

Intellectual Property Agreement for Montana State University Personnel

I understand that, consistent with applicable laws and regulations, Montana State University (MSU or University) is governed in the handling of intellectual property by its official policies (Board of Regents Policy §401.2, Tenure and Tenure Track Faculty CBA §15.04 and Non-Tenure Track Faculty CBA § 12.04) and I agree to abide by the terms and conditions of those policies and agreements, as they may be amended from time to time.

For the purpose of implementing Board of Regent and MSU CBAs concerning intellectual property, and in consideration of my employment by MSU, the receipt of remuneration from MSU, participation in sponsored research projects administered by MSU, access to or use of facilities or resources provided by MSU for such research, and/or other valuable consideration, I hereby agree as follows:

1. I will disclose to MSU all potentially patentable inventions conceived or first reduced to practice in whole or in part in the course of my University responsibilities or with more than incidental use of University resources in accordance with the above referenced policy and CBAs. Further, I hereby assign to MSU all my right, title and interest in such patentable inventions and agree to execute and deliver all documents and do any and all things necessary and proper on my part to effect such assignment.
2. I am free to place my inventions in the public domain as long as in so doing neither I nor MSU violates the terms of any agreements that governed the work done.
3. I am now under no consulting or other obligations to any third person, organization or corporation in respect to rights in inventions which are, or could be reasonably construed to be, in conflict with this agreement. I will not enter into any agreement creating patent obligations in conflict with this agreement.
4. This agreement is effective on the date of signature below.

Signature: _____

Printed Name: _____

Date: _____

MSU GID: _____

Assignment of Technologies

BACKGROUND

Last June the US Supreme Court ruled against Stanford in litigation regarding assignment of intellectual property created by a Stanford researcher.

The IP in question was created by Dr. Holodniy, a researcher in infectious diseases at Stanford, while utilizing equipment at Cetus, a small company subsequently purchased by Roche.

Stanford's IP policy simply states that researchers "agree to assign" to Stanford rights in IP created while under the employment of Stanford. However, Dr. Holodniy signed a Visitor's Confidentiality Agreement with Cetus which stated that he "hereby assigns" all rights to ideas, inventions and improvements made as a consequence of his access to Cetus.

Stanford's assignment predated the Cetus agreement, and Stanford also relied on Bayh Dole – as creating an obligation to assign all IP developed under federal funding – to the grantee, Stanford.

The Supreme Court ruled that the "agree to assign" was an assignment in the future whereas the "hereby assign" in the Cetus agreement caused the IP to be assigned immediately to Cetus.

JUSTIFICATION

As a result, all universities are modifying the timing of their assignment agreements. Companies who consider licensing university IP need more certainty that the IP that they license is in fact property of the university. The uncertainty created through this ruling could have significant impact on companies' willingness to license.

MSU is looking to secure the assignment of IP rights through a simple letter assignment. One such agreement will be a blanket agreement with any given researcher and will be sufficient in perpetuity for that researcher for IP that falls under BOR policy.

This new procedure will not impact the ownership of IP created at MSU – the BOR policy currently requires that researchers assign that IP to the university. And MSU faculty agree to abide by that policy when they sign their hire letter. But our current practice of assignment at the time of disclosure of the invention does not meet the strict standards imposed by the Supreme Court ruling. We are merely working to remove the ambiguity created by a future assignment by requiring all researchers to state that they agree to "hereby assign." The outcome of ownership remains as has been in practice for over thirty years at MSU. Providing for a current assignment will ensure that companies have more clarity regarding title to the IP than is currently the case. It is in the researchers' and university's best interest to make that clarification so that technologies can be more licensable.