

[Jointly Owned Intellectual Property \(IP\) at Syracuse University](#)

Guidance for SU innovators who have co-invented with a collaborator from outside Syracuse University (SU)

1. Contact the Syracuse University [Office of Technology Transfer](#) (OTT)
2. Do not sign another institution's "report of invention," "invention disclosure form," or "invention reporting form" until
  - a. OTT initiates contact with the other entity's Technology Transfer equivalent and
  - b. explicitly authorizes the SU inventor(s) to sign the form
  - c. **note:** on occasion signing is **not** appropriate, most commonly when the signature block or other mechanism states that, by signing the document, the inventor assigns their ownership to an entity other than SU
3. Inventors will be kept apprised of OTT's communications with the other institution.

Typically, OTT will:

- a. within days, initiate contact with the collaborating institution's OTT equivalent
- b. communicate that OTT is the point of contact for the legal aspects of joint intellectual property (IP) ownership
- c. assess whether a non-disclosure agreement<sup>1</sup> ("NDA") is appropriate, and if so, propose & circulate an NDA
- d. communicate SU's practice of using Inter-Institutional Agreements ("IIAs") to govern/manage expectations, rights and responsibilities as between the co-owners. See also page 12 of [this document](#).
- e. advise the other institution that allocation of IP ownership rights as between SU and the co-owner(s) is the domain of SU OTT, not SU inventors. Therefore, the allocation documentation appearing on invention forms is not binding. Allocation of ownership rights is defined in an IIA.
- f. OTT aims to seek agreement among the owner institutions regarding next steps, the role each owner will play in the IP protection and licensing strategy. This is done by negotiating and executing an IIA.

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<sup>1</sup> bear in mind this may be critical to preserving patenting rights

#### 4. Next Steps for SU Inventors

- a. consider alerting your non-SU faculty colleague(s) of SU's practices in this area by sharing this document with them
- b. complete a Syracuse University invention disclosure record via the OTT [online inventor's portal](#)
  - i. it is important to complete all the fields in SU's online invention disclosure. You may attach your external colleague's completed invention documentation as a cross-reference.
- c. schedule a meeting with OTT to exchange information internally on the technology and your dealings thus far with the collaborators
- d. Publishing. The release of information about a patentable invention, outside of the team who conceived and/or reduced it to practice, extinguishes the availability of patent protection (or, in the U.S., creates a one year patent filing deadline). The best practice (and often a requirement of federal funding) is to file for patent protection before publishing. For this reason, OTT works with SU researchers to understand their publishing timelines and to work within those constraints whenever possible. Our goal is for the initial patent application to be filed no later than the day before the first anticipated publication date of enabling information.

#### Turnaround time from invention disclosure receipt to filing of patent applications when IP is Jointly Owned

There are benefits to putting an IIA in place prior to incurring external legal fees, like those associated with drafting and filing patent applications, because the IIA will memorialize how the joint owners will share costs. Deferring the drafting and filing of patent applications until the joint owners as a collective are comfortable with the strategy, content, and timing is another consideration. Timely handling of new invention disclosures is also critically important. There are factors to consider like what to file, and when to file. In the context of jointly owned patentable inventions, there are circumstances in which SU will prepare and file a patent application and subsequently execute an IIA.

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