



# Meeting the Requirements: Federal Funding and Intellectual Property Reporting

**Jennifer Crisp**

Director, Office of Technology Transfer

**Elizabeth Jeffery**

Operations Specialist

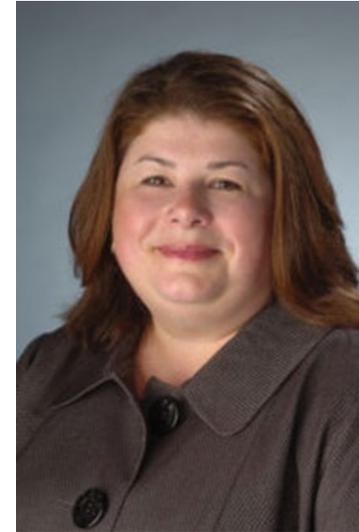


# Office of Technology Transfer Team

**Jennifer Crisp, J.D.**  
**Director**



**Elizabeth “Beth” Jeffery**  
**Operations Specialist**



Point of contact for **intellectual property (IP)** matters including patents, software, copyrights, and data rights

## Office of Research, Syracuse University

- **Office of Technology Transfer (OTT)**
- **Office of Sponsored Programs (OSP)**
- **Office of Proposal Support Services (OPSS)**
- **Office of Research Integrity and Protections (ORIP)**
- **Syracuse Office of Undergraduate Research & Creative Engagement (SOURCE)**

## Why Technology Transfer Exists

- To move compelling discoveries from academia (i.e. labs, scholarship) to the commercial marketplace.
- We do this via **Intellectual Property (IP) licensing**.
- Licensing affords “licensees\*” rights to create products and services based on university-developed innovation with a goal of improving lives, spurring economic development, and returning value to the university.

*\*“licensees” can be for-profit corporations, small businesses, start-ups, and also non-profits, NGOs, government.*

## What We Do

- **Advise on IP (patent, software, copyright, data) contract terms appearing in research grants, and IP policy.**
- **Manage and protect the IP developed by university researchers that has commercial value & is owned by SU.**
- Execute contracts and agreements
- Advise on IP topics in relation to collaborations between the University and industry; Syracuse University units; the University and other universities, and the University and government

# Intellectual Property (IP)

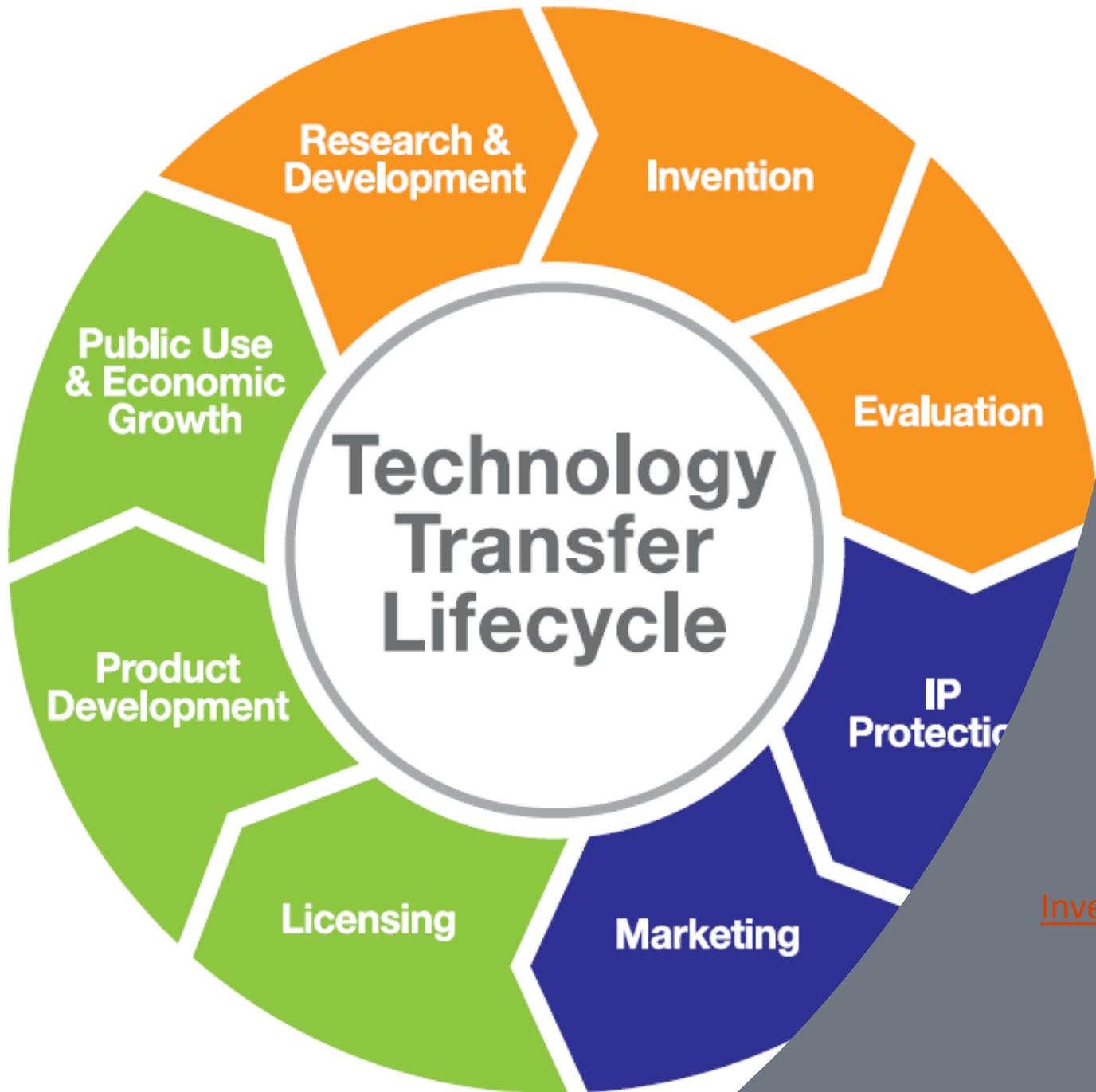
- General meaning
- Legal definitions in U.S. law
- Defined term in contracts
  - As defined in federal contracts, it is quite broad
- Defined term in employment matters

[Stanford Encyclopedia of Philosophy](https://plato.stanford.edu/entries/intellectual-property/#toc) →

<https://plato.stanford.edu/entries/intellectual-property/#toc>

“Intellectual property is generally characterized as non-physical property that is the product of original thought. Typically, rights do not surround the abstract non-physical entity; rather, intellectual property rights surround the control of physical manifestations or expressions of ideas. Intellectual property law protects a content-creator’s interest in her ideas by assigning and enforcing legal rights to produce and control physical instantiations of those ideas.

Legal protections for intellectual property have a rich history” ...



Learn more:  
Innovator's  
Guide to  
Technology  
Transfer at SU

[Inventors Guide to Technology Transfer at SU \(PDF\)](#)

# Syracuse University Intellectual Property Policy

Section 3.23 of the SU Faculty Manual:  
Ownership and Management of  
Intellectual Property

Annotated Version on [OTT website](#)



# Syracuse University IP Policy

- A few notes about the policy
  - “Technology” as the umbrella term
  - **Patentable inventions** treated differently than non-software **copyright**
  - **Software** treated more like a patentable invention
  - SU ownership of Technology & IP is clearest when there is a sponsored project

# Why U.S. Universities Have IP Policies

- Bayh-Dole Act
- Obligations of university community members to report IP to a designated office
- Incentives to commercialize, including sharing of the financial “upside” of IP licenses with innovators and to support continuing research and innovation
- IP protection is attractive to industry
- Federal grants have IP obligations from SU to the funder, thus, it is a compliance matter

# Bayh-Dole Act



## Bayh-Dole Act

- December 12, 1980, amended in May 2018
  - Codified at 35 U.S.C. § 200
  - Implemented at 37 C.F.R. 401
- Applies to most federal funding agreements
- Rights and responsibilities of grantee/contractor and Government for inventions and discoveries made in whole or in part with federal funding

## Bayh-Dole Act: Federal Funding

- Use the patent system to promote the utilization of inventions arising from federally supported research or development
- Encourage participation of small businesses
- Promote non-profit and industry collaborations
- Promote the commercialization and public availability of inventions made with federal support
- Ensure that the government obtains sufficient rights in inventions created with federal funds

## Bayh-Dole Act: Definitions

**Invention**: Any invention or discovery which is or may be patentable or otherwise protectable under this title (35 U.S.C. § 201(d))

**Subject Invention**: Any invention of the contractor conceived or first actually reduced to practice in the performance of work under a funding agreement (35 U.S.C. § 201(e))

**Caveat**: A preexisting invention can become a subject invention even if it was conceived prior to funding but was actually reduced to practice under federal funding

## Bayh-Dole Act: Responsibilities

### **In order for the grantee to retain the right to elect and keep title:**

- Inventions must be disclosed to funding agencies (often via iEdison)
- Patents must include a government support clause that states:  
*“This invention was made with government support under (contract #) awarded by (federal agency). The government has certain rights in the invention.”*
- An executed Confirmatory License must be supplied to the funding agency

## Bayh-Dole Act: Responsibilities Continued

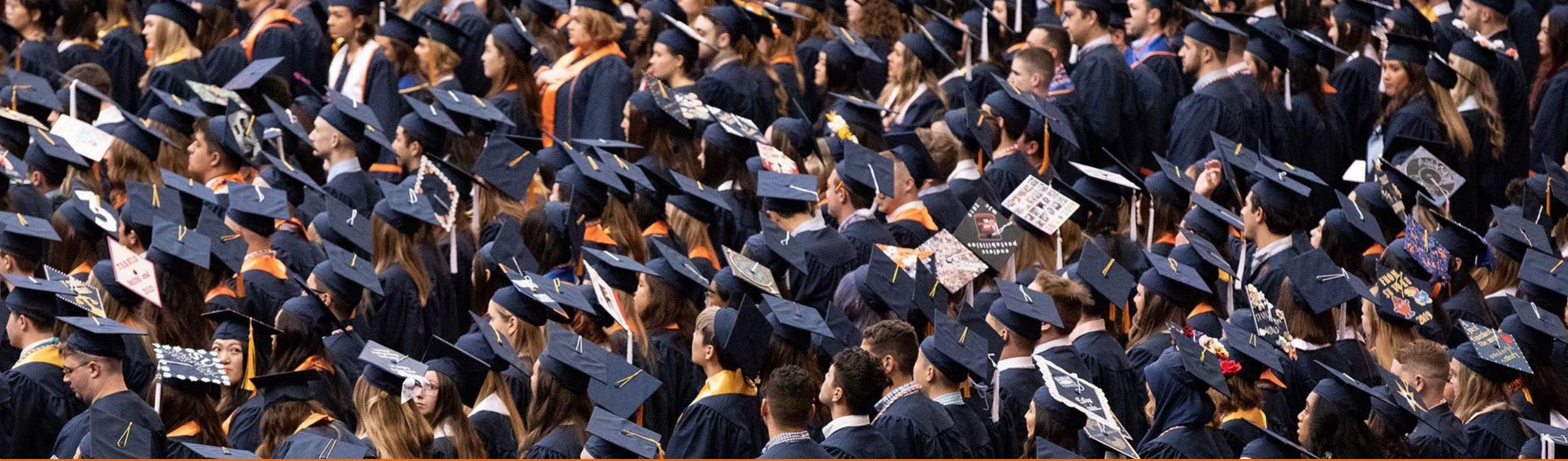
### **In order for the grantee to retain the right to elect and keep title:**

- Grantee must report decisions to discontinue patent prosecution or payment of maintenance fees – often through iEdison
- Annual reporting on the utilization of subject inventions (Utilization Report)
- Preference for U.S. Industry in manufacturing
- Share royalty income with inventors

# Bayh-Dole Act: Conditions When Government May Obtain Title

**Grantee will convey title to a subject invention to the federal funding agency when:**

- Failure to disclose or elect title to a subject invention within specified time
- Failure to file patent applications within specified time
- When a grantee decides not to continue the prosecution of any application



# Compliance

Working with Technology Transfer to Report Funding and Subject Inventions

# Who Reports IP to Sponsors?

- Investigator
- OSP
- OTT



# Intellectual Property Agreement

- Agreement is executed by PI when a first external award is secured
- Agree to:
  - The timely disclosure of inventions, process, compilations of data to OTT
  - Assist with the preparation and prosecution of patents and registration of copyrights
  - Assign rights, title and interest in IP to Syracuse University
  - Agreement found at <https://sponsoredprograms.syr.edu/tool-and-resources/sponsored-program-resources/>

# Timing and Connecting with Technology Transfer

- Contact OTT when:
  - Intellectual property is created, by completing an on-line invention disclosure
    - Link on OTT website: <https://techtransfer.syr.edu/innovators/submit-an-invention/>
  - As soon as funding is secured for research where previously disclosed IP will be **first actually reduced to practice** under the award (making the invention a “subject invention”)
    - Actually reduced to practice - term used in patent law that means that the claimed invention works for its intended purpose - the technology has moved beyond conception

## Timing and Connecting with Technology Transfer (cont.)

- Publishing and Patent Protection
  - Federal funding preserves the right for the grantee to file for patent protection
  - Critical that inventions are reported prior to publishing
  - Publishing is a broad term
  - Filing for patent protection prior to publishing preserves the rights to patent in the US and abroad



# Reporting Technology and Software to Technology Transfer

## Report innovations to Syracuse University Office of Technology Transfer

<https://techtransfer.syr.edu/innovators/submit-an-invention/>

**What:** Description/Abstract – Technical Description | Non-Technical Description

What are the immediate/future applications of this invention?

Why is this invention better/more advantageous than what is currently available?

**Technology Readiness/R&D Status:** Is work on this invention continuing?

Include information on whether there are limitations to overcome, or tasks to be done prior to practical application. Also, what further research and development is necessary; is there test data?

What is your understanding of the “**market opportunity**” for this tech/innovation?

## **When:**

**Past:** Has this innovation been disclosed in an abstract, paper, talk, news story, or a thesis?

**Future:** Is there a paper that will be submitted for publication? When? Will the paper be submitted to an Open Access repository? Which one? When (earliest date)?

**Agreements of Note:** Was this invention created or discovered under one or more funded projects?

**Who:** Who contributed to this innovation/invention and for each “individual involved” describe their contribution to the invention:

- Conceived of or collaborated on the conception of the solution
- Individual built, teste, or conducted experiments to establish that the solution works after the initial conception
- Both of the above

# Funding Secured after Invention Disclosure

- Contact OTT by email regarding the new award/funding
- OTT will investigate if corresponding IP is a subject invention (whether the IP has actually been reduced to practice for the first time under the award)
  - If yes, OTT will have inventors execute an addendum to the Invention Disclosure
  - Addendum can be found at <https://techtransfer.syr.edu/wp-content/uploads/2018/10/Disclosure-Addendum-12.12.18-Fillable.pdf>
- Follow-up discussions between PI and OTT often necessary as research continues

# Technology Transfer, Patent and Bayh Dole Resources

- OTT website
  - Bayh Dole Act at <https://techtransfer.syr.edu/about/bayh-dole/>
  - *Inventor's Guide to Technology Transfer at SU*
  - *Quick Start Guide*
- USPTO.gov
- Michaelson videos at <https://michelsonip.com/>

Questions





**Office of Technology Transfer**

224-226 Lyman Hall  
Syracuse, NY 13244

315-443-5196

[techtransfer.syr.edu](http://techtransfer.syr.edu)

