

ENGAGING CORPORATIONS

Confidentiality & Intellectual Property Considerations

Background: Faculty often have questions about Non-Disclosure Agreements (NDAs) and Intellectual Property (IP) ownership when engaging with external companies. This guidelines contained in this handout were developed in partnership with the Office of General Counsel (OGC) and the Office of Research and Innovation within the Office of Research and Sponsored Programs (ORSP) and made pursuant to Marquette University's Intellectual Property Policy, available [here](#). These guidelines and documents referenced herein may be updated from time-to-time.

A. Non-Disclosure Agreements (NDAs):

1. Faculty should request an NDA before sharing any confidential information including non-public research data, unpublished results, proprietary information, or details about potential inventions with a company.
2. Marquette has a standard mutual NDA template available on the OGC [website](#). Marquette's form is fair and mutual and should be leveraged whenever possible.
3. If a company insists on its own NDA form, it must be reviewed before signing.
4. If you need to exchange confidential information with an external party, contact the relevant department who will review/negotiate the terms to ensure compliance with Marquette's IP policy:
 - ORSP
 - OGC
5. Only individuals with delegated signature authority may sign. Currently, this includes:
 - **Ralph Weber**, Vice President and General Counsel
 - **Jeanne Hossenlopp**, Vice President of Research and Innovation
6. To the extent a company will work directly with a student, the company may require the student to sign an NDA. That agreement will be effective between the company and the student, but we should require the company's NDA to be clear and understandable to the student, and the NDA should not require disclosure of unpatented research or inventions.

B. Intellectual Property Ownership under Marquette's IP policy is as follows:

Who Owns the Intellectual Property?



Owned by the University if IP is:

- Created within the scope of University employment, or University Projects, or
- Under University grants & contracts with government entities or third parties; or
- With significant use of University Resources



Owned by individual faculty, staff or student if IP is:

- Created outside the scope of University employment, and
- Without any significant use of Marquette University Resources

Ownership of Inventions is determined by the date of invention and U.S. inventorship laws.

1. **University Ownership:** IP created by Faculty or Staff, or by Students working on University research or other University projects, is owned by the University if it is created:
 - a. within the scope of University employment, or
 - b. under University grants and contracts with governmental entities or other third parties; or
 - c. with significant use of Marquette University Resources (e.g., funded research, graduate assistants, specialized labs).
2. **Individual Ownership:** If the IP is created outside the scope of University employment and without any significant use of University Resources, the individual will own the intellectual property. Incidental use (library, laptop) does not constitute “significant use of University Resources.”
3. **Examples of Application of IP Policy to Specific Circumstances:**
 - a. **Faculty Academic Works:** Faculty own pedagogical, scholarly, and artistic works (which are not considered “Works for Hire”).
 - i. Exceptions may apply for:
 - Third-party sponsored agreements.
 - Special projects (e.g., online courses, digital education).
 - ii. Consulting agreements involving IP must be approved by the Office of General Counsel.
 - b. **License to University:**
 - i. Faculty grant limited licenses to the University for course materials:
 - **If intended for use by others:** Perpetual, nonexclusive, worldwide, royalty-free license for administrative and instructional purposes.
 - **If not intended for others:** Nonexclusive, worldwide, royalty-free license for 5 academic years after faculty departure for similar course use.
 - ii. Licenses do not cover electronic courses (see below).
 - c. **Special Projects & Electronic Courses**
 - i. Specific written agreements may reallocate rights for:
 - University publications
 - Digital courseware
 - Distance-learning curricula
 - ii. For electronic courses (> 75% online content):
 - Faculty assign rights to the University in exchange for agreed payment
 - Agreement specifies compensation and terms
 - University holds full copyright for exclusive control of course delivery.
 - Faculty may request no-cost licenses to create derivative works (liberally granted)
4. **Student Intellectual Property:**
 - a. **Coursework:** Students generally own IP created as part of their coursework.
 - b. **University Ownership:** IP belongs to Marquette when:
 - i. Created under sponsored research
 - ii. Covered by agreements (e.g., employment, research fellowship, financial aid, or special projects)

- iii. Student is supported by Marquette (TA/RA)
- c. **Self-Funded Students:** If a student pays tuition and receives no stipend, IP belongs to the student **unless:**
 - i. The advisor is actively involved in the research,
 - ii. Grant funds support the work, or
 - iii. The work requires significant use of university resources
- d. **Advisor Actively Involved:** If an advisor is actively involved, the research is considered “sponsored research” and the corresponding IP belongs to the University.

5. Examples of Student Involvement:

- a. **For IP generated during Senior Design Projects sponsored by Marquette faculty:**
 - i. If **grant funds** are used, Marquette owns the IP under its IP Policy.
 - ii. When grant funds are used, Marquette must disclose any invention to the funding agency as required by federal regulations.
 - iii. If **grant funds are not used**, and only small amounts of personal or non-grant departmental funds are involved, students typically own the IP.
 - iv. Faculty mentors are expected to **identify a need and provide guidance**, but not contribute to the design, development, or creation of the product. This ensures students are responsible for all aspects of the project.
 - v. As a result, faculty mentors generally do not contribute to project IP, and Marquette typically does not claim ownership.
- b. **For IP generated during Senior Design Projects sponsored by a company:**
 - i. Companies may enter into NDAs and IP agreements directly with students without involving Marquette. IP ownership will follow the terms of those agreements; companies often require students to assign IP rights to the company.
 - ii. If the company does **not** require assignment of IP rights, students retain ownership.
 - iii. Students who own their IP may continue working on or funding their projects after graduation and may collaborate with third parties.
 - iv. If students want Marquette to pursue patent protection, the Office of Research and Innovation will evaluate the invention through the Patent Review Committee.
 - v. If Marquette decides to file a patent (which is costly), students must assign their IP rights to Marquette before filing.

6. Who Reviews and Signs Other IP Agreements (e.g., Option, License, Joint Ownership Agreements):

- a. Office of Research and Innovation through the Technology Transfer Program drafts and negotiates IP agreements with review and approval by OGC.
- b. Authorized signatories for other IP agreements:
 - i. **Ralph Weber**, Vice President and General Counsel
 - ii. **Jeanne Hossenlopp**, Vice President of Research and Innovation

Questions? Please contact the following for assistance with NDAs and other IP matters:

- Office of Research and Innovation within ORSP
- Office of General Counsel