

## **FAQs—Intellectual Property Policy**

### **1. What is and is not included in the term “with support from University-administered funds, facilities, or personnel”?**

The term “support” requires that University funds must actually be used to pay for facilities, equipment, or personnel used in connection with the reduction of the invention to practice (i.e., making it and proving that it works). Next, University funds include the payment of salaries of any University employee, adjunct faculty member, or visiting faculty member who is considered an inventor for that invention. University facilities include University laboratories and the vivarium, as well as capital equipment purchased by the University and made available for use in research. University personnel include faculty, staff, and graduate and undergraduate students who receive compensation for services rendered in connection with research or activities that lead to the invention.

Incidental use of University funds, facilities, or personnel would not be included in this definition. For example, use of laboratory and office consumables, standard office software, personal computers, telephones, and faculty offices in connection with work that leads to an invention, individually or together, would not alone meet this definition.

### **2. If I invent something in my basement and on my own time, does the University own it?**

For purposes of the Intellectual Property Policy, there is no such thing as “on my own time.” There are only “activities related to an individual’s employment responsibilities” and those that are not. The time of day, the day of the week, the location, and whether an employee is on vacation or otherwise excused from being physically present at the University are not relevant to determining whether the rights associated with an invention have been assigned to the University.

### **3. What does “related to an individual’s job responsibilities” mean?**

Each university personnel has defined responsibilities associated with his or her appointment. These responsibilities are set forth in various places, such as the annual letter of appointment, the Faculty Handbook, duties assigned from time to time by a department chair or dean, grant agreements in connection with which a faculty member is an investigator, and job descriptions. What a faculty or staff member actually does on a regular basis and what the faculty member claims on his or her CV is part of his or her scholarly activities also helps to define his or her job responsibilities.

If an invention is related to an individual’s job responsibilities—that is, if the activities undertaken in connection with that invention fall within the scope of the individual’s job responsibilities—then the resulting invention has been assigned to the University. These determinations are made based on the specific facts and circumstances involved. For example, if a faculty member in the English Department were to discover a cure for cancer, or were to invent a more powerful computer chip, the University would have no ownership rights in that discovery or invention, because the faculty member’s “job responsibilities” are completely unrelated to research involving cancer research or computer hardware.

Where a faculty member proposes to do research in connection with a consulting arrangement that relates to his or her job responsibilities, the Director of Technology Transfer should be advised. It may be possible to structure the consulting arrangement in such a way as to resolve in advance any issues as to whether those responsibilities are “related to an individual’s job responsibilities.” This will avoid any disputes in the future concerning ownership of resulting intellectual property. Other questions can also be addressed in advance upon request.

**4. What does “faculty supervision” mean in connection with the ownership of intellectual property by students?**

Except for students receiving compensation for services rendered under the direction of a faculty member, students are not subject to the Intellectual Property Policy and own whatever intellectual property they may develop as students. In some cases, faculty members provide general supervision and oversight concerning various student-led research efforts. The University claims no interest in any resulting intellectual property in those situations unless “faculty supervision” directly contributes to the inventive process. This is a determination made based on the facts and circumstances related to a particular invention.

**5. What benefits can I expect in return for the assignment of my intellectual property rights to the University?**

Section VII of the Intellectual Property Policy specifies how income from intellectual property is distributed. Generally, the University assumes the costs associated with the necessary protection of those rights, such as patent prosecution or the filing of copyright registrations, as well as the costs associated with the marketing of the intellectual property for licensing to third parties. After out-of-pocket costs are paid, inventors receive 50% of the remaining revenue, with the other 50% divided among specified University functions. Software is the only exception, where the author receives up to 33% of the remaining revenue, with the exact amount determined by the Dean based on the criteria listed in the policy.

**6. What constitutes public disclosure?**

The University’s right to prosecute a patent on an invention depends in part on the date on which a “public disclosure” of the invention has been made. The term as used in the policy is intended to be the same as that term is used in applicable law. Consequently, what constitutes “public disclosure” may change over time.

Generally, publication of results, or presentation at conferences, is the most common way in which faculty members make public disclosures of discoveries or inventions. Presenting material in class to students or classroom guests, unless those individuals have signed non-disclosure agreements, would also constitute public disclosure. Putting posters disclosing the invention on walls in areas where the members of the general public would have access to the information would also constitute public disclosure. Discussion with other University faculty subject to the Intellectual Property Policy would generally not constitute public disclosure, and disclosure to sponsors under confidentiality obligations would also generally not constitute public disclosure.

Nevertheless, since the highest legal protection of patent rights occurs when patent applications are made prior to any public disclosure, faculty members are strongly encouraged to file disclosures of discoveries and inventions with the Office of Research and Sponsored Programs

(ORSP) at the earliest possible opportunity, even before disclosure within the University, and to advise of any scheduled publications or presentations of the material in the future. This will allow the timely filing of patent applications in advance of public disclosure.

### **7. What is the scope of the University's license in a faculty member's pedagogical materials?**

With respect to some of those works of authorship that the University does not require faculty members to assign to the University, such as teaching and classroom materials such as class notes, syllabi, curriculum guides, and laboratory notebooks, the University nevertheless retains a right "to use, display, copy, distribute, and prepare derivative works for administrative use, as well as use in educational programs and courses provided directly by the University to students." In part, this right is necessary to permit the University to "display" these materials in D2L. Furthermore, in those situations where faculty members are unable to complete their teaching responsibilities in a particular course, the University needs to be able to use these materials to fulfill its obligations to students even if the faculty member is no longer an employee of the University.

More broadly, although the copyright for these materials belongs to the faculty member, University resources, in the form of salary, are being used to support the creation and future development and improvement of these materials. As it is the fundamental mission of any educational institution to develop and to transmit knowledge, the University has traditionally reserved the right to allow one faculty member to use the materials prepared by another faculty member to provide educational programs and courses here at the University. It is typically not possible over time to track the ownership of these materials, and so the license is necessary to assure that the University is not prevented from providing the highest quality instruction to its students.

Software and electronic courses prepared by faculty members are not subject to this license, nor are textbooks, course materials, refereed literature, dissertations, theses, papers, journal articles, popular nonfiction, novels, poems, musical compositions, and other works of artistic imagination. With respect to software, the University takes an assignment from the faculty member and pays compensation as set forth in the policy. With respect to the electronic courses, separate arrangements are typically made with faculty members to obtain full assignments of intellectual property rights in return for separate compensation paid.

### **8. Why are staff being asked to assign their rights? Isn't this just for faculty?**

The university's intellectual property policy applies to all employees (as did the previous policy). The assignment of rights is restricted to intellectual property that is related to your job duties.

### **9. How are mobile apps for smartphones and tablets handled under the University's Intellectual Property Policy?**

Mobile applications designed to operate on smartphones and tablets fit within the definition of "Software" in the University's Intellectual Property Policy, provided that they are developed for University purposes or as part of sponsored research and not as part of a faculty member's independent research or scholarship.

**Software means any computer program or database, or part thereof, designed to accomplish a task or allow a user to produce, manage, analyze, or manipulate a product, such as data, text, a physical object or other Software, that has been developed for university purposes, excluding software developed by faculty as part of their independent research or scholarship. Sponsored research is not independent research or scholarship. Software may be protected by Patent, Copyright, or Trade Secret.**

If the Software is patented, it is treated the same as any other invention. If Software is not patented, and its legal protection by the University is based on copyright, then any such Software programs "are works made for hire and are the property of the University."

If the software is patented, the Inventors are entitled to 50% of royalties. If the software is not patented and treated as a copyrighted work, 67% of the royalties are paid to the responsibility center(s) from which the Originators of the software come. One-half of those royalties, or 33% of total royalties, are distributed to the Originators upon actual receipt. Distribution ceases when the Originators are no longer employed by the University. The Dean may allow the royalties to be paid among multiple Originators on other than a *pro rata* basis, taking into account the number of participants in the project, creative or inventive contribution, extraordinary project leadership, and time devoted to the project outside customary working hours.

Since none of the proceeds specifically go to other functions of the University that may be instrumental in commercializing the application, it may be appropriate or necessary for the University to provide supplemental funding to, or the responsibility center may share a portion of its proceeds with, those offices involved in commercializing the application, such as the Office of Research and Sponsored Programs.

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