INTELLECTUAL PROPERTY

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What is Intellectual Property (IP)?

• “Creations of the mind”

• Inventions / Innovations / Technology

• Literary Works – Software, Books, Reports

• Ideas, methods
How is IP created?

• Brainstorming
• Proposal development
• Research
• Development – contract performance
• Discussion / collaborating
How is IP protected?

• **Patents**
  – Must be novel, have an inventive step (non-obvious), and utility.
  – Patent must have a technical description and claims.
  – Relatively strong protection with public policy underpinnings—must disclose invention to obtain exclusive rights

• **Copyrights**
  – Copyright is achieved at the time a work is created in tangible form
  – Fairly narrow protection, but “automatic” to achieve
  – Registration enhances legal rights and remedies
  – Notice is voluntary, but recommended - © year, name

• **Trademarks**
  – Protection based on continuous use
  – Public policy underpinnings—protect the consuming public
  – Quality assurance and brand recognition

• **Trade Secrets**
  – Protect secret information so long as secret, possibly forever
  – Potentially vulnerable
Who owns the IP created at ASU?

Under Arizona Board of Regents IP Policy 6-908, ASU claims ownership of:

• Any intellectual property created by a university or Board employee in the course and scope of employment

• Any intellectual property created with the significant use of Board or university resources, unless otherwise provided in an authorized agreement for the use of those resources

For full details, see
Benefits for Inventors & the University

- Good publicity for inventors and University.
- Financial returns to the inventor – at ASU, after AzTE and legal expenses, 1/3 of net income goes directly to inventors and 1/3 goes to inventor labs.
- May lead to additional R&D funding for inventors.
- May lead to consulting work with licensees.
- May lead to employment for inventors – alumni students can be employed by licensees.
When should I be concerned about IP?

• Discussions between PI and a partner
  – Inappropriate disclosure (Is an NDA needed?)
  – Level of detail
  – Contamination
• PI wants to send or receive material
• A partner wants to fund or sponsor research
Confidentiality Agreement: What and Why?

• Binding contract that governs the use of confidential information
• Defines “Confidential Information”
• Mutual or One-Way
  – Who will be disclosing information?
  – Who will have the obligation to keep information confidential?
• Written Disclosure vs. Oral Disclosure
  – Marked “Confidential” or “Proprietary”
  – Oral disclosure – follow up in writing
• When?
  – Before any confidential discussions
  – Before filing of patent application
Confidentiality Agreement: Process at ASU

- Contact OIRC through proposalandnegotiation@asu.edu
- Provide with the following information:
  - **ASU Information**: a short paragraph that defines the information to be disclosed, the context in which the information will be disclosed and the reasons behind the parties’ wish to communicate the information.
  - **Outside Party Information**: if applicable and available, provide a short paragraph that defines the information to be disclosed and the context in which the information will be disclosed.
  - **Point of contact**: Provide the name (required), address, phone number (required), fax number, and email address (required) of the person responsible for negotiation and authorized signatory for the third party.
  - **Desired deadline**: Provide a desired date when the agreement is needed. Normal agreements do not take more than a few days to process. Complex agreements are likely to take longer. Plan accordingly.
Material Transfer Agreement: What and Why?

- Binding written contract that governs the use of loaned Material
  - Examples: assay materials, monoclonal antibodies, cell lines, mouse strains, plant varieties, technical data, or any unique material.
- Defines and protects rights to inventions, patents, and commercialization resulting from Material
- Defines and protects rights to improvements to Material and/or inventions made using Material
- Provide control over the distribution of Material
- Ensures acknowledgment of ASU investigators in publications resulting from use of their Material
- Ensures recipients exercise care in handling Material and follow relevant federal guidelines
Material Transfer Agreement: Process at ASU

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- Provide with the following information:
  - **Description of Material**: a brief, yet precise, description of the material being transferred, including amounts of materials or any special handling procedures required for safe transport and acceptance of the materials.
  - **Scope of Research**: Describe the “Purpose” with a concise statement of the intended research or other use of the materials. Ideally, the statement will identify how the materials being requested will support specific ongoing research efforts.
  - **Desired Deadline**: What is the desired date of completion? Normal agreements do not take more than a week, but complex agreements take longer.
  - **Other**: Will the Material be used to improve intellectual property that is already developed? Will the Material be used to support work developed for a sponsor supported project?
Sponsored Research Agreement: What and Why?

• Binding written contract that governs work to be performed by ASU and sponsored by another
• Defines each party’s roles and responsibilities
• Sets forth each party’s rights in and to the results of the work performed
  – Intellectual property ownership
  – Licensing – research v. commercialization
  – Publication
• Confidentiality, Term, Termination, Disputes
What types of IP issues come up in ASU contracts?

- Publication
  - Education mission
  - Fundamental Research Exclusion
- Background IP
  - Availability of rights
  - Reasonable compensation
- Ownership / Rights in Foreground IP
  - Sponsor’s payment
  - ABOR IP Policy
  - Private Use
- Freedom to Operate
Agreements: **Who can and cannot sign?**

- Neither Researcher nor management within a school or college is authorized to sign an SRA, CDA, or MTA on behalf of ASU

- Personal liability

- ASU delegated authority
  - Asst. Director of Research Admin.
  - Limited, defined delegation
Modification v. New Agreement

• What is being done?
  – Time
  – Dollars
  – Tasks

• Impact of a Modification
  – Extension of Rights
  – Extension of Obligations
  – Extension of Options
Questions
THANK YOU FOR ATTENDING

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