



<b>Roswell Park Cancer Institute</b> Policy and Procedure	<b>Date Issued:</b> 7/1/2004	<b>Number:</b> 705.1
<b>Title:</b> INTELLECTUAL PROPERTY AND PATENT RIGHTS	<b>Revision:</b> 4	<b>Effective Date:</b> 2/25/13
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## A. GENERAL STATEMENT OF POLICY

Patentable inventions and proprietary technologies often are developed as a result of research conducted by the faculty and staff of Roswell Park Cancer Institute (RPCI). This Policy and Procedure enables RPCI to protect its intellectual assets subject to the Bayh-Dole Act of 1980.

All inventions, discoveries or intellectual property (regardless of the status of a patent, trademark or copyright) and technologies developed by persons utilizing RPCI facilities, or while employed at RPCI, are the property of RPCI. Further, RPCI shall have rights to all inventions, technologies and intellectual property developed during projects under contract to RPCI, subject to the negotiations of the parties.

Inventions will be patented at RPCI's sole discretion if, by doing so, the following objectives will be achieved:

- 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 and the private sector is reasonably expected.
- The rights of RPCI, Health Research, Inc. (HRI) and the inventor(s) are protected.

Patentable inventions or technologies which are (1) developed wholly without the use of RPCI facilities or other resources, (2) wholly on an individual's own time and (3) which are unrelated to the mission of RPCI and the RPCI employment activities of the inventor, shall not be deemed to be made in the course of a program or project of RPCI. RPCI will assert no claim in such inventions and technologies or to any resulting patent(s). RPCI will issue a Patent Release to the inventor(s) following review by the Technology Transfer Committee.

Materials being transferred from RPCI researchers to outside investigators are subject to protection under the RPCI [Materials Transfer Agreement](#) (MTA). The receiving investigator must sign the MTA before physical transfer of material can occur.

## B. SCOPE

This Policy and Procedure applies to all employees, students, visiting scientists and volunteers.

## C. ADMINISTRATION

This Policy and Procedure will be administered by the President and CEO through the Department of Technology Transfer and Commercial Development, with assistance from the RPCI General Counsel.

## D. POLICY / PROCEDURE

1. **Patentable Inventions** - Inventors must notify the Office of Technology Transfer of patentable inventions or technologies through the [RPCI Invention Disclosure Form](#). When so instructed by RPCI, inventor(s) shall make timely application for patent(s) under the aegis of and in the name of HRI, which has an Administrative Services Agreement with RPCI. To protect the rights of RPCI and the inventor(s) in intellectual property, publication of research leading to the invention or technology may be deferred, pending the outcome of the patent application process.
2. **Transfer of Rights other than Patents** - Technology transfer does not exclusively involve patents. In some cases, technology is developed which can be considered proprietary in nature, but is neither patentable nor sufficiently developed for patenting at a given time. Outside parties can offer to engage RPCI/HRI in collaborative agreements involving the transfer of rights to this technology. Additionally, certain research sponsors, particularly commercial, 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.
3. **Waiver of Rights** - Employees acknowledge that inventions and technologies developed while employed at and using RPCI facilities are the property of RPCI, and waive their rights to any resultant patent(s) by signing the Patent & Technology Transfer Agreement in the Department of Human Resources upon employment.
4. **HRI as General Coordinator** - HRI coordinates all matters related to patent administration and technology. In most instances, RPCI will assign all patent and technology rights to HRI to facilitate transfer and to distribute income to inventors.

If RPCI decides that a patent application should be filed, RPCI will arrange for the filing and, subsequently, for the licensing, or other method of utilizing the patent, through HRI. Such arrangements may include the use of a patent management firm or other external resources. RPCI has the option of returning the patent rights to an employee if RPCI does not wish to obtain a patent. In such cases, RPCI will issue a Patent Release to the inventor(s) subject to the retention by RPCI of 10% of the net proceeds from the inventor's commercialization of the invention.

### 5. **Technology Transfer Review Process**

- a. **Purpose and Function.** The Technology Transfer Review Process is designed to ensure comprehensive review of patent, technology transfer, and related issues with input, where appropriate, from the Technology Transfer Committee of the Board of Directors. Decisions on patents and related actions can be complex and may have major implications for the inventor(s), HRI and RPCI. Consideration must be given to each case by the full range of scientific and management personnel at RPCI.

The review process results in recommendations on actions to be taken, including, but not limited to:

- 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 granting exclusive or non-exclusive licenses for patented inventions in exchange for royalty payments or other considerations.
- iv. The ownership of the invention (individuals and sponsor organizations).
- v. Review sponsorship proposals involving any sponsor control of future inventions.

- vi. In the case of multiple inventors, the approval of proportionate revenue shares.
  - vii. Other technology-related issues as appropriate.
- b. Structure - The Department of Technology Transfer and Commercial Development is responsible for reviewing invention disclosure forms, recommending filing of patent applications, interfacing with inventors and outside patent attorneys, managing all aspects of the patenting process and assisting the inventor to identify and consummate commercial licensing agreements.
- c. Distribution of Income - Income derived from the patenting, licensing or other method of disseminating an invention of technology shall be distributed as follows:

All income first shall be used to offset any past expenses incurred by RPCI/HRI in the patent and licensing process. Balances (negative and positive) shall be carried forward to future periods and applied against revenues derived. Inventors will receive forty percent (40%) of residual or net income annually.

## **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.