

Research Policies

Intellectual Property Policy (SC-600)

Purpose

As a medical research organization, the Howard Hughes Medical Institute (“**HHMI**”) conducts scientific research in the public interest. HHMI has adopted this intellectual property policy to help ensure that inventions, discoveries, and other fruits of HHMI’s research are made available for the benefit of the public, and that the associated financial costs and rewards are fairly allocated.

Policy

1. Scope

HHMI has employees at host institutions and at Janelia Farm Research Campus. In this policy, HHMI laboratories at host institutions are referred to as “**host-based sites**” and Janelia Farm Research Campus, which is not a host institution or a host-based site, is referred to as “**JFRC**”. In this policy, “**subject property**” means any invention, discovery, improvement or other tangible or intangible idea or creation, whether or not patentable or copyrightable, resulting from work performed by an HHMI employee, alone or with others, and funded in whole or in part by HHMI.

All HHMI laboratory employees at host-based sites are subject to this policy, and this policy applies to all subject property they develop.

All HHMI employees at JFRC, whether or not they work in a laboratory, are subject to this policy, and this policy applies to all subject property they develop.

Except as otherwise provided in this policy, an employee is considered to be “**at**” the HHMI location to which he or she is primarily assigned.

The share of royalties of HHMI employees who contribute to development of a subject property shall be determined in accordance with this policy.

Except as otherwise provided in this policy, subject property is owned by HHMI, and all patent, copyright, and other rights in subject property shall be assigned to HHMI upon HHMI’s request.

2. Agreement to Comply With Policy

Compliance with this policy is a condition of employment for all HHMI employees to whom this policy applies. Each such employee is required to sign a document memorializing his or her agreement to comply with this policy prior to commencing HHMI employment. Any failure to sign shall not affect the applicability of this policy or relieve any HHMI employee who is subject to this policy from the obligations imposed by it.

3. Employee Inventions and Use Rights

This policy does not apply to, and HHMI will not assert rights in, any invention, discovery, improvement or other tangible or intangible idea or creation that an HHMI employee develops if all four of the following conditions apply to such invention:

- It was developed entirely on his or her own time;
- It was developed with no use or only minimal use of HHMI facilities (including laboratory and office equipment, supplies, and library and other resources);

- It is not related to actual or demonstrably anticipated work of HHMI of which the employee is aware; and
- It is not related to any work performed by the employee for HHMI.

If an employee wishes to claim that HHMI does not have ownership rights in an item of intellectual property under this section, the employee must demonstrate to HHMI's satisfaction that all of these conditions have been met.

Subject to any applicable patent, copyright, or trademark rights, and subject to any obligations HHMI may have to third parties, HHMI employees shall have the right to use ideas, concepts, skills, and experience they develop or learn in the course of their HHMI employment. This right is personal, and cannot be assigned, licensed, sublicensed, or otherwise transferred to any other person.

4. Scholarly Publications, Software and Other Materials Subject to Copyright

HHMI generally will allow an HHMI employee who authors or contributes to a published scientific manuscript, journal article, student thesis, textbook, or other scholarly work to own the copyright in that work. This policy is intended to accommodate the requirement of many publishers, including most scientific journals, that copyright be assigned by the author(s) to the publisher before publication can proceed. Please note, however, that HHMI personnel at host-based sites must follow any applicable host institution policy with respect to copyrighted materials.

Although HHMI generally will allow an employee to own the copyright in a particular scholarly work, HHMI still owns all other rights, such as patent rights, in any ideas or other matter described in that work. In addition, HHMI owns all rights in any non-scholarly works created by HHMI employees in the course of their employment, such as computer software, databases, user interfaces, user or other technical manuals or documentation, and other computer-related materials, all of which are subject property under this policy.

HHMI owns all rights in works authored or co-authored by HHMI employees that are prepared for HHMI business purposes, although these are not considered subject property for purposes of the disclosure and royalty-sharing provisions of this policy. By way of example, HHMI would own all rights to any writings, photographs, videos, or sound recordings created or made by HHMI employees that are prepared for possible inclusion in an internal HHMI resource, an HHMI print publication, or on HHMI's website; however, these materials need not be disclosed under this policy, and the HHMI employees creating these materials have no rights to share in any royalties or other revenue received with respect to these materials.

5. Agreements That May Relate to Intellectual Property

a. Materials Transfer, Research Collaboration, and Other Agreements

HHMI routinely enters into agreements with other organizations, for example as a condition of receiving research materials or of using software or other proprietary technology, or in connection with a research collaboration, or otherwise in connection with HHMI operations. HHMI employees shall abide by the terms of such agreements.

b. Agreements with Host Institutions

For host-based sites, HHMI has entered into an agreement with the host institution that includes the following general provisions relating to intellectual property:

- It is the mutual objective of the host institution and HHMI to disseminate subject property developed at the site for public use and benefit on a nondiscriminatory basis (it is intended that this include dissemination through exclusive licensing where necessary and appropriate);

- HHMI will assign rights in subject property developed by HHMI employees at the site to the host institution, except that HHMI retains a royalty-free, worldwide, non-exclusive, irrevocable license, without right to sublicense, to use any subject property for research purposes;
- The host institution's technology transfer office takes the lead on licensing or other commercialization activities with respect to subject property developed at the site;
- HHMI and the host institution share expenses and income with respect to subject property; and
- The policies of the host institution with respect to sharing royalties with individual inventors apply.

HHMI personnel working at a host-based site should contact the HHMI attorney responsible for their site if they have any questions about this policy or about HHMI's procedures relating to subject property.

c. United States Government Funding

HHMI does not seek or accept research funding from the United States government. However, at host-based sites only, host institutions may apply for United States government funding for their faculty members who are HHMI investigators. HHMI personnel working at a host-based site should contact the HHMI attorney responsible for their site if they have questions about HHMI policy on whether they can be supported by a specific type of government grant.

d. Non-Government Outside Funding

As a general matter, HHMI does not seek or accept research funding from other organizations, and in particular does not permit its laboratories or researchers to accept (including indirectly through a host institution) funding from for-profit companies, other than as an unrestricted gift. However, at host-based sites only, host institutions may apply to not-for-profit organizations for grant funding for their faculty members who are HHMI investigators. HHMI personnel working at a host-based site should contact the HHMI attorney responsible for their site if they have questions about HHMI policies regarding non-government outside funding. Under limited circumstances, HHMI may accept non-government, not-for-profit research funding for research to be conducted at JFRC; see the JFRC policy on grants and awards.

e. Use of Name, Voice, Statements, and/or Likeness

HHMI may use the name, voice, statements, and/or likeness of any of its employees for all purposes of education, instruction, public information, or presentation of information about HHMI and HHMI activities, in any format and in any medium now known or later developed (including, for example, newspaper, magazine, television, radio, and the Internet) without obligation or notice to the particular employee.

6. Reporting and Management of Subject Property

a. Reporting

HHMI employees at host-based sites must disclose subject property to the appropriate office of the host institution in accordance with host policies. By agreement, host institutions are required to provide HHMI with a copy of disclosures of subject property. HHMI employees at a host-based site are required to disclose to the host institution and HHMI any additional information regarding subject property as may be requested, and to sign assignments and other documents as requested by HHMI. To preserve patent rights, researchers at host-based sites who are preparing to publish on what may constitute an invention or discovery may wish to consult with

their host technology transfer office regarding whether patent protection should be filed for before publication.

HHMI employees at JFRC must disclose subject property to HHMI using the Report of Invention form (JF-IP-003). HHMI employees at JFRC are required to disclose to HHMI any additional information regarding subject property as may be requested, and to sign assignments and other documents as requested by HHMI. To preserve patent rights, JFRC researchers who are preparing to publish on what may constitute an invention or discovery or who are contemplating the release of software other than under an open source license must consult with HHMI regarding whether patent protection should be sought before publication.

The requirement at JFRC to disclose subject property does not apply to software that JFRC researchers will make publicly available through open-source licensing. Such software may, but is not required to, be disclosed under the procedures described in the preceding paragraph.

b. Dissemination or Commercialization

At host-based sites, the host institution is generally responsible for the dissemination of subject property, in accordance with the terms of the collaboration agreement between HHMI and the host institution. If the host institution, HHMI, and any other organizations with rights in the subject property decide not to pursue commercialization of the subject property, the inventor may be given a written release subject to HHMI's rights and applicable host institution policies.

HHMI will be responsible for dissemination of subject property developed at JFRC, including patentable inventions and inventions for which patent protection is not available or is not pursued (e.g., certain unique biological materials or computer code). Licensing of JFRC subject property will be consistent with [HHMI policies on sharing of research tools and published materials](#). If HHMI decides not to pursue commercialization of subject property developed at JFRC, the inventor may be given a written release subject to HHMI's rights. Releases also will normally be subject to conditions such as reimbursement of HHMI for past patent expenses in the event income is subsequently received by the inventor from commercialization.

c. Division of Royalties Arising from Commercialization of Subject Property

For subject property developed at host-based sites, the host institution's policies for determination and distribution of the individual inventors' share of royalties apply.

For inventions developed at JFRC, the following principles apply:

- Inventors are those individuals who (a) with respect to an invention that includes patent rights, have been determined by HHMI to be appropriately named as inventors on a patent based on applicable patent law or (b) with respect to an invention that does not include patent rights, have been determined by HHMI to have substantially contributed to the creative conception, design, or development of the subject property.
- Inventors who are HHMI employees at JFRC are JFRC inventors.
- Inventors who are HHMI employees at host-based sites, but who made substantially all of their contribution to an invention while visiting at JFRC, will be treated as JFRC inventors subject to arrangements with the relevant host institution(s).
- Although inventors working at JFRC who are not HHMI employees are not subject to this policy and will normally not be JFRC inventors, HHMI may in its discretion make exceptions in compelling circumstances so as to allow royalty-sharing with such inventors under this policy. Exceptions, if made, will be allowed

only in cases where the inventor assigns rights to HHMI. Royalty-sharing (if any) for inventors who assign rights to another institution would be handled by the other institution.

- JFRC inventors will share in the net royalties derived by HHMI from the invention.
- Net royalties are gross royalties less the costs of protecting, patenting, licensing, and enforcing rights in the invention (including all legal or other third-party fees, filing fees, taxes, and other costs) ("**licensing costs**"). Gross royalties are royalties based on percentages of net sales, and any fees paid by the licensor such as up-front license fees or maintenance fees.
- The sharing percentage applied to net royalties will be 50% to the JFRC inventors collectively, and 50% to HHMI.
- If HHMI receives equity in a company in connection with commercializing subject property, the equity will be treated as gross royalties. If, after recouping licensing costs with respect to a subject property, there remain equity holdings as part of net royalties, HHMI will distribute the JFRC inventors' share of equity or its equivalent to them but not until either (a) it can be freely traded without restriction or (b) the equity received is being sold or otherwise liquidated.
- Where there are two or more JFRC inventors, each JFRC inventor will share equally in the inventors' share of royalties unless all inventors agree in writing to a different distribution.
- Distributions of the JFRC inventors' share will be made at least annually for each year in which there are net royalties to distribute. When calculating distributions, HHMI will reserve funds to pay for expected future patenting and licensing costs. Ultimately, 50% of royalties remaining after all patenting and licensing costs are paid will be distributed to JFRC inventors according to the policy.
- Royalty-sharing with a JFRC inventor under this policy continues if the inventor is no longer at JFRC.

d. Enforcement of Intellectual Property Rights

HHMI employees shall provide to HHMI all cooperation that HHMI deems necessary or desirable to secure and enforce institutional rights in subject property. This may include, without limitation, providing assistance to counsel in filing patent applications or other legal documents, providing testimony or otherwise participating in legal proceedings, and reviewing and signing legal documents during and after employment with HHMI. Such cooperation is a condition to receiving any royalties.

7. Confidentiality of Research Results and Operations

HHMI employees are expected to respect the confidentiality of unpublished research results generated in HHMI laboratories, consistent with standard practice in the academic research community.

In addition, HHMI employees generally should not disclose outside of HHMI information about HHMI's research operations that they know or reasonably should know is of a confidential or sensitive nature, without the approval of HHMI management. Examples include information about security features of HHMI facilities and systems, and vendor pricing and other information typically subject to confidentiality requirements. In some cases this information may need to be shared with other organizations with which HHMI has a business relationship, such as a host institution, an insurance carrier, or a contractor; care should be taken that disclosures are appropriately limited and will be kept confidential by the recipient organization.

8. HHMI-NIH Research Scholars

HHMI has employees at the National Institutes of Health (“NIH”) through the HHMI-NIH Research Scholars Program. Although the NIH is not a host-based site, the HHMI-NIH Research Scholars are subject to this policy, and this policy applies to all subject property they develop. HHMI-NIH Research Scholars must disclose subject property to HHMI. They may also be required by the NIH, under its policies, to disclose subject property to the NIH.

9. Administration of Policy on Intellectual Property

a. Interpretation of Policy

Questions of interpretation concerning this policy shall be submitted to the Vice President and General Counsel.

b. Termination or Revision of Policy

This policy may be changed at any time by HHMI in its discretion. Such changes shall not affect rights accrued prior to the date of the change. Rights with respect to a subject property shall begin to accrue when the subject property is first conceived or fixed in a tangible medium of expression.

c. Effective Date

This Policy is effective July 3, 2006, and supersedes any previous policies and guidelines regarding intellectual property to the extent that they are inconsistent with this policy.

Date: 10/01/07

Issued by: Office of the President