

Glossary of Intellectual Property Related Terminology

Assigned Duty of Employment (or Assigned Duty)

Duty(ies) or activity(ies), within an employee's Scope of Employment, that an employer assigns to an employee. Such a duty or activity is under the control, direction, specific authorization or supervision of the employer. (See also "Scope of Employment").

Author

A Creator who contributes to a copyrightable work, as determined under United States Copyright Law.

Background Technology

Any proprietary technology, including Tangible Research Property, that Creator(s) developed prior to or separate and apart from a sponsored research agreement. that is patentable, copyrightable, a trade secret, or otherwise protectable, and that is useful or essential in the development or production of research results, Research Data, records and work product generated in the project or under the agreement.

Bayh-Dole Act

35 U.S.C. §§ 200-211 provides the statutory basis and framework for federal technology transfer activities, including the patenting and licensing of federally funded Inventions by recipient organizations. The Act permits recipients of federal grants and contracts to retain title to patentable "subject Inventions" that arise with the use of federal funds. Where recipients elect to retain title, the Act requires recipients to file patent applications, seek commercialization opportunities, and if requested by the funding agency, to report all efforts to protect or to commercialize these Inventions back to that funding agency. The Act also reserves for the government certain rights in subject Inventions, including (but not limited to) the right to claim ownership of any subject Invention, upon written request.

Commissioned Work

A work subject to copyright protection that a party specifically commissions anyone not employed by that party (including individual consultants or contractors) to create or produce. Also, a work subject to copyright protection that a party specifically commissions its employees to create or produce outside their regular Scope of Employment..

Consideration

Any form of payment, whether cash, Equity or other item or thing of value.

Consortium Agreement(s)

Contracts that outline the rights and responsibilities of each member of a research consortium. A research consortium is a group of institutions or companies acting together to investigate an area of common interest. In a typical research consortium agreement, each outside sponsor will contribute a specific amount of funding annually, or at some other designate time interval, to support a research project or program. Consortia typically conduct research in areas of interest to multiple Sponsors that draw together multiple researchers.

Consulting or Contractor Agreement(s)

Agreement(s) between a party and independent consultants or contractors defining each party's rights and responsibilities, including equitable payment for the production of a specified work.

Copyright

The legal right granted to an author, composer, playwright, publisher, or distributor to exclusive publication, production, sale, or distribution of a literary, musical, dramatic, or artistic work.

Creator(s)

Faculty, students, staff or others who participate in programs, who conceive, create, make, or first reduce to practice, in whole or in part, Intellectual Property. In the case of a work of copyright, the author is a Creator whose original ideas become fixed in a tangible medium. An Inventor or Creator is one who finds, creates or originates an Intellectual Property that constitutes an Invention, whether patentable or not. Merely performing work in a manner that does not contribute to the constitution, creation, origination nor the founding of the Invention does not meet the definition of a Creator or Inventor. At Rensselaer, the determination of whether a member of the Rensselaer community is a Creator is independent of the legal determinations of inventorship under patent law and authorship under Copyright law.

Development Expenses

All moneys paid for goods and services to protect, develop, and/or enhance the marketability or any other aspect of an intellectual property, including, but not limited to, patent filing fees, protection of patents, marketing expenses, patent maintenance, consulting fees, prosecution expenses, expenses incurred in dealing with Equity, travel, attorneys' fees, and research costs. Salaries and general operating expenses of administrative personnel do not qualify as Development Expenses.

Disclosure (or Disclosure Form)

A form filled out by the Inventors/Creators, describing new Work product or Invention (technology). The Invention Disclosure Form provides the information that is needed to start the evaluation and protection process for Intellectual Property.

Equity

Shares of common or preferred stock, warrants, Options, convertible instruments, units of a limited partnership, or any other rights to purchase stock or securities, or any other instrument conveying ownership or economic interest in a corporation, limited partnership, limited liability company or other business entity.

Fair Use

A legal principle limiting the exclusive rights of copyright holders. In general, the "Fair Use" of a copyrighted work includes use for purposes such as criticism, comment, news reporting, teaching, scholarship, or research. Because the Copyright Act does not specifically define Fair Use, the concept and practice of Fair Use may be subject to legal challenge and judicial interpretation. Courts typically balance the purpose and character of the use; the nature of the copyrighted work; the amount and substantiality of the portion used in relation to the

copyrighted work as a whole; and the effect of the use on the potential market for, or value of, the copyrighted work.

Field of Use

The specified area of technology application as defined in a License or a licensing related transaction for which the Licensee is being granted certain rights.

Gift(s)

A voluntary and irrevocable transfer of money, services or property (for example, equipment, Intellectual Property, personnel time and skill, etc.) from a donor without any expectation of or receipt of direct economic or other benefit or provisions of goods or services from the recipient.

Improvement(s)

Intellectual Property that was developed while using or practicing an existing Intellectual Property or is directly dependent upon the claims of a basic patent.

Independent Academic Work(s)

A copyrightable Knowledge-Like Work developed as a result of independent academic effort that meets the criteria to qualify as an Exempted Scholarly Work.

Instructional Work(s)

Comprise materials developed for pedagogical purposes, and includes Course(s), Course Material(s) and Courseware or any combination thereof.

Intellectual Property Infringements

Infringement is a technical legal term that applies whenever an unauthorized party engages in one or more activities reserved to the owner of an Intellectual Property Right. The range of prohibited activities differs according to the nature of the right. Patent infringement consists of the unauthorized making, using, offering for sale or selling of any Patented Invention within the United States or United States Territories, or importing into the United States any patented Invention or any product manufactured through use of a patented process during the term of the Patent. Copyright infringement includes the unauthorized or unlicensed copying of a work subject to copyright.

Intellectual Property License

A formal legal agreement granting rights to Intellectual Property in exchange for some form of payment or other Consideration. A License may be either exclusive or nonexclusive.

Interinstitutional Agreement

Any agreement between a university and one or more institutional partners to accomplish a particular task that is generally related to research and/or technology transfer. Most such agreements take the form of a collaborative research agreement (where the goal of the agreement is to jointly conduct a research project) or the form of an intellectual property management agreement (where the goal is to protect and commercialize jointly developed Intellectual Property). An Interinstitutional Agreement defines each institution's role and contributions to the task or project and delineates the scope of the project and the rights and obligations of the institutions.

Invention

Any discovery, process, composition of matter, article of manufacture, know-how, design, model, technological development, biological material, strain, variety, culture of any organism, or portion, modification, translation, or extension of these items, and any mark used in connection with these items.

Inventor

An Inventor is someone who is the first to think of or make something as defined by patent law; it is often considered to be a Creator who materially and/or substantially contributes to the conception of a patentable Invention.

Joint Inventors

A technical term in patent law. If two or more persons contribute to the conception of an Invention jointly, they apply for a patent as Joint Inventors. A person who makes a financial contribution is not a Joint Inventor and cannot be joined in the application as an Inventor.

Joint Ownership / Joint Owner(s)

Ownership in Intellectual Property by more than one party.

Joint Work of Copyright (or Joint Work of Authorship)

Rights of ownership in a Joint Work of Copyright are determined pursuant to U.S. Copyright law.

Know How

Knowledge pertaining to Improvements, discoveries, Intellectual Property, Research Data, instructions, processes, protocols, formulas, information and trade secrets.

Knowledge-Like Works

Comprise copyrightable software, digital and/or electronic works that are intended primarily, and are reasonably likely, to provide knowledge to the user. Such works typically synthesize data and information to create knowledge and are akin to a textbook or electronic book.

License

Permission to do an act which, without permission, would be illegal, a trespass, infringement, tort, or any other private or civil wrong or injury for which a court will provide a remedy in the form of an action for damages. A patent owner grants a patent License to a party to allow the Licensee to make, use, sell, offer to sell, and import a patented Invention for a limited period.

License Issue Fee

Consideration paid by a Licensee to the Licensor in the form of an up-front payment.

Licensee

The party to whom a Licensor has granted a License or an Option to a License.

Mask Works

A series of related images representing a predetermined, three-dimensional pattern of metallic, insulating, or semi-conducting layers of a semiconductor chip product. Under the

Semiconductor Chip Protection Act of 1984, Mask Work protection extends for 10 years and gives the owner exclusive rights to its exploitation. Mask Works are registered with the United States Copyright Office. Failure to apply for registration within two years of the initial commercial exploitation results in the termination of the exclusive rights.

Material Recipient

An institution, party, or individual receiving original Tangible Research Property under the terms of a Material Transfer Agreement (MTA).

Material Transfer Agreement (MTA)

A formal contract governing the transfer of one or more materials, such as Tangible Research Property (TRP), from the owner or authorized Licensee to a recipient, usually for research purposes only. MTAs usually prohibit the Material Recipient from using the transferred materials for Commercial Purposes. MTAs also sometimes provide that certain modifications to the original material by a recipient may be treated as still being owned by the original supplier of the materials Progeny, and unmodified derivatives, usually qualify as this kind of modification. A Progeny is an unmodified descendant of the material, including but not limited to, a virus from virus, cell from cell, or organism from organism. Unmodified derivatives are substances that the recipient creates which constitute an unmodified functional sub-unit or an expression product of the material, including but not limited to, subclones of unmodified cell lines, purified or fractionated sub-sets of the material, proteins expressed by a hybridoma cell line, sub-sets of the original TRP such as novel plasmids or vectors.

Option

A binding promise in which the owner of property grants a third party the privilege of buying or licensing the property, usually at a fixed price, within a stated period of time, at the third party's sole discretion.

Patents and Patent Rights

A patent is a government grant, issued in the United States by the U.S. Patent and Trademark Office (the USPTO), giving an Inventor, or his/her assignee, the right to exclude all others from making, using, offering for sale, importing or selling the Invention within the government's territory, such as the United States, its territories and possessions, for a limited period, such as 20 years from the earliest filing date of a patent application. Procedures for filing, requirements for patentability, and term of Patent grant vary considerably from country to country. To be patentable in most countries, an Invention must be new, useful, and non-obvious. In the U.S., a grace period of 12 months from the date of the first written public disclosure, public use or offer for sale of an Invention is allowed to file a patent application. **In many foreign countries, an Invention is unpatentable unless the application is filed before any disclosure of the Invention is made anywhere outside of a confidential relationship.** However, if one has filed an appropriate patent application in the U.S. prior to such Disclosure, the applicant has twelve months from the U. S. filing date to file in most non-U.S. countries without losing patent rights.

Principal Investigator

The individual who assumes primary responsibility for the scientific or technical direction of a project. If the project involves outside sponsorship, the Principal Investigator initiates the application for sponsorship and ensures that the project is conducted as described in the application and in compliance with university and sponsor policies.

Prior Art

A technical legal term encompasses anything that has ever existed in the universe before the Invention was made. Prior Art can include U.S. patents, foreign patents, publications, documents, written articles, devices known, on sale, or used by the public, etc.

Provisional Patent Applications

A provisional application for Patent is a U. S. national application for patent filed in the USPTO under 35 U.S.C. §111(b). Provisional filings enable Inventors to establish an early effective filing date in a non-provisional patent application, and allow Inventors to attach the term “Patent Pending” to their Inventions. Since 1995, the United States Patent and Trademark Office (USPTO) has offered Inventors the option of filing a provisional application for a patent as a means of providing a lower-cost “simplified” first patent filing in the United States.

Research Data

Recorded information, regardless of form or the media on which it may be recorded, and any other information obtained, developed, conceived or reduced to practice, or derived in the course of or performance of a research program. Research Data includes, but is not limited to, reported results of research and the events and processes leading to those results, as well as information that is generated in or as a result of empirical research activities. A university must retain detailed Research Data for a period of time sufficient to enable appropriate responses to questions about accuracy, authenticity, primacy and compliance with laws and regulations governing the conduct of the research.

Scope of Employment (or Course of Normal Duties)

The range of duties or activities a person is hired or expected to perform for an employer. These duties may be listed in a job description, employment contract, an institutional policy or guideline or may be generally understood expectations of a discipline, field, or trade. The duties may or may not be performed during normal business hours or at employer’s facilities.

Trade and Service Marks

A word, name, symbol, or device (or any combination thereof) that an organization adopts to identify its goods or services and distinguish them from the goods and services of others. In the U.S., organizations gain Trademark or Service Mark ownership by using of a term on or in association with goods or in connection with services to identify their origin. Though Trade or Service Mark ownership is not dependent upon federal or state registration, but upon use of the mark, both States and the Federal government maintain registries of these marks. Registration enhances the rights acquired through the mere use of a mark.

Work Made for Hire

EMPLOYEES: A “Work Made for Hire”, as defined by law, is a work product subject to copyright protection that is created within the author’s Scope of Employment. Copyright of the work product in these situations belongs to the employer.

NON-EMPLOYEES or EMPLOYEES OUTSIDE SCOPE OF EMPLOYMENT: Under the Copyright Act, an author, and not the commissioning party, owns the copyright to Commissioned Works unless there is a written agreement to the contrary.