

Frequently Asked Questions Regarding the October 2014 IP Assignment/Acknowledgment

Has the University's IP Policy changed?

The Patent Rights and Technology Transfer policy has not changed (<http://www.cfo.pitt.edu/policies/policy/11/11-02-01.html>); it was last revised in 2005.

Why is the IP assignment/acknowledgement agreement required?

Federal grants and contracts in support of research obligate the University to have written agreements with its faculty members who engage in federally funded research. The terms of the agreement are consistent with the terms in University Policy 11-02-01, Patent Rights and Technology Transfer, which were last revised in 2005. The policy is based upon the principle that faculty act on behalf of the University when conducting research and when working with University resources.

Do these IP agreements change my ownership of "Scholarly Works" under the copyright policy?

No. The University's Copyright policy (11-02-02) has not changed and allows you to retain your ownership of "Scholarly Works," as defined in the Copyright policy.

Who needs to sign an IP assignment agreement or IP acknowledgement agreement?

Any new faculty member must sign either the assignment or acknowledgement agreement. In addition, anyone who is a Principal

Investigator (PI) or co-Principal Investigator (co-PI) that does federal funded research must sign an agreement. Any PI or co-PI on a federal grant submission must have signed an agreement in order to submit a proposal through the university. Anyone who signed a form on or after December 1, 2011 may not be required to sign a new 2014 form. Contact Sandy Latini via email at the Office of Technology Management (latini@otm.tt.pitt.edu) if you have any questions.

What is the difference between an IP assignment versus an IP acknowledgment?

The IP assignment agreement assigns to the University ownership of intellectual property covered by University policy. This protects the interests of the government, the University, and other sponsors of your research as well as your own interest should you inadvertently assign rights to a third party, as was the case in *Stanford v Roche*. Signing this agreement also will facilitate processing of third-party agreements that require the University to demonstrate ownership of intellectual property developed under the contract, as is often the case with material transfer agreements and corporate contracts.

The IP acknowledgement agreement also fulfills the University's obligations to federal agencies to have written agreements regarding intellectual property rights in place with persons working on federal grants and federal contracts. By signing this acknowledgement agreement, you will agree to take steps necessary to protect sponsor's rights in the intellectual property developed through funded research, including abiding by University policy regarding patent rights and technology transfer (Policy 11-02-01), and your responsibilities to disclose inventions. This agreement also confirms that you have not entered into other agreements that would limit your ability to meet this obligation.

How does signing the IP assignment agreement protect a faculty member's economic interests in University owned IP?

Executing the IP assignment agreement protects faculty members' proprietary interest in the patents and inventions faculty develop while working for the University. The University's two IP policies (11-02-01 and 11-02-02) provide a share of license proceeds to faculty inventors and developers of University-owned intellectual property (30% for patent rights and 50% for copyrights). If the University is not able to secure its rights and title to University intellectual property through a present assignment of rights, the University's interests (and consequently, the faculty member's interest in any proceeds) may be jeopardized. For example, if a faculty member inadvertently assigns University rights to a third party prior to the University securing a present assignment from all the University inventors/developers, then that third party could obtain intervening rights and potentially displace the University and faculty rights.

How will the executed IP assignment/acknowledgement agreement affect faculty consulting?

The IP agreement does not affect the University policy for outside work <http://www.cfo.pitt.edu/policies/policy/02/02-06-01.html>, including consulting, or the process for internal review and approval of these activities. It also does not have any effect on the IP waiver process, if a waiver is included as part of an approved consulting agreement.

However, if an IP waiver is granted in connection with consulting activities, that waiver will apply only to the specific IP described. The IP assignment agreement would continue to govern all other intellectual property.

Where do the new IP Assignment Agreements go once signed?

All original and executed forms are to be collected by each School, and then forwarded to Sandy Latini at the Office of Technology Management.