

"I'm working on a sponsored project." What do I need to know about IP and Confidentiality?

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What you need to do as an SU employee on this project

- Understand key terms of the agreement because they effect you
 - Understand basic information about what might constitute IP and what you can do to compromise or preserve the IP
 - Know the steps to take and people who can help you to do the above
- While this is a collaborative project, there are limits to the collaboration
 - Be careful with IP and confidentiality

I. Let's start with....

University-Industry Collaboration Good Practices

The Industry Partner (XYZ Co.) will be doing these, so should you....

- Maintain a Lab notebook
- Keep good records of meetings

Maintain a Lab Notebook Keep "Other" Good Records

- Maintain a Lab notebook
 - Why?
 - Can be used as evidence of inventorship
 - And from inventorship flows ownership
 - First to invent rule outside of U.S
- Keep Good Records of Meetings
 - Who is present at meetings
 - Can be used as evidence of inventorship
 - And from inventorship flows ownership
 - Consider having at least 2 SU people at the table when collaborating with XYZ Co.
 - So that it will never be one SU employee's word against one or more XYZ Co. employee's word
- When in doubt, ask

More Collaboration do-s (for team leaders)

- Keep good records regarding who is on "Team SU" for the project
- Let TTID know when there are SU people that have been
 - Added to the project
 - We'll do an orientation with them
 - Are leaving SU and are therefore off the project
 - We'll do an exit interview with them
 - And find out where they can be reached if necessary
 - Are off the project
 - We'll do an exit interview with them

II. IP = Intellectual Property

- IP is *created* by individuals
- For this project, IP will be *owned* by the individuals' employers
- IP is property that is intangible (in contrast to property which is tangible)

IP

- Intangible
 - Idea, concept, discovery
- Manifested as Tangible
 - Inventions/Patents
 - process, equipment, research tools, biological materials, licenses, and sometimes software
 - Novel, useful, non-obvious
 - Trade Secret
 - No registration, but the holder of the Trade Secret must keep it secret

Types of IP Protection

- Patents
- Trade Secret
- Copyright
 - Must be original
 - Written or otherwise "fixed" in a medium
 - Software code can be copywritten
- And also trademarks & some others...

NOTE: Some SU IP is protected via multiple methodologies, with 1 or more patent applications, 1 or more registered copyrights, and even a trademark. When it's possible to use a lock and a security system, we may very well do both!

Common IP clauses in collaboration agreements of this nature often read...

- What already existed and is SU's continues to be SU's
- What already existed and is XYZ Co. continues to be XYZ Co.
- To the extent that SU and XYZ Co. collaborate and together come up with new IP
 - It will be shared IP
 - The agreement sets forth restrictions as to how the sharing will take place
 - There is often a requirement to report inventions
 - Employee to "designated employer's department", i.e. TTID
 - One party to the agreement to the other, probably SU OSP to XYZ Co. or it could be SU Corporate Relations to the XYZ Co.
 - Within a certain time period

Yeah, but....

It is the actual collaborators and their actions that will help or hinder.

You want to help!

This is where you come in!

III. Applying IP rules to you...

... because IP ain't worth a dime (literally) if it's not protected!

- Unlike copyright, patents don't just happen, must be applied for
 - Things to do
 - Things to not do
 - Or things to wait to do until you get the green light from Technology Transfer and Industrial Development

Protecting the IP - Affirmatively

So, if there is something patentable, you must affirmatively act to pursue a patent

- You personally won't be pursuing a patent, but you set it in motion
 - How?
 - Completing an invention disclosure & submitting it to TTID
 - If you're not sure if it's patentable, let TTID decide
 - How quickly?
 - Quickly! First to file in U.S.
 - TTID will give a more definite time frame, i.e. x days, y weeks, based on the actual terms of the agreement

Protecting the IP – by Delaying Dissemination

Why?

First, because of Patent Law. Delaying dissemination impacts foreign patenting rights and could impact U.S. patenting rights.

Second, because of the contract that is in effect, i.e. the terms of the SU-XYZ Co. Agreement. The Agreement may allow for certain types of dissemination/publication. Pre-approval may be required.

Protecting the IP – by Delaying Dissemination

- Via Print
- Via Spoken Word
- Via offering for Sale

Protecting the IP – by Delaying Dissemination

- Refrain from publishing until patent protection has been applied for
 - Publishing = but is not limited to
 - academic publications
 - Posters, abstracts, presentations, e-mail, etc.
 - unwritten forms of communication
 - There is no “brainstorming” exception to the publishing rule!

Protecting the IP – by Delaying Dissemination

- U.S. Exception to the Publishing Rule
 - if you published (in the loose sense of the word as defined earlier)
 - AND it's been less than a year,
 - U.S. rights can still be pursued
 - most foreign cannot

More IP do-s

- Think ahead!
- about omissions
 - about strategic delays in dissemination
 - about affirmative actions

More IP don'ts

- *Don't* give enabling information without IP protection
 - Usually an “emergency” provisional filing can be filed with a super-quick turnaround.
- When in doubt re: enabling, err on the conservative side & let the experts in on it

Comforting Thoughts....

We have a lot of expertise!

Yours =
Engineering/biology/chemistry/physics/
programming/etc., research, teaching, etc.

Ours =
IP & agreements,
taking the headache out of IP management

IV. Confidentiality Clause in the SU-XYZ Co. Agreement

- Types
 - As to the actual existence of the agreement
 - SU confidential info
 - XYZ Co. confidential info
 - In communications
 - Labeling work product as Confidential

Confidentiality as to the existence of the project

- Why?
 - Competitive advantage!
- XYZ Co. is protecting their investment of time, money, etc. in research that may change the direction or focus of how they do business
 - It's a potential shift in business plan
 - Might be known to only a limited # of XYZ Co. employees
 - If their competitors were to find out, competitors of XYZ co. could contemplate shifting course so as to decrease XYZ's planned competitive advantage

Confidentiality Clause regarding communications

- Know the limits. The limits are often *more* restrictive than you may imagine....
- Within the SU-XYZ Research Project Team, information should be shared on a need-to-know only basis
- Confidentiality is *not* on an SU-wide basis
 - Therefore, not OK to talk to SU press
 - It's not OK to talk to a colleague not on the project (even if in the same department)
 - Sanitize your resume/CV. Entries relative to your work on the SU-XYZ Research Project must be "sanitized"
 - It's usually not OK to identify your work on the agreement in a grant proposal
 - Technically, it not OK to tell your significant other, even if you first say "this is confidential"
- When in doubt, ask a team leader

Confidentiality Clause regarding communications

- In your non-sponsored work, you may be accustomed to brainstorming or troubleshooting with
 - internal colleagues
 - external academic colleagues
 - external industry colleagues
- For purposes of this project, all bets are off! This modality is now restricted.

Ways to protect confidential information

- Appropriate markings on each and every document
- Care when addressing e-mail messages
 - Auto complete in e-mails is not always your friend
- Confidentiality notices on e-mails & faxes

In Closing...

- Use care
- Document! (v.)
- Document! (v.)
- Document! (v.)
- Don't forget the "comforting thoughts" that we'll be the IP experts and you can keep on doing your job....
- Your PI/team leader is experienced in working with industry, rely on the PI

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