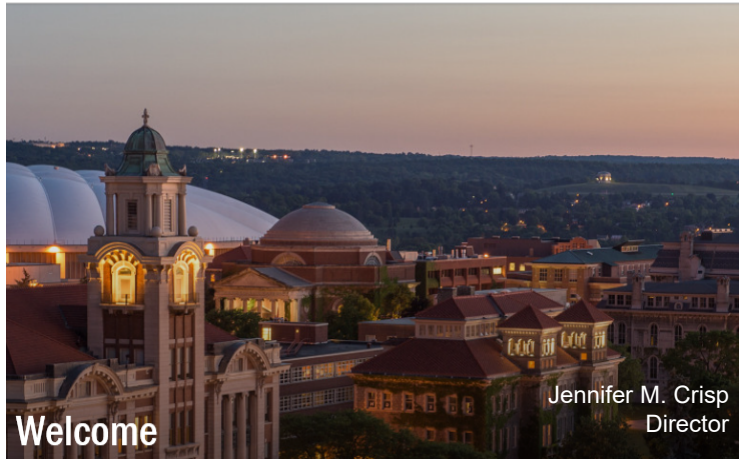


SYRACUSE UNIVERSITY | OFFICE OF TECHNOLOGY TRANSFER



<http://techtransfer.syr.edu>

What do I* need to know about
confidentiality in general
(*and with a slight focus on intellectual
property at Syracuse University*) ?

*Syracuse University faculty, staff or student either working on a corporate sponsored project or communicating with industry under a Non-Disclosure Agreement

What you need to do as an Syracuse University employee on this project?

- Understand key terms of the agreement because they effect you
 - Read and internalize the Non-Disclosure Agreement (“NDA”) (or, if a Sponsored Research Agreement (“SRA”), all terms of the agreement, beyond the content in the Statement of Work)
 - Understand basic information about what might constitute intellectual property (“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

Collaboration

- While this is (or might become) a collaborative project...
 - Each side has different corporate values
 - In some ways, it is like a game of poker
 - Be careful with IP and confidentiality
- Consider reading the University Industry Demonstration Partnership (“UIDP”) resources on this at <https://www.uidp.org/>

I. Importance of Confidentiality to Industry

- 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 Co's planned competitive advantage

Did You Know?

- A confidentiality clause or agreement may actually “cover” the actual existence of the agreement.
- Agreements vary as to the labeling requirements when something is confidential, so it's critical to know the terms.

Confidentiality Clause as it Relates to Communications

- Know the limits. The limits are often *more* restrictive than you may imagine....
- In the context of an SRA, within the SU-XYZ Co. Research Project Team, information should be shared on a need-to-know only basis
- When in doubt, ask the PI (if applicable) or the SU signatory on the NDA

Confidentiality Clause Regarding Communications

- Confidentiality is **not** on an Syracuse University-wide basis
 - Therefore, not OK to talk to SU press
- Think twice – it is not OK to talk to colleagues (even in your department) who are **not** on the project
 1. Now replace the word “colleagues” above with other terms, like “spouse,” “housemate,” “parent” etc. The same rule applies.
 2. It bears repeating. Repeat #1.
- When you are working under a confidentiality agreement, you may need to sanitize your resume/CV on entries relating to your work on the SU-XYZ Research Project
- When in doubt, err on the side of caution.

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 corporate sponsored projects, all bets are off! This modality is now restricted.

Ways to Protect Confidential Information

- Appropriate markings on every document
- Care when addressing e-mail messages
 - Auto complete in e-mails is not always your friend
- Confidentiality notices on e-mails & faxes
- Shred sensitive (draft or duplicate) documents

II. Best Practices in University-Industry Collaborations

The employees of the industry partner (“XYZ Co.”) will be doing these, so should you....

- Maintain a lab notebook
- Keep good records of meetings
- Promote and protect their employer

Do These Things...

- **At Meetings**
 - Trust your gut
 - Even with an NDA in place, consider the true importance and necessity of sharing information, along with the possible risks and benefits of doing so
- **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 Syracuse University people at the table when collaborating with XYZ Co.
 - So that it will never be one SU employee's word against the word of one or more XYZ Co. employee(s)
- **Maintain a Lab notebook**
 - Why?
 - Can be used as evidence of inventorship
 - And from inventorship flows ownership

Belts, Suspenders, and Belts + Suspenders

**Belt
or
Suspenders**

**= *either a pending patent
application or a non-disclosure
agreement***

Preference for belt + suspenders

Days/Weeks Before the Meeting...

- Know the Intellectual Property Status of all:
 - Invention disclosures
 - Pending patent applications
 - Types
 - Provisional
 - PCT
 - Utility
 - And whether it has published yet, and if not, approximate timeline for publication
 - Of any encumbrances or other obligations to keep in mind should XYZ Co. wish to
 - Sponsor Research
 - License IP
 - Pursue SBIR or STTR types of funding
 - Ask the Office of Technology Transfer for an up-to-date list
- Consider showing to Office of Technology Transfer:
 - emails between the parties
 - a draft slide deck

What Might XYZ Co. Inquire About?

1. May I see the filed patent applications?
2. What options are available to me to secure additional information on the tech readiness? On R&D in general?
 - a. Corporate Sponsored Research Project
 - b. SBIR or STTR with a subaward to Syracuse University
3. Can I make a prototype? Can I see the one you are making?
4. Can we share materials?
5. Can I speak to others about this?
6. What if I want to license this?
 - a. SU Office of Technology Transfer
7. Can we publish together?

Contact OTT to schedule a conversation to answer these questions.

Recommendations for Communicating with Industry

- Use care with your language, written and spoken
 - Patent ≠ patent application
 - Patent application ≠ patent
- You are interacting on the science, and the pitch, not the business terms of a possible relationship

Recommendations for Communicating with Industry

- Status types:
 - Patent pending (confidential, not yet published)
 - Patent pending (a.k.a. published patent application)
 - Issued patent
 - Expired patent
 - Abandoned patent application
 - Check the status of a patent application at USPTO PAIR
<https://www.uspto.gov/learning-and-resources/portal-applications>

How Do I Cite an Issued Patent? A Patent Application? A Published Patent Application?

- Status Types and unique identifier masks for each
 - Patent Pending (confidential, not yet published)
 - 61/089,963 example of a U.S. provisional patent application filing number
 - 12/542,993 example of a U.S. utility patent application filing number
 - Utility applications generally publish 18 mos. from the earliest filing date
 - Patent Pending (i.e. US 2010/0065069 **A1**)
 - Example of a U.S. published patent application
 - Patent Pending, Patent Cooperation Treaty (PCT)
 - Application No. PCT/US2015/046859
 - Publication No. WO2016033142 **A1**
 - Issued patent: U.S. Patent No. 8,161,974 **B2**

*text in red is not always part of the mask

Recommendations for Slide Decks Prepared for an Industry Audience

- Consider showing a draft to Office of Technology Transfer
- Use appropriate markings
 - Syracuse University confidential
 - © Syracuse University, All Rights Reserved
 - Contact info for key corporate liaisons:
 - Director, Office of Technology Transfer
 - Director, Office of Sponsored Programs
 - Your contact info
 - Save the EXACT COPY of the slides you will show and did show as a PPT and PDF
 - You need not share a paper or electronic copy of the slide deck
 - Trust your gut
 - Consider offering only a condensed version of the slide deck as a leave-behind

Ask OTT for sample slides.

The Parties to the SRA or NDA are SU and XYZ Co.....

But keep in mind that it is you and your actions that impact whether Syracuse University is complying with the university's obligations under the agreement.

III. Your Role in Preserving Intellectual Property Protection 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 the Office of Technology Transfer

Protecting the IP - Affirmatively 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 OTT
 - If you're not sure if it's patentable, report it anyway, and the OTT team will evaluate it
 - How quickly?
 - Quickly!
 - OTT may file an "emergency" quick provisional patent application if afforded the opportunity and the shortest of lead times (but don't come to rely on this...)

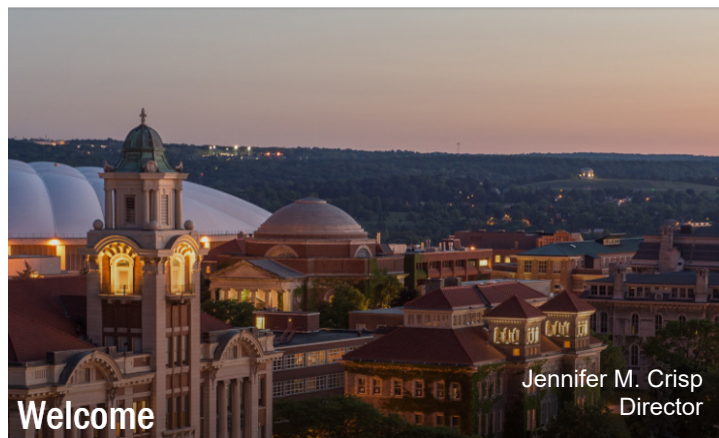
Don't...

- *Don't* provide enabling information without IP protection
 - What is “enabling” in patent law?
- When in doubt regarding whether an explanation is enabling, err on the conservative side, or, ask for the help of the OTT

In Closing...

- Use care
- Document! (v.)
- Document! (v.)
- Document! (v.)
- Your PI/team leader is experienced in working with industry, rely on the PI

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