

IP Sample Plan #5

A sample Intellectual Property Management Plan in the form of a legal agreement between a University and its collaborators which addresses data sharing, sharing of research tools and resources and intellectual property management. The Plan includes: definitions; ownership information; details about oversight and management of the project's intellectual property; information about patents; information about rights and licenses; and how disputes between the parties can be resolved.

Intellectual Property Management Plan

Preamble

The University of _____ ("University") offers this plan addressing **data sharing, sharing of research tools and resources, and intellectual property management** ("Plan") as part of its submission in response to [NIH OER Notice Number] , "[Insert name of NCI program]" ("RFA").

The University and its proposed collaborator, _____ ("Collaborator") recognize that, in the event that an award is made as a result of this application, intellectual property may result during the term of the cooperative agreement ("Award"). This Plan addresses protection and dissemination of intellectual property, while operating within the framework established by the Bayh-Dole Act ([35 U.S.C. § 200 et seq.](#)), federal patent and trademark laws, individual state laws, institutional policies, and terms of relevant grants.

University and Collaborator are each a Party and collectively Parties as referenced within this Plan.

The Plan objectives include:

1. To promote rapid dissemination of information and inventions for the public good; and
2. To promote patenting and licensing when the public good is best served by controlling the activities of those commercializing inventions and/or by providing economic rewards necessary to encourage commercial partners to make the investment required to move an early stage technology to the market.

1.0 Definitions

1.1 - Award Work means any work or activity performed by University or its Collaborator(s) within the scope of performance pursuant to and funded by the Award.

1.2 - Background Intellectual Property means Intellectual Property developed before or independent of performance of the Award, and is legally necessary for performance of Award Work.

1.3 - Background Research Data means information including, without limitation, documents, drawings, models, designs, data, memoranda, tapes, records, and databases, in hard copy form or in electronic form, developed before or independent of performance of the Award, and is necessary for performance of Award Work.

1.4 - Intellectual Property means technical information, inventions, developments, discoveries, know-how, methods, techniques, formulae, algorithms, data, processes and other proprietary ideas, whether or not patentable or copyrightable, patent applications, patents, copyrights, trademarks, mask works, trade secrets and any other legally protectable information, including computer software

1.5 - IP Affiliate means an organization, such as a non-profit organization or a foundation, that engages in the transferring of technology on behalf of any Party or a department or division, such as a technology transfer office, within the Party that is responsible for technology transfer for that Party.

1.6 - Owner refers to a party, public or private, having a legal assignment of right to Intellectual Property, as provided in the Bayh-Dole Act (35 U.S.C. § 200 et seq.).

1.7 - Project Intellectual Property means and includes all Intellectual Property first conceived, discovered, developed, reduced to practice and/or generated in the performance of the Award.

1.8 - Project Research Data means information including, without limitation, documents, drawings, models, designs, data, memoranda, tapes, records, and databases, in hard copy form or in electronic form, developed during performance of the Award.

2.0 Ownership

2.1 - Inventorship of Project Intellectual Property and Project Research Data will be determined in accordance with applicable U.S. patent, trademark and copyright law and

any corresponding state laws.

2.2 - Each Party shall retain title to Project Research Data and Project Intellectual Property developed solely by employees and/or students of that Party. Project Research Data and Project Intellectual Property developed jointly by employees and/or students of more than one Party shall be jointly owned by the respective developing Parties and subject to each such owner having an undivided interest in the same.

2.3 - Each Party shall have the right to practice other Parties' Project Intellectual Property, Background Intellectual Property, Project Research Data and related Background Research Data for the sole purpose of carrying out Award Work, but may not disclose the Background Intellectual Property and Background Research Data to any person or third party except with permission of the Owner and under suitable confidentiality obligations. In the case of Background Intellectual Property, the right to practice is granted only to the extent that the Owner(s) of such Background Intellectual Property is not prevented, contractually or otherwise, from granting such rights.

2.4 - A third party performing Award Work by contract or through collaboration with a Party, subject to confidentiality obligations, shall have the right to practice another Party's Background Intellectual Property provided the following conditions are met:

- a. Owner(s) of such Background Intellectual Property agrees in writing to such use; and
- b. the third party practices the Background Intellectual Property solely for Award Work performed in collaboration with a Party.

2.5 - Each Party reserves all legal rights in its Background Intellectual Property for all purposes.

3.0 Oversight of Project Intellectual Property

The University, as the prime recipient of the Award, will oversee implementation of this Plan and will collaborate with its Collaborator(s) to manage:

- a. Monitoring disclosure, patenting and licensing activity with respect to Project Intellectual Property;
- b. Seeking, as needed potential third-party licensees for Project Intellectual Property;
- c. Dispute resolution as described in Section 7.0;
- d. Review and revision, as necessary, of the strategy for patenting and licensing; and
- e. Facilitating timely and accurate reporting of disclosures, patents, and licenses for Project Intellectual Property to the NIH by each inventing Party, and in the final invention report of the University.

4.0 Management of Intellectual Property

4.1 - Each Party will commit, as reasonable, sufficient technology transfer administration resources to manage its Intellectual Property resulting from the Award Work in a manner consistent with any laws, statutes, rules, regulations and guidelines promulgated by any government agency, instrumentality, authority or regulatory body having jurisdiction over the Party's conduct, including, but not limited to, the Bayh-Dole Act, institutional policies, and any relevant Award language.

4.2 - Each Party will make reasonable and good faith efforts to:

- a. Inform, on a periodic basis, employees, faculty, staff and students involved in the Award Work of the expectation that the research is to serve the public benefit and the importance of prompt disclosure of developments and potential inventions.
- b. Identify documents and share the existence of any relevant Background Intellectual Property or any prior contractual agreements that may affect rights in Project Intellectual Property or Background Intellectual Property.
- c. Expedite disclosure and evaluation of Project Intellectual Property, Background Intellectual Property, Project Research Data and related Background Research Data and facilitate the effective dissemination of the Project Intellectual Property for the greater public good.
- d. Encourage researchers for Award Work to disclose to the University's Principal Investigator or the Collaborator Principal Investigator the publications, including presentations, website postings, and article submissions, prior to disclosure for publication (submission or presentation), related to Award Work to ensure timely filing of patent, trademark or copyright applications for Project Intellectual Property.
- e. Promote and publicize the availability of Project Intellectual Property for licensing.

4.3 - Data Sharing. Data will be shared in accordance with the NIH Data Sharing Policy and Implementation Guidance, including but not limited to the following principles:

4.3.1 - The Parties will cooperate fully with the overall Steering Committee (as defined in the RFA) in its efforts to encourage data sharing across the Network (as defined in the RFA). University looks forward to working with the Steering Committee during the planning period, in light of our mutual desire to share data within the Network. The Parties recognize that data sharing within the Network may include submission of data to the Data Management and Coordinating Center and/or sharing of data among other awardees.

4.3.2 - It is the intent of the Parties to encourage sharing of data and other information related to the Award Work through publication, presentation or other scientific communications consistent with academic standards. A Party will be free to publish the results of Project Intellectual Property and Project Research Data that the Party owns, provided due consideration is given to protection of patentable subject matter.

Accordingly, each Party's inventors will submit Project Intellectual Property disclosures to the Party's IP Affiliate and identify the inventions disclosed as part of Project Intellectual Property.

5.0 Reporting, Filing, and Election of Title

5.1 - Each Party will execute a mutually agreeable confidentiality agreement, which will obligate each Party to maintain in confidence other Parties' sensitive Project Research Data, Background Research Data, Background Intellectual Property and Project Intellectual Property.

5.2 - Any patent application filed relating to Project Intellectual Property or Project Research Data will cite the support of the Prime Award.

5.3 - Each Party having sole title to Project Intellectual Property is solely responsible for compliance with the Bayh-Dole Act, including reporting, patenting and licensing related to the Project Intellectual Property.

5.4 - The Parties jointly owning Project Intellectual Property are jointly responsible for compliance with the Bayh-Dole Act, including reporting, patenting and licensing activities related to the Project Intellectual Property. The Parties, through execution of appropriate agreements, will jointly determine whether an application for patent or copyright will be filed on such Project Intellectual Property, the identity of the party who will prepare and file such application, the country(ies) in which such application will be filed, and responsibility for out-of-pocket expenses of patenting. If the Parties jointly owning the Project Intellectual Property have not executed such an agreement within 90 days of the first notification of their ownership interest, a Party may treat the matter as a dispute and bring it to a fair and equitable resolution that best meets the objectives of the Award.

6.0 Rights and Licenses

6.1 Research Tools

6.1.1 - Research tools (assays, libraries, reagents, etc.) will be made available to researchers in both the private and public sector in accordance with the 1999 Principles and Guidelines for Recipients of NIH Research Grants and Contracts on Obtaining and Disseminating Biomedical Research Resources.

6.1.2 - Human tissue will be made available under material transfer agreements (in accordance with Section 6.11) to researchers who provide documentation of appropriate IRB review and approval. Patient data and records will be shared only to the extent allowable under Health Insurance Portability and Accountability Act of 1996 (HIPAA) regulations, e.g., with specific patient authorization.

6.2 Options and licenses for commercialization of Project Intellectual Property

6.2.1 - Any license that an Owner may grant to its Project Intellectual Property shall be

subject to a reservation of certain rights to the Government under the provisions of 35 U.S.C. § 201 et seq, the Owner(s) of the Project Intellectual Property, the Owner(s) of Background Intellectual Property, and, for purposes of Award Work, each of the Parties.

6.2.2 - Any license that an Owner may grant to its Project Intellectual Property will reserve the option to permit private or public educational institutions to use Project Intellectual Property on a royalty-free basis for research and education, but not for commercial purposes, subject to confidentiality requirements.

6.2.3 - University recognizes that Project Intellectual Property owned by University may result from use of or may contain materials and/or resources provided by Collaborator for use in the Award Work. Subject to the rights and obligations under pre-existing or concurrent agreements with other commercial entities, the federal government under the provisions of 35 U.S.C. § 201 et seq , ("Other Contract Rights"), the Collaborator may be granted a royalty-free non-exclusive license for the sole purpose of performing the Award Work. Subject to Other Contract Rights, the Collaborator may be further granted, the Project Intellectual Property, the first opportunity to negotiate a time-limited, exclusive, royalty-bearing license to practice commercially the Project Intellectual Property within a field of use or such other form of license as the Collaborator and the University may agree upon. The negotiation opportunity will extend for 90 days after the date the Collaborator, after executing a suitable confidentiality agreement, receives a written, confidential disclosure of the Project Intellectual Property and any relevant Background Intellectual Property and/or Background Research Data of University.

6.2.4 - In the event that solely-owned Project Intellectual Property of University does not arise from resources provided by Collaborator, University's IP Affiliate shall evaluate the Project Intellectual Property and seek, consistent with Bayh-Dole requirements, potential licensees having the necessary capability to commercialize the Project Intellectual Property and bring it into the public good.

7.0 Dispute Resolution Procedures Between Consortium Parties

7.1 - Any dispute between the Parties relating to Project Intellectual Property management, as provided in this Plan, or to the interpretation of this Plan, shall be referred to the Parties respective officers, as designated below, for resolution, within a reasonable period of time and in a fair and equitable manner, taking into consideration the objectives of the Prime Award and any laws, statutes, rules, regulations or guidelines to which the involved Consortium Parties are subject.

The designated officers are as follows:

- For Collaborator:
- For University: Vice President, Research and Development

7.2 - If a dispute relates to identification of inventor(s) or Owner(s) of Project Intellectual Property, the Parties may choose a competent patent attorney having no business or employment relationship with any Party to advise the Parties' designated officers regarding same. The costs of obtaining this advice will be divided per capita among the Parties having an interest in the invention being reviewed.

7.3 - Pending final resolution of any dispute, the Parties will proceed diligently with performance of the Award Work.

7.4 - Nothing in this Section is intended to prohibit a Party from protecting its intellectual property rights (including those in Project Intellectual Property), or obtaining injunctive relief from the courts.

[Authorized representative] /s/

Collaborator _____
[Authorized representative] /s/
University

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Source

URL:<https://techtransfer.cancer.gov/intellectualproperty/ip-information-grantees-contractors/sample-ip-management-plans/ip-sample-plan5>