

Public Dedication of Intellectual Property Quick Guide

2019



Strengthening
University-Industry
Partnerships

Public Dedication of Intellectual Property Quick Guide

INTRODUCTION

The public dedication of intellectual property (IP) model represents a novel and innovative approach to university-industry (U-I) collaboration. In certain circumstances, the public dedication of results or IP generated by academic and corporate collaborations may be a viable and desirable outcome for both parties, while offering a positive impact and benefits to the public. This Quick Guide provides critical information about the public dedication of IP approach under such collaborations, explores various perspectives on this strategy, and describes the major considerations associated with the approach.

BACKGROUND

Although publicly funded research is often associated with the generation of knowledge for the public good, some representatives in companies and universities (including faculty) may be interested in the public dedication of IP approach under industry and other non-government-funded projects. IP has traditionally been a primary focus of discussion in U-I collaborations and contracts. In more conventional IP approaches under industry-funded projects, ownership and licensing rights may be heavily negotiated between the parties, with each party considering and protecting its relative project investment (e.g., funding, background IP, facilities, expertise, and human resources), as well as potential future return on, and monetization of, these investments. Public dedication of IP models tend to focus on the scholarly, technological, and ultimately societal impact of project results, rather than their proprietary or financial value. In some cases, a public dedication approach may also reduce agreement negotiation time.

Public Dedication is one of the fastest ways industry and academia can together accelerate adoption of a new technology and bring positive value to society. – A Major US Corporation

THE PUBLIC DOMAIN

Copyrightable works may become part of the public domain because the copyrights have expired, been lost for other reasons, or are expressly waived. Other works, such as facts, are in the public domain because no legal protection is available to them. Because a copyright attaches automatically to a work when it is first created and set down in tangible form, the author or owner must make an affirmative statement on the work if they wish to dedicate it to the public, thus waiving copyrights and placing the work in the public domain.

Patentable works may become available for public use if an inventor does not seek patent protection by filing a patent application and instead publishes, or publicly discloses, the invention. In that case, an inventor waives the right to seek or enforce patent rights. Because no patent may then be issued or be enforced on that invention, use of the invention by anyone is permitted and cannot be considered an infringement of an inventor's rights. Note, however, that a description of an invention (patentable or not) remains copyrightable, so an author would have to take steps to dedicate that copyright to the public as well, if this were the intention. Patentable works may also become available for public use when patents and patent applications are abandoned.

Ultimately, the ability to identify the inventors, authors, and owners is required if a public dedication or waiver of rights is to be effective because only the inventors, authors, or owners may take the actions necessary to dedicate a work to the public.

PUBLIC DEDICATION OF IP: DEFINITION

For the purposes of this Quick Guide, an industry-funded project using a public dedication of IP approach may include the following features:

- *The parties agree that they will not file patents on the results of the research;*
- *The parties agree that they will place appropriate public dedication/public domain markings on copyrightable results; and*
- *The parties agree that they will make results publicly available.*

In some instances, explicit agreement by the parties that the project, or its result, is being undertaken primarily for societal benefit is intended to maximize immediate access and use by the public.

MOTIVATIONS FOR PUBLIC DEDICATION OF IP APPROACH: VARYING PERSPECTIVES

University

- **Accelerates negotiations.** Can reduce negotiation time and complexity, accelerating project start.
- **Builds relationships.** May help universities build relationships with a broader range of companies representing new business models, technology applications, and markets, expanding overall options for industry engagement. Allows broad access to results of university research by potential industry collaborators, exposing expertise, capabilities, and connection points.
- **Enhances dissemination of results.** Accelerates the dissemination of research results for the “greater good,” allowing others to freely use and build upon the research.
- **Lowers costs.** Reduces or eliminates potential costs of patents or other forms of IP protection and defense.
- **Supports mission.** Enables universities to further their public service–driven missions.
- **Enhances innovation.** Empowers the technology ecosystem to build and innovate in additional ways, including launching profitable business models based on publicly available technology.

Company

- **Accelerates negotiations.** Can reduce negotiation time and complexity, accelerating project start.
- **Advances corporate social responsibility goals.** Can enable companies to address social responsibility goals by disseminating research results that may be freely used by the public and applied broadly.
- **Encourages basic research.** Attractive for early stage/precompetitive research.
- **Supports platform technologies.** May be suitable for developing technology that requires more investment to be implemented across a broad or multiple industry segment by established companies, startups, government, and non-profit organizations.
- **Catalyzes strategic engagement.** Successful collaborations help support other forms of engagement across the Partnership Continuum,¹ including those involving research leading to intellectual property that the parties choose to protect through traditional legal frameworks.
- **Promotes freedom to practice.** When successfully implemented, the public dedication IP model ensures the freedom to practice funded research results.
- **Supports consortia.** May support multiparty partnerships and consortium development. This is especially true when the proposed activities are not subject to federal regulations such as Bayh-Dole.

¹ See www.uidp.org/publication/partnership-continuum.

Faculty and Other Researchers

- **Enhances professional impact.** Some faculty are enthusiastic about making their research results publicly available, allowing for wide development and application of their work, and enhancing their professional exposure, reputation, and impact.
- **Facilitates efficient matchmaking and partnering.** Some companies have adopted public dedication of IP models as one vehicle for university engagement. Faculty (and their universities) willing to accept these conditions may be able to increase their corporate engagement opportunities and funding prospects while efficiently reaching agreement with partners.
- **Gives opportunities to other lab personnel.** Increasing the number of industry collaborators provides expanded opportunities for other lab personnel, such as postdoctoral researchers and students, to gain exposure to working with a broader range of companies, impact the world through their research, and expand future employment opportunities.

COMPARING MOTIVATIONS

Key Issues	Industry Perspective
Public dedication as one option in a continuum of approaches on IP	These approaches may be appropriate for lines of inquiry in the precompetitive space; may also align with corporate social responsibility goals.
Public dedication is a model particularly well suited to early stage, precompetitive research	If research evolves beyond the precompetitive stage, an alternate IP model or agreement may be needed to support the work.
Project personnel education	Industry must ensure that their project personnel are aware when projects are operating under public dedication of IP conditions.
Multiple projects within same group	Multiple projects in a Principle Investigator's (PI's) lab with overlapping work can lead to comingling of funds and research results with conflicting IP requirements.
Administrative personnel education	Company attorneys, academic liaisons, and other involved parties may be new to public dedication of IP model.
Background and third-party enabling technologies	Industry should require university to identify any background and third-party intellectual property that would be needed to use the research results.
Protection of IP	Industry should be sensitive to project scope boundaries. Industry should ensure that core technology is not negatively impacted by public dedication of IP agreements.

APPROPRIATENESS OF AND LIMITATIONS TO THE PUBLIC DEDICATION OF IP APPROACH

Public dedication of IP approaches are not appropriate for a limited number of U-I research collaborations. This approach may be more common in the software and information technology fields. However, where circumstances are appropriate, the public dedication of IP model is an *additional* approach that can be evaluated by companies and universities when designing and negotiating a research collaboration in a range of disciplines.

When the university and company agree in principle that the public can and should freely benefit from immediate access to and use of project research results, it may be appropriate for the parties to formally agree not to file for patent protection of results or to publicly dedicate results and place them in the public domain. By agreeing upfront to public dedication of research results, the university and company may avoid having to negotiate potentially complex and difficult proprietary IP terms. Researchers may develop subsequent enhancements or improvements that result in proprietary licenses unless the preceding contract addresses and includes these in the scope of results subject to public dedication terms. If government funding is used to produce the research results, public dedication of patentable inventions would require the permission of the inventor's institution as well as the applicable government agencies because title to an invention may not be elected by the inventor's institution without agreeing to file a patent application within a specified time period.

University Perspective	Key Takeaway
These approaches may lead to a different set of benefits and obligations for university and project personnel.	Expands the number of ways in which universities and companies can partner.
If research evolves beyond the precompetitive stage, an alternate IP model or agreement may be needed to support the work.	Projects with public dedication of IP obligations require regular monitoring of their direction and outputs.
University must ensure that their project personnel are aware when projects are operating under public dedication of IP conditions.	Project personnel commonly change; active educational management is necessary to assure that all participants are aware of the requirements and effects of public dedication projects.
As always, a PI must ensure that each project in his or her research portfolio maintains integrity in regard to scope, funding, and IP	Important to scope research project boundaries and definitions of affected research results prior to committing to public dedication of IP approach for each project.
University attorneys, corporate liaisons, and other involved parties may be new to public dedication of IP model.	Ensure that all relevant and interested parties communicate and understand ramifications and obligations.
University may limit the scope of the project to avoid the need for access to background and third-party intellectual property to use the research results.	For public dedication of IP models to be effective, identified background and third-party intellectual property of industry or university cannot block public use of research results.
University should be sensitive to project scope boundaries. University should ensure that its IP distinct from public dedication project is not negatively impacted.	Industry and university must take care and avoid funding projects under a public dedication model that can impact core or previously encumbered IP

ENGAGING INTERNAL STAKEHOLDERS, ESTABLISHING BUSINESS CASES, AND CONDUCTING PROJECT PLANNING

The unique project management requirements associated with the public dedication of IP approach require careful planning within and between collaborating organizations. The following represent major considerations before the start of the project:

- ▶ **Be proactive.** Organizations should proactively develop a broad strategy for such engagements involving internal stakeholders, including ensuring communication among appropriate administrative offices. Organizations must sometimes perform due diligence in identifying appropriate/eligible researchers and projects. For example, universities typically obtain the written consent of numerous parties (faculty, staff, and students) when the public dedication of IP model is to be used. **In these situations, the licensing of foreground IP rights and resulting revenues are forfeited.** This may impact future research directions and the ability to form startups. The parties must also agree upon timely and coordinated public disclosure as well as other forms of communication and technical publications.
- ▶ **Specify funding mechanism.** The collaborating organizations must determine the appropriate agreement vehicle for a project utilizing the public dedication of IP approach. The clearly defined statement of work as well as the unique management requirements associated with public dedication of IP projects may not be congruent with utilization of unrestricted gift mechanisms. The administrative or indirect costs that may be associated with public dedication of IP projects may also influence the funding mechanism selected.
- ▶ **Perform due diligence.** When considering the public dedication of IP model, it is important to define the research results subject to the public dedication terms as specifically as possible. The parties should assure that no third-party or background rights are included in the research results that would prevent the public from obtaining the full benefit of the public dedication.
- ▶ **Establish maintenance parameters.** To realize optimal broad and public use of the research results, the parties may wish to specify where the results will be published, maintained, and accessed.

PROJECT MANAGEMENT

Once the public dedication of IP model is agreed upon by the parties and memorialized in an agreement, certain due diligence and monitoring activities should follow.

- ▶ **Manage enforcement and tracking personnel.** Because disclosures are the linchpin for ensuring the public dedication of IP model, the collaborators must have in place a process requiring research personnel to clearly identify project results (including disclosing patentable and copyrightable results) and attributing those to individual personnel and funding sources. For example, personnel changes can have a material impact on implementing the model, as project personnel must agree to forego their IP rights in their affected IP.
- ▶ **Avoid commingled funds.** Successful researchers are likely to have multiple funded projects and must ensure project integrity for any project(s) operating under the public dedication of IP model. To avoid problems resulting from overlapping statements of work and government requirements (Bayh-Dole) with other projects, with funding from other companies, or even with the same company, all personnel need to be careful not to commingle funds and to clearly define research projects. At many institutions, there are many independent research groups pursuing scholarship in overlapping or synergistic areas. The university should do its best to ensure that these groups are cognizant of any institutional obligations relative to the public dedication of IP and, if appropriate, retain an appropriate level of separation.

- ▶ **Provide other ancillary benefits.** In those instances where the public dedication of IP model expands collaborative efforts that would not exist without the use of this model, university junior and senior personnel (from students through independent faculty members) can benefit from being afforded an additional option of working with the company on site in a variety of ways, including internships or consultancies.
- ▶ **Establish triggers for departing.** There may be times when a public dedication of IP model is no longer appropriate for a given line of inquiry or research project. For example, when technology being pursued under a public dedication of IP model evolves beyond the precompetitive domain, a new agreement mechanism is needed to support an extended line of competitive research. In addition, a company, university, or faculty member's interests may change during a funding period.
- ▶ **Complete final report and archiving.** Once the funding period ends and an academic research group has completed the project activities under a public dedication of IP model, the relevant agreement may stipulate that the university create a final report and repository of appropriate material (including publications, source code, meeting presentations, and data sets). The university may also catalog disclosures of IP subject to the requirements of the agreed-upon public dedication conditions.

The public dedication of IP model provides companies and universities with another approach that can be used to catalyze partnerships between the parties, advance the interests of both parties, and ultimately provide benefits to the public at large through the development of new products and services.

REFERENCES

- Agreement of transfer of trust creating the American Chemical Society Petroleum Research Fund.* (2000). Retrieved from <https://www.acs.org/content/dam/acsorg/funding/grants/prf/prf-transfer-agreement.pdf>
- IBM: What is Open Collaborative Research?* (2011). Retrieved from https://researcher.watson.ibm.com/researcher/view_group.php?id=2290
- Intel Labs' open collaborative research model.* (2012). Retrieved from https://sites.nationalacademies.org/cs/groups/pgasite/documents/webpage/pga_081597.pdf
- Intellectual property policy.* (1985). Retrieved from <https://www.cmu.edu/policies/administrative-and-governance/intellectual-property.html>
- Intellectual property policy.* (2014). Retrieved from <https://wustl.edu/about/compliance-policies/intellectualproperty-research-policies/intellectual-property/>
- Intellectual property policy.* (2017). Retrieved from <http://www.bu.edu/academics/policies/intellectual-property-policy/>
- Microsoft Edge: Making the web better through more open source collaboration.* (2018). Retrieved from <https://blogs.windows.com/windowsexperience/2018/12/06/microsoft-edge-making-the-web-better-through-more-open-source-collaboration/>
- Policy on intellectual property.* (2001). Retrieved from <https://www.lehigh.edu/~policy/university/ip.htm>

COPYRIGHT & DISCLAIMER

UIDP materials, which include publications, webinars, videos, and presentations, reflect an amalgamation of the experiences and knowledge of those who participate in UIDP activities. The views and opinions expressed in UIDP materials do not necessarily reflect the official policy or position of any individual organization or the UIDP. At no time should any UIDP materials be used as a replacement for an individual organization's policy, procedures, or legal counsel. UIDP is not a lobbying organization, and UIDP materials are not intended to be used to influence government decisions.

All rights reserved. This member created publication is intended for use by UIDP MEMBERS ONLY. No part of this publication may be reproduced, distributed, or transmitted in any form or by any means, including photocopying, recording, or other electronic or mechanical methods, without the prior written permission of UIDP. To view the written permission granted to member organizations, go to www.uidp.org.

Additional written permission may be granted to members, non-members, and/or participants in certain UIDP events. Additional permissions can be found in the UIDP materials that they pertain to. For permission requests, write to UIDP at: 6156 St. Andrews Road, Suite 207 Columbia, SC 29212.

Copyright © 2019 by University Industry Demonstration Partnership (UIDP)

ABOUT THE UIDP

At the UIDP, we have different perspectives and one focus: improving University-Industry (U-I) partnerships. The UIDP is a unique project-oriented forum where representatives from academia and industry seek opportunities to develop new approaches to working together. Our membership comprises some of the finest innovation companies and best research universities in the world: organizations committed to active participation in pursuit of excellence in U-I collaboration and partnership. At the UIDP, we don't just talk about problems, we solve them.

UIDP • www.uidp.org • info@uidp.net



Strengthening
University-Industry
Partnerships

UIDP
6156 St. Andrews Rd., Suite 207
Columbia, SC 29212

P: 803.807.3679
E: info@uidp.net

uidp.org