

MEDICAL COLLEGE OF OHIO

Subject: PATENT POLICY AND REGULATIONS

Policy No.: 03-003

In cases which involve activity by a Medical College of Ohio faculty, staff member, or student (collectively "MCO Personnel") any patent rights and related waivers in resulting work products shall be governed by the following regulations.

Pursuant to Section 3345.14, of the Revised Code of Ohio, all right to and interests in discoveries, inventions, or patents, which result from any research, investigation or work conducted in any laboratory or facility of the Medical College of Ohio (hereinafter the "Medical College" or "MCO") or by MCO Personnel acting within the scope of their employment or with funding, equipment, or infrastructure provided by or through the Medical College, shall be the sole property of the Medical College, its successors and assigns. Assignments or waivers of such rights, titles and interests may be made to external sponsoring agencies or others, only as provided in subsequent clauses of this policy.

Promptly after the conception and/or making of an invention or discovery, MCO Personnel shall disclose to the Medical College such invention or discovery. Such disclosure should be on MCO Form RGA 202 and should contain sufficient information for the Patent Advisory Committee to make an informed judgement regarding the patentability of the invention/discovery and to allow the Committee to make an informed recommendation regarding the desirability for the Medical College to retain rights in the invention/discovery. The contents of this disclosure should include, but not be limited to, a general description of the field of the invention or discovery, a specific disclosure of the invention or discovery, any prior art of which the inventor(s) is aware, a general statement (if possible) of the economics of the invention or discovery, a listing of the notebooks or other records containing the first description of the invention or discovery, the name of the person to whom the invention or discovery was first disclosed and the date of such disclosure. This MCO disclosure document must be witnessed by someone who understands the invention, but who is not an inventor.

All information which may reasonably be related to a patentable invention, acquired by MCO Personnel resulting from or related to research or investigations conducted in any laboratory or facility of the Medical College, or acquired by such MCO Personnel in connection with research or investigations conducted in any laboratory or facility of the Medical College, or acquired by such MCO Personnel in connection with research or investigations sponsored in whole or in part by public or private foundations, governmental agencies, business, or industry shall be confidential information and shall be disclosed only to the Medical College or others directed by the Officers and agents of the Medical College.

All information as described in the above paragraph shall be maintained in confidence unless such information is, or becomes, publicly available through no fault of the student or member of the faculty or staff of the Medical College or unless written permission is obtained from an authorized Officer or agent of the Medical College to disclose such information.

MCO Personnel shall, whenever requested by the Medical College, make, sign, execute and deliver all applications, assignments and other papers which shall, in the opinion of the Medical College or its legal or patent counsel, be deemed necessary, proper or desirable for obtaining letters patent of the United States and any other countries, and for transferring all such discoveries, inventions, improvements, patentable ideas, methods, processes, trade secrets and letters patent and applications therefore to the Medical College, its successors and assigns.

The President of the Medical College may appoint another administrative official as his/her designee for the management of MCO patents and other intellectual property. This individual shall serve as the Chair of the Patent Advisory Committee. Unless otherwise specified by the President, his/her designee shall be the Associate Vice President for Research. The President, or his/her designee, shall appoint a committee consisting of at least three members of the faculty, one or more members of the administrative staff of the Medical College,

and any other members with expertise deemed desirable for evaluating MCO intellectual property, which committee shall be known as the Patent Advisory Committee. Such committee will:

Review all inventions and discoveries and determine and advise in each individual case whether a discovery or invention resulted from research or an investigation conducted in any laboratory or facility of the Medical College or by employees of the Medical College acting within the scope of their employment or with funding, equipment, or infrastructure provided by or through the Medical College and is the property of the Medical College.

Determine and advise whether the discovery or invention which is the property of the Medical College has sufficient value or is of a sufficient interest to the Medical College to warrant its retention; or, whether the same should be relinquished to the agency which sponsored the research leading to the invention/discovery, if required by said agency policies, or to MCO inventors or shall be otherwise dealt with.

In those situations in which it shall have been determined that the discovery or invention does not otherwise belong to the Medical College, advise about acquiring on behalf of the Medical College, by agreement, on such terms and conditions as the President, or his/her designee deems appropriate, an interest in such patentable discoveries and inventions of MCO Personnel

Determine and advise whether to pursue the patentability and development of a discovery or invention which is the property of, or was acquired by, the Medical College.

Recommend to the President, or his/her designee prospective purchasers or licensees of inventions or discoveries and, when requested, advise the President, or his/her designee on the terms and conditions of any agreements.

The President of the Medical College, or his/her designee is hereby empowered and authorized, after receiving the advice of the Patent Advisory Committee, to act on or reject the Patent Advisory Committee's determinations, and to sell, assign, convey, or grant any such discoveries and inventions or any rights or shares in such discoveries and inventions, including patent rights, to such persons, firms or governmental agencies for such consideration or upon such terms and conditions, including dedication to the public, as shall be deemed by him/her to be in the proper and best interest of the Medical College and its inventor(s).

The Medical College may, alone or with the assistance of an external organization(s), make application for patents on any such inventions or discoveries selected by the Medical College for patenting. Generally, the Medical College will seek a licensee prior to filing a patent application(s), and will require the licensee to pay the costs associated with patent filing, prosecution and maintenance. The net income from any invention or discovery will be shared between the Medical College and the inventor(s). Fifty percent of the net income will belong to the inventor(s) or the heirs and the legatees of the inventor(s). The remaining fifty percent of the net income will be the property of the Medical College. Net income from any invention or discovery shall be earnings received by the Medical College from the invention or discovery after payment of all costs incurred by the Medical College in connection with the invention or discovery. Such costs shall include, but not be limited to, the cost of pursuing patent protection, developing the invention, marketing the invention and licensing the invention. If there is a plurality of joint inventors, that part of the net income accruing to the inventors will be distributed on a pro-rata basis, unless another percentage disbursement of the inventor's share is specifically requested in writing by the inventors. If a plurality of institutions is involved in an invention, an agreement will be negotiated by the institutions in consultation with the inventors.

The President of the Medical College, or his/her designee shall elect whether to apply for a United States patent and shall initiate the patent search after the submission of the invention disclosure to the Medical College by the inventor(s). If the Medical College elects not to attempt to obtain patent protection, the Medical College may, at its sole discretion, and after meeting any requirements of the sponsor of the research leading to the invention(s), relinquish all rights to the invention to the inventor(s), or otherwise deal with said rights.

The President, or his/her designee is authorized by the Board of Trustees to make arrangements with external sponsors of research to obtain research funding from such sponsors. Such arrangements may include, but are not limited to, assigning all rights to inventions or discoveries to the sponsor, or granting an exclusive or nonexclusive license to the sponsor with or without royalties to be returned to the Medical College. Any such agreement must be in writing and signed by an authorized Officer or agent of the Medical College. Such agreements will be in consultation with the inventor(s).

Procedure and Regulations Governing Invention Disclosures to be Submitted to the Patent Advisory Committee:

Purpose and Authority

By regulations adopted by the Board of Trustees, the Patent Advisory Committee is charged with the responsibility for advising the President, or his/her designee in carrying out the Patent Policy of the Medical College. Pursuant to that goal, the Patent Advisory Committee has adopted the following procedure governing the disclosure and submission of inventions to the Patent Advisory Committee.

The Medical College's Rights in Certain Inventions

As required by Ohio statute and as further defined in the Medical College's Patent Policy and Regulations, any invention or discovery developed by MCO Personnel resulting from any research, investigation or work conducted in Medical College facilities, or by MCO Personnel acting within the scope of their employment or with funding, equipment, or infrastructure provided by or through the Medical College is the property of the Medical College. The Medical College will develop legal protection and utilize such inventions which may benefit the public or the Medical College. Under the Patent Policy and Regulations, fifty percent of the net income received by the Medical College on any invention or discovery will be shared with the inventor(s) and the remaining fifty percent of the net income shall be the property of the Medical College.

If the Medical College determines that it has no interest in such inventions, it may assign or release all rights therein to the inventor or inventors, after satisfying any requirements of the sponsor(s) of the research leading to the invention/discovery. In order to timely protect the rights of both the Medical College and the inventors, the prompt submission or disclosure of all such inventions or discoveries to the patent committee is necessary.

Certain research contracts with private industry and particularly with the federal government contain patent ownership clauses which may grant to or take away patent rights from the Medical College or MCO Personnel. It is necessary that these contracts be consistent with the Medical College's Patent Policy and Regulations, insofar as is possible, to maximize the benefit to the Medical College, its students, faculty and staff. Accordingly, the early submission of such contracts to MCO Research & Grants Administration for its review and approval is necessary.

The Patent Advisory Committee

Duties:

The committee shall evaluate inventions submitted to it to determine:

If the invention is such that the Medical College has no rights thereunder. For example, the invention was developed under a sponsored research contract in which the grantor is given all rights or the invention was made without using Medical College facilities, etc. and was developed by MCO Personnel outside the scope of their employment or without funding, equipment, or infrastructure provided by or through the Medical College.

If the invention is the property of the Medical College, does the invention require further legal protection and can it be licensed or otherwise used to produce royalty or other income to the Medical College and the inventors.

The inventor(s) shall ordinarily be given an opportunity to present all relevant information and recommendations to the Committee in writing or in person.

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After making the above determinations, the Patent Advisory Committee shall make its recommendations to the President of the Medical College, or his/her designee. The President, or his/her designee is empowered and authorized to act on or reject such determinations.

The Patent Advisory Committee shall be represented by MCO Research & Grants administration in maintaining liaison with the MCO patent Counsel or other agents in making patentability searches, securing proper legal protection for the selected inventions and in obtaining the maximum benefit therefrom.

Procedures:

Recognizing that time is of the essence in securing legal protection for inventions, the Patent Advisory Committee shall meet on a regular basis in order to carry out its defined duties. In its evaluations of inventions, as described under Duties above, the Patent Advisory Committee shall normally communicate its decisions and recommendations in writing to the President of the Medical College, or his/her designee within three months of the receipt of the disclosure. The inventor(s) will be informed of the Medical College's decision with respect to the submitted invention within six months of the date of receipt of a disclosure containing sufficient information for the Patent Advisory Committee to make an informed judgement regarding the patentability of the invention/discovery and to allow the Committee to make an informed recommendation regarding the desirability for the Medical College to retain rights in the invention/discovery.

Liaison with Attorneys and Prospective Licensees, etc.:

The President's designee, who is a Patent Advisory Committee member, shall provide liaison among the inventor(s); Patent Advisory Committee; Legal or Patent Counsel; external sponsors of research; prospective licensees; developers, promoters and other persons having an interest in acquiring or developing rights in inventions or discoveries from the Medical College. This individual shall convey significant matters to the Patent Advisory Committee for review, policy guidance and recommendations to the President.

Records:

The Patent Advisory Committee shall keep appropriate records of all such submitted invention disclosures, patent applications, patents and agreements, etc., as is necessary to perform its functions.

The Inventor's Responsibilities:

Submission of Disclosures:

Any MCO Personnel who has made or participated in the making of an invention or discovery using Medical College facilities or acting within the scope of their MCO employment or with funding, equipment, or infrastructure provided by or through the Medical College must submit to the Chairman of the Patent Advisory Committee, an Invention Disclosure Form completed to the fullest extent possible. At the same time, a copy of the completed Invention Disclosure form shall be submitted, for informative purposes, to the person (Department Chairman, Supervisor, etc.) responsible for the inventor's activity. The standard MCO Invention Disclosure Form (RGA 202), must be used in order to assure that the Patent Advisory Committee receives all necessary information. Additional drawings, photos, reports, etc., may be attached to the Invention Disclosure Form as necessary to complete the disclosure.

Because the completed Invention Disclosure Form may be the first complete written record of the invention, it should be signed and dated by the inventor(s) and by at least one witness who is competent to understand the invention.

Each MCO Personnel who participates in patent activities with business, industry, governmental agencies or individuals in conjunction with consulting, research or other professional activities (commensurate with Medical College personnel policies) must provide the Patent Advisory Committee with each patent application at the time of its filing.

Cooperation with the Patent Advisory Committee:

Each inventor is required to cooperate with the Patent Advisory Committee to the extent required to assist in evaluating the invention and to enable the Patent Advisory Committee to secure optimum legal protection on selected inventions.

Caveat:

Under the provision of the patent laws of the United States and the patent laws of many foreign countries, a published description (publication) or public use of an invention by the inventor or anyone else if made more than one year prior to the official filing date of a patent application for that invention, will make the invention unpatentable and will cause the forfeit of all patent rights in the invention. In some foreign countries, patent rights are lost upon publication or public use of the invention at any time before the filing date of the patent application for the invention. A "publication" has been interpreted to include a typewritten thesis deposited in a Medical College library, oral presentations at professional meetings, etc. Accordingly, any questions regarding publication, public use or disclosure of an invention which may ultimately be considered for patent protection should be referred to the Patent Advisory Committee for its consideration and guidance.

Source: President and Executive Vice President and Provost

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