

Inventorship and Ownership/Employee Rights (Professors)

- Many universities don't have formal employment contracts similar to industry
 - Stanford v Roche is changing that at least in the US
- Faculty are to abide by “university policies”
 - Patent and copyright policies
 - Some are more defined than others (use of university facilities vs. just employer/state owns)
 - Ownership rights may be different for copyrighted IP vs. patentable IP
- Most faculty may consult some portion of the academic year
 - Not all universities review consulting agreements
 - Often ownership goes to the company paying the consultancy



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Questions on the Case Study

- Who is the initial owner of the IP in the various inventors' contributions: employer or employee?
 - It depends on University policy/consulting
- Even if ownership vests in their employers, do the employees retain any rights in “their” IP?
 - Depends on the type of IP and the specific university policy; generally they do not have the right to assign ownership elsewhere
- Is the Letter of Intent effective to transfer ownership to MegaCorp and NewCo as co-owners?
 - NO!



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Access to IP by Parties Outside the Consortium

- Who owns, and who can use, the Side Study IP?
 - When, where, how did the docs do the work ?
 - University policy
 - Are there Field of Use Provisions in the Agreements?
- Do the parties to the Side Study have any access rights to the background or foreground IP under the Main Project?
 - Doubtful