

UNIVERSITY OF NORTH DAKOTA INTELLECTUAL PROPERTY POLICY

I. *General Principles.*

- a. The Institution encourages and promotes research and scholarship based on the traditional principles of the academic profession. These products may constitute Intellectual Property that could be of financial benefit to the individuals involved and the Institution. The primary purposes of this policy are to establish guidelines to support faculty, staff, and students, in identifying, protecting and administering Intellectual Property and defining the rights and responsibilities of all involved. This policy governs unless a specific policy provides otherwise.
- b. Any person who is uncertain as to how to identify a potential Copyrightable Work, Invention, Trade Secret or Tangible Research Property, or how the Institution implements any of these policies should contact the Vice President for Research and request guidance.

II. *Definitions.*

- a. "Author": A person who creates a Copyrightable Work.
- b. "Copyright Agreement": A written and signed agreement between the Author(s) and the Institution that explicitly defines the ownership of the Copyrightable Work, any control rights in cases of Mediated Courseware, any reimbursement for Significant Use of Institutional Resources, and the sharing of royalties.
- c. "Copyrightable Work or Work": An original Work by an Author which has been fixed in a tangible medium of expression from which it can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device, such as books, journals, software, computer programs (including source code), musical Work, dramatic Work, videos, multimedia products, sound recordings, pictorial and graphical Work, etc. Any Copyrightable Work that is also an Invention shall be governed by the General Patent and Trade Secret Policy and not the General Copyright Policy. A Work may be the product of a single Author or a group of Authors who have collaborated on a project.
- d. "Costs of Invention Protection": The expenses incurred by the Institution in conducting the research and in procuring, protecting, preserving, maintaining, and licensing the Invention and related property rights. This includes the costs in securing patent protection in the United States and any foreign jurisdiction.
- e. "Cumulative Net Royalties": The cumulative lifetime gross royalties and licensing or assignment fees less the expenses incurred by the Institution in procuring, protecting, preserving, maintaining, marketing and licensing the patent and related property rights including legal fees associated with the Invention, fees for patentability and marketability searches, fees arising out of litigations, fees for legal advice or any fees or costs directly attributable to the invention being licensed. Indirect costs, overhead or other Institution costs usually associated with operation of the Institution

1 and not directly attributable to the Invention will not be deducted from
2 gross revenues.

- 3 f. "Institution": The University of North Dakota.
- 4 g. "Intellectual Property": Collectively, all forms of property created by the
5 mind including, but not limited to, Inventions, Copyrightable Work,
6 Trademarks, and Tangible Research Property.
- 7 h. "Intellectual Property Protection Procedure": The procedure established
8 under VI(n) for review of Inventions by the Institution.
- 9 i. "Invention": A process, method, discovery, device, plant, composition of
10 matter, know-how, or other Invention that reasonably appears to qualify
11 for protection under United States patent law (including, but not limited to,
12 utility patent, plant patent, design patent, certificate of Plant Variety
13 Protection, etc.), whether or not actually patentable. This includes
14 software which may also be a Copyrightable Work. An Invention may be
15 the product of a single Inventor or a group of Inventors who have
16 collaborated on a project.
- 17 j. "Invention Disclosure": A written document which allows one skilled-in-
18 the-art to fully understand and practice an Invention.
- 19 k. "Invention Disclosure Committee". The Invention Disclosure Committee
20 will be composed of one member from the School of Engineering and
21 Mines, School of Medicine & Health Sciences, School of Sciences and
22 Arts, John D. Odegard School of Aerospace Sciences, and *ad hoc*
23 member from any School or Center with an Invention Disclosure
24 advancing to IPSC review. Each school will have one member and one
25 alternate. All members will serve two (2) year terms and will be
26 appointed by the VP for Research.
- 27 l. "Inventor": An individual who contributes to the conception of an
28 Invention under U.S. patent law and who is (are) identified as such on the
29 licensed patent, patent application or unpatented technology. In the case
30 of a patent or patent application, according to U.S. patent law, an
31 Inventor's contribution must be applicable to at least one claim.
- 32 m. "Licensing Revenue". Revenue derived from any agreement licensing or
33 assigning Intellectual Property or Invention rights to a third party in
34 exchange for payment of licensing fees, research fees, milestone fees,
35 sponsored research or development, royalties, equipment, or like in kind
36 payments.
- 37 n. "Mediated Courseware": Teaching aids or instructional assets created
38 and/or deployed electronically. Mediated Courseware may incorporate
39 text, graphics, video, and audio elements. Examples of such materials
40 include, but are not limited to, hypertext modules, simulation software,
41 web sites, and databases containing numbers, images, or text.
- 42 o. "PMO". A PMO or Patent Management Organization is a third party,
43 which is a nonprofit organization described in section 501(c)(3) of the
44 Internal Revenue Code of 1986, that has as one of its primary functions
45 the management of Institution Inventions and receives Licensing

1 Revenue and gifts, or supporting or promoting the Institution or Institution
2 research under U.S. 37 CFR Part 401 and 35 U.S.C. 200-212.

- 3 p. "Public Disclosure": Means describing an Invention in a printed
4 publication, a patent application or at a conference, meeting, or other
5 public gathering, in the United States or any other country, sale or offered
6 for sale of Invention, use of the Invention, other than as part of
7 experimental use, in the United States, or disclosure to any person who
8 is not required to maintain the Invention's confidentiality.
- 9 q. "Significant Use of Institutional Resources": An Author's use of other
10 employees' time or Institutional facilities or equipment that appreciably
11 increases the Institution's costs beyond those normally incurred in
12 support of an employee in the Institution. Significant Use does not include
13 the normal use of Institutional employees' time, facilities, or equipment
14 commonly available to faculty, staff, or the public, such as libraries,
15 internet access, office space, office equipment, computers, and/or office
16 supplies. Unless otherwise agreed, Significant Use also does not include
17 the use of Institution developmental leave time, so long as it does not
18 appreciably increase the Institution's costs beyond those normally
19 incurred in support of an employee of the Institution.
- 20 r. "Tangible Research Property": Tangible items produced in the course of
21 research including, but not limited to, such items as biological materials,
22 engineering drawings, integrated circuit chips, computer databases,
23 prototype devices, circuit diagrams, and equipment. Individual items of
24 Tangible Research Property may be associated with one or more
25 intangible properties, such as Inventions, Copyrightable Work, and
26 Trademarks. An item of Tangible Research Property may be the product
27 of a single Author, Inventor or a group of individuals who have
28 collaborated on the project.
- 29 s. "Technology Transfer and Commercialization Officer": The individual
30 holding responsibility for the office of Technology Transfer and
31 Commercialization at the Institution or, where appropriate, his or her
32 designee.
- 33 t. "Trade Secret": Information, including a formula, pattern, compilation,
34 program, device, method, technique or process, that derives independent
35 economic value, actual or potential, from not being generally known to,
36 and not being readily ascertainable by proper means by, other persons
37 who can obtain economic value from its disclosure or use.
- 38 u. "Trademark" (including Service Mark): A distinctive word, design, or
39 graphic symbol, or combination word and design, that distinguishes and
40 identifies the goods and services of one party from those of another, such
41 as names or symbols used in conjunction with plant varieties or computer
42 programs, or the Institutional names, logos, or derivatives thereof.
- 43 v. "Unit". Administrative, academic or research unit of the Institution that
44 provided the environment in which the research or investigation of the
45 Inventor was conducted.
- 46 w. "University System": The North Dakota University System.

- 1 x. "Vice President for Research": The individual holding the office of Vice-
2 President for Research at the Institution or, where appropriate, his or her
3 designee.
- 4 y. "Work for Hire": Defined pursuant to Federal Copyright Law which
5 includes a Work prepared by employees (staff, faculty, or student) within
6 the scope of their employment, created pursuant to a written agreement
7 identifying the Work as a Work for Hire. Unless a Copyright Agreement
8 provides otherwise, software created by employees within the scope of
9 their employment and not treated as Mediated Courseware under section
10 IV of this policy shall be treated as a Work for Hire.

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12 *III. General Copyright Policy.*

- 13 a. Except as otherwise explicitly provided under this policy or applicable
14 law, an employee who creates a Work retains copyright ownership of the
15 Work.
- 16 b. If there has been Significant Use of Institutional Resources to create a
17 Copyrightable Work, the ownership of which is vested in the individual
18 employee, the Institution shall be reimbursed out of the royalties
19 produced by the Work, in accord with a Copyright Agreement between
20 the employee and the Institution up to the value of the Significant Use of
21 Institutional Resources.
- 22 c. If an employee creates a Work for Hire, the employee must disclose the
23 Work to the Institution pursuant to section III F. In such instances the
24 Institution shall have the first option to secure copyright in the name of
25 the Institution. Should the Institution decide, in writing, it would not be
26 appropriate to secure copyright, the employee then may proceed to
27 personally secure the copyright.
- 28 d. Copyright ownership of Work developed as a result of Work supported
29 partially or fully by an outside agency through a contract or grant shall be
30 determined in accordance with the terms of the contract or grant. In those
31 cases where copyright ownership is shared between the sponsor and the
32 Institution, the employee may share in the royalties produced by the
33 Work in accord with a Copyright Agreement between the employee and
34 the Institution. In those cases where copyright ownership is vested in the
35 Institution, the Institution shall have the first option to secure copyright in
36 the name of the Institution. Should the Institution decide, in writing, it
37 would not be appropriate to secure copyright, the employee then may
38 proceed to personally secure the copyright.
- 39 e. Royalties received as a result of copyright ownership by the Institution
40 will be disbursed at a minimum of 30 percent to the employee(s) and the
41 remainder pursuant to the negotiated Copyright Agreement. No limit shall
42 be set on the absolute amount of royalty income the employee(s) may
43 earn, except that it shall be in keeping with University System policy.
- 44 f. When an Author creates a Copyrightable Work the following steps should
45 be followed to establish a Copyright Agreement between the Author and
46 the Institution:

- 1 1. The Author will initiate the process by delivering a copy of the work
2 and a proposal for the terms of the Copyright Agreement to the
3 Vice President for Research.
- 4 2. After review, the Vice President for Research will forward a
5 proposed Copyright Agreement for review and approval by
6 appropriate department or unit heads, dean or administrative unit
7 heads, and the Vice President for Academic Affairs and Provost
8 for review and comment.
- 9 3. A Copyright Agreement will be entered into between the Author
10 and the Vice President for Research on behalf of the Institution.
 - 11 i. The Institution shall be responsible for copyright registration
12 of Work owned by the Institution, and for administering
13 contracts with its Authors, including the responsibilities
14 associated with maintaining records for copyright
15 registration, royalty collection and distribution, marketing,
16 and such other actions as are appropriate.
 - 17 ii. Authors of Works for which ownership vests in the
18 Institution shall warrant that such Work does not infringe
19 any preexisting copyright and shall cooperate with the
20 Institution in the pursuit of copyright protection.
- 21 4. Disputes and questions arising under the Copyright Agreement
22 shall be submitted to the Vice President for Academic Affairs and
23 Provost for resolution.

24 *IV. Mediated Courseware.*

- 25 a. Self-initiated Mediated Courseware. When an employee develops
26 Mediated Courseware without specific direction by the Institution, unless
27 otherwise agreed, the ownership of the Mediated Courseware shall
28 remain with the employee. Normally, no royalty, rent, or other
29 consideration shall be paid to the employee when that Mediated
30 Courseware is used for instruction at the Institution and such Mediated
31 Courseware shall not be used or modified without the consent of the
32 employee. While the Author is employed by the Institution, the Mediated
33 Courseware shall not be sold, leased, rented or otherwise used in a
34 manner that competes in a substantial way with the for-credit offering of
35 the Institution unless approved by the Vice President for Academic Affairs
36 and Provost of the Institution. The Institution shall have a perpetual, non-
37 exclusive, royalty-free right to use such courseware for archival research
38 purposes. Should approval be granted to use the Mediated Courseware
39 outside of the Institution, the provisions of section III.b of this policy shall
40 apply.
- 41 b. Institution-directed Mediated Courseware. When the Institution directs in
42 an employment contract the creation of a specific Mediated Courseware,
43 the resulting Mediated Courseware belongs to the Institution and the
44 Institution shall have the right to revise it and decide who will utilize the
45 Mediated Courseware in instruction. Development of Institution-directed
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1 Mediated Courseware shall be reported to appropriate administrator(s) at
2 the Institution through a Copyright Agreement. The Institution may
3 specifically agree to share revenues and control rights with the employee
4 pursuant to the Copyright Agreement.
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6 *V. Student Work.*

- 7 a. The Copyright ownership of student Work that is performed in whole or in
8 part by the student with financial support in the form of wages, salaries,
9 stipend, or grants from funds administered by the Institution shall be
10 determined in accordance with the terms governing the financial support
11 or in the absence of such terms, shall become the property of the
12 Institution.
- 13 b. The Copyright ownership of student Work generated by research
14 performed in whole or in part utilizing equipment or facilities provided by
15 the Institution under conditions that impose copyright restrictions shall be
16 determined in accordance with such restrictions.
- 17 c. Students will own the copyrights to their Work produced as students of
18 the Institution, but not within the provisions of V.a and V.b above;
19 however, a student must, as a condition to a degree award, grant royalty-
20 free permission to the Institution to reproduce and publicly distribute,
21 including by electronic means, copies of the student's Work. Where
22 there is Significant Use of Institutional Resources, the copyright
23 ownership shall be determined under section III. Of this policy.
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25 *VI. General Patent and Trade Secret Policy ("Policy").*

- 26 a. The Institution encourages the faculty, staff, and others associated with
27 the Institution to pursue patent and Trade Secret protection for Inventions
28 as a method of bringing recognition and remuneration to Inventors and
29 the Institution.
- 30 b. Section VI(n) outlines the procedure for processing of such Inventions or
31 discoveries. The Inventor(s) shall submit an Invention Disclosure to the
32 Institution at least 60 days prior to Public Disclosure of the Invention. At
33 any time during the processing of such Invention, the rights, title and/or
34 interest of such Inventions may be assigned to a PMO. The Institution
35 President, or designee, shall sign appropriate documentation
36 acknowledging the assignment. The PMO will assume obligations under
37 section VI, as appropriate, and provide timely documentation to the
38 Institution, if requested.
- 39 c. An Invention may arise from the development of a new and useful
40 process, device or apparatus, article of manufacture, composition of
41 matter (including, but not limited to, chemical compounds,
42 microorganisms, nucleotide sequence, amino acid sequence, genetically
43 engineered organisms, and the like), plant, or related improvement, or a
44 new use for a known material or device or related improvement, or a new
45 use for a known material or device. Any individual who is uncertain as to

1 how to identify a potential Invention should contact the TTC Officer and
2 request guidance.

- 3 d. All rights to and interests in Inventions resulting from research or
4 investigation conducted in the course of the Inventor's employment with
5 the Institution (including, but not limited to, the performance of a grant,
6 contract or award made internally, by an extramural agency or by a third
7 party) or with the use of the Institution's resources shall be the sole and
8 exclusive property of the Institution, or no other person or entity shall
9 have rights of ownership or interest in such Inventions. Any and all
10 exceptions to this Policy shall be determined and approved by the VP for
11 Research. In all other cases, the Institution shall have the right of first
12 refusal to the title of all Inventions derived with the use of Institution
13 facilities, gifts, grants, or contract funds through the Institution. The
14 Inventor shall provide all necessary declarations, assignments, or other
15 documents as may be necessary in the course of processing the
16 invention, patent prosecution, or protection of patent rights to assure that
17 title in such Inventions shall be held by the Institution or other parties as
18 may be appropriate under the circumstances.
- 19 e. This Policy applies to all Inventions made by the Institution's faculty, staff,
20 students, trainees, volunteers or others if such Inventions are:
- 21 1) the result of research performed by or under the direction of any
22 faculty member, staff or student, the cost of which was partially or
23 wholly paid for with funds under the control of or administered by
24 the Institution and/or
 - 25 2) the result of an investigation by the faculty, staff, students,
26 trainees, volunteers or others utilizing the Institution's facilities,
27 laboratories or other resources available to such faculty, staff,
28 students, trainees, volunteers or others because of their status
29 within the Institution.
- 30 f. All Inventions conceived or actually or conceptually reduced to practice in
31 the furtherance of research or investigation conducted by the Institution's
32 faculty, staff, students, trainees, volunteers or others in Paragraph VI(e)
33 above, shall be promptly disclosed in writing to the TTC Officer. The
34 Invention Disclosure form provided by the TTC Officer should be used for
35 the reporting process and may be obtained from the TTC Officer or
36 completed in consultation with the TTC Officer.
- 37 g. All rights to and interests in Inventions arising in the course of research or
38 investigation sponsored by the Institution, any government or private
39 agency or other sponsored research are controlled by the terms of the
40 applicable Intellectual Property agreement, which must be reviewed,
41 negotiated and approved by the the TTC Officer. In the absence of
42 provisions to the contrary contained in any such research or investigation
43 agreement or under Federal law or regulations, the following shall apply:
- 44 1) The Inventor has the right to:
 - 45 i. receive notice within six (6) months of the Institution's
46 intention to file a patent application or otherwise to retain

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- title to the Inventions after the Invention Disclosure is made to the Institution of the Invention;
 - ii. receive a share of any licensing fees or royalties received by the Institution from the commercialization of the Invention according to the Distribution Schedule contained in VI(j);
 - iii. receive from the Institution title to any Invention subject to this Policy in the event the Institution elects not to retain title; and
 - iv. timely publication of their research findings provided that a Invention Disclosure has been made.
- 2) The Inventor is obligated to:
- i. promptly file an Invention Disclosure including the name of any collaborator;
 - ii. assign title to the Invention to the Institution;
 - iii. cooperate to the extent necessary as determined by the Institution in the reasonable delay of publication to allow for a timely submission of a patent application;
 - iv. cooperate in prosecuting all patents applications and other required documents;
 - v. participate in the defense of such patents during prosecution for interference or infringement; and
 - vi. assist with licensing or marketing efforts related to the Invention.
- 3) The Institution has the right to:
- i. assign to the Inventor title to any Invention, subject to this Policy, for which the Institution chooses not to retain title;
 - ii. assign the rights or interests of any patented or unpatented Invention owned by the Institution to a PMO; or
 - iii. make, use, license, sell or exchange rights to a third party the rights or interests of any patented or unpatented Invention owned by the Institution, and exclude others from doing so.
- 4) The Institution is obligated to:
- i. make faculty, staff, students, trainees, volunteers or others aware of this Policy and of any ongoing agreements with external sources to evaluate and/or market such Inventions;
 - ii. after the Invention Disclosure is filed, determine whether the Institution chooses to retain title and/or file a patent application and give notice of Institution's intention and/or patent application to an Inventor within six (6) months after the Invention Disclosure is made;
 - iii. expedite Intellectual Property protection; and
 - iv. distribute Licensing Revenue received by the Institution for any Invention according to the Distribution Schedule contained in VI(j).

- 1 h. In no instance, and regardless of ownership of the patent, may the
 2 Institution's name be used in connection with the marketing of the
 3 Invention without the express written permission of the Institution.
 4 i. The UND Chester Fritz Library Patent & Trademark Depository offers a
 5 preliminary review of active U.S. patents at no cost to Inventors. Principal
 6 investigators and/or Inventors are encouraged to use this resource in
 7 proposal preparation and early in a research program to document
 8 current patent coverage in an area of interest and as a way to identify
 9 potential Inventions.
 10 j. Subject to restrictions arising from obligations of the Institution pursuant
 11 to gifts, grants, contracts, or other agreements with outside organizations,
 12 the Institution agrees, for and in consideration of the assignment of
 13 Invention rights, to pay Cumulative Net Royalties according to the
 14 Distribution Schedule below.

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 16 *Distribution Schedule*

17 Cumulative Net Royalties Inventor Unit Institution/PMO
 18
 19 <\$25,000 50% 10% 40%
 20 \$25,000-\$50,000 45% 10% 45%
 21 >\$50,000 40% 10% 50%

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 23 When there are two or more Inventors, each Inventor shall share equally
 24 in the Inventor's share of Cumulative Net Royalties, unless all Inventors
 25 have agreed in writing to a different distribution of such share. The Units'
 26 share shall follow the Inventors' distribution share off Cumulative Net
 27 Royalties. The Vice President for Research will have final authority in
 28 resolving any dispute between Inventors as to the sharing of royalties
 29 between them.

- 30 k. Cumulative Net Royalties received by the Institution and the Units must
 31 be used to support research, to further development of Intellectual
 32 Property, and/or to protect Institution's Inventions.
 33 l. An Inventor voluntarily leaving the employment of the Institution for
 34 employment elsewhere will have the Cumulative Net Royalties due
 35 Inventor reduced by 75%, except in the event that the Inventor
 36 participates in the formation of a new business affiliated with the
 37 Institution using the Invention technology.
 38 m. The Inventor obligations under VI(g)(2) will not be terminated upon
 39 termination of employment from the Institution.
 40 n. Intellectual Property Protection Procedure. The Office of Vice President
 41 for Research is responsible for the administration of this Intellectual
 42 Property Policy. The TTC Officer is responsible for the administration of
 43 the Intellectual Property Protection Procedure, financial rights,
 44 negotiation and management of Invention records. If an Invention is
 45 assigned to a PMO during the Intellectual Property Protection Procedure,
 46 the PMO shall be responsible for its administration and provide the

1 Institution with the appropriate documentation if requested. This
2 Intellectual Property Protection Procedure serves as a guide to the
3 Institution community in meeting the disclosure and reporting
4 requirements of the Institution, North Dakota State Board of Higher
5 Education and cooperating agencies.

- 6 1. Intellectual Property and/or Invention Agreement Review. Prior to
7 executing any contract that binds the Institution or Inventor with
8 regards to Intellectual Property, such contract will be submitted to
9 the TTC Officer, who, with guidance from General Counsel, will
10 ascertain that Intellectual Property clauses in sponsored projects
11 are acceptable to the principal investigator and the Institution and
12 are consistent with policies of the State Board of Higher
13 Education, and if appropriate, to Federal law. Such agreements
14 include confidentiality, non-disclosure, material transaction,
15 consulting and like agreements containing provisions for
16 proprietary information and contractor, sponsored research or
17 development, licensing or like agreements containing provisions
18 for Intellectual Property. The TTC Officer shall verify that the
19 terms of a contract will not willfully or knowingly infringe on any
20 background technology on which the Institution has previously
21 secured a patent or on any proprietary agreement that the
22 Institution may have with another party.
- 23 2. Documentation and Tracking. Inventors are responsible for
24 recording and maintaining the discovery records of all potentially
25 patentable discoveries derived through Institution activity. Bound,
26 dated, witnessed documentation is the encouraged method for
27 maintaining such records. Any questions regarding the proper
28 method for maintaining records should be directed to the TTC
29 Officer.
- 30 3. Invention Disclosure. An Inventor shall make a written description
31 of the Invention to the TTC Officer at the earliest possible time
32 after the creation of an Invention. An Invention Disclosure should
33 be made on a form provided by the TTC Officer or prepared in
34 conjunction with the TTC Officer. If the written description of the
35 Invention Disclosure is adequate then the TTC Officer will assign
36 an Institution document number. The TTC Officer will have sole
37 discretion to determine whether the Invention Disclosure is
38 sufficient. If not on file, the TTC Officer will request that Inventor
39 signs an agreement with Institution to assign rights to Institution.
40 Upon making an Invention Disclosure, the TTC Officer will notify
41 within a reasonable period of time, if necessary, the appropriate
42 Federal agency providing grant support of the Invention
43 Disclosure, in compliance with U.S. 37 CFR Part 401 and 35
44 U.S.C. 200-212.
- 45 4. TTC Officer Evaluation. The TTC Officer will review each Invention
46 before committing Institution or other funds in the pursuit of a

1 patent covering the Invention, protection of the Invention as a
2 Trade Secret, protection of the Invention under Copyright or any
3 other form of protection of the Invention as Intellectual Property.
4 Such an evaluation should consider the all aspects of the
5 Invention, prior art search and assessment, discovery's gross
6 market potential, potential licensees, financial return, obligation to
7 sponsoring parties, and other factors impacting the investment of
8 time and funds to complete the patent application process. The
9 review may entail the commissioning of market, patentability or
10 similar studies at the sole discretion of the TTC Officer. Upon
11 review, the TTC Officer will advance Invention Disclosure to the
12 Invention Disclosure Committee for review, unless additional
13 research or investigation is required towards patenting of Invention
14 or determining sufficient value. If latter, the Invention rights may
15 be returned to Inventor.

- 16 5. Invention Disclosure Committee Review. The Invention Disclosure
17 Committee will review, recommend filing or not filing, and
18 prioritize, if necessary, the filing a patent application on the
19 Invention. Final approval will be signed by the VP for Research.
20 6. Patent Application. Upon approval by the Institution to pursue
21 protection of the Invention, the TTC Officer will:
22 i. notify, if necessary, the appropriate Federal agency of the
23 Institution's desire to retain title to the invention;
24 ii. work with Inventor to file a U.S. patent application on the
25 Invention; and
26 iii. file a U.S. patent application either directly, with an external
27 Intellectual Property firm or with a third party within the
28 appropriate period.
29 7. Documentation: As necessary to protect the interests of the
30 Inventor and the Institution, and as allowed by law, the records
31 supporting Invention protection and appropriate documents with
32 any commercialization organization will be maintained as
33 confidential. The official Invention File shall the following items, if
34 and when they are created,
35 i. Documentation identifying the sources of funds used to
36 cover the costs.
37 ii. The costs of Invention protection. In the event that third
38 Party pays for prosecution costs, said costs will be reduced
39 accordingly.
40 iii. Any obligatory contract or grant terms and conditions under
41 which the discovery was conceived or developed.
42 iv. Initial records of Invention (i.e. notebook references,
43 drawings, sketches, etc.).
44 v. Any formal records of Invention required by sponsors.
45 vi. Invention Disclosure documents submitted by the
46 Inventor(s).

- vii. Invention Disclosure documents submitted to a patent agent or attorney.
 - viii. Inventor and Institution assignment agreements.
 - ix. Documentation of the approval by the Invention Disclosure Committee and Vice President for Research decision to proceed in securing a patent, the source(s) of funds used in covering the costs, and the patent attorney or other professional service involved in securing the patent.
 - x. The patent agent's / attorney's findings and assessment from a preliminary patent search.
 - xi. The final draft of a patent application as filed.
 - xii. Any patent assignment.
 - xiii. Any and all appropriate patent prosecution documents.
 - xiv. A disbursement of funds agreement identifying financial returns to the Inventor, Institution, and any patent development/commercialization entity.
 - xv. The issued patent.
 - xvi. Any licenses, equity positions, or other commercialization documents which determine financial returns to the Inventor and the Institution and its entities.
 - xvii. Obligatory confirmatory licenses to any sponsor.
 - xviii. Documentation of any abandonment of any patent by the Institution, any agreements transferring title back to the Inventor or any obligatory transfer of title to the sponsor.
- The Inventor shall be provided copies of each.

8. Commercialization. Upon the decision to pursue commercialization of an Invention, the TTC Officer shall outline a commercialization plan in cooperation with the Inventor. The commercialization plan should give careful consideration to steps that could be taken to protect the value of the Invention, including the appropriate use of confidentiality agreements, material transaction agreements and other Intellectual Property agreements. A copy of this plan and annual progress reports shall be provided to the Inventor, the Institution, and any applicable cooperating agency. The principal elements of this plan shall be incorporated into any licensing agreement between the Institution and any commercialization organization.

9. Patent and/or Intellectual Property Assignment and/or Licensing. The Institution authorizes the TTC Officer to establish a means of administering and managing the Institution's Invention assets which (1) expedites their commercialization, (2) provides means for defense of a patent, (3) maintains the secrecy of Trade Secrets and (4) provides financial returns to the Inventor and the Institution. For non-PMO commercialization organizations, the TTC Officer will be responsible for reviewing with General Counsel, negotiating and approving all agreements with third

1 parties relating to the assignment of Invention rights. Either the
2 TTC Officer, the Vice President for Research, or other designee,
3 are authorized to sign licensing or like agreements on behalf on
4 the Institution.

- 5 i. The Institution may assign or transfer ownership rights in
6 Inventions to a PMO at its sole discretion. When
7 appropriate, Institution and PMO will have confidentiality
8 agreements in place. If the Invention was supported
9 directly or indirectly by a Federal agency applicable, prior to
10 assignment the Institution will obtain documents showing
11 that the Invention has been assigned to the Institution by
12 the Inventor and the Institution has disclosed and elected to
13 retain title to the Invention to the supporting.
- 14 ii. It is the responsibility of employees and Units to provide the
15 TTC Officer with any and all Intellectual Property
16 agreements, which include consulting, confidentiality, MTA,
17 licensing and research agreements, to ensure that the
18 terms of the agreements with third parties do not conflict
19 with their commitments to the Institution. Each employee
20 shall make the nature of the employee's obligations to the
21 Institution clear to any third party for whom the employee
22 expects to consult. Specifically, the scope of the consulting
23 services must be distinguished from the scope of research
24 commitments to the Institution.

25 10. Licensing Revenue Collection and Cumulative Net Royalties
26 Distribution. Unless assigned to a PMO, the TTC Officer will be
27 responsible for the collection of all Licensing Revenue and the
28 payment of all fees under VI(j), as appropriate, upon approval by
29 Institution General Counsel, and the distribution of Cumulative Net
30 Royalties under VI(j) upon approval by the Vice President for
31 Research. Documentation of the distribution of funds to the
32 Inventor, Institution, any cooperating agencies, and other parties
33 will be prepared by the TTC Officer or PMO, as appropriate, and
34 signed by all parties. A PMO will provide Institution a copy of such
35 documentation if requested.

36 11. Intellectual Property Documents. The TTC Officer shall maintain a
37 permanent filing and storage system for all original Invention
38 documents and any and all Intellectual Property agreements. A
39 copy of the document should be provided to any cooperating
40 agency and Inventor.

41
42 *VII. General Trademark Policy*

- 43 a. Trademarks developed by faculty, students and staff of the Institution
44 shall be treated in the same manner as Inventions.