

Addendum to Staff Handbook

Intellectual Property Policy

Introduction and Scope.

a) Miles College is a private liberal arts College that embraces its mission of teaching and academically preparing students. The College encourages research and scholarship and recognizes that inventions, discoveries, and creative works may arise from the scholarly activities of the College. Miles promotes the use of such intellectual property for the public good and encourages development and commercialization of inventions, discoveries, and creative works through patenting or copyrighting.

b) Miles may designate one or more commercialization agent(s) for the intellectual property of the College. To accomplish this, Miles College shall assign to such agent(s) the rights, title, and interest to certain intellectual property created, invented, or discovered by Miles faculty, staff, students, and others for the purpose of evaluation, filing for appropriate legal protection, marketing, and development.

c) All rights in intellectual property subject to this policy shall be allocated in accordance with this intellectual property policy and other College policies. The Appendices to this Policy provide additional information and serve to implement and may further define the Policy.

Types of Intellectual Property Subject to this Policy.

Except as set forth in other related College policies, this policy applies to all types of intellectual property, including, but not limited to, any invention, discovery, creation, know-how, trade secret, technology, scientific or technological development, mask work, trademark, research data, work of authorship, and computer software regardless of whether subject to protection under patent, trademark copyright, or other laws.

Individuals Subject to this Policy.

This intellectual property policy applies to:

a) All persons employed by, paid by, or under contract with Miles College, unless expressly exempted by contract, including, but not limited to, full and part-time faculty and staff and visiting faculty members and researchers, consultants, and students.

b) Students working on sponsored projects and/or who use Miles College resources other than for lecture-based coursework or other course-related assignments.

c) Anyone using the facilities or resources of the College, as defined in this policy, or the facilities of any entity affiliated with Miles College for the purposes or in the manner described in “Determination of Ownership Rights in Intellectual Property.”

College Resources. For purposes of this policy, use of College resources:

a) Means the use of College funds, facilities, equipment, personnel, tangible or intangible research materials, information and/or materials that are not publicly or freely available to the public, and funds provided through externally funded grants, contracts, or other types of awards or agreements with third parties – including gifts to the College, and anything not covered in subsection (b) below.

b) Does not include the use of College designated office space, routinely available office-type equipment such as desktop personal computers, and the College library facilities.

Determination of Ownership Rights in Intellectual Property. Unless provided for otherwise in this policy:

a. College Ownership. The College retains all rights to any intellectual property conceived, created, developed, fixed*, or first actually reduced to practice by a Creator:

i. Within the scope of their employment or official association and/or appointment with the College – inclusive of summer months and holidays; or

ii. As part of activities directly or indirectly related to College research whether the research is externally or internally funded or pursuant to an agreement or contract of any type (including gifts) between the College and a third party; or

iii. In support of specific College initiatives; or

iv. Using College resources, including any resources provided through externally funded and/or outreach initiatives.

v. For clarification purposes, the College shall retain rights to:

1. Classes and/or Courseware developed for teaching at the College whether fixed in tangible or electronic media. For illustration purposes only, a Class includes the syllabus and any Class notes, if provided, but would not include teaching notes. Courseware includes any and all software and digital material (in any media).

Any Classes which are videotaped or recorded using any other media are College property, and may not be further distributed without permission from the College and pursuant to an approved contractual agreement. Prior to videotaping, permission should be obtained from anyone who will appear in the final program. Permission is not required for 1) the use of videotaped or recorded Classes for student related or other College purposes or 2) for evanescent recordings.

With regard to Courseware, if the College enters into an agreement with a third party to license or otherwise authorize the use, distribution, replication, and sale of such Courseware to third parties for a profit, the College and Author shall share the Copyright Income related to such transactions in accordance with the Income Distribution Plan.

2. Any and all Marks (trademarks and service marks) relating to Miles College and its affiliates. Pursuant to this Policy, College faculty, staff and students grant and assign to Miles College their entire right, title and interest in and to all marks which relate in any way to the business or activities of Miles College.

Note: Research data or results created by an employee are owned by the College and, except to the extent that rights to such research data have not been contractually assigned or licensed to a third party, the Creator shall have a nonexclusive, perpetual license to use such data for nonprofit educational research and scholarly purposes within the scope of the employee's employment, subject to other provisions of this policy. Inventorship shall be determined in accordance with United States Patent Law.

* Under Section 101 of the 1976 Copyright Act, "a work is fixed in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. A work consisting of sounds, images, or both, that are being transmitted, is fixed for purposes of this title if a fixation of the work is being made simultaneously with its transmission."

**Evanescent works include "those projected briefly on a screen, shown electronically on a television or cathode ray tube, or captured momentarily in the 'memory' of a computer." (House Rpt., at 53, reprinted in 1976 U.S.C.C.A.N. 5666-67).

b. Creator Ownership. Creator(s) shall retain all rights to any intellectual property authored, invented, created, discovered, developed, or generated by Creator(s):

i. On the Creator's own personal, unpaid time; or

ii. Unrelated to the individual's College responsibilities; and

iii. Without the use of College resources, including any resources provided through externally funded programs or contracts (including gifts).

iv. For clarification purposes, Creators shall retain rights to :

1. Creative or scholarly works including artworks, musical compositions, and literary works directly related to their professional endeavors, credentials, and/or activities. This includes any personal material created, developed, or used solely by Authors in connection with their delivery of College Classes.

2. Textbooks and other materials which are developed without aid or compensation from the College.

c. Student Ownership Exception. In accordance with this policy, student Creators do not hold the rights to intellectual property created, developed, or generated:

i. In the course of rendering compensated services to the College; or

ii. As part of sponsored research or projects; or

iii. Pursuant to an agreement that requires the College and/or student to assign his or her rights either to the College or to a third party; or

iv. Using pre-existing or background intellectual property belonging to the College or to a third party with whom the College has a contract under which such background intellectual property rights are already allocated.

v. Notes:

1. Student retains a non-exclusive, royalty-free, perpetual, irrevocable license to use, reproduce, and publicly distribute, for educational and/or research purposes, copies of intellectual property created by student.

2. If intellectual property is developed or generated as a group class project, joint ownership by the collaborators will be assumed unless a prior written agreement exists among the collaborators.

d. Other. There may be instances when College faculty, staff, students, and/or others enter into written agreements with the College to collaborate in the development of intellectual property. These agreements may provide for allocation of intellectual property rights in a manner that is not consistent with this Policy. Each such agreement shall be valid only when approved by the College. While each agreement may contain unique provisions, all such agreements must require disclosure of any intellectual property in accordance with the terms of this Policy.

Use of Facilities and Resources.

Unless authorized or allowed under a College policy, the Miles College facilities and resources shall not be used to:

a) Create, develop, or commercialize intellectual property outside the course and scope of employment and/or College related-responsibilities of the individual; or

b) To further develop or commercialize intellectual properties that have been licensed, released, or are otherwise subject to third party interests except as approved by the College in instances where the College has retained an interest under the terms of the license or release.

Background Information and Special Issues

1. Patents

a. Objectives.

The objectives of the College's policy regarding patents include the following:

i. Encourage research and scholarship as creative academic endeavors while recognizing that commercially viable inventions may yield benefits to both the College and inventors;

ii. Delineate procedures that assist inventors in reporting discoveries with patent potential and safeguard the interests of all concerned parties;

iii. Make inventions resulting from academic research available to the public and promote their effective utilization and development;

iv. Provide adequate recognition and incentives to inventors through shares in proceeds from their inventions; and

v. Provide an appropriate framework to recognize the equity of sponsors by allowing reasonable and equitable provisions for the granting of patent rights to the sponsor.

b. Term. Generally, the term of a new patent is 20 years from the date on which the application for the patent was filed in the United States or, in special cases, from the date an earlier related application was filed, subject to the payment of maintenance fees. U.S. patent grants are effective only within the United States, U.S. territories, and U.S. possessions. Under certain circumstances, patent term extensions or adjustments may be available.

c. Protection. A provisional application may be filed as a “lower-cost first patent filing” to secure an initial filing date for an invention that will be the subject of a corresponding non-provisional application.

1) To retain the initial date, the non-provisional application must be filed within one year of the provisional application filing date.

2) The provisional application does not require a formal patent claim, oath or declaration, or any information disclosure (prior art) statement and allows the inventor to use the term "Patent Pending" when describing the invention.

3) The inventor may convert the provisional application to a non-provisional application by filing a petition within one year of the provisional application filing date; however, the term of the patent associated with the invention will be negatively impacted since the term will be measured from the filing date of the non-provisional application.

d. Ownership.

The rights of Miles College in patents arising from research will vary in accordance with the College Intellectual Property Policy.

In order to avoid any questions concerning the tax exempt status of financing used for certain College facilities/resources, Miles shall, with regard to sponsored research activities, seek to:

- i. Retain ownership of inventions arising during performance of research sponsored by any private industry and/or federal Government sponsor and
- ii. Grant to such sponsor(s) any right in the invention under compensation terms that are set after the time when the invention comes into existence and that are at a fair market level of compensation to Miles. Under the terms of certain contracts and agreements between Miles and various sponsors, Miles may be required to license patent rights to the contracting party.
- iii. Miles retains the right to enter into such agreements whenever such action is considered to be both in its best interest and in the public interest. The College will not agree to grant any rights in future inventions to private corporations or businesses unless such provision is included in the contract that sponsored the work leading to the invention.
- iv. Special cases not covered by the above statements or which arise because of conflict of interest shall be considered by the College.
- v. In the absence of an agreement allocating intellectual property rights, and subject to any licensing arrangements and this Policy, Miles College's policy with regard to ownership of intellectual property is as follows:

1. College shall retain title to all intellectual property including supporting data for all discoveries and/or inventions made exclusively by any individual subject to this Intellectual Property Policy.
2. College shall share ownership of intellectual property including supporting data for all discoveries and/or inventions made jointly by any individual subject to this Intellectual Property Policy and a third party.

e. College Responsibilities.

During the summer sessions and extended College holiday periods, the College will have the authority to: a) Expedite the review of patent disclosures deemed time critical, in terms of negotiations with prospective licensees, meeting filing deadlines, and the like; b) Initiate negotiations with prospective licensees for patent filing/processing fees or the like; and c) Such other activities that are time critical and cannot be delayed for handling at a regular or special called meeting or semester.

f. Record Keeping Guidelines.

Good laboratory practice dictates the use of bound notebooks for record keeping, making entries on a daily basis. This "diary" format provides a day-to-day chronology. Use the notebook to record a conception (a complete description of a means to accomplish a particular purpose or result), laboratory data, and drawings. Each entry should be headed with a title and continued on successive pages. Make entries in ink and do not erase; instead, draw a line through text or drawings to be deleted and enter the material in corrected form. Draw a line through any blank spaces on the page. Separate sheets and photographs pasted to notebook pages should be referred to in an entry. Material that cannot be incorporated in the notebook should be keyed to an entry. Sign and date all entries at the time they are made and have them witnessed by an individual who is capable of understanding the material yet had nothing to do with producing it. Secure additional witnesses when something important or highly unusual is discovered. Remember that an inventor and his or her co-inventor(s) cannot serve as their own witnesses. Records - when made a matter of routine - take only a small amount of time and effort, become an invaluable asset to work in progress, and may ultimately reserve for the inventor those rights to which he or she is, by priority, entitled. Records that support the conception, development and demonstration of a particular intellectual property should be available for review by the College and patent officials at each stage of review of a particular disclosure.

2. Copyrights

a. Introduction and Scope.

Copyright ownership and rights are defined by federal law. College policy is structured within the context of the federal copyright law and the long-standing academic tradition that Creators of works own the copyright resulting from their research, teaching, and writing. Exceptions to this rule may result from contractual obligations, from employment obligations, from certain uses of College facilities/resources, or by agreement governing access to certain College resources. This Policy addresses these exceptions.

The 1976 Copyright Act generally gives the owner of copyright the exclusive right to reproduce the copyrighted work, to prepare derivative works, to distribute copies of the copyrighted work, to perform the copyrighted work publicly, or to display the copyrighted work publicly. The copyright protects the form of expression rather than the subject matter of the writing. For example, a description of a machine could be copyrighted, but this would only prevent others from copying the description; it would not prevent others from writing a description of their own or from making and using the machine.

b. Copyrighted Materials may include the following:

- Books, journal articles, texts, glossaries, bibliographies, class notes, study guides, laboratory manuals, reports, syllabi, tests, and proposals;
- Lectures, musical or dramatic compositions, unpublished script, works of art;

- Films, filmstrips, charts, transparencies, and other visual aids;
- Video and audio tapes or cassettes;
- Live video and audio broadcasts;
- Programmed instructional materials;
- Mask works;
- Other materials or works that qualify for protection under the copyright laws of the United States (USC 102).

c. Ownership. Copyright ownership of all work by College employees or students shall be allocated in accordance with the College Intellectual Property Policy. When using outside consultants/independent contractors to perform work for the College, whether under a sponsored program or otherwise, College employees must ensure there is a written agreement or adequate provisions in other agreements with the consultants/independent contractors to assign the rights to and in all works to the College.

2. Computer Software Copyrights

a. Ownership. Ownership of computer software developed by faculty, staff, and student employees of the College shall be handled in accordance with the College Intellectual Property Policy.

b. Funding by Other College Agent(s). If computer software is developed by faculty, staff, or student employees but funded by another designated College agent(s) pursuant to a contract between the parties, then the College shall require the designated agent(s) to pay the Creator(s) the royalty payments that the Creators(s) would have received after appropriate review and recommendation by the College if the computer software had been funded and developed by the College.

Appeal Process.

a) A Creator may appeal a decision or determination made pursuant to this policy by submitting an appeal in writing to the College within thirty (30) days of receiving notice of the decision or determination.

b) The College shall review the appeal and render a decision in writing within a reasonable time of receiving the appeal.

- a) "Class" includes a set of educational objectives that are identified in a syllabus and delivered either by an instructor, or under an instructor's supervision and pursuant to the College's policies.
- b) "Class Notes" are notes or other instructional material provided to the participants by the instructor as part of a Class.
- c) "Copyright" is a form of protection provided to the authors of "original works of authorship" including literary, dramatic, musical, artistic, and certain other intellectual works, both published and unpublished.
- d) "Copyright Income" is defined to include income associated with any copyright disclosure made to the IPC for exploitation, even if the income is received before a copyright application has been filed or a copyright issued, and includes such monies received as royalties, fees, advanced payments, court awarded infringement damages, payments received in settlement of infringement disputes, and the like, calculated after the costs of exploiting the disclosure have been reimbursed to the employee(s) or the College, whichever funded the original exploitation. Some examples of such costs are the cost of securing the appropriate copyright licenses, and other legal efforts as required. Copyright Income shall not include indirect economic benefits resulting from the technological position established by the copyrighted technology or the sale of derived articles or concepts, including such items as a follow-on sponsored program that uses the copyrighted technology as a basis for future work.
- e) "Courseware" shall mean educational material in the form of software programs/applications and data (usually digital and/or packaged for use with a computer) and intended for classroom instruction (in class or remotely) or for a self-learning or faculty/coach assisted program.
- f) "Creative and Scholarly Works" shall mean traditional academic publications, such as professional papers published in scholarly journals, or newly created texts published in journals or books.
- g) "Creator" is defined as an author of, inventor of, or person who discovers, develops, or generates any type of intellectual property. Inventorship and authorship shall be determined in accordance with patent law and copyright law, respectively.
- h) "Intellectual Property" shall mean any patentable materials, copyrighted materials, trademarks and service marks, software, art and creative endeavors, and trade secrets, whether or not formal protection is sought.
- i) "Patent" refers to the grant of a property right to the inventor, issued by the United States Patent and Trademark Office (USPTO) or foreign analog.
- j) "Patent Income" is defined to include income associated with any patent disclosure made to the College for exploitation, even if the income is received before a patent application has been filed

or a patent issued, and includes such monies received as royalties, fees, advanced payments, court awarded infringement damages, payments received in settlement of infringement disputes, and the like, calculated after the costs of exploiting the disclosure have been reimbursed to the College. Some examples of such costs include, but are not limited to, the cost of securing the patent, appropriate licenses, and other legal efforts as required. Patent Income shall not include indirect economic benefits resulting from the technological position established by the patented technology or the sale of derived articles or concepts, including such items as follow-on sponsored programs that use the patented technology as a basis for future work.

k) "Software" shall mean one or more computer programs existing in any form, along with any associated operational procedures, manual, or other documentation, whether or not protectable or protected by patent or copyright. The term "computer program" shall mean a set of instructions and statements of related data that, in actual or modified form, is capable of causing a computer or computer system to perform specified functions.

l) "Teaching Notes" are the personal notes of the instructor regarding the delivery of a Class.

m) "Trade Secret" shall refer to information that companies keep secret to give them an advantage over their competitors.

n) "Trademark" is a word, phrase, symbol, or design, or a combination thereof, that identifies and distinguishes the source of the goods of one party from those of others. A "service mark" is the same as a trademark except that it identifies and distinguishes the source of a service rather than a product. The College is concerned only with trademark issues that pertain to patented or copyrighted Intellectual Property of the College. All other trademark issues should be directed to the appropriate College officials.

o) "College" includes Miles College and all of its administrative units, including but not limited to departments, centers, institutes, consortia and other similar organizations, regardless of source of funding.

Publication.

Faculty, staff, students, and others may contract with third parties to publish their own research results and other scholarly information unless there are contractually imposed restrictions or temporary restrictions imposed to protect intellectual property that may be the subject of an application for intellectual property protection.

Disclosure of Intellectual Property.

All Creators have a duty to promptly disclose any intellectual property authored, invented, created, discovered, developed, or generated by Creator(s) to Miles College in accordance with the procedures in this policy.

Assignment of Intellectual Property.

- a) If any intellectual property is determined, in accordance with this policy, to be owned by Miles College, Miles College may, at its sole discretion, assign all rights, title, and interests to one or more designated commercialization agents.
- b) Faculty, staff, students, and others may not assign or license intellectual property owned by the College without the written consent of the College or its designated commercialization agent(s), as applicable. The College has the ultimate right to resolve any conflicts relating to ownership of intellectual property rights arising in connection with contracts between the College and third parties or organizations.
- c) In the event that faculty, staff, students, or others are Creators of intellectual property owned by an external entity and the intellectual property does not fall within the scope of this Policy, (e.g., it is not the subject of an agreement between the external entity and the College/its designated commercialization agent(s)) this intellectual property policy will not apply. Neither Miles College nor its designated commercialization agent(s) will have any obligations with regard to negotiation of terms and conditions, patenting, licensing, or royalty distribution.
- d) When using outside consultants/independent contractors to perform work for the College that is not specifically identified in a sponsored research or other contract, there must be a written agreement established through procurement or other College policies/mechanisms ensuring proper assignment of intellectual property.
- e) Any special cases and unique situations relating to intellectual property and not specifically covered by this policy or any other College policy, or which arise because of conflict(s) of interest, shall be brought to the attention of the College Administration.

College Holiday Periods.

During the summer sessions and extended College holiday periods, the College will have the authority to: a) Expedite the review of intellectual property disclosures deemed time critical, in terms of negotiations with prospective licensees, meeting filing deadlines, and the like; b) initiate negotiations with prospective licensees for patent filing/processing fees or the like; and c) such other activities that are time critical and cannot be delayed for handling at a regular or special called meeting or semester.

Intellectual Property Disclosure and Related Procedures.

- a) Creators have a duty to promptly disclose all Intellectual Property to the College.
- b) With regard to College owned intellectual property, particularly patents and/or patentable inventions, each Creator has a duty to promptly disclose any intellectual property discovered, conceived, or first reduced to practice to the College prior to disclosing such information to ANY other third party.
- c) When a disclosure of Intellectual Property is received by the College, it has a duty to promptly evaluate and provide final disposition of the rights to the intellectual property disclosed. The College shall determine a preliminary course of action based on the commercial potential of the invention. The College will provide notice of any potential delays, and recommend alternative courses of action if unexpected delays are encountered.
- d) After reviewing the relevant materials and conducting discussions with the Creator(s), the College may recommend that additional information be gathered to determine the ownership, legal, competitive, and market issues that have bearing on the patenting, copyrighting, or trademark decision. After that information is collected and evaluated, the College will recommend one of two courses of action:
 - i. Assert its sole interest in the intellectual property in writing and recommend that the College pursue an application for protection using its own financial and legal resources and/or refer the intellectual property to a designated commercialization agent as determined by College's agreement with such commercialization agent;
 - ii. Return or assign sole interest in the Intellectual Property to the Creator(s) for their own pursuits, relinquishing in writing all College interests in said Intellectual Property as well as any related responsibilities for costs and reserving for itself a fee-free and royalty-free, perpetual, irrevocable license to use the Intellectual Property in its academic, research and other non-commercial scholarly endeavors. The agreement between the parties shall be in accordance with this policy.
- e) For trademark requests, the College will forward a decision to the Responsible Individual/Organization.
- f) If the College pursues a patent or copyright application, its designated commercialization agent shall manage the interactions and timelines with attorneys and the USPTO but will rely on the Creator(s) to provide sufficient technical details and insight so that attorneys will be able to craft the best possible protection.
- g) Pursuit of foreign patent applications will only be recommended to the College when: (a) there is substantial justification for the commercial potential of the invention; (b) one or more firms have expressed their intent or made a commitment to license the technology; or (c) a

potential licensee will assume all filing and other foreign application costs. Foreign patent applications will be reviewed annually and may be dropped at the College's discretion depending on actual or potential licensing activity. With the College's approval and subject to mutual agreement regarding the allocation of each party's rights, Creators and/or sponsors may request and be granted rights to assume such costs on foreign patent applications.

h) If a patent is dropped or abandoned, the rights may be released to the inventor(s) subject to a stipulation that any direct patenting costs incurred by the College be reimbursed if the patent generates income. If and when appropriate, income distribution arrangements shall be handled on a case by case basis between the College and the inventor(s) and shall be subject to College approval. The College shall review the status of all disclosures and pending or issued patents provided by the designated commercialization agent in accordance with College policies.

i) Reassignment to Creator(s) of College Intellectual Property.

Should the College, or its designated commercialization agent(s), decide not to assert its rights in and to the Intellectual Property for administration, or if at any future time decide not to take any further action in protection or commercialization of the Intellectual Property, it shall exert reasonable efforts to notify the Creator(s) and, upon request of the Creator(s), and subject to prior commitments or obligations, relinquish in writing all College interests in the Intellectual Property as well as any related responsibilities for costs and release the Intellectual Property to the Creator(s) in accordance with the following:

1) The Creator(s) agree to maintain the technology at their expense from the point of the assignment forward;

2) The assignment is consistent with any obligations to third parties, including but not limited to unreimbursed fees, any legal obligations, or any approvals from sponsors necessary prior to release; and

3) The assignment to the Creator(s) does not involve a conflict of interest.

4) In the case of Federal agency sponsorship, any release must be made to the Federal Government, following which the Creator(s) may directly petition the federal agency for a release of the rights to himself or herself. Decisions by the Federal sponsors to permit individual Creator(s) to acquire ownership are generally made on a case-by-case basis with the Federal Government retaining for itself certain rights as provided for in federal patent laws.

ii. In the case that unreimbursed fees of third parties or unreimbursed fees incurred by the College, or its designated commercialization agent(s), exist, the Intellectual Property may be licensed to the Creator(s) until all fees are repaid. At which time the Creator(s) may be assigned the Intellectual Property pursuant to section (a) above.

iii. In exchange for such assignment, the Creator(s) shall grant the College a perpetual, irrevocable, fee and royalty free license to use such intellectual property for research, academic and other scholarly purposes of the College.

Infringements.

Faculty, staff, and students should notify the College Office of Technology Transfer of any potential infringement of protected College intellectual property.

The Office of the President and College legal counsel.

Applicable Laws. The provisions of this Policy are subject to any applicable laws and regulations. Grants or contracts between external sponsors and the College under which intellectual property is produced may contain specific provisions with respect to disposition of rights to such property that may differ from those contained in this policy. Under the terms of certain contracts and agreements between the College and various agencies of government, private and public corporations, and private interests, the College may be required to license patent rights to the contracting party. Miles retains the right to enter into such agreements whenever such action is considered to be both in its best interest and in the public interest.

The Library of Congress United States Copyright Office: <http://www.copyright.gov/>

Date Entity Action

 Adopted

