

# THE COLLEGE OF WILLIAM & MARY INTELLECTUAL PROPERTY POLICY

## TABLE OF CONTENTS

### I. Purpose and Scope

### II. Introduction

### III. Definition of Terms

### IV. Policy Requirements

#### A. Ownership of Intellectual Property

1. Disclosure
2. Inventions that Are Not the Result of University Work
3. Waiver of Rights to an Invention

#### B. Grants, Contracts and Other Funding Arrangements

1. Modifying the Terms of this Policy for Grant-Funded Research
2. Guidelines for Allocation of Intellectual Property Resulting from Corporate Sponsored Research

#### C. Administrative Responsibilities

#### D. Inventor Responsibilities

#### E. Appeal Process

#### F. Distribution of Revenue

1. Distribution Formula
2. Distribution Among Inventors

### V. Transfers

### VI. Approval; Revision

## **I. Purpose and Scope**

The Commonwealth of Virginia requires that all State colleges and universities have patent and copyright policies. These policies define the ownership of intellectual property created by State university employees and other individuals who use state university resources.

This Policy applies to all Employees, University students, and University visitors.

## **II. Introduction**

The University evaluates intellectual property, derived from University Work and assists in securing intellectual property protection and commercial development of suitable intellectual property. This Intellectual Property Policy (the “Policy”) hereby defines the ownership rights in intellectual property that is created by employees, students, and visitors of the University, including the Virginia Institute of Marine Science (VIMS). In general, University students own the Intellectual Property they create while enrolled at the University (including Intellectual Property created as a condition of completing course requirements), with the exceptions described below.

## **III. Definition of Terms**

Author – Creator of any original work that produces Intellectual Property.

Copyright – Protection of an original University Work of authorship fixed in any tangible medium of expression.

Employee – Any individual employed by the University, including full- and part-time faculty, 12-month faculty, classified and operational employees, and professionals and professional faculty. Employee also includes: adjunct professors; visiting faculty; visiting scientists; and students who receive salaries or assistantships, University work-study funds, stipends, or hourly wages while they are acting within the scope of their employment at the University.

Intellectual Property – A collective term identifying University Work that may be protected by copyrights, trade secrets protections, trademarks, and/or patents, irrespective of whether formal protection is sought.

Invention – Any discovery or creation of a process, plant, machine, article of manufacture, or composition of matter that represents a significant improvement relative to the state of the art.

Inventor – Sole or joint authors or originators of Intellectual Property, with inventorship determined in accordance with United States law. The terms “Author(s)” and “Inventor(s)” are used interchangeably throughout this Policy.

Net Revenues – Income and/or equity received by the University from licensing and/or commercialization activities associated with an Invention, after deducting expenses relating to commercializing the Invention, said expenses including but not limited to contractual obligations to third parties, and expenses incurred by the University related to protecting, prototyping, marketing, and licensing the Invention.

Provost – The Provost of the University, or his or her designee.

Significant Use of University Resources – Many University resources are customarily used in the ordinary course of an employee’s duties, including resources such as the library, university-owned computers, whiteboards, photocopiers, pencils, desks, and telephones. Routine use of such resources does not constitute a Significant Use of University Resources. In contrast, extensive use of such customarily used resources, and/or extensive use of University-owned audio/visual equipment, and/or use of University personnel other than the Inventor(s), and/or other use of University resources that are not routinely available to other University personnel, would constitute a Significant Use of University Resources. In addition, University Work for which an Inventor is specifically compensated by the University constitutes Significant Use of University Resources.

Technology Transfer Office – The Technology Transfer Office of the University.

University – The College of William & Mary, including the Virginia Institute of Marine Science (VIMS).

University Work – For the purpose of this Policy and any documents developed for its implementation, University Work is defined as research, teaching, scholarship, or other activity performed by any individual:

(1) that is related to duties or responsibilities for which said individual has been compensated either by or through the University; or

(2) that makes use of facilities owned, operated, or controlled by the University, other than library resources, the University network, and University-designated maker spaces.

Vice Provost for Research – The Vice Provost for Research of the University, or his or her designee.

#### **IV. Policy Requirements**

##### **A. Ownership of Intellectual Property**

The University owns all intellectual property resulting from University Work, including but not limited to, patentable inventions. As a condition of employment or other involvement in University Work, Inventor(s) agrees to abide by this Policy, and assigns to the University ownership, right, title, and interest in any and all intellectual property resulting from University Work. Despite the foregoing presumption that the University owns property resulting from University Work, the University assigns title to such intellectual property in the form of copyrights in certain cases. These cases are where the intellectual property resulting from University Work is either (i) copyrights in University Works of academic scholarship, such as textbooks, literary University Works, artistic creations, and artifacts, or (ii) copyrights to teaching materials such as course materials, lecture notes, and syllabi, where said teaching materials are developed without Significant Use of University Resources, provided that the University Work was not a result of a University-paid, assigned duty to create a specified University Work product. Where the intellectual property resulting from University Work is copyrights to teaching materials that are transferred to the author(s), the University retains a no-cost license to such copyrights for non-commercial research and educational purposes only. Where the intellectual property resulting from University Work is copyrights to

teaching materials that are developed as a University-paid, assigned duty to create a specified University Work product or with the Significant Use of University Resources, then title to copyrights will be retained by the University, and the Author is granted a no-cost license for non-commercial research and educational purposes only.

This policy anticipates that the terms and conditions under which certain University Work will be performed might be the subject of individual agreements between Authors and the University, as approved by the Provost. Such terms and conditions may include the nature of production, the amount of any additional payment or stipend, the nature and procedures surrounding revision and alteration of the University Work, and/or other conditions. Such individual agreements shall be wholly enforceable pursuant to applicable law.

1. Disclosure. Responsibility for timely and complete disclosure of potentially patentable inventions rests with the Inventor. Disclosure forms are available from the Technology Transfer Office.

2. Inventions that Are Not the Result of University Work. The University will relinquish any claim to an Invention that is judged by the Vice Provost for Research not to have been the result of University Work. In such instances, ownership resides with the Inventor responsible for creating the Invention. In these circumstances, the Inventor may pursue intellectual property protection, marketing, and licensing activities without involving the University, and will be entitled to all revenues received. Alternatively, the Inventor may request that the Invention be evaluated by and assigned to the University, in which case the revenue distribution prescribed in Section IV(F) will apply.

3. Waiver of Rights to an Invention. At any time after disclosure of an Invention, the Vice Provost for Research may waive the University's interests in the Invention. Typically, this decision will be reached because the Vice Provost for Research (or an appropriate designee) believes that future investment of University resources is not justified by a cost/benefit analysis. The Vice Provost for Research shall communicate to the Inventor the University's decision to waive title to the Invention. At that time, the Inventor may elect to seek title to the Invention, which would culminate in a Release Agreement between the Inventor and the University. Terms for a Release Agreement will be negotiated by the Vice Provost for Research and the Inventor, retaining, on behalf of the University, rights to use the Invention in connection with research and teaching.

## **B. Grants, Contracts and Other Funding Arrangements**

1. Guidelines for Allocation of Intellectual Property Resulting from Corporate Sponsored Research. Pursuant to Code of Virginia § 23-4.4, the University by the Provost may from time to time elect to enter into contracts or grants, or other agreements regarding research, wherein the terms of this Policy may be modified. Such a grant or contract shall be deemed to be an "IP-Modified Sponsored Research Agreement."

2. Modifying the Terms of this Policy for Grant-Funded Research. Whenever the University administers an IP-Modified Sponsored Research Agreement, the principal investigator, or cognizant party to the agreement, is responsible for informing other individuals ("Sponsored Researchers") who may conduct research under the IP-Modified Sponsored Research Agreement of their modified

rights and obligations and the principle investigator or cognizant party is further responsible for obtaining each and every Sponsored Researcher's written consent to their modified rights and obligations prior to the Sponsored Researcher's commencement of research under the IP-Modified Sponsored Research Agreement.

### **C. Administrative Responsibilities**

The Vice Provost for Research, or an appropriate designee, is responsible for the implementation and administration of this Policy. The Vice Provost for Research shall:

- 1) Develop guidelines appropriate for the implementation of this Policy.
- 2) Determine, within 30 days of submission of a completed Invention Disclosure Form to the Technology Transfer Office, whether or not an Invention is the product of University Work, in accordance with Section IV(A).
- 3) Determine whether to seek intellectual property protection on behalf of the University.
- 4) Take appropriate steps to comply with applicable government reporting obligations.
- 5) Take appropriate steps on behalf of the University for patenting and/or marketing Inventions owned by the University.
- 6) Distribute revenues in accordance with the terms of this Policy.
- 7) Notify the Inventor, pursuant to Section IV(A)(2) or (3) of this Policy, whenever the University elects not to claim ownership of an Invention that has been disclosed to the University.
- 8) Interpret the Policy subject to the review of the Provost when requested by any interested party, as described below.

The Provost will:

- 1) Review and approve standards and guidelines and any amendments to them developed by the Vice Provost for Research for the implementation of the Policy.
- 2) At the request of any interested party, or on his or her own, possibly in consultation with a faculty committee appointed for the purpose, review any determination of the Vice Provost for Research as provided in Section IV(E). The Provost may affirm, modify, or reject any determination of the Vice Provost for Research.

The Office of Sponsored Programs, or another office appointed by the Vice Provost for Research, will:

- 1) Maintain records on all requirements regarding patents and copyrights in any grant or contract accepted by the University;
- 2) Provide patent, copyright and other pertinent information as required by the terms of a grant, contract, or agreement to which the University is a party; and
- 3) Submit appropriate reports as required by the University and/or applicable state or federal laws.

The President of the University may reassign the responsibilities for administering this Policy.

### **D. Inventor Responsibilities**

The Inventor will promptly disclose to the University any Invention that the University may own under the terms described in this policy. This disclosure requirement will be fulfilled by the timely and complete filing of an Invention Disclosure Form to the Technology Transfer Office. Disclosure forms are available from the Vice Provost for Research, and are also available on-line via the Technology Transfer Office website. The Inventor shall furnish additional information and execute documents from time to time at the reasonable request of the Vice Provost for Research. The Inventor shall cooperate in the patenting and licensing of the Invention.

If the Vice Provost for Research decides to waive the University's rights in an Invention, the Inventor may formally request to obtain title to said Invention, as described in Section IV(A)(3) above, and pursue intellectual property protection independent of the University.

## **E. Appeal Process**

The Inventor may appeal to the Provost regarding actions taken by the Vice Provost for Research. Grounds for appeal include failure of the Vice Provost for Research to:

- (1) follow and fulfill this Policy;
- (2) demonstrate due diligence to avoid compromising the Inventor's equity in the Invention; and/or
- (3) determine correctly whether or not an Invention is the product of University Work.

The Inventor shall submit the appeal to the Provost, who shall confirm that the Inventor has made a reasonable effort to resolve the complaint with the Vice Provost for Research and that the substance of appeal is arguably proper and made in good faith. Proceedings shall be informal, but all parties shall have adequate notice and opportunity to be heard. After hearing all relevant testimony, the Provost shall decide the merits of the Inventor's grievance and direct the Vice Provost for Research on appropriate subsequent actions to be taken in the matter.

## **F. Distribution of Revenue**

1. Distribution Formula. The Inventor(s) and the University will share in the Net Revenue derived from Inventions owned and licensed by the University. Net Revenue will be distributed as follows:

Inventor(s): 50%

Office of the Vice Provost for Research: 40%

Affiliated Department or if none, Program, or if none, School: 10%

The Inventor's Affiliation will be selected from one of the following affiliations: the School of Business, the School of Education, the School of Law, the Virginia Institute of Marine Science, the Thomas Jefferson Program in Public Policy, other recognized program or institute of the University such as the William and Mary Research Institute, or a specific department within the Faculty of Arts and Sciences. If the Inventor has multiple Departmental Affiliations, then the Vice Provost for Research will determine the appropriate distribution of the Departmental Affiliation share. Distributions will be made semi-annually, unless otherwise specified.

2. Distribution among Inventors. When multiple Inventors are involved in an Invention

that produces Net Revenue, the Inventors' respective shares will be distributed in accordance with a written agreement signed by all inventors. Alternatively, if there is no such agreement, each and every Inventor on a given Invention will receive an equal share. The Departmental Affiliation share will be divided using the same formula used to divide the Inventor's share

If there is joint inventorship including Inventors from the University and inventors from other institutions, the Vice Provost for Research will attempt to negotiate an Inter-Institutional Agreement with the other institution(s) regarding the distribution of revenues. Net Revenue accruing from Inventions subjected to such Inter-Institutional Agreements will be distributed to Inventors at the University according to the distribution formula specified by this Policy.

Inventors are personally responsible for the payment of all required taxes on income derived by them personally from Inventions.

If an Inventor leaves the University, the Inventor will receive the appropriate portion of the Inventor's share of Net Revenue. The Inventor is required to furnish, and update, personal contact information to the Technology Transfer Office in the event the Inventor ceases employment with the University. If an Inventor dies, then the Inventor's share will be paid to the Inventor's estate. If the Inventor or the Inventor's estate administrator cannot be located, the funds will be held for one year after which period they will revert to the University to be incorporated into research reinvestment funds administered by the Vice Provost for Research.

#### **V. Transfers**

The University has the right to license or transfer any intellectual property it owns.

#### **VI. Approval; Revision and Amendment**

This Policy was approved by the Board of Visitors on October 23, 2007, and amended by the Provost effective March 9, 2016.

This policy is subject to revision at any time by written recommendation from the Provost with consultation and reviews by faculty. Recommendations regarding alterations of revenue distributions may be made by the Provost and become effective only when approved by the Faculty Assembly, the President, and the Board of Visitors.