

MEMORANDUM

To: Faculty and Researchers working on Children's Healthcare of Atlanta Projects

From: Georgia Tech Research Corporation

Re: Intellectual Property Rights under Children's Healthcare of Atlanta Agreement

Date: January 2014

The Georgia Tech Research Corporation is pleased to announce that Children's and GTRC entered into a reciprocal Intellectual Property Agreement to address ownership and management of intellectual property. In addition to addressing the management and ownership of intellectual property that both Georgia Tech and Children's employees are named as inventors, the IP Agreement addresses ownership rights each institution would have when intellectual property is solely created by employees of one party while utilizing funds (whether directly or indirectly) of the other party, other resources provided by the other party, or projects otherwise supported or initiated by the other party. In all cases, GTRC and Children's jointly own the resulting intellectual property, patent administration decisions will be made jointly by the parties, and any agreements to commercialize the intellectual property will be jointly made. Licensing income will be shared equally between GTRC and Children's, after distribution of the inventor's share of any income that is due under the inventor's institutional IP policy, but before any distributions to the inventor's college or unit.

For the purpose of the IP agreement, resources can include not only funds provided through a sponsored grant or contract, but any monetary or other financial contribution, whether directly from Children's or as a subcontract or other 'pass through' from a third party, Georgia Tech department, or affiliated Georgia Tech organization. Non-financial contributions such as patient data, facilities, initiated projects, personnel and equipment are considered resources, with respect to the agreement, as well.

If federal funds will also be used in the research, please be aware that federal law prohibits assignment of federally funded intellectual property to a third party. Thus, for any intellectual property funded by the U.S. Government but also using funds or resources of Children's, to avoid requiring segregation of funds, GTRC will have to request permission from the funding agency for the partial assignment. If the funding agency grants permission, the intellectual property will be handled in accordance with the agreement as outlined above. If permission from the funding agency to assign is denied or delayed for more than five years and no license has been executed at that time, a non-exclusive, royalty free license, with the right to sublicense, to the intellectual property will be granted to Children's.

If any undergraduate students, visiting scholars, or other non-employee researcher will be working on a project that uses Children's funds or resources, that non-employee researcher must sign an appropriate agreement assigning their intellectual property to GTRC. Please contact Sherry Farrugia, the Children's research collaboration coordinator, to ensure that is done prior to commencement of the research.

Also, if a collaboration with a third party is planned for a project in which Children's funds or resources will be used, GTRC must enter into an agreement with that third party prior to commencement of the collaboration to address the collaborative research and any intellectual property that may be developed. Please contact Sherry Farrugia to initiate such an agreement.

Please contact Sherry Farrugia (404-626-9634 or sherry.farrugia@innovate.gatech.edu) with any questions.