

INTELLECTUAL PROPERTY POLICY

Purpose

This policy establishes guidelines to support faculty, staff, and students in identifying, protecting, and administering intellectual property ("IP") and defines the rights and responsibilities of all involved. It is intended to encourage creative output and facilitate the creation, development, management, protection, and dissemination of discoveries and intellectual property at the University of Mary. Nothing in this policy may be construed to jeopardize the University's tax-exempt status or to require the University to take any action that may do so.

Statement of Policy

Definitions

Creator: a person who contributes in a significant manner to the development of intellectual property.

Intellectual property or IP: collectively, any form of property created by the mind, including but not limited to inventions, trade secrets, copyrights, trademarks, mask works, and any other tangible research result, such as biological materials, engineering drawings, integrated circuit chips, computer databases, prototype devices, circuit diagrams, and equipment.

Invention: a process, method, discovery, device, plant, composition of matter, know-how, or other discovery that reasonably appears to qualify for protection under United States patent law, whether or not actually patentable (including but not limited to utility patents, plant patents, design patents, and certificates of plant variety protection). This includes patent-eligible software that may also be copyrightable.

Net Royalties: gross revenues, including all royalties, licensing, and other fees generated as a direct result of IP, less the actual, out-of-pocket expenses incurred in procuring and maintaining protection, marketing, licensing, and enforcing rights in such IP.

Significant Use of Resources: a creator's use of university facilities, equipment, or employees' time that appreciably increases the costs of the University beyond those normally incurred. Significant use does not include the creator's own time (including developmental leave) or the normal use of facilities or equipment commonly available to faculty, staff, or the public, such as libraries, internet access, office space, office equipment, computers, or office supplies.

General IP and Patent Policy

Except as otherwise provided in this policy and subject to restrictions arising from overriding obligations, the University shall have and hold title to all IP that is the result of any work, research, or investigation conducted by university employees in the course and scope of their employment. Upon employment and as otherwise necessary, all employees shall be required to execute an appropriate written assignment of IP to the University.

A creator who is a university employee shall make timely, written disclosure of IP that results from work, research, or investigation conducted in the course and scope of employment and which is supported or facilitated by significant use of university resources, including copyrightable works that are also patent-eligible inventions, such as software. Absent an agreement or university or

department policy or procedure establishing a different process, a creator shall make such disclosure to the Executive Vice President. The Executive Vice President shall establish a process for review of the technical or commercial viability and, if applicable, patentability of such IP within a reasonable time.

If at any time the University decides not to pursue or otherwise discontinue its protection and commercialization of any IP, the University shall notify the creator(s). In the absence of overriding obligations, the University shall, upon request of at least one creator, release its rights in such IP to the original assignor(s), subject to an obligation to reimburse the University for its actual out-of-pocket costs in the event of a commercial windfall. However, under no circumstance may the creator(s) to whom rights are released use the name of the University in connection with subsequent development, use, or marketing of the IP. Creators may request that IP rights be released, even in the absence of a prior decision by the University to discontinue protection. The University shall have the discretion to grant such a request, provided that the University may require, as a condition of the release of IP rights, that the creator(s) reimburse the University for its actual out-of-pocket costs incurred in pursuing formal protection of the IP.

Subject to terms in an employment contract, other agreement, or overriding obligations, creators, or the creator's heirs, successors, or assigns, shall be entitled to forty percent of the net royalties received by the University in connection with the creator's IP. The University shall establish procedures to allocate remaining net royalties.

When there are two or more creators, each creator shall share equally in the creators' share of net royalties unless all have agreed in writing to a different distribution of such share. The University will honor any agreement purporting to share rights and/or royalties between participating parties to the fullest extent permitted under applicable law.

Copyright Policy

An employee shall make timely, written disclosure of all original works of authorship which are supported or facilitated by significant use of university resources. Absent an agreement or university or department policy or procedure establishing a different process, a creator shall make such disclosure to the Executive Vice President.

The University shall own copyright in works prepared by its employees within the scope of employment and at the specific direction of or pursuant to an agreement with the University or a "work for hire" as defined by Section 101 of the Copyright Act (Title 17 of the U.S. Code).

Subject to terms in an employment contract, other agreement, or overriding obligations, the University is entitled to all net royalties resulting from the University's copyright ownership.

University employees shall be entitled to own copyright in works that are created through individual initiative and not as a "work for hire" or at the specific direction of the University, that are not created in the course of or pursuant to sponsored research or other agreement, and that do not involve significant use of university facilities or resources.

The University shall relinquish copyright ownership in any work that arises by operation of law and, if necessary, shall execute assignments conveying such copyright ownership to employees. However, as a condition of employment, each employee agrees that the University is entitled to a perpetual, non-exclusive, worldwide, and royalty-free license to use the work for teaching, educational, archival, and research purposes, if a work is created within the scope of employment.

As a condition of relinquishment or assignment conveying copyright ownership of such works to employees, the University shall retain a perpetual, non-exclusive, worldwide, and royalty-free license to use the work for teaching, educational, archival, and research purposes.

In the event an employee is entitled as a creator to copyright ownership of a work, or the University relinquishes copyright ownership in a work to an employee and the employee has made a significant use of resources in the creation of the work, the University may require the employee to reimburse the University for the value of such use.

Trademarks

The University shall provide for the identification and protection of the trademarks and service marks of the University, provided that commercialization and licensing activities may be delegated by contract to one or more third parties.

Student IP

The University or university employee may not require an assignment of IP rights from a student unless at least one of the following applies: (1) the student received financial support from the University in the form of wages, salary, stipend, or grant funds for the research or other activities that resulted in the development of the IP; (2) the University is contractually obligated to require such assignment; (3) the IP was developed with a significant use of resources, and the retention of such rights by the student would substantially impair a mission of the University; (4) the IP was a companion work that enabled, or was incidental to or necessary for, the practice of an invention owned by the University; (5) the student has expressly agreed to make such assignment; or (6) the IP comprises marks or logos used or intended to be used solely or primarily by the University in conjunction with the University's offering of goods or services, including but not limited to university athletics.

The University may not require a license in IP from a student unless at least one of the following applies: (1) the IP comprises copyright in a thesis or dissertation; (2) the IP arose from a multi-semester classroom project administered by a university employee, such as a senior design project, and the license is necessary for the University to continue administering the project; (3) in the absence of such license, a mission of the University would be substantially impaired; or (4) the student has expressly agreed to grant such license.

In the event an assignment required by this section is made, the student making such assignment shall be treated as a creator and shall be entitled to all of the rights and benefits of creators under this policy.

Licenses required by this section shall be non-exclusive, non-commercial, perpetual, and royalty-free, unless otherwise agreed to by the University.

Nothing in this section shall be construed to prevent a student from voluntarily entering into a relationship concerning IP with the University.

Approved

13 November 2019 by the President of the University

11 March 2021 by the Board of Trustees

18 March 2021 delivered to University Senate