

Rochester Institute of Technology and Corporations: An Overview of Intellectual Property Issues and Terms

Companies and RIT work together to seek solutions to a specific problem, to complement R&D expertise and facilities, to contribute to the advancement of science and technology, and to support the next generation of scientists and engineers who are employees of the future. The first two reasons are driven by specific corporate needs; output from this kind of R&D effort is intellectual property (IP) that the company can use to achieve certain competitive advantages. The last two reasons are driven by the need to ensure future availability of a well trained workforce; IP rights may not be as important to the company. RIT understands the strategic importance of IP to companies and will work with its corporate research sponsors to meet the needs of both parties. This paper outlines the terms that will guide corporate-sponsored projects at RIT.

RIT and Corporations

Companies often approach RIT with specific problems they want investigated given our expertise in key areas. In many cases, company engineers or scientists and RIT faculty will work collaboratively on the project. In other cases, RIT may already have developed technology that is of interest to the company and which can be made available under a license. If proprietary information needs to be exchanged during this planning phase, a Non-Disclosure Agreement (NDA) can be executed to cover sharing of proprietary information. A NDA can also be drawn up for the purpose of evaluating a technology to determine whether a license is desired.

Technologies Available for License

RIT protects its IP through patents and copyrights; these are licensed to interested parties both through non-exclusive or exclusive licenses and at fair market value. RIT will retain the right to use its technology for educational and non-commercial research purposes. Licenses may be field of use specific and will contain performance guarantees for exclusive licenses. Rights to derivative works are the subject of separate license negotiations.

Background Intellectual Property

Background Intellectual Property (BIP) is IP developed before or outside of the collaboration and is related to the subject of the collaboration. In order for a company to use the output of its effort with RIT, the company may need access to related BIP of RIT. RIT will always make its BIP available under a license to its corporate partners unless there are legal reasons why it cannot do so; these licenses typically are non-exclusive and royalty-bearing.

Arising Intellectual Property

Arising IP is IP developed as part of the sponsored project. Arising IP ownership is defined in the associated Sponsored Research Agreement (SRA) (<http://www.research.rit.edu/formsagreements/#agreements>). Terms in SRAs for arising IP are: it will be owned by RIT when RIT is the sole creator; it will be owned by the company when the company is the sole creator; and it will be jointly owned if jointly created. In the case of sole RIT ownership, RIT will grant a non-exclusive license to the company to arising IP; that license may be royalty-bearing or royalty-free and may include payment of associated patent costs. In the case of joint ownership of arising IP, each party can commercialize the IP on a non-exclusive basis without accounting to the other or the company can license RIT's ownership for exclusive control of the technology. A company sponsor of RIT research will typically have the first option for a limited time period (e.g., 6 months) to request a royalty-bearing, exclusive license; in such cases, the company bears patent costs associated with the IP. See also *Technologies Available for License* above.

Confidentiality

SRAs contain confidentiality terms under which RIT agrees to keep proprietary information confidential for a stated time period, which is typically two years after the sponsored project ends.

Rights to Publish or Otherwise Disclose

An essential part of RIT's educational mission is sharing newly created knowledge, including IP, with its students, other faculty, and colleagues worldwide. However, because our mission is different from a company's mission, we will, as needed, agree to delay publication or other disclosures while the company sponsor reviews a proposed disclosure and seeks to secure IP protection. Federal regulations require that such review or delay for patenting purposes cannot exceed 90 days. Please note, however, that RIT will not accept any delay on publication of student theses or dissertations.

For More Information – Technology Licensing

Varda N. Main
Director – Technology Licensing Office
585-475-2986
vmain@mail.rit.edu

For More Information – Sponsored Projects

Marjorie K. Zack
Director – Sponsored Research Services
585-475-7525
Marjorie.Zack@rit.edu