



UNIVERSITY OF
TEXAS
ARLINGTON



University Perspectives

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A University of Choice



51,000 students
(on campus + on-
line)

184 degree
programs

4,800 employees

\$78M Research
Funding FY15

\$7.5M New DoD
Funding FY15



A Future Built on IDEAS²

- I:** **Innovation** in delivery of education – Nursing, LINK Lab.
Impactful research – 13 members in the National Academy of Inventors
\$28.6M in research awards in Aug-Oct '14.
- D:** **Diversity** – Ranked 5th most diverse public research university in the nation.
Highest-profile Hispanic Serving Institution in North Texas
Growing international population
- E:** **Excellence** – Highest degree production ratio of all UT campuses.
Asia Executive MBA is one of the largest and most reputed.
Renowned faculty. Nationally ranked programs.
- A:** **Access** – 7th fastest growing public research institution – CHE (2013)
Innovative programs to develop pipelines and pathways for student success
through GO Centers, “Bound for Success”, STEM Academy...
DED hosts the nation’s largest federal OSHA education center
- S:** **Student Success--- Impact.**
College of Nursing has NCLEX results higher than TX & national average
University College, FIGs, FYE Course (MAVS 1000)
Career Development/Support Center

Occasionally Problematic Terms

- IP Ownership
- IP Reporting
- Publication rights & Confidentiality

IP Ownership

37 CFR §401.14(a)(2)

Subject invention means any invention of the *contractor* conceived or first actually reduced to practice in the performance of work under this contract ...

37 CFR §401.14(b)

The Contractor may retain the entire right, title, and interest throughout the world to each subject invention subject to the provisions of this clause and 35 USC §203. With respect to any subject invention in which the Contractor retains title, the Federal government shall have a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the subject invention throughout the world.

IP Ownership

- Ownership generally follows inventorship, especially when funding is direct from Federal agency to University.
- Issues with flow-through contracts:
 - Companies frequently seek ownership, but if their funding source is federal, they cannot demand ownership. See 37 CFR 401.14(g)(1);
 - FAR paragraph 27.304-3 (c) – contractors shall not use their ability to subcontract as economic leverage to acquire rights for themselves in inventions resulting from subcontracts;
 - University must maintain right to use for research and educational purposes;
 - Background IP

IP Ownership

- Background IP =
 - IP that is owned or controlled by the University, the Sponsor or by a third party that exists prior to, or outside of, a sponsored research agreement.
- Some things to keep in mind:
 - Access to Background IP is not automatic.
 - The terms that apply to IP resulting from a funded research project do not apply to Background IP.
 - Technology transfer office helps sponsored research office identify relevant Background IP.
 - Right to use for research project vs. ability to license.
 - Communication of availability (or non-availability) of Background IP before entering into funding agreement is important to manage the expectations of the parties.

IP Reporting & Protection

Compliance with Contractual Obligations

- Federal grant contracts and Sponsored Research Agreements contain invention reporting requirements:
 - Federal agencies require that inventions resulting from the use of the Federal funds be reported to the agencies within prescribed time frames;
 - The Federal government has certain rights in these inventions;
 - If reporting obligations not met, the Federal government can take ownership of the resulting IP
 - Sponsored Research Agreements contain language requiring the University to report inventions to the Sponsor
 - The Sponsor often has the option of obtaining a license to the IP if it desires that a patent application to be filed
 - Sponsor will often pay patent costs if it desires that a patent application be filed

IP Reporting & Protection

37 CFR §401.14(c)

- (1) The Contractor will disclose each subject invention to the *Federal Agency* within two months after the inventor discloses it in writing to contractor personnel responsible for patent matters. ...
- (2) The Contractor will elect in writing whether or not to retain title to any such invention by notifying the Federal agency within two years of disclosure to the Federal agency. However, in any case where publication, on sale or public use has initiated the one year statutory period wherein valid patent protection can still be obtained in the US, the period for election of title may be shortened by the agency to a date that is no more than 60 days prior to the end of the statutory period.
- (3) The contractor will file its initial patent application on a subject invention to which it elects to retain title within one year after election of title or, if earlier, prior to the end of any statutory period ...

IP Reporting & Protection

Issues arise when:

- Invention was conceived and reduced to practice prior to receiving federal funding;
- Funding used to further enable invention already described and claimed in a patent application;
- PI lists patent application on final report;
- Agency then wants to know why the invention was not reported when disclosed and requires reporting on iEdison;
- The non-provisional patent application has been filed and/or patent has issued;
 - Disclosure can be reported ... BUT
 - When provisional is added, iEdison sends alert that government support clause is missing;
 - University cannot add government support clause to provisional application that is expired;
 - Cannot submit use reports if any part of record has an unresolved alert.

Publication

“7000 Clause” (DFAR 252.204-7000)

- Contractor shall not release to anyone outside the Contractor’s organization any unclassified information, regardless of medium, pertaining to any part of this contract or any program related to this contract, unless
 1. The contracting officer has given prior **written approval**; or
 2. The information is otherwise in the public domain prior to release.

Issues arise when:

- “Review and approve” vs. “Review and comment”
- Restrictions on right to publish can jeopardize a University’s “Fundamental Research Exclusion.”

Publication

Alternate language:

- The contractor shall be free to publish, permit to be published, or distribute for public consumption, any information, oral or written, concerning the results of conclusions made pursuant to performance of this contract; provided, however, that it shall provide copies of any such publication or release of information to the government's contracting officer for **review and comment** at least thirty (30) days prior to any such release

Publication

Acceptable Restrictions:

- Prepublication review by a sponsor of university research solely to insure that the publication would not inadvertently divulge proprietary information that the sponsor has furnished to the researchers (EAR 734.8(b)(2))
- Prepublication review by a sponsor of university research solely to ensure that publication would not compromise patent rights. (EAR 734.8(b)(3))

Publication

The recipient is encouraged to publish results of the research, unless classified, in appropriate media. One copy of each paper shall be submitted to the GOR simultaneously with its submission for publication. Copies of all publications resulting from the research shall be forwarded to the Grants Officer or Grants Specialist as they become available, even though publication may in fact occur subsequent to the termination date of the award.

Acknowledgement. The recipient agrees that in the release of information relating to this award such release shall include the statements below, as applicable. ...

- a. “The [Name of Agency, Address of Agency] is the awarding and administering acquisition office” and
- b. “This work was supported by the Office of ... under Award No. XXX. Opinions, interpretations, conclusions and recommendations are those of the author and are not necessarily endorsed by the Department of Defense.”

Questions

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Publication

22 CFR §120.11(a)(8)

(a) Public domain means information which is published and which is generally accessible or available to the public:

(8) Through fundamental research in science and engineering at accredited institutions of higher learning in the U.S. where the resulting information is ordinarily published and shared broadly in the scientific community. Fundamental research is defined to mean basic and applied research in science and engineering where the resulting information is ordinarily shared broadly within the scientific community, as distinguished from research the results of which are restricted for proprietary reasons or specific U.S. Government access and dissemination controls. University research will not be considered fundamental research if:

- i. The University or its researchers accept other restrictions on publication of scientific and technical information resulting from the project or activity; or
- ii. The research is funded by the U.S. Government and specific access and dissemination controls protecting information resulting from the research are applicable.