

# CLARK ATLANTA UNIVERSITY

## Policy 11.2 – Intellectual Property Policy



CLARK ATLANTA UNIVERSITY		
<b>POLICY/PROCEDURE</b>	<b>Subject:</b> <b>Policy 11.2 – Intellectual Property Policy</b>	
<b>Department:</b>  <b>Division of Research and Sponsored Programs</b>	<b>Review Date:</b> <b>08 Oct 2009</b>	<b>Issued By:</b> <b>Marcus W. Shute, P.E., Ph.D.</b>
	<b>Effective Date:</b> <b>16 Oct 2009</b>	
	<b>Modified Date:</b> <b>N/A</b>	
<b>Distribution:</b>  <b>University-wide Community</b>	<b>Approved By:</b> <b>President Carlton E. Brown, CAU Compliance Committee</b>	<b>No. of Pages: 9</b>

# CLARK ATLANTA UNIVERSITY INTELLECTUAL PROPERTY POLICY

## 08 Oct 2009

---

---

### Preamble

This Intellectual Property Policy comprises both a patent policy and a copyright policy. It is intended to replace the University's patent policy and copyright policy published in Section 2.12.2.2 and Section 2.12.2.3, respectively, of the current Faculty Handbook (October 2004 version).

---

---

## 100.00 INTELLECTUAL PROPERTY

As a leading research institution, Clark Atlanta University (CAU) through the Division of Research and Sponsored Programs encourages the faculty, research scientists, postdoctoral associates, staff, students, and volunteers to engage in research activities and creative work that lead to inventions, innovation, discoveries, and copyrightable works that are patentable, copyrightable or qualify for a trademark, technology transfer, and that fosters the general development of intellectual property. Consistent with the Bayh-Dole Act of 1980 (P.L. 96-517), it is also the policy and responsibility of CAU and other affiliated organizations, such as a university-connected research corporation, to encourage the use of such discoveries, inventions, and copyrightable works for the good of the public and to provide equitable distribution between CAU and the investigator/inventor/author(s) of net licensing revenue resulting from the commercialization of novel discoveries, inventions, and copyrightable works that the University owns in whole or in part. The University remains committed to academic freedom. More information about patents can be found on the [United States Patent and Trademark Office website](#). A detailed discussion on copyright protection, including definition and use, can be found in the *Copyright Basics* document (found on the [RSP website](#)) developed by the United States Copyright Office of the Library of Congress. More information about copyrights can also be found on the [United States Copyright Office website](#).

### 100.05 RESEARCH

The term research as used in this policy shall include all research and creative work conducted in the course of a person's employment with CAU or other affiliated organizations such as a university-connected research corporation (including but not limited to the performance of a grant, contract or award made internally or by an extramural agency), or any research or creative work activity conducted with the use of CAU or other University-affiliated resources.

### 100.10 APPLICABILITY

This policy applies to all discoveries, developments, inventions, or copyrightable works made by persons employed (either as full-time, part-time or temporary employees) by CAU or affiliated organizations, research scientists, visiting scientists, postdoctoral associates, students, volunteers, and other persons using University facilities and resources if such discoveries, inventions, and copyrightable works are:

(1) a result of research investigations or creative works performed by or under the direction of any faculty member, research scientist, visiting scientist, postdoctoral associate, staff, student, trainee

or volunteer of the University or affiliated organizations of which the cost was partially or wholly paid for with funds under the control of or administered by the University or affiliated organizations, or

(2) a result of efforts by a CAU faculty member, research scientist, postdoctoral associate, staff, student, trainee or volunteer utilizing CAU or affiliated organizations facilities, laboratories or other resources available to such faculty member, research scientist, visiting scientist, postdoctoral associate, staff, student, trainee or volunteer because of their status within CAU or University-affiliated organizations, or

(3) a result of efforts undertaken within the scope of an individual's employment or affiliation with CAU or a University-affiliated organization as a faculty member, research scientist, visiting scientist, postdoctoral associate, student, trainee, or volunteer, or

(4) in the case of copyrightable works, "works made for hire" as defined in the U.S. Copyright Act, Title 17, United States Code, or scholarly works created through the significant use of University or a University-affiliated organization's resources.

Contracts between CAU or affiliated organizations, and independent contractors or third parties should define the respective rights and responsibilities of the parties with respect to ownership of any intellectual property developed as a result of the contract. CAU personnel are required to obtain assignment of ownership rights for all intellectual property and copyrightable materials from all CAU commissioned contractors.

### **105.00 RESPONSIBILITY FOR UTILIZATION**

The factors to be considered in establishing the responsibility for the utilization of any invention, discovery, or intellectual property as well as sharing of the proceeds are:

- The University sponsorship of the project leading to the invention, discovery, technology transfer or intellectual property;
- Significant use of the University's facilities, services or equipment in the discovery or production process;
- Work performed within the scope of an individual's employment or affiliation with CAU or a University-affiliated organization as a trainee, student or volunteer, and
- Sponsorship of the project through the University by agencies or persons outside the University.

In the event that any one of these factors exists, the University shall have an ownership interest—in whole or in part, as the case may be—in the invention, discovery, copyrights, trademarks, or other intellectual property. The University's interest shall not be affected by whether or not the person continues to be employed by the institution after University resources are committed to the project. With the exception of those patent rights specifically dictated by a sponsored research grant, contract, or cooperative agreement, the University claims sole ownership and control of the worldwide patent rights that result from the activities of its faculty, research scientists, visiting scientists, postdoctoral associates, staff, students, trainees and volunteers, if those activities were undertaken within the scope of the individual's employment or affiliation with the University. The University claims sole ownership and control of the worldwide copyrights to all works made for hire.

### **110.00 REQUIRED DISCLOSURES**

Inventions, discoveries, copyrightable works, and other developments conceived or first reduced to practice in the furtherance of research and creative work conducted by the University and personnel, as defined in Section 100.10 above, shall be promptly disclosed in writing to the Division of Research and Sponsored Programs. While the University remains committed to academic freedom and the free dissemination of ideas and knowledge, it is important to disclose potential inventions prior to such dissemination. The standard disclosure and assignment form provided by the University (Invention Disclosure or Copyrightable Work Disclosure, and CAU Patent and Copyright Assignment form) should be used for this reporting process and may be obtained from the [RSP website](#). Graduate students, research scientists, visiting scientists, and postdoctoral associates are responsible for disclosure if inventions, discoveries, copyrightable material and trademarks directly result from class work or programs of study, University sponsored research, or if significant University resources were utilized.

### **115.00 OWNERSHIP OF INTELLECTUAL PROPERTY**

All rights to and interests in discoveries, developments, inventions, copyrightable works, or other intellectual property resulting from research or investigation or work conducted in the course of the author's, discoverer's or inventor's employment (including research scientists, postdoctoral associates, students, volunteers and trainees) with CAU or affiliated organizations (including but not limited to the performance of a grant, contract or award made internally or by an extramural agency) or with the significant use of University resources shall be the sole and exclusive property of CAU, and no other person or entity shall have any rights of ownership or interest in such discoveries, inventions, copyrightable works, or intellectual property. Any and all exceptions to this policy shall be determined and approved by the President upon the recommendation of the Vice President of Research and Sponsored Programs, in consultation with an ad hoc advisory committee, if necessary.

Intellectual property developed outside an employee's scope of employment, on the employee's own time, and without the use of significant University resources shall be the sole and exclusive property of the Inventor or Author. In consideration of University support in evaluating the intellectual property, seeking patent protection or pursuing commercialization activities, the University and the Inventor or Author may agree to assign all or a portion of the ownership rights to his or her invention or work to CAU.

The University will not assert ownership of "scholarly works" except those activities and works that were institutionally required, commissioned, or performed or prepared as an expected and essential component of the position held, or involved significant use of University resources. Disclosure of "scholarly works" is nonetheless required, subject to the condition that only those copyrightable works that could reasonably be expected to have commercial value must be disclosed. The creator grants and the University retains a "shop right" in these scholarly works. A "shop right" includes the right of perpetual, royalty-free, non-exclusive use of the works within the University for educational and research purposes. The creator may not use University resources to commercialize or publish a "scholarly work" without a written agreement with the University. Creators of scholarly works are strongly encouraged to clarify issues of ownership and revenue sharing by specific written agreements with the University at the outset of the project or otherwise as soon as practicable.

In the cases of course material and content created or packaged for electronic delivery of CAU courses for distance education, online, or web-based education with significant use of University resources or within the scope of employment, CAU will retain ownership of the intellectual

property rights through assignment of the intellectual property rights to the University by the creator. The rights to derivative digital and electronic works also rest with the University.

The University claims no right in or to any invention originated by faculty, research scientists, post-doctoral appointees, staff, and students as a result of a disclosed and approved consulting engagement if it was conceived and first reduced to practice without the significant use of University resources. All are encouraged to disclose inventions made in the course of consulting to the University to determine if such conditions are met.

## **120.00 RIGHTS AND OBLIGATIONS OF THE PARTIES**

All rights to and interests in discoveries, inventions, copyrightable works, or intellectual property arising in the course of research or investigation sponsored by CAU or university-affiliated organizations, any government or private agency or other sponsored research are controlled by the terms of the applicable sponsored program agreement, which must be reviewed, negotiated and approved by the Division of Research and Sponsored Programs prior to execution. In the absence of provisions to the contrary contained in any such sponsored program agreement, the following shall apply.

### **120.05 INVENTOR RIGHTS**

The inventor has the right to: (1) receive notice within a reasonable time of the University's intention to file a patent application or otherwise to retain title to the discovery or invention after disclosure to the University of a discovery or invention; (2) receive a share of any licensing fees or royalties received by the University from the commercialization of the discovery or invention according to the distribution schedule contained in Section 135.00 of this Policy; (3) receive from CAU title to any discovery or invention subject to this Policy in the event CAU elects not to retain title; and (4) timely publication of their research findings.

### **120.10 INVENTOR OBLIGATIONS**

The inventor is obligated to: (1) report promptly to the Division of Research and Sponsored Programs typically through the Office of Technology Transfer and Licensing by the preparation of an Invention Disclosure, a summary of the concepts, relevant data, observations and general claims with respect to any invention, discovery or development, as well as the name(s) of any collaborator(s); (2) assign title to the discovery or invention to the University; and (3) cooperate to the extent necessary as determined by the University in reasonably delaying of publication to allow for submission of a patent application, prosecuting all patent applications and other required documents, participating in the defense of such patents during prosecution for interference or infringement, and assisting with licensing or marketing efforts related to the discovery or invention.

### **120.15 UNIVERSITY RIGHTS**

CAU has the right to: (1) assign to the inventor title to any invention, discovery or development subject to this Policy for which CAU chooses not to retain title; and (2) make, use, license, assign or sell to a third party the rights and interests of any patented or unpatented discovery, invention or development owned by CAU, and exclude others from doing so.

### **120.20 UNIVERSITY OBLIGATIONS**

CAU shall: (1) make faculty, research scientists, visiting scientists, postdoctoral associates, staff, students, trainees and volunteers aware of this Policy and of any ongoing agreements with external

sources to evaluate or market such discoveries and inventions; (2) after a discovery, invention or development is reported, act in a timely fashion to determine whether CAU chooses to retain title, to submit to an external source for evaluation, or determine whether a patent application is to be filed; (3) give notice to an inventor, within a reasonable time after disclosure of a discovery or invention, of the University's decision to file a patent application or otherwise retain title to the discovery, invention or development; (4) expedite intellectual property protection so as to minimize the delay of publication; and (5) distribute licensing fees or royalties received by the University for any discovery, invention or development according to the schedule contained in Section 135.00 of this Policy.

### **120.25 INTELLECTUAL PROPERTY PROCEDURES**

The Vice President of Research and Sponsored Programs (VPRSP) with the assistance of the staff in technology transfer and licensing, General Counsel, Provost, and an ad hoc advisory committee approved by the President, if necessary, will:

- advise the President on all matters relating to the intellectual property;
- conduct investigations to assess the rights and responsibility of all parties involved in the process;
- receive all disclosures made by employed members of the University community, students, and volunteers concerning all inventions, discoveries, copyrightable works, and intellectual property, and
- act expeditiously to determine the extent to which the invention, discovery, copyrightable works, or intellectual property resulted from University sponsorship or external funding sources, or as a result of the author's, discoverer's or inventor's employment or association with CAU (e.g., student, research scientist, visiting scientist, postdoctoral associate, volunteer, trainee) or affiliated organizations or with the significant use of University resources.

In the event the determination is made that no University sponsorship, external funding or significant use of University resources was involved, and the work did not result from activities performed within the scope of employment or association with CAU, the VPRSP shall advise the University to waive all claims. If not, the VPRSP shall determine the terms of the modification of the sponsorship agreement, intellectual property agreement, or licensing agreement as it relates to patents and copyrights, and so advise the President.

In evaluating inventions, discoveries, intellectual property, filing patents and copyrights applications, licensing, administration of patents and copyrights, the University may obtain legal and technical assistance or external services from independent patent and copyright organizations.

### **125.00 APPEALS**

The Inventor or Author may appeal decisions of the VPRSP or those of his or her designee. If the Inventor or Author disagrees with an initial decision, he or she may request a reevaluation by the President. The request must be received within thirty calendar days of notification to the Inventor or Author of the initial decision. The Inventor or Author may submit documents or other evidence in support of his or her position. A second and final decision by the President relating to ownership or royalty distribution shall be binding.

### **130.00 LICENSING**

It is the policy of the University to encourage the development, marketing and commercialization of inventions resulting from research so as to achieve a public usefulness and benefit. It is recognized

that such a policy may require various forms of agreements including the granting of exclusive licenses.

The University may, in appropriate circumstances with due consideration to the perspective licensee and when consistent with law applicable to federally supported research, license a patented invention on an exclusive or nonexclusive basis for a reasonable period up to the full term of the patent, provided that such license shall contain provisions to promote the likelihood that the invention provides a public benefit, such as a requirement of due diligence and march-in rights when the licensee does not adequately perform. CAU also may elect to license unpatented technology on an exclusive or nonexclusive basis.

**135.00 DISTRIBUTION OF PROCEEDS**

For all discoveries, inventions, copyrightable works, or developments for which CAU receives proceeds, CAU shall deduct all expenses incurred pertinent to the technology and not recovered previously for patent protection, copyright registration, or in pursuing commercialization of the intellectual property.

The remaining net revenue shall be distributed as set forth below:

<b>Cumulative Net Lifetime Revenue</b>	<b>Inventor*</b>	<b>Division‡</b>	<b>University and/or Affiliated Org.</b>
0-\$100K	50%	10%	40% (15% - RSP)
>\$100K	40%	15%	45% (15% - RSP)
*Inventor(s) retain the option of designating some fraction of these funds to support their laboratory research program.			
‡In the event the Division is dissolved, this fraction reverts to the University and/or University-affiliated organization.			

The University is authorized, subject to the approval of the President, to accept equity in lieu of cash in total or partial consideration for use of the University’s intellectual property rights. Dividend income and income received from the sale of equity shall be divided in accordance with the distribution rules adopted by the University.

**140.00 DEFINITIONS**

"Author" means the person or persons responsible for creation of a copyrightable work.

"Copyrightable Work" means an original work of authorship that has been fixed in a tangible medium of expression, as defined by United States copyright law, and which can be protected under copyright law or any statute enacted in the future that governs the protection of intellectual property and is based on principles similar to the principles governing copyright.

“Cumulative Net Lifetime Revenue” is defined as gross income or other payments received by the University from a licensed technology minus applicable patent filing fees, other legal fees associated with the technology, fees for patentability and marketability searches, fees arising out of litigation, legal advice or any other fees or costs directly attributable to the invention being licensed. Indirect costs, overhead or other costs usually associated with operation of the University and not directly attributable to the invention shall not be deducted from gross income.

"Division" is the administrative subdivision, i.e. school or center, of the University that provided the environment in which the research program(s) of the inventor(s) is (are) conducted.

"Gross Income" means proceeds from the sale, lease, or licensing of intellectual property by the University; dividends derived from equity received in consideration for the sale, lease, or licensing of intellectual property by the University; or proceeds from the sale of equity received in consideration for the sale, lease, or licensing of intellectual property by the University.

"Intellectual Property" means inventions and works; creations of the mind - creative works or ideas embodied in a form that can be shared or can enable others to recreate, emulate, or manufacture them. There are four ways to protect **intellectual property** - [patents](#), [trademarks](#), [copyrights](#) or [trade secrets](#).

"Invention" means any discovery, invention, improvement, new use or application, process, composition of matter, article of manufacture, know-how, design, model, technological development, or biological material.

"Inventor" means the person or persons responsible for conception of an idea or ideas leading to an invention. An individual or individuals who has (have) made a contribution to the conception or reduction to practice of an invention, discovery, improvement, or development and who is (are) identified as such on the licensed patent, patent application or unpatented technology. In the case of a patent or patent application, this contribution must be applicable to at least one claim. In cases of joint inventorship, it is not necessary that each inventor make the same type or amount of contribution to the invention and it is not necessary that each inventor make some contribution of each claim. The University reserves the right to utilize outside counsel or other means to resolve inventorship disputes.

"Net Income" is gross income minus the direct costs associated with patent prosecution, copyright registration, commercialization, defense, maintenance, and administration of intellectual property.

"Scholarly works" include, but are not limited to, articles written for publication in academic journals, books (including textbooks), artistic expressions, musical compositions, and literary works, the intended purpose of which is to disseminate the result of academic research and scholarly study. Works by non-faculty employees performed within the scope of their duties as administrative employees shall not, for the purposes of this policy, be considered scholarly works. Such works are works made for hire.

"Scope of employment" refers to the various activities that may occur in the performance of a person's job, especially those acts that are reasonable relative to the job description and position title as determined by the employer.

"Shop right" includes the right of perpetual, royalty-free, non-exclusive use of the works within the University for educational and research purposes.

"Significant Use of University Resources:" The following provisions provide guidance in determining the "significant use of University resources." "Significant use of University resources" in the creation of a discovery, invention, or copyrightable work ("the Work"), resulting in the University being the Owner of the Work, includes, but is not limited to the following situations:

- The University and the Inventor/Author (whether faculty, research scientist, postdoctoral associate, staff, student or volunteer) agree to create the Work, in whole or in part, as part of a specific grant, contract, appointment or assignment.
- The Work is produced through the use of University facilities (e.g., office space, libraries, secretarial and support staff, computers or other University facilities or equipment). Such facilities and services the use of which constitutes significant use include, but are not limited to, laboratories, studios, equipment, production facilities, specialized computing resources, or special expertise of University-employed individuals.
- The University provides significant funding in direct support of the Work's creation.
- The Work is significantly based upon material that is proprietary to the University, regardless of whether the creator produced such proprietary information.
- The Work is produced under the specific terms of a sponsored research grant, cooperative agreement, or contract.

“Work Made for Hire” refers to a work prepared by an employee (faculty, research scientist, visiting scientist, postdoctoral associate, staff, student, trainee or volunteer) within the scope of his or her employment. The employer or other person for whom the work was prepared is considered the author for purposes of the U.S. Copyright Act, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright. Please refer to the U.S. Copyright Act for a more comprehensive treatment of this issue.

### **ACKNOWLEDGMENTS**

Portions of this intellectual property policy were derived from the policies of the Cincinnati Children's Hospital Medical Center and the Association of University Technology Managers.

MWS 08 Oct 2009  
CAU IP Policy.doc