

Revised Intellectual Property Policy Union College—adopted by BOT May 2005

- I. Basic Objective:

Union College is a college of liberal arts and engineering whose mission is to maintain a community of inquiry, discourse, and experiment in which it is clear that scholarship and teaching are parts of a single enterprise. The intellectual endeavors and activities of its faculty, staff, or students may result in products of a tangible nature for which the College and the faculty, staff, or student may deem it advantageous to enter these products into commerce. The College strives to support its faculty and employees in securing commercial development of intellectual property resulting from their research so that society may benefit at the earliest opportunity. These products may be the subject of a patent application or a copyrightable work or other tangible material and are known collectively as "Intellectual Property."
- II. This policy is intended to:
  - (1) provide an incentive to creative intellectual effort and the advancement of knowledge;
  - (2) insure that the respective interests of the College, and supporting sponsor (if any) are considered and protected through the development of fair contracts and procedures;
  - (3) assist the Staff and the College to realize tangible benefits from Intellectual Property, and advance and encourage further research within the College with whatever funds accrue to the College from Intellectual Property resulting from College research.
- III. Definitions.
  - (1) "College" shall mean Union College.
  - (2) "Staff" shall mean any member of the faculty, administration, staff, student body, postdoctoral fellow, or visiting scientist, whether or not they receive all or any part of their salary or other compensation from the College.
  - (3) "Inventor" shall mean any Staff member who shall conceive or reduce to practice an invention while engaged in College activities.
  - (4) "Author" shall mean any Staff member who prepares any College copyrightable work.
  - (5) "Contributor" shall mean any Staff member who shall have contributed substantially to the existence of any item of Intellectual Property.
  - (6) "College Activities" shall mean activities engaged in by a member of the Staff by: (a) written assignment of the College administration; (b) contractual agreement with the College or any sponsor; (c) material use of facilities (other than its libraries), materials, or other resources of the College.
  - (7) "Intellectual Property" shall mean inventions, College copyrightable works, and tangible results of research .
  - (8) "Invention" shall mean "...any new and useful process, machine, manufacture or composition of matter or any new and useful improvement thereof..." as defined under the Patent Laws of the United States.

- (9) "College Copyrightable Work" shall mean copyrightable works owned by the College in accordance with the policies set forth in Section XVIII.
- (10) "Tangible Results of Research" shall mean a physical embodiment of the research effort, including physical embodiments of any ~~other than an~~ invention, or College Copyrightable Work that results from College Activities by any member of the Staff. Such Tangible Results of Research shall include, but not be limited to, antibodies, cell lines, new microorganisms, plant lines or progeny thereof; recombinant or other biological materials; integrated circuit chips, computer software, engineering prototypes and drawings, chemical compounds; devices; machines; and models.
- (11) "Sponsor" shall mean any individual or organization that by written agreement with the College shall finance in whole or part any College Activities
- (12) "Net Revenue" or "Annual Net Royalty" are defined as revenues received from the licensing and developing of an Intellectual Property after deduction of all costs reasonably attributable to the protection and distribution of such Intellectual Property, including any reasonable expense of patent or copyright prosecution, maintenance, interference proceedings, litigation, marketing or other dissemination and licensing. Net revenues from the following sources are subject to distribution: option fees; up-front licensing fees; licensing payments; milestone payments; or proceeds from the sale of stock or other equity in the licensee company.

#### IV. Coverage

These policies shall apply as a condition of appointment or employment by the College to every member of the Staff who during the period of their appointment or employment by the College shall: (a) conceive or first reduce to practice actually or constructively, any Invention; (b) prepare any College Copyrightable Work; or (c) contribute substantially to the existence of any Tangible Result of Research.

#### V. Disclosure of Intellectual Property

Every Staff member shall, in writing and in reasonable detail, give the Vice President for Academic Affairs (hereinafter "VPAA")/Dean of the Faculty prompt notice of any: (a) Invention; (b) College Copyrightable Work; or (c) Tangible Result of Research which or he or she shall desire to have patented, copyrighted or made available to the investigators or the public by commercial or other means, or shall believe or have reason to believe is patentable, copyrightable, or of value to other investigators or the public, or otherwise of commercial value.

- VI. Ownership of Inventions  
The rights of ownership to all Inventions which result from College Activities shall be the property of the College; provided, however, that:
- a. Within the ninety (90) days next following disclosure of an Invention to the College under the preceding Section V (or such further period of time as may be agreed upon by the Inventor and the VPAA), the VPAA shall determine, and advise the Inventor in writing, whether such rights shall be retained by the College, conditionally retained by the College or shall be released to the inventor; and
  - b. The rights of ownership to every Invention conceived by any Staff member while engaged in other than College Activities shall be the property of that person.
- VII. Ownership of Copyrightable Works  
The rights of ownership to all copyrightable works prepared while the Staff member is engaged in College Activities shall be the property of the College; provided however that:
- (1) Within the ninety (90) days following disclosure of College Copyrightable Work to the College under the preceding Section V (or such further period of time as may be agreed upon by the Author and the “VPAA”, the “VPAA” shall determine, and advise the Author, in writing, whether such rights shall be retained by the College, conditionally retained by the College or shall be released to the Author; and
  - (2) Copyrightable works prepared by a Staff member while engaged in activities other than College activities shall be the property of the Author. See Section XVIII below for specific details.
- VIII. Ownership of Tangible Results of Research  
All Tangible Result of Research shall be the property of the College.
- IX. Sponsorship of Intellectual Property  
The rights of ownership to each item of Intellectual Property produced during activities conducted pursuant to any agreement between the College and any Sponsor shall be determined in accordance with such agreement; however, it shall be the policy of the College to retain title to Intellectual Property whenever possible under state or federal law. Any agreement with a Sponsor pertaining to the ownership of Intellectual Property and assignment thereof shall be made between the College and the Sponsor in advance of the research or other activity that produces the Intellectual Property.
- X. Disagreements  
The President shall appoint a Committee on Intellectual Property composed of both faculty members and administrative officers (the VPAA shall serve *ex officio*). The creator of any Intellectual Property that is or might be covered under this Policy (see above for Patents) cannot be a voting member of this Committee. This Committee shall be the body to whom appeals may be made. Whenever legal protection for Intellectual Property is anticipated all persons engaged in such creative activity are encouraged to keep regular notebooks and records, preferably

in the form of bound notebooks that are regularly signed and dated by the Inventor(s) as well as periodically signed by one or more witnesses.

XI. Seeking a Patent or Copyright

Whenever the VPAA shall determine to seek the patenting or copyrighting of any Invention or College Copyrightable Work, the College shall, without expense to the Inventor or Author provide such professional services as it shall deem to be necessary or desirable for such purpose, and which may include the services of an independent patent organization. The Inventor or Author is obligated to cooperate fully in such effort, including his or her execution of all necessary or desirable agreements, applications, and other forms and instruments. If, at any time subsequently, the College shall terminate its effort to seek such patent or copyright, it shall promptly give written notice thereof to the Inventor or Author who thereupon to the extent allowed by law or any sponsorship agreement shall be free at his or her expense to develop, license, and otherwise use the Invention, patent application, patent or copyright. In this event the Inventor or Author shall receive all benefits of any development, licensing or other use of the Invention, patent application, patent or copyright except that the College shall be entitled to recovery of associated costs.

XII. Transfer or Sale of Tangible Results of Research

Tangible Results of Research may not be transferred or sold to any party outside the College before: (a) a disclosure of the Tangible Results of Research has been submitted to the VPAA and (b) the Contributor(s) has been notified by the Office of the VPAA of any required conditions of such transfer or sale. Such notification shall be made within thirty (30) days following the disclosure of Tangible Results of Research.

XIII. Promotion and Licensing

In interpreting and applying these policies, the College shall, by such means as it shall deem to be most effective and appropriate in each case, act to bring to the public all Intellectual Property to which the College has rights of ownership in whole or part. Such means may include, but shall not be limited to, agreements for the development, patenting, copyrighting, promotion, licensing, printing, distributing or manufacturing of any Intellectual Property; and in every case the College shall advise the Inventor, Author, or contributor of the terms of any such proposed agreement. No agreements will be entered into by the College without the review of all Inventors, Authors or contributors. Any disagreement between the College and the Inventor(s), Author(s) or contributor(s) concerning a proposed agreement will be resolved in a timely fashion by the Committee on Intellectual Property.

XIV. Proceeds from Distribution of Intellectual Property

(1) Invention Proceeds

Subsequent to the College's recovery of funds that were invested in patenting, marketing or developing Intellectual Property, the

Contributor(s) and the College will share in the net revenue received from the Contributor's Intellectual Property(ies) owned by and licensed from the College. The Contributor(s) will receive 50% of the net revenues, and the College will receive 50%. It is understood that one-half of the College's portion will be for the primary purpose of advancing and encouraging further research and intellectual property development within Union College.

In the case of multiple Inventors, the Inventors' share will be distributed among Inventors in accordance with a written agreement signed by all Inventors; or, if there is no such agreement, all Inventors will receive an equal share.

If inventorship is shared among College Inventors and inventors at one or more other institutions, the College will negotiate with the one or more other institutions concerning exclusive licenses and distribution of revenues. College net revenues from such agreements will be distributed to inventors at the College using the distribution formulae discussed above.

- (2) Copyright Proceeds: These will follow the same distribution and stipulations as Inventions listed above.
- (3) Tangible Results of Research Proceeds: To the extent allowed by law, where any Tangible Result of Research is not within the scope of the claims of a patent, patent application, or copyright, each Contributor shall share in any net revenue or annual net revenue to the same extent a Contributor shares in proceeds listed above for Inventions and Copyrights.

XV. Sponsors: Other Organizations

If and when any conflict shall arise between these Policies and any condition or conditions of (a) any proposed grant from or contract with any organization offering to act as a Sponsor or (b) the patent, copyright or intellectual property policies and procedures of any other organization to which any joint appointment or any affiliation or consulting agreement is made, such conflict shall be referred to the Committee on Intellectual Property. Following consideration of the conflict the Committee shall recommend a course of action to the College administration. It is incumbent on the College to take all reasonable steps, including but not limited to appropriate legal action, to protect and advocate issues on its behalf and those of the Inventor, Author or Contributor in the event of a conflict with a Sponsor.

XVII. Release of Rights of Ownership

The Office of the Vice President for Academic Affairs may, for reasons and upon terms deemed to be satisfactory by its office, release on behalf of the College at any time any Invention, patent, patent application, College Copyrightable Work, copyright or right of ownership to Tangible Results of Research to its Inventor,

Author or Contributor. Such release shall be in writing in accordance with Section XI

#### XVIII. Copyright.

Within higher education, it has been the prevailing academic practice to treat the faculty member as the copyright owner of works that are created independently and at the faculty member's own initiative for traditional academic purposes. Examples include, but are not limited to, class notes and syllabi, books and articles, works of fiction and nonfiction, poems and dramatic works, musical and choreographic works, pictorial, graphic, and sculptural works, computer programs, computer-generated works, and educational software (commonly known as "courseware"). This practice has been followed for the most part, regardless of the physical medium in which these "traditional academic works" appear, that is, whether on paper or in audiovisual or electronic form. This practice should also ordinarily apply to the development of courseware for use in programs of distance education. Situations do arise, however, in which the College may fairly claim ownership of, or an interest in, copyright in works created by faculty members. Three general kinds of projects fall into this category: special works created in circumstances that may properly be regarded as "made for hire," negotiated contractual transfers, and joint works" as described in the Copyright Act.

##### 1. Works Made for Hire

Although traditional academic work that is copyrightable—such as lecture notes and courseware, books, and articles—cannot normally be treated as works made for hire, some works created by College faculty members do properly fall within that category, allowing the institution to claim copyright ownership. Works created as a specific requirement of employment or as an assigned institutional duty that may, for example, be included in a written job description or an employment agreement, may be fairly deemed works made for hire. Even absent such prior written specification, ownership will vest with the college or university in those cases in which it provides the specific authorization or supervision for the preparation of the work. Examples are reports prepared by a dean or by the chair or members of a faculty committee, or college promotional brochures prepared by a director of admissions. The Copyright Act also defines as a "work made for hire" certain works that are commissioned from one who is not an employee but an "independent contractor." The institution will own the copyright in such a commissioned work when the author is not a College employee, or when the author is such a faculty member but the work to be created falls outside the normal scope of that person's employment duties (such as a professor of art history commissioned by the institution under special contract to write a catalog for a campus art gallery). In such situations, for the work-made-for-hire doctrine to apply there must be a written agreement so stating and signed by both parties; the work must also fall within a limited number of statutory categories, which include instructional texts, examinations, and contributions to a collective work.

## 2. Contractual transfers

In situations in which the copyright ownership is held by the faculty member, it is possible for the individual to transfer the entire copyright, or a more limited license, to the College or to a third party. As already noted, under the Copyright Act, a transfer of all of the copyright or of an exclusive right must be reflected in a signed document in order to be valid. When, for example, a work is prepared pursuant to a program of “sponsored research” accompanied by a monetary grant from a third party, a contract signed by the faculty member providing that copyright will be owned by the College will be enforceable. Similarly, the College may reasonably request that the faculty member—when entering into an agreement granting the copyright or publishing rights to a third party—make efforts to reserve to the institution the right to use the work in its internally administered programs of teaching, research, and public service on a perpetual, royalty-free, nonexclusive basis.

## 3. Joint Works

Under certain circumstances, two or more persons may share copyright ownership of a work, notably when it is a “joint work.” The most familiar example of a joint work is a book or article written, fully collaboratively, by two academic colleagues. Each is said to be a “co-owner” of the copyright, with each having all the usual rights of the copyright owner provided that any income from such uses is shared with the other. In rare situations it may be proper to treat a work as a product of the joint authorship of the faculty member and the College, so that both have a shared interest in the copyright. Whoever owns the copyright, the College may reasonably require reimbursement for any unusual financial or technical support. (“Unusual financial or technical support” is defined as follows: Extensive unreimbursed use of major College laboratory, studio, or computational facilities, or human resources. The use of these facilities must be important to the creation of the intellectual property; merely incidental use of a facility does not constitute substantial use, nor does extensive use of a facility commonly available to all faculty or professional staff (such as libraries and offices), nor does extensive use of a specialized facility for routine tasks. Use will be considered “unusual” and facilities will be considered “major” if similar use facilities would cost the creator more than \$5,000 (five thousand dollars) in constant 1984 dollars if purchased or leased in the public marketplace. Creators wishing to reimburse the College for the use of its facilities must make arrangements to do so before the level of facilities usage for a particular intellectual property becomes substantial as defined.) That reimbursement might take the form of future royalties or a nonexclusive, royalty-free license to use the work for internal educational and administrative purposes. This means that the course developer and the College must reach an understanding about the conditions of portability and

commercialization of faculty work developed using substantial College resources. Ordinarily, such an understanding will be recorded in a written agreement between the course developer and the College on a course-by-course basis.