Intellectual Property Management

Overview

NSF IPLER Project

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IP Policy 3.0 Provides Governance

- Applies to faculty, staff, students, contractors, adjunct faculty
- Provides creator rewards for patented IP and commercialization for all IP
- Cites researchers need to comply with terms and conditions relating to IP reporting under US government and industrial research projects
IPMO Functions

- Identify IP in conjunction with the researchers
- Capture and protect IP via our invention disclosure and patenting procedure or via copyright notification
- Commercialize the IP via licensing to others to make and sell, or distribute
  - Exclusive field of use licenses
  - Non-exclusive licenses
Sponsor Notification

- Research agreements call out sponsor notification, either upfront or during the research program
  - Background IP (BIP)
  - Foreground IP (Project IP)
Commercial Sponsors and IP

- Notification of IP creation, especially of patentable IP, during the research is provided
- Licensing rights spectrum is usually provided for this foreground IP
  - Non-exclusive
  - Exclusive option period-typical
- License agreement crafted with Sponsor if desired
Commercial Sponsors and IP

- Background IP may be an enabler for the project
  - Identified in the proposal
  - Included later upon mutual agreement
- Licenses to BIP can be negotiated as well
US Government Sponsors and IP

  - Universities to collaborate with industry to commercialize the IP
  - Leads to BIP that can be licensed to industry; thereby can lower industry’s costs for R&D
Bayh-Dole Act Highlights

- Inventors to disclose inventions under the contract and assign title to the university
- University to disclose invention to the funding agency along a specified time table
- Submitting of periodic reports to funding agency if election of title is made by university
- Exclusive licensee’s must substantially make the “licensed product” in the US or gain a waiver
- No assignment of IP is allowed except to patent management organizations
- Sharing with the inventors a portion of revenue from licensing the invention
Remember

- RIT is not in the business of making and selling products—we can’t compete with licensees
  - Therefore we want to license IP to commercialization organizations under fair and reasonable terms
    - Under our Policy and under the needs of Bayh-Dole we are able to reward the IP creators as well as the university for these innovations
    - We want terms in any license to not detract from but enable the licensee to be successful otherwise we all lose