



NORTH PACIFIC RESEARCH BOARD

"Building a clear understanding of the North Pacific, Bering Sea, and Arctic Ocean ecosystems that enables effective management and sustainable use of marine resources."

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North Pacific Research Board Intellectual Property Clause

The North Pacific Research Board (NPRB) complies with federal requirements for protection of intellectual property (including patents, inventions, and copyrights), as promulgated in Title 35, Chapter 18, of the United States Code. The requirements are based on the Bayh-Dole Act for which the Department of Commerce is the lead implementing agency. Chapter VII, Section 730, of the NSF Grant Policy Manual incorporates the federal requirements. The Patent Rights clause in section 731.3 will be posted on the NPRB web site and there will be reference to it in all contracts with research entities and principal investigators (including entities not affiliated with universities). It applies to all inventions conceived or first actually reduced to practice in the performance of a federal grant, contract, or cooperative agreement, even if the federal government is not the sole source of funding for either the conception or the reduction to practice. The provisions do not, however, apply to federal grants primarily aimed at training students and postdoctoral scientists.

In general, a university is obligated to have written agreements with its faculty and technical staff that require disclosure and assignment of inventions, and must disclose each new invention to the federal funding agency within two months after the inventor discloses it in writing to the university. The decision whether or not to retain title to the invention must be made within two years after disclosing the invention to the agency. This time may be shortened, if, due to publication of research results or public use, the one-year U.S. statutory patent bar has been set in motion. Under such circumstances, the university must make an election at least sixty days before the end of the statutory period. If the university does not elect to retain title, the agency may take title to the invention.

Upon election of title, the university must file a patent application within one year, or prior to the end of any statutory period in which valid patent protection can be obtained in the U.S. The university must provide the government, through a confirmatory license, a non-exclusive, non-transferable, irrevocable, paid-up right to practice or have practiced the invention on behalf of the U.S. throughout the world. Universities must share with inventor(s) a portion of revenues received from licensing the invention. Any remaining revenue, after expenses, must be used to support scientific research or education.

Agencies may decide, for compelling reasons, that title should be vested in the federal government. Such decisions must be consistent with provisions within the Bayh-Dole Act and made in writing before entering into a funding agreement with a university. Under certain circumstances, the government can require the university to grant a license to a third party or the government may

take title and grant licenses itself (these are called "march-in rights"). This might occur if the invention was not brought to practical use within a reasonable time, if health or safety issues arise, if public use of the invention was in jeopardy, or if other legal requirements were not satisfied. NPRB also adheres to individual State laws and regulations on protection of intellectual property rights, and will develop procedures to protect Alaska Native proprietary interests.