

University of Louisiana System

**Title: INTELLECTUAL PROPERTY
AND SHARED ROYALTIES**

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Chapter: Faculty and Staff

Policy and Procedures Memorandum

I. PURPOSE/PREAMBLE

The University of Louisiana System recognizes the need for and desirability of encouraging the broad utilization of the results of academic research by bringing innovative findings to practical application. The primary purpose of this Intellectual Property Policy is to provide the necessary protections and incentives to encourage both the discovery and development of new knowledge and its transfer for the public benefit; a secondary purpose is to enhance the generation of revenue for the home institutions and the creators.

The University of Louisiana System recognizes that research and scholarship should be encouraged without regard to potential gain from licensing fees, royalties, or other income; however, the System also recognizes that intellectual properties and discoveries may arise from the activities of faculty, staff, and students in the course of the duties or through the use, by any person, of institutional resources such as facilities, equipment, or funds. The policies governing the administration of such intellectual properties should provide adequate recognition and incentive to creators and, at the same time, ensure that the System institutions will share in the rights pertaining to intellectual properties in which they have an equity. The University of Louisiana System institutions are committed to assist their faculty and other researchers in properly disclosing their scholarly work, in complying with applicable laws and formal agreements, and in gaining the protection available under the United States laws governing patents, copyrights, trademarks, and other appropriate provisions.

II. OBJECTIVES

The University of Louisiana System's Intellectual Property Policy provides the following objectives for the System institutions as they develop and implement their intellectual property policies in compliance with applicable state and federal guidelines:

- A. To encourage research and scholarship as creative academic endeavors while recognizing that commercially valuable intellectual properties may result from such endeavors;
- B. To delineate procedures to encourage creators to report discoveries with broad commercial potential and public benefit and to assist them, while at the same time safeguarding the interests of all concerned parties;
- C. To make intellectual property developed in the course of academic research available to the public under conditions that will promote its effective and timely use and development;
- D. To optimize the environment and incentives for research and scholarly activity and for the creation of new knowledge in the System institutions;
- E. To ensure that the educational mission of the University of Louisiana System and its institutions is reinforced.

III. DEFINITIONS/BACKGROUND

The following definitions shall govern throughout the University of Louisiana System Intellectual Property Policy.

- A. Intellectual Property shall be defined as inventions, discoveries, know-how, show-how, processes, unique materials, copyrightable works, original data, and other creative or artistic works that have value. Intellectual property includes that which is protectable by statute or legislation, such as patents, copyrights, trademarks, service marks, trade secrets, mask works, and plant variety protection certificates. It also includes the physical embodiments of intellectual effort, for example, models, machines, devices, designs, apparatus, instrumentation, circuits, computer programs and visualizations, biological materials, chemicals, other compositions of matter, plants, and records of research.

- B. Traditional Academic Copyrightable Works shall be defined as a subset of copyrightable works created independently and at the creator's initiative for traditional academic purposes. Examples include class notes (in whatever form, e.g., handouts, internet posting); books, theses and dissertations; articles; non-fiction, fiction, and poems; musical works; dramatic works including any accompanying music; pantomimes and choreographic works; pictorial, graphic, and sculptural works; or other works of artistic imagination that are not created as an institutional initiative. Regarding websites, the author of each web page is responsible for the content of that page and is expected to abide by System and university policies as well as local, state, and federal laws.
- C. Creator shall be defined as an individual or group of individuals who make, conceive, reduce to practice, author, or otherwise make a substantive intellectual contribution to the creation of intellectual property. "Creator" shall include, but not be limited to, faculty, professional staff, administrative and support staff, and students. "Creator" shall also include the definition of "inventor" as used in the U.S. patent law and the definition of "author" as used in the U.S. Copyright Act.
- D. Institution Resources Usually and Customarily Provided shall include such support as office space, library facilities, ordinary access to computers and networks, or salary and shall be described in this policy as either "incidental" or "significant." The phrase does not include use of students or employees as support staff to develop the work, or substantial use of specialized or unique facilities and equipment, or other special subventions provided by the institution unless approved as an exception.
- E. Technical Works shall include intellectual properties that are of a scientific, engineering, or technical nature such as patentable or unpatentable inventions (including biological materials), computer software, and institution collections.
- F. Scholarly Works shall include all intellectual properties not covered in Technical Works that are of an artistic, scholarly, instructional, or entertainment nature.
- G. Computer Software shall include one or more computer programs existing in any form or any associated operational procedures, manuals, or other documentation, whether protectable or protected by patent or copyright.

- H. System Institutions shall include Grambling State University, Louisiana Tech University, McNeese State University, Nicholls State University, Northwestern State University, Southeastern Louisiana University, University of Louisiana at Lafayette, and University of Louisiana at Monroe.

IV. RIGHTS TO OWNERSHIP/DISCLOSURES

A. Overview

System institutions have ownership of intellectual property created (a) by an employee within the scope of his or her employment, (b) by an employee who is hired or commissioned to create a specific work, (c) when more than incidental use of institution resources usually and customarily provided occurs, or (d) when the intellectual property results from research supported by federal funds or third-party sponsorship. Institutions shall not assert ownership of intellectual property unrelated to job responsibilities and where only incidental use of institution resources usually and customarily provided has occurred, nor do they have ownership of traditional academic copyrightable works. (See principles below; institutions do have the right to recover costs and/or right to use the work.) Joint ownership may occur under certain circumstances such as when scholarly works involve the services of other institution employees (e.g., development of multi-media courseware).

B. Principles

1. This policy shall apply to all persons employed by System institutions, to anyone using institution facilities under the supervision of institution personnel, to undergraduates, and to graduate students.
2. Institutions may assert ownership in intellectual property of all types (including, but not limited to, any invention, discovery, trade secret, technology, scientific or technological development, and computer software) regardless of whether the property is subject to protection under patent, trademark, copyright, or other laws, except as stipulated in Sections 3, 4, 5, and 6 which will follow.
3. Institutions may assert their interest in intellectual property related to the creator's academic or professional field, regardless of the medium of expression. Institutions shall have ownership of all intellectual property created by persons under the conditions stated below:

- (a) if intellectual property is created by an employee within the specific scope of employment; or
- (b) if intellectual property is created with the use of institution facilities usually and customarily provided; or
- (c) if intellectual property is commissioned by the institution pursuant to a signed contract; or
- (d) if intellectual property is created by a person who was hired specifically, or is required as part of his or her job responsibilities, to produce it; or
- (e) if intellectual property fits within one of the nine categories of works considered “works for hire” under copyright law¹; or
- (f) if intellectual property results from research supported by federal funds or third-party sponsorship.

NOTE: Works related to an employee’s job responsibilities, even if he or she is not specifically requested to create them, will belong to the institution as works-for-hire. A copyright work is related to an employee’s job responsibilities if it is the kind of work an employee is employed to do and if the work is done, at least in part, for use at work or for use by fellow employees, the employer, or the employee’s clients. Use of personal time or other facilities to create the work will not change its basic nature if the work is related to the creator’s job as described above. Works that have nothing to do with job duties will remain the property of the creator, so long as he or she makes no more than the incidental use of institution facilities usually and customarily provided.

Institutions shall not have ownership when the creator is a student, professional, faculty, or non-faculty researcher and the intellectual property is a traditional academic copyrightable work in the creator’s field of experience. Even though such a work may be within the scope of employment, it is the property of the creator unless it is a scholarly work (a) created by someone who was specifically hired or required to create it or (b) commissioned by the institution.

¹ Section 101 of the copyright law defines a “work made for hire” as: (1) a work prepared by an employee within the scope of his or her employment: or (2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire. Source: United States Copyright Office, Circular 9: “Works Made for Hire Under the 1976 Copyright Act,” September 1998.

In either of these cases, the institution, not the creator, will own the intellectual property.

NOTE: The use of the terms “professionals” and “researcher,” together with faculty members and students, is intended to encompass all those individuals who routinely create scholarly works (e.g., educational, artistic, musical, literary, or architectural work). For example, if a library administrator writes a book about Louisiana History, his or her field of expertise, the institution should not assert ownership of the book.

5. In the case of traditional academic copyrightable work that involves significant institutional resource contributions, the institution shall reserve the right to secure rights (including but not limited to joint ownership), for example, to use the work and to recover its investment, in a contract with the creator. If a project involves the use of significant institutional resources, the creator and the institution shall agree before the project begins on the use of facilities, allocation of rights to use the work, and recovery of expenses and/or sharing of benefits from commercialization of the work.

NOTE: Institutions’ main concerns with traditional academic copyrightable works owned by professionals, faculty, non-faculty researchers, and students should be to allocate and recover resources that may be contributed to the creation of such works.

6. In addition to traditional academic copyrightable work created by professional, faculty, researcher, or student creators in their field of expertise, a creator shall own intellectual property under the following conditions:
 - (a) if it is unrelated to the creator’s job responsibilities and the creator made no more than incidental use of institution resources usually and customarily provided; or
 - (b) if it is intellectual property that has been released to the creator in accordance with institution policy.
7. Institution facilities or resources shall NOT be used (a) to create, develop, or commercialize intellectual properties unrelated to an individual’s employment responsibilities or (b) to develop or commercialize intellectual properties further that have been

released to a creator except when approved by the institution and when the institution retains an interest under the terms of the release.

IV. ORGANIZATION/MANAGEMENT/ADMINISTRATION

A. Acknowledgment of Institutional Impact and Authority

The University of Louisiana System recognizes that the evaluation of inventions and discoveries and that the administration, development, and processing of patents and licensable inventions involve substantial time and expense and require special talents and experience. Therefore, the System leaves to the individual institutions under its governance the task of establishing an organizational structure for the administration of intellectual property appropriate to the institution's activities. The President of each institution has ultimate authority for the stewardship of intellectual property developed at the institution. Each institution is responsible for establishing operational guidelines and procedures for the administration of intellectual property consistent with this policy and including, but not limited to, determination of ownership, assignment, protection, licensing, marketing, maintenance of records, oversight of revenue or equity collection and distribution, and resolution of disputes among creators and/or unit executive officers.

B. Institution Office

Each institution shall establish an office and/or committee or designate an individual who has responsibility for administering institution policies regarding intellectual property as defined herein. This office, committee, or individual will serve as the institution's intellectual property advocate (IPA). The IPA shall encourage research and scholarly activity, review and recommend to the President or a designated entity changes in procedures, resolve questions of intellectual property ownership, and make such recommendations as are deemed appropriate to encourage disclosures and ensure prompt and effective handling, evaluation, and prosecution of intellectual property opportunities and to protect the interests of the institution, the System, and the public.

C. Disclosure

All intellectual property in which the institution has an ownership interest under the provisions of this policy and that has the potential to be brought into practical use for public benefit or for which disclosure is required by law shall be reported promptly in writing by the creator to the designated institution officer through the appropriate unit executive officer(s) using the University of Louisiana System Intellectual Property and Shared Royalties Disclosure Form provided by the institution (See Appendix for sample). The disclosure shall constitute a full and complete disclosure of the subject matter of the discovery or development and identify all persons participating therein. The creator shall furnish such additional information and execute such documents from time to time as may be reasonably requested. Annually, the creator shall report to the institution proceeds and/or units distributed for all copyrightable works and intellectual property, regardless of the institution's ownership interests.

D. Evaluation and Exploitation Decisions

After evaluation of the intellectual property and review of applicable contractual commitments, the institution may develop the property through licensing, may release it to the sponsor of the research under which it was made (if contractually obligated to do so), may release it to the creator if permitted by law, or may take such other actions as are determined to be in the public interest. Exploitation by the institution may or may not involve statutory protection of the intellectual property rights, such as filing for patent protection, registering the copyright, or securing plant variety certification.

E. Questions Related to Institution Ownership

In the event there is a question as to whether the institution has a valid ownership claim in intellectual property, such intellectual property should be disclosed in writing to the institution by the creator. Such disclosure is without prejudice to the creator's ownership claim. The institution will provide the creator with a written statement as to the institution's ownership interest.

F. Abandonment of Intellectual Property

Should the institution decide to abandon development or protection of institution-owned intellectual property, ownership may be assigned to the creator as allowed by law subject to the rights of sponsors and to the retention of a license to practice for institution purposes. The minimum terms of such license shall grant the institution the right to use the intellectual property in its internally administered programs of teaching,

research, and public service on a perpetual, royalty-free, non-exclusive basis. The institution may retain more than the minimum license rights, and the assignment or license may be subject to additional terms and conditions, such as revenue sharing with the institution or reimbursement of the costs of statutory protection, when justified by the circumstances of development.

G. Commercialization by Creator

The institution may, at its discretion and consistent with the public interest, license intellectual property to the creator on an exclusive or non-exclusive basis. The creator must demonstrate technical and business capability to commercialize the intellectual property. Agreements with creators will be subject to review and approval of conflict-of-interest issues in accordance with applicable institution policy.

H. Decision-Making Timeline

Within 120 days of receipt of a complete intellectual property disclosure form, the institution will inform the principal creator of its substantive decisions regarding protection, commercialization, and/or disposition of intellectual property that he or she has disclosed. The institution shall be bound by any confidentiality agreement made with any external parties.

I. Disputes Policy

Each System institution shall identify and include in its intellectual property policy a dispute resolution procedure.

VI. PROCEEDS DISTRIBUTION

In the event that royalties are generated by intellectual property rights assigned or licensed to the institution, an appropriate share of such royalties shall be paid to the creator. The institution may recover its costs before the following conditions apply. The creator's share shall be determined by the following:

- A. In cases where the institution or creator, as the case may be, assign such intellectual property rights to a research corporation under contract to an institution or to the System, the share of royalties to be paid to the creator shall be governed by the terms of the contract between the institution or System and the research corporation.

- B. In cases where the intellectual property is covered by a contractual agreement with a sponsoring agency, the financial arrangements shall be in accordance with that contractual agreement as negotiated between the institution and the contracting agency.
- C. In cases of sponsorship by federal agencies, compliance with the appropriate federal regulations shall be effected in the ultimate agreement.
- D. In cases where the institution retains ownership of an intellectual property from a creator or creators, and/or expends funds to develop and market the intellectual property, any royalties generated will be used first to cover the expenses of filing, procuring, maintaining, and marketing the intellectual property. Forty percent of the net royalties will be paid to the creator, and sixty percent will be retained by the institution from which the intellectual property originated.
- E. Net royalties on intellectual property available to institutions shall be used for research, development, and other scholarly activities and allocated one hundred percent to the institution where the intellectual property originated.
- F. In instances where the institution chooses not to retain ownership of the intellectual property, the creator shall obtain permission from the institution's President, or his or her designee, before associating the institution's name, logo, etc., with the intellectual property.
- G. The System Board may approve exceptions to the established royalty distribution in extraordinary circumstances.