



**ILLINOIS STATE
UNIVERSITY**
Illinois' first public university

University Policy & Procedures

4.1.10 Intellectual Property Policy

Overview

Academic research results in new knowledge and creates opportunities for further investigation and exploration. When the products of this research have commercial potential, the University has an obligation to take steps to protect and secure the interests of the individual investigator(s), the University, and the people of the State of Illinois.

In keeping with our campus values, Illinois State University (or "University") recognizes and protects academic freedom. The University will strive to ensure that its faculty, staff, and students will have the ability to freely publish the results of their scholarly activities. As such, nothing contained within this policy is intended to diminish or reduce the academic freedom of any member of the University community.

Objectives

This policy has been developed to address the definition, ownership, and commercialization of the different types of intellectual property developed or created at the University. It is understood that inventions, discoveries, copyrightable, and other creative works may result from the activities of University employees in the course of their duties and individuals using University resources (such as facilities, equipment, funding, or other).

1.1 Illinois State University values the contributions of faculty and staff in generating new technologies and creative works through their scholarly activities. This policy supports these contributions as summarized by the following objectives:

- 1.1.1.** To optimize the creative environment and provide incentives for research, creative expression, and the creation of new knowledge at Illinois State University.
- 1.1.2.** To sustain and enhance the educational mission of the University through research initiatives.
- 1.1.3.** To bring new technologies into practical use for public benefit.
- 1.1.4.** To provide exemplary stewardship of public interests for the people of the State of Illinois by exploring partnerships with external entities to promote and support the University's mission.
- 1.1.5** To ensure that, for federally-supported inventions, the allocation of rights is made according to the requirements of the Bayh-Dole Act.

2. Key Terms

2.1. Intellectual Property: The term "intellectual property" as used herein is broadly defined to include but is not limited to inventions, discoveries, know-how, show-how, processes, unique materials, copyrightable works, original data and other creative or artistic works or any other property interest available under common law. Intellectual property includes that which is protectable by statute or legislation, such as patents, copyrights, trademarks, service marks, trade secrets, mask works, and plant variety protection certificates. It also includes the physical embodiments of intellectual effort such as: models, machines, devices, designs, apparatus, instrumentation, circuits, computer programs, visualizations, biological materials, chemicals, other compositions of matter, plants, and records of research.

2.2. Creator: refers to an individual or group of individuals who make, conceive, reduce to practice, author, or otherwise make a substantive intellectual contribution to the creation of intellectual property, including the definition of "inventor" used in U.S. patent law and the definition of "author" used in the U.S. Copyright Act.

2.3. Inventor: For purposes of this policy the term "inventor" is used as the term in U.S. patent law for patentable inventions and is a subset, or particular type, of Creator.

2.4. Patent: A patent is an exclusive right issued by law to an Inventor for a limited time to prevent other entities from producing, selling, or distributing an invention. A patentable invention is a unique solution to a specific technological problem and can take the form of a tangible product or process. Examples of patentable technologies include:

- 2.4.1. Utility Patent:** A new or useful process, machine, manufacture, or composition of matter.
- 2.4.2. Design Patent:** A new, original, or ornamental design embodied in or applied to an article of manufacture.
- 2.4.3. Plant Patent:** New and distinct, invented, or discovered asexually reproduced plant.

2.5 Copyright: A copyright is defined by law and generally includes original works of authorship which have been fixed in a tangible medium of expression. A copyright differs from a patent in that it protects the "expression" of a work rather than the patentable "idea" of an invention. Examples of copyrightable material include but are not limited to literary and scholarly publications, musical scores, computer programs and software, video or motion picture, sound recordings, photographs, sculpture, and similar artistic creations in which the expression of an idea is embodied or illustrated.

2.6. Proceeds: Proceeds include all consideration received by the University from royalties, the sale, license, or other transfer of intellectual property rights including but not limited to, royalty percentage payments, initial licensing fees, milestone payments, shares of stock, and any other financial considerations in exchange for the rights to University intellectual property. This definition does not include any consideration derived by a Creator from traditional academic copyrightable works and does not include any consideration derived by a Creator from other forms of intellectual property where it has been determined that the University has no ownership rights.

2.7. University Employee: For purposes of this Policy, the term University Employee includes all University academic personnel (faculty; administrative/professional staff working in academic areas, faculty associates); other administrative/professional staff; civil service staff; (both part-time and full-time); student employees, and graduate assistants. In addition, the definition includes persons with adjunct, emeritus or "no salary" appointments or other individuals granted access to University resources if intellectual property created by such individuals is: created with Substantial Use of University Resources; is considered a work for hire under copyright law; the intellectual property results from research supported by Federal funds or sponsored research; or the individual otherwise agrees in writing to abide by this policy.

2.8. Substantial Use of University Resources: Any substantial use of University equipment, facilities, time, personnel, or monetary expenditures by university employee or other individuals unaffiliated with the University is considered a substantial use of University resources. This use does not include resources usually and customarily provided to University faculty and staff such as salary, offices, library facilities, and everyday telephone, computer, and computer network support or written arrangements between University and external entities. For example, resources that are not considered "usually and customarily provided" include such things as the use of substantial funds received by the University through a contract or grant, use of funds allocated from internal discretionary pools above and beyond what is normally available, assistance of support staff outside of a Creator's department or unit, or assistance of support staff from a Creator's department when such assistance is substantially greater than that normally provided others in the department or field.

2.9. Traditional Academic Copyrightable Works: "Traditional academic copyrightable works" are a subset of copyrightable works created independently and at the Creator's initiative for traditional academic purposes where the Creator, rather than the institution, determines the subject matter, the intellectual approach and direction, and the conclusions of the work. Examples of traditional academic copyrightable works owned by the Creator include class notes and syllabi, books,

theses and dissertations, educational software (also known as course ware or lesson ware), articles, works of non-fiction, fiction, poems, musical works, dramatic works including any accompanying music, pantomimes and choreographic works, pictorial, graphic and sculptural works, or other works of artistic imagination regardless of the physical medium in which these "traditional academic works" appear; whether on paper or in audiovisual or electronic form and that are not created as an institutional initiative.

2.10. Student Theses and Dissertations: Unless agreed otherwise in writing, a student, as an individual Creator of a work, owns personal copyright in the student's thesis or dissertation. Students are responsible for securing written permission from copyright holders to include copyrighted materials in their work. The University shall have, as a condition of awarding the student a degree, the royalty-free right to retain, use and distribute a limited number of copies of the thesis, together with the right to require its publication for archival use.

2.11. Student Entrepreneurship Activities: A variety of campus initiatives support student created start-up activities by providing limited amounts of funding, space, and other resources. For these student initiated and directed start-ups, students will retain ownership of their respective intellectual property resulting from these efforts, even though they utilize limited University resources.

2.12. Student Class Projects: For academic courses (such as industrial or manufacturing design) where students create a copyrightable or patentable subject matter, the University does not claim any ownership rights in creations made as part of the course, provided that the only University resources used were those routinely made available by the College or Department to all students enrolled in the course. EXCEPTION: Where student class projects are created in a course in which an external sponsor provided funding or other support, the sponsor may require intellectual property protections of the resulting works. Under these circumstances, a written agreement regarding ownership rights must be executed before such collaborations proceed. If the course is a degree requirement, instructors must present participating students with a choice of projects, some of which must allow students to retain rights to their inventions.

2.13. Employee Consulting Agreements:

2.13.1. Business relationships that University employees may enter into with external entities are managed in accordance with University policy 3.3.7, the State Officials and Employee Ethics Act, the University Board of Trustees Governing Statutes, Bylaws and Policies (link to policy), and other applicable laws and University policy concerning conflict of commitment and/or conflict of interest. It is the responsibility of all University Employees to seek approval for any contract or agreement that may conflict or create the appearance of a conflict of interest or commitment with this policy or the University's intellectual property rights. Examples of non-university activities that may create a potential conflict include but are not limited to relationships with research sponsors and significant ownership interest or service in an executive or managerial capacity in a company doing business with the University, which includes companies that licensed University Intellectual Property.

2.13.2. Faculty members must identify and manage any conflict of commitment in accordance with University Policy 3.3.7.

2.13.3. All University Employees who seek to enter into an arrangement that presents a conflict of interest or commitment (if non-faculty), must consult with the office of Research and Sponsored Programs, disclose the activity and obtain approval from the University before proceeding.

2.14 Tangible Research Property: ("TRP") means those tangible (corporeal) items, as distinguished from intangible (intellectual) property, produced in performance of research. For purposes of illustration, TRP may include items related to an invention such as: biological materials, technical drawings and schematic diagrams, integrated circuit chips, prototype devices, and equipment. TRP excludes items covered by traditional academic copyrightable work.

3. Ownership

3.1. Patentable Research: The University will normally own all inventions created by University Employees within the scope of their employment. The University also claims any patentable subject matter created by any persons, whether or not University employees, making substantial use of University resources as defined in section 2.7 of this policy.

3.2. Copyrightable Works:

3.2.1. Subject to the exceptions outlined in this Policy, the University does not claim ownership of copyrightable works such as those defined as traditional academic copyrightable works in section 2.8 or student theses and dissertations in section 2.9. If there are no specific written agreements or policies to the contrary (e.g. Works for Hire covered under Section 3.2.2), a Creator is free to dispose of the rights to these works, in the manner of the Creator's choosing.

3.2.2. University Copyright Rights: Pursuant to this Policy, all rights in copyright will remain with the Creator pursuant to Section 3.2.1 unless the work is:

- A work for hire (and copyright vests in the University for a work for hire under copyright law); or
- Supported by a direct allocation of funds through the University for the purpose of creating a specified work for the University's benefit, unless otherwise agreed;
- Created pursuant to an external University grant, contract or other agreement with a third party; or
- Commissioned by the University; or
- Assigned to the University for use pursuant to a written agreement; or
- Any work created by a team of faculty, staff, or students of such size or over an extended period of time that determination of a discrete number of creators would be impossible, impracticable, or potentially unfair; or
- Otherwise subject to University and/or third party contractual obligations specifically related to the work.

University employees can ascertain if the employee has been specifically hired or required to create a work as evidenced by:

- The employee's job description. (For example, faculty members are required by their institutions to create certain materials for use by their departments. In other cases a faculty member may be hired to create specific materials, such as online course materials for a specific class or department. In such a case, the University will own the copyright in the materials and any other resulting intellectual property.)
- Professionals, faculty members, researchers or students employed to create specific intellectual property, or hired to create intellectual property generally, should review and sign a single-page acknowledgment to clarify ownership of the works they create.

3.3. Tangible Research Property: The University claims ownership to all tangible research property created through the use of Illinois State University or external sponsorship materials, funds, or equipment. Unless otherwise provided in a written agreement, the University shall hold all applicable ownership rights to all TRP produced with University resources.

3.4. Joint Ownership: In the case of joint ownership between the University, a student and/or a University Employee, the rights shall be allocated in accordance with a specific written agreement at the time that joint ownership is determined in accordance with law.

3.5. IP Clarification: If a University Employee does not know whether a particular Intellectual Property is University intellectual property, the University Employee may consult the University Intellectual Property Officer for assistance. Creators, including students, will own intellectual property when none of the situations defined in this Policy for University ownership applies.

4. Administration

4.1. Intellectual Property ("IP") Committee:

- **4.1.1.** The committee established by this Policy ("IP Committee") shall act as an advisory body for the Associate Vice President for Research and Graduate Studies.

- **4.1.2.** The IP Committee membership shall be comprised of representatives of each College appointed by the Dean of the individual College, a representative appointed by the President, a representative of the Faculty Caucus of the Academic Senate, the Associate Vice President for Research and Graduate Studies, a student representative appointed by the Student Body Vice President, and additional ex-officio (non-voting) members designated by the Associate Vice President for Research and Graduate Studies. The student member will be appointed for a term of one academic year. The other members of the committee will be appointed for terms of three years each. The terms of the IP Committee members will be staggered to provide that a minimum of one new member per year be added to the IP Committee.
- **4.1.3.** All disclosures shall be reviewed by the IP Committee and be assessed for potential before decisions regarding disposition of the University owned intellectual property will be made. The IP Committee shall make recommendations regarding the management of intellectual property assets of the University in accordance with Section 4.1.4 and Section 5.
- **4.1.4.** Management of Intellectual Property Assets of the University: Management of University intellectual property shall be informed by the recommendations of the IP Committee, provided that final decisions regarding the University's ownership of intellectual property are reserved to the Associate Vice President for Research and Graduate Studies. Regarding the University's involvement in the protection of intellectual property for which the University has an ownership claim, the University may elect to:
 - **4.1.4.1.** Retain ownership and, at the University's discretion, incur the cost of suitable protection for the intellectual property;
 - **4.1.4.2.** Relinquish rights in favor of another party, including the Creator(s); or
 - **4.1.4.3.** Any other action authorized by law.

5. Commercialization

5.1. Disclosure Process: Any creation of intellectual property by University Employees or others subject to this policy in which the University may have an ownership interest, shall be promptly reported in writing through the completion of the Disclosure Form (a "Disclosure") and returned to the Intellectual Property Officer. The Creator(s) will be responsible for furnishing additional information or executing such documents as may be reasonably required to protect, market, or license the invention. Disclosure is not required for any work that meets the definition of traditional academic copyrightable work.

5.2. Assessment: Disclosures will first be assessed by the Intellectual Property Officer and then the IP Committee before a final disposition is made by the Associate Vice President for Research and Graduate Studies regarding the commercial potential of any such invention. If an Inventor disagrees with a decision whether to pursue patent protection for an invention, the Associate Vice President for Research and Graduate Studies shall appoint an ad hoc review committee consisting of four members of the Academic Senate. This committee shall review materials and issue a recommendation regarding patentability which shall take effect unless a further appeal is made by the individual or individuals involved, or by the Associate Vice President for Research and Graduate Studies. If there is an appeal to the Senate review committee decision, that committee will present the issue and accompanying documentation and recommendations to the Provost, whose decision regarding patentability shall be final and binding upon all parties.

5.3. Protection: Should the University decide to retain ownership of an invention; the Inventors or Creator(s) will work with the Intellectual Property Officer, the Office of General Counsel, and other external parties as may be necessary to seek appropriate protection for the invention. A Creator may request that the intellectual property he or she developed be published or otherwise made available to the public without restriction on use. The Intellectual Property Officer will investigate whether such a request may be fulfilled or whether the intellectual property should be protected in some form. A Creator's or Inventor's request will be considered by the Intellectual Property Committee in its broad discretion, and accorded due weight and deference, consistent with the overall objectives of the Intellectual Property Policy, requirements imposed by law, agreements with research sponsors, and the rights and interests of co-creators co-Creators or co-inventors co-Inventors.

5.4. Licensing:

- **5.4.1.** A licensing agreement may be sought for any invention for which the University decides to pursue protection. The Creator(s) or Inventor(s) will work with the Intellectual Property Officer to determine market potential, fields of use, and potential licensees. The Intellectual Property Officer will be responsible for leading all licensing negotiations regarding University owned creations that have been disclosed to the University by the Inventor
- **5.4.2.** In contemplating potential University licensing arrangements, the Intellectual Property Officer will consider the following goals:
 - **5.4.2.1.** Work cooperatively with inventors Inventors to identify effective licensing or distribution models for each invention with the goal of enhancing public availability and use.
 - **5.4.2.2.** Make good faith efforts to inform potentially affected faculty researchers and to involve them meaningfully in early-stage negotiations concerning invention management and intellectual property.
 - **5.4.2.3.** Make best efforts to include an irrevocable, non-exclusive license for research and education purposes that includes the right to grant sublicenses to non-profit entities for collaborative research purposes.
 - **5.4.2.4.** Consider the impact of any licensing arrangements on other University research.

5.5. Revenue Distribution: Unless otherwise negotiated between the Creator and the University as confirmed in a signed written agreement, all proceeds will be allocated as indicated below after any expenses incurred in the pursuit, protection or licensing of the technology by the University is recovered. In such cases where there are multiple Creators creators, the Creator's portion will be split equally between all Creators except for instances in which the Creators have a signed agreement indicating a different percentage revenue split of the Creator's share.

- **5.5.1.** 40% to Creator(s)
- **5.5.2.** 60% to be managed by the Provost or designee to support research, scholarship and the academic enterprise at the University.

Initiating body: Office of the Provost

Contact: Assoc. Vice President for Research (309-438-3006)

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