



<b>Roswell Park Cancer Institute</b> Policy and Procedure	<b>Date Issued:</b> 4/1/2004	<b>Number:</b> 701.1
<b>Title:</b> Patents and Inventions	<b>Revision:</b> <b>4</b>	<b>Effective Date:</b> 1/7/13
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## **A. GENERAL STATEMENT OF POLICY**

All intellectual property whether patent, trademark or copyright arising from inventions and technology developed by persons utilizing Roswell Park Cancer Institute (RPCI) facilities, or by employees during the course of their employment, are the property of RPCI. The inventor, when so instructed by RPCI, shall make application for patent(s). The resulting patent(s) shall be in Health Research, Inc.'s (HRI) name. RPCI has authorized HRI to serve as a technology transfer and copyright administrator for RPCI. Additionally, RPCI shall have negotiated rights to all inventions developed in the course of projects under contract to RPCI/HRI.

A patentable invention or technology that is unrelated to the individual's employment at RPCI/HRI, is developed wholly without the use of RPCI/HRI facilities or other resources, and wholly on an individual's own time, shall not be deemed to be made in the course of a program or project of RPCI/HRI, and RPCI/HRI asserts no claim to the technology or to any resulting patent(s).

## **B. SCOPE**

This policy and procedure applies to all employees of RPCI, Health Research, Inc., Roswell Park Cancer Institute Division, professional volunteers and visitors, students and trainees.

## **C. ADMINISTRATION**

This policy is administered by the Director of Technology Transfer with oversight by the Executive Vice President.

## **D. POLICY / PROCEDURE**

### **General**

RPCI is dedicated to providing total care to the cancer patient; to conducting research into the causes, treatment and prevention of cancer; and to educating the public and the next generation of those who study and treat cancer. On occasion, patentable inventions or other intellectual property are developed as a result of carrying out these endeavors. These inventions will be patented, copyrighted or trademarked, if, by doing so, the following objectives are facilitated:

- The broadest, most efficient, and most rapid dissemination of the benefits of such inventions can be made to the public.
- Mutually beneficial collaboration between RPCI/HRI and the private sector is reasonably expected to occur.

- The rights of RPCI, HRI, and the inventor can be appropriately protected.
- It should be noted that under US Patent law, contrary to most other countries' patent laws, there is a 12-month grace period after publication where a patent application may still be filed.

**Transfer of Rights other than Patents.** Technology transfer usually involves patenting inventions, but not always. In some cases, technology is developed which can be considered proprietary in nature, but which is either not patentable or not sufficiently developed for patenting at a given point in time. Outside parties can offer to engage RPCI/HRI in collaborative agreements involving the transfer of rights to said technology. Additionally, certain research sponsors, particularly commercial sponsors, may require the transfer of rights in any invention or other technology developed under sponsored projects as a condition of a grant award or contract.

**Waiver of Rights** All employees, upon employment with RPCI and HRI, agree to assign to their employer their rights to any patent, which may be developed in the course of their employment.

## **Committee Review System**

### **1. Purpose and Function**

- a. The Department of Technology Transfer is responsible for reviewing patent, technology transfer and related issues with input, where appropriate, from the Technology Transfer Committee of the Board of Directors. Particular decisions on patenting and related actions can be complex and pose major implications for the inventor, HRI, and RPCI. Therefore, it is imperative that full consideration be given to each case by the full range of RPCI/HRI scientific, legal and management personnel.
- b. The review process results in recommendations on actions to be taken. Recommendations will cover the following issues:
  - i. The extent of interest in pursuing a patent.
  - ii. The most appropriate method for patenting and marketing the invention.
  - iii. The advisability of proposed business arrangements that may involve the granting of exclusive or non-exclusive licenses for patented inventions in exchange for royalty payments or other considerations.
  - iv. The ownership of the invention, both from the perspective of individuals and sponsor organizations.
  - v. Revisions to the patent policy as required, including individual exceptions from the policy, in unusual circumstances.
  - vi. Review of sponsorship proposals that involve any sponsor control of future inventions.
  - vii. In the case of multiple inventors, the determination of proportionate shares in any revenue.
  - viii. Other technology-related issues deemed appropriate.

2. **Applicability of Review System:** The review system is applicable to any situation in which RPCI/HRI rights to technology are concerned, regardless of whether or not a patent is involved. It is anticipated that most cases will be initiated by RPCI/HRI scientists through the filing of an invention disclosure. The issue of technology rights, however, may arise in other instances, such as the receipt of grants from sponsors (usually commercial) which require as a condition of the grant, exclusive or non-exclusive rights to any resultant technology. In other cases, an external entity may wish to obtain

rights to an emerging technology, which has not yet reached the stage of development that would call for an invention disclosure.

3. **Distribution of Income:** In the event that income, in the form of cash payments, is derived from the licensing or other commercialization of an invention or technology, such income shall be distributed as follows:
  - a. All income shall be first utilized to offset any expenses incurred by RPCI/HRI in the patent and licensing process. Any negative balances, caused by costs in excess of revenue, shall be carried forward to future periods and applied against revenues derived. Expenses shall include those related to the assertion of defense of the validity of patent.
  - b. Residual or net income is distributed annually with forty percent (40%) flowing to the Inventor(s) to be distributed based on percentage of inventor contribution. Sixty percent (60%) flows to HRI to administer on behalf of RPCI.
4. **Responsibility**
  - a. Employees are responsible for executing a Patent & Technology Transfer Agreement at the time they commence employment and promptly filing an Invention Disclosure Form upon the development of an invention. (Since time limits are imposed on the patent process, and publication or other disclosures of the development may compromise the ability to properly proceed in the patent process, prompt reporting of potentially patentable inventions is imperative.)
  - b. The Human Resources Management Department or the appropriate institution office is responsible for obtaining a signed copy of a Patent and Technology Transfer Agreement at the time of an employee's hiring and for maintaining such agreement in the employee's official personnel file.
  - c. The Technology Transfer Office is responsible for receiving the Invention Disclosure Form, and for ensuring that the Intellectual Property review is completed.
  - d. Technology Transfer Office is responsible for conducting the initial review of each invention or technology transfer proposed and for making recommendations for management (patent and licensing) of the technology.
5. Once the Technology Transfer Office has reviewed and recommended the patenting/licensing of the technology, the information about such patent or licensing of the technology will be sent to the RPCI Vice President for Corporate Ethics for review of possible individual and institutional conflicts of interest. The VP for Corporate Ethics will then send any recommendations for managing the conflict to the RPCI Technology Transfer Office, General Counsel's office and to the President and CEO's office.

## **E. DISTRIBUTION**

This Policy and Procedure will be distributed to all Managers via the RPCI internal web page and to holders of backup hard copies of the manual. Managers are responsible for communicating policy content to pertinent staff.