developed within the San Sebastián University. The Office of Transfer and Licensing works in conjunction with university researchers and external consultants to achieve the transfer of technology created at the University.

5. What is a License?

The license is an authorization or permit issued by the owner of an intellectual property right in favor of a third party, so that the latter can exploit all or some rights of the owner in a specified geographical area.

The authorization is embodied in a license agreement where all the rights and obligations between the parties are governed. The owner of the intellectual property right is called the

Licensor and the authorized third party are called the Licensee.

The Office of Transfer and Licensing selects the licensees who have the capacity to invest in the development of the technology or invention to market it and grant the benefits that come to society.

6. Costs involved in the patenting process

6.1 Patent Application in Chile

A patent application in Chile can cost approximately between: √ 130 to 190 UF.

6.2 Patent application by Paris Convention

The direct filing of a patent application through the Paris Convention with a patent office abroad costs approximately between:

√ US \$ 4,000 and US \$ 15,000 per country. The above costs depend on each patent office.

6.3 PCT Patent Application

According to the PCT patent system there are three fees to pay:

√ Presentation fee: in the order of US \$ 1,400. If the applicant is a natural person, there is a 90% discount on the rate.

√ Search fee: between US \$ 300 to US \$ 1,200.

√ Transmission rate: US \$ 100 to US \$ 140.

7. Copyright

Copyright consists of the legal protection granted to the authors and creators of an artistic, literary work, software and database. It also applies to performances by artists, phonograms and broadcasts. Copyright is regulated by Law No. 17,336.

7.1 Economic rights

Copyright includes economic rights and moral rights. The patrimonial right allows the owner the economic exploitation of the use of his works by others, conferring the power to carry out all kinds of contracts and actions such as publication, reproduction, adaptation, transfer of rights or authorizing third parties to use the work. The right can be sold, assigned and transferred.

7.2 Moral rights

The moral right consists of the recognition of the paternity of the author over his work and empowers to decide on the integrity of the same as to oppose any deformation, mutilation or change without his approval, to keep the work unpublished and the authorization to third parties to finish its other unfinished. This right is inalienable and inalienable.

7.3 Related law

Related rights (of broadcasting) to copyright, artists, performers and performers are granted to allow or prohibit the dissemination of their productions and to receive remuneration for the public use of them.

7.4 Characteristics of Copyright

How long does copyright protect an individual work?

The legal protection for a work extends from the entire life of the author and up to 70 more years from the date of his death. In the case of computer programs, it extends up to 70 years from its first publication.

In the case of neighboring rights related to performers, unfixed performances and producers of phonograms, the protection extends for 70 years from publication. In the case of broadcasts from broadcasting organizations, it is protected for 50 years from December 31 of the year of transmission.

What are the works that are protected by copyright law?

Copyright law protects books, brochures, articles and writings, lectures, speeches, lessons, memoirs, comments, dramatic, dramatic-musical and theatrical works, choreographic, pantomimic, musical compositions with or without text, radio or television adaptations, literary production, works originally produced by radio or television, scripts and scripts, photographs, engravings, lithographs, cinematographic works, projects, sketches, architectural models, mapping system, geographical or armillary spheres, relative plastics related to geography, topography, painting, drawings, illustrations, sculptures and works of similar figurative arts, scenographic sketches and their respective scenographies, adaptations, translations and other transformations when they have been authorized by the author of the work, videograms and slides, computer programs (as source program or object program) and preparatory documentation or technical description or user manuals, compilations of data or other materials, drawing and model textiles.

Application of copyright in special cases

Law No. 17,336 mentions different specific cases, indicating that the law is applied in the following way:

Computer programs are copyright holders of persons who's dependent, in the exercise of their work functions, produce them or commission the production of a program from a third party, unless otherwise agreed.

The works produced by officials in the performance of their duties, will be holders of copyright the state, municipalities, official corporations, semi-fiscal or autonomous institutions and other state legal entities, unless a resolution that releases the work to form part of the cultural heritage common.

Articles, drawings, photographs and other productions contributed by personnel subject to an employment contract in newspapers, magazines and other periodical publications: the journalistic company obtains the right to publish in the newspaper, magazine or newspaper where the author provides his services, withholding the author all other rights.

Productions commissioned by broadcast media from people not subject to an employment contract: the broadcast media will have the right to publish the first edition.

What is the cost of registering in the Intellectual Property Registry?

In Chile, the institution in charge of managing the registry related to copyright and related rights is the Directorate of Libraries, Archives and Museums (DIBAM), through the Department of Intellectual Rights (DDI). The cost of registration depends on the type of work to be protected and the value is calculated based on a percentage of the UTM. In the case of engineering, architecture and computer programs projects, the value reaches \$ 16,450.

For more information, visit the website: <http://www.propiedadintelectual.cl/sitio/>

8. Transfer management in the USS

The OTL USS's mission is to protect, promote and transfer the results of the University's research, in order to increase ties with the environment and contribute to the social, economic and cultural development of our country and, in particular, of the regions in which the Universidad San Sebastián carries out its activities.

Regular communication between the researcher and the OTL USS team is vital to ensure that the interpretation of the researcher's objectives is correct, and that management is proceeding according to scheduled timeframes and budgets.

The policy for the treatment of the research results received by the OTL USS will be evaluated on a case-by-case basis, identifying the most appropriate strategy to follow, both to support the management of the intellectual property that derives from the evaluation, and when there is none, channeling initiatives in a specific direction within the field of R + D + i + e.

The instruments and their specifications to operate the policy are detailed in official documents No. 36/2017 Decree of Creation of the Office of Transfer and Licensing of the San Sebastián University, No. 37/2017 Regulation of Intellectual Property, and Industrial Property of the University San Sebastián, and No 38/2017 Regulation on Spin Off Companies, Transfer and Licensing.

The OTL USS has formal and defined mechanisms for the transfer of technologies developed by its academics and associated with other institutions. In this regard, the transfer strategy is approached from three dimensions:

1. **Technology Development:** In this line of work, the level of development of the projects generated by the researchers is evaluated according to the methodology called "Technology Readiness Level" or TRL. This methodology is an accepted way to measure the degree of maturity of a technology (See Annex 2).
2. **Protection Strategy.** The most efficient strategy is defined to start the protection process, either via copyright or industrial property. The procedure for the licensing of technologies is described in Decree No. 38/2017 Regulation on Spin Off, Transfer and Licensing companies of the San Sebastián University.
3. **Marketing Strategy:** It is based on the requirements of the end users such as: key factors for the acquisition, final characteristics of the product / service, distribution expectations, required certifications, after-sales services, among others.

8.1 Transfer Processes

h) Licensing (Art 10 to 12, DR No. 38/2017)

It will be the responsibility of the Directorate of General Research and the Office of Transfer and Licensing or the unit that exercises its functions, to promote the transfer of technology owned by the University to third parties, the administration of the rights of inventions, their commercial evaluation, and the negotiation of licensing, transfer and sale agreements for said inventions.

Any member of the University community who, according to this Regulation, considers that an invention, development, creation, or other intangible is susceptible to legal protection corresponding to the University, must communicate it through the Declaration of Invention Form in writing to the Office of Transfer and Licensing, from the University (OTL USS).

Such statement shall include all relevant documentation for a detailed description of the prior work of the invention or creation and its potential use. The Transfer and Licensing Office or the body designated by the University, will establish the ownership of the work or invention and under what conditions and restrictions.

The declaration will be made through a Declaration of Invention Form that will be delivered by the OTL USS to the inventor or member of the University community.

The OTL USS will be responsible for ruling on the ownership of the intellectual property of an invention, creation or other intangible subject to protection, which will be issued after the analysis of the Declaration of Invention Form and the antecedents presented to the OTL USS. This pronouncement will establish the ownership of the intellectual property rights in accordance with the provisions of this Regulation.

If the OTL USS determines that the University has the right to a certain invention, creation or other intangible subject to protection, the inventor or member of the university community must assign all the intellectual property rights of the invention, creation or intangible to the University, also having to assist and cooperate in the application and registration process before the pertinent administrative authorities.

If disputes or differences arise as to the ownership of an invention, creation or intangible, said discrepancies may be the subject of an appeal before the Intellectual and Industrial Property Committee of the University.

The Intellectual and Industrial Property Committee of the San Sebastián University will be composed of the Academic Vice-Rector, who will preside over it, the Vice-Rector for Economic and Administrative Affairs, the General Director of Research, and a Lawyer specialized in intellectual and industrial property appointed by the Secretary General. The Director of the OTL USS will act as Executive Secretary of the Committee.

The functions of the Intellectual and Industrial Property Committee are as follows:

- a) Propose institutional policies on Intellectual and Industrial Property.
- b) Propose criteria and general principles to determine the origin and convenience of requesting the legal protection of an invention, as well as on the commercialization and / or transfer of such right, in any way.
- c) Study the convenience and origin of requesting the protection of the invention that is presented, for which the circumstance of complying with the legal requirements, the possible commercialization of the invention and future projections of the same must take special consideration.
- d) Resolve discrepancies or differences regarding the ownership of an invention, creation or intangible.
- e) Evaluate applications for approval of Spin Off companies as well as the functions assigned by the Regulation on Spin Off Companies, Transfer and Licensing.
- f) Spin Off (Art 4 DR N 38° / 2017).

Members of the University Community and / or graduates interested in the creation or recognition of a Spin Off company must submit the application to the Transfer and Licensing Office of the San Sebastián University, hereinafter also OTL USS, which will oversee processing application.

The request must be addressed to the Transfer and Licensing Office of the Universidad San Sebastián including the following information:

- a) The names and data necessary to identify the interested parties and their relationship with the university.
- b) General description of the project, indicating the use of university assets, dedication of researchers, conditions of use of the Technology, among others. The application must describe an economically and technically viable venture.
- c) A business plan, a market study, the financing program and the identification of the Technology belonging to the University to be exploited.

d) That the antecedents have been previously approved by the dean or deans of whose faculties those who have developed the technology are members. In the absence of a responsible Dean, the person in charge of the respective unit will be responsible.

The OTL USS may require any other additional information that is necessary and deems appropriate for the processing of the request.

i) Economic Remuneration from Industrial and Intellectual Property.

The OTL USS or the entity determined by the University, will distribute the economic benefits, if any, from the sale, licensing, and commercialization of intellectual and / or industrial property rights, as follows:

- 15% for the Transfer and Licensing Office.
- The remainder will be distributed as follows:
 - 50% for the creator (s), researcher (s) or inventor (s).
 - 20% for the Faculty, Center or Institute.
 - 30% for the General Directorate of Research

For the purposes of this Regulation, an economic benefit from the licensing of intellectual and / or industrial property rights will be understood as the result of subtracting from the income obtained all direct expenses related to the process of valuation, protection, administrative / judicial defense, taxation, licensing and transfer.

In the event that income is generated from the licensing of a certain intangible, all direct expenses of the protection and licensing processes will be paid first. The surplus will be distributed according to what is established in numeral 14.1 of DR No 38/2017, of the Regulation of Intellectual Property and Industrial Property.

This will not apply to the intellectual and / or industrial property developed by the University for a third party or that intellectual and / or industrial property that is regulated by specific agreements between the University and third parties.

Information and Questions

If you require more information about this Inventor's guide or any questions in general, you can contact:



Transfer and Licensing Office of the Universidad San Sebastián (OTL USS)

Address: Lota 2465, Providencia, Santiago

Phone: 22606602

Email: otl@uss.cl

Website: www.uss.cl/investigacion/otl/

Executive Director OTL USS

Fabian Celis M.

Phone: 22606866

Email: fabian.celis@uss.cl

Annex 2: Technology Readiness Level (TRL)

In the evaluation of projects, the range of technological maturity level or Technology Readiness Level (TRL) is applied. This scale is an adaptation of the Regional Program of the scale that has begun to be used in the calls for grants of the new Research Framework Program (2014-2020), better known as H2020, and that arises from the original prepared by NASA (1995).

TRL 0: IDEA

Unproven ideas or concepts that have not been tested or peer reviewed.

TRL 1: Basic Research

The initial scientific investigation has been completed. The basic principles of the idea have been qualitatively postulated and observed. Schemes of the process have been identified. There is no experimental evidence and detailed analyzes are still available.

TRL 2: Formulation of technology

The concept of technology, its application and its implementation have been formulated. The development plan is outlined. Studies and small experiments provide a “proof of concept” for technology concepts.

TRL 3: Applied Research

The first laboratory tests have been completed. The concept and processes have been demonstrated on a laboratory scale or benchtop experiments. The potential of the materials and scaling issues have been identified.

TRL 4: Small Scale Prototype Development Unit

The components of the technology have been identified. A prototype development unit has been built in a laboratory and in a controlled environment. Operations have provided data to identify expansion potential and operational issues. The measurements validate the analytical predictions of the different elements of the technology. The simulation of the processes has been validated.

TRL 5: Large-scale prototype development unit

The technology has been qualified through testing in the intended, simulated or real environment. The new hardware is ready for the first use. Process modeling is refined (technically and economically). Life cycle assessments and

economic assessment models have been validated. When relevant for its subsequent expansion, the following concepts have been identified: health and safety, environmental limitations, regulation and availability of resources.

TRL 6: Prototype system

Components and processes have been expanded to demonstrate industrial potential and their integration into the energy system. Hardware has been modified and expanded. Most of the issues identified above have been resolved. The full commercial scale system has been identified and modeled. Life cycle assessment and economic assessment have perfected.

TRL 7: Demo system

The technology has been shown to work and operate on a pre-commercial scale. Final manufacturing and operational issues have been identified. Minor tech issues have been resolved. Life cycle assessment and economic assessment have been refined.

TRL 8: First commercial type system

The technology has been shown to work commercially through large-scale application. All operational and manufacturing issues have been resolved.

TRL 9: Complete commercial application

The technology has been fully developed and is commercially available to any consumer.



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