



University Industry  
Demonstration Partnership

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Session 6:

# Managing Intellectual Property and Licensing

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# Issues Associated with Multiparty Consortia

- Intellectual Property Ownership
- Licensing
- Sponsors wanting to control research via steering committees
- Federal laws and regulations

# Intellectual Property Ownership

- Standard Model
  - University owns all university-developed IP
  - Industry gets an option to negotiate a license
- Consortia Model
  - Precompetitive research
  - Industry may own university-developed IP
  - University retains the right to publish and use the invention for University's educational and research purposes

# Process for establishing the IP/licensing model

*Helpful to first develop a framework in an MOU outlining the goals and intent of the consortia – include intended IP framework Industry typically looking for assurance that they won't be blocked from commercializing their own proprietary material*

- *Ex: If a Industry Member provides proprietary therapeutic agents, the Member Institution shall provide to Industry Member at least a fully paid, sub licensable non-exclusive license under all intellectual property rights in any patentable Member Institution Invention or Member Institution's interest in any patentable Joint Invention for commercial purposes related to the making, using and selling of the provided proprietary therapeutic agents, any molecules of the same chemo type (in the case molecules are provided; and proteins that bind to the same epitope in the case that proteins are provided), to the extent such rights in the Member Institution Invention, or Joint Invention block Member from exercising its own intellectual property rights which existed at the time the proprietary therapeutic agents were provided.*

# Process for establishing the IP/licensing model

- *Suggest involvement of key leadership from the contracting office, the business development office and the technology transfer or innovation alliances office*
- *Regular meetings and a focused discussion on IP is helpful.*
- *A Contract lead should own the agreement documents and track changes as well as coordinate feedback from all the members*

# Process for establishing the IP/licensing model

- *A project manager role can be helpful to facilitate agreement execution as well as proposal submission and review*
- *Members need regular updates and meetings*
- *Meetings with new members require detailed explanation of how IP works and how they will be protected – no changes to the existing agreement are allowed*

# Sponsors Wanting to Control the Research Program

- Sponsor gets to approve the projects they fund up front
- Joint review committees can work to oversee research project in appropriate circumstances
- Joint development/collaborative research projects more common
- Sponsors can truncate research funding

# Minimize Risks

## Industry Nightmare Scenario

- Industry funds research and covers patent costs but cannot reach agreement on licensing terms
- University licenses invention to a competitor of the Industry that funded the research

## University Nightmare Scenario

- University loses its tax-exempt status, owing millions of dollars in taxes or has to back pay interest on tax free bonds
- Allowing publication restriction that jeopardizes student graduation
- Important results are not shared with the scientific community or the public

# Resources

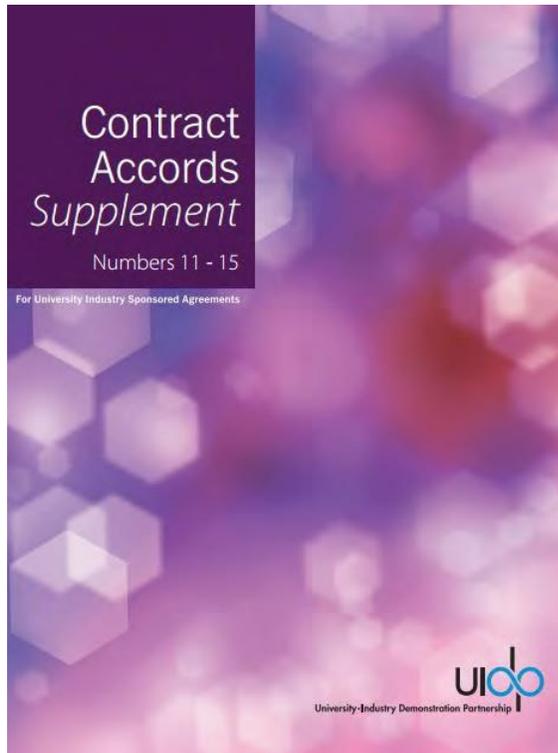
The UIDP has developed practical guidance to help universities and companies address challenges in negotiating sponsored research agreements



Statement of Work  
Indemnification  
Publications  
Other Research Results  
Background Intellectual Property  
Foreground Intellectual Property  
Export Control  
Copyright & Software  
Confidential Disclosure Agreements  
Material Transfer Agreements

# Resources

The UIDP has developed practical guidance to help universities and companies address challenges in negotiating sponsored research agreements



Gifts  
Budgeting  
Specialized Service/Testing Agreements  
Data Use Agreements  
Conflicts of Interest

Thank you!

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