



IP AND ACADEMIA

Session 1

September 27th & 28th

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TOPICS FOR DISCUSSION

1. Types of intellectual property (“IP”) and why does IP matter?
2. University IP Policy
3. IP and Sponsored Research.
4. Common IP-based agreements.

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.

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)

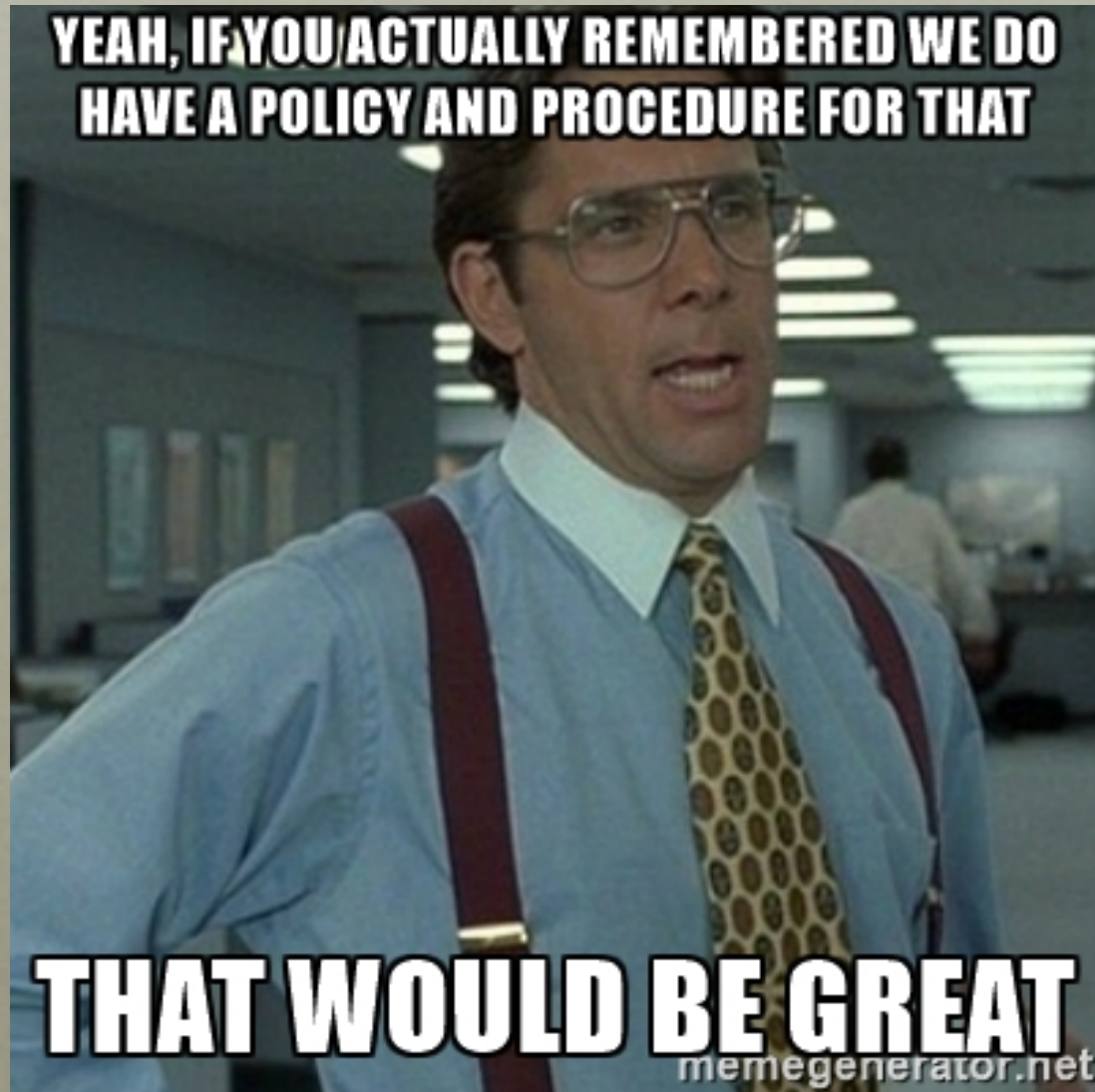
WHAT IS THE IMPACT/IMPORTANCE OF IP?

- 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).

BAYH-DOLE

- Universities may elect to retain title to innovations developed under federally-funded research programs
- Universities are expected to file patents on inventions they elect to own
- Universities are expected to give licensing preference to small businesses
- The government retains a non-exclusive license to practice the patent throughout the world and the government retains march-in rights.

UNIVERSITY IP POLICY



UNIVERSITY IP POLICY

- Norman Faculty Handbook 3.29 and OUHSC Section 4.3
- “All discoveries and inventions, whether patentable or unpatentable, and including any and all patents (domestic and foreign) based thereon and applications for such patents, which are made or conceived by any member of the faculty, staff, or student body of The University of Oklahoma, either in the course and/or scope of employment for The University of Oklahoma or substantially through the use of facilities or funds provided by or through the University shall be owned by and be the property of the Board of Regents of the University of Oklahoma ”
- Outlines ownership, revenue share, disclosure and administration

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.”
 - Preservation of publication rights and academic freedom(s).

IP AND SPONSORED RESEARCH

- Fundamental research vs. Work-Made-For- Hire
- IRS Rev. Proc. 2007-47, UBIT-related issues.
 - Want to avoid the “pre-assignment” of any technology resulting from the research to the sponsor
 - Universities are non profit and receive certain tax benefits
 - If the university is hired only as a research facility, then the university is viewed as simply performing commercial work and could be subject to taxation.
 - The typical sponsored research agreement provides the sponsor with the option to negotiate a license to obtain any patentable inventions created through the sponsored research.

COMMON IP-BASED AGREEMENTS

- The vast majority of IP-based agreements/contracts are administered, negotiated, and managed by OTD and ORS/ORR.
 - 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”)

NEXT UP IN THE DISCUSSION SERIES

“PUBLISH AND PATENT, WITHOUT PERISHING”

What You Need to Know to Be Able Write/Speak About Your Work

Without Losing US/Foreign Patent Rights

Presented by DR. CHRIS CORBETT,

OTD Director of Intellectual Property

Session 2

Norman: October 25th

HSC: October 26th

QUESTIONS?

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