

Patent Guidelines at the University of Oregon

Additional Information

These guidelines are to inform employees of their obligations and some background on how intellectual property is handled at the University.

1. UO employees assign work-related inventions to the university.
2. UO employees have a responsibility to [disclose to Industry, Innovation, and Translation](#) any inventions they make.
3. UO may waive work-related inventions, but these must first be disclosed and go through the waiver process.
4. UO, in consultation with inventors, will make UO-owned inventions available to industry and the public in an effective and non-discriminatory manner, obtain reasonable royalties for use in furthering institutional education and research objectives, and reward inventors through participation in net royalty income received.

Ownership

- 1) UO employees assign work-related inventions to the university.

UO reserves ownership to all work-related inventions, and inventions made with institutional resources. (See [UO internal directives](#) for more information). Inventions made with the use of a grant, gift, or sponsored research funds count as having been made with institutional resources. As a condition of employment, employees shall agree to assign rights in those items to the university ([UO Policy II.07.2](#)). UO can waive this ownership back to the inventors or funding agencies in certain circumstances as outlined in waivers section below.

Disclosure

- 2) UO employees have a responsibility to disclose to Industry, Innovation, and Translation (IIT) any inventions they make.

As a condition of employment, UO employees are responsible for [disclosing to the university, through IIT, all inventions and technological improvements](#) made during the conduct of normal activities ([UO Policy II.07.2](#)). We understand that you may not always know or recognize when an innovation may or may not be patentable, and we encourage faculty and staff to [contact IIT](#) to explore this possibility with regard to their projects. Typically, patents are only useful when an invention has commercial potential, but there are a wide variety of different ways to protect your intellectual property, and our team can

discuss your options with you and how to best facilitate project goals. Our federal sponsors have specific disclosure requirements through the [Bayh-Dole Act](#) that are important for all of us to meet.

Waivers

- 3) UO may waive work-related inventions, but these must first be disclosed and go through the waiver process.

UO's rights in an invention can be waived if it is determined that the invention is not related to work or an assigned project and that the development of the invention used no or minimal use of institutional funds or facilities. (See [UO internal directives](#) for more information.) For the preceding to apply, no external or internal funding through the university can have been used. If this is the case, a statement can be issued that waives any institution claim on the invention. For this statement to be issued, however, the institution must first know enough about the invention so that it can work with all of the stakeholders (department, college, center/institute) to go through our waiver process to document the determination.

Even if a UO employee has an invention that was made outside of work responsibilities and with no or minimal use of institution resources (and NO university funding, internal or external), UO requires that the employee disclose an invention to IIT so the waiver of the university's rights can be determined and documented. This is a benefit to our employee inventors, as it can proactively clear up the questions of ownership of an invention and provide certainty to their partners, and it also acts as an important part of providing transparency to the public and actively managing any potential conflicts of interest that may arise from the intersection of this work with their responsibilities at UO.

UO may waive work-related inventions through the waiver process. If UO determines that a disclosed invention is incidental to the employee inventor's work assignment or that UO has no interest in an invention and decides to forego patenting of an invention, then UO may at its discretion complete a waiver process to waive its rights to such an invention. In this case, if the invention was funded by a federal funding agency, UO would waive the rights back to the funding agency, and the employee inventor would need to petition the agency to have the rights returned to them. We can help you with the petitioning process. When waivers are made, they also seek to ensure that potential conflicts of interest are managed.

Licensing

- 4) UO, in consultation with inventors, will make UO-owned inventions available to industry and the public in an effective and non-discriminatory manner, obtain reasonable royalties for use in furthering institutional education and research objectives, and reward inventors through participation in net royalty income received.

Licensing terms can vary widely depending on the intellectual property, licensee and industry. We encourage you to work with IIT to find the best fit for your research and goals with commercialization.