

**OFFICE OF THE PRESIDENT**  
**University of New Orleans**

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Administrative Policy & Procedure (AP) 20.05  
Effective Date: June 11, 2012

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**SUBJECT:** Intellectual Property Policy

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**AUTHORITY:** *University of Louisiana System Bylaws and Rules, Part Two, Chapter III, Section VI; University of Louisiana System Policy and Procedure Memorandum FS-III.VI.-1a*

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**PURPOSE**

The University of New Orleans ("UNO") is committed to its mission of teaching, research and dissemination of knowledge for public benefit. UNO's faculty, staff and students are involved in a variety of scholarship and research endeavors which may lead to valuable inventions, computer software, educational materials, publications and other forms of Intellectual Property. UNO recognizes the need for, and is committed to, the broad utilization of the knowledge generated by UNO's faculty, staff and students.

The primary purpose of this Intellectual Property Policy ("Policy") is to provide the necessary procedures, protections and incentives to encourage both the discovery and development of new knowledge and the transfer of associated Intellectual Property for public benefit.

This Policy provides guidance to assist and support faculty, staff and students in identifying, reporting, protecting, and commercializing Intellectual Property. It also defines the rights and responsibilities of all involved, provides procedures for administering UNO's Intellectual Property, and stipulates how any revenue generated from commercialized Intellectual Property will be disbursed to the Creators and to UNO.

UNO recognizes that research and scholarship should be encouraged without regard to potential gain from licensing fees, royalties, or other income; however, UNO also recognizes that Intellectual Property may arise from the activities of faculty, staff, and students in the course of the duties or through the use, by any person, of institutional resources such as facilities, equipment, or funds. UNO is committed to assisting its faculty, staff and students in properly disclosing and protecting Intellectual Property from their scholarly work; complying with applicable laws and formal UNO agreements with sponsors; and commercializing valuable Intellectual Property as appropriate.

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**OBJECTIVES**

The UNO Intellectual Property Policy has the following objectives:

- A. To encourage research and scholarship as creative academic endeavors while recognizing that commercially valuable Intellectual Properties may result from such endeavors;

- B. To provide procedures to encourage Creators to report discoveries with broad commercial potential and public benefit and to assist them, while at the same time safeguarding the interests of all concerned parties;
  - C. To make Intellectual Property developed at UNO available to the public under conditions that will promote its effective and timely use;
  - D. To optimize the environment and incentives for research and scholarly activities for the creation of Intellectual Property at UNO;
  - E. To provide guidance for faculty, staff and students through each phase of the Technology Transfer process;
  - F. To provide adequate recognition and incentives to Creators through sharing in any revenue from their commercialized Intellectual Property;
  - G. To specify that income accruing to UNO from commercialized Intellectual Property will be used to advance and encourage research and other academic activities;
  - H. To recognize the investment of any outside sponsor in research projects by allowing reasonable and equitable provisions for the granting of Intellectual Property rights to the sponsor, consistent with the UNO's basic objectives outlined above and subject to the UNO's need to maintain the tax exempt status of financing used for certain UNO facilities;
  - I. To clearly state UNO's ownership rights in Intellectual Property developed by UNO's faculty, staff and students.
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## **DEFINITIONS**

The following definitions shall govern throughout the Policy:

1. **“Creator”** is defined as an individual or group of individuals who make, conceive and reduce to practice, author, or otherwise make a substantive intellectual contribution to the creation of Intellectual Property. "Creator" shall include, but not be limited to, faculty, professional staff, administrative and support staff, and students. "Creator" shall also include the definition of "inventor" as used in U.S. patent law and the definition of "author" as used in the U.S. Copyright Act.
2. **“Intellectual Property”** or **“IP”** shall be defined as inventions, discoveries, know-how, show-how, processes, unique materials, copyrightable works, original data, and other creative or artistic works which have value. Intellectual Property includes that which is protectable by statute or legislation, such as patents, copyrights, Trademarks, Trade Secrets, Mask Works, and plant variety protection certificates. It also includes the physical embodiments of intellectual effort, for example, models, machines, devices, designs, apparatus, instrumentation, circuits, Software programs and visualizations, biological materials, chemicals, other compositions of matter, plants, and records of research.

3. **“Mask Works”** means a series of related images, however fixed or encoded: (i) having or representing the predetermined, three-dimensional pattern of metallic, insulating, or semiconductor material present or removed from the layers of a semiconductor chip product; and (ii) in which series the relation of the images to one another is that each image has the pattern of the surface of one form of the semiconductor chip product.
4. **“Net Royalty Income”** is defined as Royalty Income received by UNO **less** any royalty or payment shared with another entity or entities (e.g., as required by an agreement with a funding source or as the result of an inter-institutional agreement with a co-owner of the Intellectual Property), and any fees or costs directly attributable to the Intellectual Property being licensed. Examples of such direct fees are patent filing fees, fees for patent searches and/or legal advice, evaluation fees by third parties, fees arising out of litigation, or marketing costs.
5. **“Royalty Income”** is defined to include income paid to UNO and associated with licensing and commercialization of any Intellectual Property owned by the UNO, and includes such monies received as royalties, option fees, milestone payments, license maintenance fees, court-awarded infringement damages, payments received in settlement of infringement disputes, and the like. Royalty Income does not include any follow-up research or development funding from a sponsor associated with the IP.
6. **“Royalty Payment(s)”** is defined as the Net Royalty Income received by UNO from licensing IP to third parties that will be distributed within UNO according to this IP Policy.
7. **“Scholarly Works”** shall include all Intellectual Properties not covered in Technical Works that are of an artistic, scholarly, instructional, or entertainment nature.
8. **“Software”** shall include one or more computer programs existing in any form, or any associated operational procedures, manuals, or other documentation, whether protectable or protected by patent or copyright. The term “computer program” shall mean a set of instructions or statements of related data that, in actual or modified form, is capable of causing a computer or computer system to perform specified functions.
9. **“Technical Works”** shall include Intellectual Properties that are of a scientific, engineering, or technical nature such as inventions (including biological materials) and computer software.
10. **“Technology Transfer”** is defined as the process and the activities by UNO through the Office of Technology Management and Commercialization that are aimed at transferring UNO IP to other organizations for the purpose of development and commercialization. Such activities include supporting UNO faculty, staff and students in identifying potentially valuable IP; protecting IP through patents and copyrights; and generating revenues for the Creators and UNO, through marketing and licensing such IP to other organizations (generally private sector companies) or to start-ups based on it.
11. **“Trademarks”** shall include all trademarks, service marks, trade names, seals, symbols, designs slogans, or logotypes developed by or associated with UNO and associated with other IP.

12. **“Trade Secrets”** means information including, but not limited to, technical or nontechnical data, a formula, a pattern, a compilation, a program, a device, a method, 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 means by other persons, who can obtain economic value from its disclosure or use; and (ii) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.

13. **“Traditional Academic Copyrightable Works”** shall be defined as a subset of copyrightable works created independently and at the Creator’s initiative for traditional academic purposes. Examples include journal publications/articles, class notes, books, theses and dissertations; educational software (also known as courseware or lesson ware); non-fiction, fiction, and poems; musical works, dramatic works including any accompanying music; pantomimes and choreographic works; pictorial, graphic, and sculptural works; or other works of artistic imagination that are not created as an institutional initiative.

14. **“UNO Personnel”** is defined as all faculty, staff, and students (graduates and undergraduates) who are subject to this Policy.

15. **“UNO Resources Usually and Customarily Provided”** shall include such support as office space, library facilities, ordinary access to computers and networks, or salary, and is described in this Policy as either "incidental" or "significant." The phrase does not include use of students or employees as support staff to develop the work, or substantial use of specialized or unique facilities and equipment, or other special subventions provided by the institution unless approved as an exception.

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## **POLICY**

### **I. INTELLECTUAL PROPERTY AND TECHNOLOGY TRANSFER**

Intellectual Property at UNO is generated through research and scholarship. UNO is committed to give the results of research and scholarship the widest possible dissemination and the broadest feasible utilization by the public. UNO is also committed, and in some cases required, to protect its ownership rights of its Intellectual Property generated by UNO Personnel, to commercialize it if appropriate, and share any commercialization revenues with the UNO Creator. The process of accomplishing this is referred to as Technology Transfer.

### **II. RIGHTS TO OWNERSHIP OF INTELLECTUAL PROPERTY**

#### **A. Overview**

UNO has ownership of Intellectual Property created:

1. by UNO Personnel within the scope of his or her employment;
2. by UNO Personnel hired or commissioned to create a specific work;
3. when more than incidental use of UNO Resources Usually and Customarily Provided occurs; or

4. when the Intellectual Property results from research supported by federal funds or other third-party sponsorship, subject to the terms and conditions of the grant or contract.

UNO shall not assert ownership of Intellectual Property unrelated to job responsibilities and where only incidental use of UNO Resources Usually and Customarily Provided has occurred, nor does UNO have ownership of traditional academic copyrightable works (see principles below; UNO does have the right to recover its costs and/or the right to use the work.) Joint ownership may occur under certain circumstances such as when Scholarly Works involve the services of other UNO Personnel (e.g., development of multi-media courseware).

## **B. Principles**

1. This policy shall apply to all UNO Personnel and to anyone using UNO facilities under the supervision of UNO Personnel.
2. UNO may assert ownership in Intellectual Property of all types regardless of whether the property is subject to protection under patent, trademark, copyright, or other laws, except as stipulated in Sections 3, 4, 5, and 6 which follow.
3. UNO may assert ownership in IP related to the Creator's academic or professional field, regardless of the medium of expression. UNO **shall have ownership** of all IP created by UNO Personnel under the conditions stated below if the IP:
  - (a) is created within the specific scope of his or her employment; or
  - (b) is created with the non incidental use of UNO Resources Usually and Customarily Provided; or
  - (c) is commissioned by UNO pursuant to a signed contract; or
  - (d) is created by UNO Personnel hired specifically by UNO, or is required as part of his or her job responsibilities, to produce it; or
  - (e) fits within one of the nine categories of works considered "works for hire" under US Copyright Law, Section 101; or
  - (f) results from research supported by federal funds or other third-party sponsorship, subject to the terms and conditions of the grant or contract.

NOTE: Copyright works related to an employee's job responsibilities, even if he or she is not specifically requested to create them, will belong to UNO as works-for-hire. A copyright work is related to an employee's job responsibilities, if it is the kind of work a UNO employee is employed to do and if the work is done, at least in part, for use at work or for use by fellow UNO employees, UNO, or UNO clients. Use of personal time or other facilities to create the work will not change its basic nature if the work is related to the Creator's job as described above. Works that have nothing to do with job duties will remain the property of the Creator, so long as he or she makes no more than the incidental use of UNO Resources Usually and Customarily Provided.

4. UNO shall not have ownership when the Creator is a student, professional, faculty, or non-faculty researcher and the IP is a Traditional Academic Copyrightable Work in the

Creator's field of experience. Even though such a work may be within the scope of employment, it is the property of the Creator **unless** it was (a) created by someone who was specifically hired or required to create it or (b) commissioned by UNO. In either of these cases, UNO, not the Creator, will own the IP.

5. In the case of Traditional Academic Copyrightable Works that involve significant UNO resource contributions, UNO shall reserve the right to secure rights (including but not limited to joint ownership), for example, to use the work and to recover its investment, in a contract with the Creator. If a project involves the use of significant UNO resources, the Creator and UNO shall agree before the project begins on the use of facilities, allocation of rights to use the work, and recovery of expenses and/or sharing of benefits from commercialization of the work.

NOTE: UNO's main concerns with Traditional Academic Copyrightable Works owned by UNO Personnel are to allocate and recover resources that may be contributed to the creation of such works by UNO.

6. In addition to Traditional Academic Copyrightable Works created by UNO Personnel in their field of expertise, a Creator shall own IP under the following conditions:
  - (a) if it is unrelated to the Creator's job responsibilities and the Creator made no more than incidental use of UNO Resources Usually and Customarily Provided; or
  - (b) if it is Intellectual Property that has been released to the creator in accordance with UNO policy.
7. UNO facilities or resources shall NOT be used (a) to create, develop, or commercialize IP unrelated to an individual's employment responsibilities or (b) to develop or commercialize such IP further that have been released to a Creator except when approved in writing by UNO and when UNO retains an interest under the terms of the release.
8. Special cases, not covered by the paragraphs 1-7, or which might involve a conflict of interest, shall be discussed by OTMC and UNO Personnel involved to come to agreement on the ownership rights of the IP involved. If agreement cannot be reached, UNO's President will make the final decision on the ownership rights.

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## **PROCEDURES**

### **I. RESPONSIBILITIES OF FACULTY, STAFF AND STUDENTS**

UNO Personnel involved in research and scholarship should:

- consider the IP developed in their work and the commercial potential for that IP;
- document research findings in laboratory notebooks;
- disclose to the OTMC new IP which may be patentable, copyrighted or otherwise protected and may have commercial potential;
- assist OTMC in the evaluation and commercialization of the IP;
- be aware that public disclosure of unprotected IP outside of UNO can hurt protection (e.g., patent applications) and commercialization potential, so accordingly:

- Consult with OTMC to discuss possible IP protection strategies before a public disclosure of commercially valuable IP;
- Non-disclosure agreement (“NDA”) should be considered before sharing possible valuable IP with third parties;
- work with UNO attorneys and potential licensees as needed;
- for those UNO Personnel interested in entrepreneurship, consider a start-up company as a way of commercialising inventions and other IP; and
- be aware that for most grants and contracts UNO has the obligation to report inventions and other IP to the funding entity.

## **II. ORGANIZATION/MANAGEMENT/ADMINISTRATION**

### **A. Acknowledgement of UNO Authority**

The President of UNO has ultimate authority for the stewardship of Intellectual Property developed at UNO. The administrative and business aspects of managing and commercializing UNO Intellectual Property are the responsibility of OTMC, under the Office of Research, and with the approval of the UNO President.

It is the responsibility of deans and unit heads, in harmony with the guidelines that follow, to act so that UNO resources including UNO Personnel time are used appropriately, and to work with UNO Personnel to promote proper fulfilment of the objectives of this Policy.

### **B. Office of Technology Management and Commercialization**

OTMC, reporting to the Vice President for Research and Economic Development, is responsible for the Technology Transfer of UNO’s IP and serves as UNO’s IP advocate. It advises the President and his senior staff on UNO’s Intellectual Property Policy matters and the status and conduct of UNO’s Technology Transfer efforts and results.

OTMC also provides advice and assistance to UNO Personnel on all matters involving IP and Technology Transfer.

In addition, OTMC

- encourages research and scholarly activities;
- reviews and evaluates all Intellectual Property Disclosures Forms submitted by UNO Personnel;
- determines how IP shall be assigned (within the limits specified in this IP Policy and any contractual obligations);
- recommends whether the University should pursue protection and commercialization of Intellectual Property
  - considers the market potential and size, the competitive landscape and other technologies in the marketplace
  - engages external specialists for assistance with knowledge of the particular area of research and/or market (when appropriate)

- works with outside patent attorneys on patentability assessments;
- engages external attorneys, as required, to protect IP (e.g. patent filings) and to assist with agreements (e.g., license agreements);
- determines best approach for commercializing IP (e.g. license to existing company or to a start-up);
- markets technology and IP to potential licensees;
- negotiates, administers and oversees IP agreements (e.g. license agreements, inter-institutional agreements), as well as some other associated agreements (e.g., non disclosure agreements, material transfer agreements, teaming agreements);
- assists in start-up company formation involving UNO IP;
- monitors agreements for compliance, including payments due to UNO;
- distributes Royalty Payments (working with UNO Financial Services) according to this Policy;
- takes any other action as deemed necessary to support UNO Technology Transfer efforts.

### **C. Intellectual Property Disclosures**

All IP, in which the UNO has an ownership interest under the provisions of this Policy and that has the potential to be brought into practical use for public benefit or for which disclosure is required by law or a contract/grant (e.g. Federal contract/grant; industry research contract; a foundation grant), shall be reported promptly in writing by the Creator(s) to OTMC using the current UNO's Intellectual Property Disclosure Form:

(<http://www.uno.edu/otmc/FormsAgreements>). The disclosure shall constitute a full and complete disclosure of the subject matter of the discovery or development and identify all persons participating therein. The Creator(s) shall furnish such additional information and execute such documents from time to time as may be reasonably requested.

### **D. Evaluation and Exploitation Decision**

After an Intellectual Property Disclosure Form is received and approved by OTMC, it is given a tracking number for reference and information is entered into the OTMC IP database. OTMC, based on discussions with the Creator(s) and an evaluation of the IP for protection and commercialization potential, shall proceed with one of five actions:

- (1) pursue protection and commercialization by UNO;
- (2) return to the Creator(s) for further research and development before further action;
- (3) release to the Creator(s) for his/her/their own IP pursuits by license or assignment, as appropriate, relinquishing UNO responsibilities for any costs but retaining, in some cases, some financial interest (see also Section 6 F below).
- (4) release to the sponsor of the project under which it was made (if contractually obligated to do so)
- (5) take any such other actions determined to be in UNO's and the public interest.



Exploitation by UNO may or may not involve statutory protection of IP rights, such as filing for patent protection, registering a copyright, or securing a Trademark. Creators of IP shall have the right to appeal decisions regarding OTMC decisions on obtaining protection (e.g., filing of patent). For any such appeal, an ad hoc committee will be formed, made up of appropriate people with relevant expertise, to review the decision and make recommendations for OMTC and the UNO President to consider. (*See also Appeals and Disputes*).

#### **E. Licensing Restriction**

No assignment of or license for (or option to assign or license) any Intellectual Property developed in the course of work supported by funds or utilizing facilities administered by UNO may be entered into by any UNO Personnel without the written consent of UNO's President. UNO has the ultimate right to resolve any conflict of interest arising in this connection with third parties or organizations. The basic objectives stated above shall serve as the criteria for approval of assignments, licenses, and agreements to assign or license.

#### **F. Abandonment of Intellectual Property**

Should the institution decide to abandon development or protection of institution-owned intellectual property, ownership may be assigned to the Creator as allowed by law subject to the rights of sponsors and to the retention of a license to practice for UNO purposes. The minimum terms of such a license shall grant UNO the right to use the intellectual property in its internally administered programs of teaching, research, and public service on a perpetual, royalty-free, non-exclusive basis. UNO may retain more than the minimum license rights, and the assignment or license may be subject to additional terms and conditions, such as revenue sharing with the UNO or reimbursement of the costs of statutory protection, when justified by the circumstances of the development.

#### **G. Questions Related to Institution Ownership**

In the event there is a question as to whether UNO has a valid ownership claim in any IP, such IP should be disclosed in writing to the OTMC by the Creator(s). Such disclosure is without prejudice to the Creator's ownership claim. OTMC will provide the Creator(s) with a written statement as to UNO's ownership interest (see also Section 6 M. – Disagreements and Appeals).

#### **H. Foreign Patent Applications**

Foreign patent applications can be very expensive, especially if filed in multiple countries, so will not be filed by OTMC unless

- a) substantial justification exists relative to the commercial potential of the invention; or
- b) one or more firms have expressed a serious intent to license the technology; or
- c) the Creator's college/department/unit assumes all filing and prosecution costs of such foreign applications.

**I. Maintenance Fees**

When UNO patents or other IP are subject to the payment of maintenance fees in order to keep such IP rights in force, OTMC may elect to abandon some non-producing IP protection. Before doing so, OMTC will endeavour to consult with the Creator(s) regarding abandoning such IP protection.

**J. Infringements**

No UNO Personnel shall accuse any third party of infringing any IP rights owned by UNO unless express written permission has previously been obtained from the President of UNO to make such allegation or accusation of infringement. Prior to granting such permission and prior to initiating litigation to resolve infringement of any UNO IP, the President shall consult with legal counsel and other counsel, as the President deems appropriate.

**K. Commercialization by Creator(s)**

UNO may, at its discretion and consistent with the public interest, license Intellectual Property to the Creator on an exclusive or nonexclusive basis. The Creator must demonstrate technical and business capabilities to commercialize the Intellectual Property. Agreements with Creator will be subject to review and approval of conflict-of-interest issues in accordance with applicable UNO policies.

**L. Decision Making Time for Disclosures**

Within a reasonable time after the receipt of a completed Intellectual Property Disclosure Form, OMTC will inform the principal Creator of its substantive decisions regarding protection, commercialization, and/or disposition of the IP that he or she disclosed. UNO shall be bound by contract or non disclosure agreement made with any external parties regarding the IP.

**M. Disagreements and Appeals**

University Personnel shall have the right to appeal decisions of OTMC. Appeals shall be made to the President of the University. UNO Personnel may, in accordance with by-laws of the University of Louisiana System Board of Supervisors, apply to the Board of Supervisors for a review of the decision of the President.

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**DISTRIBUTION OF INCOME**

In the event that Net Royalty Income is generated by IP rights assigned or licensed to UNO, an appropriate share of such Net Royalty Income shall be paid to the Creator. The Creator's share shall be determined by the following considerations:

- A. In cases where UNO or Creator, as the case may be, assign such Intellectual Property rights to a research corporation or foundation under contract with UNO or to the University of Louisiana System, the share of Net Royalty Income to be

paid to the Creator shall be governed by the terms of the contract between UNO and any such entity.

- B. In cases where the IP is covered by a contractual agreement with a sponsoring agency, the financial arrangements shall be in accordance with that contractual agreement as negotiated between the UNO and the sponsoring agency.
- C. In cases of sponsorship by federal agencies, compliance with the appropriate federal regulations shall be as specified in the funding agreement.
- D. Unless otherwise agreed to in writing before commercialization or required by contractual obligations, **forty (40) percent of UNO's Net Royalty Income ("Creator's Share") will be paid to the Creator, and sixty (60) percent will be retained by UNO.**
- E. Regarding the Creator's Share, it
  - will be shared equally among all Creators, unless they agree otherwise in writing (OTMC can provide an agreement form to accomplish this).
  - will continue to be paid even though the Creator may have left UNO.
  - will pass to the Creator's legal heirs and assigns in the event of a Creator's death.
- F. Net Royalty Income retained by UNO shall be used for research, development, and other scholarly activities.
- G. The System Board may approve exceptions to the established Net Royalty Income distribution in extraordinary circumstances.

## **USE OF UNO NAME OR LOGO**

In instances where UNO chooses not to retain ownership of any IP or licenses it to the Creator, the Creator shall obtain permission from the UNO's President, or his or her designee, in writing before associating the UNO's name or logo with the IP.

## **COMPUTER SOFTWARE**

- A. Computer Software, developed by UNO Personnel resulting from non-UNO or sponsor support (i.e., without use of UNO facilities, computers, personnel, or materials) or not required as part of a UNO job assignment, will be solely owned by the Creator of the copyrighted material, who may choose to market and receive any income as he/she/they solely desire.
- B. Computer Software, developed by UNO Personnel during and within the scope of their employment, including all works initiated at UNOs request, will be solely owned by UNO. Net Royalty Income from any commercialization of such Software will be distributed according to one of the following plans:

**Plan 1:** UNO copyrights and markets the Computer Software on its own. All costs, including copyright and marketing costs, are paid by UNO. The distribution of any Net Royalty Income will be as follows:

UNO will retain up to sixty (60) percent of any Net Royalty Income and will pay the balance to the Creator. The President will determine the split of Net Royalty Income based on a recommendation from OMTC with input from the Creator.

**Plan 2:** With UNO's approval in writing, Creator copyright's the Computer Software naming UNO as owner and author and market the computer software on their own. All costs, including copyright and marketing costs, are paid by Creator. The breakdown of any income (or any other type of income resulting from the marketing of the Computer Software) will be as follows:

The Creator will receive up to 60% of any Net Royalty Income, and the balance will be paid to UNO. The President will determine the income division based on a recommendation from OMTC with input from the Creator and will become a part of an agreement between UNO and the Creator to allow the Creator to commercialize the Computer Software.

Creator who develops Computer Software which they desire to have copyrighted and marketed should disclose the software development on a UNO Intellectual Property Form to OTMC. The Creator should forward a proposal to commercialize the Computer Software (Plan 1 or 2) through the appropriate dean and/or department head for review and approval. The dean/department head should route the proposal to OTMC with his or her recommendation. Upon review and consultation with interested parties, OTMC will make a recommendation to the President. OTMC will consider, but shall not be bound by, the proposal or other input from the Creator. The President will make the final determination as to whether to proceed under Plan 1 or Plan 2.