



## RESEARCH POLICY 5 (RP-5) (FORMER RP/TAP-40) INTELLECTUAL PROPERTY

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### 1. Introduction

Duquesne University, as an institution of higher learning, is dedicated to providing excellence in education, research, and scholarship. The goal of this Research Policy is to foster the progress of science and technology and to ensure that discoveries, inventions, and creations generated by our Faculty, Staff, Students, and Visitors are utilized in ways most likely to benefit the public. This Research Policy governs the organizational structure and procedures for the management of the University Intellectual Property and aims to promote and encourage the generation of knowledge by Faculty, Students, and Staff of the University; to facilitate the wide transfer of useful inventions and writings to society; to inspire the development and dissemination of Intellectual Property by providing administrative assistance to Creators or Inventors and appropriate financial rewards to Creators or Inventors and the University; and 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. Achieving these goals may require protection and licensing of the University Intellectual Property.

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### 2. Policy Statement

This Research Policy seeks to foster research, encourage innovation, support commercialization efforts, and make certain technologies available to the private and public sectors for the benefit of the world in a manner that is consistent with Duquesne University's commitment to academic and educational excellence. The purpose of this document is to set forth a general policy consistent with these aims that defines the rights and obligations of Duquesne University Faculty, Staff, Students, and Visitors with regard to Intellectual Property.

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### 3. Policy Scope

This Research Policy applies to Faculty, Students, Staff, Visitors, and others who make use of University Facilities, equipment, or other resources or who receive funds from the University in the form of salary, wages, stipend, or other support, but not including undergraduate financial aid.

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### 4. Definitions of Terms

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

<b>Creator</b>	Any creator, developer, or producer of Intellectual Property, including Faculty, Students, Staff, and Visitors of the University.
<b>Faculty</b>	Any member of the University's Faculty as defined by University Executive Resolution.
<b>Intellectual Property</b>	<p>Intellectual Property is a broad term referring to all forms of technology and expression whose ownership is subject to legal protection including, but not limited to, inventions, discoveries, research data, works of authorship and software, tangible research products (e.g., biological materials, databases, prototype devices, equipment, and research data), trade secrets, and know-how regardless of whether subject to protection under patent, trademark, copyright, or other laws.</p> <p>For the purposes of this Research Policy, Intellectual Property does not include the University's name, logos, trademarks and/or service marks which are not managed or overseen by the Office of Research and Innovation (the ORI).</p>
<b>Inventor</b>	Any creator, developer, or producer of Intellectual Property, including Faculty, Students, Staff, and Visitors of the University, who is determined to be an inventor under applicable U.S. patent laws and regulations.
<b>License</b>	A legal contract between parties granting rights of use in Intellectual Property and establishing the rights and obligations of each party.
<b>Net Proceeds</b>	Revenue arising from the commercial exploitation of Intellectual Property, less any costs directly attributable to the Intellectual Property being licensed such as, for example, legal costs, patent application costs, patent maintenance costs, copyright costs, dispute or litigation costs, transactional costs, or marketing costs. Deducted costs shall be reasonable and fair, and shall be properly disclosed. The sources and amounts of compensation shall also be properly disclosed.
<b>Student</b>	Any full-time or part-time graduate or undergraduate or professional student who receives funds from the University in the form of salary, wages, stipend, or other support, regardless of whether the student receives financial aid from the University or from outside sources. Any full-time or part-time undergraduate student who receives funds from the University in the form of salary, wages, stipend, or other support, but not including undergraduate financial aid. It is the responsibility of Students who are also employees of other outside entities to resolve any conflicts between this Research Policy and provisions of agreements with their employers or their employer's policies prior to beginning any undertaking at the University that will involve the development of Intellectual Property.

<b>Staff</b>	Any employee of the University other than Students and Faculty as defined above. If a Student is also a part-time University employee, the Student is considered as Staff 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 Staff.
<b>Substantial Use</b>	Extensive unreimbursed use of University facilities, equipment, personnel (including graduate students), or other resources. Mere incidental use of a facility does not constitute Substantial Use. Use will be considered “substantial” if similar use of similar facilities would cost the Creator or Inventor more than \$5,000. Creators or Inventors wishing to directly reimburse the University for the use of its facilities must plan to do so before the level of facilities usage for a particular Intellectual Property becomes substantial. (This provision is not intended to override any other department or University Policy concerning reimbursement for facilities usage.)
<b>University</b>	Duquesne University
<b>Visitor</b>	Any Visitor to the University who makes Substantial Use of University resources is considered Staff with respect to any Intellectual Property arising from such use. Visitors include scientists and scholars who are visiting the University in order to conduct, or who are currently conducting, research on the University campus. This designation includes, but is not limited to, those individuals with visiting faculty positions, short-term fellowships, and those pursuing like research opportunities with limited duration.

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## 5. Ownership of Intellectual Property

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### 5.1. University-Owned Intellectual Property

Except as delineated in subsection 5.2 of this Research Policy, the University retains ownership of all Intellectual Property (including but not limited to lab notebooks, cell lines, software, human samples and other related tangible research property) that was generated, conceived, created, first reduced to practice, or authored by Faculty, Students, and Staff acting within the scope of their employment. The University will also retain ownership of Intellectual Property where:

1. Substantial Use of University facilities, equipment, personnel, or other resources were used in the creation of such Intellectual Property;
2. the Intellectual Property was created pursuant to a sponsored grant or award funded through corporate, federal, or other external sponsoring entity administered by the University; or

3. the Intellectual Property was created by a Visitor pursuant to a written agreement providing for a transfer of the ownership of such Intellectual Property to the University.

Creators/Inventors will provide, upon request by the University, assignments or other documents necessary to perfect the University's ownership rights upon their employment, or as otherwise requested, and in accordance with this Research Policy. Creators/Inventors agree to cooperate in the execution of any documents required by the University to record and/or perfect the University's ownership interest in Intellectual Property.

Creators/Inventors of University Intellectual Property have no independent right or authority to convey, assign, encumber, or license such Intellectual Property other than to University. Furthermore, to avoid any potential for a conflict of interest, Faculty, Students, and Staff may not enter into a consulting agreement that is in conflict with any provision of this Research Policy.

## **5.2 Intellectual Property Agreements**

Prior to conducting any research on behalf of University either under a sponsored research agreement or with the Substantial Use of University resources or use of funds administered by University, all individuals subject to this Research Policy, including, but not limited to, Faculty, Staff, Students, and Visitors, must review, execute and sign the Duquesne University intellectual property and confidentiality agreement ("Intellectual Property Agreement"). By executing the Intellectual Property Agreement, these individuals do (a) agree to assign and hereby do assign to the University all of their title, right and interest to Intellectual Property created through the use of such Significant Use and (b) agree to promptly execute and deliver all documents and other instruments as are reasonably necessary to reflect Duquesne University's ownership of this Intellectual Property.

Non-employees, including Visitors, such as visiting scientists and fellows, who intend to participate in research projects that employ (i) the use of University funds and/or (ii) Significant Use of resources and/or (iii) the use of third party funds or materials obtained through University must enter into an agreement that addresses the management of intellectual property and confidentiality consistent with the provisions of this Research Policy and the federal funding and/or contractual obligations of University prior to participating in any such research. The terms of such agreement will depend on the research being contemplated, the obligations of University with respect to that research, and the assignment obligations of the non-employee.

## **5.2. Copyrightable Intellectual Property**

Copyright law encourages the creative efforts of authors, artists and others by providing for exclusive rights to reproduce and distribute copies of the work, to display or perform publicly the work, and to create derivative works. Generally, under copyright law, employers own the copyrights to works produced by employees in the course and scope of their employment, unless the employer has a policy that provides otherwise. It is the intent of the University under this policy to foster the traditional freedoms of Faculty and Students in matters of publication and dissemination of scholarly, educational and creative works, and to facilitate the academic interests of the University in the continuity of research and educational programs. To do so, this policy provides that Faculty and Students own the

copyrights to works they produce during their academic careers at the University, subject to limited contractual exceptions and, in certain circumstances, limited use rights. It is the further intent of the University under this policy to clarify that for Staff, the University owns the copyrights to works produced in the course and scope of their employment at the University.

Except as noted below, University owns the copyrights to all works produced by Staff and employees (other than Faculty and Students) in the course and scope of their employment or other engagement at University.

Faculty and Students own the copyrights to scholarly works (including dissertations and theses, and papers), literary works, art works, architectural works, musical works, syllabi, and textbooks that such person produces regardless of the form of expression, and University retains the non-transferable, perpetual, non-exclusive right to use such works on a royalty-free basis solely for University's education, teaching, and research activities, except as follows:

1. If the Faculty or Student work is subject to a contractual obligation of the University, such as a sponsored research agreement, then the ownership of the copyrights with respect to such work shall be governed by the terms of the contractual obligation of the University.
2. If the Faculty or Student has agreed with the University to produce a specific work for the University, then the ownership of the copyrights with respect to such work shall be governed by the terms of the agreement with the University.
3. If the Student work is produced in the course and scope of such Student's employment at the University, then the Student is treated as Staff and the ownership of the copyrights with respect to such work vests in the University

### **5.3. Use of Duquesne University Name**

The simple identification of the University as the employer of Faculty, Students, and Staff, is generally appropriate. However, while the Faculty, Students, and Staff may mention their employment at University, the Faculty, Students, and Staff must not use the trademarks, name, or logos to endorse products or services. The Office of Marketing & Communications must be consulted concerning the proposed use of the name of Duquesne University or any Duquesne University logo or trademark in commercial matters or any situation where University endorsement is implied.

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## **6. Administrative Procedures**

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### **6.1. Disclosure**

All computer software and potentially patentable inventions created, conceived, or first reduced to practice in whole or in part by Faculty, Students, Staff, and Visitors shall be disclosed to ORI in a timely manner shortly after such Intellectual Property is created, conceived, or first reduced to practice, regardless of the source of funding; however, in all cases, such Intellectual Property must be disclosed to ORI before it is (i) disclosed to a party other than the relevant sponsor and/or third party; or (ii) used for commercial

purposes; or (iii) published or otherwise placed in the public domain. Disclosures of Intellectual Property to the University should be made using the “Invention Disclosure Form” available at <https://www.duq.edu/research/intellectual-property-and-technology-transfer>. Nothing in this Research Policy is meant to limit or restrict the right of the Faculty, Students, and Staff to publish results of their research, subject to reasonable delays to preserve patent or other Intellectual Property rights, or as required by third-parties in research agreements.

When uncertain whether the University has an ownership interest in the Intellectual Property, notify the ORI of the Intellectual Property and the ORI will promptly review and determine the rights to the Intellectual Property in question according to this Research Policy. Any question of interpretation or dispute as to ownership rights of Intellectual Property under this Research Policy shall be settled as stated under Section 7.6.

## **6.2. Review**

Upon receipt of the Invention Disclosure Form, the ORI will ensure that the ownership rights are properly defined, which may include execution of documents to record and/or perfect appropriate ownership interests in Intellectual Property. The ORI will evaluate the Intellectual Property on the basis of protectability, including patentability, and commercial feasibility. The Creators/Inventors will be informed in writing of the action the University intends to pursue with respect to the Intellectual Property; this communication will normally take place within six months of the disclosure of the Intellectual Property to the ORI. The University may, at any time, elect not to pursue legal protection or commercialization, in which case the ORI will notify the Creators/Inventors of such decision in writing. At any time after disclosure of the Intellectual Property to ORI, Inventors/Creators may request the University release to the Inventors/Creators the University’s rights to the Intellectual Property under appropriate terms, as explained below.

The University, in its sole discretion and consistent with the public interest, (i) may choose not to assert its ownership rights in any Intellectual Property; or (ii) may decide to assign its ownership rights in such Intellectual Property to the Creators/Inventors or (iii) may decide to license its rights in such Intellectual Property to the Inventors/Creators on an exclusive or nonexclusive basis (Subsections (i), (ii), (iii) collectively called “Release”). Decisions regarding whether to issue a Release of Intellectual Property to Creators/Inventors shall take into account the stage of development of the Intellectual Property and the obligations, if any, the University has assumed from any contracts or agreements for the development of such Intellectual Property. In general, a Release will not be granted for Intellectual Property that has not been reduced to practice or for Intellectual Property that is a future or possible outcome of proposed research. Additionally, a Release will not be granted if the Intellectual Property is contractually obligated to an entity or such Release would result in an unmanageable conflict of interest or conflict of commitment. Questions about Releases should be directed to ORI.

Each and every Intellectual Property Release to Creators/Inventors will specify income rights for the University and may further impose other limitations or obligations, including, but not limited to, a nonexclusive license for the University to use the released Intellectual Property for teaching, scholarly, and other academically related purposes, nonprofit

research, and to comply with United States government reporting and license requirements. Releases may additionally require the Creators/Inventors to demonstrate an ongoing technical and financial capability to commercialize the released Intellectual Property. When the Release is issued in the form of a license, the Inventors/Creators will be required to assume the future costs of filing and prosecuting such patent application and maintaining any patent rights when a patent is issued.

### **6.3. Licensing Intellectual Property**

The University wants to encourage and advance the commercial application of University research for the public good through the licensing and commercialization of its Intellectual Property. However, the research and teaching missions of the University take precedence over intellectual property considerations, and the direction of the University research should not be guided or unduly influenced by patent considerations or personal financial interests. Any license agreements between the University and commercial entities must not undermine the University's basic missions of education and research and must be carried out in a manner that does not create an unmanageable conflict of interest, actual or perceived, for the University or its Faculty, Students, and Staff. Additionally, all license agreements must provide appropriate legal protection for the University and its Faculty, Students, and Staff and must not restrict the University's research and publication activities, and must comply with relevant laws and regulations.

Based on the University's assessment of any commercial interest in the University-Owned Intellectual Property, the University may negotiate with one or more potential licensees. The University may accept equity as consideration for a license transaction for University-Owned Intellectual Property. All decisions as to licensing or other disposition of Intellectual Property owned by the University, and liquidation of any consideration received by the University for such licensing, are at the sole discretion of the University, consistent with the University's delegation of authority.

### **6.4. Management and Distribution of Revenue**

#### **6.4.1. Division of Proceeds**

In those instances where the University licenses its rights in Intellectual Property to third parties, the full cost of such licensing activities, including, but not limited to, marketing and the legal costs associated with patent or other intellectual property protection, including those related to any dispute resolution, must first be captured from any royalties or other license payments received by the University before any further income distribution can be made. Additionally, the University may retain a portion of the royalty and other income/consideration received from such a license in order to meet known future or expected expense obligations. In the majority of cases, the remainder of any such income (including, but not limited to, license fees, prepaid royalties, minimum royalties, running royalties, milestone payments, and sublicense payments, etc.) shall be divided as follows:

Creators/Inventors will receive one-third of the Net Proceeds arising from such commercial exploitation and the University will receive two-third of the Net Proceeds arising from such commercial exploitation (see Net Proceeds Distribution table). This division of Net Proceeds will apply to all licenses executed by the

University on or after the effective date of this Research Policy, regardless of when the underlying Intellectual Property was disclosed to the ORI.

<b>Net Proceeds Distribution</b>	
<b>Inventor(s)/Creator(s) Share</b>	<b>University Share</b>
33.33%	66.67%

In the case of any potential material non-cash proceeds from a license transaction (other than equity, which is discussed in section 6.4.4 below), the Creators/Inventors will meet with the ORI prior to the execution of the license to resolve any allocation, if any, of such non-cash proceeds that is reasonable under the circumstances.

**6.4.2. Allocation of Net Proceeds**

If there is more than one Creator/Inventor, then the Creators/Inventors share of the Net Proceeds shall be divided and shared among the Creators/Inventors in accordance with an explicit written agreement executed by all of the Creators/Inventors of the licensed Intellectual Property (“Revenue Sharing Agreement”). Each Revenue Sharing Agreement should clearly state how the Net Proceeds are to be distributed among the Creators/Inventors in terms of percentages or other similar means. A Revenue Sharing Agreement may be changed at any time with the written consent of all named Creators/Inventors who executed the original Revenue Sharing Agreement. A Revenue Sharing Agreement must be in place and presented to ORI prior to the distribution of any Net Proceeds. The University is under no obligation to resolve any disagreements between or among the Creators/Inventors. However, the ORI reserves the right to intervene, at its discretion, to aid in dispute resolution. All expenses of dispute resolution that may be incurred by the University will be deducted as an additional expense prior to distribution of Net Proceeds. In the absence of a Revenue Sharing Agreement specifying an allocation of Net Proceeds, the University will distribute Net Proceeds to Inventors/Creators in proportion to the percent contribution indicated in the Invention Disclosure Form. If there is more than one Intellectual Property docket maintained by the ORI that is being licensed in a single license transaction, the University will distribute Net Proceeds divided equally between or among dockets unless there is a unanimous written agreement between or among all relevant Creators/Inventors prior to the execution of the license. A docket typically includes an initial disclosure of Intellectual Property covered by this Research Policy to the ORI, as described in subsection 6.1, as well as any dependent or corresponding supplemental disclosures by the same Creators/Inventors, and any resulting Intellectual Property rights. This Research Policy will not affect any separate arrangements or agreements, existing on the effective date of this Research Policy, concerning an alternative allocation of Net Proceeds between or among the Creators/Inventors or between the Creators/Inventors and the University.



### **6.4.3. Distribution of Net Proceeds**

In general, the ORI will distribute the Net Proceeds in accordance with this Intellectual Property Policy within a reasonable period of time after receipt thereof but no less frequently than one time per year; with each such distribution, ORI will include a summary of the total income received and the manner in which such income was, or will be, distributed. In the event that no such income distribution is to be made, the Creators/Inventors will be provided a summary of any license revenue received and/or retained by the University for that year.

The University will use reasonable efforts to distribute any Net Proceeds to any Creator/Inventor who is no longer associated with the University, provided, however, that it is the sole obligation of such Creator/Inventor to maintain current contact information with the ORI for such purposes. In the event of the death of a Creator/Inventor, any Net Proceeds due to the Creator/Inventor will be distributed to their estate, in accordance with this Research Policy and applicable law.

Distribution of Net Proceeds to a Creator/Inventor will cause tax consequences to the Creator/Inventor, which are the sole responsibility of the Creator/Inventor.

### **6.4.4. License-Derived Equity**

If the University and any Creators/Inventors are to receive any equity, or other class of securities, as consideration in a license transaction for University-Owned Intellectual Property, then all of the equity will be held by the University and managed by the University's Treasurer's Office or its designee. The University will seek to liquidate such equity as soon as reasonably practicable, usually in the public market, rather than seek to maximize the return on the equity by trying to time the sale of the equity. The University does not act as a fiduciary for any Inventor or Creator concerning such equity, and no Creators/Inventors will have any right to vote or direct the disposition of such equity held by the University. The University has no obligation or duty to a Creators/Inventors regarding the relative value realized upon liquidation of such equity, or with respect to any personal tax obligations that may arise as a result of the receipt by the Creators/Inventors of a portion of the Net Proceeds from the disposition of such equity. Once the equity is liquidated, the proceeds will be treated as cash proceeds of the applicable license transaction and distributed as Net Proceeds under the terms of this Research Policy.

## **6.5. Resolution of Disputes**

Any question of interpretation or claim arising out of this Research Policy, or dispute as to ownership rights of Intellectual Property under this Research Policy, shall be settled by the following procedure:

1. The question/claim must first be submitted to the ORI in the form of a letter setting forth the grievance or issue to be resolved.
2. The Vice President for Legal Affairs and General Counsel, in consultation with the President, shall appoint an Ad Hoc Intellectual Property Adjudication Committee of five members (including three Faculty members) to review the matter and advise the Provost of its recommendation for how to resolve the dispute.

3. Upon receiving the recommendation of the Ad Hoc Intellectual Property Adjudication Committee, and upon further consultation with the President and Vice President of Legal Affairs and General Counsel, the Provost will issue a final, binding decision with respect to the grievance.

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## 8. Exceptions

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Exceptions to this Research policy and procedures require approval from the Vice Provost for Research and normally will be made with the agreement of those involved in the Ad Hoc Intellectual Property Adjudication Committee.

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## 9. Related Documents

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This Research Policy works in conjunction with the following Research and University Policies, which are fully applicable. To the extent there is any conflict between this Research Policy and any of the Research or University Policies listed below, the University retains the sole discretion to determine which takes precedent.

<b>Research Policy/TAP</b>	<b>Title</b>	<b>Web Address</b>
RP-1	Procedure for Submitting External Sponsored Grants and Awards	<a href="https://www.duq.edu/research/research-conduct">https://www.duq.edu/research/research-conduct</a>
RP-2	The Use of Human Subjects in Research	<a href="https://www.duq.edu/research/research-conduct">https://www.duq.edu/research/research-conduct</a>
RP-3	Effort Reporting on Sponsored Grants and Awards	<a href="https://www.duq.edu/research/research-conduct">https://www.duq.edu/research/research-conduct</a>
RP-4	Faculty Research Proposals to Governmental, Corporate, Foundation and Private Sources	<a href="https://www.duq.edu/research/research-conduct">https://www.duq.edu/research/research-conduct</a>
RP-6	Research Integrity	<a href="https://www.duq.edu/research/research-conduct">https://www.duq.edu/research/research-conduct</a>
RP-7	Conflicts of Interest in Sponsored Grants and Awards	<a href="https://www.duq.edu/research/research-conduct">https://www.duq.edu/research/research-conduct</a>
RP-8	Research Agreements and Private Business Use	<a href="https://www.duq.edu/research/research-conduct">https://www.duq.edu/research/research-conduct</a>
TAP-33	Conflict of Interest	<a href="https://www.duq.edu/work-at-du/human-resources-home/the-administrative-policies-(taps)/33-conflict-of-interest">https://www.duq.edu/work-at-du/human-resources-home/the-administrative-policies-(taps)/33-conflict-of-interest</a>
TAP-46	Commercial Entities—Faculty, Staff and Student Participation	<a href="https://www.duq.edu/work-at-du/human-resources-home/the-">https://www.duq.edu/work-at-du/human-resources-home/the-</a>

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## 10. Contacts

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Office	Telephone Number	Email Address and/or URL
Office of Research and Innovation	412-396-6326	duq.edu/research ORI@duq.edu

Web Address for this Research Policy: <https://www.duq.edu/research/research-conduct>

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## 11 Effective Date and Revision History

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This Research Policy is subject to periodic review and update by the Office of the Provost and the Vice Provost for Research.

12/12/22 (Previous revision was dated 08/06)