

New York University

Tangible Research Property

Summary: Establishes NYU policy for ownership and distribution of tangible property resulting as a product or by-product of research activities.

Effective Date: 3/1/2010

Issuing Authority: University Provost

Responsible Officer: Senior Vice Provost for Research

Who Needs to Know this Policy: This policy shall apply to all University faculty, staff, postdoctoral appointees, students and any other persons involved in the conduct of research at or under the auspices of the University, and it shall apply to all research projects on which those individuals work, regardless of the source of funding for the project.

Related Policies: Statement of Policy on Intellectual Property; Policy on Access to and Retention of Research Data

CONTENTS

1. Definition of Tangible Research Property (TRP)
2. Ownership of TRP
3. Control of TRP
4. Income from TRP
5. Purpose of TRP Procedures
6. Identification of TRP
7. Distribution of TRP for Research Purposes
8. Distribution of TRP for Commercial Purposes

The following policy and procedures are directed toward the administration and distribution of Tangible Research Property (TRP) which is owned and/or controlled by NYU. The policy and procedures are subject to NYU's contractual obligations and are to be interpreted and applied consistent with and complementary to NYU's other policies affecting the administration of tangible properties.

1. DEFINITION OF TANGIBLE RESEARCH PROPERTY (TRP)

“Tangible Research Property” (“TRP”) is defined for purposes of this Policy as tangible (or corporeal) items produced in the course of research, clinical or other activities at NYU. TRP includes, but is not limited to, such items as: biological materials, engineering

drawings, integrated circuit chips, physical embodiments of computer software and computer databases (e.g. computer disks), prototype devices, circuit diagrams, equipment.

TRP is separate and distinct from intangible (or intellectual) property such as inventions, patents, copyright and trademarks, or research data, which are subject to other policies and guidelines (see NYU Policy on Intellectual Property, NYU Policy on Access to and Retention of Research Data). Individual items of TRP may be associated with one or more intangible properties such as copyright or patents.

2. OWNERSHIP OF TRP

TRP shall be owned by NYU, unless it is subject to other ownership provisions of contracts, grants or other agreements entered into by NYU.

3. CONTROL OF TRP

A. FREEDOM OF ACCESS

Consistent with NYU's Openness in Research Guidelines in the Faculty Handbook (p. 90), it is NYU's policy to promote the prompt and open exchange of TRP and associated research data with scientific colleagues outside the investigator's immediate laboratory.

B. RESPONSIBILITIES

It is the responsibility of the principal investigator (or laboratory director or department chair, if the TRP is not developed as part of a project headed by a principal investigator) to ensure the proper development, storage, use, and distribution of TRP made in the course of research activity, subject to provisions of applicable sponsored agreements and University policy. Such responsibility includes determining if and when distribution of the TRP is to be made beyond the laboratory for others' non-commercial scientific use.

C. COMMERCIAL CONSIDERATIONS

Because TRP may have potential commercial value as well as scientific value, TRP should be made broadly available for others' non-commercial scientific use by means which do not diminish its value or inhibit its commercial development or public use. Although valid non-commercial reasons may exist for the temporary delay of TRP distribution outside the laboratory for others' scientific use (e.g., safety factors or the need to more fully characterize the TRP prior to distribution, etc.) scientific exchanges should not be inhibited due to potential commercial considerations.

4. INCOME FROM TRP

A. RECOVERABLE COSTS

TRP may be licensed to for-profit companies, through licensing or material transfer agreements which include provision for royalty income (see section 8.B below). When distributing TRP to research colleagues outside the laboratory, costs of the raw materials and handling may be recovered from the recipient and returned to the account which funded those costs.

B. CONTRACTUAL OBLIGATIONS

If any of the initial costs were funded from sponsored agreements, the applicable sponsored programs office (the Office of Sponsored Programs at Washington Square or Sponsored Program Administration at the School of Medicine) should be asked to advise on the contractual obligations regarding distribution of the TRP and disposition of the recovered costs. If any costs are charged for TRP distribution, adequate documentation must be maintained for audit purposes.

5. PURPOSE OF THE TRP PROCEDURES

The following procedures for identification and distribution of TRP are designed to aid the traditional open distribution and exchange of TRP for research purposes, preserve the potential commercial value of TRP, assist the further development of TRP for public use, and protect the University and its employees from liability claims arising from the use of NYU TRP by others.

6. IDENTIFICATION OF TRP

A. IDENTIFICATION SYSTEM

Each item of TRP should have an unambiguous identification code and name sufficient to distinguish it from other similar items developed at NYU or elsewhere. For TRP that is being commercialized by NYU, researchers should contact the Office of Industrial Liaison (OIL), so that OIL may maintain a database of TRP provided outside of NYU.

B. OWNERSHIP MARKS

Where applicable (e. g., embodiments of computer software), each item should also carry the name of the TRP owner and such other marks and legends as may be required to meet NYU's contractual obligations and administrative needs, including notice of copyright, trademark, government rights, etc.

Information regarding identification, marks, and legends required under sponsored agreements can be obtained from the applicable sponsored programs office.

7. DISTRIBUTION OF TRP FOR NON COMMERCIAL RESEARCH PURPOSES

A. BIOLOGICAL TRP

Material Transfer Agreements

Each distribution for non-commercial or commercial research purposes should be accompanied by a Material Transfer Agreement provided by and signed by the Office of Industrial Liaison. (Note: For information about regulations regarding transfer of infectious agents or recombinant DNA material, contact the Office of Environmental Health and Safety.)

B. SOFTWARE TRP

1. Distribution Agreement

If software owned by NYU has commercial value or if it is considered desirable to control subsequent use, distribution of any associated TRP for research purposes must be coordinated with OIL and must be accompanied by an appropriate agreement with the recipient. OIL will arrange for trademark and copyright registration as needed. OIL will also provide wording for the distribution agreement as necessary to preserve commercial value and provide coordination with existing or prospective commercial licensing activities.

2. Contractual Obligations

When software results from a sponsored agreement, OIL or the applicable sponsored programs office, respectively, should be consulted regarding contractual obligations and regulations affecting ownership, disposition of various rights, and restrictions on the distribution and use of TRP and any associated income.

C. OTHER FORMS OF TRP

OIL should be consulted regarding the distribution of TRP other than biological products.

8. DISTRIBUTION OF TRP FOR COMMERCIAL PURPOSES

A. DISTRIBUTION AGREEMENT

If TRP developed by NYU as a result of research activities is to be distributed to outside users for commercial purposes, through license or other agreements, the distribution agreement must contain provisions negotiated by OIL covering the terms under which the property may be used, limits on the University's liability for the property or products derived there from, and disposition of any royalty income to NYU from the licensing of intangible property rights associated with the use of the tangible property.

When TRP is subject to commercial distribution the University asserts ownership of any underlying research data that were developed at the University or under University auspices.

B. INCOME DISTRIBUTION

Distribution of any TRP-related royalty income other than patent royalties will be similar to the patent royalty income distribution policy (see NYU Policy on Intellectual Property) except that a portion of income may be distributed to a research account in the laboratory which produced the TRP to reimburse costs associated with generating and transferring the TRP (subject to any contractual obligations regarding distribution of income). Questions regarding distribution of any royalty income to individuals should be referred to OIL.

C. CONTRACTUAL OBLIGATIONS

If the TRP results from a sponsored agreement, OIL or the applicable sponsored programs office, respectively, should be consulted regarding contractual obligations and regulations affecting ownership, notices, acknowledgments, disposition of various rights, and restrictions on the distribution and use of the TRP and any associated income.

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