

Intellectual Property at  
The University of  
Oklahoma

**RESEARCH COMPLIANCE AND  
INTELLECTUAL PROPERTY**

November 30, 2021

# INTELLECTUAL PROPERTY

- What is Intellectual Property?
  - Patents
    - Novel, Non-Obvious, Useful
    - Process, Compositions, Design, Plant, etc.
    - Most common type of IP
    - Please see “Publish and Patent without Perishing”
  - Copyrights
    - Protect Original Works of Authorship
    - Attributed at Creation, but should be registered
    - Can be used to protect software or data
    - Ownership can depend on circumstances of creation

# INTELLECTUAL PROPERTY

- What is Intellectual Property?
  - Trademarks
    - Protects things such as Name, Logo, Slogan, etc.
    - Meant to convey confidence of the source of good
    - Registration enhances enforcement & geographical rights
    - Often commercialized in conjunction with other rights
  - Know-How
    - Separate from Trade Secret
    - Broader than Patent eligible subject matter
    - Can be transferred with or separately from other IP

# OTC – ORS IP COMPLIANCE

- Proposal Infosheet
  - Intellectual Property Information
  - Review of Questions and Discussions with PIs
- Grant/Contract Negotiations
  - OTC Review of Potential IP Issues
  - IP which may Result
- Awards as Received
  - Regulations and Contract Requirements for IP
  - Notifications and Obligations
  - Grant Close-Outs



# IP TERMS IN SPONSORED RESEARCH

- Historical Standard Terms:
  - Background IP
    - Ownership remains with cross license for use
  - Project IP
    - The Party that creates the IP owns IP
    - Created jointly, owned jointly
    - Rights to Project IP
      - University grants Non-Commercial NERF
      - Option to Commercially License

# FEDERAL REPORTING COMPLIANCE

Federal Reporting of Inventions

37 CFR PART 401 – Bayh-Dole Act

Rights to Inventions Made by Nonprofit Organizations  
and Small Business Firms Under Government Grants,  
Contracts, and Cooperative Agreements

NOTE: OTC will have a Lunch and Learn in February, 2022, to present a  
broader discussion on this topic.

# OU IP POLICY

- As a term of employment you agree to the University's Intellectual Property Policy
- Applicable to Faculty, Staff and students
- Allows for Revenue sharing of proceeds from resulting commercialization
- Available on the [OTC website](#) or Faculty and Staff Handbooks of all campuses

# OU IP POLICY

## *(A) Ownership*

All discoveries and inventions, whether patentable or un-patentable, and including any and all patents (domestic and foreign) based thereon and applications for such patents, which are made or conceived by any member of the faculty, staff, or student body of The University of Oklahoma, either in the course and/or scope of employment for The University of Oklahoma or substantially through the use of facilities or funds provided by or through the University shall be owned by and be the property of the Board of Regents of the University of Oklahoma and the member will assign and does hereby assign all of member's rights in and to the discoveries and inventions to the Board of Regents of the University of Oklahoma except as described

- For IP created using substantial University resources and/or within the course and scope of an employees work the IP is considered a state asset and property of the Board of Regents of the University of Oklahoma



# OU IP POLICY

- Basis for Possible Exceptions
  - Created prior to employment at University
    - Must be disclosed to OTC via a Day One Disclosure
  - Created outside of scope of employment and without using University resources
  - All inventions must still be disclosed and only OTC can determine if IP falls outside of the scope of this Policy
- General Principles:
  - University Inventors have an affirmative responsibility to disclose and assign IP to OU
  - OU does not want to own IP it does not have a claim to
  - Ownership does not mean IP can't be used or distributed

# IP OWNERSHIP - COPYRIGHT

## University Intellectual Property Policy-Copyrights

It is the policy of the Board of Regents of the University of Oklahoma that all rights in copyright shall remain with the creator of the work unless the work is created with substantial use of University resources, is specifically assigned or commissioned by the University, is subject to non-University contractual or legal obligations, or is a “work made for hire” as that term is defined by U.S. Copyright Law.

- Scholarly/Aesthetic Works-Owned by the creator
  - ownership of copyrights to works of artistry or scholarship
  - Copyrighted courseware and/or software that are not associated with traditional works as described in the Policy under (C)(1) shall fall under and are subject to the Patent Policy.
- Personal Works- Owned by the creator
- Sponsored Works- determined by the agreement
- Commissioned Works -University
- University Works-University
  - Except as otherwise provided in this Policy, the University shall own all copyrights to works made by University employees in the course and scope of their employment and shall own all copyrights to works made with the substantial use of University resources



**Disclose an Invention**

A disclosure is the first step in the process of determining appropriate protections and commercialization opportunities for your technology. This document provides a confidential overview of the invention to the Office of Technology Commercialization, and serves as the foundation for future discussions about the best path forward.

[BEGIN YOUR DISCLOSURE](#)

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**Transforming Ideas Into T**

The Office of Technology Commercialization believes positive difference in the world. We help OU research betterment of society.

We provide the highest level of fiduciary expertise for OU intellectual property, and serve as a driving force for and efficiency.

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## Disclose an Invention

A disclosure is the first step in the process of determining appropriate protections and commercialization opportunities for your technology. This document provides a confidential overview of the invention to the Office of Technology Commercialization, and serves as the foundation for future discussions about the best path forward.

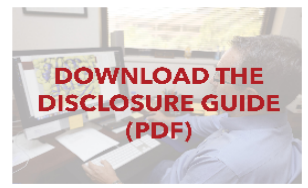
**To begin the disclosure process:**

1. Download the [Disclosure Guide](#)
2. Access the online disclosure system [here](#)
3. Choose the link to "Login using SAML Authentication"
4. Enter your OU username and password



An invention disclosure should be completed when an invention is recognized by the inventor(s). You must first choose the link to log in using SAML Authentication, and then enter your OU username and password.

[BEGIN YOUR DISCLOSURE](#)



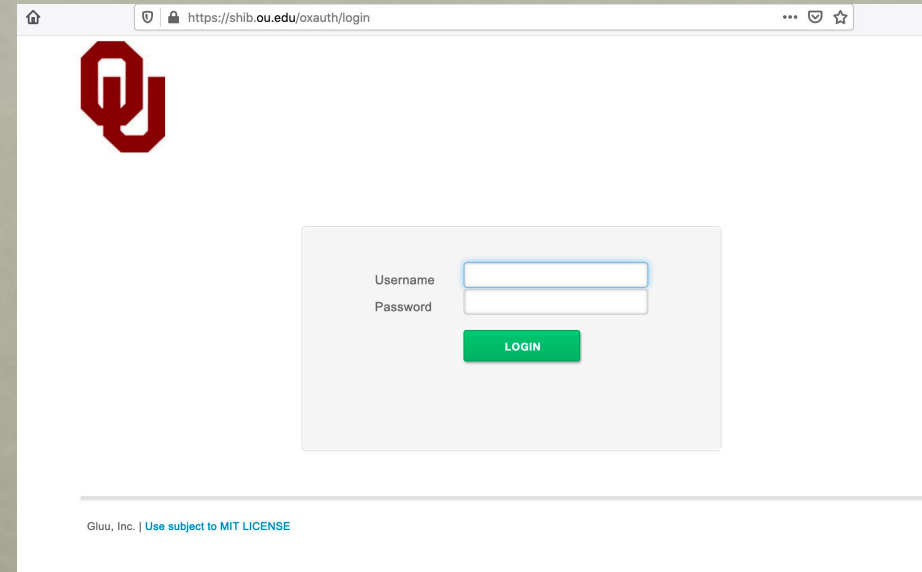
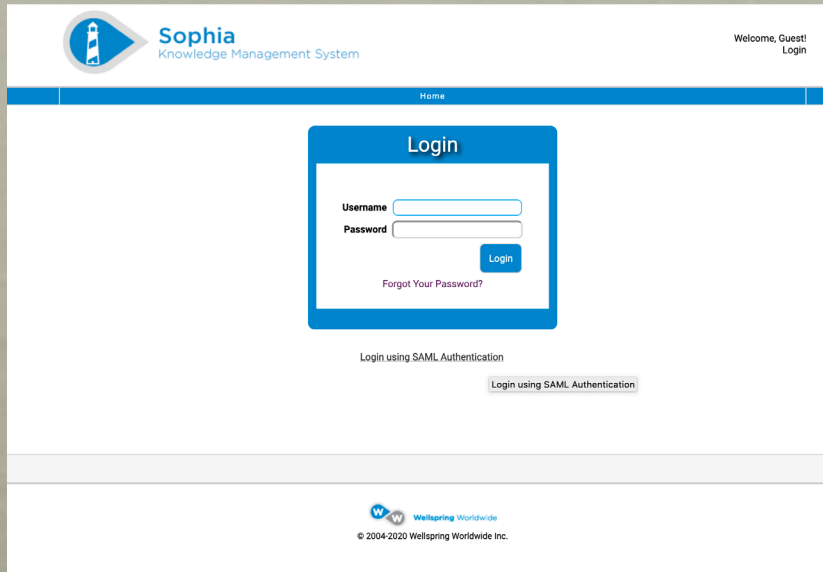
Our Disclosure Guide is designed to walk you through each step of the online disclosure submission process. We encourage you to reference it often for helpful tips and references.

[DOWNLOAD THE GUIDE](#)



# HOW TO DISCLOSE

- Disclose technologies through OTC's online database portal.



- Important information to include:
  - All inventors and possible contributors in creation of technology
  - Sources of funding used in the creation
  - A description of the discovery
  - Current state of the art and/or others working in the field
  - Future plans for development and commercial intentions
  - Details of any publications, presentations or external conversations (public disclosures)

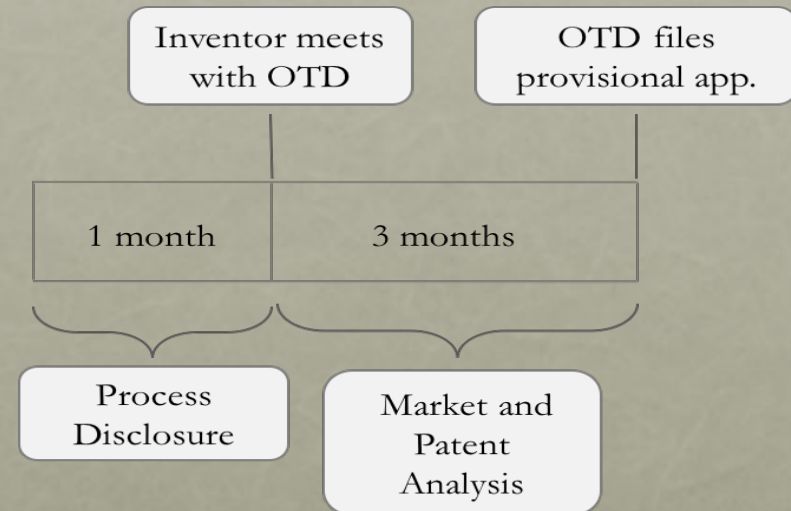


# PROTECTING OUR IP

- Important to Protect the University's rights in disclosed and potential IP
  - Can be to protect future commercial interest
  - But also important for continued access, publication implications, etc.
- OTC has multiple mechanisms to assist in protecting
  - NDA-holds conversations and information confidential
  - MTA-maintains ownership and rights of materials in/out
  - Licenses/Options/Intellectual Property Agreements – convey rights in IP
  - Inter-Institutional Agreements (IIAs) – convey rights between collaborators at multiple institutions
  - Open Source Licenses-University Approved Language for use and liability
- These agreements are managed by OTC and should not be entered into directly by Employee

# HOW DOES OTC COMMERCIALIZE

- Step #1: Disclosure – ALL IP must be disclosed to OTC
- Step #2: Processing and Initial Evaluation
- Step #3: Inventor Meeting



- Step #4: Evaluation – Marketing and Customer Discovery
- Step #5: Recommendation for Protection
  - Patents, Copyrights, Trademarks
- Step #6: Marketing

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