

Intellectual Property Handbook

1. [Intellectual Property Policy and Guidelines of UT System](#)

2. Intellectual Property Policy and Guidelines of UTEP

2.1 General Policy

2.1.1 This policy applies to all UTEP personnel subject to Series 90101, Number 2, Section 2, of the [Regents' Rules and Regulations](#) (UTEP Employees).

2.1.2 UTEP Employees are required to disclose intellectual property to the Office of Technology Transfer prior to public disclosure by filing a completed [Invention Disclosure Form \(IDF\)](#), a copy of which is available from the Office of Technology Transfer or online at the [Office for Technology Transfer's website](#).

2.2 Responsibilities of the Office of Technology Transfer (OTT) & Intellectual Property Committee (IPC)

2.2.1 The Office of Technology Transfer and Intellectual Property Committee reviews each disclosed intellectual property and recommends to the Vice President of Research specific action that UTEP should take with regard to the invention.

2.2.2 When the Vice President for Research, or his designee, decides to patent or copyright an intellectual property, the Office of Technology Transfer contracts with outside intellectual property counsel approved by the Texas Attorney General's Office and UT System to obtain the appropriate protection. Inventor(s) must assist throughout this process to ensure getting the strongest intellectual property protection. UTEP bears the expense of protecting such intellectual property.

2.2.3 The Office of Technology Transfer determines how to commercialize inventions. Inventions need not be patented or copyrighted to be commercialized.

2.2.4 The Office of Technology Transfer defines inventors consistent with U.S. patent law regardless of the manner in which the intellectual property is protected.

2.2.5 The Office of Technology Transfer negotiates and administers all agreements relating to intellectual property owned by The Board of Regents (Board) for and on behalf of UTEP. Such agreements may include, but are not limited to, non-disclosure agreements, distribution agreements, joint ownership agreements, option agreements, and license agreements. Board and UTEP may grant licenses of any type, including, but not limited to, exclusive or nonexclusive licenses. No arrangement with any commercial entity may undermine UTEP's basic missions and must be carried out in a manner that does not place UTEP or inventor(s) in a position of having or appearing to have a conflict of interest. In addition, all license agreements must provide UTEP and its inventor(s) protection from undue restrictions of scientific

publication and provide full indemnification and use of name restrictions.

- 2.2.6 Intellectual property agreements may yield a variety of different financial payments, which may include, but are not limited to, up-front license fees, milestone payments, royalties and equity. All such income will be received through the Office of Technology Transfer, which will maintain accounts documenting intellectual property expenses, income and disbursement.

2.3 Policy for Disbursing Non-equity Compensation Generated Through Licensing

- 2.3.1 Before disbursing licensing income, UTEP will deduct the expenses it incurred to protect, manage, and transfer the intellectual property. Additionally, UTEP may withhold a portion of the income received through licensing to meet expected future expense obligations.

- 2.3.2 Disbursable net licensing income for licensed intellectual property will be distributed according to the following formula:

50% to inventor(s) as Personal Share(s)

25% to OTT

15% to inventor(s') College

10% to inventor(s') Department

Licensing income retained by UTEP may be used for research, managing intellectual property, and creating technology development services.

- 2.3.3 If multiple inventors are due to receive Personal Shares resulting from a license generating income, the inventors must submit a written revenue sharing agreement signed by all inventors to the Office of Technology Transfer. The revenue sharing agreement must specify how disbursable income from a license should be proportionally divided amongst the inventors. If inventors cannot agree on an appropriate revenue sharing agreement, all such disputes will be settled according to Series 90102, Section 3, Number 4, of the [Regents' Rules and Regulations](#).

- 2.3.4 Disbursements are made annually.

2.4 Equity Ownership and Business Participation

- 2.4.1 UTEP may accept equity in business entities as compensation for intellectual property rights conveyed to such entity. In addition, UTEP may accept Founding Shares in startup companies as compensation for its efforts in forming these companies. Each type of equity is handled differently:

- Publicly traded equity received for technology licensed to an entity will be shared according to the following formula:

50% to inventor(s) as Personal Share(s)

50% retained by UTEP

- Private equity received for technologies licensed to an entity will be shared according to following formula:

50% to inventor(s) as Personal Share(s)
50% retained by UTEP

All Founders Shares received by UTEP for its activities in the formation of a company are retained by UTEP and are not subject to sharing.

2.4.2 Any inventor who receives a Personal Share in equity is subject to a Conflict of Interest Management Plan.

INVENTION DISCLOSURE PROCESS

