

IP Sample Plan #4

Sample letter from Research Institutes and their principal investigator and consultants, describing a data and research tool sharing plan and procedures for sharing data, research materials, and patent and licensing of intellectual property. This letter is designed to be included as part of an application.

RE: [NIH OER Notice Number] - Data, research tools and resources sharing plan and procedures

This letter describes how the _____ Research Institute will oversee the intellectual property produced by lead investigator Dr. _____ [*insert name of principal investigator*] and his team, which includes external co-investigators, collaborators, and consultants at [*insert names of institutions*] in their research within the [*insert name of NCI program*]. This letter is included as a part of application [*NIH OER Notice Number*], and will specifically address how the participating institutions will share data, share research materials, and patent and license intellectual property.

All participating institutions are experienced and knowledgeable in capturing and protecting biotechnology related intellectual property and have already shown the ability to stimulate the interest of commercial partners.

Sharing Data: The participating institutions will follow NIH Grants Policies concerning the sharing of research data. As outlined by the NIH, the participating institutions will make available to the public the results of this collaboration and any accompanying data that were supported by the NIH. The participating institutions will consult the following NIH source for guidance on sharing data: Sharing of Research Data as defined in the "NIH Statement on Sharing of Research Data" February, 2003 and referenced online at <http://grants.nih.gov/grants/guide/notice-files/NOT-OD-03-032.html>.

Sharing Research Materials: The participating institutions will also comply with the Federal requirements governing technology transfer, including 35 USC and associated Federal Regulations and adhere to the policies and guidelines of NIH addressing technology transfer and the distribution of NIH funded research materials. Participating institutions in possession of materials generated during the course of the project ("*NCI program*" Materials") will strive to make the unique research resources readily available for research purposes to members of the [*NCI program*], non-profit organizations, and commercial collaborators in accordance with NIH guidelines. The participating institutions

will consult the following NIH source for guidance on sharing resources: Sharing of Research Resources as defined in "Sharing Biomedical Research Resources: Principles and Guidelines for Recipients of NIH Research Grants and Contracts" issued in December, 1999 and referenced online at

<http://www.gpo.gov/fdsys/pkg/FR-1999-12-23/pdf/99-33292.pdf>. Material transfer agreements will be used when appropriate and the Uniform Biological Material Transfer Agreement will be favored for the transfer of materials between non-profit institutions.

Intellectual Property: Researchers at participating institutions will disclose "Subject Inventions" as defined in 35 USC 201(e) to their respective organizations. Subject Inventions will be reported to the NIH by the participating institution receiving disclosure of the Subject Invention and title will be elected as the participating institution believes is appropriate. All Subject Inventions to which title is elected shall be considered "[*NCI program*] Inventions" and participating institutions will take steps to protect [*NCI program*] Inventions by filing patents.

Licensing of Intellectual Property: Participating institutions will openly communicate and cooperate with other [*NCI program*] institutions for the purpose of managing, protecting and licensing [*NCI program*] Inventions. Information on Subject Inventions will be made available as needed between participating institutions and upon request the same will be made available to commercial collaborators involved with the project. Shared information will be treated as confidential by participating institutions and commercial collaborators as is necessary. Institutions having ownership of [*NCI program*] Inventions or possession [*NCI program*] Materials will coordinate with each other to further the development of the technology. When ownership of [*NCI program*] Inventions involves multiple institutions, the participating institutions will form agreements involving the consolidation and central management of intellectual property rights. Similarly, participating institutions will collaborate to package [*NCI program*] Inventions for licensing when necessary to commercially develop [*NCI program*] Inventions in a timely fashion.

Participating institutions will make their own [*NCI program*] Inventions available for licensing to those commercial collaborators from which they received materials used to arrive at [*NCI program*] Inventions. Commercial collaborators interested in licensing [*NCI program*] Inventions shall notify the participating institution having ownership of the particular [*NCI program*] Invention in which they are interested. Licenses for commercial purposes will be made available to commercial collaborators having the resources and ability to adequately develop and/or commercialize [*NCI program*] Inventions. If multiple commercial collaborators exist, licensing will be restricted to the "field of use" or nonexclusive rights will be licensed. Options to license [*NCI program*] Inventions may be offered to commercial partners for reasonably limited times as long as the particular participating institution has appropriate ownership of rights being optioned. To the extent it is reasonable to believe that the objectives of the [*NCI program*] will be accomplished and when it is not in conflict with other preferences required by law, qualified commercial collaborators involved with the project will be given preference over other potential

licensees with respect to commercial licenses. Once options have expired, participating institutions will be free to pursue other interested licensees as needed to facilitate the successful technology transfer of [NCI program] Inventions. Licenses will be executed when appropriate and milestones will be used to insure that the licensing leads to timely commercial development. In such licenses, the participating institution will strive to limit the exclusive license to the commercial field of use, retaining rights regarding use and distribution of any technology that is a research tool.

The appropriate representative from each institution of Dr. _____'s team has read and concurred with the terms of _____ Research Institute's intellectual property management strategy.

Updated

Monday, December 18, 2017

Source

URL:<https://techtransfer.cancer.gov/intellectualproperty/ip-information-grantees-contractors/ip-sample-plan4>