

Office of Technology Licensing
IP Guidebook

This IP Guidebook is supplementary to the Georgia Tech IP Policy, <https://www.policylibrary.gatech.edu/faculty-handbook/5.4-intellectual-property-policy>. The guidebook provides operational guidelines and procedures for the administration of Georgia Tech intellectual property.

5.4.2

“Creator of Record”: If no contribution allocation is made on the invention disclosure form the Creators need to agree to relative percent contribution and sign a new invention disclosure form. If the Creators cannot agree to a relative percent contribution, net income will be divided equally amongst all Creators listed on the invention disclosure for that particular invention.

5.4.3 A.

For inventions created under research grants there may be some restrictions. For industry grants the sponsor typically receives a non-exclusive royalty free (NERF) license with rights to license exclusively within a set timeframe. This timeframe varies among research agreements. For work done under Foundations, requirements vary widely. The research agreement may include restrictions on licensing inventions produced from research conducted with Foundation funds. There may also be reporting and royalty sharing requirements.

5.4.5 A.2.

Creators wishing to have a copy of a license agreement should request it from OTL.

5.4.5 B

Disclose [here](#).

It is essential that all Creators, and only Creators, be listed on the invention disclosure. If you have questions on who is a Creator, please contact OTL at techlicensing@gtrc.gatech.edu.

On the disclosure form you will be asked to attribute percent contribution for each Creator. If the work was done in conjunction with Creators at another entity, all names should be listed but percent contribution should only be recorded for GT Creators. Total % contribution for GT Creators must equal 100%. If Creators cannot decide on the percent contribution for each Creator the Creator’s share be divided equally. Information regarding sponsorship (granting entity and grant #) is required to enable OTL to fulfill necessary compliance requirements.

Creators must electronically sign invention disclosures before proceeding with the IP protection and commercialization processes. Creators will be sent a link to do so. If percent contribution changes need to be made after signature of the disclosure, contact the Licensing Associate assigned to your invention. All Creators whose percent contribution is changed will need to sign a new disclosure form for the new contribution percentages to be enacted.

5.4.5 C

When an online invention disclosure is received by OTL it is assigned to a Licensing Associate. That Licensing Associate will contact the Creators to arrange an initial meeting to confirm sponsorship, discuss technical aspects of the invention and discuss potential market and patentability information, if known at that point. At a later date an evaluation of commercial potential and patentability issues will be produced by the Licensing Associate. This evaluation will be discussed with the Creators and, based on input, OTL will decide upon a course of action. The decision to file a provisional application will be made within 60 days of disclosure as provided for in the **IP policy**. Meeting this deadline is dependent on the Creator meeting with OTL in a timely manner.

If OTL decides, based on the analysis, not to pursue commercialization of the invention the principal Creator may request rights be returned to them. If the invention was created using federal funding OTL must return the rights to the sponsor and the Creator must then petition the funding agency to have rights transferred to them. If there is no federal funding (or other funding with restrictions) OTL will execute a document stipulating the return of rights to the principal Creator. If the principal Creator does not wish to manage the IP rights another Creator(s) may petition to do so.

If OTL decides to proceed with protection and commercialization of the invention we will, where necessary, file a provisional patent application. Not all inventions require a patent to be commercializable. The provisional patent application allows OTL and the Creator(s) one year before making a decision on filing a Patent Cooperation Treaty (PCT) or U.S. application. A decision to do so is based on the existence of supporting scientific data, feedback from potential licensees (if obtained), predicted commercial potential and any patentability information gathered since disclosure of the invention. If OTL decides not to convert the provisional application they will notify the Creators within 10 months of filing the provisional application. Adhering to the 10-month timeline is dependent upon the timeliness of all Creator(s)' participation in the evaluation process. If OTL decides not to convert the provisional application the principal Creator may request the IP rights revert to the Creator. Unless sponsorship requires otherwise, OTL and the Creator will execute documentation to accomplish this. Thereafter the Creator will be responsible for all patent prosecution and the related expenses required to obtain IP protection, plus effort to commercialize the invention.

5.4.5 D

When a question of inventorship arises, OTL will deliver a written decision, supported by rationale, within 30 days. Adhering to the 30-day timeline is dependent upon the timeliness of all Creator(s)' participation, including meeting with a patent attorney if necessary, provision of documentation and the complexity of the issue.

5.4.5 I

Notice of maintenance due date is deemed “given” whether by OTL or the relevant patent attorney.

5.4.6

Other than exceptional cases, equity will be distributed directly to the Creator(s) from the Licensee.

8/2/23