

# Intellectual Property Ownership

[Faculty Handbook Category #2]

In furtherance of the college's goal of encouraging creative and scholarly works, St. Olaf College has adopted this Intellectual Property Ownership Policy.

## **Ownership of Creative Works**

As "works made for hire" are defined under Section 101 of the Copyright Act of 1976, works created by an employee within the scope of his or her employment are owned by the employer. The college does not intend for this "works made for hire" doctrine to apply to faculty-created works unless extraordinary resources of the college are used in the creation of a work. Therefore, faculty members will own the copyrights in works that result from a faculty member's pursuit of traditional teaching, research and scholarly activities, including the creation of books, articles and other literary works; computer software; inventions; artistic, musical or dramatic works; or course materials, whether in traditional or electronic form, unless extraordinary resources of the college were used in the creation of the work. With regard to any particular creative work, the college and the faculty member may mutually agree on an alternative ownership arrangement.

## **Ownership of Inventions**

Under patent law, inventions are owned by the inventor and not the employer unless the inventor agrees to assign his or her rights in an invention to the employer. Unless extraordinary resources of the college are used in the creation of a work, the college will not expect the faculty member to assign his or her rights in an invention conceived, developed, or discovered during the faculty member's employment with the college. With regard to any particular invention, the college and the faculty member may mutually agree on an alternative ownership arrangement.

## **Definition of Extraordinary Resources**

"Extraordinary resources" may consist of released time from regularly assigned duties (but not a sabbatical or similar leave); direct investment by the college through funds or staff; the college's purchase of special equipment for the project; use of the college's multimedia production personnel and facilities; or extraordinary use of the college's computing resources. Use of incidental supplies, use of a college computer in a faculty office, or use of college personnel or shared facilities on an occasional basis will not be considered use of extraordinary resources. The college will determine whether extraordinary resources have been used on an individual basis.

## **Further Actions**

For all works for which the college retains ownership, the faculty member agrees to cooperate with the college and take any further actions necessary to effectuate ownership by the college.

## **Administration**

This Intellectual Property Ownership Policy will be administered by the Dean of the College. Disputes concerning application of this policy will be resolved by a review panel of three members consisting of the President, a representative appointed by the creator of the work, and a representative appointed by the Dean of the College.

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**DAVIDSON COLLEGE INVENTIONS AND PATENT POLICY****Proposal Development****Forms****Policies****Post-Award Management****> Post-Award Q&A****Human Subjects IRB****Animal Care and Use in Research****Introduction****Definition of Invention****Administration****Applicability****Ownership****Procedures for Reporting an Invention****Legal Expenses and Distribution of Income****Dispute Resolution****Introduction**

Davidson College is dedicated to teaching and to the pursuit of knowledge. While the primary focus of these activities is to lead students to lives of leadership and service, the College recognizes that inventions and discoveries of commercial importance may be a natural outgrowth of activities within the College community. The following policy statement clarifies the ownership rights to inventions made by employees and students of Davidson College.

The goal of the inventions and patent policy is to ensure that discoveries, inventions, and other creations generated by faculty, staff, and students of Davidson College are utilized in ways most likely to benefit the public. The College seeks to assist its 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 United States laws governing patents. Likewise, the College seeks to ensure that commercial benefits are distributed in a fair and equitable manner that recognizes both the contributions of the inventors and the interests of Davidson College.

**Definition of Invention**

Inventions are ideas and may or may not be patentable. Under U.S. patent law, an invention is patentable if it is a novel, unobvious and useful idea relating to a process, machine, manufacture, composition of matter, or an improvement thereof. Patentable inventions include ideas relating to machines and other devices, software, electrical circuits, chemical compositions or compounds, and even some business methods. It is probable that a patentable invention has been made when something new and useful has been conceived or developed which is not obvious in view of the prior art, for example, because it has unexpected results. An invention is considered new or novel if it has not been previously publicly known or used by others in this country or patented or described in a printed publication anywhere in the world prior to conception of the invention. Patentability of an invention may vary from country to country and is determined by the patent laws of the particular country issuing the patent. Although the patent laws of other countries are generally similar to those of the United States, there are some differences. For example, in the United States an inventor may file a patent application up to one year after publicly disclosing the invention while in most foreign countries the inventor is required to file the patent application before disclosing the invention to the public.

**Administration**

The administration of this patent policy will reside with the Patent Advisory Committee which shall be appointed by the President. The committee shall

consist of the Vice President for Academic Affairs, and the department chairs of the Biology, Chemistry, Physics, and Mathematics departments or their representatives and other at large appointees as deemed appropriate by the President. When an invention is submitted for consideration, it will be the responsibility of the Patent Advisory Committee to:

1. evaluate the patentability and commercial or other value of the invention;
2. determine a course of action for patenting and commercializing the invention;
3. ensure that all sales or licensing of inventions and/or discoveries are implemented to bring the inventions and/or discoveries to the public while securing financial reward for the College and the inventors.

The Chair of the Patent Advisory Committee shall report to the President of the College. The College attorney shall be consulted on all legal matters pertaining to this policy.

#### **Applicability**

This policy applies to all patentable inventions conceived or first reduced to practice by full-time, part-time or visiting faculty, post-doctoral researchers, staff, students, or any other persons performing research or engaging in work at the College where such inventions may be created or discovered.

#### **Ownership**

Ownership of inventions conceived or reduced to practice by faculty, staff or any other person performing research or engaging in work or study at the College, where such inventions are created or discovered within the course of their employment or with substantial use of College resources, personnel or facilities beyond the usual office and library provisions, will reside with the Trustees of Davidson College. Inventions or discoveries that are made off college premises and that are unrelated to teaching and professional activities are exempt from this policy.

Any student invention will be deemed made under College auspices and therefore the property of the College pursuant to the patent policy only if it is made in the course of the student's employment by the college for an assigned work project. Royalties from the College's licensing of any student invention will be shared with the student on the same basis that royalties are shared with faculty or staff employees.

When a patentable invention is developed through a sponsored grant or contract, the special provision contained in the grant or contract will prevail. In the absence of such special provisions, the College policy will apply. Generally, while the College is assigned the rights to intellectual property generated during the course of federally-sponsored research activities, the government retains the option to claim ownership under certain circumstances. In the event that the government does not exercise its option and regardless of ownership, the government retains a non-exclusive, non-transferable, irrevocable, royalty-free, worldwide license to the invention produced under government sponsorship.

#### **Procedures for Reporting an Invention**

When any person makes a discovery or invention to which this policy applies, a report of the invention should be made promptly to the Chair of the Patent Advisory Committee. The report should be made on the attached invention disclosure form. If ownership of the invention resides with the College, the inventor(s) shall assign all intellectual property rights to the invention to the College upon the committee's request.

Within 30 days of receipt of an invention disclosure form, the Chair will

convene a meeting of the Patent Advisory Committee to evaluate the invention.

The Patent Advisory Committee shall have the sole right to determine the disposition of inventions in which the College has a proprietary interest. A decision to exercise this right shall be transmitted in writing to the inventor within 60 days of the date of disclosure of the invention to the committee. If the committee decides to pursue a patent, it may recommend that the College alone, or with the assistance of an external organization such as a technology transfer company, make applications for letters of patent. Title to all such patent applications and resulting patents shall be held by the Trustees of the College.

If the committee decides not to patent an invention, or not to commercialize a patented invention, the College will release to the inventor its interest in the invention.

#### **Legal Expenses and Distribution of Income**

An account will be opened to which expenses associated with patenting and marketing inventions will be charged. Expenses include, but are not limited to, invoiced costs such as legal fees, patent filing fees, licensing agent fees and other out-of-pocket expenses.

Revenues attributable to a particular invention will first be used to recover expenses incurred according to the following formula:

100% of the income shall go to the College until all its out-of-pocket expenses associated with the protection and exploitation of the patent have been reimbursed.

After the College's full recovery of expenses, the net revenues will be distributed as follows:

50% to the inventor(s) and 50% to the College.

In each of the first three years in which royalties are received, the College will allocate one-fifth of its share (i.e. 10% of net royalties) to the department(s) of the inventor(s). These funds may be used for equipment purchases, research and instructional activities, and other purposes approved by the Vice President for Academic Affairs, but they may not be used to create or support permanent faculty positions.

Royalties for patentable inventions developed as a result of assigned College duties are normally divided as follows: 75% to the College and 25% to the inventor.

In the event of multiple inventors, the inventors will be expected to agree among themselves on the fractional distribution of each inventor's share of any royalties. The inventors shall sign a written agreement specifying the fractional distribution of their share of royalties. The inventor's share will continue even if s/he leaves Davidson College.

#### **Dispute Resolution**

In the event of any dispute regarding a decision of the committee under this policy, including, without limitation, the ownership of an invention or the allocation of the inventor's share of royalties, the President shall have the final decision concerning the College's position in the matter.

(Adopted by the Davidson College Board of Trustees' Executive Committee  
June 13, 2002)