

## **LSU PRACTICE ON RELINQUISHING INVENTIONS**

When an LSU campus technology transfer office makes a determination, after careful assessment of an invention, that the campus will not protect or manage that invention, the Chancellor (or his/her designee) may recommend to the President that LSU relinquish ownership rights in that invention to the inventor(s). A campus may take such action only when an invention is free from contractual or legal obligations which would conflict with or otherwise prohibit LSU from relinquishing the rights. Final release of rights will be effective upon signature of the attached template letter by the LSU System President. At the end of each fiscal year, campuses will provide to the LSU System Office a list of relinquished inventions by title, case number (if applicable) and inventor(s).

LSU campuses shall execute all documents and take all steps necessary, including any required actions with a federal funding agency, to relinquish the rights in an invention, enabling the inventor(s) to pursue appropriate protection and commercially develop the invention.

Once LSU has relinquished rights in an invention, LSU funds may not be used for the filing of patent applications or for any other expenses in support of that invention. LSU facilities and resources may not be used for further development of the relinquished invention without appropriate written contracts between the inventor(s) and LSU under terms and conditions standard for private use of state facilities.

Any release of LSU ownership rights in an invention shall be made only under the following terms and conditions for the inventor(s):

1. The inventor(s) agrees to develop the invention for the public benefit; and
2. The inventor(s) agrees to comply with and fulfill any obligations that may exist to sponsors of the research leading to the invention, particularly the federal government; and
3. The inventor(s) agrees to report to LSU, upon request, the status of licensing and/or commercial development of the invention; and
4. The inventor(s) agrees that continued participation in research related to the invention, and/or the involvement of LSU facilities and personnel for such research, are subject to: (a) all applicable LSU policies, (b) prior disclosure and approval by the respective campus authorities, and (c) appropriate contractual arrangements with LSU; and
5. The inventor(s) agrees that LSU has relinquished rights only in the invention as originally disclosed and has not waived any rights in new or related inventions, which must be disclosed to LSU according to standard procedures; and
6. The inventor(s) agrees that the first income received from the licensing and/or commercial development of the invention will be used to reimburse LSU for any legal or licensing expenses related to that invention incurred by LSU prior to the date the invention was relinquished. LSU will provide an accounting of such expenses at the time the invention is relinquished. The inventor(s) may elect to reimburse LSU at the time the invention is relinquished in order to fulfill this obligation.

## TEMPLATE LETTER TO INVENTOR

<DATE>  
<NAME>.  
<TITLE >

RE: RELINQUISHING LSU RIGHTS IN INVENTIONS

Dear Dr. \_\_\_\_\_,

The Office of (*Technology Transfer*) has evaluated your invention entitled \_\_\_\_\_, disclosed on (date) and assigned case number \_\_\_\_\_. The staff has determined that LSU will not protect or manage this invention.

LSU chooses to voluntarily waive its rights to this invention and relinquish those rights back to you as the inventor(s). Please be advised that rights in this invention may also be subject to obligations to the United States government and/or other sponsors under contracts or grants. (*IF federal funds were used, insert this paragraph: Federal funds were used in the creation of this invention under (insert funding agency) grant number \_\_\_\_\_. Upon waiver of rights by LSU, title to the invention reverts to the U.S. government, as stipulated under the Bayh-Dole Act. However, you, as the inventor, can request title to the invention from the U.S. government. If you would like for LSU to request that the government's rights be transferred to you, please complete an Inventor Certification and return it to my attention.*)

As conditions of LSU's release of its ownership rights in the invention, you as the inventor are obligated to do the following:

- develop the invention for the public benefit; and
- comply with and fulfill any obligations that may exist to sponsors of the research leading to the invention, particularly the federal government; and
- report to LSU, upon request, the status of licensing and/or commercial development of the invention; and
- agree that your continued participation in research related to the invention, and/or the involvement of LSU facilities and personnel for such research, are subject to: (a) all applicable LSU policies, (b) prior disclosure and approval by the respective campus authorities, and (c) appropriate contractual arrangements with LSU; and
- agree that LSU has relinquished rights only in the invention as originally disclosed and has not waived any rights in new or related inventions, which must be disclosed to LSU according to standard procedures; and
- agree that the first income generated as a result of the commercialization of this technology will be used to reimburse LSU for all expenditures related to patent applications filed on the invention, which total \$\_\_\_\_\_ as of this date.

I wish you success in furthering this very interesting work.

Sincerely,

\_\_\_\_\_  
Chancellor

\_\_\_\_\_  
President, LSU System