

Tangible Research Property Policy

1. Objectives

Tangible research property (TRP) is a valuable asset to The University of Tennessee (the University). This policy protects the University's property rights by addressing definition, responsibility, control, and distribution of tangible property produced during activities supported by the University; supported by external sponsors; or produced with University facilities, resources, or personnel. It is the University's intent to preserve TRP where necessary to allow reconstruction of scientific and medical research and to capture commercial value where economically feasible, while not interfering with the normal conduct of research. The policy also guides the distribution of TRP and resolution of disputes involving TRP.

2. Definition of Tangible Research Property

For the purposes of this policy, TRP includes all tangible items produced in the course of research or other projects supported by the University or external sponsors. TRP includes, but is not limited to, biological materials, engineering drawings, computer software, integrated circuit chips, computer databases, prototype devices, circuit diagrams, and equipment.

TRP is distinct and separate from other research data and intellectual property such as patentable or copyrightable works, and trademarks. Intellectual property that develops from research activities and/or data is subject to a separate policy (see The University of Tennessee Statement of Policy on Patents, Copyrights, and Other Intellectual Property, the "IP Policy"), as are research data (see Research Data Policy).

3. Responsibility for Tangible Research Property

The University is ultimately responsible for the accuracy and sufficiency of research records, the cornerstone of rigorous research. Therefore, the University as well as the researcher have rights and responsibilities of ownership of Tangible Research Property developed by University personnel in performing the duties of their employment by the University or through substantial use of facilities or funds provided by the University. Such ownership applies to research funded by external sources and managed by the University, unless the University agrees to another arrangement in a grant, contract or other agreement.

4. Control of Tangible Research Property

The University supports the principle of openness in research. Free dissemination of data, processes, and results of research and other sponsored activity is crucial to a vibrant and healthy academic environment. The University promotes the prompt and open exchange of

TRP and associated research data with scientific colleagues outside the investigator's immediate laboratory or department, subject to relevant grants, contracts, other agreements, or applicable law.

In the case of externally sponsored research involving a grant, contract, or other agreement, the Principal Investigator (PI) is responsible for controlling storage, use, and distribution of TRP arising from the research activity, subject to provisions of the applicable grant, contract, or other agreement, or University policy, or applicable law. The laboratory or department head is responsible in situations where the research is performed without a grant, contract, or other agreement, such as institutionally sponsored research. The responsibility includes determining whether TRP may be distributed outside the department or laboratory for other's scientific uses. Control of TRP, however, remains at all times subject to the other provisions of this policy.

Because TRP may have commercial value, the responsible party may desire to limit the dissemination of TRP to individuals involved in the research. This restriction of dissemination should be carefully considered and should not unreasonably impact outside scientific research, public use, or other commercial development. Scientific exchanges should not be inhibited by unreasonable commercial considerations, only by those being actively pursued.

All TRP transfers outside the University require a material transfer agreement (MTA) approved by the Campus Research Office and, if applicable, The University of Tennessee Research Foundation (UTRF).

5. Commercialization of Tangible Research Property

TRP may be commercialized, typically through a license agreement providing for commercialization income. In addition, a license agreement may be negotiated for the intangible property rights associated with the TRP. All such agreements must be established in accordance with the IP Policy.

Commercialization must be coordinated through UTRF.

In the course of evaluating the commercial potential of University-owned TRP, prospective licensees may require specific information. To protect University ownership and other rights, disclosure of unpublished inventions, discoveries, or other pertinent information to third parties should be made only after the third party has signed a Confidentiality Agreement, as provided by UTRF.

6. Distribution of Tangible Research Property

All persons involved in TRP exchanges with other institutions are responsible for promptly contacting the Campus Research Office to disclose the nature and detail of such activities and otherwise complying with this policy. TRP leaving the University must be supported by

an MTA developed in conjunction with the Campus Research Office. Consultation with UTRF may be required and is recommended.

Before distribution, each item of TRP should be marked with unambiguous identification, as developed and documented by the Department Head, sufficient to distinguish it from other similar items developed at the University or elsewhere. In certain instances, ownership marks may be necessary to meet the University's contractual obligations and administrative requirements. Because of the various types of TRP, the use of such ownership marks could include the name of the institution, the name of the TRP developer, a copyright notice, a trademark notice, or other identifying marks. The selection of the ownership mark will depend upon the nature of the TRP.

a. Distribution for research purposes

1. Biological TRP

Biological materials must be shipped or transferred in a manner that satisfies regulations addressing transfer of infectious or other hazardous agents or recombinant DNA material. Please consult with the Campus Safety Office if the biological material may fall within the scope of these regulations.

All biological material transfers must be pursuant to an appropriate MTA approved by the Campus Research Office and, if applicable, UTRF.

2. Software TRP

Distribution of University-owned software for research purposes must be coordinated through the Campus Research Office and UTRF if (i) the software has potential commercial value, (ii) the PI wishes to control subsequent use, or (iii) the software is subject to the provisions of contracts, grants, or other agreements.

UTRF will work with the PI to establish an appropriate agreement with the recipient. If approved, UTRF will arrange for patent, copyright, or trademark protection.

3. Other forms of TRP

Other forms of TRP should typically follow the policy for software outlined above. Should questions arise, contact the Campus Research Office.

b. Distribution for Commercial Purposes

If TRP developed as a result of research activities at the University is to be distributed to outside users for commercial purposes, UTRF will coordinate the distribution as provided in Section 5 of this policy.

c. Procedures for Receiving TRP from other organizations

Organizations supplying TRP to University scientists and staff will typically insist on entering into an appropriate MTA. The recipient of the TRP must send the MTA to the Campus Research Office for review and execution.

MTAs from provider organizations may contain unacceptable conditions. Two of the most common unacceptable terms are demands for ownership of any invention or discovery made using their TRP and restriction of the right to publish research results. Demands for ownership conflict with the IP Policy and with federal law where government funding supports the research. These demands may also interfere with research by preventing researchers from obtaining materials and funding from other sources.

The Campus Research Office will work to resolve disagreements over terms through negotiations with the transferring organization. In the case of ownership of inventions, reasonable license rights may be offered, consistent with other commitments, legal requirements and University policy. Regarding the right to publish, a reasonable delay in publication may be granted if acceptable to the PI and in conformity with the applicable grant, contract, or other agreement, so that the transferring organization can review proposed publications.

In some instances, a grant, contract, or other agreement will have terms that provide for transfer of certain classes of TRP. In such cases, transfers of the materials may not require a separate MTA, but the terms for transfer in such an agreement must be reviewed by the Campus Research Office.

7. TRP Transfer When a PI Leaves the University or a Grant is Transferred

If a PI leaves the University and a research project is to accompany the PI to a new institution, TRP may be transferred in conjunction with the transfer of a grant, contract, other agreement. In recognition of existing rights to the TRP which are held by the University or a contracting third party, all TRP must be cleared for transfer by the Department Head, the Campus Research Office, and/or UTRF. An MTA may be required to document the transfer of the TRP and associated liability to the new organization.

8. Resolving Disputes Concerning Tangible Research Property Ownership or Policy

Questions of TRP ownership or other matters pertaining to the TRP policy will be resolved by the campus Chief Research Officer in conformance with applicable University Policies.

9. Distribution of Income from the Sale or License of Tangible Research Property

Distribution of any TRP-related royalty income will follow the income distribution plan described in the IP Policy.