

# UT-Dallas/UT System Intellectual Property Policy and Process

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# Agenda

- Regents' Rules and Regulations
- UTD IP Policy
- IP Process at UTD
- University IP and Industry
- Questions

# UT System Regents' Rules and Regulations

## Series 90000 – Intellectual Property

- 90101 – General Rules for IP
- 90102 – Property Rights and Obligations
- 90103 – Equity Interest
- 90104 – Business Participation and Reporting
- 90105 – Execution of Legal Documents Related to IP
- 90106 – Income from IP

# UT System policy – Who is covered?



- All System employees
- Anyone using System facilities under the supervision of System personnel
- Undergraduate and graduate students
- Postdoctoral fellows
- Medical or other residents working at non-System facilities

# UT System policy – What is covered?



- Inventions
- Discoveries
- Trade secrets
- Trade and service marks
- Writings
- Art works
- Musical compositions and performances
- Software
- Literary works
- Architecture

# Who owns what?



1. Within scope of employment
2. With System time, facilities or financial support
3. As a work for hire
4. From research supported by Federal or third party sponsorship



Owned by Board of Regents

1. Unrelated to job responsibilities
2. Invention released to inventor by System
3. IP is a scholarly work
  - scholarly, educational (i.e. course materials), artistic, musical, literary or architectural work in the author's field of expertise



Owned by Inventor/Author

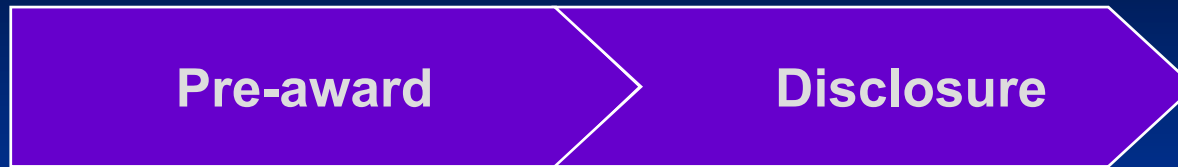
# UTD IP Policy

- Follows Regents' Rules and Regulations on ownership of IP
- Creates an **Intellectual Property Advisory Committee (IPAC)**
  - Evaluates IP
  - Recommends to the president
    - To assert university ownership of IP
    - To release IP back to inventor
- Establishes policy for distribution of licensing income
  - 50/50 split between university and inventor (after recovery of IP expenses)
- Allows UTD to accept equity as compensation for licensing IP

# IP Process



# IP Process

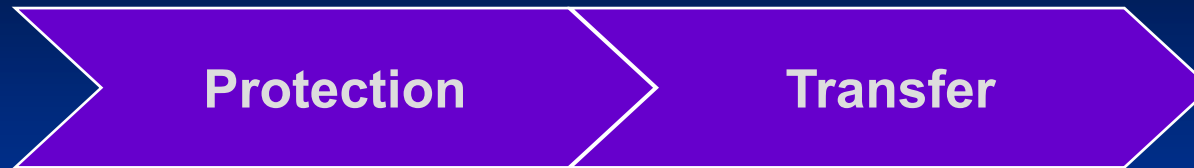


## Tasks

1. Assist with sponsored research contract negotiation.
2. Identify and seek approval of non-standard contract clauses (Form G).

1. Collect and process IP disclosures from PI's.
2. Manage and direct IP evaluation process.

# IP Process



## Tasks

1. Determine appropriate protection method.
2. Engage and manage outside counsel.
3. Monitor protection process and insure PI's are adequately engaged.

1. Determine appropriate means of commercialization.
2. Assess markets and engage targeted firms.
3. Negotiate licensing terms.

# IP Process



## Monitoring

### Tasks

1. Monitor and process ongoing IP protection expenses.
2. Ensure licensee compliance with contract terms.

# IP Process



# IP Process at UTD

- Fill out **IP Disclosure Form**
  - [rafael.martin@utdallas.edu](mailto:rafael.martin@utdallas.edu)
  - [www.utdallas.edu/research/tt/index.htm](http://www.utdallas.edu/research/tt/index.htm)
- Submit disclosure to Rafael Martín (x4824/MP15)
- Schedule a meeting to review disclosure
- Disclosure will be reviewed by IPAC
- If disclosure is approved for protection, **be prepared**
  - To work with IP attorneys to draft patent application
  - To work with tech transfer staff to market technology to potential licensees or investors

# Working with Industry

- Consulting
  - Work directly with researchers.
  - Contract directly between researcher and company.
  - No IP production.
- Sponsored Research
  - Contract between company and University.
  - Statement of work.
  - IP creation.
- Licensing
  - Contract between company and University.
  - Terms for the commercial exploitation of University owned technology.

# University/Industry IP Issues

- Ownership of IP
  - Industry sponsors often want ownership of IP
    - Industry wants a return on its investment.
  - However, university has a significant investment in research projects as well (i.e. support personnel, facilities, etc.)
  - Policy on ownership is simple – “Ownership follows inventorship”
  - Sponsor receives right of first refusal in licensing IP.

# University/Industry IP Issues

## ■ Publication

- Industry may want IP to be held as a trade secret.
  - May want to block disclosure of the IP to maximize its value.
- IP policy generally prohibits restrictions on the right and ability of universities to publish research findings.
- However, universities may delay publication to allow a sponsor to protect (i.e. patent) IP it believes is valuable.

# University/Industry IP Issues

- Conflict of Interest
  - Researchers with significant financial interests in companies related to their research must report this relationship annually.
  - Researchers must submit COI management plans to avoid any potential COI.

# Resources

- UT System Regents' Rules and Regulations for Intellectual Property
  - [www.utsystem.edu/bor/procedures/rules.htm#A10](http://www.utsystem.edu/bor/procedures/rules.htm#A10)
- UT System IP Policy in Plain English
  - [www.utsystem.edu/ogc/intellectualproperty/ippol.htm](http://www.utsystem.edu/ogc/intellectualproperty/ippol.htm)
- UT System Office of Research and Technology Transfer
  - [www.utsystem.edu/rtt/](http://www.utsystem.edu/rtt/)
- UT System Technology Transfer Offices
  - [www.utsystem.edu/rtt/tech\\_transfer\\_office\\_contact.html](http://www.utsystem.edu/rtt/tech_transfer_office_contact.html)

# Contact Information

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