

Northwestern Intellectual Property Policies

OSR-Evanston Quarterly Network

Monday, April 13th

Ben Frey, J.D., Senior Contracts Manager



**NORTHWESTERN
UNIVERSITY**

Overview

- Define baseline terms (IP, patents, inventions, copyright)
- IP ownership under NU policy by:
 - Faculty
 - Students
 - Consultants
 - External Collaborators
 - Government
- Royalties
- Copyright



What is Intellectual Property?

- Includes anything intangible that is created by people and can be legally protected
- Two most relevant categories: **patent** and **copyright**
- A **patent** protects an invention that is new, useful, not obvious, and fully disclosed to the public
 - An **invention** is technology that may be patentable
- **Copyright** protects a particular expression of an idea
- Ideas themselves are not protectable
- Other types of IP: trademarks, designs, trade secrets

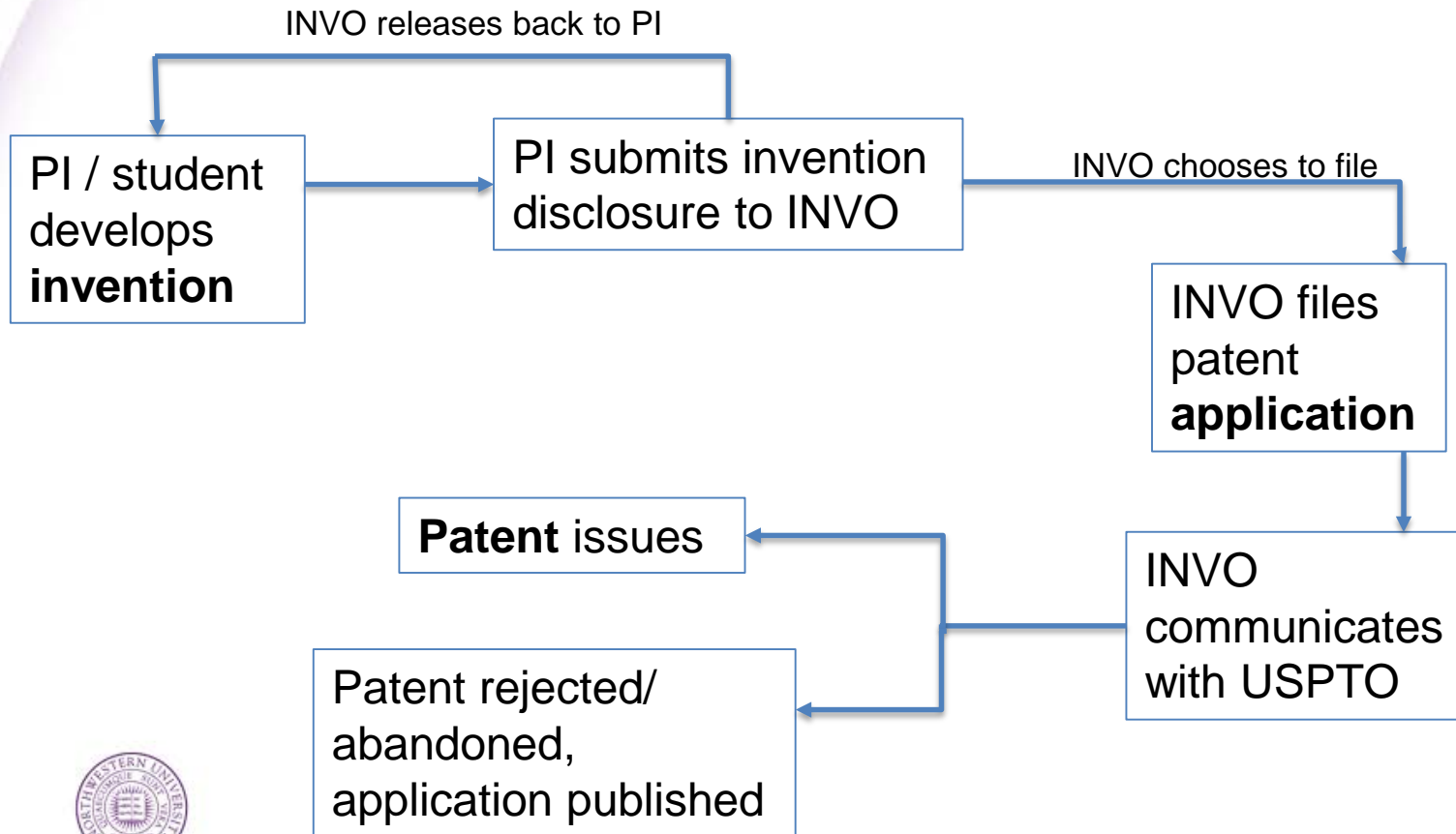


OSR and INVO: Helping Manage IP

- Intellectual Property and New Ventures Office (**INVO**) (formerly Technology Transfer):
 - Manages faculty invention disclosures
 - Files / prosecutes patent applications
 - Licenses IP to third parties, NU startups, etc.
- OSR works with INVO to:
 - Identify IP issues at proposal stage
 - Negotiate appropriate IP terms at award stage
 - Manage certain post-award IP obligations, including final patent reports and payment of “tech fees”



Patent Process at NU



NU Patent and Invention Policy

- Current policy became effective August 31, 2011
- Generally consistent with other US universities' policies
- **University owns any inventions** made by faculty, staff, or students that are created:

Within the normal field of their employment responsibility at the University (Broadly interpreted)

OR

Using University “resources”

(Includes space, materials, or facilities other than the Library)



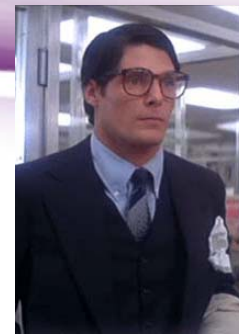
Student Inventions/Patents

- Policy applies to undergrads, grad students, and postdocs
- BUT student may petition INVO to “release” invention rights
- University will generally release rights unless:
 - NU contributed substantial / essential resources (funds, space, materials)
 - There is an existing, separate agreement with a third party (sponsored research, license, etc.)
 - Student collaborated with faculty other than the class instructor
 - Invention was created as a “work for hire”





Examples

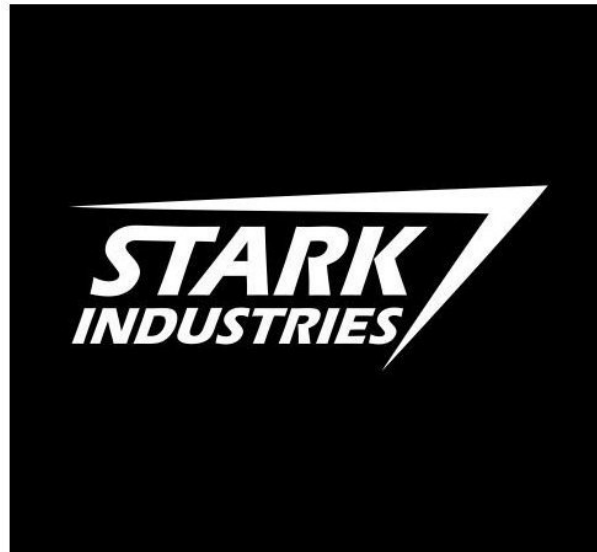


- Dr. Tony Stark in Materials Science and Engineering invents an Iron Man suit in his lab
- Stark invents the suit entirely on his own time at home
- Clark Kent in Medill (Journalism) invents the suit in his office
- Kent invents the suit on his own time at home
- Kent and his student, Jimmy Olsen, invent the suit as part of Kent's class
- NU student Jimmy Olsen invents the suit at home
- Who owns the IP?



Consulting

- Professor Kent designs the suit, then signs a separate consulting agreement with Stark Industries assigning the IP to the company
- Who owns the IP?



Consulting

- Faculty **cannot** assign, license, or transfer rights to inventions; only University can
- Faculty must notify their dean/director and INVO of any inventions arising from consulting engagements



External Collaborators

- NU Professor Kent travels to Stark Industries and develops the suit while at the company
- Stark Industries researcher Pepper Potts comes to NU and develops the suit while at Kent's lab
- Pepper Potts comes to NU and both she and NU Prof. Kent develop the suit together
- Who owns the IP?



External Collaborators

- Patent and invention policy applies to NU faculty's inventions, wherever developed, and to inventions developed at NU, whoever is the inventor(s)
- If an external PI is coming to NU, or if a NU PI is going to an external institution, it is important to get them (and their employer) to sign a visiting scientist agreement
- Note: NU and an external collaborator/sponsor can agree to IP terms in a specific agreement that differ from NU policy



Government Rights

- NU Professor Steve Rogers develops new shield technology under a grant from the U.S. Army
- NU licenses the shield technology to Stark Industries
- Who owns the IP?



Government Rights

- Under the Bayh-Dole Act, NU can elect to own title to federally funded IP and assign rights to that IP
- In this case:
 - NU owns the IP
 - Stark Industries has rights to the IP
 - US Army also has rights to the IP



Who Gets Royalties?

- For most inventions, royalties are split:
 - 33% to the inventor (shared, if multiple inventors)
 - 17% to the inventor's department
 - 17% to the inventor's school
 - 33% to Central Administration / Office of Research
- For blockbuster inventions, the inventor's share stays the same but some of the department/school share goes to OR



A Note on Copyright

- Creators own the copyright to anything they create at NU
 - EXCEPT if it's a “work for hire” (contractual arrangement or in performance of an administrative duty to NU)
- Creators receive all royalties to “traditional works”
- NU may share in royalties for software / computer applications if
 - Northwestern has provided “extraordinary resources” (more than 1/3 of an average faculty's annual effort or the equivalent salary) AND
 - Creator signs an agreement
- Copyright policy currently under review for update



Questions?



Patent and Invention Policy:

<http://www.invo.northwestern.edu/policies/patent-invention-policy-current>

Copyright Policy:

<http://www.invo.northwestern.edu/policies/copyright-policy>

