

17.01.02 Evaluation and Protection of Intellectual Property

Revised [March 1, 2023](#)

Next Scheduled Review: March 1, 2028

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Regulation Summary

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.

Definitions

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Regulation

1. DISCLOSURE

Individuals subject to System Policy *17.01, Intellectual Property Management and Commercialization*, are required to promptly disclose to Texas A&M Innovation (TI) all inventions, copyrightable works and TRPs 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 TI 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 TI, which includes a full and complete description of the discovery, development, process, improvement,

works of authorship, or TRP and identifies all contributing participants (system-disclosure). Submission of a complete system-disclosure initiates 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 belongs 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 system-disclosure, the IP creators agree between and among themselves as to their relative contributions and how they will share any potential 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 is made only upon execution and receipt by TI 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 system-disclosure form, the chancellor or designee decides how any benefits accruing to the IP creators are shared. Such decision by the chancellor or designee is final and binding on all of the IP creators.

2. DISCLOSURE EVALUATION PROCESS

Upon receipt of a completed system-disclosure form, TI conducts a review of the disclosure to determine the rights and obligations of all parties concerned and the commercial significance of the disclosure IP and evaluates 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 TI additional information as needed in all stages of this process.

If the system-disclosure form containing the disclosure IP contains more than one intellectual property, another system-disclosure form is 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 are tracked as one disclosure IP and such disclosure IP has 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.

TI informs 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 or designee, execute an assignment agreement, approved by OGC, to set forth effectively the ownership and rights to intellectual property of the system. (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 is not 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 does not generally seek protection for disclosure IP that TI determines is not commercially attractive even if the intellectual property has intellectual merit, unless required by the sponsor, in which case the sponsor is responsible for the cost of legal protection with the disclosure IP.
- 4.2 The decision whether to provide funding for intellectual property protection is at the discretion of TI. The cost of legal protection is recovered 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, TI may require a new multiple IP creators sharing agreement. See Section 1.1.
 - (b) As new intellectual property is created, TI may require a new system-disclosure, a new multiple IP creators sharing agreement, a new multiple IP relative weighting agreement for IP creators, or a combination thereof. See Section 1.1, and System Regulation *17.01.04*.
- 4.4 TI 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*. TI is responsible for centrally tracking and handling of payment of outside counsel invoices for IP protection according to procedures defined by OGC and the Office of the Attorney General of the state of Texas.

Related Statutes, Policies or Requirements

[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](#)

Member Rule Requirements

A rule is not required to supplement this regulation.

Contact Office

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