

Alfred University Intellectual Property Policy
May 2008

1. Introduction:

1.1 The fundamental mission of Alfred University (“University”) is teaching, research, and service to advance knowledge and serve the public good. In the pursuit of this mission, new creations and discoveries often result that are subject to, or eligible for, intellectual property protection. The University encourages 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. Further the University wishes to offer its faculty, staff, and students incentives to develop scholarly and creative works and other Intellectual Property which can be used for the good of the University and the public at large.

1.2 The stewardship of such Intellectual Property, consistent with the teaching, research, and service missions of the University, is an important responsibility of both the University and the Creator (e.g., faculty member). This document sets forth the University’s Policy concerning the stewardship of Intellectual Property. Terms not defined in the body of the Policy are defined in Appendix 1 attached hereto and incorporated herein by reference.

2. Overview

2.1 The purposes of the University’s Intellectual Property Policy are to:

1. Promote the publication of scholarly works and the discovery of new Intellectual Property.
2. Encourage the full and free exchange and expression of creative and scholarly ideas and comment within the context of the teaching, research, and public service missions of the University.
3. Maintain and enhance the reputation of the University as a teaching and research institution.
4. Promote the public good by producing, disseminating, and, when appropriate, commercializing, Intellectual Property of artistic, scientific, and practical value.
5. Enhance opportunities for cooperation and productive interaction with external sponsors who support University research and other creative endeavors.
6. Establish the basis on which income resulting from the commercialization of Intellectual Property is shared by the University with Creators.

7. Insure that the rights and responsibilities of all involved are fairly determined.

2.2 It is the University's policy that individuals through their employment by the University or by participating in a sponsored research project or using University-administered funds or University Resources thereby accept the principles of Intellectual Property ownership and related policies as stated under this Policy. In furtherance of such undertaking, all such individuals will sign Intellectual Property and Proprietary Agreements (in the form attached as Appendix 3) in accordance with this Policy.

3. General Policy:

3.1 All Intellectual Property conceived or first reduced to practice in whole or in part by Creators in the course of their University responsibilities, which may include, but is not limited to, work on publicly or privately sponsored research, or use of University Resources, shall be disclosed to the University on a timely basis and shall be assigned to the University, unless the University otherwise disclaims such IP or re-assigns it to its Creator(s) (see Sections 3.6 – 3.8). At the same time, the University acknowledges a responsibility to ensure that the specific Intellectual Property policies of third-party sponsoring organizations be understood prior to acceptance of funding, and complied with after Intellectual Property is developed.

3.2 The University shall have the sole right to determine the disposition of applicable Intellectual Property under this Policy. The determination shall take into account the interests of the University, any external sponsors, the public, and the Creator, including the Creator's professional or ethical convictions concerning the use of applicable Intellectual Property. Responsibility for disposition of applicable Intellectual Property resides with the Office of the Provost and Chief Operating Officer, consistent with this policy.

3.3 Creators shall assist the University as reasonably requested to protect, maintain, and enforce, if applicable, Intellectual Property, including without limitation, executing appropriate assignments and other documents and providing testimony as needed. The University shall reimburse all pre-approved out-of-pocket costs incurred by any applicable Creator in rendering such assistance.

3.4 Intellectual Property may be developed under a "sponsored research agreement" where the research is sponsored by an external source (including federal and state agencies). Consistent with its nonprofit status, mission for the public (and not private) good, and federal laws and regulations, the University will own any resulting Intellectual Property. One exception is when the Intellectual Property derives from "prior art" developed by the sponsoring organization; in such cases, joint ownership between the University and Sponsor may be indicated. However, the terms of sponsored research agreements typically provide the sponsor with certain rights to that material, e.g., the grant of the right for a limited period of time to negotiate for an exclusive license of such Intellectual Property with the University, and they may impose other duties, e.g., advance

notice of publication. In the case of joint ownership, the University would agree not to dispose of its ownership rights without the consent of the other joint owner.

3.5 Intellectual Property may not be licensed or assigned to third parties without the prior written consent of the University, via the Office of the Provost and Chief Operating Officer. The decision whether to proceed to patent and/or license any Intellectual Property shall be solely within the discretion of the University, subject to the terms of any agreement(s) that supported or related to the creation of the applicable Intellectual Property.

3.6 In the case where the University has reviewed the Intellectual Property Opportunity and elects not to pursue Intellectual Property rights to the project, the University will execute the Waiver Letter in Appendix 5 and allow the Creator(s) to pursue the IP rights at their own expense. The University should make and communicate this decision to the Creator(s) within three (3) months of receiving the Intellectual Property Disclosure Form (Appendix 2), to allow Creator(s) adequate time to pursue the rights on their own.

3.7 In the case of Federal agency sponsorship, any "stand aside" as described in Section 3.6 must be made by releasing the invention to the Federal government, following which the Creator may directly petition the agency for a release of rights. Decisions by Federal sponsors to permit Creators to acquire ownership are generally made on a case-by-case basis, and the Federal Government retains for itself march-in and related rights.

3.8 Intellectual property developed under an independent consulting agreement is not subject to ownership by the University as long as University resources were not used in the conduct of the consulting work.

3.9 In the interest of furthering education and industry research, should the opportunity arise where it will be of benefit to the University to share ownership of a patent, the University will review the opportunity on a case-by-case basis. This endeavor will also be evaluated by submittal of the form provided in Appendix 4 to this policy.

4. Disclosure

4.1 An Intellectual Property Disclosure Form is a document which provides information about the Creator(s), what Intellectual Property was created, circumstances leading to the creation, and facts concerning subsequent related activities. It provides a basis for determining patentability and the technical information for a patent application. An Intellectual Property Disclosure Form is also used to report technology that may not be patentable, but that can be protected by other means, e.g., copyright.

4.2 Creators shall prepare and submit an Intellectual Property Disclosure Form promptly for each potentially patentable invention and other Intellectual Property conceived or first reduced to practice in whole or in part in the course of their University responsibilities or with more than incidental use of University Resources. If Intellectual

Property for which an Intellectual Property Disclosure Form has been filed, e.g., to mark its conception, is later reduced to practice, a subsequent amended Intellectual Property Disclosure Form should also be filed regarding such reduction to practice.

4.3 Disclosures shall be made on the Intellectual Property Disclosure Form to the Office of the Provost and Chief Operating Officer, with copies to the applicable Department Chairperson and School Dean.

4.4 Each Creator shall maintain his or her moral rights, namely to be identified, or to refuse to be identified, as a Creator by the University and by subsequent licensees and assignees, except as required by law or subsequent agreement. Creators shall retain the rights to pursue related research and creative activities, determine methodologies, draw conclusions, disseminate information, and develop related Intellectual Property (including derivative works), except to the extent that the Creators have voluntarily entered into contractual arrangements or are required by legal or professional considerations to do otherwise.

4.5 Because premature or inappropriate disclosure may defeat legal protection of Intellectual Property, the University will undertake to inform Creators and other members of the University community about the consequences of premature disclosures. The University and Creators will work together to facilitate both scholarly disclosures and the acquisition of appropriate Intellectual Property protection.

5. Institutional Works, Traditional Works of Scholarship, and Student Theses

5.1 The University shall own all Intellectual Property rights in, and receive all proceeds resulting from the sale, assignment, licensing, or use of, Institutional Works unless provided otherwise in prior written agreements between the University and the applicable Creators, except as provided in Section 5.2.

5.2 In keeping with academic tradition, the University generally will not claim ownership for itself of Traditional Works of Scholarship. Copyrights in those works shall belong to the Creator.

5.3 The rights in student theses are governed as follows:

1. Copyright ownership of student theses generated by research that is performed in whole or in part by the student with financial support in the form of wages, salaries, stipends, or grants 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 student, but the University shall have a non-exclusive, fully-paid-up license to use, archive, display, copy, and make the work accessible in all forms and media in perpetuity.
2. Copyright ownership of theses generated by research performed in whole or in part using equipment or facilities provided to the University under

conditions that impose copyright restrictions shall be determined in accordance with such restrictions.

3. In most cases, research undertaken by students as part of their thesis research is intended to be presented in a thesis as well as being published in the open literature. Indeed, publication is frequently a graduation requirement. In such cases, the research is conducted under the usual guidelines surrounding the dissemination of results arising from the research. The thesis is written and defended in the usual way, which includes public display and presentation.

In some cases, however, a Sponsor of research might desire that its project be conducted under conditions of confidentiality resulting in a delay in publication, not only in the open literature, but also in circulation of the thesis. A thesis or other publication prepared under the aegis of such sponsored research must still be able to be defended in the normal timelines so that the graduation of a student is not delayed.

6. Commercialization

6.1 The University encourages the development of inventions and technology resulting from University research by industry for public use and benefit. The University recognizes that formal protection of Intellectual Property is often necessary - particularly with respect to Intellectual Property derived from basic research - to encourage a company to risk the investment of its personnel and financial resources to develop the Intellectual Property. In some cases an exclusive license may be necessary to provide an incentive to undertake commercial development. Non-exclusive licenses allow several companies to exploit Intellectual Property.

6.2 The research and teaching missions of the University always take precedence over Intellectual Property protection considerations. While the University recognizes the benefits of patents, it is most important that the direction of University research not be established or unduly influenced by patent considerations or personal financial interests.

6.3 The Office of the Provost and Chief Operating Officer will handle the evaluation, marketing, and licensing of University-owned Intellectual Property with commercial potential.

6.4 Income generated by Intellectual Property owned by the University shall be received solely by the University and shall, except where this Policy or the funding agreement specifies otherwise, be distributed as follows:

- A. All income received by the University shall first be used to defray the technology-transfer costs incurred by the University, or its agents, at any time in evaluating, developing, protecting, administering, enforcing, defending, and otherwise exploiting the Intellectual Property.
- B. The University encourages and respects agreements that best reflect the contribution of the Creator(s) and the University. Unless specifically contracted

otherwise, net income shall be distributed to Creators, or their heirs, in accordance with the following schedule:

Each Creator's share of equity shall be determined consistent with formulas established in this Policy: University: 50%; Creator(s): 50%

- C. Net income distributed to the University shall be designated as discretionary funds available to the Office of the Provost and Chief Operating Officer to be used to further research activities at the University. However, at least 25% of the University's share of net income shall be distributed to the School or College where the Intellectual Property originated.

6.5 The University may at times accept equity, as defined in Appendix 1, as part of the license issue fee or other related consideration. In particular, when the entity selected to develop, market, and deliver the technology to the marketplace is not reasonably able to provide adequate compensation in cash for a license, the University may choose to accept equity, in partial lieu of cash, to facilitate the practical application of University technology for the general public benefit. University acceptance of equity shall be based upon the principles of openness, objectivity and fairness in decision-making, and preeminence of the education, research and public service missions of the University over financial or individual personal gain.

6.6 The above guidelines may be subject to certain pre-existing and ongoing requirements affecting income from, and license or other rights in, various categories of Intellectual Property. Such requirements could include, for example, Intellectual Property created or developed at, or through the use of, the facilities of the Center for Advanced Ceramic Technology in accordance with New York State Laws of 1987, Chapter 839, and any agreement between the University and NYSTAR pursuant to such legislation. Thus, unless the applicable legislation or agreement(s) provides otherwise, net income for purposes of this Policy shall exclude all amounts payable to NYSTAR or to other institutions or entities.

6.7 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.

7. 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 Provost and Chief Operating Officer (or his/her designee).

7.2 The Alfred University Intellectual Property Committee (AUIPC) shall provide advice and make recommendations to the Provost and Chief Operating Officer with respect to interpretation, implementation, and amendment of this Policy, and such other matters as its Chair may deem appropriate.

1. The AUIPC shall have four members as follows: The Chair of the Research and Scholarship Committee of the Faculty Senate, one other faculty member elected by the Faculty Senate, and two other members from the campus community appointed by the Provost and Chief Operating Officer. The Provost and Chief Operating Officer and the Director of Sponsored Research Administration will serve as ex-officio members.

2. Members (other than ex-officio members) of the Committee shall be appointed for three-year terms, renewable for a maximum of one additional term. Terms shall be staggered so that no more than two new members are appointed each year.

3. Should any faculty member of the Committee who was elected by the Faculty Senate be unable to complete his or her term of service, the Faculty Senate will elect another member of the faculty to serve for the duration of the unexpired term.

4. No member of the AUIPC may participate in the deliberations or decisions of the Committee if that member has a personal interest, direct involvement, or an actual or apparent conflict of interest in matters before the Committee.

5. The Provost and Chief Operating Officer and the Chair of the AUIPC shall jointly report annually to the President of the University and the Faculty Senate upon matters of significance relating to the administration of this Intellectual Property Policy.

6. The AUIPC will meet often enough to provide timely disposition of Intellectual Property Disclosure Forms. The AUIPC will also review the University's Intellectual Property strategy and portfolio and consider specific actions to enhance and develop this Policy on at least an annual basis.

8. Recognition

A patent award certificate signed by the Provost and Chief Operating Officer and the Chair of the AUIPC will be given to each Creator for each issued U.S. patent during an annual recognition ceremony. The AUIPC may also give a special monetary award for Intellectual Property that has had a highly significant impact on the University's income or reputation.

9. Intellectual Property Education

The AUIPC will conduct periodic Intellectual Property education presentations and provide associated reading materials to the University community. Everyone at the University is asked to observe the rights of other owners of Intellectual Property. With very limited exceptions, use of protected Intellectual Property without the permission of the owner is unlawful and can result in substantial civil and/or criminal penalties.

Appendix 1

Definitions

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

1. **AUIPC** – the Alfred University Intellectual Property Committee.
2. **Creator** - a Member who develops or creates Intellectual Property. An individual's obligations and rights as a Creator shall continue with respect to the applicable Intellectual Property even if the individual leaves the University.
3. **Intellectual Property** or **IP** – creations of the human mind which are legally protectable as property, including without limitation, inventions (patentable or not), tangible research property, trademarks and service marks, and works subject to copyright protection, including without limitation, mask works and software. IP includes not only the technology but also the tangible embodiment of the technology, such as biological organisms, plant varieties, and software.
4. **Members** – all full-and part-time persons at the University, including visiting faculty, staff, students (both undergraduate and graduate), fellows (pre- and post-doctoral) whether or not compensated in whole or in part; persons performing research or engaging in work or study using University Resources; persons engaged by the University to perform research whether or not using University Resources; and other persons in research at the University or otherwise participating in a University program.
5. **Institutional Work** – a work created at the instigation of the University or under its direction for the University's use by a person acting within the scope of his or her employment or subject to a written contract.
6. **Traditional Work Of Scholarship** – a work, other than an Institutional Work, reflecting research and/or creativity which has been traditionally considered as evidence of professional advancement or accomplishment within the University. Such works include scholarly publications, journal articles, research bulletins, monographs, books, plays, poems, musical or choreographic works, paintings, sculptures, and other works of art.
7. **University Resources** - all tangible resources provided by the University, including office, lab, and studio space; equipment; computer hardware, software, and support; secretarial service; research, teaching, and lab assistants; supplies; utilities; funding for research and teaching activities, travel; and other funding or reimbursement. University Resources do not include salary, insurance, or retirement plan contributions.

8. **Incidental Use of University Resources or Facilities** – Incidental Use is the use of resources or facilities which are routinely made available to faculty and staff members in association with their normal responsibilities. This use of resources or facilities is not appreciable or readily measurable. Examples of Incidental Use of University Resources or Facilities include, but are not limited to, offices, laboratories, library facilities, and personal computers, as well as professional development leaves and other awards. Incidental costs may also include, but are not limited to, reasonable use of telephone services, and of office equipment such as photocopiers, fax machines, and printers. Final determination of questions about Incidental Use will be made by the AUIPC and the Provost and Chief Operating Officer.

9. **Equity** – the money value of a property or of an interest in a property in excess of claims or liens against it

Appendix 2

IP Disclosure Forms

Appendix 2A

**ALFRED UNIVERSITY
INVENTION DISCLOSURE FORM**

1. Inventor: List names of all inventors. If more than four inventors, attach additional sheets.

• **Inventor Name** _____ **Title** _____
Business Address _____ Business Phone _____
Business Fax _____ Department _____
Email address _____
Home Address _____
_____ Citizenship _____

• **Inventor Name** _____ **Title** _____
Business Address _____ Business Phone _____
Business Fax _____ Department _____
Email address _____
Home Address _____
_____ Citizenship _____

• **Inventor Name** _____ **Title** _____
Business Address _____ Business Phone _____
Business Fax _____ Department _____
Email address _____
Home Address _____
_____ Citizenship _____

• **Inventor Name** _____ **Title** _____
Business Address _____ Business Phone _____
Business Fax _____ Department _____
Email address _____

Home Address _____
_____ Citizenship _____

Contribution of each inventor: This percentage will be used to distribute revenues generated from any license of this disclosure. **Total must equal 100%.**

Inventor: _____ % _____

Inventor: _____ % _____

Inventor: _____ % _____

Inventor: _____ % _____

2. Invention Title:

3. Description of Invention: Attach description of invention, photographs, drawings, sketches, patent applications, and any other descriptive material. Description should include construction of the invention, principles involved, details of operation, and alternative methods of construction or operation.

4. Application of Invention: What are the immediate and/or future applications of the invention?

5. Novelty and Usefulness: Why is this invention better? What are its novel and unusual features? What problem(s) does it solve? What is your approach to the solution(s)? How does it differ from current solution(s) to the problem(s)? What are the advantages that your invention has over the current solution(s)?

6. Conception and Public Disclosure: In the United States, a patent application must be filed no later than one (1) year after the first publication, sale or offer for sale, or public use of the invention. (Note: use of overheads or a blackboard may be considered publication.) For foreign patent protection, filing must occur before any of these activities. Where there has been a filing in the U.S. before any of these activities has occurred, there will be a limited time to file a foreign patent application. Please complete all relevant questions with the foregoing and the following in mind.

- A. "Conception" involves the formulation in the mind of the inventor of the complete means to solve a problem. The mere recognition of a desirable result or of a problem or a general approach to solving the problem, without the formulation of the physical structure to accomplish the result or solve the problem, will not constitute conception.
- B. "First publication" means the first time any member of the public, which could include members of the Alfred community who are not aware of the need to keep an invention confidential, would have been legally able to gain access to the oral, written, or other enabling description of the invention without a confidentiality restriction.
- C. A "sale" or "offer for sale" could occur any time an invention is potentially available without any confidentiality or similar restriction.

What is the date of first conception of the invention? Has this date been documented? If so, where?

What is(are) the date(s), if any, of first publication of the invention? (Enclose drafts, abstracts, pre-prints, etc.) Has the invention been sold/offered for sale or publicly used? If so, please describe the circumstances of such event(s).

If the invention has not been disclosed, provide the expected publication or oral disclosure of the invention (and any related submissions made for potential

publication) and other activities which could “bar” the chance to file for patent protection on the invention. (Enclose drafts, abstracts, pre-prints, etc.)

7. Reduction to Practice:

“Reduction to practice” generally is the actual and complete use of the invention for its intended purpose, usually involving physical construction of the invention and testing its physical embodiment to determine whether it performs as contemplated. This is not always necessary if the invention can be fully described. With that in mind, has the invention been reduced to practice? If so, what was the date of the first reduction to practice? Is work on the invention continuing? Are there limitations to be overcome or other tasks to be done prior to practical application? Are there any test data? Have products, apparatus or compositions, etc., actually been made and tested?

8. Further Research: What further research and development is necessary or desirable before showing the invention to a potential industrial licensee?

9. Commercial Partners:

a. Names and addresses (if known) of potential commercial partners:

b. Companies presently offering comparable technology (if known):

c. Has the invention been disclosed to industry representatives? If "yes", provide details, including names of companies and their representatives:

NOTE: Valid intellectual property protection depends on accurate answers to the following items:

10. Related Developments: Are you aware of related developments by others? If "yes", please give citations. Copies of any relevant patents or publications would be appreciated.

11. Sponsorship: If the research that led to the invention was supported by extramural funding (sponsor) or involves the use of tangible research material provided by another university or company (provider), please provide the information below.

Sponsor/Provider Name: _____ Agreement Number or
Date: _____

Sponsor/Provider Name: _____ Agreement Number or
Date: _____

12. Signature of Inventor(s)

Signature Date

Signature Date

Signature Date

13. Signature of Witness

Name (printed)

Signature

Date

IMPORTANT NOTE: The Technology Disclosure requires the signature of a witness (other than one of the inventors), who has read and understood the invention disclosure on the date indicated next to his signature

Please hand deliver or mail the completed and fully signed disclosure to:

**Alfred University
Provost and Chief Operating Officer
Jordan Hall
1 Saxon Drive
Alfred, NY 14802-1205
Tel: (607) 871-2137**

Appendix 2

IP Disclosure Forms

Appendix 2B

**ALFRED UNIVERSITY
COPYRIGHT DISCLOSURE FORM**

1. AUTHOR(S): Please list names of all authors. The Lead author is a designation for Provost and Chief Operating Officer database retrieval purposes only.

Please Print or Type:

NAME	DEPARTMENT	PHONE	TITLE	CITIZENSHIP
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2. CONTRIBUTION OF EACH AUTHOR

3. TITLE OF THIS WORK

4. PREVIOUS OR ALTERNATIVE TITLE

5. NATURE OF AUTHORSHIP Briefly describe nature of material created by this author(s) in which copyright is claimed

6. PUBLICATION AS A CONTRIBUTION If this work was published as a contribution to a periodical, serial, or collection, give information about the collective work in which the contribution appeared.

Title of Collection Work:

IMPORTANT NOTE: This Copyright Disclosure is not valid unless a person (other than one of the author(s)) who understands the creation has witnessed the above signature(s).

Please hand deliver or mail the completed and fully signed disclosure to:

**Alfred University
Provost and Chief Operating Office
Jordan Hall
1 Saxon Drive
Alfred, NY 14802-1205
Tel: (607) 871-2137**

Appendix 3

IP and Proprietary Information Agreement

**Alfred University
Intellectual Property and Proprietary Information Agreement**

Name (please print or type): _____ (“I” or “my”)
Social Security No.: _____
Department: _____

This Agreement is made in consideration of the following:

- My continuing or anticipated employment at Alfred University (“University”);
- My performance of research at the University;
- Opportunities made or to be made available to me to make significant use of University Resources; and/or
- Opportunities to share in royalties and other rights outlined in the University Intellectual Property Policy (“Policy”) in effect from time to time.

In exchange for the consideration listed above, I agree to each of the following:

- A. To disclose promptly to and assign to the University all rights to all Intellectual Property, as defined in the Policy, which has been or will be conceived, invented, authored, or reduced to practice by me, either solely or jointly with others, which:
 - (i) is developed in the course of or pursuant to a sponsored research or other agreement in which I am a participant;
 - (ii) results from the significant use of University Resources (as defined in the Policy); or
 - (iii) is an Institutional Work (as defined in the Policy).
- B. During and subsequent to the period of my the University affiliation, to execute all necessary papers and otherwise promptly provide proper assistance at the University’s request and at the University's expense to enable the University to obtain, maintain, or enforce for itself or its nominees such Intellectual Property.
- C. To prepare and maintain for the University adequate and current written records of all such Intellectual Property.
- D. To deliver promptly to the University when I leave the University for whatever reason, and at any other time as the University may request, copies of all written records referred to in Paragraph C. above as well as all related memoranda, notes, records, schedules,

Appendix 4

IP Special Project Proposal

Name (please print or type): _____ (“I” or “my”)
Department: _____

This Proposal is made in consideration of the following:

My continuing or anticipated employment at Alfred University (“University”);

My performance of research at the University;

Opportunities made or to be made available to me to make significant use of University Resources; and/or

Opportunities to share in royalties and other rights outlined in the University Intellectual Property Policy (“Policy”) in effect from time to time.

In exchange for the consideration listed above, I/we propose the following:

A.: _____

B. This endeavor will require the University to share ownership of any arising patent rights with _____. This will benefit the University in the following manner:

I represent that, except as identified on the pages attached hereto, I have no agreements with or obligations to others in conflict with the foregoing.

In witness whereof, I have signed this Agreement as indicated below.

Signature Party’s Signature (include full first name)

_____, 200__

Print Name

Date

Witness Party's Signature (include full first name)

Print Name

Date

, 200__

Return to: the Provost and Chief Operating Officer

