

**Youngstown State University**  
**School of Graduate Studies and Research**

*Handbook on Ownership  
of  
Intellectual Property*

**March 2012**

**Youngstown State University**

**School of Graduate Studies and Research**

*Handbook on Ownership  
of  
Intellectual Property*

**March 2012**

# Handbook on Ownership of Intellectual Property

## Table of Contents

Introduction .....	1
University Policy on Intellectual Property Rights .....	1
Definitions .....	1
Governing Law .....	2
Student Involvement in Research .....	5
Invention Disclosure .....	5
Types of patents .....	5
Criteria for patentability .....	6
Loss of Patentability .....	6
Impairment of patentability .....	6
International variations in patent regulations .....	6
Non-Disclosure Agreements for Intellectual Property .....	7
Material Transfer Agreements .....	8
Procedure for Protecting intellectual property at YSU .....	9
Conclusion .....	9
Reference Guides .....	10
Appendices .....	11 – 31
Appendix I – University Guidebook – Intellectual Property Rights .....	11
Appendix II – Standard Contract Language.....	14
Appendix III – University Intellectual Property Agreement (for students).....	16
Appendix IV – Invention Disclosure.....	18
Appendix V – Non-Disclosure Agreement .....	22
Appendix VI – Mutual Non-Disclosure Agreement .....	25
Appendix VII – Materials Transfer Agreement .....	28

# Ownership of Intellectual Property

## Introduction:

This Handbook on Ownership of Intellectual Property has been designed to guide faculty, staff, and students in dealing with issues of ownership and protection of intellectual property that is eligible for protection under patent law. Incorporated into this handbook are several documents that should be of use to individuals who have questions about the forms of intellectual property, mechanisms for the protection of intellectual property, or individual rights associated with the ownership of intellectual property at Youngstown State University. The Board of Trustees of Youngstown State University seeks to stimulate innovative research and to encourage the development and utilization of the discoveries and inventions of research at the university in a manner consistent with the public interest. The Board believes it should make the results of its research available to industry and the public on a reasonable and effective basis with an appropriate allocation of intellectual property rights between the creator and the University. This Handbook does not deal with copyright issues except to describe general institutional policies and to reference appropriate federal statutes.

## Youngstown State University Policy on Intellectual Property Rights:

The development and dissemination of intellectual property benefits the public, the University, and its faculty, staff, and students. Research and scholarship are encouraged through an appropriate allocation of intellectual property rights between the creator and the University. The full Youngstown State University Policy (#1018.01) can be found in Appendix I, at the end of this document and at [http://web.yosu.edu/gen/ysu\\_generated\\_bin/documents/basic\\_module/1018.01.pdf](http://web.yosu.edu/gen/ysu_generated_bin/documents/basic_module/1018.01.pdf) The Board of Trustees has designated the Associate Provost for Research and Dean, School of Graduate Studies and Research to administer procedures for intellectual property and as “*Authorized Institutional Official*” for grants and contracts related to research and scholarship, which may result in intellectual property. All questions on intellectual property should initially be addressed to the Associate Provost for Research and Dean, School of Graduate Studies and Research.

## Definitions:

- "Intellectual Property" includes inventions, discoveries, works of authorship, and/or other creative works that may be subject to protection under federal or state patent, copyright, trademark, and/or trade secret laws.
- “Employee owned intellectual property” includes intellectual property privately created, made or originated by a faculty member, employee, or student, without use of

University facilities, shall be the sole and exclusive property of the creator(s), except as he or she may voluntarily choose to transfer such property, in full, or in part.

- “University owned intellectual property” includes all intellectual property arising from the following circumstances:
  - The University expressly directs a faculty member, employee, or student to create a specified work or the work is created as a specific requirement of employment, or a credit bearing course, or as an assigned institutional duty that may, for example, be included in a written job description or an employment agreement.
  - The faculty member, employee, or student has voluntarily transferred the intellectual property, in whole or in part to the institution. Such transfer shall be in the form of a written document signed by the transferring individual.
  - The faculty member, employee, external entity or student has contributed to a “joint effort” which has the ownership rights and any income distribution set forth in writing. Unless agreed in writing otherwise, all IP developed by students shall be the property of the University. Absent specific agreement for the ownership of intellectual property resulting from a sponsored program supported by an external entity, the intellectual property will be the property of the University.
- "Invention" is any discovery, product, process, machine, composition of matter, and/or improvement that may be patentable.
- "Patent/Patentable" is any invention or other matter that may be patentable under the patent laws of the United States or foreign country.
- "Trade Secret" is any information that derives economic value from not being readily known or available to others and is protected from disclosure by reasonable efforts.
- "Copyright/Copyrightable" is any original work of authorship protectable under the copyright laws of the United States or foreign country.
- "Gross Royalty Income" is gross revenue resulting from a given intellectual property.
- "Net Royalty Income" is gross royalty income less costs incurred by the inventor(s)/author(s), the University, and any third party commercializing the product, including securing legal protection and licensing.

#### **Governing Law:**

##### **Ohio Revised Code:**

Section 3345.14 of the *Ohio Revised Code* provides that all rights to discoveries or inventions that result from research or investigation conducted in any facility of a state university are the sole property of the University. The Board of Trustees may assign, license, transfer, or sell these rights as the Board deems appropriate. Accordingly, the Board

has assigned the rights to intellectual property between any member of the full-time faculty and the University through ratification of the *Agreement between Youngstown State University and Youngstown State University Chapter of the Ohio Education Association, Article 27.3*. Researchers who are working in areas that could develop intellectual property are advised that ownership and commercialization of faculty owned intellectual property may result in the need to disclose such ownership or relationship to an outside company/entity under O.R.C. Section 3345.14(D). In addition, ownership/interests of/in intellectual property may also result in conflicts of interest under Board of Trustees Policy 1017.01 “Objectivity in Research...” or Board of Trustees Policy 7001.01 “Conflict of Interest;” and the need to manage such commercial relationships that may result in a conflict of interest or a perceived conflict.

Employees are admonished that any communication regarding patentable intellectual property, such as an abstract, public presentation (seminar or meeting presentation, including posters), or publication prior to actual submission of a patent application could cause forfeiture of patentability for an invention. There may also be instances when a sponsored program agreement with an external company requires a specific signed Non-Disclosure Agreement by a faculty/staff researcher and/or students participating in a particular research project. In these instances, faculty members are advised that their submission and signature on the internal “blue-sheet” Proposal Authorization and pre-Approval Form constitutes their consent to abide by the Agreement for the project including any separate related NDA.

### **Federal Law:**

Stipulations of P.L. 96-517, the Bayh–Dole Act, may take precedence over any other terms of agreement negotiated by the university in matters of patenting and technology transfer. Intellectual property resulting from federally sponsored research is disposed of in accordance with the terms of the applicable agency. Regulations implementing federal patent and licensing policy regarding “Rights to Inventions Made by Nonprofit Organizations and Small Business Firms” are codified at 37 CFR Part 401. The Department of Commerce is designated as the federal agency to promote commercialization and to assume responsibility for maintaining these rules. The provisions apply to all inventions conceived or first actually reduced to practice in the performance of a federal grant, contract, or cooperative agreement. This is true even if the Federal government is not the sole source of funding for either the conception or the reduction to practice. The provisions do not, however, apply to federal grants that are primarily for the training of students and postdoctoral scientists. A Principal Investigator/Project Director on any federally sponsored research grant *must* disclose any discovery/invention of intellectual property to the University, as owner of the intellectual property, so proper disposition “in the public interest” can be accomplished as required by the Bayh–Dole Act.

Recent changes in patent law (June 23,2011) by the Leahy-Smith America Invents Act has significantly changed patent law to define the “effective filing date” as the actual the actual filing date of the patent application for a claim to an invention. This changes the current “first to invent” system to a “first inventor to file” system. As a result,

confidentiality with regard to intellectual property or proprietary information is much more important than ever before in assuring property rights and possible patentability.

### **Contract Law:**

Intellectual property resulting from research sponsored by industry or other non-governmental sources of support, other than the university itself, is disposed of in accordance with contract terms negotiated between the university and the sponsor, and approved by both parties. In such negotiations the university may agree to a non-exclusive royalty bearing license; a license of limited exclusivity which is royalty bearing; an exclusive, royalty bearing license for the life of the patent, a one-time payment for the entire technology; or other mutually acceptable consideration. Acceptable contract terms will depend upon such factors as the initial amount of research support, financial expenditures for further development, costs of patent acquisition, duration of exclusivity, period likely needed for market development, or other pertinent factors. Externally sponsored research is always between the sponsor as "grantor" and the University as "grantee." Therefore, the University exercises ownership and there cannot be a faculty sponsored agreement. A faculty member may not agree or sign on behalf of the University for any sponsored program or intellectual property issue. Only the "Authorized Institutional Official" may sign such agreements and at Youngstown State University only the Associate Provost for Research and Dean, School of Graduate Studies and Research, and the President have been authorized by the Board of Trustees for that purpose.

*Standard Contract Language:* Appendix II contains approved intellectual property clause language for a research/sponsored program agreement for research or other deliverables undertaken by any employee of Youngstown State University. This language defines both sponsor and University interests and ownership rights of intellectual property developed independently or collaboratively in meeting contractual requirements. Royalty fees are negotiable on an individual contract basis, depending on the nature of the work and likelihood of producing intellectual property. As described above, a single one-time payment to the university by the sponsor or other mechanism may be substituted for the payment of royalties.

### **Copyright Law:**

Copyrights are governed by federal laws. The authors should be aware of 17 U.S.C. the Copyright Act (See Reference guides - #4. <http://www.copyright.gov/title17/> for the Copyright Act). Typically, copyright protection is available for protection of original works of authorship in any medium of expression. This definition includes such forms or media of expression as literary works, musical works, pictures, sculptures, audiovisual works, computer programs, etc. Protection of intellectual property under copyright laws requires registration of the copyright with the U.S. Copyright Office prior to any action to enforce the copyright with a lawsuit. Under Youngstown State University Board of Trustees Policy Number 1018.01, with the exception for works for hire or joint efforts, ownership of copyrighted materials is the property of the faculty member who creates the material. In the case of a work for hire,

the University owns the intellectual property. Board policy defines the distributions and circumstance applicable to joint efforts or works for hire as these are the only situations where the University has any legal interest in such forms of copyrighted intellectual property. For non-faculty employees or students the information under “employee owned or university owned intellectual property” above (page 1 and 2) applies.

### **Student Involvement in Sponsored Research:**

When students are expected to participate in a sponsored research project, either as a student employee or as part of a thesis or other educational experience (internship, university funded research, etc.) relating to that project, the student faculty advisor will be directed by the Associate Provost for Research and Dean, School of Graduate Studies and Research to inform the student of his/her responsibilities under University Policy 1018.01. Each student so involved, will be required to execute a University Intellectual Property Agreement (Appendix III) as required by the Bayh–Dole Act, prior to involvement in the project. In execution of the University Intellectual Property Agreement it is assumed that the student is using University facilities and resources (other than incidental use of library and computer facilities generally available to the public) in the development of the intellectual property. All students supported by any form of Graduate Assistantship or Research Assistantship will be required to execute the University Intellectual Property Agreement (Appendix III) as part of their appointment documents. The executed University Intellectual Property Agreement is returned to the Office of the Associate Provost for Research and Dean, School of Graduate Studies and Research for safekeeping.

### **Invention Disclosure (*Initiating the Patent Process*):**

An invention is a novel and useful idea relating to processes, machines, manufactures, and compositions of matter. It may cover such things as new or improved devices, circuits, systems, chemical compounds, drugs, etc. To be patentable, the invention must not be obvious to a worker with average skills in that particular technology. In addition, it must not have been used by others in this country, or patented or described in a printed publication anywhere, prior to the date of conception.

Patents may be of three types:

- *Utility Patents* – This classification constitutes the bulk of patents issued. A utility patent is used to protect an invention that is useful and that works in a novel or unique way.
- *Design Patents* – This classification is used to protect the appearance of an article. It does not protect the use of an invention. A Design Patent deals with the shape or surface ornamentation, or both.
- *Plant Patents* – Plants may be protected if the uniquely created plant results from any asexual reproduction process: grafts, buds, root cutting, etc. Sexually produced plants are protected under the Plant Variety Protection Act [7 U.S.C. Art.



2483(a)(1)]. Both asexually and sexually reproduced plants can be protected by a utility patent.

There are several issues which can make intellectual property unpatentable:

- *Criteria for patentability:* As indicated above, patentability requires that an invention must not be obvious to a worker with ordinary skill in that particular field. It also must not have been publicly known or used by others in this country or patented or described in a printed publication anywhere prior to the date of invention.
- *Loss of patentability:* Inventions that are initially patentable may become unpatentable for a variety of reasons. An invention becomes unpatentable in the United States unless a formal application is filed with the United States Patent Office within 12 months of disclosure in a publication or within 12 months of any other action which results in the details of the invention becoming generally available. As indicated earlier, the Leahy-Smith America Invents Act has significantly changed patent law to define the “effective filing date” as the actual the actual filing date of the patent application for a claim to an invention. This changes the current “first to invent” system to a “first inventor to file” system. As a result, confidentiality with regard to intellectual property or proprietary information is much more important than ever before in assuring property rights and possible patentability.
- *Impairment of patentability:* Many other circumstances may impair patentability, such as lack of “due diligence.” For example, if there is no record of continuous activity in attempting to complete and perfect an invention, the invention may be considered to have been abandoned by the initial inventor, and priority could be given to a later inventor who showed “due diligence.” Sufficient documentation of the invention must be provided in the patent process. An undated and unsigned laboratory notebook cannot be used to document a discovery and even in the case where good records are available, lack of a witness attesting (in writing) to the discovery could impair the patentability of the intellectual property.
- *International variations in patent regulations:* Regulations covering the patentability of inventions and application filing procedures vary considerably from country to country and are subject to change.

In the protection intellectual property the Invention Disclosure is critical to patenting and patent protection. Invention disclosures may be “preliminary;” submitted for each invention conceived by faculty, staff, or students, paid or unpaid, of the University and submitted to document and record a concept or idea that has not yet been reduced to practice and is not ready for patent filing. A disclosure may also be “final;” insofar as the idea has been reduced to practice and is ready for final filing as a patent application. The preliminary disclosure records the concept of the invention only until such time as a final invention disclosure document is received. This provides the basis for a determination of the date of conception only and because the Leahy-Smith America Invents Act, which shifts patents to a “first inventor to file” system, the date of conception is less important

than it formerly was. In general, an Invention Disclosure should be made when unusual, unexpected, or unobvious research results have been achieved and can be utilized. Under BOT Policy #1018.01 employees of YSU are **required** to submit an Invention Disclosure, if they believe that they have developed intellectual property that may be patentable and have done so as a university employee.

In cases where preliminary publication (including oral presentation or any type of public disclosure) describing the intellectual property has occurred, which could affect the patentability of the intellectual property, an alternative to filing a patent application is the use of the provisional patent. In this case, U.S. patent rights can be protected for up to one year by filing a Provisional Patent Application with the U.S. Patent Office. The process is less cumbersome and considerably less expensive than a full Patent Application (approximately \$2,000 - \$5,000 as compared to a \$40,000 - \$60,000+ expense for final filing), however the submission of a provisional patent must be followed by a full patent application within one year, or the patentability of the invention is lost. This process, in effect, allows a two year period to obtain a patent within the United States. A Provisional Patent is used to protect the priority date of invention, but *prevents* pursuit of world-wide patent protection. A Provisional Patent may not be used to protect an invention that will ultimately be patented only as a Design Patent as it cannot protect the priority date in this case. One advantage of the Provisional Patent is the ability to license the intellectual property to a commercial entity with the commercial partner assuming the costs for the full patent application as a part of the license agreement. This obviously is possible if the invention could be of commercial value to the company and is widely marketable.

A preliminary or final Youngstown State University Invention Disclosure (Appendix IV) should be filled out completely by the inventor(s) and reviewed in the presence of two witnesses. After your disclosure has been reviewed, please submit the completed and witnessed document, with **original signatures**, to:

Associate Provost for Research and Dean  
School of Graduate Studies and Research  
Youngstown State University  
One University Plaza  
Youngstown, Ohio 44555

### **Non-Disclosure Agreements for Intellectual Property:**

In many situations, discussions and/or collaborations between an employee of Youngstown State University (faculty, student, or staff member) and a representative of an external entity (faculty member or staff employed by another university, commercial company researcher, etc.) may be advisable in the course of research and scholarship. *If the research or scholarship has a reasonable likelihood of resulting in intellectual property the researcher cannot protect the confidentiality of his/her research, unless a formal Non-Disclosure Agreement is executed by the University and external agency on behalf of their respective employees.*

In the event that an employee of YSU believes that they have created an item of intellectual property in the course of their scholarship and they have interest in contacting any commercial entity to discuss potential commercialization a Non-Disclosure Agreement should also be executed. The first step in this process is for the inventor (employee) to complete the Invention Disclosure, described above, and to contact the Associate Provost for Research and Dean, School of Graduate Studies and Research (or in the absence of the dean, the Director of Grants and Sponsored Programs), in order to define whether the University has any legal interest in the intellectual property or, alternatively, any economic interest in the event that YSU ownership is clear.

Interest in intellectual property is defined as follows: In the event that the intellectual property is an independent effort leading to employee owned intellectual property as defined above (Definitions), the University has no interest in the issue and the employee will be advised to contact external legal counsel about the issue. In the event that the intellectual property is a *work-for-hire or joint effort*, as defined above, the University will act as representative of the inventor in execution of a Non-Disclosure Agreement with any external entity (which funds and/or collaborates in the research project), in order to protect the confidentiality of the intellectual property prior to seeking either copyright or patent protection. Such a process is also used if the intellectual property is of a proprietary nature *for which copyright or patent protection will not be sought* (a trade secret).

Non-disclosure agreements are of two types (Appendices V and VI contain copies of these agreements):

- **Non-Disclosure Agreement** – A document designed to protect YSU intellectual property only, because the external entity is the “recipient” of the intellectual property.
- **Mutual Non-Disclosure Agreement** – A document designed to protect the intellectual property and confidentiality of both parties to the agreement. This form is usually used when an external agency *and* YSU employee intend to enter into a mutually beneficial research agreement which could result in intellectual property and employees of both entities are doing pertinent research either separately or in concert.

If a student is involved with the research of a faculty member who wishes to engage in collaborative research with individuals from an outside entity, where intellectual property may result and needs protection under a non-disclosure agreement; the faculty member will be advised to have the student execute the University Intellectual Property agreement described under “Student Involvement in Research” above. Failure to do so could invalidate the ability of the University to honor the terms of such an agreement and cause significant liability to the University, since a party to the research may then be unaware of their responsibilities under Board of Trustees Policies.

### **Material Transfer Agreements:**

In the course of some research projects it may become necessary to share created materials (chemical compounds, physical materials, computer codes, biological materials, etc.) with employees of outside entities (commercial or non-profit). In order to protect these forms

of intellectual property, but permit collaboration, a Material Transfer Agreement should be executed by the provider and recipient. Both the involved scientist and the Authorized Institutional Official should approve and sign the agreement. A Material Transfer Agreement specifies the uses permitted for the materials transferred (usually research and development only), that the recipient may not give the materials to any other person/entity, and that all information about the materials, such as possible uses, commercial application, etc. must be held in confidentiality. These agreements also have clauses relieving the provider of liability for uses by the recipient and specify that the materials may not be used for human experimentation. A standard Material Transfer Agreement (Appendix VII) can be provided by the Associate Provost for Research and Dean, School of Graduate Studies and Research upon request. It should not be used without first reviewing the appropriateness with the Associate Provost for Research and Dean, School of Graduate Studies and Research.

### **Procedure for Protecting Intellectual Property at YSU:**

1. The employee in the course of research, scholarship, or other activities that are expected to yield intellectual property maintains accurate documentation of the discovery, has it witnessed (i.e.: documentary supporting documents such as laboratory notebooks), and communicates the discovery to the Associate Provost for Research and Dean, School of Graduate Studies and Research.
2. If the discovery has been “reduced to practice,” the employee completes a final Invention Disclosure (Appendix IV) to the Associate Provost for Research and Dean, School of Graduate Studies and Research for review. If the discovery is of a preliminary nature a Preliminary Invention Disclosure is completed and sent to the dean. Upon receipt of the disclosure the dean will determine if the University has a legal ownership interest in the intellectual property.
3. If the University does have some ownership rights, the Associate Provost/Dean may consult with the University Research Council, as internal advisory body and/or external consultants as needed, to determine whether the University may have interest in proceeding with the patent protection process. The decision to initiate the patent application process will be based on the evaluation of the commercializability of the intellectual property and likelihood that it will yield royalty income. In some cases, if the public interest would be served by seeking patent protection (as in the case of an orphan drug, for example) the university could also move forward with the patent application.
4. If publication or public disclosure of the intellectual property has already occurred or is expected to occur in the near future, consideration will be given to application for a Provisional Patent in order to extend the patentability of the Intellectual property for one additional year. If research is being carried out in an area which has a high probability of producing intellectual property, all investigators should consider the effect of publication or public disclosure of their research findings.
5. The Associate Provost/Dean will also communicate with the University General Counsel, in order to seek the advice of outside counsel in the matter of researching and protecting the intellectual property if it appears that the invention will have commercial value or value to the public if it is commercialized.

6. A Patent Counsel will be retained to proceed with submission of the patent application to the U.S. Patent Office on behalf of the University.
7. In the event that a patent is issued, the Associate Provost for Research and Dean, School of Graduate Studies and Research will seek an external agency to track patent infringement in order to protect the invention and the Associate Provost/Dean will also monitor the generation of royalties and oversee the distribution of royalties according to existing University Policy and other contractual agreements.

### **Conclusion:**

The area of intellectual property law is extremely complicated and requires legal assistance to allow the proper protection of intellectual property. This Handbook is provided only as a guide to permit an employee to understand some of these complications and to guide the individual to discuss their discovery with the proper officials of the University and to protect both University and individual employee rights in this complex field. A patentable discovery is of no value unless it is properly handled and protected under current patent laws. In externally funded projects that lead to such discoveries, there are significant responsibilities the University has to fulfill to the funding agency as part of a grant or contract and failure to keep University officials informed can lead to significant liability for all concerned.

*Appendix forms are available on appropriate letterhead paper from the Office of the Associate Provost for Research and Dean, School of Graduate Studies and Research.*

### **Reference Guides Available in the Office of the Associate Provost for Research and Dean, School of Graduate Studies and Research:**

1. Joy L. Bryant, "Protecting Your Ideas," Academic Press, 1999: A readable discussion of intellectual property, types of protection, general procedures, etc.
2. Peter Kolchinsky, "The Entrepreneur's Guide to a Biotech Startup," Download at [www.evelexa.com](http://www.evelexa.com).
3. The Bayh-Dole Act – A Guide to the Law and implementing Regulations, Council on Governmental Relations, October 1999.
4. The Copyright Act: <http://www.copyright.gov/title17/>
5. Gary W. Matkin, "Technology Transfer and the University," American Council on Education/MacMillan, New York, 1990

## Appendix I



NUMBER

**1018.01**

PAGE 1 of 3

### *UNIVERSITY GUIDEBOOK*

**Title of Policy: Intellectual Property Rights**

Responsible Division: Academic Affairs – School of Graduate Studies & Research

Approving Officer: Provost and Vice-President for Academic Affairs

*Revision History:* December 1999; March 2006; November 2011

Resolution Number(s) YR 2001-31; YR 2006-29; YR 2012-17

Board Committee: Academic Quality and Student Success

**EFFECTIVE DATE:** December 14, 2011

Next Review: 2016

**Policy:** The development and dissemination of intellectual property benefit the public, the University, and its faculty, staff, and students. Research and scholarship are encouraged through an appropriate allocation of intellectual property rights between the creator and the University. Except for works for hire and joint efforts, an employee’s or student’s rights to copyrightable materials shall be governed by the applicable provisions of state and federal law. For all other Intellectual Property not governed by the copyright protection laws, the applicable state and federal laws shall govern the employee, student, University and external entity rights to such property. The President and the Associate Provost for Research and Dean of Graduate Studies and Research are specifically designated to serve as “Authorized Institutional Officials” with the right to approve licensing and royalty agreements with entities entering into a contractual or grant relationship for research and development activities to be carried out by the University.

**Definitions:**

- "Intellectual Property" includes inventions, discoveries, works of authorship, and/or other creative works that may be subject to protection under federal or state patent, copyright, trademark, and/or trade secret laws.
- "Invention" is any discovery, product, process, machine, composition of matter, and/or improvement that may be patentable.
- "Patent/Patentable" is any invention or other matter that may be patentable under the patent laws of the United States or foreign country.
- "Trade Secret" is any information that derives economic value from not being readily known or available to others and is protected from disclosure by reasonable efforts.
- "Copyright/Copyrightable" is any original work of authorship protectable under the copyright laws of the United States or foreign country.

**Parameter:** Section 3345.14 of the *Ohio Revised Code* provides that all rights to discoveries, inventions or patents that result from research or investigation conducted in any facility of a state university are the sole property of the University. The Board of Trustees may assign, license, transfer, or sell these rights as the Board deems appropriate.

**Procedures:**

1. The Associate Provost for Research and Dean of Graduate Studies and Research is responsible for administering intellectual property procedures as described in the "Handbook on Ownership of Intellectual Property" and for procedures for the allocation of income from intellectual property. Any faculty member, employee, or student who creates intellectual property that can be patented under applicable federal laws must disclose that information to the Associate Provost for Research and Dean of Graduate Studies and Research according to the procedures described in the "Handbook on Ownership of Intellectual Property."
2. As part of the duties of the Associate Provost for Research and Dean of Graduate Studies and Research as Authorized Institutional Official for grants and sponsored programs the dean may agree to assignment of intellectual property to the funding agency, provided that such assignment is appropriate to the project and maintains University rights to all or an equitable portion of royalties that may be generated by the project. Externally sponsored research is always between the sponsor as "grantor" and the University as

“grantee”; therefore, the University exercises intellectual property ownership over all intellectual property resulting from sponsored program support. No employee, other than an Authorized Institutional Official, may sign on behalf of the University for any sponsored program, licensing, or related agreement.

3. The University Research Council advises the Associate Provost for Research and Dean of Graduate Studies and Research regarding the ownership of intellectual property and the distribution of income derived from the intellectual property.
4. Ownership:
  - a. Employee Owned: Intellectual property privately created, made or originated by a faculty member, employee, or student, without use of University facilities, shall be the sole and exclusive property of the creator(s), except as he or she may voluntarily choose to transfer such property, in full, or in part.
  - b. University Owned: The University shall own the intellectual property in the following circumstances:
    - i. The University expressly directs a faculty member, employee, or student to create a specified work or the work is created as a specific requirement of employment, or a credit bearing course, or as an assigned institutional duty that may, for example, be included in a written job description or an employment agreement.
    - ii. The faculty member, employee, or student has voluntarily transferred the intellectual property, in whole or in part to the institution. Such transfer shall be in the form of a written document signed by the transferring individual.
    - iii. The faculty member, employee, external entity or student has contributed to a “joint effort” which has the ownership rights and any income distribution set forth in writing. Unless agreed in writing otherwise, all IP developed by students shall be the property of the University. Absent specific agreement for the ownership of intellectual property resulting from a sponsored program supported by an external entity, the intellectual property will be the property of the University.



## Appendix II

### Acceptable Standard Contract/Sponsored Agreement Language

#### Article 7 – Intellectual Property

- 7.1 All rights, title and interest to University Intellectual Property shall belong to University and shall be subject to the terms and conditions of this Agreement.
- 7.2 Rights to inventions, improvements and/or discoveries, whether patentable or copyrightable or not, relating to Project and made solely by employees of Sponsor without the use of University resources, shall belong to Sponsor. Such inventions, improvements, and/or discoveries shall not be subject to the terms and condition of this Agreement.
- 7.3 University will promptly notify Sponsor of any University Intellectual Property conceived and/or made during the Contract Period under Project. If University determines that a patent application or other application for intellectual property protection is to be filed, University shall prepare, file, and prosecute such U.S. or foreign application in University's name as it determines appropriate. University shall bear all costs incurred in connection with such preparation, filing, prosecution, and maintenance of U.S. and foreign application(s). Sponsor shall cooperate with University to assure that such application(s) include, to the best of Sponsor's knowledge, all items of commercial interest and importance. While University shall be responsible for determining the scope and content of application(s) to be filed and the prosecution thereof, Sponsor shall be given an opportunity to review and provide input thereto. University will keep Sponsor apprised of significant developments with respect to such application(s) and promptly supply Sponsor with copies of significant non-privileged papers received and filed in connection with the prosecution thereof in sufficient time for Sponsor to comment thereon.
- 7.4 If University elects not to file a patent application or seek other intellectual property protection, and/or decides to discontinue the financial support of the prosecution or maintenance of such protection, Sponsor shall be granted first option to file, continue prosecution and/or maintain any such application(s), and to maintain any protection issuing thereon in the U.S. and in any foreign country at Sponsor's sole expense. If Sponsor exercises its option to file prosecute and/or maintain protection of University Intellectual Property, all right, title and interest to University Intellectual Property remains with University.
- 7.5 Reasonable and customary costs expended by University or Sponsor pursuant to 7.3 or 7.4 to file, prosecute and/or maintain U.S. or foreign patent applications as

described in this section will be repaid to University or Sponsor from royalties realized from University Intellectual Property. Until such expenditures are repaid in full, \_\_\_\_\_ percent (\_\_\_%) of royalties realized from University Intellectual Property will be utilized for such repayment and \_\_\_\_\_ percent (\_\_\_%) of royalties will be allocated between University and Sponsor in accordance with the terms of this Agreement.

7.6 Nothing contained in this Agreement shall be construed as:

7.6.1 requiring the University to file any patent application, secure any patent or maintain any patent in force after the effective date;

7.6.2 a warranty or representation by University as to the validity or scope of any patents;

7.6.3 a warranty or representation by University that use of University Intellectual Property for any manufacture, sale, lease, or other use hereunder will be free from infringement of intellectual property owned by others than University;

7.6.4 conferring by implication, estoppel or otherwise upon Sponsor or other third party any license or other right regarding University Intellectual Property, except rights expressly granted hereunder; or

7.6.5 a warranty by University as to accuracy, sufficiency, or suitability for use of the University Intellectual Property made available hereunder, or for any products or processes made by the use thereof, and University assumes no responsibility or liability, including liability for consequential damages or loss, which might arise out of any use by Sponsor of University Intellectual Property.

## **Article 8 – Grant of Rights**

8.1 University grants Sponsor the first option for an exclusive license, with a right to sublicense, for University Intellectual Property on terms and conditions to be mutually agreed upon and consistent with this Agreement. Sponsor may exercise its option for an exclusive license within twelve (12) months from the date of termination of the Agreement. If Sponsor elects to exercise its exclusive option, Sponsor shall pay University a royalty fee of \_\_\_ percent (\_\_\_%) of net revenues realized from use of University Intellectual Property.

8.2 If Sponsor does not exercise its option for an exclusive license for University Intellectual Property, then University shall, at Sponsor's request, provide Sponsor with a non-exclusive royalty-free license.

## Appendix III

### Youngstown State University School of Graduate Studies and Research University Intellectual Property Agreement

(For Students having use of University Facilities or Resources and Graduate Assistants)

Name \_\_\_\_\_ Student Number \_\_\_\_\_ (please type or print)

I understand that my association with Youngstown State University (hereinafter referred to as UNIVERSITY), at least in part, may be in connection with one or more research or development projects, which may include contracts or grants between non-University sponsors (hereinafter referred to as SPONSORS) and UNIVERSITY.

I have been given a copy of the University Policy (1018.01) "Intellectual Property Rights" approved by the Board of Trustees and Ohio Revised Code, Section 3345.14. I understand this Policy, and I agree to abide by the terms thereof, especially noting the following responsibilities:

- 1) **to assign to UNIVERSITY (or its designate)** all rights which I have or may acquire in inventions, discoveries, or rights of patent therein (a) conceived, or (b) first actually reduced-to-practice by me in carrying out research with the significant use of UNIVERSITY facilities or resources;
- 2) **to submit invention disclosures to UNIVERSITY** following (a) the completion of conception, or (b) the first reduction-to-practice of any invention or discovery which use UNIVERSITY facilities or resources; and
- 3) **to do whatever is required to enable UNIVERSITY (or its designate)** to obtain a patent upon any invention or discovery (a) conceived, or (b) first reduced-to-practice by me with (i) the utilization of time, money, or facilities, charged to said contracts or grants or (ii) use of UNIVERSITY facilities or resources, provided that I shall not be charged with any costs or expenses involved therewith.

I also understand that, whenever I am associated with contracts and grants of certain SPONSORS, that the invention and patent provisions of the sponsor agreements and/or applicable institutional patent agreements may create additional responsibilities with respect to (1) submission of invention disclosures; (2) assignment of inventions; (3) execution of papers; (3) confidentiality of SPONSORS or UNIVERSITY owned information relating to the SPONSORS agreement, which are summarized below:

- A) Inventions (a) conceived, or (b) first reduced-to-practice by me in carrying out work under said contracts and grants must be assigned to SPONSORS if UNIVERSITY or SPONSORS so request;
- B) Inventions which utilized time, money, or facilities charged to said contracts or grants must be **promptly** reported to UNIVERSITY following (a) the completion of conception, or (b) the first actual reduction-to-practice; and
- C) Prior to completion of my association with said contracts or grants a complete disclosure of all inventions or discoveries (a) conceived, or (b) first reduced-to-practice by me with the utilization of time, money, or facilities charged to said contracts or grants must be submitted to UNIVERSITY.
- D) During the project, all information received from the SPONSOR or UNIVERSITY, which has been identified as proprietary or confidential, shall be considered confidential and may not be disclosed to any person outside of those authorized by UNIVERSITY to have access to such information.

It is understood that the responsibility set forth in Section 3) above will continue after termination of my association with UNIVERSITY.

---

Witness

---

Student Signature

---

Date

## Appendix IV

YOUNGSTOWN STATE UNIVERSITY

Page 1 of 2

### Preliminary or Final Invention Disclosure

Your invention or idea is important (1) to your professional development; (2) to the University; and if applicable, (3) to your research sponsor. It is essential that it be reported promptly, so that it can be evaluated to determine if there is (a) sufficient novelty to permit patenting, and if so, (b) sufficient commercial potential to justify a licensing program for industry.

1. Full name and address of the inventor(s):

Name and Status (Title):

Home Address:

2. Title of Invention:

3. Description of invention-attach description of invention, photographs, drawings, sketches, patent applications, or any other descriptive material. A draft journal article often will suffice for this description. Description should include the construction, the principles involved, and details of the operation, and alternative methods of construction or operation, including the following points:

- a. Problem to be solved, or purpose;
- b. Solution;
- c. Similar inventions in current use; and
- d. Disadvantages of present practice overcome by the invention.

4. Further research and development which is necessary or desirable before showing the invention to a potential industrial licensee.

5. a. Names and addresses (if known) of potential manufacturers.

b. Manufacturers presently making comparable equipment (if known).

c. Commercial possibilities, indicating estimated quantity and price range (if known).

6. Date of past publication or public use related to this invention, if any. (attach copy).

Where published or used \_\_\_\_\_

- a. If not yet published, has a manuscript been accepted?

When \_\_\_\_\_ Where \_\_\_\_\_

- b. If not yet accepted, has a manuscript been submitted?

When \_\_\_\_\_ Where \_\_\_\_\_

- c. If not yet submitted, will a manuscript be submitted? \_\_\_\_\_

Any prior applications for patents by inventors on related subjects (list serial numbers):

\*For plant varieties eligible for Certificates of Plant Variety Protection only, wherever appropriate, the term "inventor" shall include the breeder of a Novel Plant Variety; and the term "inventor" shall include the determination of a Novel Plant Variety.

7. Reasons for urgency in making patent application, if any (intended public use or publication, give estimated dates):

8. If conceived and/or reduced to practice in connection with a sponsored, state sponsor, and contract or grant number, if "none", so state:

9. Contribution of each co-inventor:

10. Continuation of above items or Remarks:

11. Please indicate inventor to be contacted for additional information:

_____	_____	_____	_____
Last Name	First Name	(Area Code)	Telephone Number

Signature(s) of Inventor(s):

_____	Date _____
_____	Date _____
_____	Date _____

Witnesses:

Disclosed to and understood by me:

_____	Date _____
_____	Date _____

## INVENTION DISCLOSURE INSTRUCTIONS

A Preliminary Invention Disclosure may be prepared and submitted for each invention conceived by faculty, staff, or students, paid or unpaid, of the University. The purpose of this Preliminary Invention Disclosure is to record a concept or idea that has not yet been reduced to practice and is not ready for patent filing. This form shall serve the purpose of documenting the concept of the invention only until such time as a Final Invention Disclosure document is received. This provides the basis for a determination of the date of conception only. A Final Invention Disclosure should be made (using the same form) when something new and useful has been conceived or developed (“reduced to practice” and demonstrated to work as the concept suggests), or when unusual unexpected, or unobvious research results have been achieved and can be utilized. This form can be used for either a Preliminary or Final Invention Disclosure by checking the correct box in the title of the document. *Please read these instructions carefully before completing the Invention Disclosure.*

The following instructions apply to the corresponding sections of the Invention Disclosure:

1. List all inventors. A co-inventor is an individual who has conceived an essential element of the invention either independently or jointly with others, during the evolution of the invention concept. **Note:** *Do not list any inventor gratuitously. The rules for inclusion are not the same as for a scientific publication. Inclusion as an inventor will have legal implications and includes rights to any royalty income distribution.*
2. Provide a brief, *nonconfidential title*, sufficiently descriptive to identify the general nature of the invention.
3. If this is a Preliminary Invention Disclosure give a brief description of the invention that does *not teach the art* (i.e., does not reveal confidential, proprietary information about the process or concept that would enable one to reproduce the invention) and that can be understood by someone generally knowledgeable about science.

In addition, if this is a Final Invention Disclosure (which has been reduced to practice) attach separately material which covers the following points (This attached section contains confidential information which describes the art involved with the invention and is covered by the Security Section below):

- a. general purpose or utility of invention-as part of this, provide a brief summary which addresses its essential nature;
  - b. technical description including drawings, schematics, sketches, etc., as appropriate;
  - c. advantages and improvements over existing practice, and the features believed to be new
5. Also list any companies which have received proposals based on the information contained in the disclosure and indicate when they received the information and whether a Non-Disclosure Agreement was completed prior to the delivery of the information.
  6. In recording the history of the Invention, give particular attention to the legally important events of conception. *As a general rule, public disclosure, in any manner which teaches the art, before the date a formal patent application is filed in a national patent office automatically eliminates patent rights in most foreign countries; foreign rights often are very important to potential industrial licensees. In the United States a patent application must be filed no later than one year after publication describing the associated invention. Note: Receipt of your Invention Disclosure form by the Office of the Dean of Graduate Studies and Research is not the same as the filing of a patent application.*
  8. Give the full applicable contract or grant number(s) and University account number, the name of the sponsor and the principal investigator's name, if the invention was a result of sponsored research that led to the conception or first actual reduction to practice of the invention. List specific university support as well.

## SECURITY INFORMATION

A completed invention disclosure contains confidential **University Proprietary Information**. Distribution to third parties of a disclosure **is expressly prohibited**, except under attorney-client privilege, to research

sponsors as required by contract, or under appropriate Non-Disclosure Agreements. Distribution within the University is limited to individuals having a *demonstrated need to know and who are bound, as a result of their employment, to maintain appropriate security at all times.*



## Appendix V

### NON-DISCLOSURE AGREEMENT

\_\_\_\_\_ ("COMPANY"), having its principal place of business at \_\_\_\_\_ desires to receive certain confidential information from Youngstown State University ("YSU"), a non-profit education institution of the State of Ohio, which COMPANY acknowledges to be confidential. COMPANY agrees to the following conditions under which certain valuable confidential information owned or controlled by YSU (the "Confidential Information") will be disclosed. This Agreement shall refer to YSU as the "Discloser" and COMPANY as the "Recipient".

1. The Confidential Information relates to: \_\_\_\_\_ developed by \_\_\_\_\_ at YSU (the "Confidential Information").
2. The Confidential Information may include, for example and without limitation, scientific knowledge, know-how, processes, inventions, techniques, formulae, products, business operations, customer requirements, designs, sketches, photographs, drawings, specifications, reports, studies, findings, data, plans or other records, biological materials, and/or software.
3. YSU intends to maintain the Confidential status of its Confidential Information. YSU is aware that Company may have pursued independent research of its own in the area to which the Confidential Information relates and may have independent knowledge of some of the information that YSU may disclose.
4. To the extent practical, YSU shall furnish its Confidential Information in documentary or tangible form marked as Confidential. However, if disclosure of Confidential Information is in non-documentary form, or if the disclosure is first made orally or by visual inspection, the Discloser shall have the right or, if requested by the Recipient, the obligation to confirm in writing the fact and general nature of such disclosure within thirty (30) days after such disclosure is made.
5. While the amount of Confidential Information to be disclosed is completely within the discretion of the Discloser, all disclosures under this Agreement shall be completed within one year of the effective date of this Agreement.
6. Recipient understands that disclosure of the Confidential Information could destroy the value of the information. Therefore, the Recipient agrees to exercise at least the same degree of care to protect Discloser's Confidential Information that it exercises to protect its own Confidential Information and in any event such care shall at least be reasonable care to prevent disclosure of Discloser's Confidential Information to any third party. Internal dissemination of Discloser's Confidential Information by the Recipient shall be limited to those employees, agents, representatives, consultants, or affiliates whose duties justify the need to know such information and then only on the basis of a clear understanding by

these individuals of their obligation (a) to maintain the Confidential status of such information and (b) to restrict the use of such information solely to the use specified in Paragraph 7 of this Agreement.

7. Recipient accepts the Confidential Information disclosed by the Discloser under this Agreement, for the sole purpose of evaluating it in order to determine Recipient's interest in engaging in research with respect to the Confidential Information, or in licensing and/or supporting research.
8. The Recipient shall be under no obligation with respect to any information:
  - a. which is, at the time of disclosure, available to the general public;
  - b. which becomes, at a later date, available to the general public through no fault of Recipient and then only after the later date;
  - c. which Recipient can demonstrate (i) was in its possession before receipt of the information from Discloser or (ii) was developed independently by Recipient without reference to the Confidential Information provided by Discloser;
  - d. which is disclosed to Recipient without restriction on disclosure by a third party who has the lawful right to disclose such information, or;
  - e. which is required to be disclosed to comply with applicable laws or government regulations, provided that prior written notice is given to the Discloser of such required disclosure and the Recipient takes lawful actions to avoid and/or minimize the degree of such disclosure.
9. Nothing contained in this Agreement shall be construed as granting or implying any right or license to use any Confidential Information disclosed under this Agreement except as set forth in Paragraph 7 above.
10. This Agreement shall remain effective for five (5) years from the date of the signing of this Agreement. YSU reserves the right to terminate this Agreement without notice and require Recipient to return, within thirty (30) days of receiving notice of termination, all Confidential Information and any copies of the Confidential Information. The five (5) year Confidentiality requirement shall survive the termination of this Agreement.
11. Upon the expiration of this Agreement, Recipient shall discontinue using and return all Confidential Information and copies of Confidential Information. Within thirty (30) days of receiving such a request from Discloser, Recipient shall discontinue using and return all Confidential Information and copies of Confidential Information. This paragraph shall not apply if YSU and COMPANY have executed a separate agreement that permits COMPANY to continue using the Confidential Information provided under this Agreement.
12. YSY does not release RECIPIENT from any liabilities based upon any copyright or patent or other rights YSU now possesses or may acquire concerning Confidential Information.

No license or other right under any U.S. or foreign patent, copyright, or know-how is granted or implied by this Agreement.

13. The interpretation and validity of this Agreement and the rights of the parties shall be governed by the laws of the State of Ohio. Any action brought to enforce this Agreement shall be brought in Ohio.
14. University will not disclose or provide to any employee or agent of Company any information subject to the licensing provisions of the International Traffic In Arms Regulations (ITAR) under 22 CFR §§ 120-130, or the Export Administration Regulations (EAR) under 15 CFR §§ 730- 774, without the prior written notice to and advance approval by an authorized representative of Company.
15. This Agreement constitutes the full and complete Agreement in this matter between YSU and RECIPIENT.

This Agreement shall be executed in duplicate and be effective as of the date signed by the party last to sign.

YOUNGSTOWN STATE UNIVERSITY

COMPANY

By: \_\_\_\_\_

By: \_\_\_\_\_

Title: Dean of Graduate Studies and Research  
and Authorized Institutional Official

Title:

Date:

Date:

## Appendix VI

### MUTUAL NON-DISCLOSURE AGREEMENT

Company Name ("Company") and University Name ("University") agree to the following conditions under which certain valuable confidential information owned or controlled by Company or University, or both, (the "Confidential Information") will be disclosed. This Agreement shall be effective on Insert Effective Date ("Effective Date"). A party disclosing information is referred to as the "Discloser" and a party receiving information shall be referred to as the "Recipient."

1. Confidential Information may include, for example and without limitation, scientific knowledge, know-how, processes, inventions, techniques, formulae, products, business operations, customer requirements, designs, sketches, photographs, drawings, specifications, reports, studies, findings, data, plans or other records, biological materials, and/or software. Insert additional information if desired
2. Company and University intend to maintain the confidential status of their Confidential Information. Company and University are aware that each may have pursued independent research of its own in the area to which the Confidential Information relates and may have independent knowledge of some of the information the other may disclose.
3. This Agreement shall remain effective for six (6) months from the Effective Date. All obligations of the Recipient with respect to the use and disclosure of Confidential Information hereunder shall terminate three (3) years from the Effective Date.
4. In order for Confidential Information disclosed by one party to the other to be protected in accordance with this Agreement it must be clearly identified as Confidential Information at the time of its disclosure. If Confidential Information is disclosed either orally or visually, at the request of Recipient, Discloser will put such information in a written statement, and such written statement shall be delivered to Recipient within thirty (30) days of such oral or visual disclosure.
5. Recipient shall exercise the same degree of care to protect Discloser's Confidential Information that it exercises to protect its own Confidential Information and in any event such care shall at least be reasonable care to prevent disclosure of Discloser's Confidential Information to any third party. Internal dissemination of Discloser's Confidential Information by the Recipient shall be limited to those employees, agents, representatives, consultants, or affiliates whose duties justify the need to know such information and then only on the basis of a clear understanding by these individuals of their obligation (a) to maintain the Confidential status of such information and (b) to restrict the use of such information solely to the use specified in Paragraph 6 of this Agreement.

6. Recipient shall not use the Confidential Information disclosed by the Discloser under this Agreement, except for the following purposes: to evaluate mutual business and research activities. Nothing contained in this Agreement shall be construed as granting or implying any right or license to any party to use another party's intellectual property or to use any Confidential Information disclosed under this Agreement for any other purpose.
7. Recipient shall be under no obligation with respect to any information:
  - a. which is, at the time of disclosure, available to the general public;
  - b. which becomes, at a later date, available to the general public through no fault of Recipient and then only after the later date;
  - c. which Recipient can demonstrate (i) was in its possession before receipt of the information from Discloser or (ii) was developed independently by Recipient without reference to the Confidential Information provided by Discloser;
  - d. which is disclosed to Recipient without restriction on disclosure by a third party who has the lawful right to disclose such information, or;
  - e. which is required to be disclosed to comply with applicable laws or government regulations.
8. Upon request by Discloser, Recipient will discontinue using and return all Confidential Information and copies of Confidential Information within thirty (30) days of receipt of the request, except that Recipient shall have the right to retain one copy of such Confidential Information in its legal archives for the purpose of determining its legal obligations hereunder.
9. Any notices required to be given or which shall be given under this Agreement shall be in writing and delivered by first-class mail, facsimile transmission, or email addressed to the parties as follows:

For University:

Youngstown State University  
ATTN: Associate Provost for Research and Dean  
School of Graduate Studies and Research  
One University Plaza  
Youngstown, OH 44555  
Phone: 330-941-3091  
Email: [pjkasvinsky@ysu.edu](mailto:pjkasvinsky@ysu.edu)

For Company:  
Company Name  
Company Contact  
Company Address  
Company Phone  
Company email

10. This Agreement reflects the entire agreement between Company and University regarding information disclosed hereunder, and the Agreement may be modified or altered only in writing.
11. The interpretation and validity of this Agreement and the rights of the parties shall be governed by the laws of the State of Ohio. Any action brought to enforce this Agreement shall be brought in Ohio.
12. Company will not disclose or provide to any employee or agent of University any information subject to the licensing provisions of the International Traffic In Arms Regulations (ITAR) under 22 CFR §§ 120-130, or the Export Administration Regulations (EAR) under 15 CFR §§ 730- 774, without the prior written notice to and advance approval by an authorized representative of University.

This Agreement may be executed in one or more counterparts including signing a facsimile or scanned electronic version. Each counterpart shall be deemed an original and all counterparts together shall constitute one and the same instrument.

**University**

**Company**

By: \_\_\_\_\_

By: \_\_\_\_\_

Name: Peter J. Kasvinsky

Name: \_\_\_\_\_

Title: Associate Provost for Research and  
Dean

Title: \_\_\_\_\_

Date: \_\_\_\_\_

Date: \_\_\_\_\_

## Appendix VII

Page 1 of 4

### MATERIAL TRANSFER AGREEMENT

This Agreement is between \_\_\_\_\_, a corporation having a place of business at \_\_\_\_\_ ("RECIPIENT"), and Youngstown State University ("YSU") having an address at One University Plaza, Youngstown, Ohio 44555. This Agreement shall govern the conditions of disclosure by YSU to RECIPIENT of certain biological or other Materials ("MATERIALS") relating to:

\_\_\_\_\_ developed by \_\_\_\_\_ ("INVESTIGATOR") of YSU and further identified as \_\_\_\_\_. YSU retains ownership of the MATERIALS including any material contained or incorporated in Modifications. The MATERIALS are provided to RECIPIENT for use by \_\_\_\_\_ ("SCIENTIST") in SCIENTIST'S laboratory. MATERIALS include all such biological or other samples actually provided to RECIPIENT, plus any Progeny and/or any Unmodified Derivatives of the original biological samples.

A. DEFINITIONS. The following definitions shall apply to this Agreement:

1. Progeny: Unmodified descendant from the MATERIAL, such as virus from virus, cell from cell, or organism from organism.
2. Unmodified Derivatives: Substances created by RECIPIENT that constitutes an unmodified functional sub-unit or an expression product of the MATERIALS. Some examples include: sub clones of unmodified cell lines, purified or fractionated sub-sets of the MATERIALS, proteins expressed by DNA/RNA supplied by YSU, monoclonal antibodies secreted by a hybridoma cell line, subsets of the MATERIALS such as novel plasmids or vectors.
3. Modifications: Substances created by RECIPIENT that contain or incorporate the MATERIALS.
4. Commercial Purposes: The sale, lease, license, or other transfer of the MATERIALS or Modifications to a for-profit organization. Commercial Purposes shall also include uses of the MATERIALS or Modifications by any organization, including RECIPIENT, to perform contract research, to screen compound libraries, to produce or manufacture products for general sale, or to conduct research activities that result in any sale, lease, license or transfer of the MATERIALS or Modifications to a for-profit organization. However, industrially sponsored academic research shall not be considered a use of the MATERIALS or Modifications for Commercial Purposes per se, unless any of the above conditions are met.

B. PRICE. RECIPIENT shall pay YSU (\$\_\_\_\_\_) due upon execution of this Agreement.





- C. USE OF MATERIALS. RECIPIENT agrees:
1. that the MATERIALS will be used only in SCIENTIST'S laboratory and only by SCIENTIST and laboratory personnel under SCIENTIST'S immediate and direct control;
  2. to use MATERIALS for the sole purpose of teaching and academic research and NOT for any Commercial Purposes;
  3. that MATERIALS will be received, handled, stored, used and disposed of in compliance with all applicable laws, regulations and guidelines, and in accordance with safe and prudent practices, and will not be administered to human subjects or provided to any third parties, nor will any animals or plants exposed to MATERIALS, or products of such animals or plants, be used for food; and
  4. that RECIPIENT has adequate systems, procedures and personnel to review and oversee arrangements for the receipt, handling, storage, use and disposal of experimental materials of the nature of MATERIALS and that it will ensure that all persons involved in receiving, handling, storing, using or disposing of MATERIALS are adequately qualified by training and experience to do so safely and legally.
- D. TRANSFER OF MATERIALS. RECIPIENT shall not transfer MATERIALS to any others (except to its employees, agents or consultants who are bound to RECIPIENT by like obligations conditioning and restricting access, use, and continued use of MATERIALS) without the express written consent of YSU.
- E. WARRANTIES. RECIPIENT acknowledges that MATERIALS are experimental products of research that may not have been fully characterized, and will accept MATERIALS as is and entirely at its own risk and without exculpatory reliance on any information or representation/s that may be, or have been, furnished or made by or on behalf of YSU, including without limitation information or representation/s as to (i) the composition, characterization, purity, stability, safety or utility of MATERIALS, (ii) the applicability, efficacy or safety of any method/s of preparing, handling, storing, using or disposing of MATERIALS, or (iii) the freedom from claims by others of intellectual or other property rights in MATERIALS or in any such methods. All warranties, express or implied, in respect of MATERIALS, including warranties of merchantability and of fitness for any particular purpose, are disclaimed by YSU.
- F. LIMITATION ON DAMAGES. YSU shall not be liable for any indirect or consequential damages attributable in any way to the subject matter of this Agreement, whether or not it had actual or constructive notice of the potential for such damages occurring, nor in any event shall YSU be liable for any damages attributable in any way to the subject matter of this Agreement which exceed the amount of any payment received by YSU under this Agreement.

- G. TERM. YSU may terminate this Agreement and require return or destruction of the MATERIALS by RECIPIENT upon thirty (30) days written notice. RECIPIENT shall otherwise destroy all copies of MATERIALS within one year of the effective date of this Agreement, unless:
1. this deadline is extended by YSU in writing; or
  2. RECIPIENT has indicated to YSU in writing its desire to obtain a commercial license to MATERIALS and negotiations to that end have begun.
- H. INDEMNIFICATION. Except to the extent prohibited by law, RECIPIENT shall indemnify YSU against any claims, costs, or other liabilities which may arise as a result of RECIPIENT'S use of MATERIALS.
- I. NOTIFICATION. RECIPIENT may file patent applications claiming inventions made by RECIPIENT through the use of the MATERIALS but agrees to notify YSU and INVESTIGATOR upon filing a patent application claiming Modifications or uses of the MATERIALS. SCIENTIST will inform INVESTIGATOR in confidence of research results related to the MATERIALS, by personal communication or by providing copies of manuscripts describing the results of such research at the time the manuscripts are submitted for publication.
- J. USE OF NAME. RECIPIENT shall acknowledge the source of MATERIALS in any descriptions of experiments and/or results involving MATERIALS. However, neither RECIPIENT nor its personnel will otherwise use, or authorize or permit the use of, the name of any YSU organization or personnel in connection with any commercial or promotional activities relating to MATERIALS, nor in such a way as to imply any endorsement by YSU or YSU personnel of any Material, product or method.
- K. RIGHTS TO MATERIAL. The furnishing of MATERIALS to RECIPIENT shall not constitute any grant or license to RECIPIENT under any legal rights now or later held by YSU other than as stated in this Agreement. The provision of the Material to RECIPIENT shall not alter any pre-existing right to the MATERIALS. Without written consent from YSU, RECIPIENT may NOT provide Modifications for Commercial Purposes. It is recognized by RECIPIENT that such Commercial Purposes may require a commercial license from YSU and YSU has no obligation to grant a commercial license to its ownership interest in MATERIALS incorporated in any Modifications. Nothing in this paragraph, however, shall prevent RECIPIENT from granting commercial licenses under RECIPIENT'S intellectual property rights claiming such Modifications, or methods of manufacture or their use.
- L. ENTIRE AGREEMENT. This Agreement reflects the entire agreement between YSU and RECIPIENT, and the Agreement may be modified or altered only in writing.
- M. INTERPRETATION AND JURISDICTION. The interpretation and validity of this Agreement and the rights of the parties shall be governed by the laws of the State of Ohio. Any action brought to enforce this Agreement shall be brought in Ohio

This Agreement shall be executed in duplicate and be effective as of the date signed by the party last to sign.

YOUNGSTOWN STATE UNIVERSITY

RECIPIENT

By: \_\_\_\_\_

By: \_\_\_\_\_

Name: Peter J. Kasvinsky

Name: \_\_\_\_\_

Title: Associate Provost for Research and Dean  
School of Graduate Studies and Research

Title: \_\_\_\_\_

Date:

Date:

Signature: \_\_\_\_\_

Signature: \_\_\_\_\_

Name: \_\_\_\_\_

Name: \_\_\_\_\_

Title: Investigator

Title: Scientist

Date:

Date:

*Prepared by:*  
*Youngstown State University*  
*School of Graduate Studies and Research*  
*Peter J. Kasvinsky, Associate Provost for Research & Dean*  
*One University Plaza*  
*Youngstown, Ohio 44555*

*November 2005*  
*Revised: 3/2012*

**Youngstown**  
STATE UNIVERSITY