



Policies and Procedures Manual

Title: Intellectual Property Policy
Policy Administrator: President of the College
Effective Date: Dec-15-2011
Approved by: President of the College

Overview:

This policy reflects the culture of the College, and more specifically its interest in the advancement of knowledge and the support of professional development for its members. It also recognizes that new intellectual property contributes to the social good and advances the state of knowledge; may absorb substantial institutional resources in its creation; may generate income; and may raise questions of actual or perceived conflict of interest for its creators and the College. With this Policy the College intends to promote the creativity of the entire College community and to recognize the contributions of creators and the College in determining the rights of ownership and use of intellectual property and the distribution of equity interests.

Policy:

- A. [Overview](#)
- B. [Effective Date and Applicability](#)
 - 1. Applicable to Faculty, Staff and Students
 - 2. Type of Property
 - 3. Application to Collaborative Projects
 - 4. Application to Traditional Academic Works
 - 5. Effective Date and Changes to the Policy
- C. [Ownership](#)
 - 1. Definitions
 - 2. General Statement
 - 3. Academic Works
 - 4. Rights under Consulting Agreements
- D. [Intellectual Property Disclosure and Request for Waiver](#)
 - 1. Intellectual Property Disclosure
 - 2. Determination
- E. [Exploitation and Administration of Intellectual Property](#)
 - 1. College waiver of all rights to ownership
 - 2. Joint Ownership by the College and the **Creator**

- F. [Income, Royalties](#)
 - 1. Creator and College Share of Income or Royalties
 - 2. Definition of “Net”
- G. [Agreements in Writing, Disputes](#)
- H. [Priority of Claims by Government Agencies and Private Sponsors](#)

B. Effective Date and Applicability

- 1. **Applicable to Faculty, Staff and Students**

This Policy applies to all full- and part-time faculty members, administrative officers, staff members, and students engaged in teaching, research, study, or other forms of activity within the College or in connection with any College program (collectively “Holy Cross community members”). Any Holy Cross community member who has not previously signed [Exhibit A](#) will need to sign Exhibit A when disclosing an invention by submitting the [intellectual property Disclosure Form \(Exhibit B\)](#), discussed in section D of this policy.
- 2. **Type of Property**

This Policy applies to inventions that are subject to protection under the patent laws of the United States and/or other countries, and to copyrightable works other than traditional academic works (see section B(4)). The Policy does not apply to any work that is subject to an agreement between the College and a third party or to any tangible research materials, notes or supporting technology associated therewith.
- 3. **Application to Collaborative Projects**

This Policy applies to projects in which Holy Cross community members are engaged in research or other academic activities in collaboration with individuals located at other institutions, including but not limited to other colleges or universities, hospitals, and research foundations. Holy Cross community members embarking on such collaborations should understand their obligations under this Policy and are responsible for knowing and communicating to the College any obligations their collaborators bear to their respective institutions that might conflict with or need to be reconciled with this Policy. The College will make all reasonable efforts to collaborate with any such other institutions to reconcile the College’s objectives under this Policy with the objectives of those institutions. This paragraph does not apply to Consulting Agreements, which are discussed in section C(4), or to situations covered by section H.
- 4. **Application to Traditional Academic Works**

In accordance with prevailing academic practice and its own traditions, the College asserts no ownership interest in traditional academic works created by Holy Cross community members. These include, but are not limited to, literary works; creative, scientific, and artistic works; scholarly publications; textbooks; syllabi; assignments; lecture notes; class presentations; websites for classes; and instructional materials distributed to students or made available to them electronically. Exceptions to this paragraph are noted in section C(3).

5. Effective Date and Changes to the Policy

This Policy takes effect when approved by the President of the College and promulgated to the College community. While this Policy is subject to change at any time, once a disclosure (as defined in section D below) is made, the terms of this Policy existing on the date of the disclosure shall continue to guide and determine the relative rights of the creator and the College with respect to that disclosure despite changes in the Policy made after the date of disclosure.

C. Ownership

1. Definitions:

- a. "Creator" means the individual who invents, creates, authors, innovates, etc., whether individually or jointly with others with respect to intellectual property(-ies).
- b. "Dean" is the Vice-President for Academic Affairs and Dean of the College. In all references the responsibilities of the Dean may be delegated at her or his discretion to another officer of the College or to an independent contractor.
- c. "Dedicated resources" are
 - (i) facilities including but not limited to
 - (1) specialized laboratories used primarily to support research,
 - (2) specialized equipment,
 - (3) purpose-designed spaces which are created with the specific research activity in mind and used for the purpose of supporting creative or research activity; and
 - (ii) support provided by the College and used by the creator including but not limited to
 - (1) licenses to handle certain types of hazardous or specialized materials,
 - (2) collections of books, publications, materials, or other works, that were acquired to support specific research or creative activities,
 - (3) utilization of more than ten percent of the time and effort of one full-time equivalent person (such as shop or laboratory staff) who is hired to support an area of study and not specifically hired to support the creator,
 - (4) hiring of personnel specifically to support certain research or creative activities, and
 - (5) direct or indirect funding, including funding from a third party granted to or administered by the College.
- d. "Intellectual property" means all copyrightable or patentable works covered by this Policy, and the patents and copyrights that reserve rights to them, and tangible research materials, notes and supporting technology associated therewith.

- e. "Normal resources" means resources that are not "dedicated resources" as defined in section C(1)(c) of this Policy. "Normal resources" include but are not limited to office space, library resources and archival collections, machine shops, basic desktop and personal computer resources and clerical services.
- f. "Substantial normal resources" means extensive use of College laboratory, studio or computational facilities, or personnel. The use of these resources must be important to the creation of the intellectual property; merely incidental use of a resource does not constitute substantial use, nor does extensive use of a facility commonly available to all faculty or professional staff (such as libraries and offices), nor does extensive use of specialized facilities for routine tasks. Use will be considered "extensive" and facilities will be considered "major" if similar use of similar facilities would cost the creator more than \$10,000 if purchased or leased in the public market.
- g. "Technology transfer" refers to the commercialization of intellectual property.
- h. "Conflict of interest" is defined by the College's policy on conflicts of interest which states in part:

A conflict of interest is defined as incompatibility between an individual's private interests and his or her duties or actions as a college employee.

Those involved in the design, conduct, or reporting of research or educational activities supported by outside funding must disclose to the Vice President for Finance and Administration all financial interests they may have (including those of relatives or members of their household) (i) that would reasonably appear to be affected by the research or educational activities that are funded or are proposed for funding; (ii) in entities whose financial interests would reasonably appear to be affected by their research activities.

2. General Statement

The ownership of **intellectual property**¹ created by those to whom this Policy applies (see section B(1)) is an equitable determination of the rights of the College and the **creator**. The College claims ownership of **intellectual property** to the extent that the **intellectual property** is produced with the College's **dedicated resources**, or with **substantial normal resources** used by the **creator** in the production of the **intellectual property**. The College may choose to relinquish its claim of ownership as determined on a case-by-case basis. Notwithstanding the foregoing, any work subject to copyright created within the scope of employment by a non-teaching employee of the College shall be owned by the College as work for hire under US Copyright law.

3. Academic Works

- a. **Assigned Tasks.** The College will retain an ownership interest in academic works created as part of an assigned task where the assignment explicitly states that the work will be owned in part or in whole by the College.

¹ Words and phrases that appear in **boldface type** from this point in the Policy forward should be understood to have the meaning defined for them in section C(1) of the Policy.

- b. Special Circumstances. The College will retain an ownership interest in academic works created with **substantial normal resources** or with **dedicated resources**.

4. Rights under Consulting Agreements

The **creator** may agree to assign to third parties for whom they consult the rights in **intellectual property** made in the performance of consulting services, provided that such an agreement is consistent with any previous obligations of the **creator** and the rights of the College as described in this Policy or any other rights or obligations described in this Policy. Specifically, consulting services cannot be accomplished using dedicated or **substantial normal resources** as defined in this Policy. Prior to entering into any such agreements, the **creator** shall request the **Dean** in writing to review and approve of the provisions concerning the assignment of inventions and also of provisions concerning any **intellectual property** rights assigned to third parties pursuant to such agreements. Absent an agreement with a third party, rights in **intellectual property** made in the performance of consulting services will belong to the **creator**, unless **intellectual property** made in the performance of consulting services is subject to this Policy. Consulting arrangements should avoid all **conflicts** or appearances of **conflicts of interest**. To this end, the Holy Cross community member involved as the **creator** or members of his or her immediate family may not wholly or partially own the company or organization with which the consulting agreement is made.

D. Intellectual Property Disclosure and Request for Waiver

1. Intellectual Property Disclosure

The development of a work of **intellectual property** by any individual to whom this Policy applies (see section B(1)) shall be reported fully and in writing at the earliest time possible after the **creator** decides that a work should be protected as valuable or potentially valuable **intellectual property**. The report shall be made to the **Dean** using the [Intellectual Property Disclosure Form](#) attached to this document ([Exhibit B](#)). The disclosure of such a work to the **Dean** assumes that the **creator** believes that the work is subject to a claim of ownership by the College based on the use of the College's **dedicated resources**, or with **substantial normal resources** used by the **creator** in the production of the property. If the work was created in the context of a collaborative project, the **creator** should identify on the disclosure form any additional **creators** at the College or at other institutions.

If the **creator** believes that such work should be protected as valuable or potentially valuable **intellectual property** but that it is not subject to a claim of ownership by the College, the **creator** should instead submit a written request for waiver of the College's ownership rights. To assist in determining whether or not **substantial College resources** have gone into the work, the **creator** is encouraged to attach any relevant information regarding time and resources used, including research diaries, personnel records, etc. The College will accord such disclosures the confidentiality required to preserve the potential patent rights associated with them.

2. Determination

Within ten business days, the **Dean** shall consult with the **creator** to determine issues of ownership based on the information submitted on the disclosure form or the request for waiver. Should agreement between the College and the **creator** not be reached, an ad-hoc committee of College employees comprised of one individual appointed by the **Dean**, one individual appointed by the **creator**, and one individual agreed to by both parties, shall be constituted. Committee members will have knowledge about the particular field and/or **intellectual property** issues and will have no personal or compensable interest in the matter at hand. It will be the function of the committee to review the information submitted on the disclosure of **intellectual property** form or the request for waiver form, and to make a recommendation to the **Dean** for final decision. The committee will have access to legal counsel, secured for it by the Office of the General Counsel, if the committee deems it necessary.

E. Exploitation and Administration of Intellectual Property

1. College waiver of all rights to ownership

The College shall waive all rights to ownership if it has none under this Policy. The College may also choose not to preserve its right and to grant to the **creator** clear rights to proceed with protection and exploitation of the property. The College will document its waiver of ownership and pledge its cooperation in ensuring that its waiver of ownership is clearly stated to all who require it.

2. Joint Ownership by the College and the **Creator**

When the College has an ownership interest in the **intellectual property**, the following policy applies to protection and exploitation of the property.

a. Patent Protection. The College retains sole discretion in deciding how to fund the process of seeking a patent. The **Dean** has responsibility for managing the patenting process including the retention of experts, specialists, and attorneys. In his or her sole discretion, one of the following three options for financing the patent protection process will be selected. Both the College and the **creator** shall keep confidential any invention, creation or discovery until the College has completed its assessment and patent protection process.

(i) College bears all expenses of seeking patent protection.

All expenses associated with this process will be borne by the College and will be included in expenses deducted from later revenue, should a calculation of net revenue be necessary at any time in the future. In this instance the College is the patent holder.

(ii) College and **creator** jointly bear expenses of patent protection.

The College may offer to pay a percentage or a fixed sum towards the full cost of securing patent protection. All expenses associated with this process will be borne by the College and the **creator** in shares determined by the parties and will be included in expenses deducted from later revenue, should a calculation of net revenue be necessary at any time in the future. The

College and the **creator** will jointly decide in whose name the patent should issue.

(iii) The **creator** bears all expenses of patent protection.

The College may determine that while it has an ownership interest it is not interested in seeking patent protection. In this case the **creator** will have the option of seeking patent protection on her or his own and will bear all the costs of seeking that protection. All expenses associated with this process will be borne by the **creator** and will be included in expenses deducted from later revenue, should a calculation of net revenue be necessary at any time in the future. In this instance the **creator** will hold the patent and share revenue with the College as determined by the Policy.

b. **Technology transfer.** The College retains sole discretion in deciding whether it will fund the process of **technology transfer**. The **Dean** has responsibility for managing the **technology transfer** process including the retention of experts, specialists, and attorneys. In his or her sole discretion, one of the following three options for financing that process will be selected.

All licenses or agreements to transfer technology are subject to the approval of the **creator**, which approval shall not be unreasonably withheld. The College will not enter into any agreements that restrict the free use of the **intellectual property** by the **creator** for research or educational purposes, unless the **creator** agrees to such restriction.

(i) College bears all expenses of **technology transfer**.

The **Dean** has responsibility for working with the **creator** to ensure that appropriate licensees are identified and considered in any plan to license or otherwise commercialize the **intellectual property**. All expenses associated with this process will be borne by the College and will be included in expenses deducted from later revenue, should a calculation of net revenue be necessary at any time in the future.

(ii) College and **creator** jointly bear expenses of **technology transfer**.

The College may offer to pay a percentage or a fixed sum towards the full cost of **technology transfer**. The **Dean** has responsibility for working with the **creator** to ensure that appropriate licensees are identified and considered in any plan to license or otherwise commercialize the **intellectual property**. All expenses associated with this process will be borne by the College and the **creator** in shares determined by the parties and will be included in expenses deducted from later revenue, should a calculation of net revenue be necessary at any time in the future.

(iii) The **creator** bears all expenses of **technology transfer**.

The College may determine that while it has an ownership interest it is not interested in contributing to the expenses of **technology transfer**. In this case the **creator** will have the option of developing the technology on his or her own and will bear all the costs. All expenses associated with this process will be borne by the **creator** and will be included in expenses deducted from

later revenue, should a calculation of net revenue be necessary at any time in the future.

F. Income, Royalties

1. Creator and College Share of Income or Royalties

Under all of the circumstances outlined above where it elects to help fund the patenting of inventions and/or **technology transfer of intellectual property** subject to this Policy, the College will provide the **creator** 50% of the net income or royalties gained through **technology transfer**. The other 50% of the net income shall be managed through the Office of the **Dean**. Exceptions to this policy may be made upon mutual agreement between the **creator** and the **Dean**.

2. Definition of "Net"

"Net" royalties or income is that sum remaining from the total income or royalties after deducting the expenses related to obtaining patent protection and marketing and licensing or transferring the technology. Where the **creator** shared the cost of such expenses with the College, the distribution of net royalties will be adjusted to reflect the relative contributions of the College and the **creator**. Accounting of such net royalties or income shall occur at least annually.

G. Agreements in Writing, Disputes

At all of the decision-making points outlined above, decisions by both the **creator** and the College must be made in a prompt and timely manner and communicated completely, in writing, to the other party. If, at any point in the process, disagreements arise between the **creator** and the College, an ad-hoc committee will be appointed as described in section D(2) above to make a recommendation to the **Dean** for final decision. To the extent possible, the same ad-hoc committee will be used to advise the **Dean** for all issues related to the same **intellectual property**.

H. Priority of Claims by Government Agencies and Private Sponsors

In the event that a grant or contract from a government agency or private sponsor contains provisions that determine the ownership and/or disposition of the rights to **intellectual property**, those provisions must prevail and the College and the **creator** must carry out their commitments under the terms of such grants and contracts. Private sponsors, in this context, may not include companies or organizations wholly or partially owned by the Holy Cross community member involved as the **creator** or by members of his or her immediate family. However, a **creator** may have a financial interest in a company or organization to which **intellectual property** is licensed, subject to any College **conflict of interest** policy in place at the time of the licensing agreement.

Procedures:

See relevant sections above.

Forms:

Exhibit A-Agreement to Assign Intellectual property Rights
Exhibit B-Intellectual property Disclosure Form

Related Information:

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