

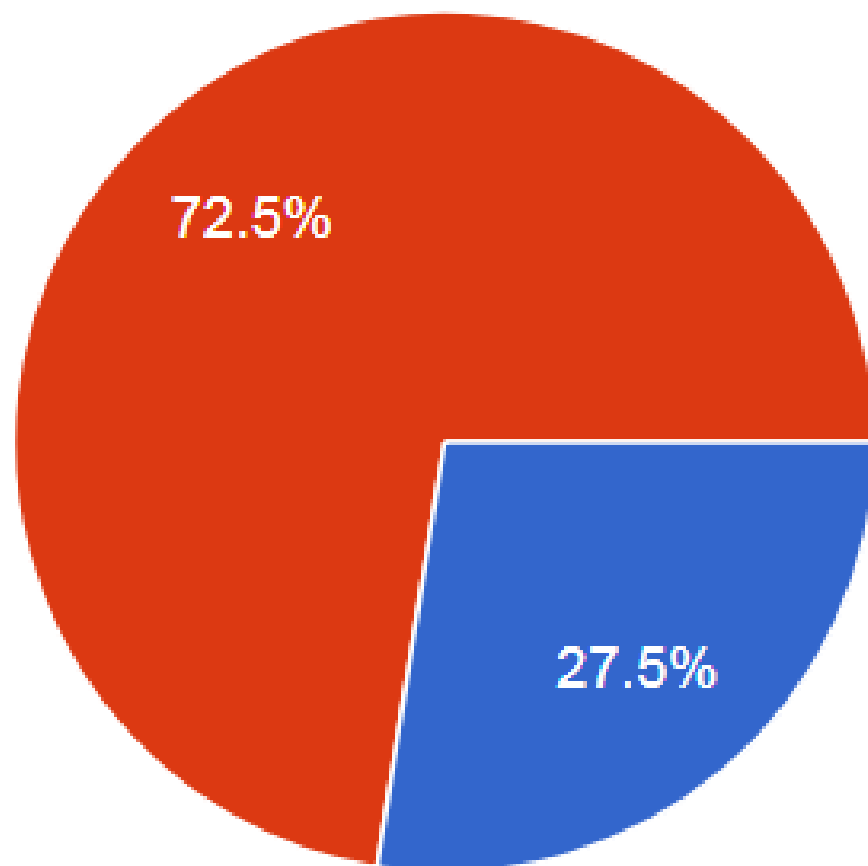
Results of Intellectual Property and Technology Transfer Sub-group Survey

May 14, 2018

Survey Respondents: Research Funding Entity? Or Research Performing Entity?

40

respondents

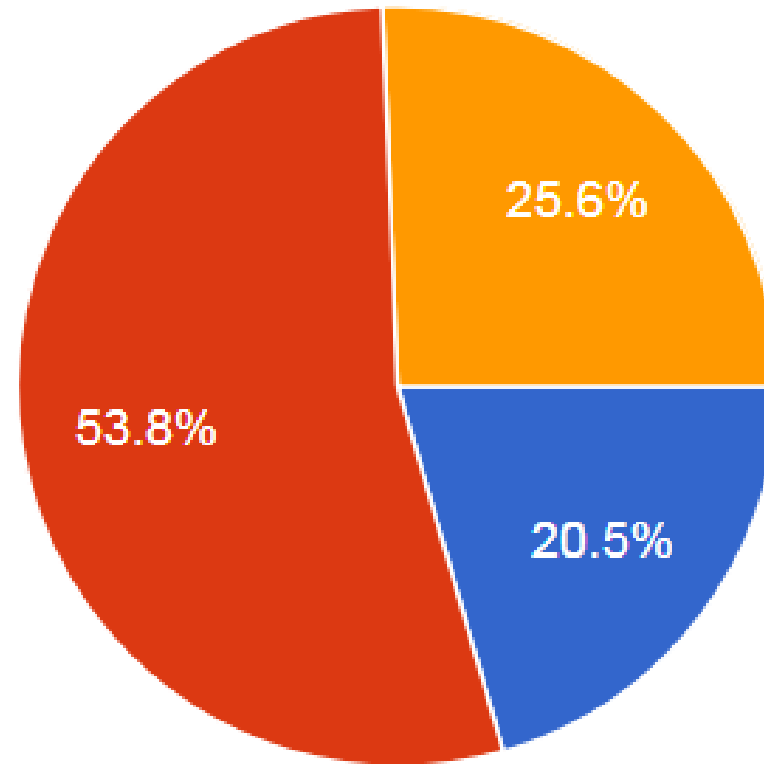


- Funding Entity
- Research Performing Entity

Scope of definition of IP (e.g., Which kinds of IP are going to be considered and affected by an agreement)

25.6%

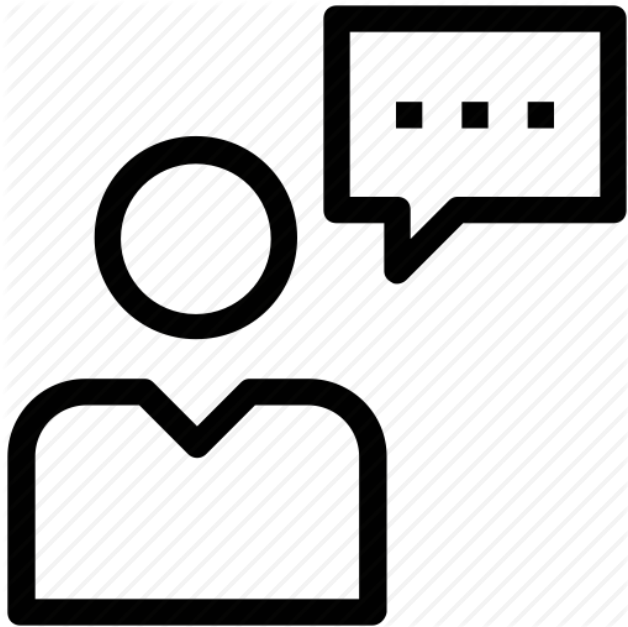
- Sometimes or frequently the topic of negotiations; the parties often have difficulty coming to agreement



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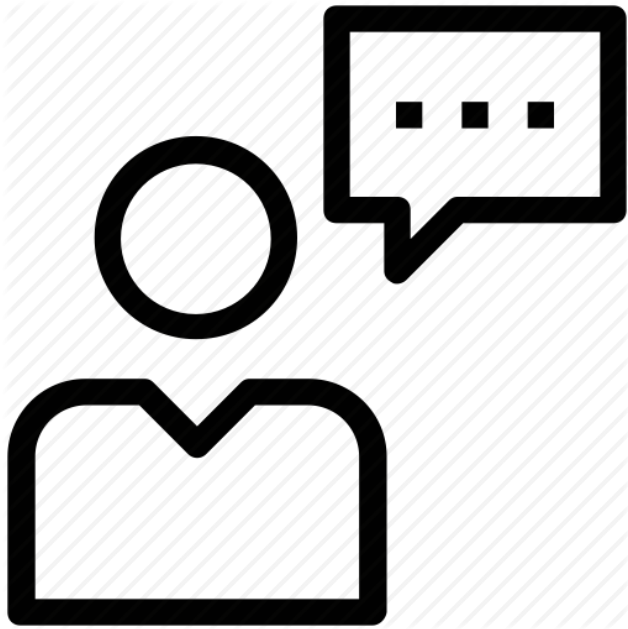
Your Comments



Crafting an appropriate scope of work with a defined "field" of IP is where most of the effort takes place. Negotiations center around the definition of the "field".

Scope of definition of IP (e.g., Which kinds of IP are going to be considered and affected by an agreement)

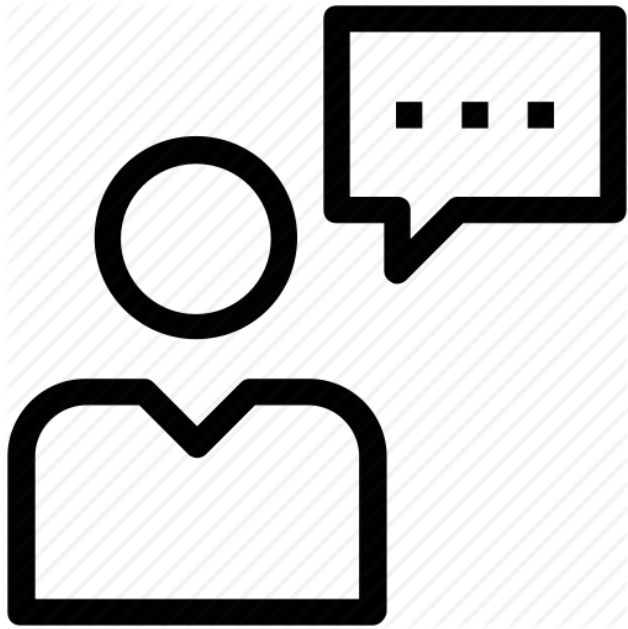
Your Comments



Other than discussions of whether data should be treated separately and differently than other types of IP, I rarely see negotiation of how to define IP.

Scope of definition of IP (e.g., Which kinds of IP are going to be considered and affected by an agreement)

Your Comments



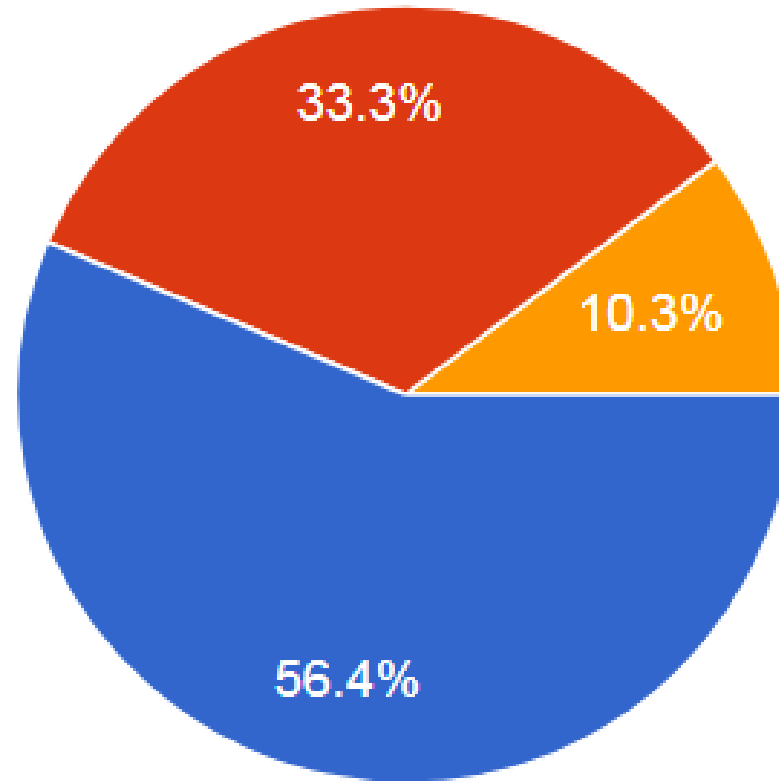
Actually I don't think we are ever successful at narrowing the definition.

Usually we have no demands for IP

Disclosure requirements (e.g., disclosing inventions to the sponsor)

10.3%

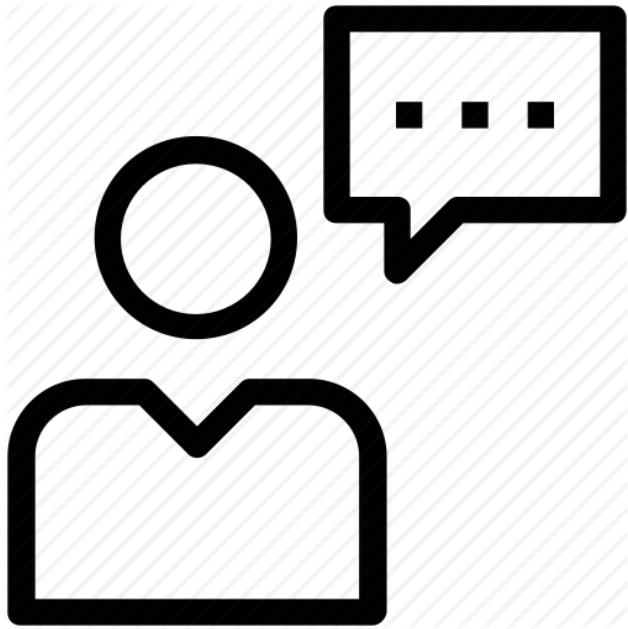
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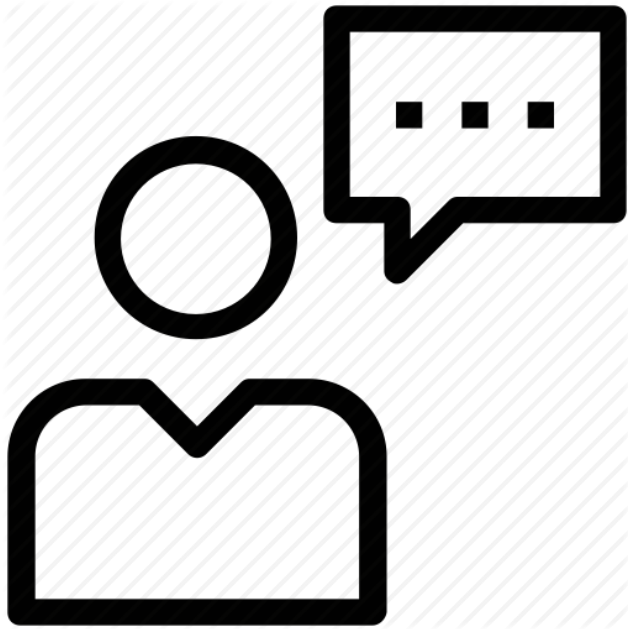
Your Comments



Timing of disclosure can be an issue; whether the inventions are reported directly to the company (without going through tech transfer) can be an issue.

Disclosure requirements (e.g., disclosing inventions to the sponsor)

Your Comments

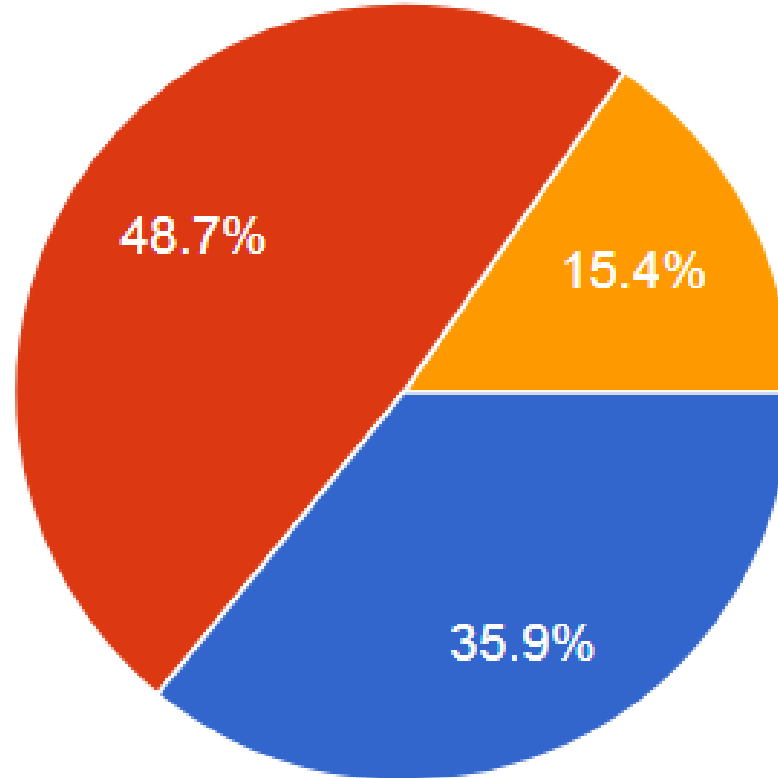


While this is rarely subject to negotiation, we find that grantees don't always actually disclose their inventions and we find out later when we see a press release or some other way. This is problematic and we'd love to know what other organizations do about this.

Ownership of new IP

15.4%

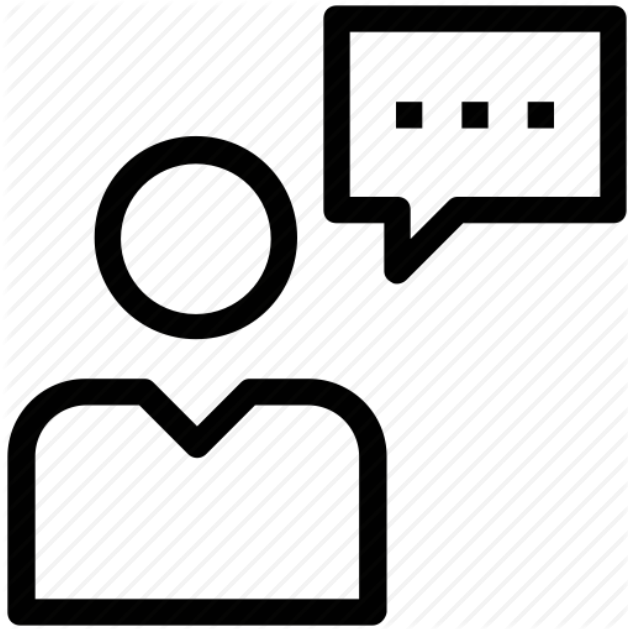
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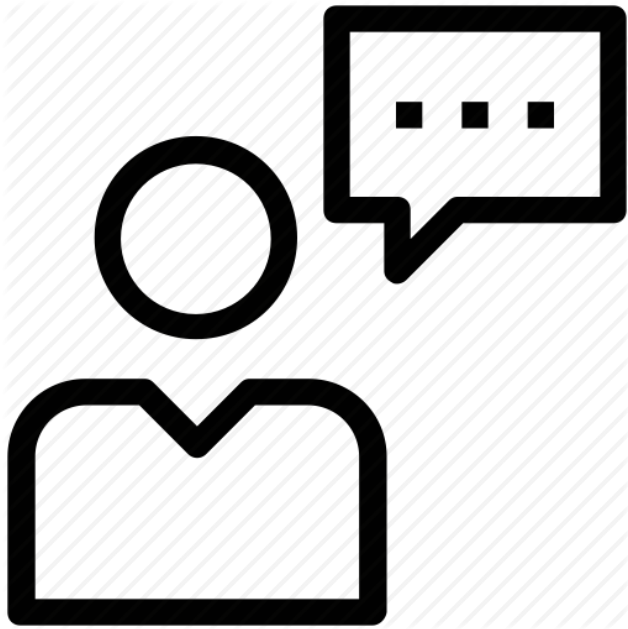
Your Comments



Specific in re: terms of licensing are generally not included in the sponsored research agreement but the SRA does clearly articulate the intent to afford the sponsor the opportunity to pursue and exercise an option to such licenses. Negotiations generally focus on non-exclusive vs. exclusivity

Ownership of new IP

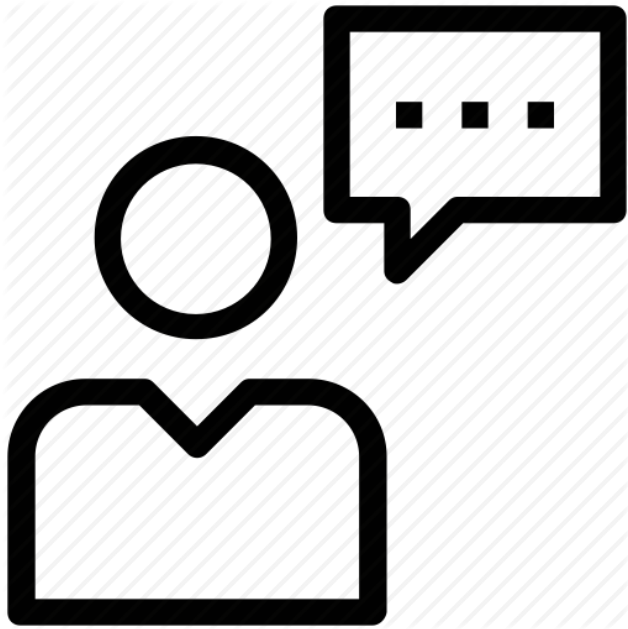
Your Comments



Grantees have full rights to ownership of all IP generated so this is not a problem.

Ownership of new IP

Your Comments

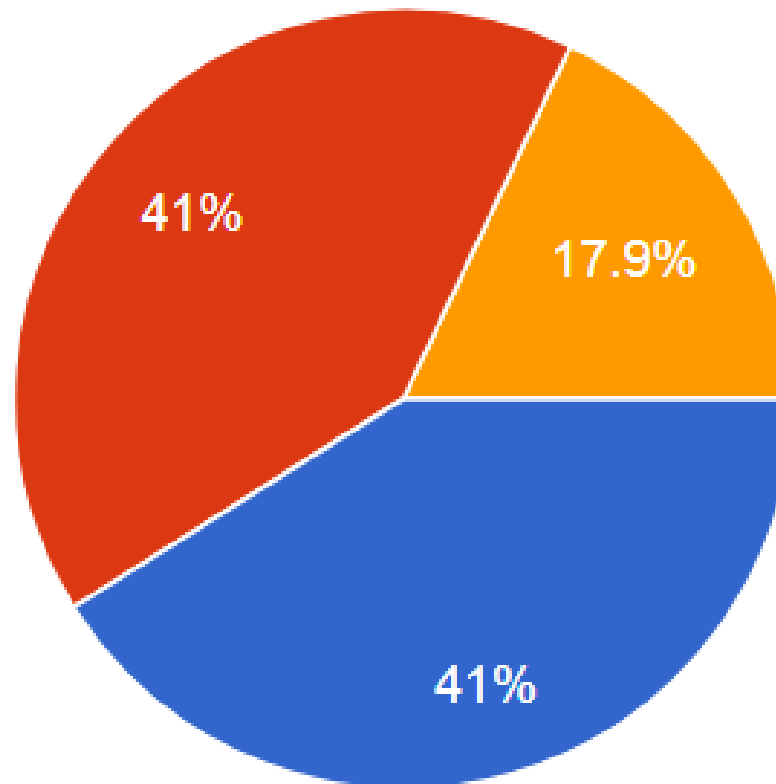


Generally, the funder understands that the universities must own the IP and this is generally viewed as non-negotiable.

Joint ownership of IP absent joint inventorship

17.9%

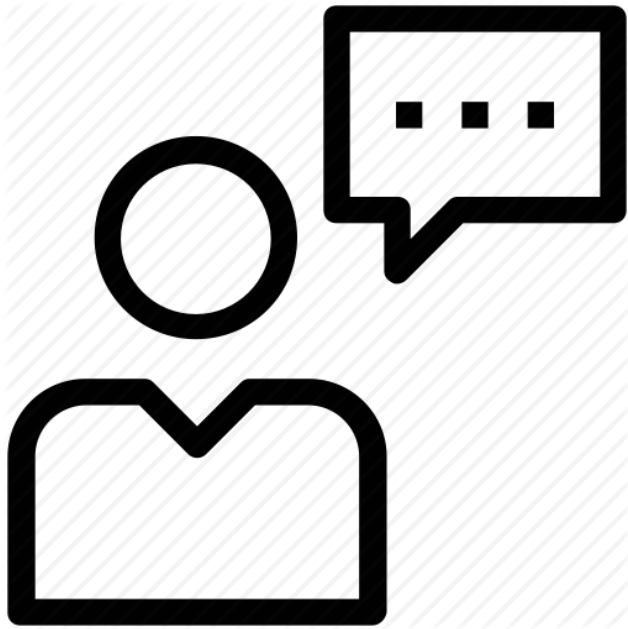
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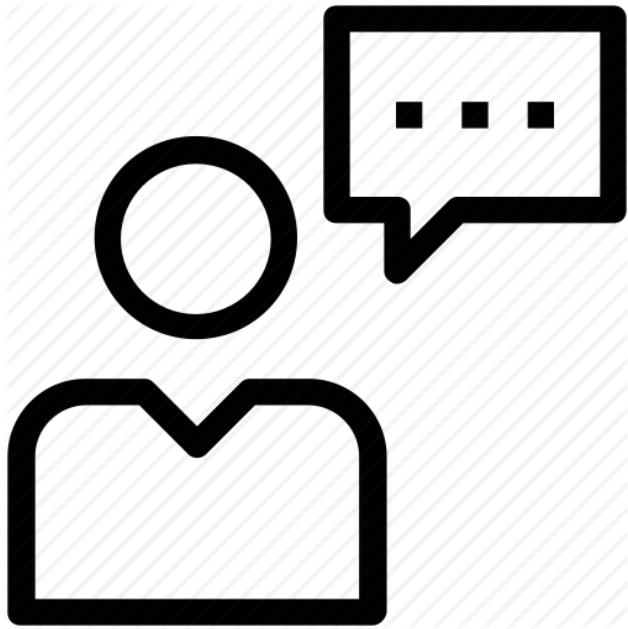
Your Comments



Generally foundations understand that universities own what we create.

Joint ownership of IP absent joint inventorship

Your Comments

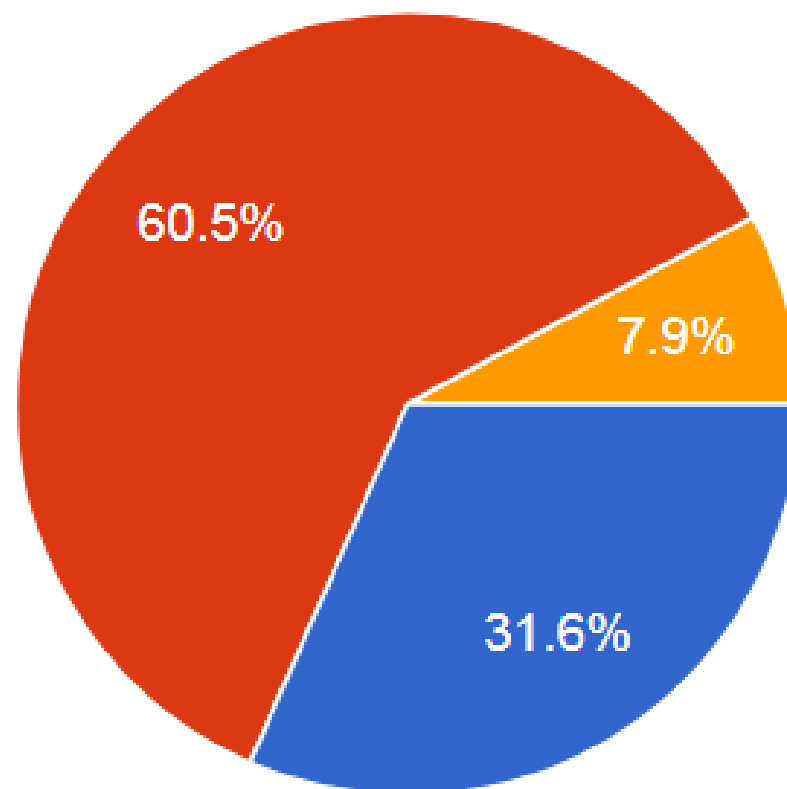


I view this is coupled with the preceding question; the funders generally understand that joint ownership absent joint inventorship is (with rare exception) a non-starter.

Patent decisions and patent costs; Costs for protection of IP

7.9%

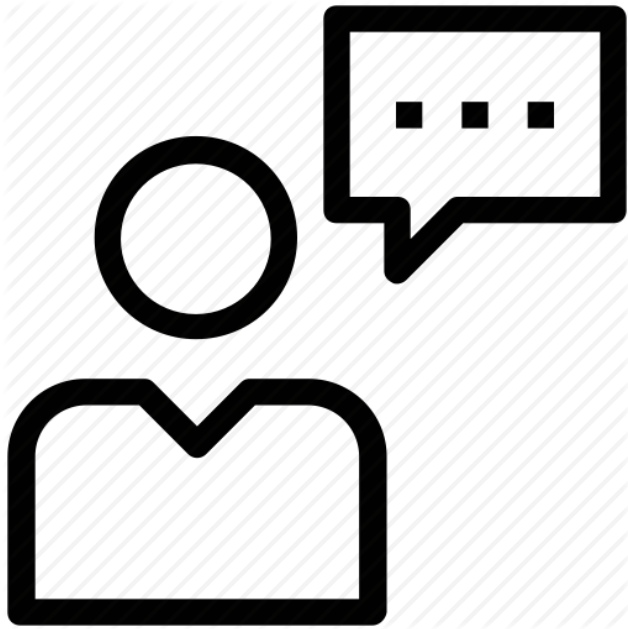
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Patent decisions and patent costs; Costs for protection of IP

Your Comments

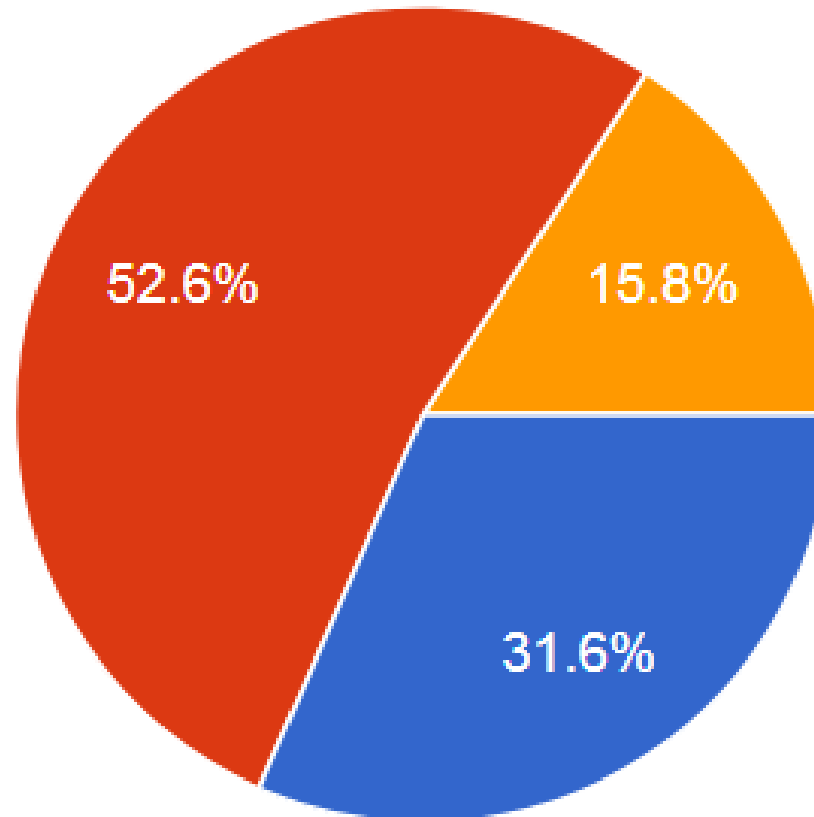


The funder wants broad rights
but generally never agrees to
pay for costs.

Research use of IP by funder or performer

15.8%

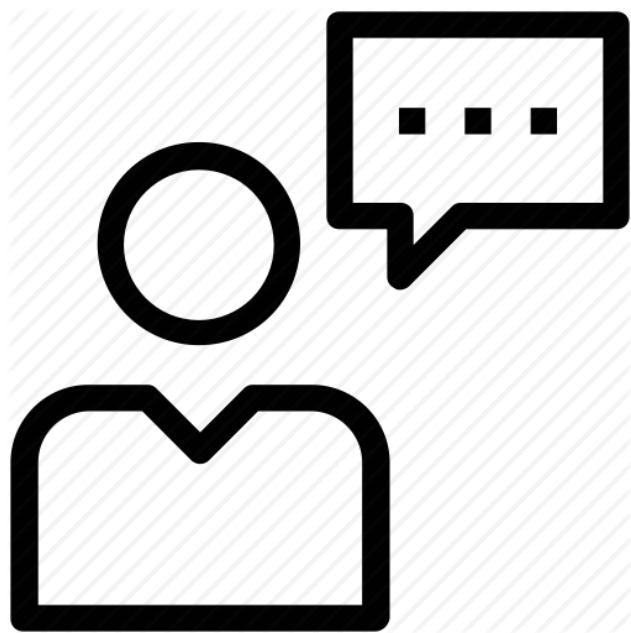
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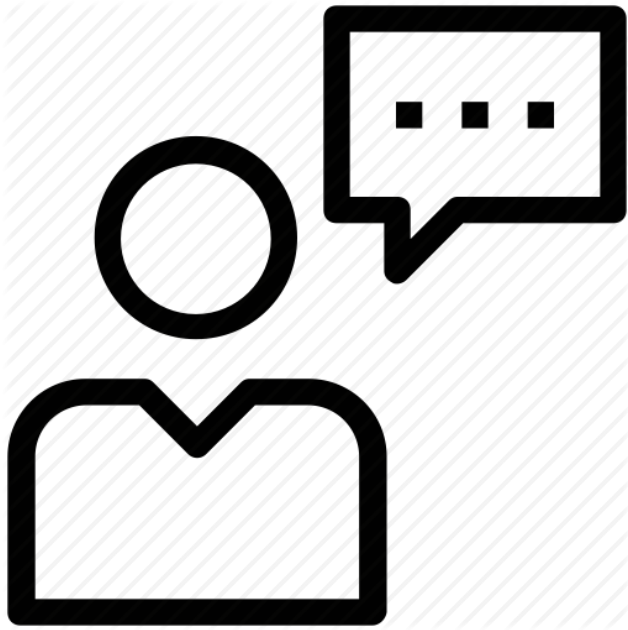
Your Comments



We retain the right to license IP as desired and it has never been an issue.

Research use of IP by funder or performer

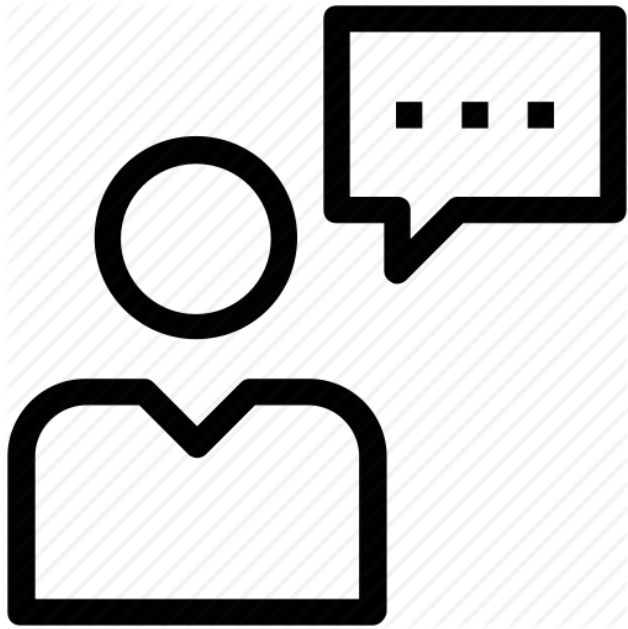
Your Comments



Right to use and allow others to use as well.

Research use of IP by funder or performer

Your Comments

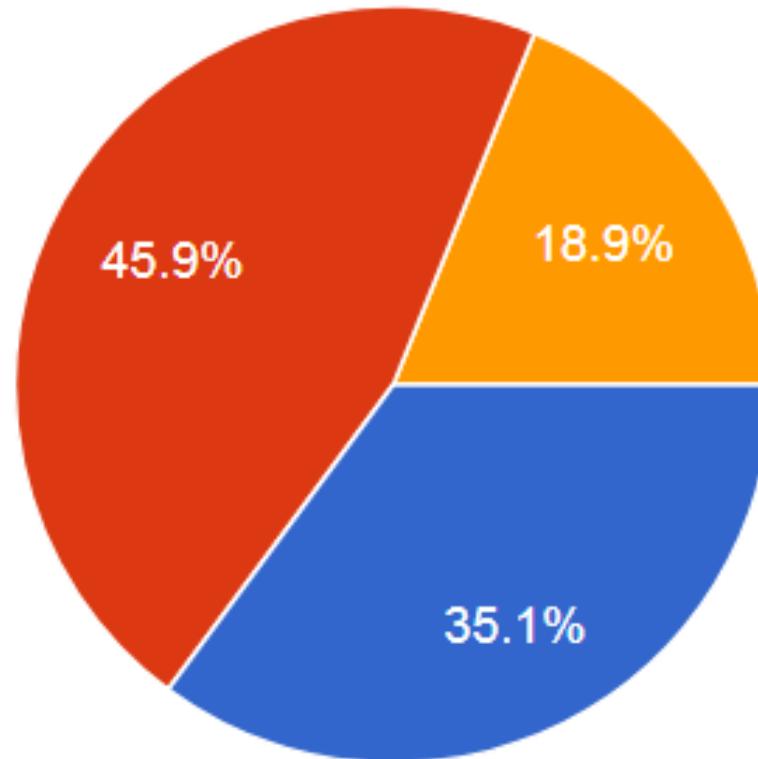


A recurring issue that I encounter is that many funders don't themselves have research operations and thus the research license needs to be sublicensable for research use; the right to sublicense sometimes makes the universities nervous.

Access to background IP

18.9%

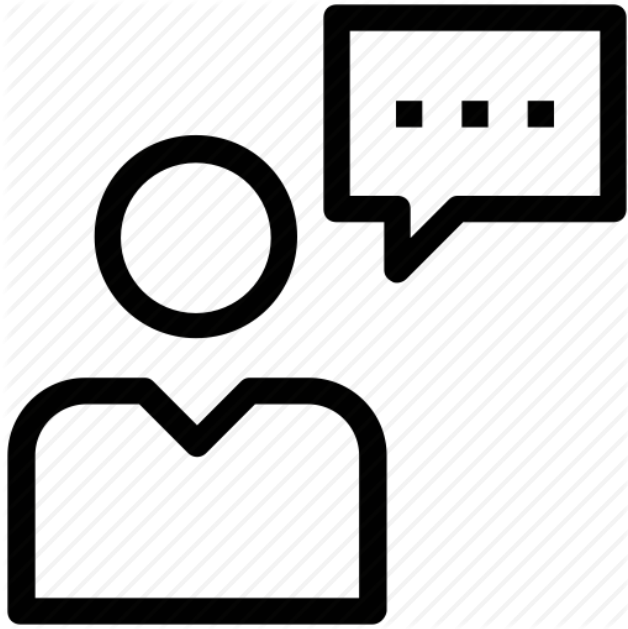
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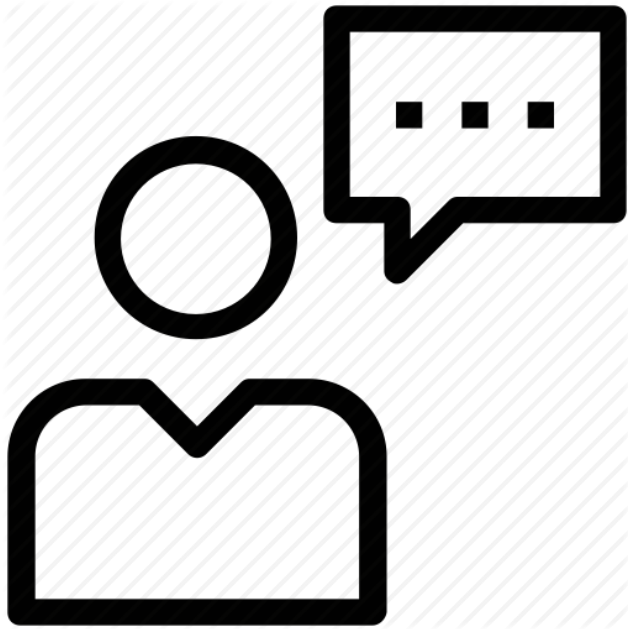
Access to background IP

Your Comments



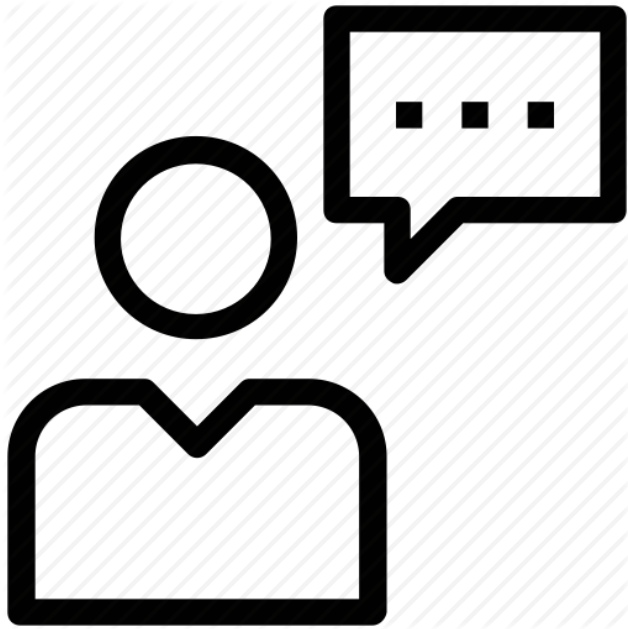
If this comes up, it can be difficult.

Your Comments



We experience it sometimes and in most cases the funder is not willing to negotiate. If a funder asks for access to any background IP required to practice any foreground IP, this could be a significant issue if we have obligations for such background IP or if the IP is exclusively licensed.

Your Comments

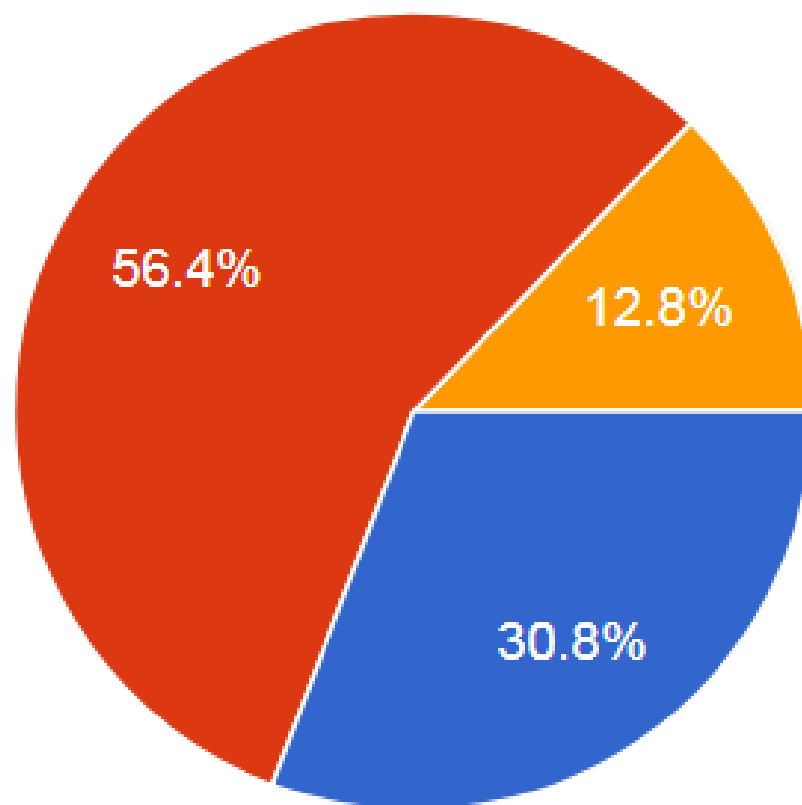


My experience is that foundations sometimes don't have a good idea of what background IP may exist in the field being funded, and how that may affect development and commercialization going forward.

Sharing of research materials

12.8%

- Sometimes or frequently the topic of negotiations; the parties often have difficulty coming to agreement

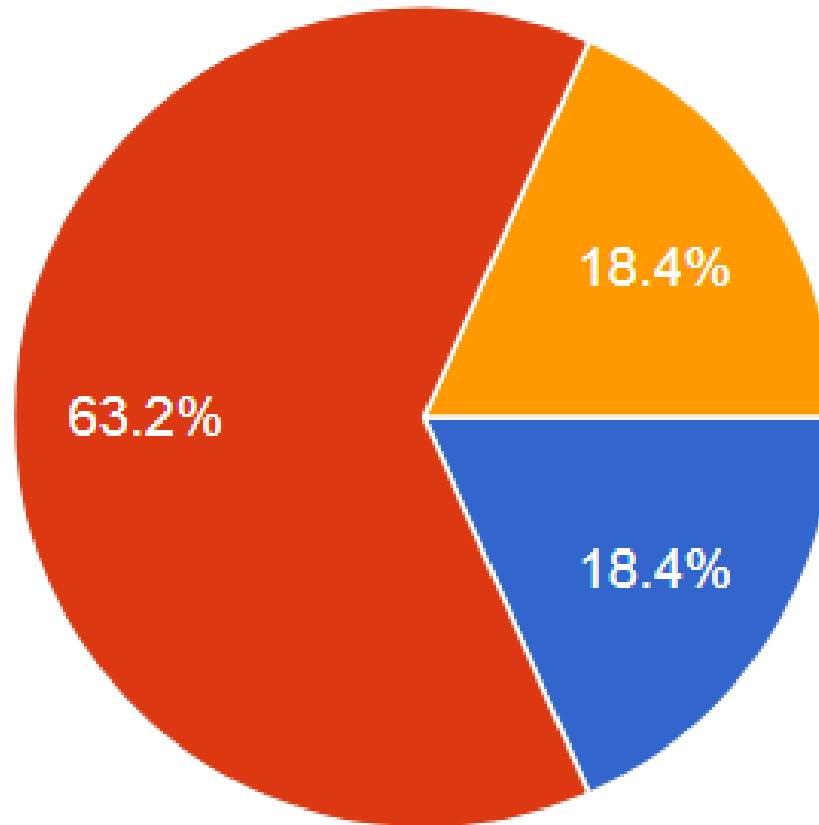


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Control of licensing

18.4%

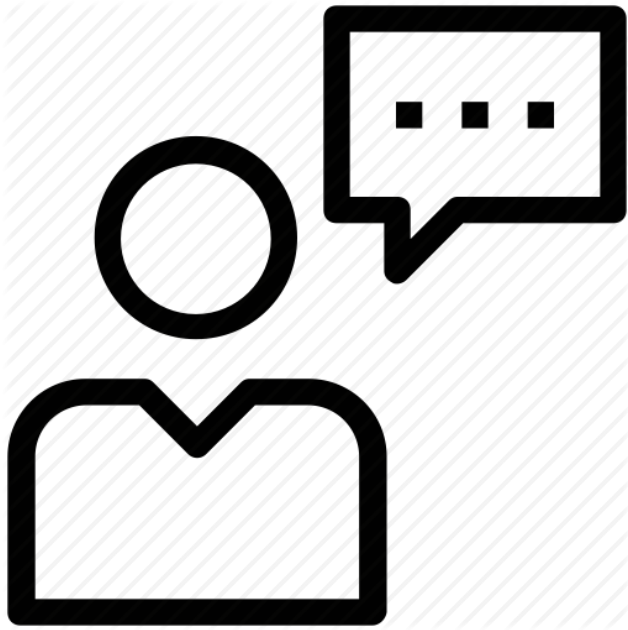
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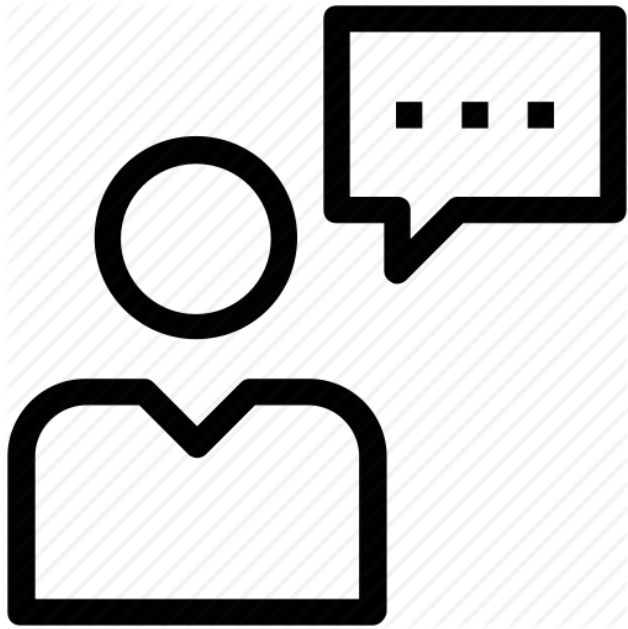
Your Comments



Time periods are usually the
topic of negotiation

Control of licensing

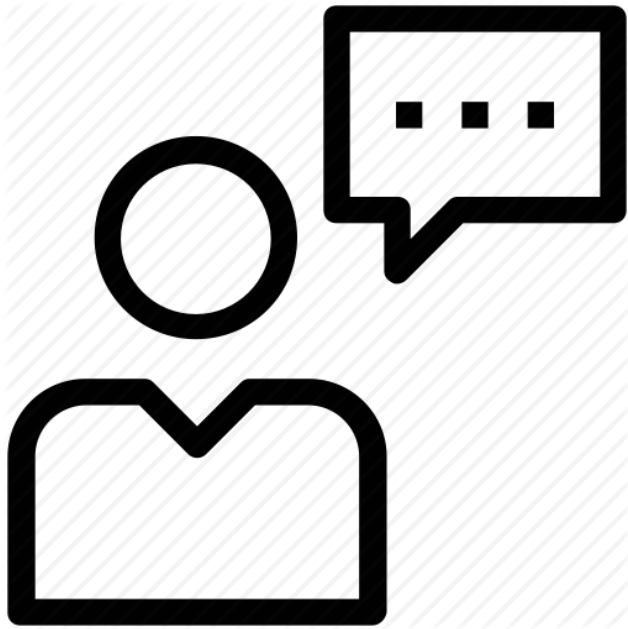
Your Comments



Funder seeks approval of patents but doesn't pay anything.

Control of licensing

Your Comments

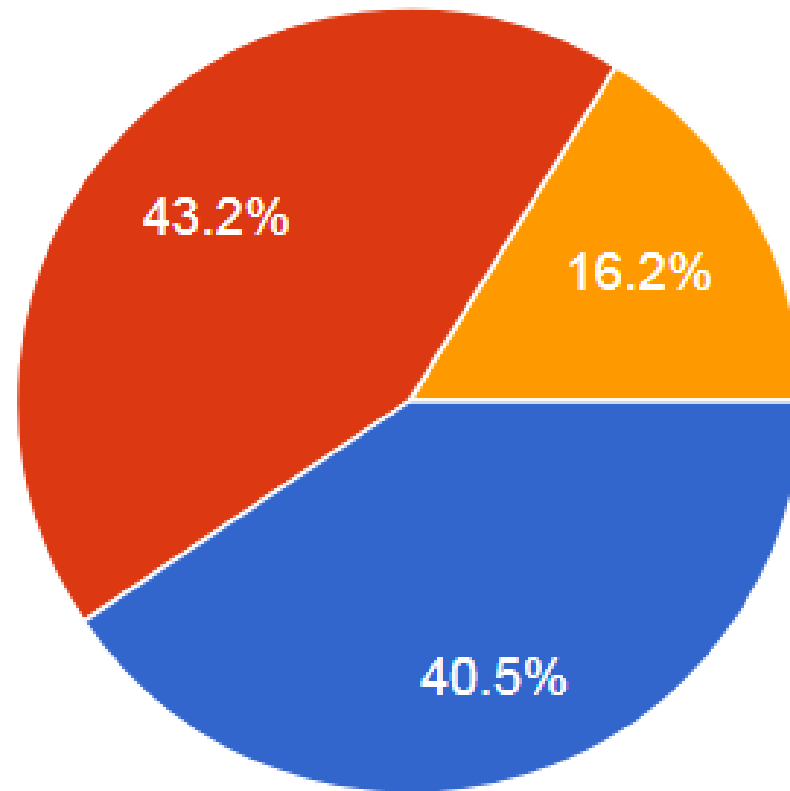


I'd rate this as the single most recurring issue I face with funders. Almost uniformly, foundations want to have some level of control over licensing decisions and it's often very hard to get to agreement on this point. I view this as one of the most critical issues that universities and foundations have to grapple with going forward as I think this trend is not going away.

Disclosure of licensing efforts

16.2%

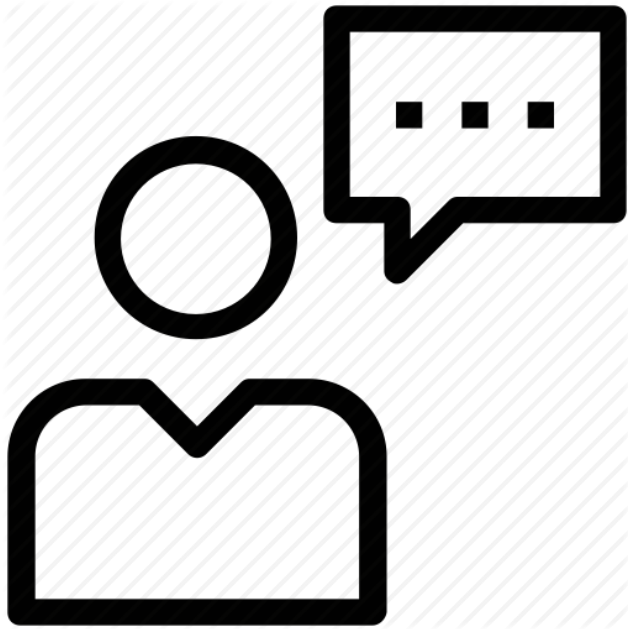
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Your Comments

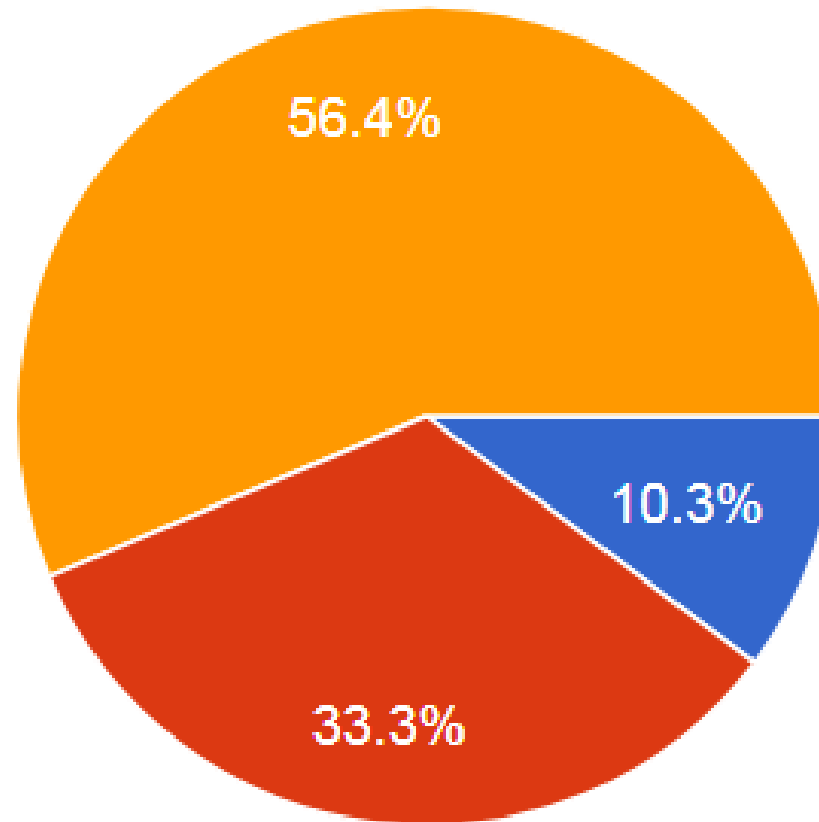


Similar to disclosure of inventions, this is rarely a negotiation topic but often something that in practice does not get disclosed to us as the funder.

Royalty issues / sharing / distribution; Use of royalties for future research

56.4%

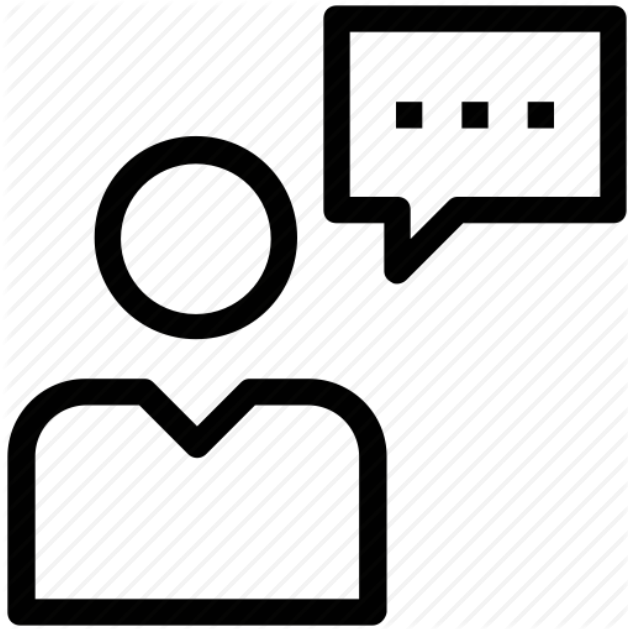
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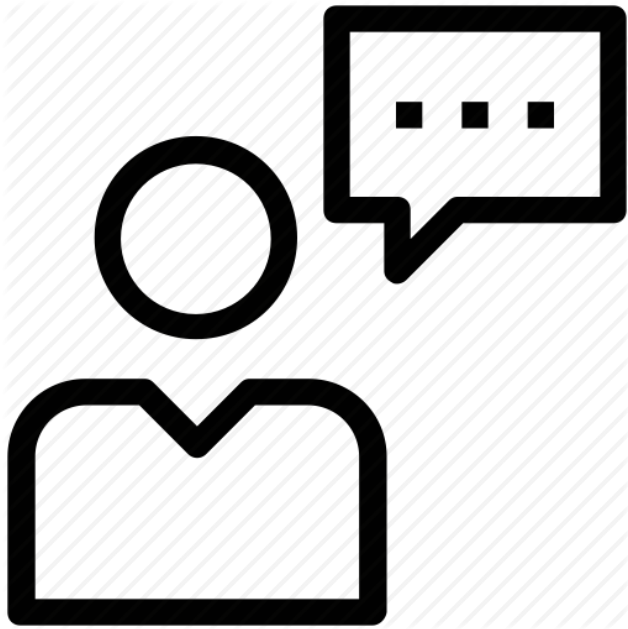
Your Comments



Although in most cases, this is non-negotiable so we end up accepting if the PI really wants the funds and is agreeable to terms. In one case recently we had to have a discussion with the Dean because the grant required a certain percentage of licensing income to be used for research in a specific disease area.

Royalty issues / sharing / distribution; Use of royalties for future research

Your Comments

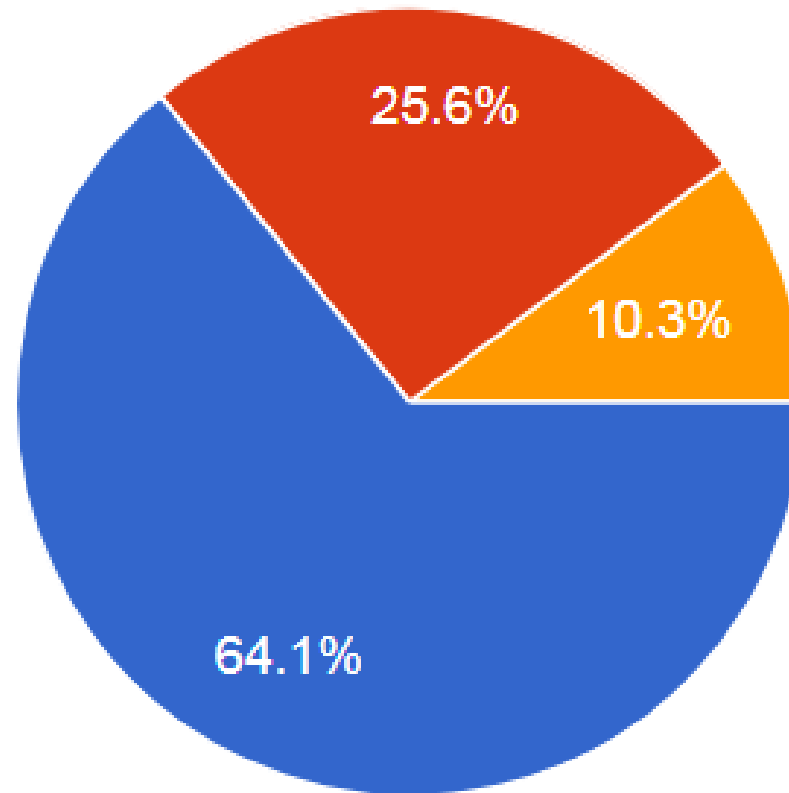


This is the most frequent issue and rarely do they budge on this. We have started to ask to recoup our F&A before sharing royalties. This worked in one case. It is a huge administrative burden and opens us up to risk for tracking and compliance.

Conflicts of interest

10.3%

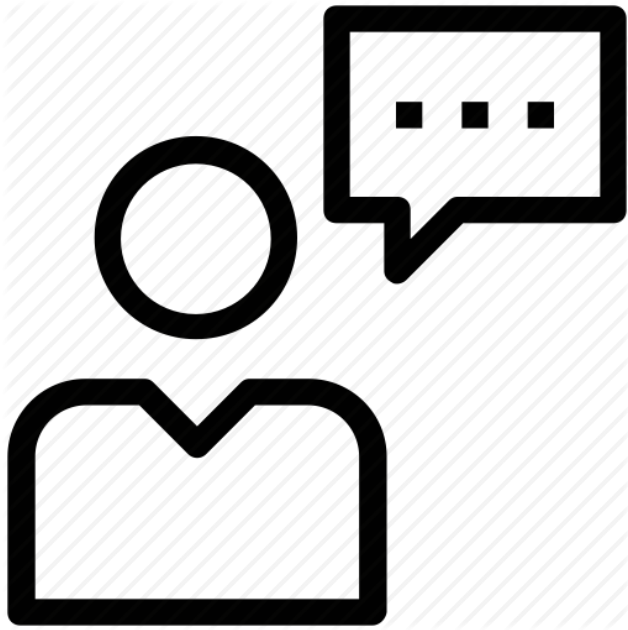
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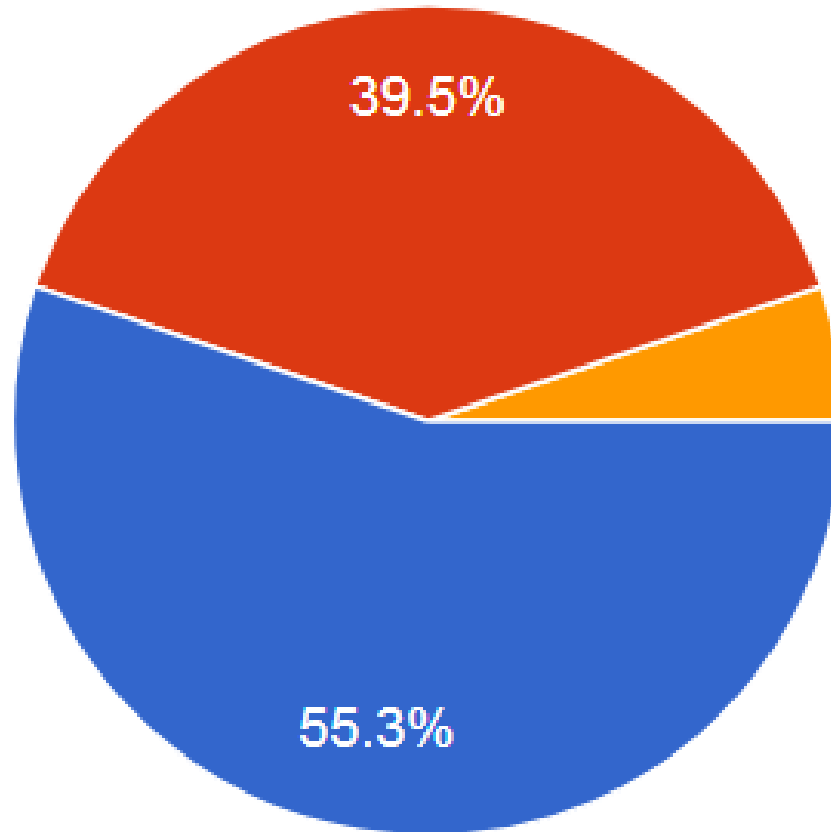


Seeing this more and more.

Disposition / Abandonment of patent protection

5.3%

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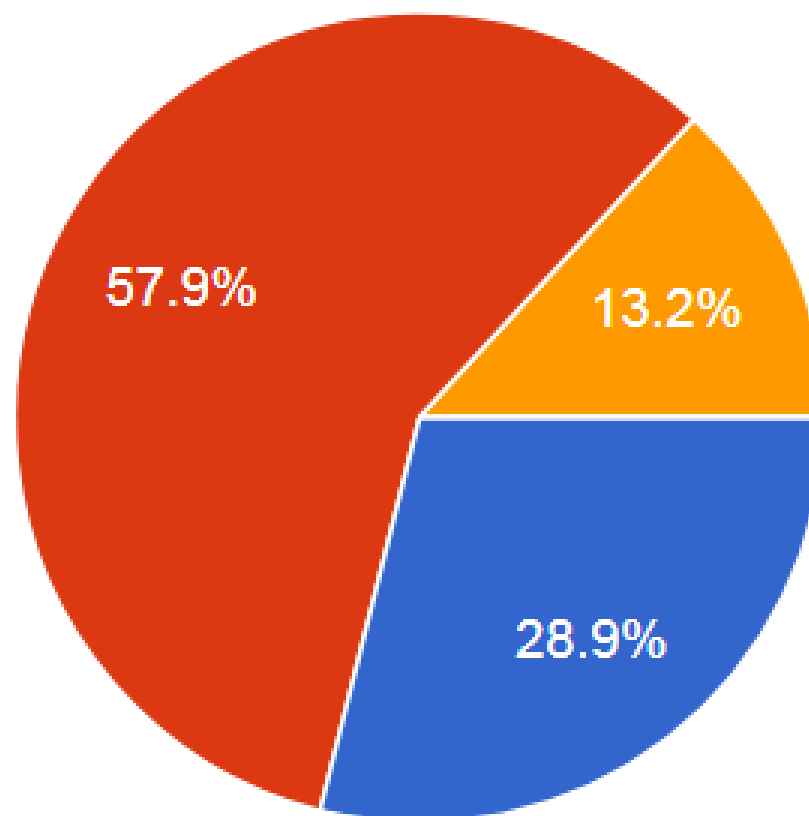


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Publication Rights (right of performers to publish research results; Right of funders to review publication for potentially patentable subject matter)

13.2%

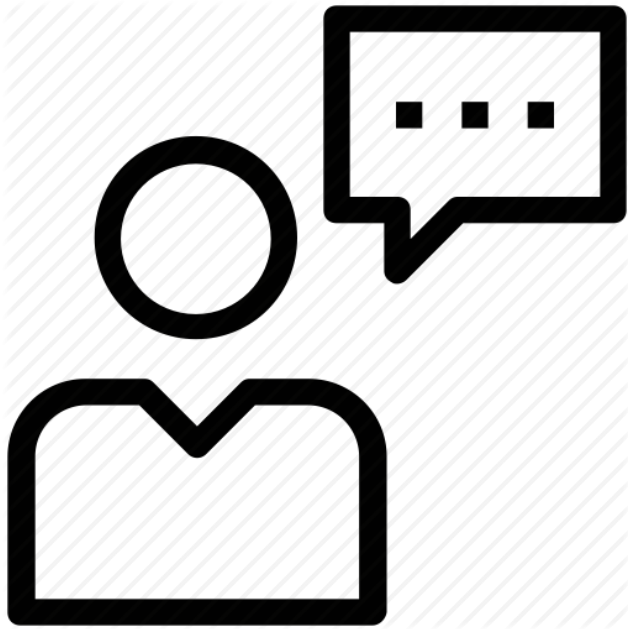
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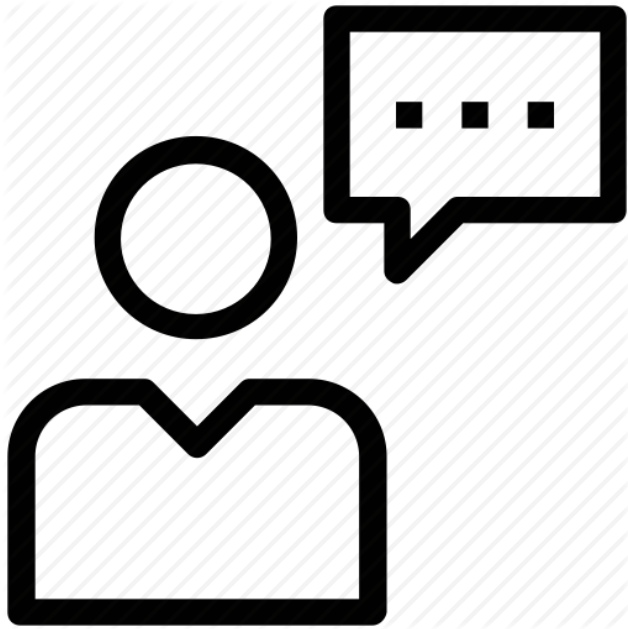
Your Comments



If there are problems it is generally because the sponsor wants an authorship attribution rather than an acknowledgement in the paper.

Publication Rights (right of performers to publish research results; Right of funders to review publication for potentially patentable subject matter)

Your Comments

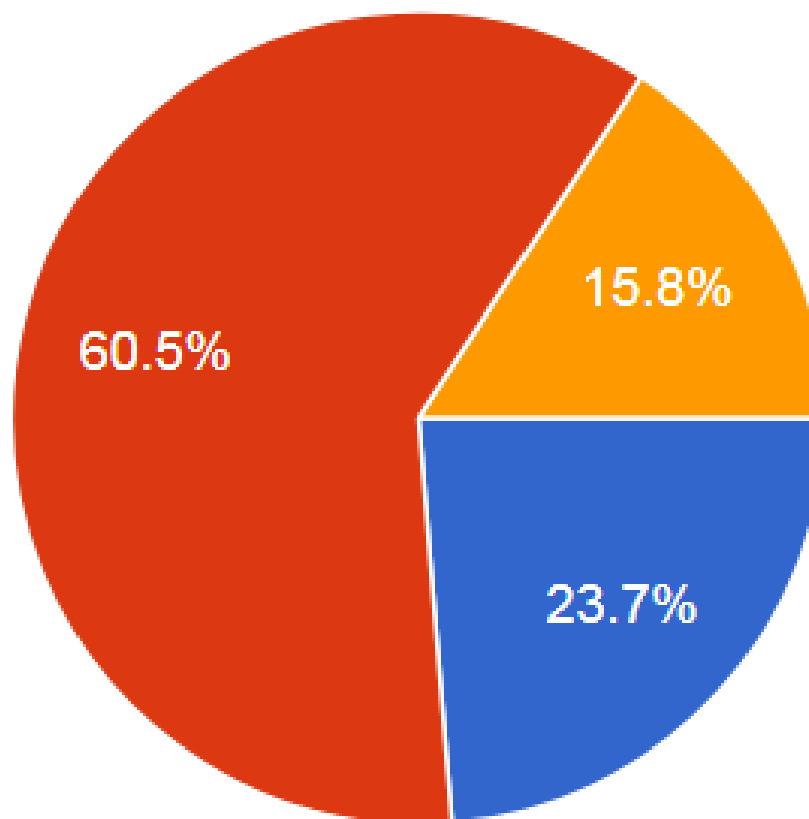


Usually they are pretty reasonable.

Ownership/disposition of other research results (e.g., data, prototypes, and other tangible and intangible research results)

15.8%

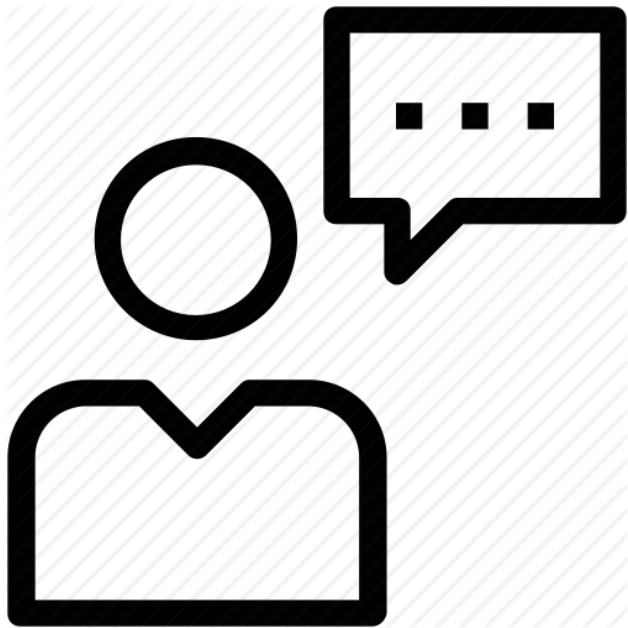
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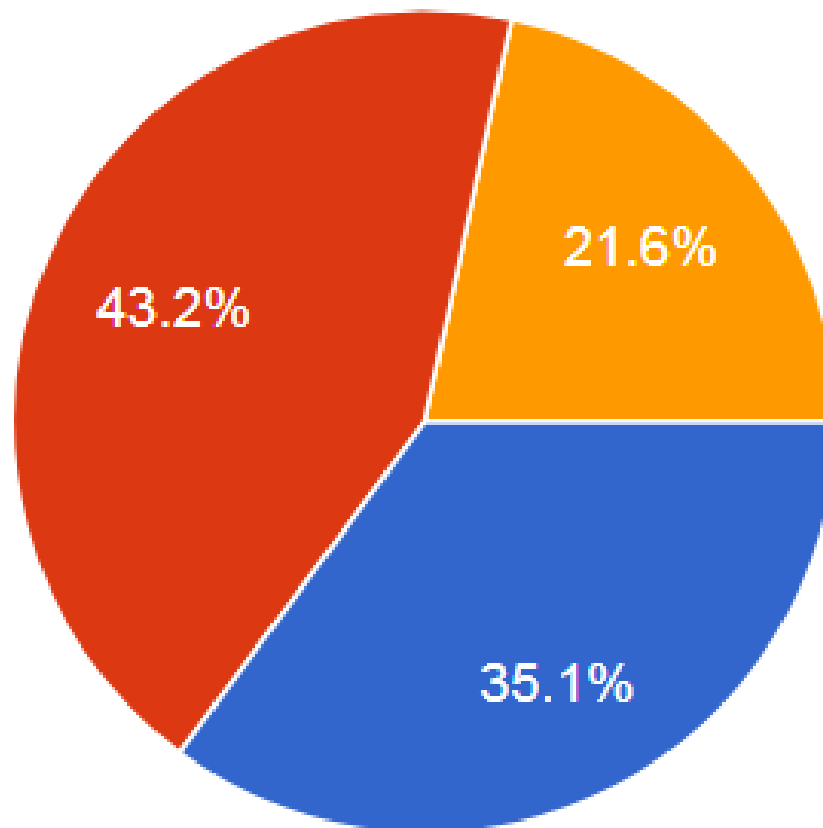


Again, hard to narrow what is subject to the terms. Often want unlimited rights to data. Some sponsors are now dictating very difficult data sharing terms that the faculty are concerned about (not enough time for them to get the datasets together and allow them to publish first). Also often they want unlimited rights to copyrights including the right to make derivative works, and refuse to indemnify us for their use.

Patient access to resulting drugs, devices, diagnostics and cures including requirements to flow license terms to licensees that require: (1) reasonable effort to assure patient access, (2) reasonable efforts to establish patient assistance program, (3) mechanism to assure patient access.

21.6%

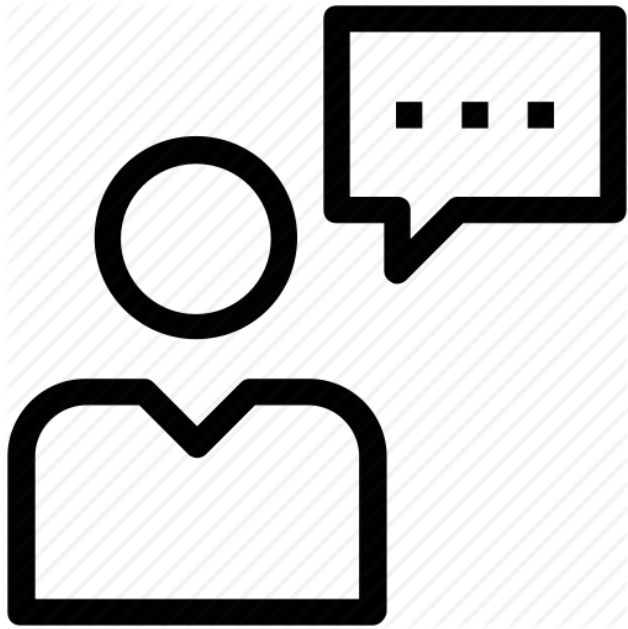
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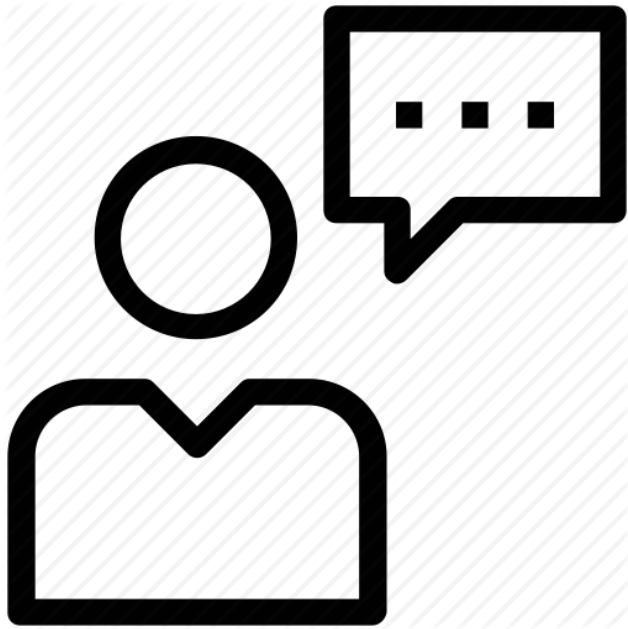
Your Comments



This is often not part of negotiations at the time of funding, however our foundation funds research in [one disease] and sometimes we have grantees who develop drugs with our funding that they later want to repurpose toward other conditions and not apply them to the [disease of interest to our donors], and then we get involved in trying to insist they pursue [the original purpose] or repay funds, and it gets very sticky.

Patient access to resulting drugs, devices, diagnostics and cures including requirements to flow license terms to licensees that require: (1) reasonable effort to assure patient access, (2) reasonable efforts to establish patient assistance program, (3) mechanism to assure patient access.

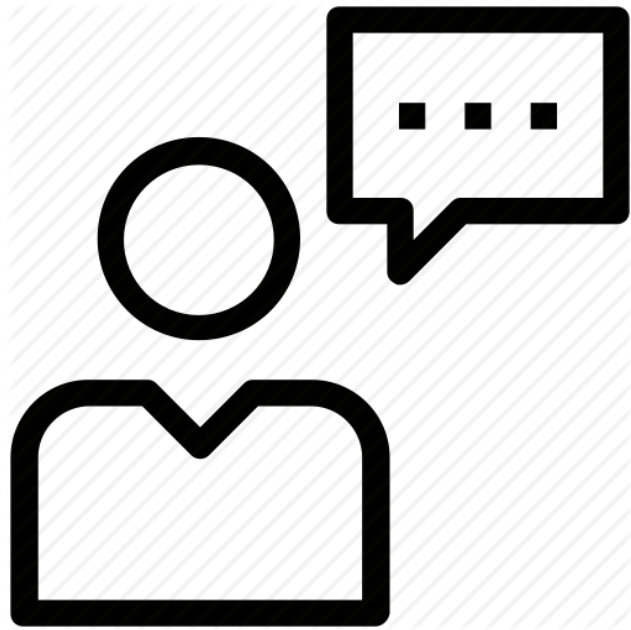
Your Comments



This is not generally difficult as long as reasonable effort is the standard.

Patient access to resulting drugs, devices, diagnostics and cures including requirements to flow license terms to licensees that require: (1) reasonable effort to assure patient access, (2) reasonable efforts to establish patient assistance program, (3) mechanism to assure patient access.

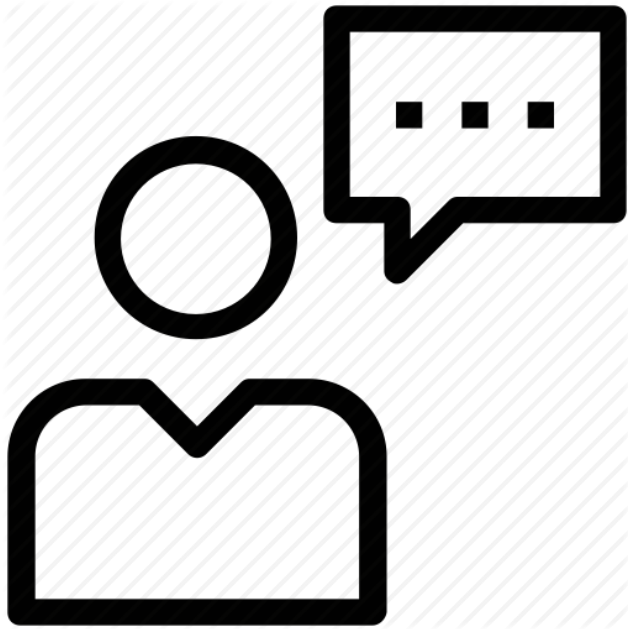
Your Comments



I have more seen this being accomplished through requiring us to agree to provide free (or very discounted) licenses to certain populations or business sectors.

Suggest or Describe Topics Not Included in Survey

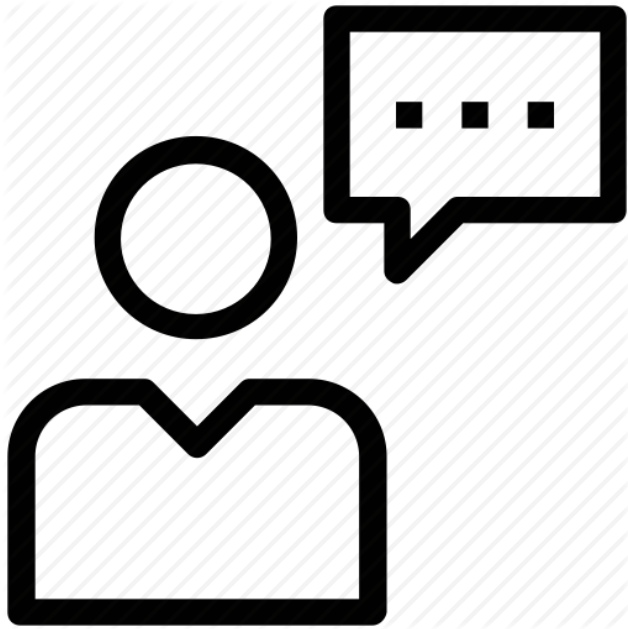
Your Suggestions



We have been approached by researchers who are employees of the NIH or other federal agency who are interested in pursuing foundation funding, but we have found it impossible to reach agreement around our terms and conditions. I'd be curious whether other funders have encountered this with government researchers and how they approached it.

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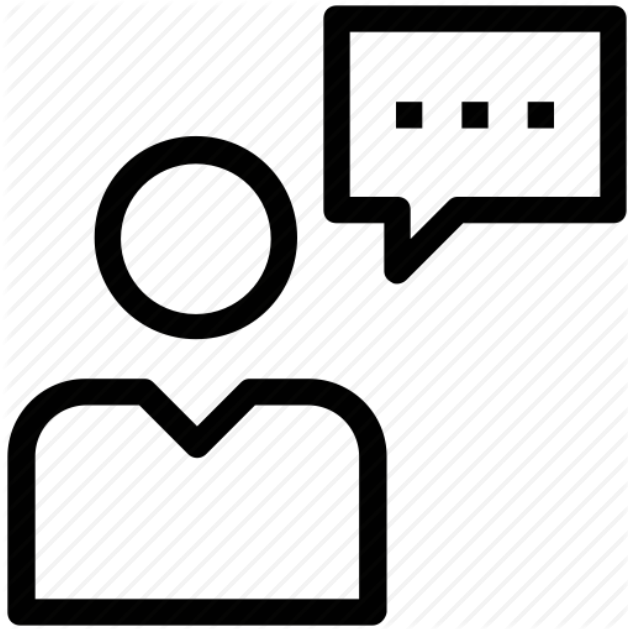
Your Suggestions



IP in regards to students working on a project. It would be interesting to discuss how each institution and funding agency views the issue of non-employees working on research projects and how that impacts the overall IP rights.

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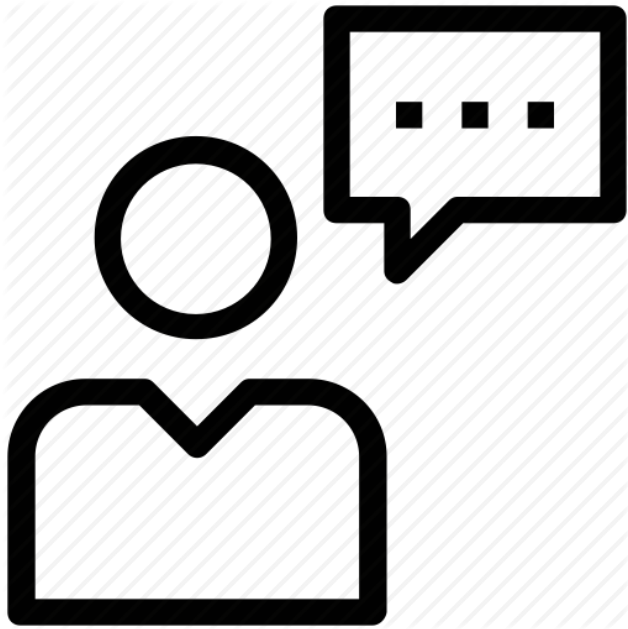
Your Suggestions



Not the topic of negotiations at all should be an option as a young grass roots funding organization. I just don't know all that I don't know to even begin to inquire about. Yes these items are discussed but not in the context of the grants we are awarding.

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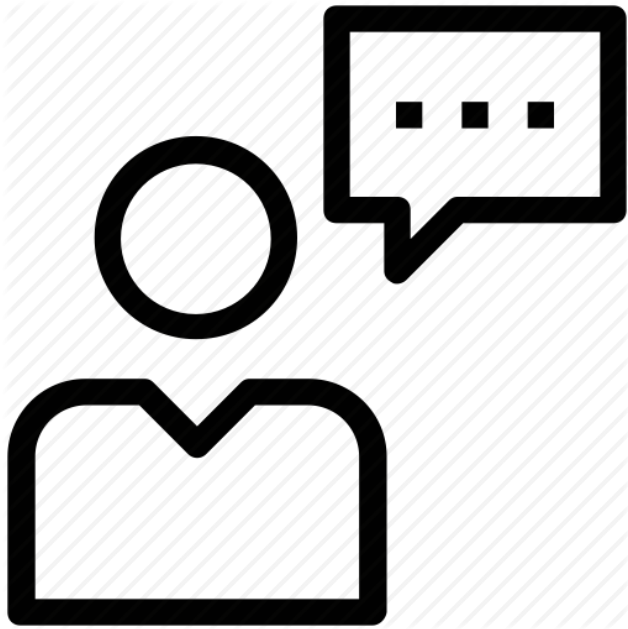
Your Suggestions



Non-patentable IP is a big problem. No control over what they decide to do with a copyrightable work. This could include study designs, publications, data, etc.

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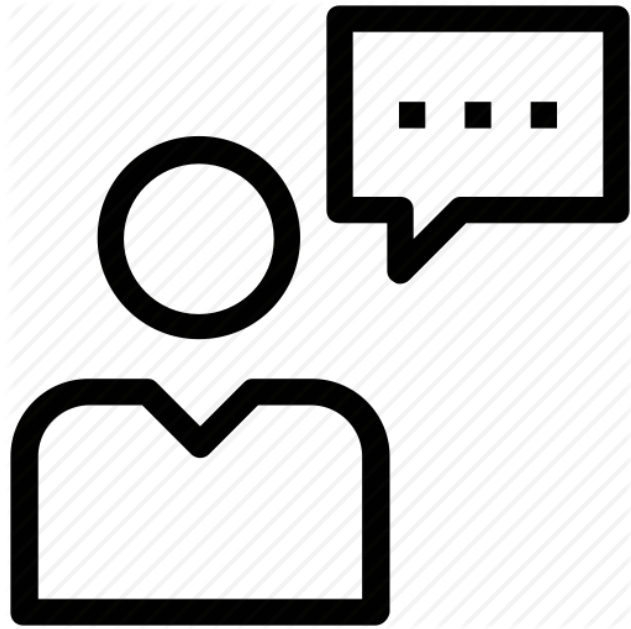
Your Suggestions



F&A recovery; if not fully recovered in the sponsored agreement then unreimbursed F&A should be retained before royalty sharing with sponsor.

Suggest or Describe Topics Not Included in Survey

Your Suggestions



Determining the basis if royalty sharing when the IP is developed from multiple funding resources - prefer a % of net royalties after patent and licensing expense, F&A recovery and a multiple of the \$ funded in the sponsored agreement.