

HEALTH SCIENCE CENTER HANDBOOK OF OPERATING PROCEDURES

Chapter 12	Intellectual Property	Effective:	December 2000
Section 12.1	Technology Commercialization	Revised:	September 2015
Policy 12.1.1	Intellectual Property Policy	Responsible Party:	Vice President for Research

INTELLECTUAL PROPERTY POLICY

Overview

The University of Texas System (UT System) Board of Regents (Board) and the University of Texas Health Science Center at San Antonio (Health Science Center) encourage the development of intellectual property to enhance research, scholarship, teaching and discovery in the best interest of the public, the inventors and research sponsors. This policy is intended to promote the objectives of the Bayh-Dole Act (35 U.S.C. §§ 200 et. seq.) to encourage reporting and commercialization of technologies developed using federal (e.g., NIH, NSF, NASA, DOD) funds.

Intellectual property either developed within the course and scope of Health Science Center employment of the individual or resulting from activities performed on UT System time, or with support of State funds, or from using facilities or resources owned by the UT System or any of its universities (other than incidental use) is automatically owned by the Board. The course and scope of employment includes outside activities related to the employee’s area of expertise. Final decisions regarding ownership of intellectual property developed in connection with outside employment will be made by the President or his/her designee.

All matters relating to the ownership and reporting of intellectual property, the commercialization of intellectual property and the distribution of income from intellectual property are governed by the UT System Board of *Regents’ Rules and Regulations (Regents’ Rules) Series 9000, Intellectual Property.*

Policy

This intellectual property policy applies to:

- all persons employed by the Health Science Center, including but not limited to full and part-time faculty and staff and visiting faculty members and researchers and
- to anyone using the facilities or resources of the Health Science Center, including but not limited to students, residents, participants in certificate programs or collaboration programs, or postdoctoral and pre-doctoral fellows.

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All individuals subject to this policy assign their rights in intellectual property included under this policy (see Section 3 below) in accordance with the provisions of *Regents' Rule 90102, Intellectual Property Rights and Obligations*.

All university employees, non-employees who use Health Science Center facilities, visiting faculty members and researchers and those persons who are hired or funded contractually by the Health Science Center to perform certain activities or services, unless otherwise exempted by the *Regents' Rules*, shall disclose and do hereby assign all rights, interest and title to the Board for all intellectual property discovered or invented during the time employed, funded or using the facilities as specified in accordance with *Regents' Rule 90102, Intellectual Property Rights and Obligations*. Individuals subject to this Policy who create such intellectual property must promptly execute and deliver all documents and other instruments as are reasonably necessary in the Health Science Center discretion to reflect the Board's ownership of such intellectual property, including for purposes of satisfying requirements of the United States Patent and Trademark Office or other patent registrars. An inventor of intellectual property owned by the Board has no independent right or authority to convey, assign, encumber or license such intellectual property to any entity other than the Board.

The Board will not assert an ownership interest in the copyright of scholarly or educational materials, artworks, musical compositions, and literary works related to the author's professional field regardless of the medium of expression, unless the work is commissioned by the university or the Board as a work made for hire. The Board encourages such creators to manage their copyrights in accordance with the guidelines concerning management and marketing of copyrighted works (<http://www.utsystem.edu/ogc/IntellectualProperty/copyrighthome.htm>) consistent with applicable university policies. Inventors with questions regarding ownership of scholarly works should contact the Health Science Center's Office of Technology Commercialization ("OTC").

As reasonably required for the limited purpose of continuing a Health Science Center scheduled course offering, the Board and Health Science Center retain for one year following the loss of an instructor's services, a fully paid-up, royalty-free, nonexclusive worldwide license to use, copy, distribute, display, perform and create derivative works of materials prepared by the instructor for use in teaching such course

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(including lectures, lecture notes, syllabi, study guides, bibliographies, visual aids, images, diagrams, multimedia presentations, examinations, web-ready content and educational software).

Research data or results created by an employee are owned by the Board and, except to the extent that rights to such research data are contractually assigned or licensed to another party by the Board, the inventor shall have a nonexclusive license to use such data for his/her nonprofit educational, research and scholarly purposes within the scope of his/her employment, subject to adherence to other provisions of this policy and the *Regents' Rules*.

Definitions

INTELLECTUAL PROPERTY: includes all types of intellectual property, including but not limited to any invention, discovery, creation, know-how, trade secret, technology, scientific or technological development, research data, works of authorship and computer software regardless of whether subject to protection under patent, trademark, copyright or other laws.

KEY EMPLOYEE: includes but is not limited to an owner, manager, director, board member or advisory board.

Procedure

The Health Science Center Office of Technology Commercialization (OTC) coordinates and assists in securing available protection for Board and Health Science Center owned intellectual property. Such efforts are provided by either an OTC staff, through a related foundation or entity, or through other means.

Improperly or inadvertently disclosing the details of one's invention, such as may occur when a technical presentation is made in a public forum (seminar or conference), could result in losing all intellectual property protection in the United States and foreign countries.

Whenever an invention has reached the level that the inventor believes a distinct contribution could be made by its adoption, close communication with OTC is essential so that OTC may advocate for the inventor and take effective measures to ensure confidentiality, disclosure, and protection of the inventor (s) critical discovery.

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Beyond the obvious practical reasons for disclosure, the Bayh-Dole Act of 1980 outlines the rights and obligations of both the University and the Government whenever there is a federally supported research and development project. Thus, Federally-funded investigators are obligated to report any inventions to the University, and the University must then report the invention to the appropriate Federal office (i.e. NIH) within 60 days.

A. Reporting Intellectual Property

The [Invention Disclosure Form](#) (IDF) a legal document prepared by the inventor, explains what was discovered or created or what scholarly work was created, who sponsored the work and whether such work has been disclosed or is scheduled for publication or public presentation. For patentable inventions, the completed IDF should clearly indicate the new, useful and non-obvious properties of the intellectual property over existing published materials.

All inventors of the intellectual property should be listed in the IDF even if they are not university employees. The IDF is available and submitted electronically through the OTC portal. An IDF is “accepted” upon signature by all inventors and notice of acceptance to the inventor(s) from the OTC.

It should be noted that the IDF is NOT a patent and affords no intellectual property protection to the invention or The University of Texas System Board of Regents.

B. Evaluation of the Invention for Intellectual Property Rights

Upon two (2) weeks of an approved IDF, a business development manager (BDM) shall contact the primary investigator to understand the invention in order to assess the invention via two paths: intellectual property potential rights and business commercialization due diligence. This process requires up to ten (10) weeks from the time of the initial two (2) week meeting.

The Intellectual Property (IP) assessment is a collaborative process through the involvement of the investigator, a professional patenting law firm approved by the University of Texas System Board of Regents, and the OTC. The cost of patenting while not trivial, is borne by the Health Science Center/OTC with the understanding that such costs will be

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recovered through future licensing of the technology. All IP filed is assigned to The University of Texas System Board of Regents.

During the IP filing process (which can be expedited ahead of the ten (10) week process if necessary), more understanding and ‘discovery’ about the invention in terms of patent law will be determined. This process will, at times, require a ‘prior art’ search to understand if the invention has been mentioned in any literature etc. Frequent communications as well as manuscripts, presentations etc. from the investigator to the law firm in order to derive the strongest ‘claim set’ to lead to issuance of the patent will occur.

The OTC will be a partner with the investigator and the law firm to derive a “patent strategy” to determine the best approach towards when to file, where to file and what to file with regard to the United States and/or foreign countries. The patent strategy is a critical step that often makes the patent process (which is lengthy) more anticipatory and thus more in the control of the Investigator/law firm/OTC.

Other protection strategies, such a copyright (as is useful in software) or trademarking will be under the guidance of the OTC and will utilize the same process outlined above when necessary.

C. Evaluation of Commercialization Potential of the Invention

Commensurate with the IP assessment, the OTC will undertake a thorough market and competitive landscape analysis of the invention (business due diligence). This analysis led by the Business Development Manager, utilizes healthcare and pharmaceutical databases to reveal the global movement by potential commercialization partners in research and development. The findings of this research will be delivered to the investigator. This analysis will inform on an entrepreneurial or translational strategy in commercialization of the invention. Importantly, the assessment is critical to the determination of utilization of the Health Science Center fiscal resources on the filing of and prosecution of IP as well as the allocation of further resources towards commercialization. If it is deemed that the invention can, with proper development, be commercialized into a product for the public good, the OTC will assert its’ right in the name of the University of Texas System Board of Regents, to protect the invention. (Please see part B above)

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At twelve (12) week post disclosure a meeting will be held with the investigator and OTC staff to discuss the findings of the business commercialization potential along with a recommendation as to a patenting and commercialization strategy. There are numerous recommendations which may include the following:

- “holding” of the disclosure for more data from the inventors to strengthen the IP;
- pursue intellectual property protection (patenting or copyright) on behalf of the Health Science Center and the UT Board of Regents;
- pursue research partnerships or collaborative research agreements;
- pursue direct licensing to an interested for-profit entity;
- creation and licensing to a start-up entity;
- closing and termination of the technology;
- release and reassignment to the inventor(s).

Such information will be delivered to the investigator (and the team) in a Technology and Management Report. This Report is confidential and is not to be shared publicly.

**Office of
Technology
Commercialization**

The Health Science Center’s Office of Technology Commercialization (OTC) is the single point of entry for faculty and staff seeking advice on technology development and intellectual property resulting from their research, and for community and industry representatives seeking bioscience research partners at the Health Science Center.

The OTC is responsible for meeting patent regulations associated with research grants and contracts, oversees retaining whenever possible the HSC/UT Board of Regents rights to inventions developed on such programs, and provides information and general assistance to faculty and other Health Science employees and research participants concerning patent protection and commercialization.