

A BRIEF GUIDE TO INTELLECTUAL PROPERTY IN A UNIVERSITY CONTEXT

I. WHAT IS INTELLECTUAL PROPERTY?

A. Patents

- Patenting your invention allows you to prevent others from making, using or selling that invention without your permission (i.e., a license).
- “Invention” refers to any new process, machine, manufacture, or composition of matter that is a) novel, b) non-obvious, and c) useful.
- Inventing requires both “conception” and “reduction to practice.”
- Patents must be issued by US (or foreign) Patent Office.

B. Copyrights

- Protect expressions, not ideas.
- Grants exclusive legal right (usually to the author or composer or publisher of a work) to copy, distribute, display, perform, or generate derivations of a given work.
- Software, in some cases, can be protected under copyright.
- Copyrights vest immediately upon the creation of the work.

C. Trademarks

- A word, phrase, graphic image, or symbol used by a business or other organization to represent itself or its merchandise.

D. Trade Secrets

- A way to protect items not otherwise protected under patent, copyright or trademark.
- Rights vary from state to state, but a basic requirement is that the owner take appropriate steps to protect the information from disclosure.

II. KEY LAWS, REGULATIONS AND POLICIES REGARDING INTELLECTUAL PROPERTY

A. The Bayh-Dole Act (Public Law 96-517, 98-620)

- Intellectual property that results from research funded by the Federal Government is owned by the institution that performs the research.
- The Federal Government retains limited rights to such IP, including, but not limited to:
 - Non-exclusive right to use for government purposes
 - Right to claim ownership if ownership is waived by institution
 - Right to claim ownership if commercialization does not proceed fast enough

B. UW policies on the ownership of IP

- All *staff* work product is owned by the UW.
- All intellectual property resulting from a *faculty member's* appointment, with the exception of academic publications, is owned by UW; academic publications are owned by the individual who produces them.
- UW policy provides for royalty sharing with inventors – of net revenues, 1/3 goes to inventors, 1/3 to inventors' department, 1/3 to UW research fund.

C. Washington State Ethics Laws

- Cannot dispose of state assets (e.g., IP) for the purposes of private gain.

D. Other regulatory factors also come into play

- IRS Revenue Procedure 97-14
- Unrelated business income tax

III. UW OFFICES INVOLVED IN THE MANAGEMENT OF INTELLECTUAL PROPERTY

A. Office of Research

- Perform Significant Financial Interest (SFI) reviews
- Manage Royalty Research Fund

B. Office of Sponsored Programs (OSP)

- Review grant proposal/applications
- Negotiate and execute grant awards
- Execute non-disclosure agreements for incoming information

C. UW TechTransfer

- Principle office charged with managing intellectual property
- Receive invention disclosures, make patenting decisions, market and license technologies
- Negotiate and execute material transfer agreements
- Two divisions: Invention Licensing and Digital Ventures

IV. DOCUMENTS IMPACTING THE MANAGEMENT OF INTELLECTUAL PROPERTY

A. Non-Disclosure Agreements (NDA) / Confidentiality Agreements

- Provide for protection of certain kinds of information.
- Can have significant consequences if not drafted carefully – extremely risky.
- Signed by TechTransfer if intended to protect UW information.
- Signed by OSP if to protect sponsor information.
- In some circumstances, other signatories possible.

B. Sponsored Research Agreements

- Confers funding for a project on the UW.
- Typically defines ownership of, access to, licensing options, and other issues related to intellectual property that may result from the project.
- Signed by OSP on behalf of the UW.

C. Material Transfer Agreements (MTA)

- Used when research materials – e.g., reagents, animal models, code, etc. – are to be exchanged between research institutions.
- Governs use of the materials and the rights (ownership, access, etc.) to new intellectual property that may result from such use.
- Signed by TechTransfer on behalf of the UW.

D. Invention Licenses

- Grants a party the right to use a given technology in exchange for remuneration or other considerations.
- Signed by TechTransfer on behalf of the UW.

E. Research Agreement Acknowledgment Form

- Signed by PI to confirm that s/he is aware of, and will abide by, a) the terms of the award, b) UW policies for research; and c) that there is no overlap between the project in question and other projects the PI may be doing.

F. Participation Agreement

- Signed by participants in a research project without a faculty or staff relationship with the UW (e.g., visiting scholars).
- Grants the UW the right to make management decisions regarding intellectual property that results from the project.
- Signing the Participation Agreement does not give up your right to share in royalties or other payments generated by the intellectual property, just the right to manage it.

IV. KEY TASKS FOR RESEARCHERS

A. Keep your projects clean and self-contained

- Don't mix funding from multiple sources
- Keep good records documenting your discoveries
- Avoid extra-contractual work
- Note: Even \$1 of Federal funding will invoke Bayh-Dole
- Note: Competing obligations to commercial sponsors is an invitation for lawsuits

B. Disclose your discoveries properly

- Notify TechTransfer whenever you believe you've developed intellectual property
- Confer with TechTransfer before disclosing the details of your intellectual property to third parties (such disclosure can become a bar to patent), including disclosure via publication or presentation of research results

C. Think before you sign

- Do you have the authority to sign it?
- If so, are you sure that the terms are reasonable?
- Is it something better handled by OSP or TechTransfer?

D. Follow UW policies and procedures

IV. CONTACT INFO

A. Office of Sponsored Programs

www.washington.edu/research/osp

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B. UW TechTransfer

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