

## **Policies and Procedures**

<b>SECTION:</b> <b>Academic Concerns</b>	<b>NO.</b> <b>4.2.3.</b>				
<b>CHAPTER:</b> <b>Faculty</b>	<b>ISSUED:</b> 4/3/96	<i>REV. A</i> 1/14/00	<i>REV. B</i> 6/26/00	<i>REV. C</i> 2/15/02	<i>REV. D</i> 4/22/19
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### **PURPOSE**

The Intellectual Property Policy is to define the conditions for ownership, legal protection, licensing, and development of any intellectual property conceived or first reduced to practice by any Creighton University associated personnel. Intellectual property exempt from this policy is defined, and the division of any income resulting from the development of intellectual property is defined.

### **POLICY**

- A. Applicability:** The Intellectual Property Policy of Creighton University is applicable to all intellectual property conceived or first reduced to practice, in whole or in part, by any faculty, staff, students, contractors, commissionees, non-employees participating in research projects (visiting faculty, industry personnel, fellows, etc.), or others, with more than incidental use of University resources, including personnel, facilities, equipment, services, supplies, trade secrets, employment time (based on a 40 hour week), or funds paid by the University, whether for reimbursement, direct compensation, or by contract. All personnel shall agree as a condition of employment, or of undertaking investigation and development activities, at Creighton University to the conditions in the Intellectual Policy Agreement for Creighton University Personnel (Form IRM-1)(APPENDIX I). This Policy shall be contractually incorporated into the Handbook for Faculty, and Form IRM-1 shall be signed by any non-faculty individuals who may develop intellectual property. Intellectual property shall come under the provisions of this Policy whenever the developer's duties include research and investigation, and the intellectual property developed arose during the course of such investigation and is relevant to the field of inquiry in which the developer was employed, or when the development involved the use of University resources. This Policy **shall not apply** to intellectual property developed for which no substantial University resources or funds were used.
- B. Third Party Arrangements for Research and Development:** Whenever grants, contracts, consulting arrangements, commissions, or agreements, verbal or written, are made or signed to support research or development or clinical trials with other teaching and research institutions, business, industry, governmental agencies, or other third parties, such agreements shall contain intellectual property clauses conforming to this Policy governing the ownership, licensing, and control of any resulting intellectual property. All such agreements shall use agreed standard clauses or shall be cleared through the Director, Intellectual Resource Management. Any agreements with third parties not in conformance with this policy shall be approved in advance by the University.

Public Law 96-517, the Patent and Trademark Amendments Act of 1980, as amended by Public Law 98-620, as codified in 37 CFR Section 401, gives nonprofit organizations and small businesses the right of first refusal to the title to inventions made during the performance of government grants and contracts, with some limited exceptions. If the University does not diligently pursue protection and/or licensing, the invention shall then be referred to the Federal

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sponsoring agency, and the developer may then request assignment of title from the Government agency. The government shall be given an irrevocable, nonexclusive, royalty-free license, which may include without limitation the right to reproduce, publish or otherwise use the work for federal purposes, and to authorize others to do so. Under the Copyright Act commissioned works of non-employees are owned by the creator, and not by the commissioning party, unless there is a prior written agreement to the contrary. Thus all agreements, commissions, and contracts, shall have provisions providing for the ownership of all copyrightable materials.

**C. Ownership of Intellectual Property:** The University shall own, or shall be assigned title by the developer, to all intellectual property rights for intellectual property as defined in this Policy, i.e. patents, copyrights, or trademarks, conceived or reduced to practice, in whole or in part, by any personnel directly or indirectly using more than an incidental amount of University resources, unless specifically exempted by this Policy. Whenever a project is undertaken which may possibly develop intellectual property where ownership and rights may be in question, initial discussion should be held between the developer and their Chair, Dean or Director, and an understanding developed and recorded with regard to the intellectual property rights. The developer, or the University, shall each grant the other an irrevocable, nonexclusive, royalty-free, paid up license to the intellectual property for noncommercial use internal to the University or solely as an individual by the developer, as appropriate. The owner of the intellectual property shall diligently pursue securing patent, copyright, or trademark protection and licensing for commercial development when reasonable to do so, but if the owner is not interested in securing protection or developing licensing, or is not diligent in its pursuit, the other party shall have the right to request assignment of ownership to pursue such protection and/or licensing at their own expense. Such assignment shall be granted unless there are reasonable grounds for refusal. Such assignment shall be requested and granted within one year of disclosure, or within nine months of publication or public availability. If the owner pursues protection in the United States the developer may request permission to pursue foreign protection rights separately, and such permission shall be granted if the owner does not diligently pursue such rights. The owner may waive, assign, license, or transfer in the whole, or in part, any of these rights at any time. [Note: Many foreign patents require application prior to publication or public use, although United States law permits one year.] The University agrees that the developer(s) collectively are free to place intellectual property in the public domain, if in the best interest of technology transfer, provided this is not in violation of the terms of any agreement that supported the work.

**D. Definition of Intellectual Property:** Intellectual property for the purposes of this Policy, shall be defined as:

1. **Invention(s):** A novel and useful idea relating to a process, a machine, an article of manufacture, a compound, the composition of matter, or an apparatus or improvement thereof made or conceived by the developer. Inventions include new and improved devices, systems, circuits, chemical compounds, mixtures, bioengineered organisms, etc.

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2. **Copyrights and Similar Materials:** Copyrights are the protections provided various forms of written, visual, electronic, and artistic expression, including most software (a set of ordered instructions or programs used to control the operations of a computer). [Note: Some software may be patentable.]
- a. **Excluded Items:** The following classes of intellectual property are excluded from the disclosure, ownership, and royalty distribution provisions of this Policy (sections C, E and F), unless they are works-for-hire as defined in 2(c), or institutional projects specifically and substantially directly funded by the University as defined in 2(b). These excluded classes, whether in print, video, or electronic form, are books, articles, computer software, and similar works intended to disseminate the results of academic or scholarly activities, including dissertations, papers, articles, teaching materials (including those developed for distance education courses), and syllabi. Similarly excluded are popular nonfiction books, novels, poems, musical compositions, art works, and other works of artistic imagination. Copyrights on these excluded classes of intellectual property, unless works-for-hire, or specifically and substantially directly funded by the University, shall vest in the creator with no requirement for disclosure or distribution of royalties to the University. If copyrights of excluded items vest in the University by law, the University shall, on request, assign such copyrights to the creator(s) of such works.
- b. **Directly Funded Projects (Institutional Projects):** It is agreed that for all intellectual property arising from sponsored agreements or other research that is awarded to and/or managed by the University, or from scholarly projects, specifically and substantially directly supported by University funds, that ownership of copyrights of works resulting from such projects shall vest in or be assigned to the University. Royalty income from such projects shall ordinarily be distributed as in F. following. This section shall not apply unless there is an agreement in place between the investigator and the University regarding such specific and substantial direct support and the ownership of any resulting copyright(s).
- c. **Works-for-Hire:** Ownership of works created on projects on which the employee was employed and specifically directed by the University as a part of the employment or contractual agreement to invent or develop such works, i.e. works-for-hire, shall vest in the University, and shall not be subject to royalty proration under this Policy. This is true regardless of whether or not the work is developed in the course of sponsored research, nonsponsored research, or nonresearch activities. Examples may include the development of computer software for specific purposes, or distance education courses that are separately

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contracted between the University and a developer. A work-for-hire arrangement must be identified in writing for this section to apply.

3. **Trade Marks:** Trademarks and service marks are distinctive words or graphic symbols identifying the source, product, producer, or distributor of goods or services. Any trademark or service mark that results from activities at or through the University shall be owned by the University.
4. **Trade Secrets:** Any proprietary intellectual property arising out of University work as defined in this Policy that is not patented, copyrighted, or otherwise protected, whether or not it is patentable or copyrightable, shall be owned by the University. Trade secrets are properties which are not generally known or accessible, and which give competitive advantage to the owner. Since trade secrets are essentially not legally protected, and the only protection is restriction of dissemination and signed secrecy agreements, this concept should rarely apply in the University setting.

- E. **Disclosure:** All intellectual property developed by any faculty, staff, students, contractors, commissionees, non-employees participating in research, or others at Creighton University shall be disclosed to the Director, Intellectual Resource Management as soon as the invention or intellectual property is conceived or reduced to practice. The disclosure shall describe the invention or intellectual property and its uses, list the inventors, and describe the circumstances leading to the invention and subsequent activities. Disclosure need not be made on copyrightable items clearly excluded in D(4). preceding from the definition of intellectual property. Disclosure shall be made for all potentially patentable inventions, nonexcluded copyrights, trademarks, and other intellectual property developed by individuals subject to this policy, regardless of the source of funding or the use of University resources, in order to clearly determine ownership. Disclosure shall not be made to the sponsor of the research or development until after submission to the Director, Intellectual Resource Management.

The Director shall determine on all disclosures received whether to pursue protection and licensing, or whether to assign ownership to a sponsor or the developer, on request. All developers shall cooperate fully with the Director in supplying and executing all necessary documents for the approved course of action.

- F. **Royalty Distribution:** All income received from royalties and/or licensing or sale of any intellectual property not excluded by this Policy, by the University, or by the developer of the intellectual property, regardless of ownership, shall be distributed successively as follows:

1. Directly assignable expenses, outside of the University and/or the developer, for applications for and securing of protection, or for licensing. To the extent such expenses are paid for as a direct charge from a federal grant, those expenses would not be recovered.

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2. A 15% technology transfer fee for developments administered by the Intellectual Resource Management office.
3. Payments of contractually required amounts to sponsors or other institutions participating in the development of the Intellectual Property.
4. Payment to the developer(s). of 50% of the net return (total minus 1., 2., and 3.). If there are multiple developers, this payment is split equally between the developers unless the developers unanimously agree to a different split.
5. Payment to the University of 25% of the net return (total minus 1., 2., and 3.).
6. Payment to the University School(s) of 12.5% of the net return (total minus 1., 2., and 3.). If there are multiple developers from different University Schools, each University School will receive the same percentage as its developers do in subsection 4 above.
7. Payment to the University Department(s) of 12.5% of the net return (total minus 1., 2., and 3.). If there are multiple developers from different University Departments, each University Department will receive the same percentage as its developers do in subsection 4 above.

Note 1: Funds designated for the University, School, and Department shall be used to support the development of further intellectual properties and research. Funds for the University shall be administered by the Provost, those for the School by the Dean, and those for the Department by the Chair.

Note 2: In the case of intellectual property developed by a group where the distribution of royalty to individuals would be impractical or inequitable, such as a laboratory project, the developers' share shall be allocated by the Dean to a fund for the developing unit.

Note 3: In situations where an inventor belongs to a School but not a specific department, the School will receive the aggregate 25% from sections 6 and 7.

Note 4: If an inventor comes from a non-academic unit (e.g. DoIT), then the division would receive the 25% from sections 6 and 7.

- G. **Publication:** The policy of the University is openness in research, and the ability of investigators to publish research results. Investigators shall not enter into projects requiring secrecy without the specific permission of the Dean. A project requiring secrecy is defined as one in which the sponsoring or granting documents are not freely publishable, access to security classified

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information is necessary to carry out the research, or one in which there is a reasonable expectation that any documents generated will be restricted by an outside sponsor from publication for a period in excess of 90 days. Secrecy based on reasonable provisions to protect the rights and privacy of all individuals is acceptable. Provisions from a sponsor requiring submission of publications for review and comment, or for patenting purposes, are acceptable provided there is no reason to expect that the sponsor would attempt to suppress publication or require substantive changes. If confidential information has been made available to the investigator the confidentiality of such information may be protected, and the person furnishing such information may require submission of any manuscript for review and comment and deletion of specific items constituting disclosure of such confidential information within 90 days. It should be noted that in the United States application for a patent must be submitted within one year of publication or public use of the invention, but for many foreign countries patent applications must be submitted prior to publication or public use.

**I. Functions of the Intellectual Resource Management office(IRM):** The Director, IRM, shall report to the General Counsel of Creighton University. The Director of Intellectual Resource Management shall maintain liaison with, and provide advice and consultation to, faculty and staff to identify intellectual property which is potentially patentable, copyrightable, or registerable as a trademark or service mark, and promote its protection, technology transfer, and licensing. The Director shall represent the University in accepting those developments in which the University has a significant interest, and shall diligently pursue their protection, transfer, and licensing. The University shall pay all necessary fees and costs for protection and licensing of accepted developments. For those developments to which the University does not wish to make a commitment, the Director shall promptly assign such developments, on request, to the developer, sponsor, or other appropriate party.

The Director, IRM, shall provide reasonable amounts of advice, consultation, and assistance to faculty and staff to assist developers in protecting, transferring, and licensing developments which do not come under the Intellectual Property Policy, or which have not been accepted by the University. The developer shall be responsible for all necessary fees and costs for protection, transfer, and licensing of developments not accepted by the University. There shall be no charge for reasonable amounts of advice, consultation, and assistance from IRM.

The Director, IRM, shall advise and recommend to the University Contracting Officer policy and its implementation for the protection and sharing of intellectual property ownership, technology transfer, and licensing for all University grants, contracts, and agreements.

The Director, IRM, shall be responsible for the protection, transfer, and licensing activities associated with all University technologies, shall administer the licenses, and maintain records regarding the receipt and distribution of all royalty, licensing, and other related income. The

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Director shall make recommendations with regard to all cases of disputed ownership, licensing, or income distribution concerning intellectual property developed by any faculty, staff, students, contractors, commissionees, non-employees participating in research projects, and others at Creighton University. All unresolved disputes shall be referred to the Provost for resolution.

### **SCOPE**

The Intellectual Property Policy applies to all intellectual property (inventions, devices, creations; written, visual, electronic, software, or artistic expressions; trademarks; or trade secrets) conceived or first reduced to practice by eligible individuals (as listed below) in the scope of their employment or when using substantial University resources. Excluded copyrighted materials are specified in section D(2)(a). It applies to all faculty, staff, students, contractors, commissionees, or non-employees (visiting faculty, industry personnel, fellows, etc.), as a condition of employment or participation.

### **ELIGIBILITY**

All faculty, staff, students, contractors, commissionees, or non-employees (visiting faculty, industry personnel, fellows, etc.), are covered immediately and continuously on an ongoing basis, as a condition of employment or participation.

### **DEFINITIONS**

All terms are defined in the Intellectual Property Policy in paragraph D.

### **ADMINISTRATION AND INTERPRETATION**

The Intellectual Property Policy is administered by the Intellectual Resource Management office. The Director, Intellectual Resource Management, reports to the General Counsel, Creighton University. All disputes between developers of intellectual property and the Director, Intellectual Resource Management shall first be referred to the Provost. If the Provost is unable to satisfy both parties, appeals may be made to the President. Questions regarding the interpretation of the Intellectual Property Policy should be referred to the Director, Intellectual Resource Management, or the University General Counsel.

### **AMENDMENTS OR TERMINATION OF THIS POLICY**

Creighton University reserves the right to modify, amend, or terminate this policy at any time. The Intellectual Property Policy constitutes a contract with all University faculty through the current edition of the Handbook for Faculty, and is binding with regard to all development of intellectual property disclosed to the University, undertaken by mutual agreement between the developer and the University, or developed under external contracts in place, up to the effective date of modification, amendment, or termination. Intellectual Policy Agreements for Creighton University Personnel may also be in place, which are subject to modification, amendment, or termination in the same manner as set forth above.

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### **APPENDIX I**

#### **Intellectual Policy Agreement for Creighton University Personnel**

In consideration of my employment or continued employment by Creighton University, my contractual relationship with Creighton University, the receipt of remuneration from Creighton University, participation in projects administered by Creighton University, access to or use of facilities provided by Creighton University, and/or other valuable considerations, I hereby agree as follows:

1. I shall disclose to Creighton University all potentially patentable inventions conceived or first reduced to practice in whole or in part in the course of my University responsibilities, or with more than incidental use of Creighton University resources. I further agree to assign and do hereby assign to Creighton University all of my rights, title, and interests in such potentially patentable inventions, to execute and deliver all documents, and do any and all things necessary and proper on my part to affect such assignment.
2. I shall disclose and assign or confirm in writing to Creighton University all my rights, title, and interests, including any associated copyrights, in and to copyrightable materials created, except as excluded by the Creighton University Intellectual Property Policy:
  - a. in the course of any agreement entered into by Creighton University if the terms of the agreement require creation of copyrightable materials or require some interest in them be conveyed to Creighton University, to the sponsor, or to any other party;
  - b. in the course of my employment (that is, as a work-for-hire, or as an institutional work); or
  - c. in the course of a project specifically and substantially directly supported by University funds or where the University is awarded or manages project funds, and where an agreement is in place between the investigator and the University regarding such support and the ownership of any resulting copyrights.
3. I am now under no consulting or other obligations to any third person, organization or corporation in respect to rights in inventions or copyrightable materials which are, or could reasonably be construed to be, in conflict with this agreement.

NOTE: If you do have an agreement with another employer, or anyone else, that would apply to copyrightable materials or to potentially patentable inventions conceived or first reduced to practice, in whole or in part, with more than incidental use of Creighton University resources, do not sign this form. You must consult with the Dean of your

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School or College for resolution of any conflicts before using any Creighton University resources, and to develop specific written exceptions to this agreement prior to signing.

4. I shall not enter into any agreement creating copyright or patent obligations in conflict with this agreement. I further agree to be bound by the terms of any grants, contracts, or other agreements entered into by Creighton University in which I am an investigator or participating worker, regarding patent and copyright obligations.
5. This agreement is effective as of the date of signing, or of hire or entering into any covered contractual relationship, and is binding on myself, my estate, heirs, and assigns.

Signed this \_\_\_\_\_ day of \_\_\_\_\_, \_\_\_\_\_

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(Signature)

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(Printed or Typed Name)

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(Title)

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(Department)

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(Social Security Number)

NOTE: This agreement does not apply to any invention which is an invention for which no significant Creighton University equipment, supplies, facilities, or trade-secret information were used, and which was developed entirely on the developer's own time, and neither (a) related to Creighton University research, nor (b) results from any work performed by the developer for Creighton University.

Original to Intellectual Resource Management, copy to signer.

Form CU IRM-1