



# Howard University Intellectual Property Policy

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**Issuing Authority:** Board of Trustees, September 23, 1993

## Purpose:

The Howard University Intellectual Property Policy provides guidance on policies governing inventions, patents, copyrights, trademarks, and other intellectual property arising from sponsored research programs. Faculty, staff, students, and trainee employees (but not clerical or manual workers) are, in general, required to sign agreements assigning patent rights to the University. Net proceeds from any inventions are shared with the inventor as described in the University's Intellectual Property Policy. Deans and directors obtain signed copies of this agreement from all staff and students in specified departments at the time of employment, and a signed agreement is required before salary is paid. For additional information pertaining to patents, copyrights, etc., contact the Office of the General Counsel at (202) 806-2650.

## Policy:

### I. Definitions

**Intellectual Property:** The tangible embodiment of any product of the human intellect, including patentable inventions, copyrightable works and trademarks.

**Copyright:** A form of protection provided by the laws of the United States to authors of original works of authorship fixed in a tangible form of expression including literary, dramatic, musical, artistic, and certain other intellectual works. Copyrightable works include, but are not limited to, the following: books, periodicals, lectures, dramatic compositions, musical compositions, maps, works of art, drawings or plastic works of a scientific or technical character, computer programs, programmed instructional material, photographs, pictorial illustrations, motion pictures and video tapes, and audio recordings. Copyright protection does not extend to an idea, process, concept or discovery but only to the work in which it may be embodied, illustrated, or explained.

**Patent:** A form of protection provided by the laws of the United States (through a grant of "letters patent") for a term of seventeen years giving an inventor the right to exclude all others from making, using, or selling his or her invention within the United States, its territories and possessions. A patent may be granted to the inventor or discoverer of any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, or any distinct and new variety of plant, (other than a tuberpropagated plant) or any new, original, and ornamental design for an article of manufacture.

Inventors and/or discoverers must be aware that an invention may become unpatentable unless a formal application is filed with the U.S. Patent and Trademark Office in a timely manner.



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**Trademark:** Any word, name, symbol, or device, or any combination thereof adopted and used by persons in commerce to identify their goods and distinguish them from those manufactured or sold by others. When used herein, the term also encompasses "service marks" which specifically refers to marks used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others.

**Employee:** For purposes of this policy, any member of the faculty, staff or student body who works for the University and is compensated for such services via a University payroll check, annually reported on form 1099. Graduate Assistants shall specifically be considered employees of the University for the purposes of this policy.

**Committee:** The Intellectual Property Committee described in section VI.86

## **II. Objectives**

The policies and procedures relating to intellectual property developed at Howard University are directed toward the following objectives and purposes:

- A. To facilitate the publication of original works, the transfer of technology, and the utilization of findings of scientific research in order to provide maximum benefit to the public therefrom.
- B. To assist in an equitable disposition of interests in intellectual property among the originator, the University, and, when applicable, the sponsor.
- C. To protect the rights and economic interests of originators while providing individual incentives in the form of personal development, professional recognition, and financial compensation.
- D. To comply with applicable federal laws and regulations when the University accepts federal funds for research and, further, to assist in the fulfillment of the terms of private research grants and contracts.

## **III. Rights to Intellectual Property**

**The rights, ownership and disposition of all intellectual properties shall be determined as follows:**

- A. 1. **Copyrights:** Except as provided below, copyrightable works authored by a member of the faculty shall be presumed to be owned by that faculty member. Such works may be registered, sold and licensed by the author without permission or payment to the University. (Works authored by non-faculty employees, however, shall be presumed to be "works for hire" as described in section III. B. 2., below).
- A. 2. **The University may assert ownership of copyrightable works created under the following conditions:**
  - a. Works created pursuant to agreements with governmental or private entities shall be governed according to such agreements. Where the agreement does not



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- specify the disposition of the work, or refers the disposition to University policy, such work shall be considered subject to a claim of ownership by the University.
- b. "Works for hire" shall be considered the property of the University. Works for hire are defined in the Copyright Act of 1976, as amended, and generally arise in the following situations.
    - i. The author is an employee of the University and the creation of the copyrightable work is within the scope of the author's employment.
    - ii. The University specifically commissions a work from a faculty or staff member. Agreements for such works should generally be in writing and executed prior to commencement of the work.
  - c. The creation of the copyrightable work involves substantial University resources as determined by the Intellectual Property Committee. The use of University libraries, classrooms, office space, word processors or other minor uses of University computers shall not, by themselves, be considered use of substantial University resources.
- B. **Patents:** In general, patentable works created by University employees while employed by the University shall be presumed to be subject to a claim of ownership by the University. Patentable works shall not be subject to ownership claims by the University, however, where the creation of the work did not involve the use of substantial University resources, as determined by the Intellectual Property Committee. The use of University libraries, classrooms, office space, word processors or other minor uses of University computers shall not, by themselves, be considered the use of substantial University resources.
- C. 1. **Trade and Service Marks:** In general, trade and service marks created by a member of the faculty shall be presumed to be owned by that faculty member. Such marks may be registered, licensed or sold without permission or payment to the University. (Marks created by non-faculty employees, however, shall be presumed to be "works for hire" as described in section III. C. 2. b., below).
- C. 2. The University may assert ownership to service or trademarks created under the following conditions:
- a. Works created pursuant to agreements with governmental or private entities shall be governed according to such agreements. Where the agreement does not specify the disposition of the works, or refers the disposition to University policy, such works shall be considered the property of the University.
  - b. "Works for hire" shall be considered the property of the University. Works for hire generally arise in the following situations.



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- i. The creator of the trade or service mark is a non-faculty employee and the creation of the work is within the scope of the creator's employment.
  - ii. The University specifically commissions a work from an employee. Agreements for such works should generally be writing and executed prior to commencement of the work.
  - c. The creation of the work involves substantial University resources as determined by the Intellectual Property committee. The use of University libraries, classrooms, office space, word processors or other minor uses of University computers shall not, by themselves, be considered the use of substantial University resources.
- D. Where the Intellectual Property committee determines that the University has an ownership interest in a work, the originator shall, upon request, promptly execute all contracts, assignments, waivers or other documents necessary to vest in the University or its assignees rights to work.
- E. Notwithstanding the ownership rights of the originator of the work, a faculty or staff member may, upon the agreement of the University, assign or otherwise transfer his or her rights to the University on terms and conditions acceptable to the parties.
- F. Notwithstanding the ownership rights of the originator of the work, the University shall have the right to use, at no cost and for educational purposes only, all intellectual properties created while the faculty or staff member is working at the University and utilized during the course of their teaching or employment activities.

### **IV. Division of Income**

**All income derived from properties to which the University claims ownership shall be distributed in accordance with the following rules:**

- A. The University will first deduct any direct expenses incurred by it in connection with the preparation, filing, marketing, exploitation or defense of the property. Any such expenses incurred by the originator with the prior written approval of the Intellectual Property Committee shall also be deducted and paid to the originator. The income remaining shall constitute "net income".
- B. Unless otherwise agreed between the University and the originator the University will next deduct and pay to the originator 50% of the net income.
- C. The remaining income will be used by the University to pay for the general support of scientific research and education at the University.
- D. Notwithstanding the above, if the University utilizes the services of a separate management organization, only the University's share of revenues, after the payment of



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expenses (including those of the management organization), will be considered to be net income. All revenues from properties managed by a management organization shall be subject to the terms of the agreement between the University and the management organization.

### **V. Disclosure of Intellectual Properties for Classification**

All faculty, staff, students and employees of the University who, during their associations with the University, develop or originate any intellectual property whether or not on University time or with University facilities, shall cooperate with the University in defining the rights to such properties by promptly reporting to the Intellectual Property Committee on the University's Disclosure Form. This disclosure obligation shall apply to all works where there is a reasonable basis for the assertion of University ownership. The information included in such disclosure is confidential and should not be revealed to others until reviewed by the Intellectual Property Committee. The disclosure should be in the form of a written report and should identify the contract, if any, under which the invention was made and the inventor(s). The disclosure should also identify any publication, or sale or public use of the invention and whether a manuscript describing the invention has been submitted for publication and, if so, whether it has been accepted for publication at the time of disclosure. In addition, after disclosure, the Inventor will promptly notify the Intellectual Property Committee of the acceptance of any manuscript describing the invention for publication or of any sale or public use planned by the Seller.

### **VI. Intellectual Property Administration**

- A. The President of the University shall appoint an Intellectual Property Committee, which shall be generally responsible for administering this Policy. The Intellectual Property Committee shall:
1. Receive all disclosures of properties submitted under this Policy.
  2. Determine the ownership of properties in accordance with guidelines developed by the Committee and approved by the President.
  3. Determine whether a property, which the University owns, is subject to protection through patent, copyright or trademark registration.
  4. In consultation with the originator, the Office of the General Counsel and outside consultants, evaluate potential commercial use and investigate possible courses of action for protecting and/or marketing properties in which the University has an ownership interest.
  5. Authorize the negotiation of licensing and technology transfer agreements.
  6. Maintain complete records on all disclosures and other intellectual property matters of interest to the University administration.
  7. Prepare periodic reports of the Intellectual Property Committee to the President and the Board of Trustees as requested.



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8. Administer this Policy and serve as a clearinghouse for proposed revisions.
- B. The Intellectual Property Committee shall consist of seven voting members who shall be appointed by the President. Five committee members shall be selected from names provided by the University's Senate for a term of four years and shall include one faculty member from the College of Medicine and one from the College of Engineering. Two committee members shall be selected from the administrative staff, one of whom shall be the Associate Provost for Research. The General Counsel to the University or his designee, shall serve as an ex-officio, non-voting member to the committee and shall advise the Committee members. The Intellectual Property Committee shall sit as a tribunal for the resolution of specific disputes involving the ownership of any equities involved in specific properties. Decisions rendered by the Intellectual Property Committee shall be final except for decisions, which are appealed to the President by any person claiming an ownership interest in a property. Any such appeal must be made in writing within thirty days of the disputed decision and the action of the President shall be final.

[The following provisions relate specifically to patentable inventions].

### **VII. Invention Management**

- A. With respect to all inventions to which the University asserts ownership, the patent rights shall be assigned by the originator to the University.
- B. For all patent rights assigned to the University under this Policy, the University will at no expense to the originator make reasonable efforts to evaluate the interest of others in commercializing the property, seek licenses and options for licenses, have applications for property protection filed and prosecuted, and otherwise manage the properties or arrange for their management by recognized management organizations. The University may assign such patent rights to a foundation or corporation organized by it. Such rights as remain with the University under agreements with management organizations will be administered consistent with this Policy.
- C. The Intellectual Property Committee will normally evaluate or have evaluated, potential commercial uses of inventions prior to the filing of an application. If the University determines that neither commercial possibilities nor the potential contribution to the public good warrants proceeding further, the patent rights of the invention will be returned to the originator and shall belong to him or her unless such action is precluded by prior agreement with sponsors. The University shall make such determination within three months from the date of disclosure, unless additional time is agreed to by the parties.
- D. In recognition that the evaluation of inventions and the development and processing of patents and licensable inventions involves substantial time, expense and special expertise, the University may contract with outside organizations covering specific inventions believed to be patentable and patents developed therefrom, or covering all such inventions and patents in which the University claims an ownership interest.



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- E. In licensing, selling, or otherwise disposing of rights to inventions, the University will consult with the inventor and include his/her views in the decision making process. Royalty rates shall be reasonable and consistent with the goal of the University to effectively transfer technology in the public interest. Where feasible, the University will grant non-exclusive, reasonable royalty-bearing licenses to all qualified licensees. However, the University recognizes that non-exclusive licensing in many cases may not be effective in bringing the invention to the commercial market in a satisfactory manner and thus will grant an exclusive license if it determines that such is required in the public interest to encourage the marketing and eventual public use of the property. In all cases, the University shall reserve to itself the rights to make or have made the invention and to use the invention within the University for its own purposes.
- F. If within one year from the date of issuance of rights to the invention, the University does not make a substantial effort to license or sell the rights assigned to it, ownership of the rights will revert to the originator upon written request and approval of the Intellectual Property committee.
- G. All employees (other than clerical employees) working on research programs sponsored by the United States government, agencies thereof, or third parties, may be required to sign a written statement that:
1. He or she agrees to be bound by the terms of any agreement between the University and such third party to the extent that the terms of such agreement provide for the disposition of inventions or other properties developed in connection therewith.
- or, in the absence of any such agreement,
2. He or she agrees to be bound by the terms of this Policy generally, and specifically agrees pursuant to section v, above, to report any invention or discovery developed as a result of his or her participation in such sponsored research.

### **VIII. Publication or Public Use of Inventions**

Inventors should be aware that publication, public use or nonconfidential disclosure of an invention prior to the filing of a United States patent application is a bar to the grant of certain foreign patents and can bar the grant of a United States patent if it occurred more than one year earlier than the filing date. The University recognizes, however, that the advancement and dissemination of knowledge is a major goal of the University and thus any practice, which unreasonably restricts the publication of results of scientific work, is to be avoided. Accordingly, an inventor shall give notice of any proposed publication, use or disclosure concerning an invention to the Intellectual Property Committee within two months of such notice, the Intellectual Property Committee shall determine, after conferring with any relevant sponsor, whether such publication, use or disclosure will jeopardize any patent application in process or under



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consideration to be filed. If a delay is desired, the Intellectual Property Committee will notify the inventor to withhold the submission of the manuscript to a publisher, or delay the use or disclosure, but in no event shall such delay exceed one year from the date of the notice of publication.

[The following provisions relate specifically to copyrightable works].

### **IX. Protection of Copyrightable Works**

For all original copyrightable works subject to the University's ownership claim, the originator shall affix to the work the following:

- a) the word "Copyright", "Copr." or the symbol C (the letter "C" in a circle);
- b) the year of first publication; and
- c) the name of Howard University.

Thus, for all such works, the originator shall affix "Copyright 19 -- Howard University".

### **X. Foreign Language Versions of Copyrighted Works**

When the University claims ownership rights to copyrightable works, the University shall have the right to prepare or have prepared foreign-language versions of the materials and to copyright the same.

### **XI. Computer Software**

"Computer software" is defined as a set of computer programs and the manuals associated with these programs. A "program" is defined as a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result.

Notwithstanding its classification under section III. A., above, the University shall have the right to use internally any computer software developed by any University computer. This right to use shall include the right to modify the program for University purposes.

[The following provisions relate to all intellectual properties].

### **XII. Use of University Name**

Any use of the University's name in connection with the commercialization of property by an individual shall be approved in writing in advance by the University.

### **XIII. Binding Effect**

This Policy as amended from time to time shall be deemed to be a condition of initial or continuing employment of every University employee and a condition of enrollment and attendance of every student who works on any research project under University control. Any use of University funds or facilities after the effective date of this Policy shall be subject to this Policy. As stated in section X. F., with specific respect to projects sponsored by third parties, certain faculty, staff and students working on such





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projects may be required to sign agreements incorporating the terms of this Policy. The failure of any employee or student to sign an agreement incorporating the terms of this Policy shall not affect the applicability or validity of this Policy nor relieve any employee or student from the obligations imposed by it.

### **XIV. Interpretation**

This policy may be changed or discontinued at any time by action of the Board of Trustees. Such changes or discontinuance shall not affect rights accrued prior to the date of such action.

### **Roles and Responsibilities:**

#### **Academic Department**

- **Faculty, Staff, Students and Employees of the University:** All of the listed individuals who, during their associations with Howard University, develop or originate any intellectual property, **shall promptly disclose intellectual property as outlined in this policy to the Intellectual Property Committee using the University's Disclosure Form.** As necessary, the individual will provide additional information to the Intellectual Property Committee as requested.

#### **University**

- **Intellectual Property Committee:** **When a University's Disclosure Form is submitted, the Intellectual Property Committee will review the disclosure consistent with the Intellectual Property Policy (this document).** The committee will maintain complete records of all disclosures and other intellectual property matters of interest to the Howard University administration.
- **General Counsel (GC):** The General Counsel is responsible for consulting the Intellectual Property Committee and others to evaluate potential commercial use and investigate possible courses of action for protecting and/or marketing properties in which Howard University has an ownership interest.