

LeMoyne-Owen College

POLICY ON INTELLECTUAL PROPERTY, PATENT AND INVENTION

I. PREAMBLE:

It is the intent of this policy of LeMoyne-Owen College (LOC) to encourage and assist members of the faculty, staff, and student employees of the College with their professional development, utilization of their talent, discoveries and inventions for the maximum benefit to academia and to the public.

II. GOAL:

The goal of this policy is to promote the progress of the science and the arts, to encourage patentable and copyrightable products through the provision of an established policy.

III. OBJECTIVES:

1. To support scholarly work, creative activities and research of the faculty, staff, and student of LOC.
2. To encourage publications of scholarly work.
3. To contribute to the economic development locally, nationally, and globally.
4. To establish policies for the ownership on Intellectual Property.
5. To establish polices for shared income related to patentable inventions produced at LOC.
6. To facilitate and manage the patent application, execution, licensing, and equitable distribution of Licensing Income to further support scholarly work of the employees of LOC.
7. To encourage and assist LOC's employees to develop and commercialize inventions for the benefit of personal gains as well as for the benefit of the College and the public.
8. To protect LOC's resources.
9. To protect LOC's reputation as a forward looking academic institution.

IV. Definitions:

General Definitions:

- a. **Assignment of Rights:** A written statement assigning or transferring ownership of an Intellectual Property from a College employee to the College or from the College to the employee
- b. **Author or Creator:** LOC employee responsible for the creation of a copyrightable or patentable work.
- c. **College Employee:** All faculty members, staff, and student employees, with full or part-time status. A student employee is defined as a person who is enrolled as a student in the College and who is also employed by the College.
- d. **Copyright:** An original scholarly work of authorship, including words or phrases, in the form of a tangible medium of expression from which it can be reproduced.

- e. **Curriculum:** The descriptive collection of LOC courses, such as course descriptions, course sequences, intended learning outcomes that constitute an area of specialization.
- f. **Educational and Research Activities:** Teaching, research or investigation, or the supervision of research or investigation relating to the general field of inquiry of the College employee.
- g. **Externally Funded Research:** Research and development work, sponsored by governmental, commercial, industrial, or other public or private organizations, that is the subject of a Research Agreement or other official arrangement with LOC.
- h. **Intellectual Property (IP):** An intangible asset that may lead to the development of tangible products such as copyrightable and patentable materials, trademarks, software, and trade secrets.
- i. **Internally Funded Research:** Any research project funded by the College with LOC funds.
- j. **Invention:** Any discovery related to technological development, new use or application, process, new know-how, new design, painting, music, or any new scientific processes that may be patentable or copyrightable under the United States or International Patent Laws.
- k. **Inventor:** A person or persons responsible for an invention.
- l. **Institutional Works:** Works that are produced as a result of specific allocation of LOC funds for a specific LOC purpose.
- m. **Research Disclosure:** A document submitted by one or more College employees to the Office of Academic Affairs (OAA) that describes potentially patentable materials.
- n. **Scope of employment:** Activities that have been assigned to an employee incorporated within the employee's job description.
- o. **Substantial Use of College Resources:** The use of College resources by a College employee with the exception of the customary use of office space, laboratories, studios, libraries; library collections, subscriptions or services; secretarial or other staff assistance; computer time or computer or lab equipment on hand; network or Internet access; standard office equipment and supplies.
- p. **Trade Secret(s):** Information including, but not limited to technical or nontechnical data, a formula, a technique, a drawing, a process, financial data, financial plans, product plans, or a list of actual or potential customers or suppliers which: (i) derives economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper and legal means by, other persons, who can obtain economic value from its disclosure or use; and (ii) is the subject of efforts that is reasonable under the circumstances to maintain its secrecy.
- q. **Work:** Any copyrightable material, such as literary, scholarly, musical, dramatic choreographic, pictorial, graphic, sculptural, motion pictures, audio visual sound recordings, architectural, computer software or database, and recorded lectures.

V. Definitions related to funds generated through Intellectual Property:

- a. **Equity:** Shares of common or preferred stock, options to purchase, warrants and other convertible instruments, and any other instruments representing an ownership interest in a commercial venture or the right to acquire the same. However, Equity shall not include the receipt of real or personal property; e.g., real estate or equipment.
- b. **Gross Income:** Profit/Income received from the sale, lease, or licensing of intellectual property, or bonuses, payments, or other profit/income derived from equity received as a result of sale, lease, or licensing of intellectual property, or profit/income received from the sale of equity received as a result of sale, lease, or licensing of intellectual property.
- c. **Licensing Income:** Money received by the College as a result of the grant of an option to license or a license to another entity in consideration for the option or license granted to the entity. Licensing Income may include, but not be limited to, upfront payments, milestone payments, annual licensing fees, royalties and other forms of revenue received from another entity. Licensing Income does not include Equity or proceeds derived from liquidating Equity.
- d. **Net Revenue:** The gross income minus direct or indirect cost related to the cost of copyright registration, patent execution, commercialization, defense, maintenance, and administration of intellectual property.
- e. **Net Licensing Income:** Licensing Income received by the College less the College's out-of-pocket patent, and other legal and licensing expenses.

VI. Ownerships of Intellectual Property by the Inventor:

- a. **Copyrightable Material:** Ownership of personal copyrightable materials, such as scientific writings, articles, and presentations, shall remain the property of the author (faculty and staff members, artists in residence, and visitors). The right of ownership shall remain with author unless the work was the outcome from direct allocation of funds from LOC for a specific project.
- b. **Book, Articles, and similar works:** The ownership of pedagogical, scholarly, or artistic works, including but not limited to thesis, papers, and articles, shall remain with the inventor. LOC does not have a claim or right to ownership to fiction, nonfiction, novels, textbooks, poems, musical compositions, or other works of artistic imagination.
- c. **Patentable or copyrightable work produced during sabbatical or short term vacation:** Any scholarly or artistic work produced during such period will remain the property of the inventor or creator except when the creator or inventor transfers rights, in writing, to the College to produce income or to increase the positive image of the institution.

- d. **Loss of Intellectual Property Rights:** Intellectual Property Rights may be lost if the inventor or any co-inventor makes a non-confidential public disclosure prior to filing a patent application. Therefore, confidentiality of ideas and procedures of invention is the utmost responsibility of the inventor and co-inventors.
- e. **Course Material:** Copyrights shall be owned by the creator unless the copyrights are subject to any claim of ownership by another entity or individual. In that case, Course Material shall be owned by the entity or individual with the valid claim of ownership because of prior copyright of inclusion in a prior professional publication.
- f. **Work created by a student:** Copyrights shall be owned by the creator in response to their course work assignment or work created on their own time and without substantial use of College resources and educational and research supervision by the employee of the College, regardless of their employment status at LOC. LOC can use their invention for teaching purposes but only with the written permission of the inventor.

VII. Externally Funded Research: All patentable or copyrightable Intellectual Property developed by the LOC employee(s) performing work sponsored by governmental, commercial, industrial, or other public or private organizations shall be determined according to the policy of the funding agency.

VIII. Ownerships of the Intellectual Property by the College:

- a. **Work by an employee:**
The College specifically directs a faculty member, staff member, or a student to create a specific work or as a part of specific duty as described in the job description or an employment agreement.
- b. **Curriculum** shall be owned by LOC.
- c. **Work of non-employees:** Ownership of works created by non-employees that are the result of a request or direction of the College, utilizing LOC's ideas, efforts, and resources shall remain with the College. A written agreement, stating that rights were assigned to the College, from non-employees is required.

IX. Use of the College's name in Copyright notices:

The following notice should be placed on the College-owned materials in order to protect the copyright:

Copyright©[year] The LeMoyne-Owen College. All Rights Reserved

No other institutional or department name is to be used in the copyright notices, although the name and address of the department to which readers can direct inquiries may be listed below the copyright notice. Additionally, works should be registered with the United States Copyright Office using its official forms. The url link <http://www.copyright.gov/> is helpful.

X. Responsibilities:

Responsibilities of the employee inventor or creator to the College:

- a. **Research Disclosure of Commercial Value.** All LOC employees who create an invention that may have commercial value are obligated to disclose such Inventions to OAA if the activity was part of their educational and research activities and involved substantial use of college resources. The Research Disclosure should be submitted well in advance of making a public disclosure of the potential invention to protect patentability of the potential invention.
- b. **Assignment of Rights.** The College shall have ownership of any invention of commercial value that involved substantial use of college resources within the scope of employment. Each College employee is required to assign to the College all domestic and foreign rights to any such invention.
- c. **Confidentiality.** The College desires to uphold acceptable standards of confidentiality. Therefore, it is imperative that all LOC employees would receive permission from OAA before having discussions pertaining to the creation of patentable inventions or disclosure of Trade Secrets.

Responsibilities of the College to the inventor or creator:

- a. **Research Disclosure.** The OAA will assist the College employees in completing a Research Disclosure. College employees are encouraged to discuss their ideas with the OAA in the early stage of the research.
- b. **Timely Determination of Interest.** The OAA is obligated to review the Research Disclosure within fifteen working days of the request and to communicate next steps to the College employee(s).
- c. **Reasonable Efforts to Commercialize.** The OAA is obligated to seek and expedite the process of getting copyright and patent for the invention.
- d. **Identification of Commercial Partner:** The OAA will assist the inventor to identify a commercial partner for any invention for which the College has ownership rights and to negotiate licensing terms that are fair and equitable to all parties involved.
- e. **Release of Rights.** The College is obligated to offer to release the right, in writing, to the College employee(s) if the College decides not to pursue or maintain Patent protection or wishes to discontinue efforts to commercialize the invention, creation of artistic work.
- f. **Determination of Inventors and Non-Inventors:** Inventor of a patent is determined according to United States patent law.

XI. Distribution of funds generated through Intellectual Property or patents:

Licensing Income Sharing: Subject to restrictions, arising from overriding obligations of the College; pursuant to gifts, grants contracts, or other agreements with outside entities, the College will, following assignment of Inventions and patent rights by the Inventor(s) to the College and distribute Net Licensing Income as follows:

50% to Inventor(s)

50% to the College as given below:

- 10% to the Inventor(s) Department or Center to support and encourage further research. In this category all academic and non-academic units are included.
- 10% to the Office of Academic Affairs
- 30% to the Operations Budget of the College

This distribution formula may change for a specific invention after negotiations with the inventor and with the approval, in writing, of the OAA.

In the case of Multiple Inventors, the inventors will determine the allocation of their shares in writing when the work is first started.

Distribution of proceeds derived from liquidating Equity will be determined according to the specific circumstance of the Equity arrangement.

XII. Disputes:

- a. The OAA will establish, an ad hoc Intellectual Property Committee that will review any disputes and will inform the OAA of the decision. The Intellectual Property Committee will consist of faculty members nominated by the Faculty Senate and staff members, if needed.
- b. The OAA will inform the concerned party or parties of the decision within fifteen days after receiving the decision of the Committee.
- c. If the party or parties are not satisfied with the decision of the committee, within fifteen working days, the concerned parties can appeal the decision to the President of the College. The President will have final authority to settle any disputes. The President will inform the concerned party or parties with fifteen working days of his final and binding decision.

XIII. Modification of the Intellectual Property Policies and Procedures:

The policies stated here-in may be reviewed and revised after consultation with the faculty and staff and notification of any changes in the existing policies will be made.

LeMoyne-Owen College
Research Disclosure of Commercial Value Form

DATE: _____

Lead Inventor: _____

Department: _____

Co-Inventor: _____

Department: _____

Co-Inventor: _____

Department: _____

Title of Invention: _____

Funding sources: _____

Publication (s): List any publications or any anticipated publications:

1. _____
2. _____
3. _____

I/we agree to assign to LeMoyne-Owen College my/our rights of Intellectual Property of this invention. I/we also agree that any income resulting from this invention will be distributed according to the policies of the College.

Lead Inventor: _____
(Name, Signature, Date)

Co-Inventor: _____
(Name, Signature, Date)

Co-Inventor: _____
(Name, Signature, Date)