

The Administrative Policies

TAP NO. 40: INTELLECTUAL PROPERTY POLICY

A. POLICY

The Policy reflects the following goals:

1. To create a University environment that encourages the generation of knowledge by faculty, students, and other personnel of the University.
2. To facilitate wide transfer of useful inventions and writings to society.
3. To motivate the development and dissemination of intellectual property by providing administrative assistance to creators and appropriate financial rewards to creators and the University.
4. To ensure that the financial return from the development of intellectual property does not distort decisions and operations of the University in a manner contrary to the mission of the University.

The Policy is based upon the following principles relating the University to society:

1. The University is a community of scholars, both faculty and students, dedicated to the discovery, enhancement, and communication of knowledge.
2. Intellectual property will be generated within the University and there exists an obligation to disseminate it.

The Policy is further based upon the following principles relating faculty, students, and other personnel to the University:

1. Intellectual property is created by individuals or by groups of individuals, who are entitled to choose the course of disclosure: academic freedom of individuals is a higher priority than possible financial reward.
2. There exists a historical tradition allowing authors to retain ownership of intellectual property rights from textbooks, teaching materials and works of art.
3. The University is the sole support of the whole campus community and is thereby entitled to share in financial rewards.
4. The provisions of this Policy do not apply to the normal scholarly or creative publication processes unless the creator intends to waive all proprietary rights to the publication.

B. DEFINITIONS

Certain terms are used in this document with specific meanings, as defined in this section. These definitions may not necessarily conform to customary usage.

Intellectual Property includes all intangibles protected by intellectual or creative effort as defined by law. It also includes computer software, books, teaching materials, on-line course materials, works of art, and other inventions, or other copyright materials that might be developed as original works of authorship.

University means Duquesne University.

Faculty means members of the University's Faculty as defined by University Executive Resolution.

Student means any full-time or part-time undergraduate, graduate, or professional student regardless of whether the student receives financial aid from the University or from outside sources. It is the responsibility of students who are also employees of other outside entities to resolve any conflicts between this policy and provisions of agreements with their employers prior to beginning any undertaking at the University that will involve the development of intellectual property.

Other personnel means any employee of the University other than students and faculty as defined above, or any individual using University equipment and/or facilities. If a student is also a part-time University employee, the student is considered as other personnel with regard to intellectual property developed as a result of his employment, and as a student with regard to other intellectual property. A full-time employee who is also enrolled for one or more courses is considered to be other personnel. Visitors to the University who make substantial use of University resources are considered other personnel with respect to any intellectual property arising from such use.

Creator means any person or persons who create an item of intellectual property.

Net proceeds to the University means all proceeds received by the University on intellectual property that it assigns, sells, or licenses, minus any patent application, patent maintenance, copyright, litigation, interference, or marketing costs directly attributable to the intellectual property being licensed. Deducted costs shall be reasonable and fair, and shall be properly disclosed. The sources and amounts of compensation shall also be properly disclosed.

Net proceeds to the creator means all proceeds received by the creator from intellectual property owned by the creator that the creator sells, assigns or licenses to the University, less the costs of patent application, patent maintenance, legal protection, litigation, interference, travel, and other marketing costs directly attributable to the intellectual property being exploited. Such net proceeds do not include compensation legitimately received by the creator for consulting services, interest or other return on invested labor or capital.

Substantial use of University facilities means extensive unreimbursed use of major University laboratory, studio, or computational facilities or human resources. Use will be considered “extensive” and facilities will be considered “major” if similar use of similar facilities would cost the creator more than \$15,000. Creators wishing to directly reimburse the University for the use of its facilities must make arrangements to do so before the level of facilities usage for a particular intellectual property becomes substantial.

C. PATENTS

Ownership of patentable intellectual property created by a member or members of the faculty, student body, or other personnel of the University, except intellectual property developed pursuant to a pre-existing negotiated agreement between its creator and the University, shall be vested:

1. In the University if created as a result of substantial use of University facilities, unless superceded by 3. or ;
2. In the creators if created without substantial use of University facilities; or
3. In accordance with the terms of any preexisting contract between the University and a sponsoring entity, including but not limited to government agencies, business organizations, foundations or professional societies;

Duquesne University shall enjoy a right and license from the creators to use and modify, for its own use and study, inventions and software, whether or not patentable, which are created through the use of University facilities, whether or not such use is substantial.

D. INVENTION DISCLOSURE

When a member of the faculty or other personnel of Duquesne University creates intellectual property which a reasonably prudent person would believe to be governed by 1) or 3) above, such member shall promptly notify the Associate Academic Vice President for Research/Office of Research by submission of a properly executed Disclosure of Invention form. If a creator of intellectual property is uncertain whether a particular creation is intellectual property subject to 1) or 2) above, it shall be the obligation of the creator to notify the Associate Academic Vice President for Research of the intellectual property and the creator's basis for concluding that the intellectual property is subject to 1) or 2) as the creator's belief may be. Upon investigation, the Academic Vice President for Research will promptly review and determine the rights of the intellectual property in question according to this policy. Any question of interpretation or dispute as to ownership rights of intellectual property under this policy will be settled as stated under Section H.

After review of the Disclosure of Invention form and if ownership of the intellectual property is concluded to be vested in the University, the University, through the Office of Research, shall seek competent patent counsel and shall promptly decide whether or not to seek patent or other protection for the intellectual property, and whether or not to seek licensing or other commercial exploitation of the intellectual property. The University shall have no obligation to exploit commercially any intellectual property.

The creator will be required to execute such applications, assignments, and other lawful papers and do such other lawful acts as may be deemed necessary or desirable by counsel for the University to vest legal title to the intellectual property and any patents thereon in the University or its nominees, and to aid in obtaining patent (or other) protection therefore, all without expense to the creator.

E. COPYRIGHT

Ownership of intellectual property subject to protection under the copyright statutes of the United States created by members of the faculty, student body, or other personnel of the University shall be vested in the creators, except that ownership of such intellectual property is vested in the University if:

1. the materials have been created with substantial use of University facilities; or
2. the materials have been created as a condition of employment as work-for-hire.

Copyrightable intellectual property developed by members of the faculty pursuant to a pre-existing negotiated agreement between its creator and the University, shall be owned by the creator(s).

Duquesne University shall enjoy a right and license from the creator(s) to use and modify copyright materials, for its own use and study, whether or not copyrightable, which are created through the use of University facilities, whether or not such use is substantial. The University shall, in such cases, make every effort to obtain permission of the original creator and properly attribute the original authorship or creation. The University recognizes that this right shall be exercised only when necessary, to prevent unnecessary reengineering or duplication of previous efforts.

F. ROYALTY DISTRIBUTION

If the University licenses or otherwise commercially exploits intellectual property owned by the University pursuant to Article C.1 or E.1), the University shall share with the creator one-third of the net proceeds from such commercial exploitation.

If the University grants royalty bearing licenses to organizations that require the sharing of net proceeds with the creator different from this policy, the creator shall share in the returns in accordance with the terms of the agreement or agreements which the University has with each such organization.

G. WAIVER OF INTELLECTUAL PROPERTY

If the University decides not to carry out patenting and licensing of an invention or other commercial exploitation of any intellectual property which belongs to the University, it will return the invention or intellectual property to the creator who may proceed independently to protect and exploit the creation.

If title to the intellectual property is vested in the creator, the creator may proceed on the creator's own initiative to protect the creation, bearing the responsibility for all costs incurred and receiving any and all incomes resulting.

H. RESOLUTION OF DISPUTES

This policy constitutes an understanding which is binding on the University and on the faculty, students, and other personnel of the University as a condition for participating in research programs at the University or for use of University funds or facilities.

Any question of interpretation or claim arising out of this policy, or dispute as to ownership rights of intellectual property under this policy, will be settled by the following procedure:

1. The issue must first be submitted to the Office of Research in the form of a letter setting forth the grievance or issue to be resolved. The Provost/Vice President for Academic Affairs, in cooperation with the President, shall appoint an Ad Hoc Intellectual Property Adjudication Committee of five members (including three faculty members) to review the matter and then advise the parties of its decision within 60 days of submission of the letter.
2. If any of the parties to the dispute is not satisfied with the Committee's decision, the party may seek binding arbitration in Pittsburgh, Pennsylvania and in accordance with the Rules of the American Arbitration Association then in effect. Judgment upon the award rendered by the arbitrator(s) may be entered in any court having jurisdiction thereof. The arbitrator(s) will give some weight to the decision of the Ad Hoc Intellectual Property Adjudication Committee in reaching a decision. The responsibility for the cost associated with the arbitration shall be determined by the arbitrator(s).

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