

## INTELLECTUAL PROPERTY POLICY

### PREAMBLE

RIT strongly encourages all faculty to participate in an active professional development program to enhance our academic programs, to heighten and satisfy the creative interests of faculty, and to fulfill the needs of external sponsors and supporters of the Institute. Professional development programs take many forms: research (sponsored or otherwise), creation of artistic works, professional presentations, consulting, curriculum development, and pedagogical innovation, among others. Often, such professional development programs result in the creation of Intellectual Property. Similarly, all RIT academic programs contain research and experiential learning components for students, which may also result in the creation of Intellectual Property.

### OVERVIEW

The Intellectual Property developed by RIT faculty, staff, and other non-students takes many forms; examples include patentable inventions, copyrighted materials, and tangible research property. RIT values the creation of Intellectual Property primarily because of its potential to support the educational mission of the Institute and, in the process, enhance the reputation of the Institute and its faculty. In addition, there are times when the creation of Intellectual Property can provide financial benefit to the Institute and/or individual faculty, staff, and other non-students.

The purpose of RIT's Intellectual Property Policy is to:

- enhance the learning environment of RIT's Faculty and Students,
- facilitate the development and use of the results of scholarship that are consistent with and in support of the mission of the Institute,
- enable the faculty, staff, and other non-students and the Institute to obtain appropriate benefit from any commercial applications of scholarship results, and
- ensure that the interests, rights, and responsibilities of all involved are fairly determined.

RIT will administer its Intellectual Property Policy with a minimum of institutional bureaucracy, specifically:

RIT's Intellectual Property Policy will not be used to inhibit faculty from participating in meaningful and appropriate projects (research or otherwise) and contracts with external sponsors. RIT will negotiate mutually acceptable assignment of Intellectual Property Rights with third-party sponsors.

The Intellectual Property Policy will be implemented in such a way as to facilitate and simplify the seeking of Intellectual Property protection and benefits. RIT will establish an Institute Intellectual Property Committee competent to determine, in a short period of time, whether the

Institute intends to seek protection on any specific invention or creation. Should the Institute seek protection, it will do so in a timely manner.

RIT's Intellectual Property Policy is intended to encourage faculty to engage in scholarship, research, and special projects that will result in the development of Intellectual Property for the mutual benefit of the involved Creators and the Institute.

**Footnote:** In implementing this policy in 1997-98 the Institute will make no claim of ownership on any current revenue-generating Intellectual Property of faculty, regardless of the use of Institute Resources or Facilities involved in the past creation of such Intellectual Property.

## **I. Introduction**

### **A. Glossary of Terms**

The following terms are used throughout this document:

**Author:** Institute faculty, staff, or any other non-student participating in Institute programs, whether or not paid by the Institute, who have developed or produced an Original Work of Authorship.

**Commissioned Work:** A Creation which is produced in connection with the Institute's expressed assignment or commissioning of a Creator's project or with the Institute's assignment or commissioning of a Creator to develop a specific Work of Authorship or other Creation.

**Computer Software:** A set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result. (See, 17 U.S.C. 101 [See The United States Code for detailed information. For instance, go to <http://www.law.cornell.edu/uscode/17/>. Contains all Code 10 chapters.])

**Note:** Copyright protection for a computer program is a complex matter due to the difficulty in separating the idea from the expression. In some cases, the Institute's Patent Policy may be applicable.

**Creation:** Commissioned Work, Invention, Mask Work, Non-Incidental Creation, Original Work of Authorship, Tangible Research Property or other Intellectual Property (such as, but not limited to, research data), as applicable.

**Creator:** Institute faculty, staff, or any other non-student participating in Institute programs, whether or not paid by the Institute, who develops Intellectual Property, including Inventors, Authors, and developers of Mask Works.

**Incidental Use of Institute Resources or Facilities:** "Incidental Use" is the use of resources or facilities which are routinely made available to faculty and staff in association with their normal responsibilities. This use of resources or facilities is not appreciable or readily measurable. Examples of Incidental Use of Institute Resources or Facilities include, but are not limited to

offices, laboratories, library facilities, and personal computers, as well as professional development leaves and other awards. Incidental costs may also include, but are not limited to, reasonable use of telephone services, and of office equipment such as photocopiers, fax machines, and printers. Final determination of questions about Incidental Use will be made by the Institute Intellectual Property Committee and the Provost.

**Institute:** The Rochester Institute of Technology.

**Intellectual Property:** Certain creations of the human mind that are legally protected as a property right. The term is an all-encompassing term now widely used to designate as a group all of the following fields of law: patent, trademark, unfair competition, copyright, trade secret, moral rights, and the right of publicity.

**Invention:** Any invention or discovery of a new and useful process (which may include computer software), machine, manufacture, or composition of matter, or any new and useful improvement thereof, protectable under Title 35 of the United States Code.

**Inventor:** Institute faculty, staff, or any other non-student participating in Institute programs, who has invented or discovered an Invention.

**Mask Work:** A series of related images, however fixed or encoded, having or representing the predetermined, three-dimensional pattern of metallic, insulating, or semiconductor material present or removed from the layers of a semiconductor chip product, in which series the relation of the images to one another is that each image has the pattern of the surface of one form of the semiconductor chip product, protectable under Title 17 of the United States Code.

**Non-Incidental Creation:** A Creation produced with the non-incidental use of Institute resources or facilities.

**Non-Incidental Use of Institute Resources or Facilities:** "Non-Incidental Use" of Institute Resources or Facilities is use which exceeds the Incidental Use of Resources or Facilities. Non-Incidental Use must be identified by the Institute and agreed to in writing by the Creator in advance of work on a project.

**Original Work of Authorship:** An original work of authorship, fixed in any tangible medium of expression from which it can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device, protectable under Title 17 COPYRIGHTS of the United States Code. Original works of authorship include, but may not be limited to, the following categories:

- books, journal articles, texts, glossaries, bibliographies, study guides, laboratory manuals, syllabi, tests, and proposals
- lectures; literary, musical, or dramatic compositions; and unpublished scripts
- visual, audio-visual, and television films; motion pictures, film strips, charts, transparencies, slides, and other visual aids
- sound, video, audio tapes, cassettes, disks, compact disks, kinescopes, or other recordings

- live video and audio broadcasts
- programmed instructional materials
- computer software (instructional or otherwise)
- pantomimes and choreographed works
- pictorial, graphic, and sculptural works; paintings, weavings, prints, and other arts and crafts
- architectural works
- Mask Works

Technology Transfer Costs: Technology Transfer Costs are those direct expenditures related to the commercialization of Intellectual Property. Examples of technology transfer costs may include, but are not limited to, attorney's fees, application and search fees, contracted services for market evaluation, and patent management.

Trademarks and Service Marks: A Trademark or a service mark is a word, name, symbol, or device (or any combination) adopted by an organization to identify its goods and services to distinguish them from the goods and services of other organizations.

## **B. Intellectual Property and Related Rights**

The material set forth in this document covers the ownership, distribution, and commercial development of Intellectual Property developed by Rochester Institute of Technology ("Institute") faculty, staff, and other non-students participating in Institute programs. The principal rights governing the ownership and disposition of technology are referred to as "Intellectual Property Rights," which are derived primarily from federal legislation granting patent, copyright, trademark, and mask work protection.

In some instances, distribution and commercialization of Intellectual Property may be accomplished by the transfer or licensing of the Intellectual Property Rights, such as patents and copyrights. In other instances, distribution and commercialization of Intellectual Property may be aided by or depend upon access to the physical or tangible embodiment of the Intellectual Property, as in the case of biological organisms, plant varieties, or computer software. Therefore, this Policy will define not only ownership, distribution, and commercialization rights associated with Intellectual Property, but will also define policies and procedures which govern use and distribution of tangible forms of Intellectual Property.

### **1. Patents and Patent Rights**

A patent is a grant issued by the U.S. Patent and Trademark Office which gives an inventor the right to exclude all others from making, using, or selling the invention within the United States, its territories and possessions, for a period of 20 years from the date of filing of the patent application.

Patents may also be granted in foreign countries; however, procedures for filing, requirements for patentability, the terms of patent grants, and the cost of patents may vary considerably from country to country.

To be patentable in most countries, an invention must be new, useful, and non-obvious. In the U.S., inventors are allowed a grace period of 12 months from the date of the first public disclosure, public use, or offer for sale of an invention for the filing a patent application. However, in almost all foreign countries, an invention is unpatentable unless the application is filed before any public disclosure occurs anywhere, with the exception that if an Inventor has filed a patent application in the U.S. before such disclosure, the Inventor has 12 months from the U.S. filing date to file in most foreign countries without losing filing rights.

In addition to more traditional forms of inventions, the patentability of computer software is well established in the U.S. A computer software invention generally will be patentable if it meets the tests of novelty and non-obviousness, and the statutory requirements for patentable subject matter.

## 2. Copyrights

A copyright owner has the exclusive right to reproduce his or her work, prepare derivation works, distribute by sale or otherwise, and display or perform the work publicly.

Under copyright law, a copyright subsists in "original works of authorship" which have been fixed in any tangible medium of expression from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.

For an individual author, copyright protection of a work extends for the author's life plus 50 years. For employers, copyright protection of a work extends for 75 years from the date of publication or 100 years from the date of creation, whichever is shorter. Note that a patent may protect an "idea," but ideas cannot be copyrighted.

Rights of copyright do not commence with registration of a claim of copyright with the Copyright Office. Under copyright law, copyright protection begins at the time an idea is expressed in a tangible medium of expression. In order to be copyrighted, a work must be original and have a modicum of creativity.

While registration is not a condition of copyright protection, prompt registration of a copyright should be considered for the following reasons:

- registration is required before a suit for infringement can be filed;
- registration within five years of initial publication creates a presumption of validity;
- registration within three months after the first publication of the work allows for the possibility of recovery of statutory damages and attorney fees in a claim for infringement;
- registration is required before assignment of the copyright can be recorded with the Copyright Office.

Although not required, the Institute highly recommends the use of copyright notices [©].

### 3. Trademarks and Service Marks

A trademark or service mark is a word, name, symbol or device (or any combination) adopted by an organization to identify its goods or services and distinguish them from the goods and services of others. In the U.S., trademark ownership is acquired through the use of a term on or in association with goods, or in connection with services to identify their origin. Trademark ownership is not dependent upon federal or state registration, but upon use of the mark. Registration of trademarks and service marks may be obtained on both the state and federal levels. However, to apply for a federal registration of a mark, which offers more benefits than a state registration, the mark must be used in interstate commerce.

### 4. Mask Works

A mask work is defined as a series of related images, however fixed or encoded, having or representing the predetermined, three-dimensional pattern of metallic, insulating, or semiconductor material present or removed from the layers of a semiconductor chip product, and in which series the relation of the images to one another is such that each image has the pattern of the surface of one form of the semiconductor chip product. Under the Semiconductor Chip Protection Act of 1984, mask work protection extends for 10 years, and gives the owner of the qualifying mask work exclusive rights to its reproduction and to importation or distribution of a semiconductor chip product in which the mask work is embodied. Mask works are registered with the United States Copyright Office. Failure to apply for registration of a mask work within two years of the initial commercial exploitation, anywhere in the world, results in the termination of the exclusive rights.

### 5. Tangible Research Property

The term "tangible research property" refers to those research results that are in a tangible (as distinct from an intangible) form. Examples of tangible research property include integrated circuit chips, computer software, biological organisms, engineering prototypes, engineering drawings, and other property which can be physically distributed.

Although tangible research property may often have Intellectual Property Rights associated with it - such as biological organisms, which may be patented, or computer software, which may be either patented or copyrighted, - the Institute and/or the Creator/Author may choose to distribute the research property, without securing Intellectual Property protection, by using some form of contractual agreement, such as a material transfer agreement.

## **II. Institute General Policy Statement**

The Institute recognizes that the development of marketable Intellectual Property may occur in the course of personal, institutional, and sponsored program activities. The Institute wishes to encourage the development of such Intellectual Property for the public benefit, and to establish procedures that adequately reward the Creator and compensate the Institute for expenses, if any. At the same time, the Institute acknowledges a responsibility to ensure that the specific

Intellectual Property policies of third party sponsoring organizations be understood prior to acceptance of funding, and complied with after Intellectual Property is developed.

It should be clearly understood in all cases where the Institute holds the Intellectual Property Rights, that the Institute retains the right to make, use, sell, or otherwise reproduce the Creations and to use them without incurring financial responsibility to the Creator, except in accordance with this Policy.

The Institute will establish and support an Institute Intellectual Property Policy Committee to advise the Provost in making a determination whether the Institute intends to seek protection on specific inventions or creations. On a case by case basis, the Committee is expected to seek additional expertise to complement that present on the Committee. The Committee shall also have the responsibility of recommending to the Provost interpretations of this Policy, including regulations thereto. Recommendations for changes in this Policy will be made to the Provost for submission to the Academic Senate and the Institute Council. The Committee shall make an annual written report to the Institute Council.

The Committee shall consist of four members. One member shall be elected by the Academic Senate and one by the Staff Council; two members from the Institute community shall be appointed by the Provost. The members shall serve staggered three-year terms. Initially two members shall serve two-year terms and two shall serve three-year terms. Vacancies will be filled by the originating body.

The Committee shall elect its Chair from among its members.

The Intellectual Property Policy will be implemented by the Provost in consultation with the Committee in such a way as to facilitate and simplify the seeking of Intellectual Property protection and benefits. In implementing this Policy, fairness shall be the first criterion.

Questions regarding interpretation of any section of this Intellectual Property Policy and Procedures will be addressed through the Institute Intellectual Property Policy Committee and resolved by the Provost of the Institute. All waivers of any Intellectual Property Rights of the Institute to any Creations will be addressed by the Committee with a recommendation to the Provost.

The Institute may assign or license its rights in any Creation to others.

Also, the income sharing policies described below will continue for the life of the Intellectual Property Rights owned by the Institute. If the Creator leaves the Institute, any share due to the Creator (or the heirs of the Creator) will be forwarded at least annually.

In instances where faculty or staff think there has been an unfair application of policy or procedures, they should refer to the Institute Policies and Procedures Manual, Section E24.0 and Section E30.0, respectively.

## **A. Institute Patent Policy Statement**

### **1. Individual Effort**

Inventions made, conceived, or first reduced to practice by an Inventor are the property of the Inventor when all of the following conditions have been met:

- a. The Invention is the result of activities carried on by, or under the direction of, the Inventor and only incidental costs were paid from Institute funds, or from funds under the control of, or administered by, the Institute;
- b. The Invention is not a direct result of the Inventor's duties to the Institute; and
- c. The Invention has been conceived or developed by the Inventor without the non-incidental use of Institute resources or facilities.

The Institute makes no claim to ownership or rights to Inventions arising from individual (i.e., non-sponsored) efforts. However, the Institute will, on an ad hoc basis, and only at the request of the Inventor, consider providing assistance to evaluate, patent, market, and license the Invention on a shared-income basis. Initial costs will be borne by the Institute and recompensed from royalties or other income before any distribution of the royalties or other income is made. This arrangement will only be entered into following the submission by the Inventor of an agreement to assign all rights and title in the Invention to the Institute. If, after evaluation, the Institute decides not to further pursue a patent, it will release the Inventor from the agreement. The Institute will reach such decisions within one year from the date the Invention is submitted to the Institute.

### **2. Sponsored Effort**

Inventions arising from sponsored efforts are the property of the Institute in any of the following circumstances:

- a. The Invention is the result of activities carried on, by, or under the direction of the Inventor and some of its non-incidental costs were paid from Institute funds, or from funds under the control of, or administered by, the Institute; or
- b. The Invention is a direct result of the Inventor's duties to the Institute; or
- c. The Invention was made, conceived, or reduced to practice by the Inventor with the non-incidental use of some of the Institute resources or facilities.

To the extent a third-party sponsored contractual instrument does not include terms and conditions relative to Inventions, the Institute's Intellectual Property Policy will apply.

At any time after the Institute decides to file for a patent on an Invention, the Institute may, at its sole discretion, decide not to prosecute a patent further or otherwise pursue marketing or licensing of the Invention. In such event, the Institute will reassign or otherwise release an Invention back to the Inventor.



## **B. Institute Copyright Policy Statement**

- 1 The Institute encourages faculty, staff and other non-students to create Original Works of Authorship. In keeping with academic tradition, the Institute does not claim ownership in those Creations which are intended to disseminate the results of the academic research, scholarship, pedagogy, and/or the artistic expression of the Author. Copyright ownership of such an Original Work of Authorship generally will reside with the Author(s), unless the Original Work of Authorship has been created through the non-incidental use of Institute facilities or other resources, is a Commissioned Work, or has been contractually determined to be Institute property, in which case ownership resides with the Institute. If the Original Work of Authorship is the result of a third-party sponsor agreement, the terms and conditions of that agreement will apply.
- 2 While copyright registration is not required under U.S. law, registration of copyright affords added protection for Original Works of Authorship. Copyright registration is recommended for any Original Work of Authorship with the potential for commercial value.

## **C. Institute TRADEMARK AND SERVICE MARK Policy Statement**

- 1 Ownership of Trademarks and Service Marks generally will reside with the Author(s), unless the Trademark and Service Mark have been commissioned by the Institute, or are created within the assigned responsibilities of the Creator's employment with the Institute or through the non-incidental use of Institute facilities or other resources, in which case ownership resides with the Institute. If the Trademark and Service Mark are the result of a third-party sponsor agreement, the terms and conditions of that agreement will apply.
- 2 See Article I.B.3. for additional information regarding Trademarks and Service Marks.

## **D. Institute Mask Works Policy Statement**

- 1 Institute policy on ownership of Mask works is the same as for Copyrights under Article II.B. above.

## **E. Tangible Research Property (TRP)**

- 1 Definition

Tangible Research Property (TRP) is defined for purposes of this Policy as a tangible (or corporeal) item produced in the course of research. TRP includes such items as:

- Biological materials
- Engineering drawings
- Computer software
- Integrated circuit chips
- Computer databases
- Prototype devices
- Circuit diagrams
- Equipment

TRP is separate and distinct from intangible (or intellectual) property such as patents, copyrights, and trademarks, which are subject to other parts of this policy. However, individual items of TRP may also be associated with one or more forms of intangible Intellectual Property, such as copyrights or patents.

## 2. Ownership of TRP

Ownership of TRP generally will be determined in the same manner as ownership of IP, as defined in this document. Non-commissioned TRP created through the Incidental Use of Institute Resources and Facilities is owned by the Creator. For example, circuit diagrams produced under a federal government grant are generally owned by the Institute, subject to the grant terms and conditions. Conversely, fabricated equipment that is the result of a non-federal research sponsor is usually owned by the sponsor, pursuant to the terms and conditions of the sponsor agreement.

## 3. Control of TRP

### a) Control Responsibilities

It is the responsibility of the principal investigator (or laboratory director or department chairperson, if the TRP is not developed as part of a sponsored program) to control the development, storage, use, and distribution of TRP made in the course of research activity, subject to provisions of applicable grants or contracts and Institute policies. Such control includes determining if and when distribution of the TRP is to be made beyond the laboratory for others' scientific use.

### b) Commercial Considerations

Because TRP may have potential commercial value as well as scientific value, the principal investigator (or laboratory director or department chairperson, if the TRP is not developed as part of a sponsored program) may wish to make TRP broadly available for others' scientific use by means which do not diminish its value or inhibit its commercial development or public use. Although valid non-commercial reasons may exist for the temporary delay of TRP distribution outside the laboratory for others' scientific use, (e.g., safety factors, or the need to characterize more fully the TRP prior to distribution, etc.), scientific exchanges should not be inhibited due to potential commercial considerations.

## 4. Purpose of TRP Procedures

Procedures for identification and distribution of TRP are designed to aid the traditional open distribution and exchange of TRP for research purposes, preserve the potential commercial value of TRP, assist the further development of TRP for public use, and protect the Institute and its employees from liability claims arising from the use of TRP by others.

## 5. Identification of TRP

Each item of TRP should have an unambiguous identification code and name sufficient to distinguish it from other similar items developed at the Institute or elsewhere.

## 6. Distribution of TRP for Research

Items of TRP may be distributed to other researchers, in many cases without significant preconditions. However, the Provost, through the Department of Sponsored Research Services, should be consulted for appropriate preconditions to be incorporated into a Materials Transfer Agreement whenever one or more of the following applies:

- The TRP is susceptible to commercialization, further transfer, or other inappropriate use so that restrictions on use and transfer are needed;
- The recipient is expected to defray the costs of materials and handling incurred in the distribution;
- There is a possibility of biohazard or other risk associated with the transport, storage, or use of the TRP, or the recipient might expect to use the TRP in clinical research or some other application posing health or safety considerations; or
- The TRP was developed under a sponsored research agreement, or is part of a pending or potential patent application.

## 7. Distribution of TRP for Commercial Purposes

### a) Distribution Agreement

If TRP developed by the Institute is to be distributed to outside users for commercial purposes, the distribution agreement must contain provisions negotiated by the Provost, through the Technology Licensing Office, covering the terms under which the TRP may be used, limits on the Institute's liability for the property or products derived therefrom, and disposition of any royalty income to the Institute from the licensing of Intellectual Property Rights associated with the use of the TRP.

### b) Contractual Obligations

If the TRP results from a sponsored program, the Department of Sponsored Research Services should be consulted regarding contractual obligations and regulations affecting ownership, notices, acknowledgments, disposition of various rights, and restrictions on the distribution and use of the TRP and any associated income.

## **F. Institute Policy on Commissioned Works**

1. If the Institute assigns or commissions a Commissioned Work, such assignment or commission would normally be in connection with work outside or beyond the ordinary duties of the Creator. The terms of a Commissioned Work will be in writing and will specify the Intellectual Property rights in accordance with this Policy. For example, such

activity could involve released time, a reduced load, grant of additional Institute financial resources, and/or other support or relief from customary responsibilities.

2. Without limiting the Institute's rights with respect to Non-Incidental Creations discussed elsewhere in this Policy, the Institute shall own all Commissioned Works, except that if a Commissioned Work is subject to contractual obligations, ownership shall be in accordance with the terms and conditions of the contractual instrument. If the designation of a Commissioned Work is in question, the case will be reviewed by the Creator's director or department head, and a recommendation shall be forwarded to the Institute Intellectual Property Policy Committee for a decision subject to approval by the Provost.
3. The Institute shall have the exclusive right to use Commissioned Works for the purposes for which they were created and for similar purposes. If not otherwise prohibited by the terms of assignment or commission by the Institute, the Creator shall have the royalty-free right to modify, enhance, or otherwise create derivative works of the applicable Commissioned Work for use outside the original scope of the Commissioned Work.

However, if the Creator of a Commissioned Work believes the Work has become intellectually obsolete or is being used by the Institute in an academically improper manner, the Creator may appeal to the Institute Intellectual Property Committee to direct the Institute to change or stop using the Commissioned Work or otherwise created derivative works.

4. Net income to the Institute from a Commissioned Work shall be shared with the Creator as provided in Article III, except that the Creator shall not be entitled to any share of income derived from the original purpose for which the Commissioned Work was originally created or from any similar purpose, unless otherwise contracted or specified in the written terms of the Commissioned Work.

#### **G. Institute Policy on Non-incidental Creations**

1. The Institute shall own all Non-Incidental Creations. If the designation of a Non-Incidental Creation is in question, the case will be reviewed by the Creator's director or department head, and a recommendation shall be forwarded to the Institute Intellectual Property Policy Committee for a decision subject to approval by the Provost.

### **III. Royalty Income Distribution**

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

- A. All income received by the Institute shall first be used to defray the technology transfer costs incurred by the Institute, or its agents, at any time in evaluating, developing, protecting, administering, enforcing, defending, and otherwise exploiting the Intellectual Property.

B. The Institute encourages and respects agreements that best reflect the contribution of the Creator(s) and the Institute. Unless specifically contracted otherwise, net income shall be distributed to Creators, or their heirs, in accordance with the following schedule:

Institute: 50%

Creator: 50%

**Note:** If the Institute chooses to engage the services of a patent management firm, net income will be reduced by any associated costs prior to distribution.

C. Net income distributed to the Institute shall be designated as discretionary funds available to the Office of the Provost to be used to further research activities at the Institute.

#### **IV. Implementation of Policies**

All faculty, by virtue of their appointment to the Institute, are bound by this Intellectual Property Policy, as it may be amended from time to time. Staff and other non-students whose duties may involve the creation of Intellectual Property shall sign an Intellectual Property Assignment Agreement with the Institute and shall comply with this Policy, as it may be amended from time to time. With respect to the Institute's Intellectual Property, faculty, staff, and other non-students shall assign to the Institute, or any other designated entity, any and all Creations which are the Institute's Intellectual Property under the terms of this policy. Faculty, staff, and other non-students shall execute necessary documents at the time of patent application or copyright registration as requested by the Institute, and shall do anything else reasonably requested by the Institute to assist the Institute to obtain, maintain, protect, and otherwise exploit the Institute's Intellectual Property Rights.

Without the prior written consent of an authorized employee of the Institute, no individual associated with the Institute shall enter into any agreement conveying rights to own or to use Creations, or other Intellectual Property, in which the Institute has an interest.

If it is necessary for the details of a Creation to be revealed to a prospective licensee before patentability (or other form of Intellectual Property protection) has been determined, the prospective licensee may be required to sign a Non-Disclosure Agreement to protect the Institute from unfair appropriation of the Creation or other loss of rights.

##### **A. Procedures for Processing Inventions**

1. Each Inventor shall promptly make a full disclosure of any and all Inventions that fall under the jurisdiction of the Intellectual Property Policy to the Provost, through the Technology Licensing Office, by completing an Invention Disclosure Form. To permit timely evaluation and filing of any patent application in the United States and/or in foreign countries, disclosure to the Technology Licensing Office shall take place prior to public disclosure of the Invention. Such public disclosure may include, but is not limited to, an

abstract presentation or publication, manuscript publication, speeches, transferring of material related to the Invention, or efforts to market the Invention.

If the Invention is the result of a sponsored effort, a duplicate copy of the agreement shall be sent to the Technology Licensing Office.

2. Upon receipt of such disclosure, the Technology Licensing Office shall conduct a timely review of the patent provisions of the relevant contract or grant award to determine the interests of the Institute in the Invention.
3. If the Institute is not entitled to patent rights in the Invention, the Technology Licensing Office shall so notify the Inventor and formally report the Invention to the sponsor, if any.
4. The Technology Licensing Office shall oversee the evaluation of the Invention for patentability and commercial potential. The Institute may elect to engage the services of an independent organization to evaluate, and possibly develop and commercialize, such Invention.
5. If the Institute elects to proceed, the Institute shall use reasonable efforts to obtain a patent and effect its commercial development. The Inventor and sponsor, if any, will be informed in writing of the determination when made but in no case no more than six months following the written notification to the Technology Licensing Office. Should the Institute receive royalties from the commercial development of a patent, it shall pay the Inventor a share, as outlined in Article III - Royalty Income Distribution.
6. If the Institute declines to file a patent application or to proceed with commercial development of a patent, it shall, upon the request of the Inventor but subject to any prior commitment to a sponsor, execute in a timely manner a formal waiver of Intellectual Property Rights in the Invention in favor of the Inventor.

## **B. Procedures for Processing Copyrights and Mask Works**

1. If an Original Work of Authorship is published (i.e., made available to any audience on a nonconfidential basis) before it is registered with the Copyright Office, full protection against infringement is jeopardized. Prior to any publication, the following notice should be placed on all Original Works of Authorship in which the Institute owns the copyright:

Copyright © [year of first publication] Rochester Institute of Technology. All rights reserved.

To protect Mask Work rights, the following notice should be applied on all Institute-owned, semi-conductor chip products which incorporate the Mask Work to be protected:

Mask Work (M) Rochester Institute of Technology. All rights reserved.

No other institutional or departmental name is to be used in either notice, although the name and address of the department to which readers can direct inquiries may be listed below the notice. The date in the copyright notice should be the year in which the Original Work of Authorship is first published.

2. Additional rights and protection for Original Works of Authorship and Mask Works require registration with the U.S. Copyright Office. The Author of an Original Work of Authorship or Mask Work owned by the Institute shall provide a copy of such Original Work of Authorship or Mask Work that may be subject to distribution, publication, reproduction, display, or performance to the Office of the Provost, through the Technology Licensing Office, for consideration of copyright registration before any such activity occurs.
3. Creators of Computer Software are obliged to disclose in writing to the Provost, or his designee, certain kinds of Computer Software generated in whole or in part by and during such Creator(s)' course of employment or participation at the Institute. In general, Computer Software to be disclosed is that which may have commercial potential or which may be utilized in education, research, service, or administration by the Institute. The purpose of such disclosure, which should be in sufficient detail to enable a thorough review and evaluation, is to assure that the interests, rights and responsibilities of the parties involved are determined in a prompt and timely manner without unnecessary expenditure of resources.

It shall be a further obligation of Creators to maintain the confidentiality of any Computer Software generated and to treat it in accordance with the Procedures for the Processing of Inventions and the Procedures for Processing Copyrights approved and implemented by the Institute.

The Institute may at its discretion, and under the directive of the Provost or his designee, utilize any protective mechanisms it deems appropriate for the physical protection of Computer Software covered by the Policy and for legal protection of the Institute's rights to said Computer Software.

### **C. Procedures for Protection of Trade and Service Marks**

1. Trademarks and service marks should be accompanied by the TM or SM designations, respectively.
2. Additional rights and protection are afforded to trademarks and service marks if they are registered. Registration should be coordinated by the Provost's office, through the Technology Licensing Office. Only federally registered marks are accompanied by the "®" symbol.

## **V. Trade Secrets**

Commercial enterprises, which sponsor or are otherwise involved in Institute activities, may seek to protect their trade secrets (i.e. proprietary information giving rise to a competitive commercial advantage) with agreements requiring the maintenance of confidentiality. While the Institute adheres to a principle of free and open publication, there are numerous instances in which agreements confidentiality are necessary and appropriate; these would include activities which enable faculty to engage in intellectual discussion and learn about ideas through working with those who have proprietary interests, as well as activities which are in the public interest (e.g. to aid the education of students, to work on a cure for a disease, to aid a geographic area by assisting in the development of industry, etc.).

In addition, it may be necessary for the faculty to discuss with potential sponsors background research that has resulted in potentially patentable inventions. In these cases, the Institute would request that the potential sponsor sign an agreement to maintain the confidentiality of the Institute's Intellectual Property.

Confidentiality agreements are entered into only after diligence and careful consideration of the best interests of the Institute, including protecting its tax exempt status. Center for Integrated Manufacturing Studies (CIMS), Training & Professional Development (TPD), and the Image Permanence Institute regularly enter into confidentiality agreements as part of their normal business.

All such agreements are subject to the provisions of the Research Oversight Policy.

## **VI. Waiver of Institute Rights**

The Institute will waive its rights to a Creation in favor of the Creator, if the Institute determines that it has no general proprietary interest in the Creation and that such a waiver would enhance the transfer of the knowledge into useful applications for the public benefit, does not raise a conflict of interest, and is consistent with the Institute's obligations to third parties, particularly the sponsor(s) of any applicable program. All waivers of any Intellectual Property Rights of the Institute to any Creation will be determined by the Provost after consultation with the Institute Intellectual Property Policy Committee. All waivers must be in writing and signed by the Provost.

Approved October 15, 1997  
Edited to reflect department name changes 2002-2003