

APPROVED:


Anthony G. Collins, President

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**CLARKSON UNIVERSITY
INTELLECTUAL PROPERTY POLICY**

I. PREAMBLE

It is the policy of Clarkson University (the "University") to encourage creativity and inventiveness in its faculty, staff, and students. By providing facilities, equipment, information, resources, and personnel, and by obtaining external support from public and private sources, the University strives to create an environment fostering the interests of the academic community. The University wishes to offer incentives to its faculty, staff, and students to develop scholarly and creative works and other intellectual property, which can be used for the good of the University and public at large.

II. OBJECTIVES

- 2.1 Promote the publication of scholarly works and new discoveries;
- 2.2 Encourage the full and free exchange and expression of creative and scholarly ideas and further scholarly comment within the context of the teaching, research, and public service missions of the University and applicable law and regulation;
- 2.3 Maintain and enhance the reputation of the University as a teaching and research institution;
- 2.4 Promote the public good by producing, disseminating, and, when appropriate, commercializing works of artistic, scientific, and practical value;
- 2.5 Enhance opportunities for cooperation and productive interaction with external sponsors funding University research and creative endeavors; and
- 2.6 Establish the basis on which income resulting from the commercialization of intellectual property developed by members of the University, is shared by the University, with faculty, staff, or students responsible for its creation.

cc: Susan Conry, Dean Pratt, Dean Sugrue, Dean Ahmadi, Greg Slack, Jim Manaro, Tom Langen, Human Resource

III. DEFINITIONS

Whenever used in this Policy, the following capitalized terms shall have the meanings given to them below.

3.1 Creator – each Member of the University who develops or creates Intellectual Property. An individual's status and royalty or other rights as Creator shall continue even if the individual leaves the University.

3.2 Creative Works – articles, papers, books, novels, compilations, theses, poems, texts, and other literary works; graphic designs, paintings, drawings, sculptures, musical compositions, films, photographs, choreographic works, and other visual and performing art works; architectural and engineering drawings; and all other works subject to protection under copyright law; provided, however, that the term "Creative Works" shall not include computer software or maskworks.

3.3 Intellectual Property – inventions (patentable and non-patentable), creations, innovations, discoveries, Creative Works, trade secrets, computer software, maskworks, trademarks, service marks, and tangible research property. Tangible research property is any physical item, not otherwise listed in the preceding sentence, used or generated in connection with any research, scholarly, or administrative activity conducted by any Member as part of the Members normal and customary duties or responsibilities to the University which relate to research, including notes, charts, graphs, compilations of data in any form, draft grant applications, draft or unpublished articles, computer printouts, cell lines, prototypes, constructions, video tapes, films, biological materials, integrated circuit chips, engineering and architectural drawings, etc.

3.4 Members - faculty, staff, students, and visitors of the University, whether or not compensated for their services; persons performing research or engaging in work or study utilizing University resources or facilities; and other persons contracted by the University to perform research whether or not using University resources and facilities.

3.5 Sponsored Program – any grant, contract, agreement, or similar arrangement between the University and a private or governmental sponsor furnishing funds, equipment, or other resources to support research, the creation of a Creative Work, or any other educational or scientific activity to be performed by one or more Members of the University that may result in the creation of Intellectual Property.

3.6 University Resources – facilities, library resources, equipment, funds, salary, personnel, and other resources belonging to or supplied by the University.

IV. OWNERSHIP OF INTELLECTUAL PROPERTY

4.1 Ownership of Intellectual Property

With the exception of student theses as described below in Section 4.3 (Ownership of Copyrights in Theses), rights in patentable inventions, mask works, tangible research property, trademarks, and copyrightable works, including software ("Intellectual Property"), made or created by Members including Clarkson faculty, students, staff, and others participating in Clarkson University programs, and visitors are as follows:

4.1.1 Inventor(s)/author(s) will own Intellectual Property that is:

- i) not developed in the course of or pursuant to a sponsored research or other agreement (the faculty advisor, administrative officer, or the Director of the Division of Research can advise on the terms of the agreements that apply to specific research); and
- ii) not created as a "work-for-hire" by operation of copyright law (a "work-for-hire" is defined, in part, as a work prepared by an employee within the scope of his or her employment) and not created pursuant to a written agreement with Clarkson University providing for a transfer of copyright or ownership of Intellectual Property to Clarkson University; and
- iii) not developed with University funds or use of facilities administered by Clarkson University.

4.1.2 Ownership of all other Intellectual Property will be as follows:

- i) ownership of Intellectual Property developed in the course of or pursuant to a sponsored research or other agreement will belong to the University unless specified differently in the sponsor research Agreement;
- ii) ownership of copyrightable works created as "works-for-hire" or pursuant to a written agreement with Clarkson University providing for the transfer of any Intellectual Property or ownership to Clarkson University will vest with Clarkson University;
- iii) ownership of Intellectual Property developed by faculty, students, staff, and others participating in Clarkson University programs, including visitors, with the use of funds or facilities administered by Clarkson University will vest with Clarkson University.
- iv) in cases in which the University has an ownership interest in an invention pursuant to this policy and either does not file a patent application within nine months, or fails to make a positive determination regarding pursuit of a patent within a period of six months from the date of disclosure, all of the University's rights shall be reassigned to the inventor upon request in writing to the University, subject only to such external sponsor restrictions as may apply.

4.2 Use of Resources Administered by Clarkson University

When Clarkson University faculty, students, staff, visitors, or others develop Intellectual Property while participating in Clarkson University programs using Clarkson funds or Clarkson University facilities, Clarkson University will own the Intellectual Property. If the material is not subject to a sponsored research or other agreement giving a third party rights, the issue of whether or not use was made of Clarkson University facilities will be determined by an ad-hoc committee of five selected by the Provost and composed of administration and faculty. Textbooks developed in conjunction with class teaching are excluded from the "resources used" category and not considered "works-for-hire," unless such textbooks were developed using Clarkson University-administered funds paid specifically to support textbook development. Otherwise, the author is the owner. Generally, an invention, software, or other copyrightable material, mask work, or tangible research property will not be considered to have been developed using Clarkson University facilities if:

- a) the Intellectual Property has been developed outside of the assigned area of research of the inventor(s)/author(s) under a research assistantship or sponsored project, and
- b) only a minimal amount of time has been spent using Clarkson University facilities and equipment (note: use of office, library, and traditional desktop personal computers are examples of facilities and equipment that are not to be considered), and
- c) the development has been made on the personal, unpaid time of the inventor(s)/author(s).

When a created item of Intellectual Property is not subject to a sponsored research or other agreement (such as an equipment agreement), but has been developed using Clarkson University funds or facilities, the DOR may, at its discretion and consistent with the public interest, license the inventor(s)/author(s) exclusively or nonexclusively on a royalty basis. The inventor(s)/author(s) must demonstrate technical and financial capability to commercialize the Intellectual Property, and the DOR will have the right to terminate such license if the inventor(s)/author(s) have not achieved effective dissemination by the time agreed upon in the license Agreement. Where such a license is issued, the inventor(s)/author(s) may be required to assume the costs of filing, prosecuting, and maintaining any patent rights.

4.3 Ownership of Copyrights in Theses

In all cases the student shall own the copyright to his/her doctoral dissertation or master's thesis. Consequently dissertation and master's thesis advisors must take responsibility to ensure that the contents of dissertations and master's theses do not fall under Intellectual Property agreements precluding the student owning the copyright to any portion of a doctoral dissertation or master's thesis. Intellectual Property, other than the copyright of the doctoral dissertation or master's thesis, created doing research toward a doctoral or master's degree is subject to all the other terms of this policy.

4.4 Evidence of Ownership For ownership documentation and protection of ownership of Intellectual Property by the University (e.g. patents, trademark registrations, copyright registrations, etc.) as established by this policy, members shall sign any and all documents reasonably necessary or desirable, as determined by the University in its sole discretion for these purposes.

4.5 Reservation of Rights

Whenever the University grants rights in, or transfers ownership of, Intellectual Property, the University hereby reserves for itself, without further act or deed, the royalty-free right to (a) use the Intellectual Property for its own academic, educational, and research purposes, and (b) permit other academic institutions to use the Intellectual Property for academic, educational, and research purposes.

V. DISCLOSURE AND PROTECTION OF INTELLECTUAL PROPERTY

5.1. Inappropriate or premature disclosure of Intellectual Property to persons, firms, or corporations outside the University may jeopardize the ability to protect it. Prompt disclosure to the University of Intellectual Property is essential to the proper administration of this Policy. In addition, Sponsored Programs frequently give the sponsor the right to review or inspect a discovery or invention. Each Member shall promptly disclose to the Division of Research any creation, invention, discovery, improvement, or other Intellectual Property developed or created by the Member or under his or her supervision if the University has or may have an ownership interest under this policy. Disclosure shall be made in the manner and with the degree of specificity as the Division of Research may prescribe. No other disclosure shall be made without the proper approval of the Director, Division of Research.

5.2 After consulting with the Creator and other appropriate parties, the University, in its discretion, shall determine whether and to what extent to seek legal protection of Intellectual property owned by the University. If the University elects not to seek legal protection within six months of disclosure, as per Section 4.1.2 (iv) above, ownership may revert to the Creator as specified in Section 3.1.

5.3 The University may make suitable arrangements not inconsistent with the provisions of this Policy with agencies or firms for the purpose of obtaining services and advice with respect to the patentability of inventions, obtaining patent or copyright protection, and the management and commercialization of Intellectual Property.

5.4 The Creator shall cooperate and assist the University in all phases of the process of seeking protection for the University's Intellectual Property, including execution of documents of assignment. The costs of obtaining legal protection for the University's Intellectual Property shall be paid by the University, by sponsors or by partners where appropriate in connection with the commercialization of Intellectual Property.

5.5 In cases where the University has not obtained legal protection for its Intellectual Property and has elected to transfer ownership to the Creator, the Creator may place the Intellectual Property in the public domain without obligation to the University. The University will maintain a file of its Intellectual Property dedicated to the public domain and will arrange for copies to be available to the public through the Educational Resources Center.

VI. DISTRIBUTION OF INCOME FROM COMMERCIALIZATION OF INTELLECTUAL PROPERTY

6.1 It is the general policy of the University to encourage the commercialization of Intellectual Property resulting from the scientific or educational endeavors of its Members.

6.2 In recognition of the efforts and contributions of Creators who develop Intellectual Property owned by the University, the University will share income derived from its commercialization with the Creators in accordance with the following guidelines.

6.2.1 From gross income derived from the commercialization of its Intellectual Property (whether from sale, licensing, royalties, or otherwise), the University will retain enterprise expenses in an amount equal to the costs and expenses incurred in connection with the legal protection, development, promotion, marketing, and licensing of the Intellectual Property, and any other direct costs associated with its commercialization. The Director of Research and the Controller's Office shall identify such expenses.

6.2.2 the balance (the "Net Income") shall be distributed within three months of receipt as follows:

25% of up to \$400K income (40% of additional income) to the University	To help defray costs of managing the Intellectual Property program generally. (This money will be allocated to an Intellectual Property account for other related expenses)
50% to the Creator(s)	Joint Creator(s)' shall determine in writing what percentage of the Creators share of income shall be allocated to the respective Creators.
25% of up to \$400K income (10% of additional income) to the Creator(s)' Department, or School in the absence of a Department	For the benefit of the Creator(s)' appropriate subunit, typically the department. In the case of Intellectual Property supported by two or more departments or units of the University, this portion of the Net Income shall be allocated and made available to the appropriate departments, or comparable unit on an equitable basis as determined by the Director of the Division of Research.

6.2.3 The above guidelines are subject to certain pre-existing and ongoing requirements ("Requirements") affecting income from and license or other rights in various categories of Intellectual Property, including Requirements relating to Intellectual Property "created or developed at, or through the use of, the facilities of" the Center for Advanced Materials Processing in accordance with Section 23 of New York State Laws of 1987, Chapter 839, and any agreement between the University and the New York State Urban Development Corporation ("UDC") pursuant to that legislation.

Unless the terms of the applicable Requirement provide otherwise, Net Income for purposes of this Policy shall exclude all amounts payable to UDC or to others as required by such Requirement.

6.3. The provisions of this Policy dealing with the distribution of income shall apply only to income received from Intellectual Property disclosed to the University subsequent to the effective date of this Policy.

VII. ADMINISTRATION OF INTELLECTUAL PROPERTY POLICY

7.1 Responsibility for all Intellectual Property matters, including the interpretation and administration of this Policy, shall rest with the Division of Research in consultation with an Intellectual Property Committee.

7.2 The Division of Research will provide the following support and supervision for implementation of this Policy:

- * assure that Members are aware of and adhere to provisions in research contracts or other agreements with outside parties restricting publication rights or otherwise relating to the creation, use, or disposition of Intellectual Property;
- * facilitate the early identification of potentially patentable inventions and discoveries, the preparation of disclosures, and the review thereof;
- * advise on available methods for the protection of copyrightable works, and, if appropriate, assist in negotiations for publication or commercialization;
- * review the terms and conditions governing others' Intellectual Property acquired for use in University-sponsored programs and activities and advise on compliance with those terms and conditions;
- * issue guidelines or other information and materials applicable to this Policy;
- * for Intellectual Property management purposes, the University shall also maintain an internal (within DOR) searchable database on all assigned and unassigned Intellectual Property disclosed to the University and evaluate, in consultation with Creators, invention disclosures in order to confirm ownership or applicable grant and contract terms.
- * determine whether legal protection (e.g., patent filing, formal copyright registration, or other mechanism) should be procured and, if so, the territory to be covered.

7.3 Intellectual Property Committee

7.3.1 The Intellectual Property Committee shall provide advice, and make recommendations to the Director, Division of Research, with respect to interpretation and implementation of this Policy, amendments to this Policy, and such other matters as the Director may deem appropriate.

7.3.2 The Intellectual Property Committee shall be comprised of nine persons as follows: a chair of the committee; five members of the faculty (provided that no department shall have more than one member); a member of the professional non-teaching Staff; and, *ex officio*, the Vice President for Business and Finance and the Director, Division of Research. The Faculty Senate shall nominate for the President's approval the faculty members of the Committee (other than, *ex officio* members), as well as the chair of the Committee who shall be a senior, tenured member of the faculty. Administrative Council shall nominate the professional non-teaching staff member. The President must approve all nominees.

7.3.3 Faculty and other Staff members (other than *ex officio* members) of the Committee shall be appointed for three year terms, renewable for a maximum of two additional terms. Terms shall be staggered so that no more than three new members will be appointed each year.

7.3.4 Should any member of the Committee be unable to complete his or her term of service, the Faculty Senate (or Administrative Council) will nominate, for the approval of the President, another member of the faculty (or the professional Staff), as appropriate, to serve for the duration of the unexpired term.

7.3.5 No member of the Intellectual Property Committee may participate in the deliberations of the Committee if that member has a personal interest or direct involvement in matters to be discussed.

7.3.6 The Director of Division of Research, and the chair of the Intellectual Property Committee shall jointly report annually to the President of the University upon matters of significance relating to the administration of this Intellectual Property Policy.

VIII. CONSULTING RELATIONSHIPS

It is the responsibility of individual members of the Clarkson community to ensure that the terms of their consulting agreements with third parties do not conflict with their commitments to the University (see Sections 5.2 Duties of a Faculty Member, 5.8.2 Periods of Duty - Faculty, 6.4 (V) Consulting, and 7.2.0 Conflict of Interest). Each individual should make the nature of his or her obligations to the University clear to any third party for whom he or she expects to consult. Members shall notify his or her department head or supervisor in writing of consulting relationships. Specifically, the scope of the consulting services should be distinguished from the scope of research commitments at the University. Intellectual Property created by Clarkson personnel who are consulting with external entities (corporations, businesses, government agencies, foundations, etc.) without making essential use of University funds, resources or facilities and while abiding by University policies on consulting is presumed retained by the external entity or the individuals as specified by the terms of the consulting agreement. Student employment with external entities will be considered as consulting under this policy, and externally employed students will be responsible for respecting the Intellectual Property policies of both Clarkson and their employers.

IX. MISCELLANEOUS

8.1 It shall be the responsibility of the Department Chair and/or supervisor in any department in which a visitor is performing University research or scholarly activities that may result in the creation of Intellectual Property to ensure that this Policy is described to the visitor and that the visitor consents, on forms provided by the Division of Research, to abide by it.

8.2 The University reserves the right to amend this Policy from time to time, including the method by which income will be shared with Creators. Any Member of the University may propose changes or additions to this Policy. The Intellectual Property Committee shall consider such proposed changes and, upon open deliberation, recommend adoption of such changes and modifications as may be deemed by it to be reasonable, appropriate for the furtherance of the University's Policy for the Management of Intellectual Property and consonant with applicable law and regulations. The Provost in consultation with the President may accept or reject changes recommended by the Intellectual Property Committee.