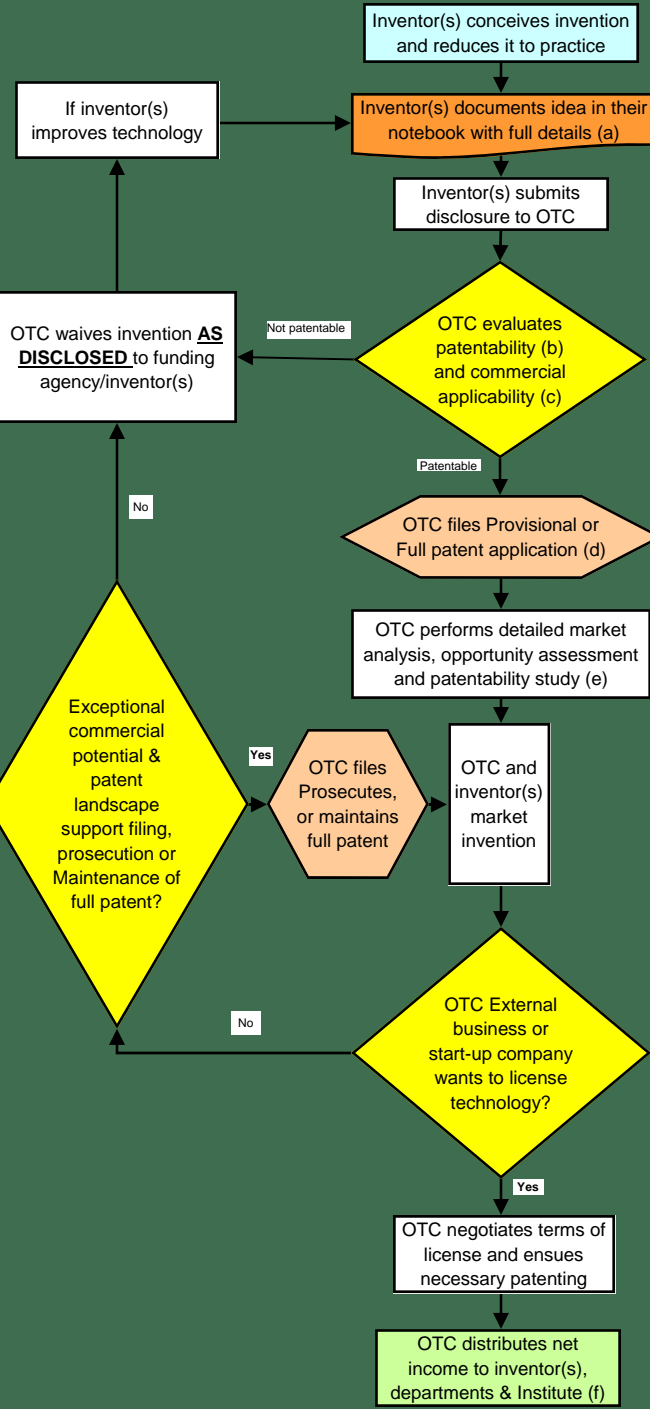
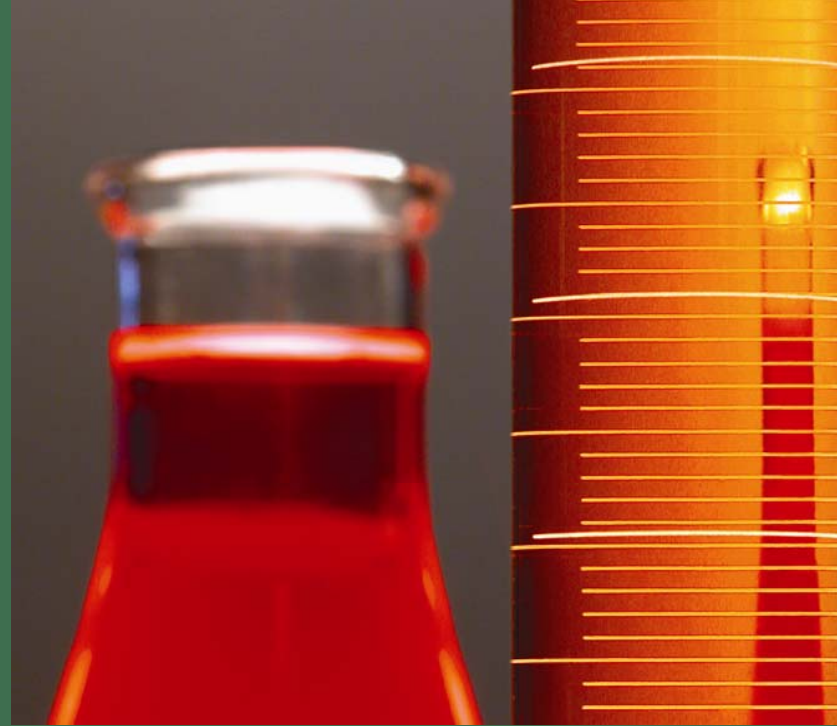


The Rensselaer Intellectual Property Patent & Licensing Process



- (a) See "Research Notebook Guidelines" on rpitechnology.com
- (b) Research contractual obligation & technical merit verified, see "Non-obviousness" on rpitechnology.com
- (c) Potential for return must greatly exceed marketing and patenting expenses
- (d) Now **SAFE** to **PUBLISH** and **PUBLICALLY DISCLOSE** and **OFFER** for **LICENSE**
- (e) See article "Patentable Subject Matter" on rpitechnology.com
- (f) According to Rensselaer I.P. Policy on rpitechnology.com



Guidelines for Creators of Intellectual Property at Rensselaer



The Office of Technology Commercialization at Rensselaer supports researchers in protecting intellectual property and bringing discoveries into the commercial marketplace. We are dedicated to building relationships with commercial partners to benefit Rensselaer, researchers, and the broader community.

Intellectual Property, Technology Transfer and New Ventures

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Rensselaer

Guidelines for Creators of Intellectual Property at Rensselaer

General Principles

Those who create Intellectual Property at Rensselaer are “Rensselaer Creators” and are obligated under Rensselaer’s Intellectual Property (IP) Policy to:

1. Immediately disclose to Rensselaer any IP they have created and own or to which they already have a license.
2. Maintain in a bound researcher’s notebook, documentation of the dates of the creation and the reduction to practice of the IP that they innovate.
3. Submit written disclosures of their innovations to the Office of Technology Commercialization (OTC) as soon as practicable.
4. Support the ownership and protection of Rensselaer’s IP, including the execution of documents that effectuate that IP ownership and protection by the Institute.

Ownership of Intellectual Property:

- Creator-Owned IP is IP that is/was NOT:
 - 1) Subject to a sponsored research or other agreement requiring ownership to reside in some other party including Rensselaer; and
 - 2) Conceived, created, developed, or first reduced to practice with Significant Use of Rensselaer Resources; and
 - 3) Conceived, created, developed, or first reduced to practice as a direct result of his/her duties at Rensselaer.
- Rensselaer-Owned IP is that which was conceived or reduced to practice under conditions that are opposite to those listed above.

Some Important Definitions

“Significant Use of Rensselaer Support” is defined in the Rensselaer IP Policy to include:

- Any use of Rensselaer personnel or facilities that is not exempted by Rensselaer’s IP Policy, including: space, funds, equipment, facilities or services, employee on-the-job time, laboratories, computers, software, paid student time, (e.g. research assistants, teaching assistants, fellows, students who provide services under sponsor agreements that require Rensselaer ownership), attending, participating in or benefiting from a Rensselaer Course, the supervision of a faculty or staff member, confidential information or Rensselaer-owned Intellectual Property (such as “Tangible Research Property” or “TRP”), Rensselaer organized software development projects or recordings of presentations of Course Materials. Several exceptions and exemptions apply, so Creators must refer to the Rensselaer IP Policy for the complete definition.

“Tangible Research Property (TRP)” is defined in the Rensselaer IP Policy to include:

- Those research results that are in a tangible form, as distinct from intangible property. Examples of Tangible Research Property may include, but are not limited to: integrated circuit chips, computer software, biological materials, engineering prototypes, engineering drawings, and other property, which can be physically distributed. Tangible Research Property may often have associated intangible property rights.

Questions and Answers

What are the primary categories of Intellectual Property?

The primary categories of Intellectual Property are patent, copyright, trademark, and integrated circuit mask work, though from time to time other types of protection and other bodies of law may also fall under the broad heading of IP.

How do I make a disclosure of new IP that I create to Rensselaer?

A disclosure of a new invention or other IP is made to the OTC by filling out and submitting an Invention Disclosure Form, which can be found at: www.rpитеchnology.com.

If I create IP while associated with Rensselaer that I don’t believe falls under the definition of Rensselaer-Owned IP, do I still have to disclose it to the OTC?

Yes. You are required to disclose all IP that you create while associated with Rensselaer. Among other things, this helps assure you that you have clear ownership of Creator-Owned IP in accordance with the Rensselaer Intellectual Property Policy, free from claims of Rensselaer or research sponsors.

Why is it important to provide the OTC with a disclosure of the IP that I create while at Rensselaer?

Intellectual Property are considered to be assets of the Institute, and need to be evaluated for their commercial or other value to the Institute, as well as, for those who have created it or have supported their creation via sponsored research. As such, the Institute will likely have legal obligations to several parties that can be met only if the OTC has knowledge of the newly created IP.

When should the disclosure of newly created IP be submitted to the OTC?

A written disclosure should be made to the OTC once the concept and reduction to practice of the IP has been completed. It is extremely important that no public disclosure, offer for sale, public display, publication or non-confidential presentation of an invention is made prior to the submission of your disclosure to the Rensselaer OTC and the filing of a patent application. **Failure to follow this guideline will result in the loss of all patent protection rights outside of the U.S., and if patent protection is desired within the U.S., will mandate the filing of a full U.S. patent application within one year from the date of any of the above public events.**

Will the Institute seek patent or other protection for all new IP that I disclose to the Office of Technology Commercialization (OTC)?

No. The decision as to whether to patent or register copyrights or trademarks in IP that is disclosed to the OTC is made on a case-by-case basis. If the OTC decides not to seek such protection, the IP will be returned back to you “as disclosed.” If you then improve your IP through a Significant Use of Rensselaer Support, you are obligated to make a new disclosure to the OTC. It is best to ask questions about a possible obligation rather than make an assumption that may be incorrect.

What is the patent and licensing Process at Rensselaer?

A depiction of the process is shown on the next flap.

What benefits can Rensselaer Creators receive from the Rensselaer-owned IP that they have created?

1. An opportunity to share in the benefits, if any, that result from the successful commercialization of the IP that they develop:
 - Creators receive 35% of the net adjusted proceeds resulting from successful commercialization;
 - Creator’s academic department receives 15% of the net adjusted proceeds; and
 - The Institute receives 50% of the net adjusted proceeds and uses those funds to support research and education at Rensselaer.
 - Please Note: Courses funded by an NCIIA or other grant may have a different distribution of net adjusted proceeds. The faculty member responsible for teaching such a course is responsible for notification of their students if there is a different distribution than that stated herein.
2. The grant of clear title to IP that you conceived while at the Institute if it is not owned by Rensselaer.
3. Education in the innovative process and in the protection of intellectual property.
4. An opportunity to become an entrepreneur and to license the IP that you have created into your own company.

Can I get into legal trouble if I don’t follow the Rensselaer IP Policy?

Yes. It is possible to get into legal difficulties if you do not follow the Rensselaer IP Policy. Rensselaer Creators have a legal obligation to follow the Rensselaer IP Policy as the ownership of intellectual property is a legal matter. The Institute has legal obligations to Rensselaer’s Creators and to outside parties, such as, the sponsors of the research that led to the creation of the IP. For Rensselaer to meet its obligations, Rensselaer’s Creators must meet their obligations under the Policy.

This publication is only a guideline. Rensselaer’s IP Policy and Procedures can be found at www.rpитеchnology.com. If you have further questions, contact:

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