

Institutional Technology Transfer Policies

Institutional intellectual property policies generally provide the legal parameters of the rights and responsibilities that affect the entire research community. Intellectual property policies are all encompassing and involve, among other things, ownership rights and financial considerations and seek to limit risk and liability exposure. Additionally, the process of establishing an intellectual property policy is extensive, as many entities within the institution such as boards of directors, regents, faculty groups, and foundation directors need to agree on the intent and content of the policy. The technology transfer business is ever-changing, and, thus, differences in technology transfer missions, changing cultures, economy, and regulatory environments are reflected in the many institutional policies whose content and style are varied.

Some issues covered by policies include

- Who owns the invention?
- Does the policy cover students?
- Are there different policies for copyrighted vs. patentable technologies or is there one combined policy?
- What is the revenue distribution? Can an inventor waive his or her rights to royalties?
- What are the options for commercialization of an inventor's technologies (e.g., will the university reassign to the inventors)?
- How is equity treated?
- Are there appeal processes?

There is much overlap in topics within institutional intellectual property policies, including sponsored research, institutional and employee conflict of interest, and equity. Each published policy should clearly state when it was implemented, who is responsible for the policy, how a policy change would occur, and how the policy relates to other institutional policies. High-level issues are usually dealt with at the institutional-wide policy level, but those that are very detailed and less strategic in scope and that require more frequent revision are usually handled at the departmental level as internal procedures.

In the United States, the enactment of the Bayh-Dole Act created within academic and research institutions a new profession and activity for the management of intellectual property that results from federally funded research. The act enabled institutions to acquire title to intellectual property; required that, for any invention disclosed, the institution asserts its rights and prepare and file patent applications; that the inventor assign his or her rights to the university; that a portion of any revenue generated be shared with inventors; and that licensing preferences be granted to U.S. small companies.

In addition, the institution is required to report to the federal government, on a regular basis, the existence of any federally funded intellectual property. The passage of the act had a profound impact on the creation of intellectual property programs, policies, and procedures. A pivotal policy generally found in the United States is that institutions require their researchers to assign rights of inventions directly to the institution, with the technology transfer office handling commercialization and federal reporting. However, there are exceptions to these requirements. For example, faculty members at the University of Wisconsin own their own inventions if they are not federally funded. While Wisconsin is unique in the United States, this is one example that illustrates the variations in technology transfer policies.

In Canada, the absence of any national legislation comparable to the Bayh-Dole Act means that universities are freer to establish their own policies on ownership and management of inventions and other intellectual property. Some Canadian universities have chosen to assert ownership of inventions (e.g., the University of British Columbia and McMaster University), some grant inventors complete rights of ownership in inventions (e.g., University of Waterloo and Queen's University), and some universities jointly own intellectual property developed using university resources (e.g., McGill University and University of Toronto).

Although the policies are different in Canada, in each case, there is a technology transfer office that is available to protect intellectual property, commercialize technologies, and share revenues with the inventors. Compared with the U.S. model, in Canadian universities with inventor-owned or jointly owned intellectual property policies, the inventors have

the option to patent and commercialize without the assistance of the technology transfer office and retain a larger share or, in some cases, 100 percent of any revenues.

Universities with these policies argue that they nurture a more entrepreneurial culture among the faculty and students. Statistically, the impact of intellectual property policies on conventional technology transfer metrics tends to suggest that intellectual property policies are not as important as other considerations in determining overall effectiveness in technology transfer.

The following list of policies includes both those that are comprehensive in scope and those that are specific or focus on more recent facets of securing research from the faculty; assessing, protecting, commercializing intellectual property; distributing royalties; material transfers; trademarks; and copyrights. These policies are provided by way of example, to use as you develop or revise policies at your institution.

This list is by no means comprehensive, and we encourage you to review many different policies before embarking on a new or revised policy.

Disclaimer: AUTM does not endorse or recommend any of the policies listed here. They are provided as-is and are for illustrative purposes only.

Comprehensive Intellectual Property

- Massachusetts Institute of Technology: <http://web.mit.edu/policies/13/13.1.html>
- Stanford University: <http://dor.stanford.edu/Resources/ip.html#policy>
- The Texas A&M University System: <http://otc.tamu.edu/inventors/index.jsp?cid=56>
- University of Toronto: <http://www.sgs.utoronto.ca/governance/policies/intellectualprop.htm>

Conflict of Interest within Institutions

(Faculty Consulting, Conflict of Commitment) Conflict of interest policies are different than and separate from intellectual property/technology transfer policies.

However, they often affect intellectual property and technology transfer policies; thus sample policies are listed here.

- Massachusetts Institute of Technology: <http://web.mit.edu/policies/4.4.html>
- Stanford University: <http://rph.stanford.edu/Chpt4.html>

- University of California: <http://www.ucop.edu/ucophome/policies/bfb/g39.html>
- University of Maryland: <http://www.usmh.usmd.edu/regents/bylaws/SectionIII/III111.html>
- University of Miami: <http://uresearch.miami.edu/?p=173&s=4>
- Council on Governmental Relations: http://www.cogr.edu/Pubs_Conflicts.cfm

Copyright and Software

- North Carolina State University: http://www.ncsu.edu/ott/university_policies.html
- University of North Carolina:
<http://intranet.northcarolina.edu/docs/legal/policymanual/500.2.pdf>
- University of Pennsylvania: <http://www.library.upenn.edu/scholcomm/copyright.html>
- University of Washington: <http://www.washington.edu/admin/rules/policies/APS/59.04.3.html>

Equity

- Iowa State University Research Foundation:
http://www.techtransfer.iastate.edu/en/for_iowa_state/our_policies.cfm
- Stanford University: <http://www.stanford.edu/dept/DoR/rph/4-6.html>
- North Carolina State University: <http://policies.ncsu.edu/regulation/reg-10-00-04>

Faculty

(Visiting Scientist and Sabbaticals, Entrepreneurial Leave, and Faculty Evaluation)

- Ohio State University: <http://mansfield.osu.edu/HTML/handbook/consulting.html>
- University of Maryland: www.ord.umaryland.edu/policies_procedures/index.html

Material Transfer Agreements, Tangible Research, and Research Tools

- Johns Hopkins University: <http://www.techtransfer.jhu.edu/resources/material.html>
- Northwestern University: <http://www.research.northwestern.edu/osr/mta.html>
- University of Illinois: <http://tigger.uic.edu/depts/ovcr/research/mta/index.shtml>
- University of Washington:
<http://depts.washington.edu/uwc4c/for-researchers/material-transfers/>

Patent, Outside Counsel, Conflict of Interest with Counsel, Ownership Back to Inventors, and Royalty Sharing

- Harvard University: <http://www.techtransfer.harvard.edu/Policies.html>

Record Retention and Management

- Texas Tech University: <http://swco.ttu.edu/recordsmanagement/home.htm>
- University Washington: <http://www.washington.edu/admin/recmgt/uw.gs7.html>

Sponsored Research

- Harvard University: http://vpf-web.harvard.edu/osr/support/policies_main.shtml
- University of New Mexico: <http://www.unm.edu/~handbook/E60.html>

Startups

- Washington University in St. Louis: <http://www.wustl.edu/policies/startup.html>

Trademark

- Indiana University: <http://iu.licensing.indiana.edu/policies/mainpolicy.shtml>
- Princeton University: <http://www.princeton.edu/trademark/policy.html>
- University of Texas at Austin: <http://www.cc.utexas.edu/trademarks/policy.html>