

## POLICY 5. Faculty

### POLICY 5.J: Intellectual Property Policy on Discoveries and Patents for their Protection and Commercialization

#### Objectives

Creating and disseminating knowledge is a fundamental mission of the University of Colorado. The creative environment of the university is conducive to the development of the University of Colorado. The creative environment of the university is conducive to the development of inventions, software, and other discoveries. This policy of the University ~~of Colorado~~ has been established to accomplish the following objectives:

- To encourage the faculty and staff employees of the University to make all discoveries available for public use and benefit as efficiently and quickly as possible;
- To protect the University's primary role of teaching and research by regulating the involvement of the University, its faculty, staff employees, students and visitors and ~~all collaborators~~ in the development of discoveries;
- To protect the potential ~~equities~~ interests of the University, its faculty and staff employees in discoveries; and
- To provide a method of using royalty income from discoveries to advance discoveries and encourage research innovation within the University ~~by providing a method of using royalty income from discoveries for research purposes.~~

#### Definitions

- The term "discovery" or "discoveries," means as used in this policy, shall mean any inventive idea and/or its reduction to practice ~~which that~~ relates to, but is not limited to: new processes or methods of producing a new and useful industrial result; any composition of matter, including chemical and biological compounds and research materials; any new devices; any new plant; any new design in connection with the production or manufacture of an article; any new computer hardware and/or software programs; any ~~knowledge clinical protocol or survey instrument; any new use or improvement of existing systems, devices, compositions, programs or processes; and any know-how and data~~ supporting these inventive ideas, systems, devices, compositions, programs or processes; ~~and any new use or improvement of existing systems, devices, compositions, programs or processes.~~
- ~~The term "discoverer" or "discoverers" shall refer to any individual or group of individuals responsible for a discovery.~~
- ~~The term "included persons" shall refer to all faculty members and other employees (including students on appointment as University employees).~~
- ~~The term "collaborator" or "collaborators" shall refer to any person or persons who participate with an included person on a discovery.~~
- The term "discovery expenses" means all documented, unreimbursed expenditures incurred by the university for any discovery, including but not limited to:
  - to engage third parties to analyze, prepare, determine inventorship/authorship, file, register, record, prosecute, issue, maintain, assess value, and litigate, including defending in litigation

or in an administrative proceeding, intellectual property for a discovery or any other issue relating to university discoveries;

o for obtaining searches and opinions and otherwise in connection with marketing, licensing, enforcing, administering contractual obligations, and collecting license income for, a discovery or related intellectual property;

o for amounts owed to joint owners of a discovery under discovery management agreements or inter-institutional agreements; and

o any award funded and provided by the university to advance further development or commercialization of that discovery.

Discovery expenses do not include any compensation to university employees.

- The term "included persons" means all faculty members and other employees of the university, including individuals receiving salaries, research stipends, fellowships or other remuneration from the university, part-time employees, student employees, university employees on sabbatical who receive remuneration from the university, and employees on a paid leave of absence. included persons also includes university volunteers, students, and visitors who make substantial use of university resources, and visiting scholars.
- The term "intellectual property" means any legal protection that exists and/or is or may be sought for any discovery. For example, intellectual property may include, but is not limited to, a patent, copyright, mask work, trademark, service mark, trade secret, proprietary and confidential information, and other forms of intellectual property legally recognized now or in the future.
- The term "net receipts" means all financial consideration received by the University or its agent from the transfer, license, assignment, development, or commercial exploitation of a discovery and/or the intellectual property for a discovery, less all discovery expenses for the discovery or discoveries (including intellectual property for the discovery) that generated such financial consideration.
- The term "principal technology transfer officer" means the member(s) of the university staff employed and appointed by the university to perform such duties and responsibilities as the university may prescribe for the purposes of effecting this policy.
- The term "sponsored program" means any research, instruction or service activity financially supported, authorized, administered, or managed by the university.
- The term "substantial use of University resources" means use of University ~~administered~~ funds, ~~programs, sponsored programs, facilities, research~~ equipment, ~~including software, research~~ space or other physical assets that goes above and beyond those customarily and currently provided to included persons in accordance with their university position as an employee, student, or volunteer. A visiting scholar or any other visitor makes substantial use of university resources by using university administered funds, sponsored programs, facilities, research equipment, including software, research space, or other physical assets. For purposes of this policy, offices, office equipment, library access, desktop and laptop computers, photocopy

equipment, telephone, and fax machines that are customarily provided, are excluded from substantial use of university resources. Use of university resources as permitted under a separately executed facilities use agreement will not be considered substantial use of university resources. (This provision is not intended to override any other university policy concerning reimbursement for facilities or equipment usage.)-

- ~~The term "university discoveries" in means discoveries made: which the University has an interest" shall include discoveries made while performing duties required by a university grant or contract, and/or made~~

- ~~with the substantial use of University resources, and/or~~

- ~~made as a result of the use of sponsored program funds supplied or administered by the University, and/or made in fulfillment of an included person's work responsibilities.~~

A discovery made by an included person in connection to consulting or other third-party contractual arrangements is a university discovery if it meets the above criteria.

- The term "visiting scholar" means a person who has been granted access to university administered funds, sponsored programs, facilities, research equipment, including software, research space or other physical assets pursuant to an appropriately executed visiting scholar agreement.

- The term "visiting scholar agreement" means a separately executed written agreement between a person or that person's home institution and university permitting substantial use of university resources, which agreement includes intellectual property provisions approved by the appropriate principal technology transfer officer.

### **Scope of Policy**

- ~~• This policy shall apply to all included persons of the University.~~
- ~~• This policy shall apply to any other persons using University facilities.~~
- The term "work responsibilities" means any work, including third party employment such as consulting activity, that is related to an included person's activities or field of expertise at the university as evidenced by their research focus, or as otherwise articulated in a faculty member's professional plan or an employee's position description.

#### **A. University Ownership**

- ~~• This policy shall apply to any person not in an above-mentioned category who collaborates with included persons in a discovery.~~

1. The university owns all university discoveries. Every included person(s), by accepting employment with the university and/or making substantial use of university resources, assigns to the Regents of the University of Colorado any legal rights that may exist in such university discoveries and any intellectual property rights in such university discoveries.

2. The university has separately established through Regent Policy 5.K Intellectual Property that is Educational Material that the university will not take ownership of Educational Materials, and the ownership and administration of Educational Materials will be in accordance with Regent Policy 5.K; provided, however, that if any Educational Material is a

derivative of or otherwise uses any pre-existing university discovery or related intellectual property, neither Regent Policy 5.K nor this provision prevents the university from asserting its pre-existing rights under this Regent Policy 5.J. Where an Educational Material is also a discovery, the terms and conditions of this Regent Policy 5.J supersede the terms and conditions of Regent Policy 5.K.

3. The university will make no ownership claim on discoveries created without substantial use university resources to develop the discovery and where the discovery is not related to an included person's work responsibilities.

4.4. Should the terms of a ~~University approved~~ ~~university-approved~~ third-party grant or contract, including ~~consultation consulting~~ agreements approved by ~~the University the~~ ~~principal technology transfer officer~~, be in conflict with the terms of this policy, the terms of the approved third-party grant or contract shall control. Only the principal technology transfer officer or their designee has the legal, delegated authority to waive ownership by the university, or to assign ownership, license, or otherwise provide legal rights to university discoveries and intellectual property in a university discovery.

## B. Ownership of Student Discoveries

1. The university will not own a discovery created by a student who is not employed by the university at the time the discovery is made and who has not made substantial use of university resources to develop the discovery, unless the student: (A) creates the discovery with an included person who assigns to university (in which case the university will jointly own the discovery), (B) assigns ownership rights in the discovery to the university in writing, or (C) must make an assignment of such ownership rights to the university as a condition for participation in a course. If the student-created discovery is a university discovery and the student assigns ownership rights in the discovery to the university, the student will be bound by this policy the same as an included person, including but not limited to, having rights in the distribution of net receipts.

2. A student who holds a research stipend or fellowship through the university and who creates a discovery during the course of the stipend or fellowship will be considered an included person bound by this policy.

## C. Responsibilities of ~~Participating Parties~~ Included Persons

Every included person, as a condition of employment, ~~or of his/her education, and every user or making substantial use of university resources of University facilities shall must~~ comply with this policy and ~~hereby by~~ accepting such employment or making substantial use of university resources, agrees to make a timely, written report to the university of all discoveries made by the included person, in order for the university to determine whether the discovery is a university discovery as follows.:

In the event the university determines that the discovery is a university discovery, the included person must:

- ~~To inform all collaborators of the terms and conditions of this policy;~~
- ~~To report to the Technology Transfer Office, in writing, all discoveries in order for the Technology Transfer Office to determine whether or not the University has an interest in the invention. Such report shall be made within a reasonable time after the discovery is made and within reasonable time prior to its submission for publication;~~

- ~~To cooperate with the Technology Transfer Office in deliberations and activities, as provided herein;~~
- ~~To assign to the University, its designee, or a sponsoring agency if required under agreements governing research, any and all rights in and to discoveries in which the University has an interest, as determined by the terms of this policy;~~
  - Execute and deliver any and all documents that may be necessary or desirable to perfect title in the university to all university discoveries and related intellectual property;
- ~~To e~~Execute all documents necessary to complete a patent, license, or other commercial application, and all documents necessary to accomplish a licensing agreement or other agreement for commercial development; ~~and~~
- ~~To e~~Cooperate reasonably with the ~~Technology Transfer Office~~ university in activities necessary or desirable for the commercial development of university discoveries in accordance with the applicable policies and procedures established by the university. in obtaining, protecting, and maintaining rights necessary to the commercial development of discoveries in which the University has an interest.

It will be the responsibility of all included persons who would like to provide access to university research facilities, equipment, and other research resources to a visitor to ensure that such visitor has executed an agreement with university prior to the visitor having such access, which agreement must include intellectual property provisions that have been approved by the appropriate principal technology transfer officer.

It will be the responsibility of the University to disseminate the policy to all included persons and to all others susers making substantial use of University ~~resources facilities~~. However, the failure of the University to do so ~~shall~~does not, in ~~no any~~ way, affect the rights and obligations of the University or of included persons under the terms of this policy.

### **Committee on University Discoveries**

~~The Committee on University Discoveries (CUD) is made up of faculty and staff of the University. The CUD shall advise the Principal Technology Transfer Officer on matters related to this policy and shall serve as the appeals board. The CUD shall also provide such other technical advice and expertise as the Technology Transfer Office or its designee, or the University, may request, or as initiated by the CUD itself.~~

### **Principal Technology Transfer Officer**

#### **D. Dispute Resolution**

The university shall create a process to address any disputes that may arise related to this policy.

#### **E. Principal Technology Transfer Officer**

The University shall employ and appoint ~~a one or more~~ member(s) of its staff to serve as the Principal Technology Transfer Officer(s) to perform such duties and responsibilities, as it shall prescribe.



F. Division of Receipts

The ~~Technology Transfer Office~~ agrees to university must determine how it will share and distribute ~~net receipts received from the commercialization~~ net receipts; provided that the university must share no less than 30% of any discovery developed under the net receipts with the included persons who are the inventors or creators of the discovery ~~terms of an agreement as follows:~~

- ~~25 percent to discoverer(s) personally;~~
- ~~25 percent to a University campus account for support of discoverer's(s') research;~~
- ~~25 percent to an account for the benefit of the University; and~~
- ~~25 percent to the Campus Chancellor, which will be directed to research with technology transfer potential and distributed on a percentage basis as determined at each individual campus.~~

~~The Campus Chancellors' Offices will make information regarding this distribution readily available. Net receipts for each discovery shall be defined as all sums received by the Technology Transfer Office from the development and commercial exploitation of the discovery after first deducting all unreimbursed legal expenses incurred by the Technology Transfer Office in securing the intellectual property protection of that particular discovery or bundle of discoveries if licensed as a group. The above distribution schedule shall not apply when it is in conflict with the terms and conditions of an approved third-party grant or contract with the University. In such case, the terms of the approved third-party grant or contract will control. In the event that a discoverer is no longer employed by the University, the 25 percent designated to his/her research account shall be divided 10% to an account for the benefit of the University and 15% to the Campus Chancellor, which will be distributed in a manner identical to the Campus Chancellor share mentioned above.~~

Last Amended: March 2, 2006 TBD (Pending)

History:

05/19/83, 06/20/85, 04/21/94, 01/16/03, 03/02/06, TBD (Pending)