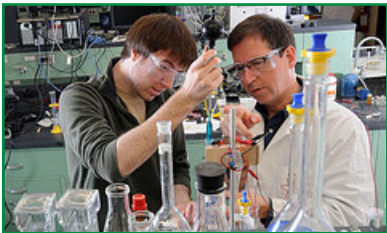




IP Concerns in Research and Consulting

Will a researcher be able to publish the results of the research and still protect the commercial value of the associated intellectual property?

Yes, but because patent rights are affected by these activities, the TTO recommends submitting an invention disclosure well before a researcher communicates or discloses an invention to people outside the university. There are significant differences between the U.S. and other countries as to how early publication affects a potential patent. Once publicly disclosed (published or presented in some form), an invention may have restricted or minimal potential for patent protection outside of the United States. A researcher should therefore inform the technology transfer licensing specialist assigned to assist the researcher about any imminent or prior presentation, lecture, poster, abstract, website description, research proposal submission, dissertation/master's thesis, publication, or other public presentation that includes the invention.



When can a university researcher share materials, research tools, or intellectual property with others to further his/her research?

If a university researcher wishes to send materials to an outside collaborator, an outgoing MTA should be completed. It may also be necessary to have a non-disclosure agreement completed to protect the research results or intellectual property. A technology transfer representative can assist in completing the outgoing MTA or non-disclosure agreement. Technology transfer representatives can be reached at (573) 341-4690 or by visiting:

<http://ecodevo.mst.edu/info/ttohome/>

This information is taken from the University of Michigan's "Inventor's Guide to Technology Transfer," with adaptations for the University of Missouri. We are very grateful to Ken Nisbit and the staff of the University of Michigan Office of Technology Transfer for granting permission to use their excellent material and to the University of Michigan for permission to use its copyright.



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What rights does a research sponsor have to any discoveries associated with university research?

The sponsored research agreement should specify the intellectual property (IP) rights of the sponsor. The university generally retains ownership of the patent rights and other intellectual property resulting from sponsored research. However, the sponsor may have rights to obtain a license to the defined and expected outcomes of the research. Often, sponsored research contracts allow the sponsor a limited time to negotiate a license for any patent or intellectual property rights developed as the result of the research. Even so, the sponsor generally will not have contractual rights to discoveries that are clearly outside of the scope of the research. Therefore, it is important to define the scope of work within a research agreement.

The campus research office works closely with the TTO on IP issues in sponsored research agreements. For questions about sponsored research, please contact the applicable sponsored research representative.

What about consulting?

When researchers enter into consulting agreements, they are deemed to be acting outside of the scope of their employment. Therefore, consulting arrangements are not negotiated by the university nor formally reviewed by the TTO or research office. Researchers who enter into consulting agreements should familiarize themselves with the policies of the university that pertain to consulting activities. The researcher is expected to ensure that the terms of the consulting arrangement are consistent with university policies, including those related to IP ownership, employment responsibilities, and use of intellectual property. The TTO is available to provide informal advice on how a consulting agreement relates to the university's intellectual property. For more information regarding university policy on consulting, visit:

http://www.umssystem.edu/ums/rules/collected_rules/personnel/ch330/330.015_policy_on_conflict_of_interest

