

Invention and Patent Policy Implementation Guidelines

GUIDELINE #1 (Approved by the Invention and Patent Committee on 11/26/91). For each invention, the inventors will designate by mutual agreement one among them to serve as their representative with the University concerning the patenting and licensing of their invention. This designation is made as part of the initial invention disclosure but may be changed at any time later by mutual written agreement of all the inventors. Whenever possible, this representative should be an University employee. Consultation with and reporting to "the inventors" by the University pursuant to the Invention and Patent Policy will be made through this representative, who undertakes to keep the other inventors fully informed.

GUIDELINE #2 (Approved by the Invention and Patent Committee on 11/26/91). The process of licensing inventions requires appropriate consultation between the University and the inventors. This process is as complex and diverse as the inventions themselves, so that the level and the timing of the consultation also vary widely. Furthermore, so that the University's relationship with industry representatives is used most effectively, related inventions are often marketed in groups rather than individually. The University will make every reasonable effort to involve the inventors meaningfully in the marketing process, usually in five main ways:

(a) to suggest additional potential licensees;

(b) to provide, review and update non-confidential marketing materials (such as invention summaries and copies of published papers) that may be needed by the University in its search for potential licensees;

(c) to provide confidential materials (such as unpublished manuscripts or preliminary data) for review by potential licensees who have signed confidentiality agreements with the University;

(d) to prepare proposals for additional research or to discuss technical details of the invention with representatives of potential licensees; and

(e) to assist the University in devising its negotiating strategy with potential licensees.

GUIDELINE #3 (Approved by the Invention and Patent Committee on 11/26/91). The University will report to the inventors yearly on its marketing activities relating to their inventions.

GUIDELINE #4 (Approved by the Invention and Patent Committee on 11/26/91). Upon receipt of the first royalty payment for any invention, the University will provide the inventors with a summary of all prior costs incurred in patenting and marketing the invention, as well as a calculation of the first net royalties and their distribution to the inventors. Each year thereafter the University will provide the inventors with an annual statement of gross royalty income, costs, and a calculation of the net royalties and their distribution to the inventors.

GUIDELINE #5 (Approved by the Invention and Patent Committee on 9/22/92). If an inventor is affiliated with more than one Department or Research Unit, the inventor will designate the manner in which the Department/Research Unit's share of net royalties will be distributed.

GUIDELINE #6 (Approved by the Invention and Patent Committee on 9/22/92). If inventors choose to give part of their share of net royalties to non-inventors, only the Departments/Research Units and Schools/Colleges of the inventors will receive the appropriate share of net royalties.

GUIDELINE #7 (Approved by the Invention and Patent Committee on 9/22/92). If inventors choose to divide their share of net royalties unequally among themselves, their Departments/Research Units and Schools/Colleges will divide the corresponding shares of net royalties in the same unequal proportions.

GUIDELINE #8 (Approved by the Invention and Patent Committee on 9/22/92, revised on 11/6/00). If the University decides to abandon either the prosecution of a patent application or the maintenance of any patent, the inventor shall be given the opportunity to take over, to the extent permitted by law or regulation, the prosecution or the maintenance as well as all related costs. In return for the prosecution file and for a waiver of all University rights, the University may require the inventor to agree in writing to share with the University fifty percent (50%) of any gross income he/she derives from the invention, until all out-of-pocket costs incurred by the University in

connection with the invention have been reimbursed; this agreement will list all such out-of-pocket costs and the inventor will acknowledge his/her acceptance of their appropriateness.

GUIDELINE #9 (Approved by the Invention and Patent Committee on 11/22/95, revised on 11/6/00). The inventors' share of income from any invention shall be distributed to those inventors who are inventors of record at the time the income is received by the University. Inventors added later shall be entitled only to share in net income which is received subsequently. Cases to which this guideline applies include, without limitation: (a) incompletely defined inventions (for example, concepts without reduction to practice) which become fully defined due to additional inventors' contributions; (b) fully defined inventions which are improved or expanded due to additional inventors' contributions; and (c) inventions for which persons considered, in good faith, by the University's patent counsel not to be inventors are later required to be named as inventors by the United States Patent and Trademark Office.

GUIDELINE #10 (Approved by the Invention and Patent Committee on 11/6/00, revised 11/13/01). The inventors' share of net income from any invention shall be distributed prior to the end of the fiscal year in which the income is received by the University. However, in the event that additional costs in excess of income are expected for the following fiscal year, the estimated additional costs may be included when calculating the net income, and the inventors shall so be informed.

GUIDELINE #11 (Approved by the Invention and Patent Committee on 5/8/01). Net income resulting from a commercialization agreement that covers more than one invention will be apportioned equally among all the inventions to which the net income is attributable, unless all inventors agree otherwise in writing. Inventions added to an agreement after its effective date will be allocated only the increase in net income, if any, that is attributable to them. A United States Patent Application, its foreign counterparts, continuations, continuations-in-part, divisions, re-issues, additions, renewals or extensions, and patents issuing from any of them, are all deemed to pertain to the same invention.

GUIDELINE #12 (Approved by the Invention and Patent Committee on 11/2/03). Net income distribution to inventors who cannot be located, after reasonable attempts have been made to locate them, will revert to the University three years from the date the first attempt was made. Reasonable attempts may include, where appropriate: inquiries with thesis advisor, searches of Graduate School and Alumni records, searches of professional literature, inquiries with professional societies, web searches.

GUIDELINE #13 (Approved by the Invention and Patent Committee on 5/4/04). Inventions by OTT staff will be first disclosed to the Committee for review. The disclosure will highlight: (a) all contributions made by other University employees to the invention and (b) all connections to other inventions made by University personnel. The Committee will have thirty (30) days to transmit a recommendation for disposition to the Vice President for Research. However, the disposition will be at the sole discretion of the Vice President for Research.

GUIDELINE #14 (Approved by the Invention and Patent Committee on 5/4/04). In the event a matter is presented to the Committee involving a Committee member, the member will be absent from all deliberations.