




INTEROFFICE MEMORANDUM

TO: CLARENCE PEARSON, CHAIR, FACULTY SENATE
FROM: SMRUTI RADKAR, ACTING GENERAL COUNSEL *SR*
SUBJECT: INTELLECTUAL PROPERTY POLICY
DATE: 2/2/2014
CC: RACHEL PETTY, INTERIM PROVOST

The Office of General Counsel (OGC) is in receipt of the Faculty Senate's request for review and comment of the attached Intellectual Property Policy. In October 2013, University Administrators presented OGC with the same draft document and requested a legal sufficiency review. The legal sufficiency review was completed on October 11, 2013 and it was recommended that the policy be forwarded to the Faculty Senate and then on to the Board of Trustees for final approval. At this time, pending additional changes or questions, OGC has determined this policy to be legally sufficient and has no further comments on this matter.

To: Kenneth Campbell, Esq.-Acting General Counsel

From: Clarence w. Pearson, 
Choir – Faculty Senate

Subject: Intellectual Property Policy

The Faculty Senate met and voted to transmit the Intellectual Property Policy proposal to the University General Council's office for review and comment. I hope your office can assist the senate in what is considered good practice and is the standard in higher education.

I am looking forward to meeting with you to discuss this matter. Please let me know when we can meet.

Attachment

The University of the District of Columbia

Intellectual Property Policy

This Policy governs the ownership of Intellectual Property. Intellectual Property is defined as scholarly works, patentable inventions, mask works, tangible research property, trademarks, online courses, computer programs and applications, computer codes and files, copyrightable works, and other works as defined below.

I. Introduction

The University of the District of Columbia (UDC) encourages the production of creative and scholarly research, courses, works and inventions, known broadly as Intellectual Property, among all classifications of faculty, other employees and students. This policy seeks to support and reward research and scholarship, and help faculty, students and staff define some of the rights and responsibilities of all involved. The purpose of establishing a policy is to make available University technology to industry and others for the public benefit.

1.1 Ownership of Intellectual Property

With the exception of student theses, ownership of Intellectual Property is transferred to UDC employees as specified below with the following exceptions:

- a. Intellectual Property that has been developed in the course of or pursuant to a sponsored research or other agreement (the faculty advisor, administrative officer, or the Office of Sponsored Programs staff can advise on the terms of the agreements that apply to specific research); and
- b. Intellectual Property 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 UDC providing for a transfer of copyright or ownership of Intellectual Property to UDC; and
- c. Intellectual Property developed with the significant use of funds, facilities administered by UDC, or professional staff (such as instructional designers) employed by UDC ("significant use" is discussed in Section 1.2); and
- d. Intellectual Property developed under direct assignment; and
- e. Intellectual Property developed under a negotiated or formal contract with a creator; and
- f. Intellectual Property developed under contract or grant that prohibits the transfer of copyright (for example, the university retains a non-exclusive right to all research reported in manuscripts funded in whole or part by NIH funding, so as to ensure compliance with the NIH Public Access Policy; and
- g. Intellectual Property developed by employees as a condition of employment.

As a result, this means that ordinarily all classifications of faculty, staff, employees, students, and contractual non-permanent employees own the rights to all their Intellectual Property as defined in this policy, including online course materials and grant the university a right to use those works only for university educational purposes, subject to the exceptions in 1.1 (a-g).

1.2 Significant Use of UDC-Administered Resources

When Intellectual Property is developed by UDC faculty, students, staff, visitors, or others participating in UDC programs using significant UDC funds, professional staff, or facilities, UDC 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 a significant use was made of UDC funds or facilities will be reviewed by the inventor's/author's dean or supervisor and a recommendation forwarded to the Provost's Office. The Provost or an officer designated by the Provost will make the final decision on this issue and on any dispute or interpretation of policy relating to Intellectual Property.

Textbooks developed in conjunction with class teaching are excluded from the "significant use" category and not considered "works-for-hire," unless such textbooks were developed using UDC-administered funds paid specifically to support textbook development. Sabbatical support for the purpose of developing a textbook would constitute significant use. Otherwise, the author is the owner.

Generally, an invention, software, application or other copyrightable material, mask work, or tangible research property will not be considered to have been developed using UDC funds or facilities if:

- a. only a minimal amount of unrestricted funds has been used; and
- b. 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
- c. only a minimal amount of time has been spent using significant UDC facilities or only insignificant facilities and equipment have been utilized (note: use of office, library, machine shop facilities, and of traditional desktop personal computers are examples of facilities and equipment that are not considered significant); and
- d. the development has been made on the personal, unpaid time of the inventor(s)/author(s).

When an Intellectual Property is not subject to a sponsored research or other agreement, but has been developed using significant UDC funds or facilities, the Provost's Office or other office designated by the Provost 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 Provost's Office or other office designated by the Provost will have the right to terminate such license if the inventor(s)/author(s) have not achieved effective dissemination within three years. 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.

1.3 Ownership of Copyrights in Theses

The ownership of copyrights in student theses is governed by the following:

- a. Copyright ownership of theses generated by research that is performed in whole or in part by the student with financial support in the form of wages, salaries, stipend, or grant from funds administered by the University shall be determined in accordance with the terms of the support agreement, or in the absence of such terms, shall become the property of the University.
- b. Copyright ownership of theses generated by research performed in whole or in part utilizing equipment or facilities provided to the University under conditions that impose copyright restrictions shall be determined in accordance with such restrictions. Questions regarding restrictions imposed on any of the University's facilities or equipment may be addressed to the dean responsible for the equipment or facilities or to the Office of Sponsored Programs.
- c. Students will own the copyrights to theses not within the provisions of a) and b) above; however, a student must, as a condition to a degree award, grant royalty-free permission to the University to reproduce and publicly distribute copies of his/her thesis.

- d. Where significant use is made of UDC facilities or equipment provided to UDC without copyright restrictions, students own copyrights in theses per c) above; however, software code, patentable subject matter, and other Intellectual Property contained or disclosed in the theses are subject to the significant use policy set forth in Section 1.2, above. For more information relating to student theses, please refer to the Graduate Student Handbook or consult the UDC Graduate Council.

1.4 Invention and Proprietary Information Agreement

All members of the UDC community — including visiting scientists and fellows — who participate in either sponsored research or University-funded research or who use significant funds or facilities administered by the University agree through accepting such funds or using such significant facilities, that the individual will assign to UDC or its designate his or her title to Intellectual Property created through the use of such funds or facilities.

1.5 Consulting Agreements

It is the responsibility of individual members of the UDC community to ensure that the terms of their consulting agreements with third parties do not conflict with their commitments to the University. 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. Specifically, the scope of the consulting services should be distinguished from the scope of research commitments at the University. In addition, the individual member of the UDC community must obtain approval from his or her dean or administrative vice president prior to entering into a consulting agreement the nature and parties to his or her consulting agreements. Uncompensated professional service as a peer reviewer or journal editor or reviewer need not be disclosed.

The University will not negotiate any consulting agreements on behalf of any faculty, student, or staff member; however, any questions regarding the University's policies may be directed to the Office of the General Counsel.

1.6 Organization

There are two offices and one committee responsible for addressing all Intellectual Property matters at the University. The President appoints various members of the community to the Committee on Intellectual Property that is empowered to propose Intellectual Property policies for the University. The chair of this committee in relationship with the Provost's Office is responsible for the implementation and administration of these policies. The Office of Sponsored Programs assisted by the General Counsel's Office negotiates the patent and copyright terms for each research agreement with every government and industrial sponsor, subject to the Provost's approval of any non-standard license terms. The Provost's Office will license the resulting Intellectual Property. All technology disclosures should be sent to the Provost's Office with the following exception. If the Intellectual Property was developed using funding from an external sponsor, the disclosure should also be sent to the Office of Sponsored Programs (see Section 1.7).

1.7 Disclosures and Technology Transfer

The federal government funds a significant amount of research at the University, and the University is obligated by federal regulations to report promptly to the appropriate federal agency any inventions conceived or reduced to practice during the course of a government-sponsored research program. The University similarly is obligated to report inventions to its industrial sponsors who provide financial support for research.

In order to comply with these policies and contract terms, inventors and authors must report to the Provost's Office any Intellectual Property (as defined in the first paragraph of Section 1.1) created during

the course of a sponsored research agreement or with the use of significant funds or facilities administered by the University.

Disclosures should also be submitted simultaneously to the inventor's project supervisor, department head, and dean or vice president. In this reporting, the inventor and authors must identify the sponsor, if any that funded the research resulting in the Intellectual Property. At a later date, a disclosure form will be developed primarily for this purpose.

At the time the invention is disclosed, it is assigned an internal case number and a copy of the disclosure is sent to the Office of Sponsored Programs, who reviews the patent and copyright terms of the applicable research agreements and notifies sponsors of the disclosures, as appropriate. In the Provost's Office of Office designated by the Provost, the disclosure is assigned to a person, who will contact the inventor(s) to discuss the invention. A decision is then made as to whether technology transfer will be accomplished most effectively by applying for patent or other legal protection. Industrial sponsors are usually granted rights to elect a license to technology for which patent or other legal protection is sought; the specific terms are then negotiated with the Provost's Office with the assistance of the Office of the General Counsel.

More generally, the Provost's Office will pursue the licensing of technology by researching the market for the technology, entering into discussions with potential licensees, developing a business plan, negotiating appropriate licenses or other agreements, monitoring progress, and distributing royalties to the inventor(s)/author(s) in accordance with UDC royalty policy.

1.8 Teaching Materials

In the case of copyrightable works developed by the Faculty, UDC's mission has generally been best served by allowing the individual faculty member to decide when, how, and in what form these works should be disseminated. Where significant University resources were involved in producing a work, or where there are contractual requirements, UDC and the faculty author share ownership of the work and responsibility for the decisions.

1.9 Materials Developed by Students

Students should also be recognized as creators and authors of their own material. The academic and financial rights of students should be honored in the creation and dissemination of educational materials.