



MOREHOUSE SCHOOL OF MEDICINE School Policy

SUBJECT LEGAL SERVICES CODING 01-90-35:00 PAGE 1 OF 13

TITLE INTELLECTUAL PROPERTY EFFECTIVE DATE 06/09 REVISION 01

PURPOSE

To establish Morehouse School of Medicine (MSM) policy for patenting any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereon made by MSM faculty, staff, and/or students, while using MSM facilities and/or funds, and to establish policy for the distribution of patent income.

ACCOUNTABILITY

Under the direction of the President, the Senior Vice President and Chief Operating Officer shall ensure compliance with this policy. The Vice President and Senior Associate Dean for Research Affairs shall implement this policy.

APPLICABILITY

- A. All MSM personnel, including every person holding any form of teaching or research appointment, fellows, and non-academic staff, holding appointments at or employed by the School.
- B. All students enrolled at MSM.

DEFINITIONS

- A. **Inventor** - Any individual named in Section III above who makes or develops any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereon. An inventor is further defined as an individual who has provided critical intellectual contribution that in its absence would not have resulted in the particular intellectual property. An author of a manuscript that describes the invention may or may not appear as an inventor.
- B. **Invention Developed With MSM Support** - Any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereon made or developed upon the time of and while in the pay of; or during appointment by or enrollment as a student; or in the laboratory of or with the facilities of the Institution.
- C. **Patent Management Organization** - A corporation or foundation (e.g., Research Corporation Technologies) which may be designated as the MSM agent in the handling of certain patent matters.
- D. **Gross Patent Income** - All income arising directly from the licensing or sale of the patent to either a third party or to a company in which the inventor has a financial interest. Such income shall include, but shall not be limited to, cash payments, minimum royalties, running royalties dividends, stocks, stock options, capital gains or payments in kind.

- E. **Net Patent Income** – Gross patent income, less applicable fees including; legal, patent application and patent maintenance fees.

POLICY

A. Requirements:

1. The Morehouse School of Medicine is committed to fostering research, educational and technical endeavors related to the advancement of scientific knowledge and to the publication and the use of the results of such research. While such research activities performed with the facilities and/or funds of MSM by faculty, staff and students are not intended to be profit making, MSM recognizes that some activities may lead to inventions which should be patented for one or more of the following reasons:
 - a. to protect the public interest;
 - b. to comply with the requirements of research grants, awards, and contracts for research;
 - c. to comply with the requirements agreed upon by MSM and non-research entities;
 - d. to promote the development of useful apparatus and processes which would not be developed without patent protection;
 - e. to encourage invention and assure adequate rewards as incentive for the inventor; and
 - f. to support facilities and programs at MSM for research, education and advance technology by means of income derived from royalties.
2. The MSM Patents policy is intended to be consistent with these principles and philosophy and with the purposes of the School. It is intended to encourage patenting of potentially valuable inventions made by members of the MSM community while using MSM facilities and/or funds.
3. **Ownership of Inventions**
 - a. A condition of appointment or continued employment by or enrollment in the Institution has been the agreement to assign to the Institution all inventions developed with Institutional support. Notebooks, electronic files and other documents pertaining to research activities and all data (including written and computerized material and photographs, etc.) leading to an invention must be maintained by the Principal Investigator and copies made available to the Institution.
4. **Administration of Patents**
 - a. The Office for Research Development shall be responsible for providing information and assistance on patent matters to inventors, and for managing the patenting of inventions under this policy after consultation with the inventors.
5. **Disclosure Responsibilities of Inventors**
 - a. Every inventor shall promptly disclose to the Office for Research Development as described under "PROCEDURE" all inventions

developed with MSM support in order that they may be evaluated as to patentability and commercial and scientific utility, and so that timely decisions can be made regarding the filing of patent applications thereon.

- b. An **Invention Disclosure Form (Exhibit I)** will be filed before either a provisional or full patent application is filed. This will outline the novelty of the potential invention, and any and all obligations or collaborations made by the inventor(s) that may have directly or indirectly led to the invention.
 - c. The invention document will explain the intellectual contribution (percentage) made by the inventors (i.e., % inventorship).
6. Inventions made Jointly with Outside Inventors
- a. Where an invention covered by this policy has been developed jointly with individuals not covered by this policy, the terms of any contractual agreement previously entered into by MSM with the non-MSM inventors will govern. If no agreement exists or the terms of the existing agreement are not complete, an agreement regarding patent rights and obligations shall be negotiated with the co-inventor(s)'s or the appropriate institution or corporation by the Associate Dean for Research Development.
7. Compliance with Contractual Patent Restrictions
- a. All inventions or disclosures thereof resulting from research performed under grants or contracts entered into by MSM with specific patent restrictions shall be subject in the first instance to the restrictions, but, even when governed by contract or grant, all inventions must be submitted for review and evaluation as provided in paragraph A. 5. above.
8. Distribution of Patent Income
- a. A portion of patent income shall be paid to the inventor(s) according to the schedule set forth herein. **(See Procedures Section C.1.)**
 - b. The initial invention disclosure shall outline the % inventorship of the patent and will be used to calculate the distribution of patent income.

PROCEDURES

A. Disclosure of Inventions

1. Inventors shall submit a full disclosure of any invention to the Office for Research Development using the **Invention Disclosure Form (Exhibit I)**.
 - a. **Intellectual Property** - The Office of Research Development is responsible for all Technology Transfer/Intellectual Property related issues. Intellectual Property includes ideas, inventions, processes, works of authorship, which are able to be protected under patent, copyright, trademark or trade secret. Any material transfer agreement or confidentiality agreement questions or concerns you may have related to these should be directed to this office. **It is extremely important that Intellectual Property not be presented,**

discussed, published or disclosed, prior to filing or transmitting an application for ownership.

b. Process for Submitting Invention Disclosure

- Obtain Invention Disclosure form from the Office of Sponsored Research Administration (OSRA).
 - Complete Invention Disclosure form and return to ORD.
 - ORD will forward the Invention Disclosure form to the Intellectual Property Committee for review. The review process takes 30 days.
 - If the committee does not have proper representation for your research an ad hoc committee member will be brought in for the review which will be required to submit confidentiality agreement.
 - Once the committee reviews the form, they will make a decision as to whether the disclosure should be sent forth to the Legal Counsel based on its potential or returned to the faculty with reviewer's comments.
 - Requester will be notified of the decision.
2. Disclosures should be made as early as possible in the development of an invention.
 3. When any question exists as to whether an invention is covered by this policy, the invention must be disclosed through the usual disclosure mechanism described above, with a request for a determination of whether the invention is covered. In cases where an inventor seeks to establish that an invention is not covered by this policy, the burden of proof shall be with the inventor.
 4. An Invention Disclosure Form must be submitted prior to any negotiations by any inventor with outside companies with regard to further support or licensing of the invention. Disclosure shall be made even if the inventor seeks additional support to complete the invention or to enter into a collaborative arrangement to complete the invention. This is imperative in order to ensure confidentiality of the potential invention.
 5. A **Confidentiality Agreement (Exhibit II)** must be completed and submitted to the Office for Research Development when the applicant/inventor needs their invention evaluated for commercial purposes or to gather expertise about the proposed invention from an external expert. The confidentiality agreement protects the rights of the inventor.

B. Patent Protocol

1. Once the invention disclosure has been made to the Office for Research Development, the Office for Research Development shall promptly submit the disclosure to the Intellectual Property Committee for review. When a disclosure containing sufficient technical information to permit an effective patent study has been made, the Office for Research Development shall notify the inventor in writing, within 30 calendar days for a provisional patent and 60 calendar days for full patents, of MSM's intentions with regard to the invention.

2. Options Available to the Institution

2.1 MSM may, after consultation with the inventor:

- a. undertake the filing of patent prosecution within 30 days, development, and marketing of the invention and shall bear all related costs. Any income to be distributed shall be gross income received, less applicable costs, including; legal, patent application and maintenance fees incurred by the Institution in obtaining and protecting the patent rights or marketing the intellectual property, as defined in section C.1.b.
- b. seek support for the costs of patent prosecution through a licensing or other agreement. Any income to be distributed shall, in this instance, be income received less costs incurred by the Institution in obtaining and protecting the patent rights
- c. cause the invention to be assigned to a patent management organization. The domestic or foreign patent rights, or both, may be assigned to a patent management organization. Any income to be distributed shall be the income received after the patent management organization has received its portion of the income, less additional costs borne by the Institution;
- d. release to the inventor all rights to the invention unless such rights revert to the sponsor of the program or the Federal Government; and
- e. the Institution has the obligation to make a good faith effort to commercialize the invention within 12 – 18 months. If, for any reason, the Institution is unwilling or unable to carry out this obligation, the Institution will then offer to release the invention to the inventor(s), as in Option B.2.d., under conditions acceptable to all parties.

3. Continuing Option

- a. Notwithstanding any previous decision to support an invention, the Institution may at any time elect to release all rights to the invention to the inventor, as in B.2.d. above.

C. Distribution of Invention Related Income

1. Formula for Distribution of Income – Except as otherwise provided in this policy, the following distribution formula will apply to Net Royalties.

- a. 35% of the net patent income and/or milestones to the inventor(s) personal share; and
- b. 10% of the net income and/or milestones to the inventor(s) research share; and
- c. 15% of the net patent income and/or milestones to the inventor(s) Department/Center – directed share (if no department or center to be allocated by Dean of the School for research purposes)

- d. 15% of net patent income and/or milestones to the School share
- e. 15% of net patent income and/or milestones to the Dean's share
- f. 10% of net patent income and/or milestones to the OSRA

Exhibit(s)

- I) Invention Disclosure Form
- II) Confidentiality Agreement

By Direction of the President:

Senior Vice President and Chief Operating Officer

Date

Dean and Senior Vice President for Academic Affairs

Date

Exhibit I

MSM ID No. ____ - ____

CONFIDENTIAL

MOREHOUSE SCHOOL OF MEDICINE

INVENTION DISCLOSURE

Please provide as much information as possible on this form. Attempt to answer all of the questions and be as accurate as you can be, providing as much information as you can to answer the question. If you need more space, use separate pages and attach them to this form. Please feel free to use photocopies of lab notebooks (showing dates), data sheets, drawings or any other rough document(s). If you have questions, please contact the MSM Office of Sponsored Research Administration at 404-752-1050.

1. Title of Invention

2. Investigator to whom communications should be addressed.

Name: _____

Address: _____

Phone #: _____ Fax #: _____ E-mail: _____

Date: _____

DESCRIPTION OF THE INVENTION

3. Describe the characteristics/specifications of the invention

- a. Please give a complete technical description of the invention and its advantages over what was known previously. If necessary, use drawings, diagrams, pathways, etc.

- b. What is the technology that presently exists in the area of this invention? What are the advantages of this technology over existing inventions and practices?

- c. What need does this invention meet and how is that need presently being met?

- d. What additional embodiments, variations, or applications can you reasonably envision for this invention?

4. Date of the Invention

When did you and/or your co-inventors conceive this invention? On or about _____

Provide the date when a written description was documented in a laboratory notebook, computer record, or other form, other than this Disclosure Form _____.

DETERMINATION OF OWNERSHIP AND INVESTORSHIP

5. Ownership of the Invention.

In my opinion this invention:

- A. Is owned by MSM in accordance with Patent Policy;
- B. Was developed by the inventor(s) without use of MSM time, facilities, or materials.
- C. Is co-owned by another institution or company.

6. Individuals involved in discovery or inventive contribution.

Inventive Contribution is defined as a contribution made to the conception of and/or reduction to practice which would contribute to at least one claim of a patent application.

A. Printed Name in Full _____

Signature _____

Address _____

Phone _____ - _____ Fax _____ - _____ E-mail _____

Date _____ Citizenship _____

B. Printed Name in Full _____

Signature _____

Address _____

Phone _____ - _____ Fax _____ - _____ E-mail _____

Date _____ Citizenship _____

C. Printed Name in Full _____

Signature _____

Address _____

Phone _____ - _____ Fax _____ - _____ E-mail _____

Date _____ Citizenship _____

D. Are there additional inventors? Yes _____ No _____
If YES, please list on additional page.

7. Who has funded the development of the invention to date?

Grant# _____ Funding Organization. _____ P.I. _____

Other:

8. Have any agreements been proposed or signed regarding this invention?

Yes _____ No _____. If yes, please explain below.

9. Have any materials or facilities which were NOT provided by MSM been used in the discovery or development of this invention? If so, please list the materials and facilities used, who paid for their use, and the approximate dates.

Relationship with Third Parties

10. Have you published in any form, including poster material or abstracts, information regarding this invention? If yes, provide details below and attach a copy of each such document.

11. Have you discussed the invention in any non-confidential setting, either in the U.S. or abroad? If so, please give the date of such disclosures, who received the disclosure, the form of the disclosure, e.g., written or oral, and describe the extent of that disclosure, including a description of any materials provided.

12. List any manuscripts which have been prepared and indicate the status of the pending publication(s), e.g., initial review, final review, in press, including possible publication dates. Please attach copies of all such manuscripts.

13. Please list other researchers or organizations of whom/which you are aware might be doing similar work. Cite published references where possible.

14. Provide references to reviews, publications and other literature or public disclosures of this work or any related work of which you are aware.

15. Who would use this product and how would it be used?

16. Please name any competitive products and manufacturers of which you are aware, even though their products are not as good as your invention.

17. List names, addresses, and phone numbers of corporations or individuals you would like to have contacted and who might be interested in licensing this technology.

18. What are your personal goals regarding the development and commercialization of this technology?

Exhibit II

Confidentiality Agreement

Effective _____, 20__ (the "Effective Date"), "Corporation Name" and Morehouse School of Medicine agree as follows:

1. Confidential Information means: (a) any information in written or tangible form of the type described in the List of Definitions at the end of this Agreement, communication to "Corporation Name" by Morehouse School of Medicine, and marked confidential; and (b) information of the type described in the List of Definitions, communicated orally or visually to "Corporation Name" by Morehouse School of Medicine, if it is reduced to writing or tangible form by Morehouse School Of Medicine on or before the date thirty days after the date of such communication, marked confidential, and promptly delivered to "Corporation Name". Other italicized terms in this Agreement are defined in the List of Definitions.
2. After Morehouse School of Medicine receives a fully-signed copy of this Agreement, Morehouse School of Medicine shall disclose to "Corporation Name" Confidential Information solely for use by "Corporation Name" in its internal evaluation of the Confidential Information's commercial prospects.
3. "Corporation Name" agrees that, for a period of five years after the date of its receipt of each Confidential Information disclosed under this Agreement, it shall: (i) keep Confidential Information confidential; and (ii) not use the Confidential Information for any commercial purpose. The foregoing shall not apply to that part of any Confidential Information that:
 - (a) is disclosed or used by "CORPORATION NAME" in accordance with any written consent granted by Morehouse School Of Medicine, or
 - (b) at any time becomes generally known to the public through no fault of "Corporation Name"; or
 - (c) has been or is made available to "Corporation Name" by a third party having the lawful right to do so without breaching any obligation of nonuse or confidentiality to Morehouse School Of Medicine; or
 - (d) has been or is disclosed to others by Morehouse School Of Medicine without similar restrictions on disclosure and use; or
 - (e) "Corporation Name" is required to disclose pursuant to an order of a judicial or administrative authority.
4. Morehouse School Of Medicine authorizes "Corporation Name" to disclose the Confidential Information to those employees and consultants who require the Confidential Information for the evaluation hereunder, and to potential licensees, provided each such employee, consultant and potential licensee has first entered in to a written agreement in which it agrees to be bound by similar obligations of nonuse and nondisclosure as those imposed on Research Corporation Technologies Inc. hereunder.
5. "Corporation Name" shall complete its evaluation within the Evaluation Period. If "Corporation Name" believes the Confidential Information has scientific and commercial promise, "Corporation Name" and Morehouse School Of Medicine may elect to commence negotiations leading to an agreement governing "Corporation Name's" commercialization of Morehouse School Of Medicine.
6. At the end of the Evaluation Period, "Corporation Name" shall, upon request of Morehouse School Of Medicine, return to Morehouse School Of Medicine all Confidential Information disclosed to "Corporation Name" in writing, unless written consent is granted by Morehouse School of Medicine to retain confidential information.
7. This Agreement shall not be construed to grant to "Corporation Name" any express or implied option, license or other right, title, or interest in or to the Confidential Information, or the patent rights corresponding to the Confidential Information, or obligate either party to enter into any agreement granting any of the foregoing.

8. This Agreement shall be construed and enforced under the internal laws of the State of Georgia, U.S.A. If any provision of this Agreement is held to be invalid, illegal, or unenforceable, the validity, legality, and enforceability of the remaining provisions shall not in any way be affected or impaired thereby.
9. Any Riders attached to this Agreement are incorporated in, and made part of, this Agreement. This Agreement represents the entire agreement of the parties relating to Confidential Information, and any corresponding patent rights, and any and all contemporaneous and prior oral and written understandings and agreements with respect thereto are superseded by this document. However, any written agreements between "Corporation Name" and Morehouse School Of Medicine that are made effective prior to the Effective Date of this Agreement are not superseded by this Agreement and shall remain in full force and effect unchanged by this Agreement.
10. This Agreement shall be legally binding upon the undersigned, their successors, and assigns but shall not be assigned by either party except in its entirety and only with the entire business of such party.

IN WITNESS WHEREOF, the parties have duly signed this Agreement, or caused an authorized officer or agent to sign this Agreement, on the date(s) indicated below, to be effective the Effective Date.

Morehouse School of Medicine

"Corporation Name"

By: _____

By: _____

Title: _____

Title: _____

Date: _____

Date: _____

List of Definitions

CORPORATION
NAME

"CORPORATION NAME, TYPE: PROFIT OR NON-PROFIT, ADDRESS

MOREHOUSE
SCHOOL OF
MEDICINE

MOREHOUSE SCHOOL OF MEDICINE, A private, non-profit academic institution, 720 Westview Drive, S.W. Atlanta, Georgia 30310

EVALUATION
PERIOD

Evaluation Period means the period expiring on the date six months after the date "Corporation Name" receives the Confidential Information from Morehouse School of Medicine.

CONFIDENTIAL
INFORMATION

Confidential Information pertains to:
Inventions disclosed to (CORPORATION NAME) from time to time after the Effective Date of This Agreement by the disclosing party and identifies with particularity at time of disclosure.