

IP & Compliance

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WHAT IS IP?

- Intrinsic to the work of a university, intellectual property refers to ideas, processes, or inventions that are the products of intellectual endeavor.
- Intellectual Property (IP) is the basis for research commercialization.

INTANGIBLE



Patents
Copyrights
Trademarks
Knowhow

TANGIBLE



Germplasm
Antibodies
Any material

WHAT IS 'FOREIGN'?



Foreign or local visiting scholar is anyone who is NOT a UT-employee.

Greater complications can arise when a scholar is a foreign national or employed by a “company” (already assigned IP rights by employment).

AGREEMENTS THAT INVOLVE IP

Confidentiality Agreement

- Only for the exchange of confidential information
- Cannot use information for internal research



Research Agreement

- For specific purpose
- Option is granted to IP created under the agreement
- Our standard agreement
- Sponsor has no rights to background IP

CDA, MTA and RA are executed by UT (& UTRF) & company. LA is executed only by UTRF & company.

Material Transfer Agreement

- For transfer of materials listed in the agreement
- Materials can only be used for the purpose stated in the MTA



License Agreement

- Non-exclusive or exclusive grant to use the IP for commercial purposes in a given field of use and/or territory

CASE STUDY 1



Company signs CDA with UT and sends company's confidential information to UT's PI.

PI shares the information with his research group, which includes a visiting scholar.

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1. **Does the CDA cover the scholar?**
 2. **What about the IP generated?**

No IP should be generated under a CDA!

Cannot use any information obtained under a CDA for research.

CASE STUDY 2



UTRF had filed a patent application and the PI continues to work on the invention.

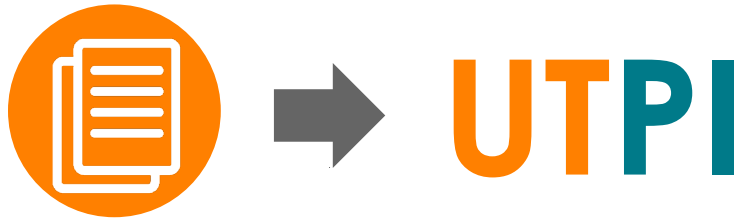


A visiting scholar works in the PI's lab and makes improvements to the IP.

Who own the rights to the scholar's work?

A UT researcher was working on IP and had visiting scholars work in her lab. These scholars went back to their home country. They then published a paper on the work they performed at UT! A large company expressed an interest in licensing the patent. The intervening publication could have had effects on the patenting and licensing of the IP.

CASE STUDY 3



Company signs RA +MTA with UT and sends company's confidential material to UT.

Has visiting scholars in their lab.

- 1) *The visiting scholar cannot know about the project or work on the material.*
- 2) *What about the new IP generated outside the scope of RA but using company's material?*

IP generated by use of 3rd party material is governed by the MTA and RA.

What about Patents?

- Any inventions may be jointly owned.

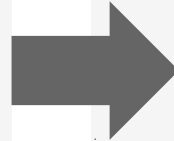
What about copyright or improvements to the material?

- If the scholar solely writes the code, that can belong to the scholar!
- What about improvements to the material ..?

CASE STUDY 4



*US Subsidiary of a foreign company signs an RA.
During the research agreement,
US Govt. puts the mother
company on the “entry list.”*



UTPI

*Has joint invention
with the US subsidiary.*

- 1) The RA has an option to the IP generated with the Option Period end of the term.**
- 2) UTRF has a joint IP with the US Subsidiary.**
- 3) The company has filed a PCT application.**
- 4) Working with GC and Export control on a BIS license application.**

CASE STUDY 5

UTPI

Has visiting scholar in their lab who develops a novel material.

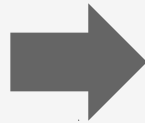
The PI wants to use that material in sponsored research.



Who owns the material???

*Who would own the patent application
(if any) filed on that material?*

CASE STUDY 6



UTRFI

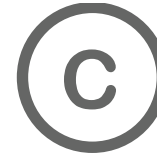
Foreign company sponsors work.

Has joint invention with this company.

- 1) The RA includes a license to the patent application in that foreign country and option world wide license.**
- 2) Company wants UTRF to file a patent application.**

- It is hard for UTRF to file directly in certain foreign countries like China or India when the patent application has inventors who are nationals in that country.
- Discussing with foreign national counter part on patent cost reimbursement can be entertaining.

IP PROCESS AND COMPLIANCE



IP is more than patent application.

- Inventorship is determined by patent law, but ownership of the patent is determined by contract law.
- Understanding who owns copyright/material and derivative works becomes more complicated if non-UT employees were involved.



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