

Office of Technology Licensing

Patent Policy & Procedures

"OLD" Policy, Effective January 1, 1990

This policy, effective January 1, 1990, was outlined in a March 14, 1990 memo to members of the faculty from then Provost Robert Sulkier.

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Preamble

Brandeis University wishes to foster both new knowledge and patentable inventions. As recipients of federal funding, nonprofit organizations are subject to the regulations contained in 37 CFR 401, Rights to Inventions made by Nonprofit Organizations and Small Business Firms. Those regulations were the outgrowth of Public Law 98-620 and its predecessor Public Law 96-517, more commonly known as the Bayh-Dole Act.

The Bayh-Dole Act (and the subsequent PL 98-620) was landmark legislation that, for the first time, gave nonprofit organizations and small business firms the right to elect title to inventions made as a result of federal funding and to grant exclusive term-of-patent licenses.

Patentable inventions or discoveries often arise from work undertaken by faculty members and other persons associated with Brandeis University. These people associated with the University shall have the right to decide when, and under what conditions, they shall offer the results of their research to journals and other entities whose primary function is to publish information. However, if a person associated with the University shall seek commercial development of an invention or discovery that is conceived or reduced to practice while that person is associated with the University, or if a person is subject to a disclosure obligation arising from a sponsorship agreement, then that person must disclose the invention or discovery to the University.

As an educational institution, the University's basic objectives in responding to and dealing with such inventions and discoveries are to:

promote their disclosure, dissemination, and utilization for the greatest possible public benefit;

protect the rights and patents and other intellectual property which the inventors and the University may have;

provide positive incentives for people associated with the University to develop and bring forth inventions, through an equitable allocation of rewards and responsibilities among such inventors, the University, and any other organizations that may have sponsored or financed any such activities.

ARTICLE I. Definitions

"Invention" shall include any invention, discovery, or other work product that manifests an idea that may be patentable or otherwise commercially valuable, and that is conceived or reduced to practice by an Inventor who is associated with the University.

"Inventor" shall include any person who makes a significant contribution to the conception, discovery, or reduction to practice of an invention and who is associated with the University, e.g. faculty, staff, and students (including all types of postgraduate or postdoctoral fellows, research assistants, graduate research assistants, teaching assistants and trainees) doing work that is supported in whole or in part by funds, space, personnel or facilities provided or administered by the University.

"Commercial development" shall include any efforts that are likely to result in financial benefit from an invention, excluding compensation relating solely to publication by a journal or other entity whose primary function is to publish information.

"He," "his," or "him" shall be deemed to read "she" or "her" where applicable.

ARTICLE II. University Ownership Rights

A. Any invention which is conceived, discovered, or reduced to practice by the Inventor during his term of association with the University or within six (6) months after said association ends shall be presumed to have been conceived as a result of the Inventor's use of University facilities, funds or other support. In the absence of sufficient evidence to the contrary, any such invention shall be the property of the University.

B. The use of office space or library facilities that are ordinarily available to the Inventor shall be regarded as de minimis support by the University, and shall not entitle the University to ownership rights in an invention.

ARTICLE III. Authority of the President

The President of Brandeis University has the authority to make all necessary decisions relating to patents and trade secrets, including the preparation and filing of domestic and foreign patent applications, licensing agreements, and all legal, academic or other matters related thereto. The President may vest authority to act on his/her behalf in patent-related matters to the Assistant Provost for Research. The President shall appoint an advisory committee, entitled the Patent Review Committee (PRC), which shall report to the President.

ARTICLE IV. Patent Review Committee

A. The PRC shall consist of up to five (5) members appointed by the President including the Assistant Provost for Research, who shall chair the Committee, and representatives of the research faculty. The term of appointment shall be for one year ending on August 31. Ad-hoc non-voting members may be added by the Chairperson or the President at any time to consider a particular invention or discovery.

B. When required, the PRC shall investigate patent disclosures arising from research activities at the University and advise the President regarding all matters relating to patent policies or disclosures in accordance with the provisions set forth herein.

C. In considering any issue, the PRC may consult with patent agents and attorneys, business or invention consultants, and other qualified persons, and have various documents, including literature and patent searches and license agreements, prepared for it.

ARTICLE V. Disclosure

A. If any Inventor should seek patent protection or commercial development of any invention, or if he is subject to a disclosure obligation (See Exhibit A) arising from a sponsorship agreement, he must fully and promptly disclose the invention to the University's Office of Grant, Contract, and Patent Administration (OGCPA).

B. If an invention is co-invented, each Inventor associated with the University has a duty to disclose the invention to the OGCPA. All inventors may discharge this obligation by means of a single disclosure.

C. Each recipient of funds under a governmental or industrial sponsorship agreement is responsible for understanding and complying with his obligations under that agreement. Most such agreements require that all inventions arising from sponsored research must be

reported to the sponsor.

D. Inventors are urged to disclose any inventions to the University before they release information regarding the invention to people who are not co-inventors. Patent rights can be destroyed if an invention is published or disclosed before a patent application is filed unless the disclosure is protected by a written confidentiality agreement or by a relationship that clearly implies confidentiality.

E. If an unpublished idea is being discussed with a commercial enterprise, an exchange of confidential information should be covered by a confidentiality agreement. Forms for such agreements are available from, and should be prepared by, the OGCPA. If a confidentiality agreement is received from an outside company by a person associated with the University, that person should forward the confidentiality agreement to the OGCPA for review and signature. The University may be an involved party and the Assistant Provost for Research normally should sign any such agreement on behalf of the University.

F. If a patentable idea is discussed in a thesis or other written document, the document should be brought to the attention of the OGCPA. If necessary, the OGCPA may postpone the indexing of the report until a patent application is filed on the invention.

ARTICLE VI. Requests for Waiver

If the Inventor believes that an invention was conceived and reduced to practice without support from the University, he may accompany a disclosure with a request that the University waive any rights it may have to such invention. Any such request must be accompanied by a statement of facts that relate to the request.

ARTICLE VII. Evaluations

A. The University shall, when required, evaluate all disclosures and requests for waiver with good faith and reasonable diligence. If it appears that a request for waiver should be granted, or if the University decides for any other reason not to prepare a patent application on the invention or discovery, then the University shall issue a written waiver or decision not to patent, disclaiming any rights the University may have to the invention. However, any such waiver or decision not to patent shall permit the University to make and use the invention for non-commercial University purposes.

B. If the University fails to make a determination regarding a waiver or a decision to patent within a period of sixty (60) calendar days from the date of disclosure to it, then the inventor may so notify the Assistant Provost for Research in writing. Within thirty (30) calendar days after the Assistant Provost for Research is notified, a decision must be rendered in writing by the Assistant Provost for Research or all of the University's rights shall be forfeited and reassigned to the inventor, subject only to such external sponsor restrictions as may apply.

C. The University may engage a patent management firm to assist in the evaluation, filing, and marketing of any and all inventions.

ARTICLE VIII. Rights and Obligations of Inventors

The University is obliged to solicit and consider the opinions and suggestions of the Inventor while evaluating a disclosure, preparing a patent application, licensing an invention, or making other recommendations regarding an invention. The Inventor is obliged to bring to the attention of the University all relevant facts and developments regarding an invention, and to cooperate with and assist the University in all matters relating to an invention. The Inventor shall assign to the University all domestic and foreign rights to any invention when requested to do so by the University, on forms provided for such purpose by the University. An Inventor's rights and obligations with respect to an invention shall survive so long as the University owns any property rights relating to the invention.

ARTICLE IX. Income from Inventions

A. The University shall reimburse itself from the gross income from an invention for all out-of-pocket and contractual expenses related to the invention. If a patent management firm is engaged to evaluate, file or market an invention, all expenses and fees of said firm will be deducted prior to distribution of income to the University and inventors. Remaining and subsequent income shall be distributed as follows:

the Inventor(s) shall receive 40%;

the department(s) with which the Inventor(s) is associated shall receive 20%. These funds are in addition to the regular University budget for the department and shall be divided equally between direct support to the Inventor for his or her research and the Inventor's department to foster research in the department.

the University shall allocate 20% to a fund under the direction of the President for the promotion of research; and

the University shall retain 20% for use at its discretion.

B. Distributions shall be paid quarterly.

C. If the provisions of this article are inconsistent with the requirements of a sponsorship agreement, then the sponsorship agreement shall prevail.

ARTICLE X. Multiple Inventors

Inventors shall share in the income to which they are collectively entitled. The percentage shall be indicated beside each inventor's name on the disclosure (Exhibit A). The disclosure may allow for income-sharing with people who are not co-inventors as defined by the patent law.

ARTICLE XI. Amendments

A. Any amendment to this policy shall apply to all decisions that are made after the effective date of said amendment. However, no amendment shall decrease the royalties received by the inventors under any assignment or license agreement that is signed before the date of said amendment.

B. The University should, no less frequently than every five years from date of enactment, review, revise, and update the patent policy as appropriate.