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Patenting University Inventions

University Policy Number 4003

Categorized: [Research](#)

Responsible Office: [Office of Technology Transfer, Vice President Research and Economic Development](#)

Policy Procedure:

- N/A

Related Law & Policy:

- [Policy 4002: Copyright in University Works](#)
- [Policy 1104: Use and Reproduction of Copyrighted Materials](#)

I. PURPOSE AND SCOPE

George Mason University is committed to encouraging the making of patentable inventions, the successful commercialization of those inventions, the equitable allocation of income from commercialization, and the protection of the rights of patent holders. This policy addresses the ownership of, benefit from, and other matters relating to inventions made at the university.

Members of the university community may obtain advice and assistance on how to secure patent protection for inventions and how they may be commercialized from the university's Office of Technology Transfer (OTT, <http://research.gmu.edu/techtransfer/techtransfer.html>). Potential inventors should be aware that patent protection for an invention made as a result of certain collaborations may be unavailable if the collaboration is not reflected in a simple "joint research agreement" that describes the scope of the collaboration and names the

parties to it.¹ OTT can assist in the preparation of these agreements. In addition, inventors are reminded that any release of information about an invention before an application for patent protection is filed may result in the limitation or denial of that protection.

This policy is required by State law to cover certain persons. Virginia Code, section 23-4.3 B, requires that employees be bound by the university's patent policy as a condition of employment.

Article I, section 8, clause 8 of the United States Constitution grants to the Congress the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the Exclusive Right to their respective Writings and Discoveries.” Pursuant to that authority, Federal patent law in Title 35 of the United States Code protects inventions and discoveries. Specifically, patents protect new, useful, and non-obvious –

- Processes;
- Machines;
- Articles of manufacture;
- Compositions of matter;
- Improvements to processes, machines, and compositions of matter;
- Plants; and
- Ornamental designs.²

The owner of a patent has the right to exclude others from —

- Making;
- Using;
- Selling;
- Offering for sale; or
- Importing

inventions covered by the patent.³

If a patent is jointly owned, the law provides that “[i]n the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, without the consent of or without accounting to the other owner.”⁴

The treatment of inventions made with Federal support is governed by Federal law, including the Bayh-Dole Act (the Patent and Trademarks Act Amendments of 1980.)

II. POLICY STATEMENT

A. OWNERSHIP OF INVENTIONS MADE AT GEORGE MASON UNIVERSITY

1. INVENTIONS MADE IN THE COURSE OF SPONSORED RESEARCH

An invention made by any person in the course of research at George Mason University sponsored by a Federal agency, industry, or any other entity is owned by the university, except that –

- a. The sponsorship agreement may provide otherwise; and
- b. The university makes no claim of ownership of copyrightable and patentable software if the conditions in Part II (A)(2)(e), relating to open source software, are met.

2. OTHER INVENTIONS

Ownership of an invention not made in the course of sponsored university research is determined as follows:

a. Inventions by university employees

An invention made by an employee of the university in the course of fulfilling his or her employment responsibilities or with substantial use of significant university resources as described in Part II (A)(2)(d) is generally owned by the university.

b. Inventions by students who are not university employees

An invention made by a student who is not engaged in fulfilling his or her responsibilities as a university employee is owned by the student, with the following exceptions:

i. Substantial use of significant university resources. The university generally owns the invention if it is made with substantial use of significant university resources, as described in Part II (A)(2)(d).

ii. Internships with outside employers. Ownership of inventions made by a student in the course of outside employment that is a part of his or her academic work may be specified in an agreement between the university and the employer.

c. Inventions by visiting researchers

Ownership of an invention made by a visiting researcher is generally specified in an agreement between the researcher or the researcher's employer and the university.

d. Substantial use of significant university resources.

The university owns the invention if it is made with substantial use of significant university resources and has considerable potential commercial value, except that the university makes no claim of ownership to an invention that is made pursuant to an agreement between the inventor and a third party for the making of the invention. Substantial use of significant university resources occurs when an invention is made with the substantial use of significant university equipment or facilities, the use of special financial assistance from the university, or the significant assistance of university employees. The use of a university computer or servers or of incidental supplies, or the occasional use of university administrative employees or shared facilities, would typically not be a basis for university ownership.

e. Open source software.

The university makes no claim of ownership of copyrightable and patentable software if (1) the university does not hold copyright in the work, and (2) all known creators and inventors of the software agree to make it available under an open source license that meets the requirements of The Open Source Definition, Version 1.9, of the Open Source Initiative. The Vice President may update the requirements for an open source license under this policy.

3. UNIVERSITY PROCEDURES REGARDING OWNERSHIP OF INVENTIONS

a. General provisions.

The university claims and disclaims ownership of inventions by operation of Federal patent law, by this policy, and by entering into agreements with parties who employ students as a part of their academic work. Subject to provisions of the Federal patent law, patents are endowed with the attributes of personal property.⁵ Any interest in a patent or patent application is assignable by written instruments.⁶ State law prescribes limits on, and procedures for, the university's transfer of interests in patents in certain works. See Part II (C)(3).

b. Inventor's duty to disclose.

The inventor of an invention that the inventor reasonably believes the university owns or may own under Part II (A)(1) or (2) must disclose the existence of the invention to the university as soon as it is conceived or first

reduced to practice. Prompt disclosure to the university before public disclosure is critical to obtaining full patent protection of the invention and is essential to the fulfillment of the university's obligations to funders of sponsored research. The disclosure must be provided to the Director of the Office of Technology Transfer using the Invention Disclosure Form.

If the invention is made by more than one inventor to whom this policy applies, those inventors must sign a single disclosure and include the percentage of each inventor's share of net income derived from the invention that is claimed by each inventor under Part II (D)(3).

c. Inventor's duty to assign and assist.

If the university owns an invention under Part II (A)(1) or (2), the inventor must assign title to the invention to the university in a manner prescribed by the Office of Technology Transfer. In addition, the inventor must execute all documents needed to support the prosecution of United States and foreign patents to the invention and provide reasonable assistance to the university or its assignee for the commercialization of the invention.

d. Notice that university does not claim ownership of an invention.

At the request of an inventor who reasonably believes that he or she owns an invention under Part II (A)(1) or (2), the university provides the inventor with a statement that the university does not claim ownership of the invention within 45 days of receipt of the request by the Director of the Office of Technology Transfer.

B. ADMINISTRATIVE ORGANIZATION

1. RESPONSIBLE OFFICERS AND ORGANIZATIONS

The following officers and organizations are responsible for the administration of this policy:

a. Vice President for Research and Economic Development. The Vice President for Research and Economic Development is responsible for the overall administration, interpretation, and application of this policy. The responsibilities of this officer include deciding questions concerning the application of this policy to ownership of inventions under Part II (A) and the allocation of net income from these inventions under Part II (D)(3). In specific and unusual circumstances, the Vice President may approve deviations from this policy and resolve questions relating to the subject matter of the policy but not clearly addressed by it.

b. Office of Technology Transfer. The Office of Technology Transfer serves as the Vice President's principal staff office for the administration and application of this policy. OTT approves any provisions of agreements between the university and others that address the development of new intellectual property. OTT also advises faculty, staff, and students on matters relating to inventions owned by the university and the university's use of inventions owned by others.

c. Purchasing Department. The Purchasing Department executes licensing agreements that permit the university to practice patented inventions owned by others.

d. Intellectual Property Committee. The Intellectual Property Committee hears appeals from decisions of the Vice President on disputes under this policy, as described in Part II (E), and provides advice and recommendations to the university administration on patent policy and procedures.

e. Provost. The Provost hears appeals from decisions of the Intellectual Property Committee on disputes under this policy, as described in Part II (E).

f. Senior Vice President. After considering the recommendation of the Vice President for Research and Economic Development, the Senior Vice President decides whether the university will commercialize an invention by assigning title to the invention, as described in Part II (C).

2. INTELLECTUAL PROPERTY COMMITTEE

- a. **Membership.** The Intellectual Property Committee is comprised of seven members, three appointed by the Faculty Senate, three appointed by the Vice President for Research and Economic Development, and one appointed jointly by the Faculty Senate and the Vice President. All members must be members of the faculty and knowledgeable of intellectual property matters.
- b. **Meetings.** The Committee meets annually in September and at other times at the call of the Chair or the Vice President for Research and Economic Development.
- c. **Terms.** Committee appointments are for three years, beginning on September 1 and ending on August 31, except that, of the original appointments, (1) two (one by the Faculty Senate and one by the Vice President) are for one year, (2) two (one by the Faculty Senate and one by the Vice President) are for two years, and (3) the remaining appointments (one by the Faculty Senate, one by the Vice President, and the joint appointment of the Faculty Senate and the Vice President) are for three years. Original appointees serve from the date of their appointments through the first subsequent August 31 in addition to their terms as described in the preceding sentence. Members may serve successive terms.
- d. **Chair.** The Committee selects the Chair-7 from among its members at its annual September meeting. The Chair serves until the earlier of the next annual meeting or the expiration of the Chair's term as a member of the Committee. The Chair may serve successive terms.
- e. **Vacancies.** If a vacancy occurs on the Committee before the expiration of a member's term, a successor is appointed to fill the unexpired term in the same manner as the original member was appointed. If a member goes on an extended period of leave, a replacement to serve until the member returns is appointed in the same manner as the member on leave was appointed. If the Chair goes on an extended period of leave, the Committee selects a replacement from among its members to serve until the Chair returns.

C. PROTECTION AND COMMERCIALIZATION

1. PROTECTION OF RIGHTS IN UNIVERSITY-OWNED INVENTIONS

The Vice President for Research and Economic Development or that officer's designee acts for the university in pursuing and maintaining protection of the rights of the university and the inventor in inventions owned by the university.

2. COMMERCIALIZATION OF UNIVERSITY-OWNED INVENTIONS

- a. To commercialize an invention that it owns, the university usually assigns title to George Mason Intellectual Properties, Inc. (GMIP).~~8-~~ In rare circumstances, the university seeks to commercialize the invention itself or assigns title to the Innovative Technology Authority; to an entity whose purpose is to manage intellectual property on behalf of nonprofit organizations, colleges, and universities; or to another party. Before assigning title to an invention to a party other than GMIP, the university obtains the inventor's approval of the assignment. The assignee commercializes the invention by entering into one or more licensing agreements with other parties or by assigning title to the invention to another party to commercialize the invention.
- b. The Senior Vice President decides whether the university will assign an invention for commercialization after receiving the recommendation of the Vice President for Research and Economic Development.
- c. The university or its assignee decides in a timely manner whether it intends to commercialize an invention. If the university or its assignee does not intend to commercialize an invention, the university promptly notifies the inventor and either (1) assigns title to the invention to the inventor, or (2) if required, seeks permission from the sponsor to assign title to the inventor.
- d. When the university assigns title to the invention, the university retains a nonexclusive, nontransferable, irrevocable paid-up license to practice and have practiced the invention for the university's educational and research purposes.

3. APPROVAL OF GOVERNOR FOR CERTAIN UNIVERSITY ASSIGNMENTS TO THIRD PARTIES

The university must obtain the Governor's prior written approval for the assignment of an interest in an invention if –

- a. The invention was developed wholly or predominantly through the use of state general funds, exclusive of capital assets; and
- b. Either the invention was developed by an employee of the university acting within the scope of his or her assigned duties, or the proposed assignee is a party other than GMIP, the Innovative Technology Authority, or an entity whose purpose is to manage intellectual property on behalf of nonprofit organizations, colleges, and universities.⁹

4. COMMERCIALIZATION OF INVENTIONS NOT OWNED BY THE UNIVERSITY

If the inventor or another party who holds title to an invention in which the university has no ownership interest wishes the university to become involved in its commercialization, that party must first assign title to the invention to the university. The university may accept or decline the offer of such an assignment. The university accepts an assignment by entering into an agreement that sets out the rights and responsibilities of the parties, including how revenues will be shared. The Vice President for Research and Economic Development or that officer's designee signs the agreement on behalf of the university.

D. INCOME FROM INVENTIONS OWNED BY THE UNIVERSITY

This Part II (D) governs the allocation of royalties and other income from inventions owned by the university, including software and other inventions in which the university owns both copyright and patent, unless an agreement between the university and the inventor provides otherwise.

1. GROSS INCOME

For the purpose of this policy, gross income derived from an invention includes, but is not limited to –

- a. Option fees;
- b. License fees;
- c. Running royalties;
- d. Minimum royalty payments;
- e. Milestone payments;
- f. Proceeds from the sale of stock or other equity in the licensee company; and
- g. Funds and other compensation received as a result of the resolution of disputes related to the invention.

Gross income does not include revenue received under sponsored program agreements related to the invention.

2. NET INCOME

Net income is gross income derived from the invention less the following costs where they are specifically attributable to the invention-10 –

- a. The costs of obtaining and maintaining patent protection;
- b. The costs of developing the invention for license;

- c. The costs of marketing the invention;
- d. The costs of ensuring licensee performance;
- e. Payments required by the sponsored program agreement under which the invention was made; and
- f. Reimbursements of the inventor's expenses directly associated with developing the invention for commercialization, if these reimbursements are approved by the Office of Technology Transfer.

3. DISTRIBUTION OF NET INCOME

a. Net income is administered by George Mason Intellectual Properties, Inc. (GMIP) pursuant to agreement with the university, subject to this policy.

b. Net income is distributed as follows:

i. Inventor. The inventor (or inventors), and any person designated by the inventor, receives fifty percent of net income. These persons receive their shares irrespective of any change in their employment. If any of these persons dies, his or her share goes to his or her estate.

If the university commercializes an invention and the license provides for an option regarding future inventions by unknown inventors, the inventor's share of net income attributable to that option is distributed to the research group that is conducting research related to the field of use of the licensed invention. The university may seek the advice of the Intellectual Property Committee in identifying the appropriate research group.

ii. Inventor's employing unit. The school, college, institute, or equivalent non-academic unit in which the inventor holds an appointment at the time the invention is made receives ten percent of net income, irrespective of any change in the inventor's assignment within the university or any change in his or her employment. If the inventor holds an appointment in more than one unit, the unit's share is distributed in proportion to the inventor's percentage appointment, as expressed in his or her letter of appointment.

iii. George Mason Intellectual Properties, Inc. GMIP administers the remainder of net income pursuant to its agreement with the university.

c. The distribution of net income from the invention may be revised by the Vice President for Research and Economic Development to take account of the costs of litigation or other costs arising from disputes related to the invention.

4. INVENTOR'S ACCESS TO INFORMATION

The inventor of an invention owned by the university, or the inventor's authorized representative, has the right to review the income and expenses that form the basis for the calculation of gross income, net income, and the distribution of net income related to the invention.

E. DISPUTE RESOLUTION

This Part II (E) addresses the process for resolving disputes concerning this policy.

1. Appeals to Intellectual Property Committee. As described in Part II (B), the Vice President for Research and Economic Development is responsible for the overall administration, interpretation, and application of this policy. Any party who is covered by this policy may appeal to the Intellectual Property Committee a decision of the Vice President concerning—

- The ownership of an invention;
- The allocation of royalties and other income from an invention; or

- Any other issue arising under the terms of the policy.

2. Procedure for appeals. A party may appeal the decision of the Vice President by submitting a request for review of the decision to the Office of Technology Transfer (OTT), which transmits the request to the Chair of the Intellectual Property Committee within 15 days of receipt.

If the appellant is a member of the university staff, the Chair invites the Staff Senate to appoint two members of the staff to participate in the review. The Committee meets, considers the matter on appeal, and issues a decision. If the Committee does not meet to consider the matter within 30 calendar days of the Chair’s receipt of the request, or if the Committee does not issue its decision on the matter within 90 calendar days of the date of receipt, the appellant may appeal the Vice President’s decision directly to the Provost by submitting a request for review to OTT. If the Committee issues a decision, a party may appeal that decision to the Provost by submitting a request for review of the decision to OTT. In either case, OTT transmits the request to the Provost within 15 days of receipt.

3. Final decisions. The Provost issues any decision on an appeal under this policy within 60 calendar days of receipt. If the Provost does not issue a decision within this period, the decision being appealed is final. A decision of the Provost on an appeal is final.

F. PRACTICE OF INVENTIONS AT THE UNIVERSITY

It is the policy of the university that the patent rights of the owners of inventions used at the univeristy by university faculty, staff and students, but not owned by them, will be fully respected. Therefore, these members of the university community may practice an invention for which a license is required only after the university has obtained from the owner a nonexclusive, nontransferable, irrevocable, paid-up license to practice the invention for its educational and research purposes.

“Employee” means a person who works for the university full-time or part-time and is paid through the university’s payroll system.

“Faculty” means an employee who is appointed as a member of the instructional, research, administrative, professional, or visiting faculty, including adjunct faculty, or as a post-doctoral fellow. For the purpose of this policy, administrative and professional faculty are considered faculty when performing instructional, research, or other scholarly functions.

“Staff” means an employee who is not a member of the faculty or a student. For the purpose of this policy, administrative and professional faculty are considered staff when performing administrative and professional functions.

“Student” means a person who is officially enrolled in a course or program of study offered by the university.

If a person is covered by more than one of these definitions, the applicable provisions of this policy are those that relate to the person’s status when the invention was made.

IV. EFFECTIVE DATE, REVIEW, AND APPROVAL

This policy is effective upon approval by the Board of Visitors. The policy will be reviewed and, if necessary, revised every five years or sooner if circumstances require. Any revision will take effect at the beginning of the first university fiscal year following its approval unless the revision specifies a different date.

Footnotes:

 1 35 U.S.C. 103(c), enacted as part of P.L 108-453, the Cooperative Research and Technology Enhancement (CREATE) Act of 2004.

2 35 U.S.C. 101.

3 35 U.S.C. 271(a).

4 35 U.S.C. 262.

5 35 U.S.C. 261.

6 Ibid.

7 The Chair of the Intellectual Property Committee serves ex officio as a full voting member of the Board of Directors of George Mason Intellectual Properties, Inc.

8 Under contract with the university, George Mason Intellectual Properties, Inc. commercializes inventions and distributes the income from the commercialization of inventions. GMIP negotiates licensing agreements for the commercialization of inventions in its sole discretion, subject to the requirements of this policy and of the contract between GMIP and the university.

9 Virginia Code, section 23-4.4 A.

10 Costs paid under the university's "Invention to Innovation" project are excluded. Repayment of these costs is treated in a separate agreement.

Approved:

_____/S_____
Senior Vice President

_____/S_____
Provost

_____/S_____
Board of Visitors

Date: March 19, 2008

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TTY: [Skype Chat](#) | Phone: 703-993-1000

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