

Intellectual Property Considerations in Sponsored Research

*Intellectual Property &
Commercialization (IP&C),
Texas A&M AgriLife Research*

September 16, 2021

AgriLife IP&C Role

- Responsible for managing intellectual property (IP) developed under AgriLife-administered research funding
- AgriLife IP&C serves:
 - College of Agriculture & Life Sciences
 - Texas A&M AgriLife Research Centers & Institutes
 - Texas A&M AgriLife Extension
 - Texas Forest Service
 - Texas A&M Veterinary Medical Diagnostic Laboratory
 - College of Veterinary Medicine & Biomedical Sciences (depending on source of research support)
- Cooperates closely with Contracts & Grants, SRS, and CERS on IP matters involving sponsored research

IP Terms under Research Contracts

- Externally-funded research comes with contracts containing provisions on ownership and control of IP that may arise from the funded research
- While the IP provisions of research contracts/awards may vary somewhat, the basic principle is that the A&M System maintains ownership of inventions coming from research, and those inventions are managed per A&M System Policy 17.01 and regulations under that policy
 - Any exceptions to the A&M System owning the inventions created under sponsored research requires administrative approval
 - Funding alone is not justification for sponsors to own inventions coming from that sponsored research
 - Become familiar with requirements of disclosing inventions to the sponsor once awarded

Additional requirements related to IP with Federal Agency Funding

- Most federally funded research is subject to the Bayh-Dole Act (1980), which provides for universities and small businesses to maintain ownership of inventions created with federal funding
- In most cases, federal agencies maintain the right to use the inventions royalty-free for governmental purposes although the inventing entity has the ability to commercialize the invention
- Strict guidelines and timelines apply concerning inventions, such as:
 - Notifications of inventions within a designated time period
 - Election of title to an invention within a designated time period
 - Ongoing reporting obligations regarding patent protection and commercialization (licensing efforts)
- Texas A&M Technology Commercialization (the "central" IP office for the A&M System) is responsible for handling such notifications/reporting, but IP&C assists in these efforts

IP Considerations when Preparing Proposals

- Do you have an existing invention (background IP) you will be utilizing under the proposed project?
 - Verify that your use of an existing invention will not violate agreements with other external parties
 - If your existing invention has not yet been disclosed to IP&C, complete and submit an invention disclosure or contact IP&C to discuss
- Will your project utilize resources or discoveries from another externally-funded project?
 - Verify that there are no restrictions or conflicts pertaining to use of those resources or discoveries under the proposed project
- Does a proposal you are submitting to a for-profit entity contain proprietary information that may need to be protected?
 - Before revealing critical details to the company, a confidentiality agreement may be needed

Resources

- See our website for more information
 - <https://ipc.agrilife.org>
 - For Inventors: <https://ipc.agrilife.org/for-inventors/>
 - Commercialization Overview: <https://ipc.agrilife.org/for-inventors/commercialize/>
 - More Information on Disclosing: <https://ipc.agrilife.org/for-inventors/disclose/>
- Contact Janie or Robert about any questions or for additional information
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