

3344-17-02 Patents policy.

- (A) Research is recognized as an integral part of the educational process to generate new knowledge; to encourage the spirit of inquiry; and to develop scientists, engineers, and other scholars. As a result of such research, new discoveries and inventions may be made by faculty members of the university. Discoveries and inventions may have material commercial value or potential as revenue producers; may contribute significantly to scientific, technological, social and cultural progress; and may qualify for patent protection. Patents are created by the constitution and laws of the United States to recognize the ownership of inventions by individuals in return for the publication of the inventions by issued patents and ultimate dedication to the public after the limited period for which the law grants patent protection.
- (B) The faculty members of the university are encouraged to evaluate the results of their research activities in terms of potential commercial value and public interest, as well as for scholarly significance.
- (C) Definitions.
 - (1) Patents/Patentable means:
 - (a) Utility inventions or discoveries that constitute any new and/or useful process, machine, manufacture, or composition of matter, or any new and/or useful improvement thereof;
 - (b) Ornamental designs, being new, original and ornamental designs for an article made; and
 - (c) Plant patents, being for the asexual reproduction of a distinct and new variety of plant, including cultivated sprouts, mutants, hybrids and newly found seedlings, other than a tuber propagated plant or plant found in an uncultivated state.

- (2) Invention includes discoveries, products, processes, compositions of matter and improvements that are or may be patentable.
- (3) Sponsored research agreement includes any sponsored research grant, contract, fellowship, or other special arrangement to fund faculty research by third parties.

(D) Disclosure

- (1) Faculty members, other employees, and students shall disclose in a timely manner to the office of research all inventions that are developed from research or investigations supported by the university or by any university facilities, equipment, or resources provided pursuant to sponsored research agreements.
- (2) Disclosure shall be in writing and shall include at least the following: a general description of the field of the invention or discovery, and prior art of which the inventor(s) is aware, a general statement (if possible) of the economics of the invention or discovery, a listing of the notebooks or other records containing the first description of the invention or discovery, the name of the person to whom the invention or discovery was first disclosed, and the date of such disclosure. The office of research will determine the particular form, detail, and supporting information required for disclosure.
- (3) Faculty members, other employees and students who believe they have inventions that were not developed from research or investigations supported by the university or by any university facilities, equipment, or resources shall not file, or permit others to file in their name, patent applications, without providing at least thirty days' notice and a statement of the circumstances of the invention to the office of research. At the office of research's request, additional information as to the nature and circumstances under which the invention was developed and a copy of the invention disclosure of proposed patent application,

whichever the office of research may deem appropriate under the circumstances, shall be approved.

(E) Disclosure and review process

- (1) Within thirty days of a disclosure of an invention, the office of research shall notify the inventor whether his/her disclosure is incomplete, with notations of the additional information required, or shall refer the disclosure to the patent review committee.
- (2) Within thirty days of the receipt of the complete disclosure from the office of research, the patents review committee shall make a recommendation about the invention to the president or the president's designee. The president or the president's designee shall notify the inventor of the disposition of the invention.

(F) Patent review committee

(1) Composition and appointment

- (a) The patent review committee shall be composed of six members. The committee members shall elect a chair from among themselves. At the time of the initial appointment or election, each member shall be designated as serving either a one-year, two-year, or three-year term, so that the term of one faculty committee member and one administration member will expire each year and a replacement appointment or election will be made each year. After the first appointment, subsequent members shall serve a three-year term, commencing on July 1 and terminating on June 30. Committee members may serve additional three-year terms.
- (b) Three members shall be faculty members elected by the faculty senate. One faculty member shall be from the college of engineering and one shall be from mathematics or the natural sciences.

(c) Three members shall be appointed by the president.

(2) Duties

(a) The committee will review the merits of the invention and make recommendations to the president for the management of the invention, including its development, patenting, and exploitation.

(b) The committee shall make an initial determination of whether the university or any other party has rights to the invention and, if so, the basis and extent of those rights.

(c) If the committee determines that the university has rights to the invention, the committee will make one of the following recommendations to the president:

(i) The university should pursue legal protection of the invention, through patent or otherwise, and seek commercial development of the invention;

(ii) The university should dedicate its rights to the public, adhering to the wishes of the inventor or creator where feasible; or

(iii) The university should transfer or waive its rights in favor of permitting the inventor or creator to protect and develop the invention at his or her own expense, and whether and what conditions should be attached to a transfer or waiver. At a minimum, such a transfer shall be subject to the retention of a non-transferrable, royalty-free license in favor of the university to be used in connection with the university's mission of teaching, research and service.

- (d) The committee, on at least an annual basis, or more frequently, shall review the patent policy as a whole and recommend changes to the contract implementation committee.
- (e) If there are two or more claimants to an invention within the university and they cannot reach an agreement as to how to share the benefits of this policy, the committee shall recommend to the president which of the competing claimants shall be considered inventors or creators for the purpose of this policy and in what fraction they shall share in the benefits of the policy.

(G) Duties of the office of research

The office of research will have the following duties related to the patents policy:

- (1) Upon request, provide advice and assistance to researchers with respect to consulting agreements with industrial and other organizations that may involve rights to inventions within the scope of this policy and provide advice and assistance to university officials who have responsibilities with respect to the approval of the consulting arrangements;
- (2) Maintain a file for each invention disclosure and each notice and statement with respect to inventions that the faculty member is claiming were not supported by the university. Each file will contain a complete record of all actions;
- (3) Determine the form, detail, and supporting information required for disclosure of inventions and provide notice of these requirements to the university community and to individual inventors.
- (4) Where there are two or more persons associated with the university claiming to be inventors or creators of an invention in which the university has rights, encourage and facilitate an early agreement (in a form acceptable to the

university) among those persons concerning which of the claimants shall be considered inventors or creators for the purposes of this policy and in what fraction each shall share in the benefits of the policy;

- (5) Assist the office of general counsel in obtaining legal protection and arranging for licensing or other commercial development in those cases in which the university elects to pursue its rights, including preparing and prosecuting applications for patent, plant variety protection, and other legal protection; negotiating or assisting in negotiation of licenses and related agreements; and monitoring the collection of royalties or other related income; and
- (6) Prepare or assist in the preparation of all required reports on inventions.

(H) Sponsored research

- (1) All rights to inventions resulting from sponsored agreements shall be controlled by the terms of those agreements. Before accepting funding and conducting research activities under any sponsored research agreement, faculty members, other employees and students shall be fully informed by the office of research of the terms of such agreements. Faculty members and other employees accepting support through sponsored research agreements shall be required to execute such agreements as will enable the university to conform with the requirements of the sponsoring agencies and shall abide by the terms of such agreements.
- (2) When the university and an external sponsor enter into an agreement for research to be conducted with funds or facilities provided in whole or in part by external sponsors, any person who elects to conduct such research may be required by the university to enter into an agreement assigning all rights to inventions arising from such research to the university or to the external sponsor.

- (3) No person may enter into any agreement respecting the assignment, licensing, or exploitation of any patent or other rights to any invention developed in the course of research supported by funds or utilizing facilities administered by the university pursuant to an agreement with an external sponsor without the written consent of the office of research. Such consent shall be given or withheld in accordance with the objectives set forth in this policy.

(I) Rights to inventions and patents

- (1) All rights with respect to inventions from research activities of faculty members, other employees, and students of the university that are supported by the university or by university facilities, equipment, or resources shall be assigned to and controlled by the university.
- (2) All rights with respect to inventions resulting from personal and independent research activities that are not supported by the university or by university facilities, equipment, or resources shall be the sole property of the inventor.
- (3) Upon request of the patent review committee or the office of research, the appropriate university department chair or dean shall investigate and report to the requesting party the extent to which university facilities and resources were used to support research activities resulting in an invention disclosed in accordance with this policy.
- (4) All rights to inventions resulting from sponsored research grants, contracts, fellowships, or special arrangements shall be controlled by the terms of those agreements. Faculty members, other employees, and students accepting sponsored research grants shall execute such agreements in a manner that will enable the university to conform with the requirements of the sponsoring agencies and shall abide by the provisions of such agreements and the sponsored research section of this policy.

(J) Distribution of income

- (1) At the time that the invention disclosure form is filed with the office of research, the inventor shall assign all rights to the invention or discovery to the university and shall elect a patent expense payment and income distribution option as provided in schedule A or schedule B.
- (2) Schedule A: all patenting costs are paid by the inventor(s) prior to distribution of income. No university funds may be used to pay patenting costs.

| Cumulative Net Income Range | Income distribution | |
|-------------------------------|---------------------|------------|
| | Inventor | University |
| Up to \$50,000 | 90% | 10% |
| Amount greater than \$50,000 | 75% | 25% |
| Amount greater than \$100,000 | 50% | 50% |

- (3) Schedule B: All costs of patenting are paid by the university prior to distribution of any income.

| Cumulative Net Income Range | Income distribution | |
|-------------------------------|---------------------|------------|
| | Inventor | University |
| Up to \$50,000 | 50% | 50% |
| Amount greater than \$50,000 | 40% | 60% |
| Amount greater than \$100,000 | 25% | 75% |

- (4) Net income to the university resulting from intellectual property, including patents developed by members of the university faculty, will be reinvested in faculty development and administered by the university research council (URC).
- (5) Determination of net financial returns as used in this policy shall be made by the office of research for the university in accordance with generally accepted accounting principles.

- (6) Where rights to an invention are transferred or waived to the inventor, the allocation of these rights and any resulting future income shall be specified in writing by the office of research and approved by the president. A copy of the transfer or waiver shall be promptly supplied to the inventor.

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