

OSP Roundtable Discussion

**Topic: “Intellectual Property”
October 4, 2007**

1. If a PI signs an Agreement, is he recognized as the legal representative?

The PI does not have the legal authority to sign any Agreement on behalf of MIT.

2. How does a Non-Disclosure Agreement (NDA) relate to the intellectual property issues?

As MIT’s standard policy and practice, IP issues are not set forth in an NDA. Instead, any IP issues should be negotiated as terms and conditions of a sponsored program agreement. The purpose of an NDA is to keep confidential the communication and exchange of information from both parties for the purpose to evaluate opportunities or mutual interest and to further define the scope of research prior to entering into a sponsored research agreement.

3. How does the NDA relate to MIT’s sponsored research?

It is important to realize that confidential information may be exchanged under a research agreement and as a result there are non-disclosure terms in our Standard Research Agreement. The use of confidential information in a research agreement does not affect the reporting or results of the research and should have minimal impact on MIT intellectual property arising from the research.

4. Has MIT run into concerns about graduate students who can not publish because of an NDA?

It is rare for this issue to occur. It is MIT’s general research policy to prompt and open dissemination of the results of MIT research and the free exchange of information among scholars and that includes the ability of graduate students to publish their results and thesis. In order to avoid such a situation and to assure that MIT graduate students can publish their research results, the terms in an NDA or a corresponding sponsored research agreement has to be carefully negotiated and drafted.

5. Have you ever thought a PI was signing away too many rights, restricting his right to publish?

OSP is constantly involved in the negotiation process to ensure that concessions that may be suggested or made are consistent with MIT policy. It is always important for OSP to listen to the views and concerns of Investigators and advise them on the best steps to reach a mutually agreeable contract between MIT and its Sponsors.

6. Can a researcher sign their own NDA?

In a sponsored program, the Sponsor enters into contract with MIT, not individual researcher. A researcher is asked to fill out an NDA questionnaire which provides OSP the necessary information to negotiate the contract. The researcher also states how he/she plans to protect the information once it is received on campus. Sometimes other members of the research team may require access to the confidential information and the researcher is charged with

informing any team members of the obligations MIT has taken to protect such information. If NDAs were signed by individuals all members of the research team requiring access to such information on campus would be required to sign their own contract. Further, this practice would open up personal liability issues for those with individual obligations to various sponsors.

7. Is there a 5-day deadline in the process of the background IP check?

The background check does not hold up the proposal.

8. How do we deal with a sponsor who has providing funding for a research project and as a result wants to own all of the IP?

Although we retain title to the IP, we offer licensing options that are embedded in the research agreement or contract.

9. When we talk about background IP, is that information from the same research group?

MIT's policy is that background IP is specific to the investigator. Background IP is checked by TLO. If multiple investigators are participating in one project, then the portfolios of all investigators are reviewed.

10. Is there a good place to go to look up information on the process or policy?

<http://web.mit.edu/tlo/www/>

http://web.mit.edu/osp/www/resources_policy.htm

<http://web.mit.edu/ogc/>

11. How closely do OSP people work with the General Counsel office? At what point do matters rise to the level where legal counsel is involved?

We have one General Counsel's office for the entire Institute. Any member of the MIT community can contact the Office of the General Counsel. OSP collaborates with OGC regularly about various legal issues.