

IP AND ACADEMIA

Session 1
August

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Purpose

- We believe innovation from academic research can make a positive difference in the world. The Purpose of OTD is to help OU researchers transform ideas into tangible impact for the betterment of society.

Mission

- The Mission of OTD is to provide the highest level of fiduciary expertise for the perfection, conveyance and commercialization of OU IP.

Vision

- To be recognized as a driving force for OU's economic impact through education, expertise and efficiency.

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TOPICS FOR DISCUSSION

1. Types of intellectual property ("IP") and why does IP matter?
2. IP and Sponsored Research.
3. Common IP-based agreements.

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TYPES OF IP

- **Patents** (35 U.S.C.)
  - Protects devices, compounds/compositions, methods
  - Requirements: Eligible subject matter, Useful, Novel, Non-obvious
  - Patents will be discussed in next seminar in this series
- **Copyrights** (17 U.S.C.)
  - Protects original works of authorship fixed in a tangible medium (the "right to copy")
- **Trademarks** (15 U.S.C.)
  - Identifies the source of a good or service so as create consumer confidence (a mark or design used in trade).
- **Trade Secrets** (common in corporations, not universities)
- **Know-How** (non-traditional IP that has commercial value)

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WHAT IS THE IMPACT/IMPORTANCE OF IP?

- IP protection facilitates the continued development and commercialization of discoveries from research.
- IP can generate individual and institutional revenue via commercialization activities and sponsored research agreements.
- IP can impact and foster individual and institutional prestige and reputation.
- IP-based agreements facilitate the protection of a PI's rights to teach, publish, and research.
- Bayh-Dole (Patent and Trademark Law Amendments Act, Pub. L. 96-517, December 12, 1980).

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IP AND SPONSORED RESEARCH

- Coordinated effort by and between the PI, the Sponsored Programs Office ("ORS" and "ORA"), and the Office of Technology Development ("OTD").
- IP Ownership Mantra: "Our's is our's, their's is their's, joint is joint."
  - Fundamental research vs. Work-Made-For- Hire
  - IRS Rev. Proc. 2007-47, UBIT-related issues.
- Preservation of publication rights and academic freedom(s).

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COMMON IP-BASED AGREEMENTS

- The vast majority of IP-based agreements/contracts are administered, negotiated, and managed by OTD and ORS/ORA.
  - Material Transfer Agreements ("MTA")
  - Non-Disclosure/Confidentiality Agreements ("NDA")
  - Inter-Institutional Agreements ("IIA")
  - Intellectual Property Agreements ("IPA")
  - License Agreements (Research and Commercial (Non-Exclusive, or Exclusive))
  - Sponsored Research Agreements ("SRA")
  - Clinical Trial Agreements ("CTA")
  - Service Agreements ("SA")
  - Facility Use Agreements ("FUA")

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NEXT UP IN THE DISCUSSION SERIES

Patents 101: Patents 101: First Do No Harm (How to write and speak about your invention without losing patent rights)

Presented by Dr. Chris Corbett,

Director of Intellectual Property

QUESTIONS?