

**WILKES UNIVERSITY INTELLECTUAL PROPERTY POLICY:
RECOMMENDATIONS OF THE IP TASK FORCE**

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1. Purpose

Wilkes University (hereinafter the “University”) strives to cultivate an intellectual environment that encourages and rewards creative effort and innovation. This policy is intended to foster creativity while protecting the legitimate rights of all parties that contribute to the development of intellectual property at the University. By assuring that intellectual property is evaluated for its potential exploitation and is afforded timely protection, this policy seeks to assure the benefits of such property to authors, creators, and inventors and to the University.

2. Definitions

2.1. Author or Creator. Author or Creator shall mean the individual(s) responsible for producing a written, scientific, industrial, or artistic work that may give rise to intellectual property that may be subject to the provisions of section 3, below.

2.2. Contractor. Contractor shall mean any individual or entity with whom or which the University enters into a contract to provide goods or services and such individual is not Faculty, Staff, or Student.

2.3. Faculty. Faculty shall have the meaning given it by the *Faculty Handbook* of the University.

2.4. Intellectual Property. For purposes of this policy, intellectual property (hereinafter “IP”) shall mean the legal rights and responsibilities which result from intellectual activity in the industrial, scientific, literary, and artistic fields, including inventions, copyrightable works, research data, tangible research materials, trade secrets, and software. For this purpose, IP shall include all property subject to protection under the laws of the United States governing patents, trademarks, and copyrights.

2.5. Inventor. Inventor shall mean any individual(s) associated with the University, whether member(s) of the Faculty, member(s) of the Staff, Student(s), or Contractor(s), who is responsible for a discovery or invention that constitutes IP, including IP that may be subject to the provisions of section 3, below. In case of any invention for which a patent application is filed, the determination of inventorship shall be in accord with the U.S. patent laws.

2.6. Software. Software shall mean computer programs (with or without associated hardware), whether eligible for copyright protection, patent protection, or both.

2.7. Staff. Staff shall mean any employee of the University other than members of the Faculty.

2.8. Student. Student shall mean an individual who is enrolled as a student at the University, whether or not a candidate for a degree and whether or not for academic credit.

3. Ownership of Intellectual Property

3.1. General Rule - Copyright and Trademark.

3.1.1. Faculty and Students. The Author or Creator shall be the owner of all copyrights and trademarks (including but not limited to software) created by member(s) of the Faculty or Student(s) subject to the exceptions provided in section 3.2.1.

3.1.2. Staff and Contractors. The University shall be the owner of all copyrights and trademarks (including but not limited to software) created by members of the Staff or Contractor(s) in the course of performing services for which they were hired by the University. At the request of the University, Author(s) or Creator(s) shall execute assignments or other documents assigning to the University all rights in copyrights and trademarks; to the extent such copyrights or trademarks are not subject to any exception set forth in Section 3.2.2 below. Any obligation to assign ownership of copyrights or trademarks resulting from contract work must be explicitly expressed in the contract and must receive approval of the Provost.

3.2. Copyright and Trademark Exceptions.

3.2.1 Faculty and Students. The University shall be the owner of all copyrights and trademarks (including but not limited to software) created by member(s) of the Faculty or Student(s) where any of the following conditions apply:

- A. The University has expressly contracted with the member(s) of the Faculty or Student(s) to create the material subjected to copyright or trademark; or
- B. The material subject to copyright or trademark is created as a specific requirement of employment or an assigned institutional duty [i.e., performed as "work for hire"]; or
- C. The member(s) of the Faculty or Student(s) has voluntarily transferred the copyright or trademark, in whole or in part, to the University; or
- D. The material subject to copyright or trademark was created with extraordinary use of University resources.

3.2.2. Staff and Contractors. Member(s) of the Staff or Contractor(s) shall be the owner of all copyrights and trademarks (including but not limited to software) created by the Staff or Contractor(s) where any of the following conditions apply:

- A. The member(s) of the Staff or Contractor(s) has expressly contracted with the University to create the material subject to copyright or trademark and the University has agreed to provide the member(s) of the Staff or Contractor(s) with all or some proprietary interest in the copyright or trademark; or
- B. The University has voluntarily transferred the copyright or trademark, in whole or in part, to the member(s) of the Staff or Contractor(s); or

- C. The material subject to copyright or trademark was created outside the scope of employment or contract by the member(s) of the Staff or Contractor(s).

3.3. General Rule – Patent.

3.3.1. Faculty and Students. The University shall be the owner of all patents and patent applications that disclose and claim inventions (including but not limited to software inventions) made or conceived by member(s) of the Faculty or Student(s) subject to the exceptions provided in section 3.4.1.

3.3.2 Staff and Contractors. The University shall be the owner of all patents and patent applications that disclose and claim inventions (including but not limited to software inventions) made or conceived by member(s) of the Staff or Contractor(s) in the course of performing services for which they were hired by the University, subject to the exceptions provided in section 3.4.2. Any obligation to assign ownership of patents resulting from contract work must be explicitly expressed in the contract and must receive approval of the Provost.

3.3.3. Execution of Documents. At the request of the University, the Inventor(s) shall execute assignments or other documents assigning to the University all rights in patents; to the extent such patents are not subject to any exception set forth in Sections 3.4 below.

3.4. Patent Exceptions.

3.4.1. Faculty and Student. Member(s) of the Faculty or Student(s) shall be the owner of all patents and patent applications that disclose and claim inventions (including but not limited to software inventions) made or conceived by member(s) of the Faculty or Student(s) where any of the following conditions apply:

- A. Member(s) of the Faculty or Student(s) has expressly contracted with the University to invent or discover the subject matter to which the patent and/or patent application is directed and the University has agreed to provide member(s) of the Faculty or Student(s) with all or some proprietary interest in the patent or patent application; or
- B. The University has voluntarily transferred the patent or patent application, in whole or in part, to the member(s) of the Faculty or Student(s); or
- C. The subject matter of the patent or patent application was invented or discovered by the member(s) of the Faculty or Student(s) outside the scope of employment of the Faculty member or outside the scope of the Student relationship to the University; or
- D. The University actually or constructively abandons the patent or patent application or commercialization of the patent or patent application by failing to take all appropriate actions in a timely and reasonable manner. In such a case the University shall execute all appropriate documents to vest ownership of the patent in the member(s) of the Faculty or Student(s).

3.4.2. Staff and Contractor. Member(s) of the Staff or Contractor(s) shall be the owner of all patents and patent applications that disclose and claim inventions (including but not limited to software inventions) made or conceived by the Staff or Contractor(s) where any of the following conditions apply:

- A. The member(s) of the Staff or Contractor(s) has expressly contracted with the University to make the subject matter of the patent or patent application and the University has agreed to provide the member(s) of the Staff or Contractor(s) with all or some proprietary interest in the patent or patent application; or
- B. The University has voluntarily transferred the patent or patent application, to the member(s) of the Staff or Contractor(s); or
- C. The subject matter of the patent or patent application was made or conceived by the member(s) of the Staff or Contractor(s) outside the scope of employment or contract.

4. Administration of the Policy.

4.1. Intellectual Property Committee. The Intellectual Property Committee (the “IPC”) shall be responsible for the administration and management of the University intellectual property policy. Additionally, the IPC shall act as an advisory committee to the Provost.

4.2. Membership and Duties of the Intellectual Property Committee. The Provost shall appoint one member of the Provost’s staff and one unit dean to serve on the IPC. In addition, each college or school shall either appoint or elect one full-time faculty member to the IPC. A majority of the committee shall constitute a quorum for all actions of the committee. The duties of the IPC shall be:

- A. To receive and to review all disclosures of intellectual property invented or created by member(s) of the Faculty, member(s) of the Staff, Contractor(s), or Student(s).
- B. To determine whether University-owned IP merits the investment of University funds for further external assessment as to patentability, enforceability, and likelihood for commercial success, including commercialization as a trade secret.
- C. To make recommendations, within a period of 90 days of receipt of a disclosure, the 90-day period optionally being eligible for extension subject to the approval of the Provost by not longer than an additional 90 days, as to whether the University should exploit the disclosed IP or cede the IP to the Author(s), Creator(s), or Inventor(s) if the IP is not to be exploited by the University and to communicate such recommendations to the Provost and to the Author(s), Creator(s), or Inventor(s).
- D. To facilitate the transfer of relevant information to professionals retained by the University to prosecute a patent or to license or market IP that the University has chosen to exploit.
- E. To apportion costs and benefits attendant to the exploitation of IP if the IP is to be exploited by the University.
- F. To monitor the timely payment of maintenance fees related to any patents issued to the University.
- G. To assist with developing, implementing, and monitoring processes that the University uses to inform and to educate the Wilkes community about IP.
- H. To play an advisory role in contract negotiations between the University and third parties when IP is involved, or is expected to be involved.

4.3. Duties of the Provost. The Provost shall be responsible for the following:

- A. Considering requests for permissions to use University-owned IP pursuant to section

4.4[C], below.

- B. Making decisions, taking into consideration any pertinent IPC recommendations under Section 4.2[C], as to whether the University should exploit the disclosed IP or otherwise cede the IP to the Author(s), Creator(s), or Inventor(s) if the IP is not to be exploited by the University based upon the recommendation of the IPC, and to communicate such decisions to the IPC and to the Author(s), Creator(s), or Inventor(s).

4.4. Duties of Author, Creator and Inventor. Author(s), Creator (s) and Inventor(s) shall, to the extent consistent with this policy, do the following:

- A. Disclose promptly the creation of University-owned IP to their respective supervisor (in the case of member(s) of the Staff), or department chair (in the case of member(s) of the Faculty), or instructor (in the case of Student[s]). Furthermore, in the case of member(s) of the Faculty, disclosure may take the form of information shared on an annual basis in connection with the faculty self-evaluation report (as defined in the *Faculty Handbook*). Supervisors, department chairs, and instructors shall promptly notify the IPC of the creation of University-owned IP. Such disclosure shall include disclosure of the identity(ies) of all individuals involved in the process that produced the work.
- B. Cooperate in the preparation, filing, and prosecution by University of any and all applications, instruments and other documents to perfect IP rights, including patent applications and assignments of rights, and including instruments necessary to protect the rights of the University and/or the U.S. government.
- C. Refrain from using University-owned IP without first obtaining the consent of the University.

5. IPC Review Process. When University-owned IP is sufficiently developed by the Author(s), Creator(s), or Inventor(s), the IPC will, in accord with its duties under Section 4.2[C], determine if the IP merits an investment of University funds for further external assessment as to patentability, enforceability, and likelihood for commercial success. If the IPC concludes that IP does have commercial viability, the IPC will determine the likelihood of profiting from exploitation of the IP. After those determinations have been made, the IPC will submit a recommendation to the Provost, who may then authorize the University, acting with the considered input of the IPC, to do any of the following:

- A. Assign any or all of its rights, see sections 3.2.2[B], 3.4.1[B] and 3.4.2[B] above, to the Author(s), Creator(s), or Inventor(s).
- B. Proceed with exploitation of the IP by securing copyright, trademark, or patent protection and by developing and pursuing a plan for commercializing the IP. All costs associated with this process (hereinafter referred to as “Start Up Expenses”) shall be advanced by the University. Profits produced by the commercial venture contemplated by the commercialization process will be used first to reimburse the University for all Start Up Expenses. Thereafter, net income from the commercial venture (meaning revenues less all operating expenses) shall be allocated to the University and the Author(s), Creator(s), or Inventor(s) as follows: 50% to the University (to be applied in equal parts to the University general fund and to the Provost’s fund for research) and 50% to the Author(s), Creator(s), or Inventor(s). The IPC shall also have authority to consider requests from Faculty, who have been approached by Student(s) about inventions not subject to this

policy, for University sponsorship similar to that described in this section. In cases where the IPC decides that the University should move forward with a patent application that is fully or partially owned by the University, the University may require a delay of at least 90 days before the IP can be publicly disclosed or submitted to any third party including for purposes of any form of disclosure.

6. Appeals. An individual who is subject to this policy shall have the right to appeal any decision of the Provost with respect to such IP to the President. Such appeal shall be initiated in writing upon receipt of the decision rendered by the Provost. The appeal shall include detailed facts supporting the requested change in the decision. The President shall consider the information included in the appeal. The President's decision shall be final and may be communicated to the appellant.

7. Fees & Costs. Fees and costs incurred in connection with any dispute surrounding the application of this policy shall be borne by the respective parties to that dispute.