

Who owns my intellectual property?

Navigating MIT Ownership of Intellectual Property Policy

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Technology Licensing Office



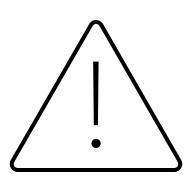
What is intellectual property?

The fruits or product of human creativity
that may be protected under the law

- Inventions
- Literary and artistic works
- Code
- Symbols, names, images, and designs

Intellectual property is protected by:

- Patents
- Copyrights
- Trademarks



Why Protect IP?

- Stimulate and promote further innovation and creativity
- Benefits creators and society
- Mission of the TLO – to disseminate via technology license

With Limits:

Patent is good for 20 years from the date of the filing of the patent application

Intellectual Property Policy at MIT

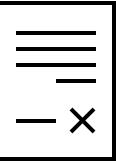
The aim of the Institute's policy on patents, copyrights, and other Intellectual Property is to make available Institute technology to industry and others for the public benefit, while providing recognition to individual inventors and encouraging the prompt and open dissemination of research results.

WHY

The federal government, research sponsors require MIT to own and control certain intellectual property as a condition of receipt of funds.

HOW

All members of the MIT community – including visiting scientists and fellows – who participate in either sponsored research or Institute-funded research or who use significant funds or facilities administered by the Institute must agree to the terms in MIT's Invention and Proprietary Information Agreement and sign the agreement.



The Why: Foundational to Research Sponsors

- Federal regulations (35 U.S.C. 18 § 200-212, the “Bayh-Dole” Act) and contracts with research sponsors, external collaborators, and third-party providers of resources used in MIT facilities (e.g., data, equipment, or software) specifically require MIT to direct the disposition of intellectual property produced during MIT research projects.
- Sponsored research agreements
- IP Rights in Exchange for Funds. Common rights granted:
 - Government non-exclusive license
 - Sponsor internal use and option to exclusive license
 - MIT required to own IP

The How: Inventions & Property Information Agreement (IPIA)

What is the IPIA?

- Contract between MIT and inventors
- Establishes assignment to and ownership by MIT of intellectual property created by the inventor using significant MIT funds or resources
- IP is protected and can be utilized by the inventor to create a patent

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Massachusetts Institute of Technology
Inventions and Proprietary Information Agreement

Legal Name (please print or type): [] MIDDLE: LAST:
MIT ID No.:
Birth Month/Day (year of birth is not required):
Email address:
Department:

*All items above are **required** and must be completed in full before returning to the Technology Licensing Office

This agreement is made in consideration of the following:

- my continuing or anticipated employment at the Massachusetts Institute of Technology ("MIT"); and/or
- my performance of research at MIT; and/or
- opportunities made or to be made available to me to use MIT's funds, facilities or other resources.

In exchange for the consideration listed above:

A. I will disclose promptly to and assign to, and I hereby assign to, MIT all rights to all inventions, copyrightable materials, computer software, semiconductor mask works, tangible research property, and trademarks ("Intellectual Property") conceived, invented, reduced to practice, or authored by me, either solely or jointly with others, which:

- (i) are developed in the course of or pursuant to a sponsored research or other agreement in which I am a participant as defined in Part 2 of the Technology Policy Guide; or
- (ii) result from the significant use of MIT administered funds or MIT facilities as defined in Paragraph 2.1.2. in the Technology Policy Guide; or
- (iii) result from a work-for-hire funded by MIT as defined in Paragraph 2.1.3 of the Technology Policy Guide.

B. I will execute all necessary papers and otherwise provide proper assistance, promptly upon MIT's request and at MIT's expense, during and subsequent to the period of my MIT affiliation, to enable MIT to obtain, maintain, or enforce for itself or its nominees, patents, copyrights or other legal protection for such Intellectual Property.

C. I will prepare and maintain for MIT adequate and current written records of all such MIT Intellectual Property.

D. I will deliver promptly to MIT when I leave MIT for whatever reason, and at any other time as MIT may request, copies of all written records referred to in Paragraph C. above as well as all related memoranda, notes, records, schedules, plans or other documents, and tangible research property made by, compiled by, delivered to, or manufactured, used, developed or investigated by MIT, which will at all times be the property of MIT.

E. I will not disclose to MIT or use in my work at MIT (unless otherwise agreed in writing with MIT):

- (i) any proprietary information of any of my prior employers or of any third party, such information to include, without limitation, any trade secrets or confidential information with respect to the business, work or investigations of such prior employer or other third party; or
- (ii) any ideas, writings, or Intellectual Property of my own which are not included in Paragraph A. above within the scope of this Agreement (please note that inventions previously conceived, even though a patent application has been filed or a patent issued, are subject to this Agreement if they are actually first reduced to practice under the circumstances included in Paragraph A. above).

This Agreement replaces all previous agreements relating in whole or in part to the same or similar matters that I may have entered into with MIT. It may not be modified or terminated, in whole or in part, except in writing signed by an authorized representative of MIT. Discharge of my undertakings in this Agreement will be an obligation of my executors, administrators, or other legal representatives or assigns.

Furthermore, I represent that, except as identified on page attached hereto: (i) I have not executed any agreements with or incurred any obligations to others in conflict with the foregoing; and (ii) I will not, while bound by this Agreement, enter into any other agreements, or otherwise incur any obligations, that conflict with the foregoing.

Your Signature (required), include full first name: _____ Date (required): _____

Return to the Technology Licensing Office via email to: tlo-mail@mit.edu
Or send a hard copy to: MIT Technology Licensing Office, Room NE18-501, 256 Main Street, Cambridge, MA 02142
For further information see MIT Policies and Procedures or the Guide to the Ownership, Distribution and Commercial Development of MIT Technology, <http://mit.edu/lnm/about/intellectual-property/tlo-policies> or contact TLO: (617) 253-6966.



Ownership of Intellectual Property

Inventors will own:

- Not developed during sponsored research
- Not created as a “work-for-hire”
- Not developed with significant use of funds or facilities

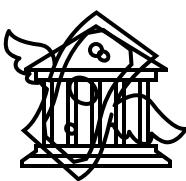
MIT will own:

- Developed by participants of sponsored research
- Created as a “work-for-hire”
- Participating with MIT programs with significant use of funds or facilities



Research pursuant to a sponsored research agreement

- Sponsored scope of work
- Federal or industrial grant
- Can be interpreted broadly
- In the case of industrial grants,
applies also to sponsor employees –
MIT ownership stake in research
inventions



Significant Use of Funds or Facilities

- MIT administered funds or facilities –
 - Industrial or federal sponsorship
 - MIT-administered salary
 - Funded equipment (e.g., Beaver Works)
 - Includes biological material, data sets
- Significant Use
 - More than incidental
 - Insignificant facilities: office, library, machine shop facilities, computers

“Work-for-Hire”

- Under copyright law of the United States
- Applies to commissioned works – MIT considered the author and copyright ownership
- Not a work conducted during scope of employment
- Scholarly publications, teaching materials

Questions to consider

- Was I doing a job for the Institute?
- Was I in a research lab or using a special resource that is not available outside of MIT?
- Was I working under a sponsored research project or using MIT-administered materials?
- Was I receiving funds from the Institute other than financial aid?
- Was I collaborating with other researchers or faculty on campus?

Navigating gray areas

- If uncertain – or if you need written documentation – prepare a waiver request
- Confirms the invention is not owned by MIT – valuable to investors
- Requires full disclosure of invention and facilities and funding used
- Signature by department head or lab director – sent to TLO for review
- *The Vice President for Research will make the final decision on this issue and on any dispute or interpretation of policy relating to Intellectual Property.*

Questions?

tlo-ipia@mit.edu