

## 17.01.02 Evaluation and Protection of Intellectual Property

Approved May 1, 2019  
Next Scheduled Review: May 1, 2029



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### Regulation Summary

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This regulation requires the prompt disclosure of intellectual property (IP) and tangible research property (TRP), defines the intellectual property disclosure evaluation process, and describes the authorized process for protecting disclosed intellectual property.

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### Definitions

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Click to view [Definitions](#).

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### Regulation

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#### 1. DISCLOSURE

Individuals subject to System Policy *17.01, Intellectual Property Management and Commercialization*, are required to promptly disclose to Texas A&M Technology Commercialization (TTC) or their representative member commercialization office with a copy to TTC, all inventions, copyrightable work and TRP in which The Texas A&M University System (system) has an ownership interest under the provisions of System Regulation *17.01.01, Ownership of Intellectual Property and Tangible Research Property*, or for which disclosure is required by contract or law (hereinafter disclosure IP). Prompt disclosure is especially important for inventions conceived and/or made with federal or state agency funding so that the system and/or member may meet its legal obligations under such funding agreements.

Questions about whether an idea or discovery constitutes an invention, and is therefore patentable, can be complex. Any publication or verbal disclosure that describes a patentable invention prior to filing for patent protection may limit the scope of any patent protection, preclude patent protection entirely or limit the countries where patent protections may be obtained. In recognition of this complexity, individuals covered by this regulation are encouraged to disclose as soon as possible after the conception of the invention or seek guidance from a licensing professional at TTC or their respective member commercialization office as soon as questions arise as to what is patentable and what must be disclosed.

IP creator(s) must submit the disclosure IP using a standard form, approved by all of the member commercialization offices and TTC, which includes a full and complete description of the discovery, development, process, improvement, works of authorship, or TRP and identifies all contributing participants. Submission of a complete disclosure will initiate the evaluation process.

Disclosure of a potential new trademark or trademarks that are first adopted and used in connection with a member's own goods or services will belong to the member or designee. See System Regulation *17.01.01*.

### 1.1 Multiple IP Creators Sharing Agreement

If there are multiple IP creators on a disclosure, the IP creators will agree between and among themselves as to their relative contributions and how they will share any benefits accruing to the IP creators consistent with the terms and conditions of System Policy *17.01* and System Regulation *17.01.04, Distribution of Royalties, License Fees and Sale Proceeds from Licensing*. The final determination of each IP creator's share will be made only upon execution and receipt by TTC and their respective member commercialization office(s) of a signed sharing agreement between and among the IP creators. Such multiple IP creators sharing agreement will not change unless for a legal reason approved by the System Office of General Counsel (OGC). In the event that the IP creators cannot agree upon an appropriate sharing agreement within three (3) months of the submission of a completed disclosure form, the IP creators' member CEOs or designee(s) will decide how any benefits accruing to the IP creators will be shared. Such decision by the member CEO(s) or designee(s) will be final and binding on all of the IP creators. If the member CEO(s) or designee(s) cannot decide on the sharing between the IP creators within three (3) months after failure of IP creators to reach a sharing agreement, the chancellor or designee will decide on how the IP creators will share any benefits accruing to the IP creators and such decision will be final and binding on all IP creators and member(s).

### 1.2 Member Sharing Agreement

If there are multiple IP creators each representing a different member, one or more IP creators that report to multiple members, one or more IP creators whose research was funded or administered by another member, or a combination thereof, the member CEOs or designees will agree as to the relative contribution of each member, which member commercialization office will be responsible for commercialization, or TTC, and how the members will share the cost of legal protection and any benefits accruing to the members in a member sharing agreement, considering such factors as how this has historically been addressed based upon previous agreements, the annualized FTE by member, the level of financial support by the member, etc. In the event that the member CEOs or their designees cannot agree upon the appropriate sharing arrangement between the members within three (3) months after submission of the complete disclosure form and the executed multiple IP creators sharing agreement, the chancellor or designee will decide how the members will share any benefits accruing to the members and such decision will be final and binding on all members.

## 2. DISCLOSURE EVALUATION PROCESS

Upon receipt of a completed disclosure form, TTC or the respective member commercialization office will conduct a review of the disclosure to determine the rights and obligations of all parties concerned and the commercial significance of the disclosure IP, and will evaluate patentability and/or other intellectual property protection issues. The first step in this process is typically a meeting with the IP creator(s) to better understand the disclosure's scientific and commercial merit and, if necessary, devise strategies for protection, development and commercialization. It is the obligation of the IP creator(s) to make available to TTC and the IP creator's respective member commercialization office additional information as needed in all stages of this process.

If the form containing the disclosure IP contains more than one intellectual property, another disclosure form is to be submitted and tracked separately. For the case where the disclosure IP is for multiple plant or biological materials where no protection is sought under patent law, plant variety protection act, or equivalent protection in foreign jurisdictions, the multiple plant or biological materials will be tracked as one disclosure IP and such disclosure IP will have a listing of the multiple plant or biological materials along with the contribution(s) for IP creator(s) for each of such plant or biological materials.

The TTC or the IP creator's respective member commercialization office will inform the IP creator(s) of the outcome of its review regarding rights and obligations as soon as practical.

## 3. ASSIGNMENT OF RIGHTS

All persons subject to this regulation must, upon request by the chancellor, CEO or designee of the respective member or TTC, execute an assignment agreement, approved by OGC, to set forth effectively the ownership and rights to intellectual property of the system or member. (See System Regulation *17.01.01*.) Such written assignment is to confirm, in a specific instance, the allocation and present assignment of intellectual property rights mandated by this regulation and will not be construed as making the present assignment of rights in this regulation conditional upon the execution of such written agreement.

## 4. PROTECTION OF INTELLECTUAL PROPERTY

4.1 The system will not generally seek protection for disclosure IP that TTC or the respective member commercialization office determines is not commercially attractive even if the intellectual property has intellectual merit, unless required by the sponsor or the member CEO, in which case the sponsor or the member will be responsible for the cost of legal protection with the disclosure IP.

4.2 The decision whether to provide funding for intellectual property protection will be at the discretion of the member CEO or designee. The cost of legal protection will be recovered for the member before distributing royalties, license fees or sale proceeds as outlined in System Regulation *17.01.04*.

4.3 If during the period protection is being sought or during the life of the disclosure IP:

- (a) An IP creator is added or removed for that disclosure IP, TTC may require a new multiple IP creators sharing agreement and/or a new member sharing agreement. See Sections 1.1 and 1.2.
- (b) As new intellectual property is created, TTC may require a new disclosure, a new multiple IP creators sharing agreement, a new member sharing agreement, a new multiple IP relative weighting agreement for IP creators, a new multiple IP relative weight agreement for member, or a combination thereof. See Sections 1.1 and 1.2, and System Regulation *17.01.04*.

4.4 TTC and member commercialization offices will work with OGC on the selection, retention and evaluation of outside counsel for IP protection. Outside counsel contracts are subject to System Regulation *09.04.01, Legal Counsel and Attorney General Opinion Requests*. TTC will be responsible for centrally tracking and handling of payment of outside counsel invoices according to procedures defined by OGC and the Office of the Attorney General of the State of Texas.

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## **Related Statutes, Policies or Requirements**

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[System Regulation \*09.04.01, Legal Counsel and Attorney General Opinion Requests\*](#)

[System Policy \*17.01, Intellectual Property Management and Commercialization\*](#)

[System Regulation \*17.01.01, Ownership of Intellectual Property and Tangible Research Property\*](#)

[System Regulation \*17.01.04, Distribution of Royalties, License Fees and Sale Proceeds from Licensing\*](#)

[System Invention Disclosure Form](#)

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## **Member Rule Requirements**

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A rule is not required to supplement this regulation.

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## **Contact Office**

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(979) 458-6000