

SYRACUSE UNIVERSITY

OFFICE OF TECHNOLOGY TRANSFER

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Intellectual Property at Syracuse University: An Introduction for Industry

The Syracuse University Office of Technology Transfer (OTT) identifies, evaluates, and facilitates the transfer of Syracuse University's Intellectual Property (IP) from Syracuse University to the private sector.

The OTT serves multiple constituencies, and represents Syracuse University in matters relating to IP owned by Syracuse University.

The Syracuse University Office of Technology Transfer (OTT) manages the science and research based intellectual property portfolio (primarily patents) of Syracuse University.

Most of the inventions we manage are discovered by faculty (often with their graduate students or post-docs) in Engineering, Chemistry, Biology, Physics, Math, Forensics and Earth Sciences.

Tracking and Protecting IP discovered at Syracuse University

The first phase of IP management involves the OTT conducting intake of newly discovered inventions (which are reported to our office by the faculty inventors themselves), analyzing them, and coordinating with outside patent counsel to pursue patent protection on behalf of Syracuse University.

Wish to learn about Syracuse University technologies that are protected via issued patents or patent applications? Some Syracuse University technologies are featured on the online IP portal i-bridge.

Patent-pending technologies are not made public by the U.S. Patent and Trademark Office until 18 months into the patenting process. Therefore, to learn about some of the newest patent-pending technologies, contact the Office of Technology Transfer and describe the type of technology of interest. In order to share meaningful information about the technology, Syracuse University may require a signed Non-Disclosure Agreement (NDA).

Intellectual Property Licenses for Non-commercial Uses

Businesses can gain rights (limited by time and scope) to existing Syracuse University IP in a variety of ways, including negotiation and execution of one of the following agreements:

- **research license** – Syracuse University may enter into a research license with a business that would allow the business to use the IP for internal, non-commercial purposes. These tend to be very short term (i.e. a year or less). This type of agreement is negotiated by Syracuse University's Office of Technology Transfer.
- **option license** – An option license essentially combines a research license (see above) with an option. Under an option, the option holder/business has a designated period of time (often a year) to evaluate the IP/technology, and decide whether to pursue a commercial license for the IP. Syracuse University agrees to keep the IP available only to the option holder for the designated time period. Ultimately, the business may either let the option expire, or, prior to the expiration of the option period, initiate commercial license negotiations. Under an option license, the (a) licensee has the right to use the IP for internal non-commercial means, wherein the rights granted allow the business to evaluate the IP/technology. The option license also functions to (b) prevent competitors/others from licensing the IP, since Syracuse University is also agreeing to "hold" the right to enter into a commercial license to the option holder for a certain period of time. Option licenses are negotiated by Syracuse University's Office of Technology Transfer.

Commercializing Intellectual Property discovered at Syracuse University

Another phase of IP management at Syracuse University is to commercialize the technologies owned by Syracuse University. Unlike IP created and owned by businesses, universities are typically not in the position of commercializing intellectual property themselves. In order for university created IP to benefit the world at large, universities look to existing or start-up businesses to license Syracuse University IP. Those licensees will then incorporate the technology into their products or systems.

Businesses can gain the ability to use existing Syracuse University IP for commercial purposes via a:

- **commercial license** – This license allows the licensee to use the IP for commercial purposes as per the negotiated terms. Commercial licenses can be exclusive or non-exclusive; restricted to a field of use or not; restricted to a geographic region or not; etc. A commercial license requires a licensee to use the IP in a particular fashion, and diligence milestones are embedded in the license terms to ensure same. Up-front fees to Syracuse University are required, as are sales based ("running") royalties. Milestone based royalty fees and annual fees may also

be appropriate. This type of agreement is negotiated by SU's Office of Technology Transfer.

Corporate Sponsored Research Agreement (CSRA):

Research conducted at Syracuse University for the benefit of the Corporate Sponsor With Access to Existing and Newly Created IP

When businesses want to have specific research performed by an outside party, and that outside party is SU, they may do so via a Corporate Sponsored Research Agreement (CSRA) with Syracuse University. A CSRA allows a business access to a faculty researcher and his/her team who will conduct research as agreed upon between Syracuse University (representing the University's and the faculty member's interests) and the business. Findings are reported to the Corporate Sponsor.

Under a CSRA, a course of research is outlined (the outline is developed between the business entity's technical personnel and the Syracuse University faculty researcher who will conduct the research) in a Statement or Scope of Work (SOW). The SOW is accompanied by a short contract that sets non-SOW terms like duration of the project, timelines for reporting to the sponsor, confidentiality, insurance, indemnification, publication, and payments/budget. Sometimes OTT gets involved during negotiations of the CSRA as relates to the IP terms of the contract, but usually this type of contract is handled by SU's Office of Sponsored Programs (on the contract and budget terms) and the faculty member (in relation to the SOW), possibly in conjunction with a member of SU's Corporate Relations team.

IP Terms within the CSRA

In some instances, there is pre-existing Syracuse University IP (often referred to as "background IP") that must be employed in order to conduct the research set forth in the SOW. When that is true, the Corporate Sponsor will – via the terms of the CSRA – explicitly be granted a research license to the designated background IP for the duration of sponsored project. Above and beyond the grant of a research license, Syracuse University offers assurances – again, via the terms of the CSRA – to the Corporate Sponsor that Syracuse University will protect the background IP from being offered via a license or sale to other potential licensees, at least for the duration of the sponsored project. Together, these assurances act to preserve access to the background IP to the Corporate Sponsor should the Corporate Sponsor wish to separately (with the Office of Technology Transfer) negotiate a commercial or other license to the background IP that extends beyond the scope or duration of what is embedded in the CSRA.

Regardless of whether there is background IP in a CSRA, it is possible that during the performance of a CSRA, new IP might be created. New IP created in that context is often referred to as "foreground IP." Foreground IP may be (a) Syracuse University owned IP; (b)

Jointly owned IP by Syracuse University and the Corporate Sponsor; or (c) Corporate Sponsor owned IP. Foreground IP that is created exclusively by Syracuse University inventors (inventorship is governed by the Manual of Patent Examining Procedure and case law) will be owned by Syracuse University, but certain rights (a non-commercial research use and a limited option to negotiate a commercial license) in the Syracuse University owned foreground IP will vest – via the terms of the CSRA – with the Corporate Sponsor. Notices about Foreground IP will be sent to the Corporate Sponsor by the Office of Technology Transfer.

If you wish to learn more about Corporate Sponsored Research at Syracuse University, please contact the Director of Syracuse University Office of Sponsored Programs at www.osp.syr.edu.

Additional Reading on Corporate Sponsored Research

Syracuse University is a member of the University-Industry Demonstration Partnership (UIDP). UIDP “is an organization of universities and companies who seek to build a stronger relationship between these parties. UIDP provides a unique forum for university and industry representatives to meet and discuss operational and strategic issues such as contracting, intellectual property, and compliance matters. These conversations might otherwise never take place, and they serve to help university representatives better understand the culture and constraints of their industry counterparts, and vice versa.” Quoting UIDP website.

Two UIDP publications are on point for corporate sponsored research. (a) The publication entitled Contract Accords for University-Industry Sponsored Research Agreements “were developed by a strategically assembled and dedicated team of research administration professionals from academia and industry... These Contract Accords reflect the consensus and best practices of university and industry UIDP representatives and continue to evolve.” Quoting UIDP website. (b) The publication entitled the Researcher Guidebook “addresses the opportunities and challenges unique to institution and industry collaborations, specifically targeting active researchers (at all career stages) and is the product of the collective expertise of the UIDP's member representatives. The guidebook is divided into two parts: Part 1 is dedicated to the Institutional Researcher; Part 2 is dedicated to the Industrial Researcher. These two companion portions of the guidebook together create a strategic tool to promote greater understanding of the issues that face both parties in order to facilitate more effective collaborations for mutual benefit. Reading this guidebook should lead the researcher to ask the right questions, both of the organization and of the potential collaborator, to determine whether to proceed with a particular collaboration.” Ibid. A company's contracts team, IP team, and others who are involved in contract negotiations of CSRAs would also benefit from reading the Contract Accords and Researcher Guidebook available at www.uidp.org/resource-center/.