

Guide to the Records of the Technology Licensing Office AC.0503

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May 27, 2010

Massachusetts Institute of Technology. Institute Archives and Special Collections
(2009)

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Summary Information

Repository	Massachusetts Institute of Technology. Institute Archives and Special Collections
Creator	Technology Licensing Office, Massachusetts Institute of Technology
Title	Technology Licensing Office records
Date	approximately 1999 to 2009
Extent	218.0 cubic feet (218 record cartons)
Location	Materials are stored off-site. Advance notice is required for use.
Language	English
Abstract	The largest set of material in the Technology Licensing Office collection (AC 503) consists of case files in series 1 (invention disclosure case files). Records in collection AC 503 were transferred to the permanent holdings of the Institute Archives beginning in 2004, but files, especially case files, may be created over a period of time. Therefore, documents in files will have dates earlier than 2004.

Citation

Massachusetts Institute of Technology, Technology Licensing Office, AC 503, box X. Massachusetts Institute of Technology, Institute Archives and Special Collections, Cambridge, Massachusetts.

Historical note

The Technology Licensing Office (TLO), constituted in its current form in 1986, manages the formal licensing to third parties of technology and other intellectual property developed at the Massachusetts Institute of Technology and Lincoln Laboratory. The office handles patent, licensing, trademark, and copyright activities for inventions and intellectual property in a variety of fields including the physical sciences, life sciences, and information technology. The office also serves as a resource on intellectual property and licensing matters for the MIT community. *An Inventor's Guide to Technology Transfer at the Massachusetts Institute of Technology*(2005) outlines the activities of the office.

The stated mission of the TLO (2009) is to benefit the public by moving results of MIT research into societal use via technology licensing, through a process which is consistent with academic principles, demonstrates a concern for the welfare of students and faculty, and conforms to the highest ethical standards.

Predecessor offices include the Patent, Copyright, and Licensing Office, which reported to the Vice President for Research (1977-1985), and the Patents and Copyrights Office, which was part of the Office of Sponsored Programs (1970-1976). Between 1920 and 1970 the Division of Industrial Cooperation (incorporated into the Division of Sponsored Research in 1956) had similar responsibilities.

A history of the office can be found at: http://web.mit.edu/tlo/www/about/our_mission.html

Arrangement note

Technology Licensing Office records are organized into fifteen series as determined by the Institute's retention schedule for Technology Licensing Office records: <http://libraries.mit.edu/records/tlo-schedule.html>

Administrative Information

Publication Information

Massachusetts Institute of Technology. Institute Archives and Special Collections (2009)

Access note

In accordance with MIT records policy, records are open after twenty years with the following exceptions:

Licensee Agreement Files (series 5) are closed 50 years.

Software Code Files (series 8), Software Case Files (series 9), and Software End-Use Licenses (series 10) are closed for 75 years.

Litigation Files (series 7) are permanently closed.

Personal identification numbers on documents in series 1 and series 6 are restricted and files will be screened for numbers prior to research use.

Intellectual Property Rights

Access to collections in the Institute Archives and Special Collections is not authorization to publish. Separate written application for permission to publish must be made to the Institute Archives.

Accruals note

Additional accruals are expected.

Source of Acquisition

Records were transferred to the Institute Archives and Special Collections from the Technology Licensing Office beginning in 2004.

Related Materials

Related Archival Materials

Related collections in the Institute Archives are AC 588, Technology Licensing Office, containing records transferred to the Archives between 1982 and 2003. Also of interest are the records of the Patent Policy Committee, 1930-1968 (AC 64), and records of the MIT Patent, Copyright, and Licensing Office (AC 67) containing records dating from 1930 to 1979.

Controlled Access Headings

Corporate Name(s)

- Technology Licensing Office, Massachusetts Institute of Technology

Genre(s)

- Patents.

Other Aids to the Collection

More detailed file lists are available in the Institute Archives and Special Collections collection control file for some boxes, restricted to staff. TLO staff have a file level listing database to the collection.

Case Files

Collection Inventory

Series 1. Case Files

Access note

Case Files are open for use after twenty years.

Personal identification numbers on documents in case files are restricted and files will be screened for numbers prior to research use.

Scope and Contents

Case files are started when an invention disclosure is submitted to the Technology Licensing Office. Case files track the evaluation and progress of MIT inventions. The technology licensing officers review invention disclosures, often with inventors and/or a literature search specialist. They examine each invention disclosure to review the following: the novelty of the invention, competing technologies, protectability and marketability of potential products or services, relationship to related intellectual property, size and growth potential of the relevant market, amount of time and money required for further development, pre-existing rights associated with the intellectual property, and potential competition from other products/technologies. Types of files associated with this series: closed cases, assigned cases, assigned to government cases, copyright waivers.

	Box
Case files received March 2004	1 through 8
Case files received September 2004	9 through 12
Case files received April 2005	13 through 19
Case files received April 2006	20 through 25
Case files received October 2006	26 through 35
Case files received February 2007	36 through 44

Law Firm Patent Prosecution Files

Case files received September 2007	45 through 49
Case files received November 2008	50 through 57
Case files received October 2009	58 through 65
Case files received February 2010	66
Case files received in April 2010	67 through 73

Series 2. Law Firm Patent Prosecution Files**Access note**

Law Firm Patent Prosecution Files are open for use after 20 years.

Scope and Contents

Once the Technology Licensing Office determines that a patent should be filed on an invention because of its novelty and marketability, the office engages outside patent counsel to patent the invention. These files mark the progress of the patent from filing through issuance and expiration or through abandonment of the patent. Many patent files can be associated with each case file. Original letters patent are secured from the U.S. and foreign patent offices. The letters patent are original patent documents. Types of files associated with this series: original law firm patent prosecution files.

Box

Files received April 2006	1 through 19
Files received September 2007	20 through 24
Files received November 2008	25
Files received October 2009	26 through 47

Series 3. Letters Patent, U.S.**Access note**

Letters Patent, Foreign

Letter Patent, U.S. are open for use after 20 years.

Scope and Contents

Once the Technology Licensing Office determines that a patent should be filed on an invention because of its novelty and marketability, the office engages outside patent counsel to patent the invention. These files mark the progress of the patent from filing through issuance and expiration or through abandonment of the patent. Many patent files can be associated with each case file. Original letters patent are secured from the U.S. and foreign patent offices. The letters patent are original patent documents. Types of files associated with this series: abandoned U.S. application files, expired U.S. patent files, letters patent (sometimes referred to as Ribbon Patents).

	Box
Files received September 2007	1
Files received January 2008	2
Files received November 2008	3 through 7
Files received April 2010	8
Files received May 2010	9 through 29

Series 4. Letters Patent, Foreign**Access note**

Letters Patent, Foreign are open for use after 20 years.

Scope and Contents

Once the Technology Licensing Office determines that a patent should be filed on an invention because of its novelty and marketability, the office engages outside patent counsel to patent the invention. These files mark the progress of the patent from filing through issuance and expiration or through abandonment of the patent. Many patent files can be associated with each case file. Original letters patent are secured from the U.S. and foreign patent offices. The letters patent are original patent documents. Types of files associated

Licensee Agreement Files

with this series: abandoned foreign applications files, expired foreign patent files, letters patent (sometimes referred to as Ribbon Patents).

	Box
Files received April 2006	1 through 2
Files received October 2006	3 through 7
Files received September 2007	8
Files received October 2009	9 through 18
Files received February 2010	19 through 23

Series 5. Licensee Agreement Files**Access note**

Licensee Agreement Files are closed for 50 years.

Scope and Contents

The Technology Licensing Office enters into many types of agreements and contracts with outside companies and institutions. The most common agreement type in our office is a license agreement through which permission is granted by the owner of intellectual property (MIT) to allow another party to act under all or some of the owner's rights. A licensee file is created when a party requests rights for intellectual property. There are also other agreement types such as: option agreements (when another party wants to evaluate intellectual property to determine whether to enter into a license agreement); joint invention agreements (when another party or institution co-owns the intellectual property with MIT); and interference agreements which are administrative actions documenting the resolution of a disagreement between MIT and another party in relationship to a patent.

	Box
Files received April 2006	1 through 4
Files received October 2006	5
Files received February 2007	6 through 7

Invention and Proprietary Information Agreements

Files received September 2007	8
Files received January 2008	9 through 10
Files received November 2008	11 through 12
Files received October 2009	13 through 16
Files received April 2010	17 through 18

Series 6. Invention and Proprietary Information Agreements**Access note**

Inventions and Proprietary Information Agreements are open for use after 20 years.

Personal identification numbers on documents in Inventions and Proprietary Information Agreements are restricted and files will be screened for numbers prior to research use.

Scope and Contents

These agreements signed by MIT faculty, staff, graduate students, undergraduates (who are UROP-supported) and visiting scholars assign ownership to MIT of inventions while working under a grant or contract to MIT or making significant use of MIT resources and facilities.

Box

Records received April 2006	1 through 2
Records received November 2008	3 through 8

Series 7. Litigation Files**Access note**

Litigation Files are closed.

Scope and Contents

Software Code Files

Litigation files are created when either another party is infringing one of MIT’s patents or another party believes that MIT is infringing one of their patents. These files contain documents pertaining to the litigation.

Box

Files received April 2006

1 through 10

Series 8. Software Code Files

Access note

Software Code Files are closed for 75 years.

Scope and Contents

Software files are treated differently than case files because software is copyrighted, not patented, and different rules apply to copyright. Three types of software files are kept: source code, software case files, and software end-use licenses.

Series 9. Software Case Files

Access note

Software Case Files are closed for 75 years.

Scope and Contents

Software files are treated differently than case files because software is copyrighted, not patented, and different rules apply to copyright. Three types of software files are kept: source code, software case files, and software end-use licenses. Types of files associated with this series: software case files.

Box

Files received April 2006

1

Files received October 2006

2 through 3

Files received February 2007

4

Software End-Use Licenses

Files received January 2008	5
Files received November 2008	6 through 7
Files received October 2009	8

Series 10. Software End-Use Licenses

Access note

Software End-Use Licenses are closed for 75 years.

Scope and Contents

Software files are treated differently than case files because software is copyrighted, not patented, and different rules apply to copyright. Three types of software files are kept: source code, software case files, and software end-use licenses.

Series 11. Background Reviews

Access note

Background Reviews Files are open for use after 20 years.

Scope and Contents

These are letters prepared by the compliance administrator with the help of the technology licensing officer that document whether there is any background technology for faculty who are entering into an agreement with an industrial sponsor or a subcontract with a government sponsor. These letters, which document the background technology, are then forwarded to the MIT Office of Sponsored Programs.

Box

Records received February 2007	1
Records received April 2010	2 through 3

Series 12. Director's Office Meeting Minutes

Director's Office Administrative Records

Access note

Director's Office Meeting Minutes are open for use after 20 years.

Scope and Contents

These are files which document the TLO's office procedures, policy change documentation, historical data, and best practices. Types of files associated with this series: minutes of meetings.

Series 13. Director's Office Administrative Records

Access note

Director's Office Administrative Records are open for use after 20 years.

Scope and Contents

These are files which document the TLO's office procedures. These files may include policy guides, policy change documentation, historical data, best practices and office procedures, and chronological files.

Series 14. Invention Reports

Access note

Invention Reports are open for use after 20 years.

Scope and Contents

These are reports prepared when a sponsored research contract expires. The report documents the inventions that have been developed during the sponsored research contract period.

Box

Records received April 2006

1

Series 15. Trademark License Files

Trademark License Files

Access note

Trademark Files are open for use after 20 years.

Scope and Contents

The Technology Licensing Office manages applications and agreements concerning the use of the MIT name or mark on products. License files contain various documents pertaining to the trademark licensing agreement.

Box

1

Files received November 2008

2 through 4

Files received October 2009