

Intellectual Property (IP) and Contract Considerations in the EBI

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Eight Underlying Principles

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are needed to see this picture.

1. Open Dissemination of Research Results & Information
2. Commitment to Educate Students
3. Accessibility for Research Purposes
4. Public Benefit
5. Informed Participation
6. Legal Integrity and Consistency
7. Fair Consideration for University Research Results
8. Objective Decision Making

- ✓ **Were applied when developing the BP proposal**
- ✓ **Are currently being applied, in contract negotiation**

<http://www.ucop.edu/ott/genresources/082699a.html>

**BP's call for proposals challenged academic applicants to
propose a research model
with two research components:**

An Open Component and Proprietary Component

OPEN

PROPRIETARY

Basic, academic research	Commercial applications lab
Research performed by UCB, LBNL, UIUC employees	Research performed by BP employees
Results all published	Confidential
Results belong to UCB, LBNL, and/or UIUC	Results belong to BP

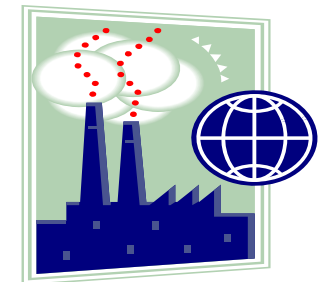
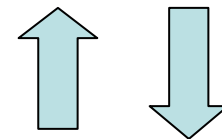
EBI's Open and Proprietary Components Help Us to Implement a Shared Vision

Of translating basic, academic, research results from the EBI into global energy solutions

Science-to-technology transition can be expedited through innovative Public-Private Partnerships

Engineering and Agriculture

- o input from industry provides valuable insight
- o problems to be solved
- o where and how academics can help



ACADEMIC TECHNOLOGY TRANSFER



Many University discoveries have been commercialized
It's a part of our mission

Few examples from U.C. Berkeley alone:

- therapeutics, diagnostics, neutraceuticals
- internet search engine, scheduling algorithm
- medical devices
- research tools: DNA sequencing reagents, gene chips
- protein modeling software

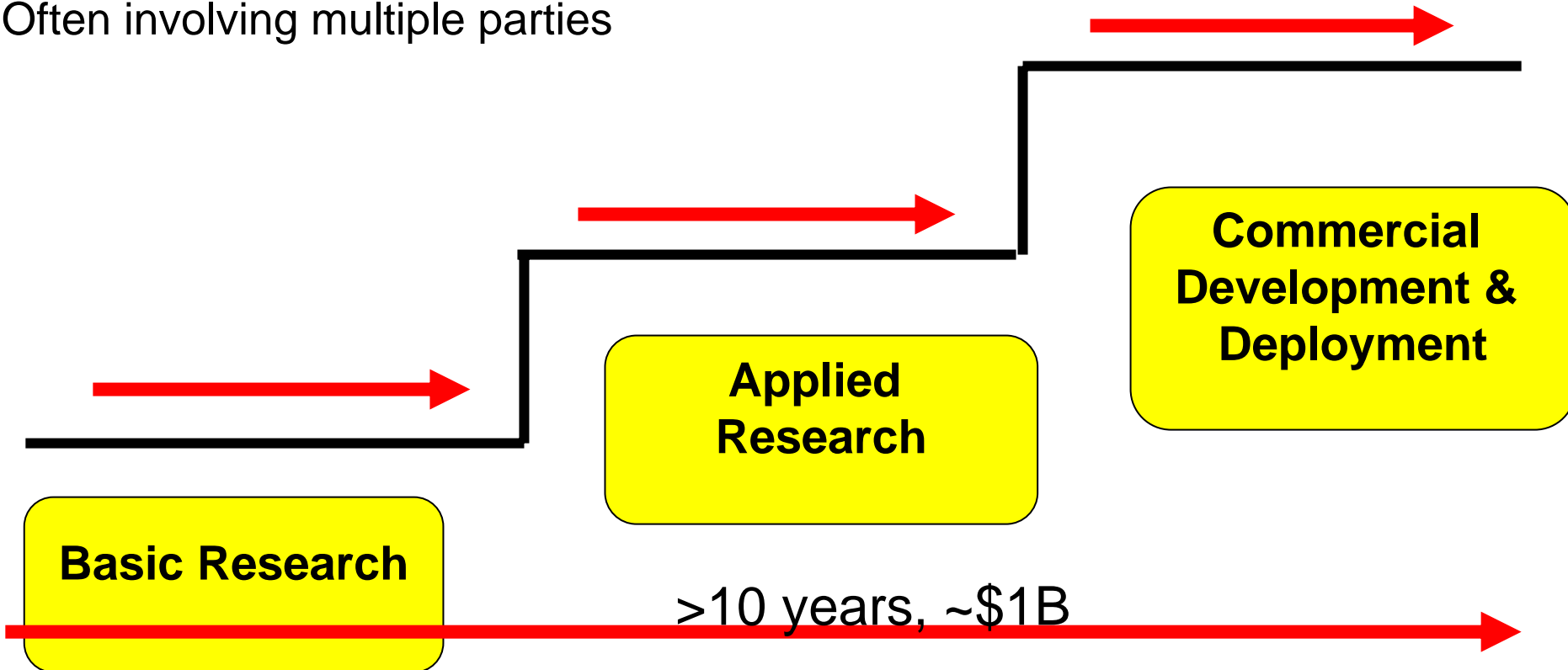
University tech transfer is practiced throughout the U.S. and Canada
Growing worldwide

University Research Results are Far from Being a Commercial Product

Commercial investment in and by the private sector is required to bring basic research results to the point of practical application

Technology transfer: the road to commercialization of university IP is typically a **series of separate steps**

Often involving multiple parties



The Translational Research Gap is Both Wide and Deep

University research results are embryonic

Rights to University IP are licensed to industry for commercial development



Bench to bedside



Bench to fuel tank

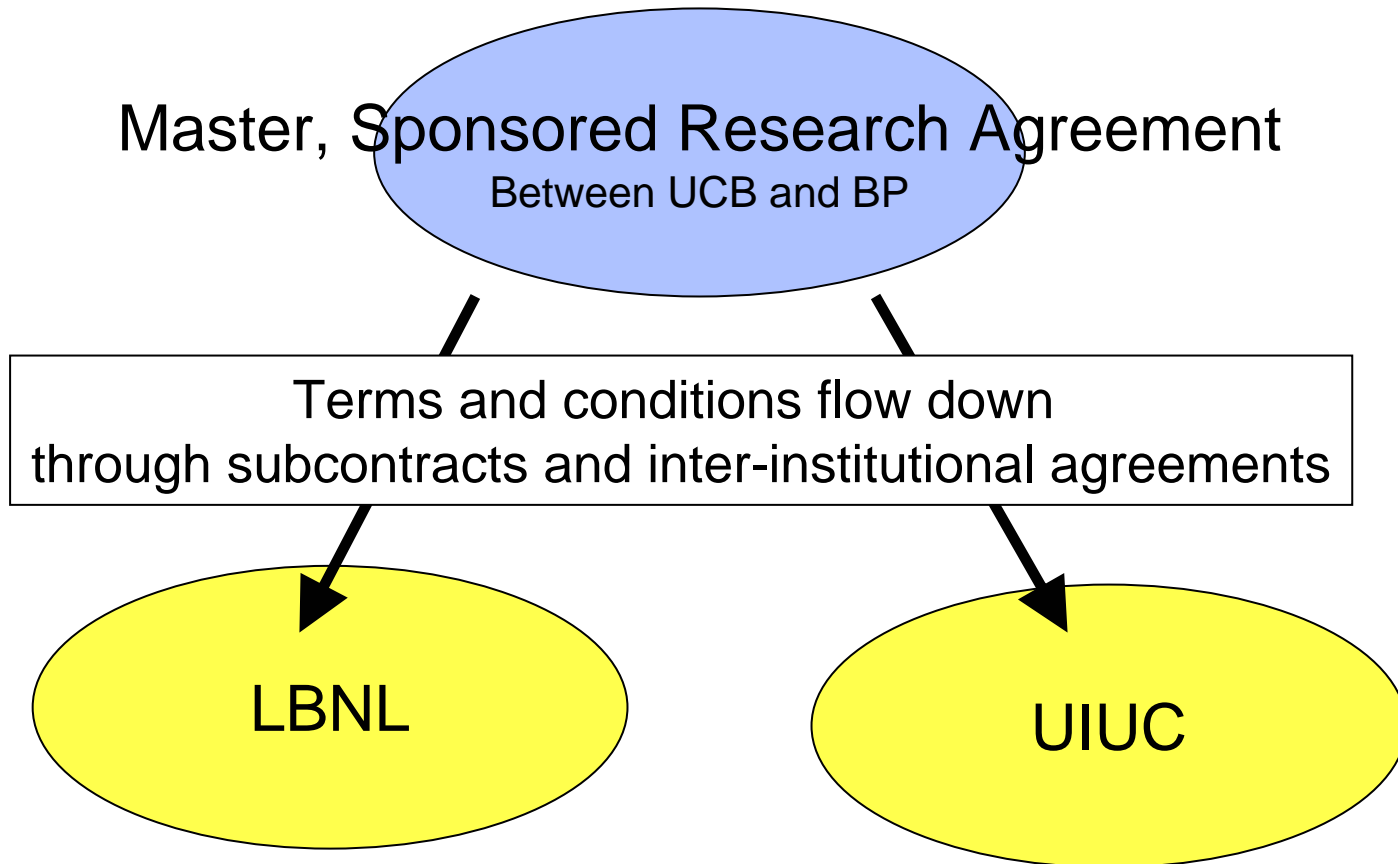
**Licensees invest enormous sums in risky
R&D, manufacturing, regulatory approvals**

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IP licensing gives industry an incentive to invest

EBI Intellectual Property & Contract Structure

To implement a shared vision of creating robust and long-term technological solutions to global energy challenges



What is a Sponsored Research Agreement between the University and Industry?

- University researcher seeking financial support for a given research project proposes a research plan to company/sponsor
- Corresponding budget: (direct costs + full indirect cost)
- Research results reported to sponsor and the University retains ownership
- Sponsor may request University to file patent application on its IP
- Sponsor receives first right to negotiate a license to IP rights

The guiding principles are always followed

This agreement: at least three members of the Academic Senate

Also see handout: “How Academic Freedom and Academic Principles are Preserved in Sponsored Research Agreements with Industry”

Research Implementation Under The Master Agreement

The EBI agreement will be a Master Sponsored Research Agreement

No pre-defined work plan

Funding to research institutions in the EBI will be administered to individual projects



Based on future, individual project proposals

Submitted by principal investigators in response to an open call for proposals

IP Ownership: Yours, Mine and Ours

Inventions made solely by BP personnel in their own space (rented)

“Yours”
Solely owned by BP

Inventions made solely by UCB, UIUC, or LBNL, personnel in their own space

“Mine”
Solely owned by UCB, LBNL or UIUC

Inventions made by at least one inventor from BP and at least one inventor from UCB/LBNL/UIUC

“Ours”
Jointly Owned

Licensing of EBI Inventions

For inventions that are solely owned by UCB, LBNL and/or UIUC that are fully funded by BP

Non-Exclusive

We will grant to BP a Non-Exclusive, Royalty Free (NERF) commercial license in BP's areas of interest with two qualifications:

1. BP will be required to diligently pursue commercialization of the licensed invention(s)
2. Inventor institution will not be obligated to file for patents unless it has a commitment from at least one licensee to underwrite patent costs

Exclusive

UCB, LBNL and UIUC agree that BP may obtain Exclusive license rights to our sole or joint interests in EBI inventions

Will feature pre-negotiated capped fees and/or royalty rate ranges in technology areas where it is possible to estimate those ranges