

Below is a list of baseline terms for sponsored research agreements with UW–Madison.

### **UW POLICY ON PUBLICATION AND DATA OWNERSHIP**

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- UW–Madison always retains the ability to publish the results of the research. Research results are not confidential information of the sponsor.
  - With publications, UW–Madison can provide a maximum delay of 30 days for sponsors to review for the presence of sponsor confidential information and offer substantive comments on that publication, and 60 additional days, upon sponsor request, to enable filing of patent protections on inventions disclosed in the publication.
  - Review and comment of publications does not include editorial rights by sponsors over the publication itself. Recommendations regarding content should be considered in good faith, and sponsors’ requests to remove their confidential information should be honored, but UW–Madison must maintain ultimate editorial control over the publication.
  - The UW’s publication policy also ensures that UW research falls within the fundamental research exception to export control laws, which is important to ensure the ability of international students and scholars to participate in industry-sponsored research at the UW, and to ensure the ability to publish and disseminate research results to international collaborators.
- UW–Madison always retains ownership of the research results (data) developed under the sponsored research agreement. This is to ensure the ability to publish and continue to build on research. We can provide sponsors with free access to and use of data that is developed under the sponsored research agreement, except that a grant of rights in data does not convey intellectual property rights, which are typically addressed separately in the research agreement.

### **UW POLICY ON INTELLECTUAL PROPERTY.**

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- UW–Madison does not assign ownership rights to patentable inventions developed under sponsored research agreements. This ensures that UW researchers will not be blocked from continuing the lines of research that have generated the patentable IP. However, the UW has wide flexibility to license such patentable intellectual property.
- The factors that impact licensing terms for patentable inventions include: the need to recover, at minimum, the costs incurred in securing and maintaining patents; the commercialization desires of the inventor(s); whether all inventors are UW personnel or whether sponsor personnel are co-inventors; the extent to which the invention builds on either existing UW or sponsor intellectual property; the extent to which the invention was created under multiple agreements with multiple sponsors; the presence or absence of existing license agreements for related technologies; and of course the intrinsic value of the invention as expressed by market interest.



## Office of Business Engagement

UNIVERSITY OF WISCONSIN-MADISON

- Rights to background intellectual property necessary for a sponsor to fully exploit inventions arising from a sponsored project (foreground IP) are typically negotiated separately after the foreground intellectual property has been developed. This is because the nature of any such background intellectual property generally cannot be known with certainty in advance, and thus it cannot be predicted ahead of time whether background intellectual property may have been invented in a completely separate UW lab with different inventors, is already subject to license obligations, etc.
- Beyond patentable inventions, UW–Madison can transfer ownership of certain forms of intellectual property that are deliverables in sponsored research projects, such as copyright to software and final project reports, and ownership of tangible items, such as prototypes and materials. However, as noted above with respect to data and patents, ownership of underlying data and ideas that are embodied in copyrightable and tangible deliverables must be retained by the UW to ensure the ability to publish and build on research. Thus, for example, at times a patent license may be needed for a sponsor to commercially exploit research results, a novel material, or a prototype.

### STATE LAW ISSUES

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UW System is an independent executive branch agency in the Wisconsin state government. As part of the state government, the UW is faced with various limitations.

- Location for lawsuits. The Wisconsin Constitution specifies that only the legislature can decide for what matters and in what courts the state can be sued. The legislature has not consented to be sued in other state's courts.
  - As a practical matter, this means UW–Madison simply lacks the authority to agree to the jurisdiction of other state's courts, and it would not be within the scope of a UW employee's employment to agree otherwise.
- Liability and Insurance. As part of the state government, UW–Madison can only accept liability in the circumstances provided by state law.
  - State law provides UW employees and agents with a legal defense by the Attorney General's office and liability insurance coverage for their acts or omissions while acting within the scope of their employment or agency.
  - The UW has no insurance coverage that would cover sponsor employees or third parties and has no insurance coverage for intentional or criminal acts of our employees.
  - This means we can't accept a blanket obligation to indemnify a sponsor against all liability arising from the research, and we can't provide the sponsor or its employees with a legal defense because we can't make this commitment on behalf of the Attorney General's Office.
- UW–Madison is unable to warrant our research or the use of the results. Because research, by its nature, is uncertain on outcomes, it isn't possible to make promises regarding what the results will be, nor whether they'll be useful. We can promise that we will use best efforts with doing the research, and that we'll comply with the terms of our research agreements.