NATIONAL CANCER INSTITUTE
Technology Transfer Center

IP Sample Plan #6

A sample Intellectual Property Management Plan that covers the objectives of the plan and a summary of how the issues are addressed in the plan.

INTELLECTUAL PROPERTY (IP) MANAGEMENT PLAN FOR [*Insert name of NCI Program*]

Objectives of IP Management Plan

[*Briefly summarize nature of Research Plan in relation to core mission of NCI program.*]

Accordingly, applicant's IP management strategy for this project is to promote rapid dissemination of information and inventions for the public good. When it is deemed that patenting and licensing an invention or series of related inventions serves the public good, applicant will do so by:

a. controlling the activities of those commercializing the inventions by tailoring fields of use appropriately and developing appropriate benchmarks; and/or
b. providing sufficient coordination of related inventions created by applicant's investigator and the collaborating investigators to justify the investment a licensee must make to move an early stage technology to the market, which will include, as appropriate:

- ensuring that a licensee will have access to the bundle of intellectual property generated by the project necessary to take a product to market on commercially reasonable terms; and
- providing a mechanism that protects IP rights of third party sponsors/materials providers of applicant and applicant's external collaborators.

IP Management Plan

Applicant investigator's team is comprised of the following external co-investigators, collaborators and consultants: [*list should identify investigator, institutional or company affiliation, and expected contributions*]. The following members of applicant investigator's team will receive funding and/or materials from for-profit third parties: [*list should identify investigator/institution and company and associated material and/or funding*].

As applicant's investigator is the lead principal investigator for this project, the institutions represented by applicant's team members have agreed that applicant through its technology licensing office ("TLO") will coordinate patenting and licensing activities

relating to inventions arising out of this project either directly or through an intellectual property management firm. Pursuant to such agreement, member institutions have agreed to pool inventions arising out of this project by exclusively licensing their individual patent rights to applicant institution or by assignment to an intellectual property management firm. Applicant in turn has agreed to (1) prosecute all patents, in consultation with member institutions, (2) license all patent rights in a way that maximizes commercial development of the inventions and the public health; and distribute royalties pursuant to an agreed percentage. Pooled inventions will be licensed in product bundles either by applicant's TLO or an intellectual property management firm. Member institutions will share in the royalty stream and have agreed to incur their proportionate share of patent prosecution expenses. Licensing strategies can be exclusive or nonexclusive, depending on the rights available and the need for commercial incentive.

Tools (data, assays, libraries, research tools, reagents, etc.) will be made available, in accordance with the 1999 Principles and Guidelines for Recipients of NIH Research Grants and Contracts on Obtaining and Disseminating Biomedical Research Resources, to all researchers in both the private and public sector free or for a nominal charge and with minimal restriction. In some cases applicant may determine that the public and the research community are better served by a licensing program whether or not patents have been filed. This may be relevant; for example, if a tool is best distributed under license to guarantee reagent availability and quality.

So that the entire research community can benefit from the tools, reagents, and data generated by applicant's investigator's team, applicant will transfer materials to outside researchers under a Material Transfer Agreement (MTA) no more restrictive than the NIH Simple Letter Agreement (SLA) or the Uniform Biological Material Transfer Agreement (UBMTA). This MTA will also provide for a transfer of new data developed using tools created in the [*NCI program*] back to applicant investigator to become part of a publicly available database.

Applicant's collaborating investigators may have pre-existing sponsored research agreements with industry. Institutions of such collaborating investigators will use reasonable efforts to ensure that these sponsored research agreements are consistent with the 1994 Developing Sponsored Research Agreements: Considerations for Recipients of NIH Research Grants and Contracts (http://www.ott.nih.gov/developing-sponsored-research-agreements) and the 1999 Principles and Guidelines for Recipients of NIH Research Grants and Contracts on Obtaining and Disseminating Biomedical Research Resources (http://www.gpo.gov/fdsys/pkg/FR-1999-12-23/pdf/99-33292.pdf).

It may be necessary for applicant institution to meet prior obligations to sponsors of collaborating investigators. Applicant will do so in the least restrictive way consistent with the primary objectives of the [*NCI program*]. Rights of sponsors may include the right to

negotiate an exclusive license or a non-exclusive license. Such obligations to such sponsors should be made consistent with the objective of rapid dissemination of information and inventions for the public good through standard institutional licensing practice. Applicant institution, through its sponsored research agreements and those of member institutions, will not provide a single sponsor with a substantial (i.e. a 50% or greater) proportion of the intellectual output of research related to [*NCI program*]. NCI expects inventions resulting from [*NCI program*] to be made reasonably accessible, resulting in a reasonable distribution of the related intellectual property rights.

Collaborating institutions with obligations that are inconsistent with the foregoing objectives will be asked to renegotiate their agreements with sponsors to comply with these objectives. Collaborators who are unable to renegotiate such obligations will be screened out by Applicant. Obligations inconsistent with these objectives include but are not limited to providing a single sponsor with a substantial (i.e. a 50% or greater) proportion of the intellectual output of the collaborator's work with the [*NCI program*].

Pursuant to 35 USC 202(c)(4), the NCI (on behalf of the United States Government) retains a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States any subject invention arising from [*NCI program*] throughout the world.

The appropriate representative from each institution of applicant investigator's team has read and concurred with the terms of applicant institution's IP Management Plan.

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