

Determination of Inventors and Distribution of Licensing Income

I. Inventorship

Inventorship will be determined according to United States patent laws and is tied to inventive contributions made by University Employees to claims in pending or issued patent in the United States and/or other countries. In order to be an Inventor, a University Employee would have to ultimately make an inventive contribution to one or more of the claims contained in an issued patent. This guidance document addresses a process for determining Inventors starting early in patent prosecution since Licensing Income may be received by the University prior to the issuance of a patent.

Provisional patent applications will be filed in the name of the first principal investigator listed on the Research Disclosure Form. Prior to conversion of the provisional patent application the Division of Technology Management (DTM) will ask the patent attorney assigned to the case to review the contributions of each investigator as detailed in the Research Disclosure Form and other documents used to prepare the patent application in light of the claims in the pending patent application. The patent attorney may interview one or more of the investigators as needed in order to obtain additional background information. The attorney will notify the DTM of his/her findings and the DTM will notify each investigator listed on the Research Disclosure Form in writing. As the patent prosecution proceeds, inventorship may change based on the pending claims. The DTM will work with the patent attorney to identify changes to inventors and will notify the inventors of such changes.

II. Distribution of Licensing Income

A. Distribution – distribution of Net Licensing Income will be made quarterly, according to the Patent and Invention Policy in effect at the time of filing of the first Research Disclosure of the licensed technology. Deviations from the policy must be approved in advance in writing by the Vice Chancellor for Research and Sponsored Programs.

B. Inventors - Inventors will share Net Licensing Income equally unless they have signed an intellectual property sharing memorandum prepared by the DTM that provides for a different distribution.

C. Non-Inventors

- a. In rare situations one or more Non-Inventors will make a significant contribution to the development of a technology and should be considered for receiving a share of the Net Licensing Income. In such cases the Director of the DTM will present the facts to the Intellectual Property Management Group for the Life Sciences or the Intellectual Property Management Group for the Physical Sciences and Engineering as applicable. The Intellectual Property Management Group will make a recommendation to the Vice Chancellor for Research and Sponsored Program who will make the final decision.
- b. It is expected that any share approved for distribution to one or more Non-Inventors will come from the Inventor's share of Net Licensing Income. The DTM will prepare an intellectual property sharing memorandum for approval by all the Inventors.

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- c. In rare circumstances it may be appropriate to reward Non-Inventors by distributing a portion of the share of Net Licensing Income distributed to the Dean's Office, the Department or Center, and/or the Office of Research and Sponsored Programs. In such cases the Director of the DTM will notify the affected parties in writing.
- d. Any distribution of Net Licensing Income to Non-Inventors will be documented in an intellectual property sharing memorandum signed by the Inventors, the Non-Inventors, and appropriate administrators.