

INVENTIONS

creativity

ideas

LICENSES

technologies

COMMERCIALIZATION

markets

products

R·I·T

Intellectual Property Management

Overview

NSF IPLER Project

October 30, 2009

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10/30/2009



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

- ◆ University retains all rights and title to commercialize the IP via the Bayh-Dole Act of 1980 (Effective July 1, 1981) (37 CFR Part 401), “Rights to Inventions Made by Nonprofit Organizations and Small Business Firms”
 - 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