

1.13 ETSU Intellectual Property Policy

1.13.1 Objectives of this Policy

It is the policy of the East Tennessee State University (the University) to: (1) encourage inventions and the production of copyrightable works by employees of the University; (2) facilitate the utilization of such inventions and works to the benefit of the public, the University, and the members of the University community; and (3) provide for the equitable sharing of any proceeds derived from the commercial exploitation of inventions and copyrightable works in which, pursuant to this policy, the University is determined to have an interest. This policy is intended to protect the interests of all concerned parties: the University, members of the University community, external sponsors of research, and the public.

1.13.2 Definitions

“Author” means the person or persons responsible for creation of a copyrightable work.

“East Tennessee State University Research Foundation, Inc.” (ETSURF) means a corporation established by East Tennessee State University and approved by the Tennessee Board of Regents to provide support for activities related to the mission of East Tennessee State University including management of Intellectual Property.

“Gross Income” as defined here is income coming to East Tennessee State University or the East Tennessee State University Research Foundation and means proceeds from the sale, lease, or licensing of Intellectual Property by the University; dividends derived from equity received in consideration for the sale, lease, or licensing of Intellectual Property by the University; or proceeds from the sale of equity received in consideration for the sale, lease, or licensing of Intellectual Property by the University.

“Intellectual Property” means Inventions and Creative Works.

“Invention” means any discovery, invention, new use or application, process, composition of matter, article of manufacture, know-how, design, model, technological development, or biological material.

“Inventor” means the person or persons responsible for conception of an idea or ideas leading to an invention.

“Net Income” as defined herein refers to income coming the East Tennessee State University or the East Tennessee State University Research Foundation and is gross income minus the direct costs associated with patent prosecution, copyright registration, commercialization, defense, maintenance, and administration of Intellectual Property.

“Scholarly Works” include, but are not limited to, articles written for publication in academic journals, textbooks, works of art, musical compositions, and literary works.

Theses and dissertations are not, for the purposes of this policy, scholarly works. Works by non-faculty employees shall not, for the purposes of this policy, be considered scholarly works.

“Scope of Employment” refers to activities which have been assigned to an employee by his or her supervisor or which are performed during normal working hours or which fall within the employee’s job description.

“Significant Use” means utilization of Institution funds, personnel, facilities, equipment, materials or other resources resulting in a cost to the Institution (direct, indirect, or depreciative) of more than \$2,500 (in constant 2001 dollars).

“Work” means any copyrightable material, such as literary works; musical works, including any accompanying words; dramatic works, including any accompanying music; pantomimes and choreographic works; pictorial, graphic, and sculptural works; motion pictures and other audiovisual works; sound recordings; architectural works; computer software or databases; circuit diagrams; architectural and engineering drawings; and lectures.

1.13.3 Authorization

Institutions of the Tennessee Board of Regents are authorized to seek and hold patents and copyrights, to assign their rights in Intellectual Property, and to execute agreements concerning royalty distribution. TBR Universities shall develop additional Institution-specific policies and rules relating to Intellectual Property not inconsistent with the Tennessee Board of Regents Intellectual Property Policy (http://www.tbr.state.tn.us/policies_guidelines/personnel_policies/5-01-06-00.htm) or other policies of the Tennessee Board of Regents.

East Tennessee State University has authorized the East Tennessee State University Research Foundation to act as the agent for the University in matters concerning Intellectual Property. The University may, at the direction of its President and with approval of the Board of Directors of the ETSURF, assign its rights to Intellectual Property to ETSURF. ETSURF may, on behalf of the University, seek and hold patents and copyrights, negotiate and administer licenses, and collect and distribute royalties on behalf of the University in accord with the provisions of this policy.

1.13.4 Applicability

This policy shall apply to all persons employed (either as full-time, part-time or temporary employees, including Graduate Assistants) by East Tennessee State University, to students enrolled at East Tennessee State University, and to other persons using University facilities and resources. Contracts for works for hire between East Tennessee State University and independent contractors should define the respective rights and responsibilities of the parties with respect to ownership of any Intellectual Property developed as a result of the contract.

1.13.5 Ownership of Intellectual Property

Intellectual Property developed by persons to whom this policy applies shall be the sole and exclusive property of the University or ETSURF if the subject Intellectual Property is (1) developed within the person's scope of employment with the University, (2) developed in the course of a project sponsored by the University, (3) developed with the significant use of the University's facilities, services, or equipment (personal office space, libraries and the inventor or author's personal computer provided by the Institution excluded), or (4) developed in the course of a project arranged, administered or controlled by the University and sponsored by persons, agencies or organizations external to the University, absent prior written agreement to the contrary.

With respect to students, use of resources or facilities typically available to students in their educational activities shall not be considered "significant".

Prior to the University providing support (for example, release time or University funding) to a person to whom this policy applies, where that support could reasonably be expected to result in an invention or creation of a copyrightable work with commercial value, the University and the person or persons receiving that support shall agree in writing whether any Intellectual Property potentially arising from the supported activities would qualify as a Scholarly Work.

The University shall not assert ownership of Scholarly Works, regardless of whether the circumstances surrounding creation of the work satisfy one or more of the four tests outlined in this section for determining University ownership. Disclosure of Scholarly Works is nonetheless required, subject to the condition that only those copyrightable works which could reasonably be expected to have commercial value must be disclosed.

Intellectual Property developed outside an employee's scope of employment, on the employee's own time and without the use of significant University resources shall be the sole and exclusive property of the Inventor or Author. In consideration of University or ETSURF support in evaluating the Intellectual Property, seeking patent protection and/or pursuing commercialization activities, the University and the Inventor or Author may agree to assign all or a portion of the ownership rights to his or her invention or work to the University or the ETSURF.

Nothing in this policy shall preclude a mutually agreed upon contract between the University and persons to whom this policy applies wherein either party may agree to waive their rights under this policy.

1.13.6 Administrative Responsibilities

1.13.6.1 Inventors and Authors

Persons to whom this policy applies are responsible for disclosing to the University his or her invention or production of a copyrightable work that could reasonably be expected to

have commercial value. Disclosure shall be made to the Vice Provost for Research and Sponsored Programs using an Invention Disclosure Form (see Attachment 1) or Copyrightable Work Disclosure Form (see Attachment 2). The Vice Provost will coordinate review of the Disclosure by the University Intellectual Property Advisory Committee (**Section 6.2**). The Inventor or Author shall fully cooperate with the University Intellectual Property Advisory Committee other University and ETSURF personnel in the disclosure process and in other subsequent activities associated with patenting and/or commercialization of the invention or work. Information regarding disclosure of inventions or copyrightable work may be found in “Information and Guidelines Concerning the Patent and Copyright Process at East Tennessee State University” (<http://www.etsu.edu/ospa/Word-Web-Docs/ETSU%20Patent%20Guide.doc>).

In the event that two or more persons are entitled to claim ownership of the Intellectual Property, the Inventors or Authors shall reach agreement between or among themselves regarding relative contributions for the purposes of distribution of Net Income from the Invention or Work. That agreement should be in writing and be notarized. The agreement will be required prior to review by the University Intellectual Property Advisory Committee.

Inventors should particularly note that certain acts (for example, publication of the Invention in an academic journal or possibly even presentation at a conference) can constitute a statutory bar to patent protection. An Inventor contemplating public disclosure activities prior to filing an Invention Disclosure Form should contact the Vice Provost for Research and Sponsored Programs prior to engaging in those disclosure activities.

1.13.62 Intellectual Property Advisory Committee

The President of East Tennessee State University shall appoint members to the University Standing Committee on Intellectual Property Advisory Committee (IPAC). The IPAC will consist of nine (9) appointed, voting members experienced in Intellectual Property matters. Seven (7) of these members shall be drawn from the faculty and two (2) from the community. Two (2) of the nine members shall also be members of the Board of Directors of ETSURF. The Vice Provost for Research and Sponsored Programs shall serve as the chair of the IPAC and will not vote. All members of the IPAC shall execute confidentiality agreements to insure that all information concerning Intellectual Property disclosed to the Committee is held confidential.

The Inventor(s) or Author(s) will fill out the Invention Disclosure or Copyright Disclosure Form, have their chairman and dean review and sign it, and submit it to the Vice Provost for Research and Sponsored Programs. The Vice Provost shall conduct an interview with the Inventor(s) or Author(s) to discuss the process with them and make any recommendations he/she has to improve the Disclosure.

The Vice Provost for Research and Sponsored Programs shall convene the IPAC and charge them with evaluation of the Disclosure. A patentability evaluation shall in

particular include a thorough evaluation of acts by the Inventor or items of prior art that would bar patent protection. Additional guidelines for evaluation may be found in “Information and Guidelines Concerning the Patent and Copyright Process at East Tennessee State University” (<http://www.etsu.edu/ospa/Word-Web-Docs/ETSU%20Patent%20Guide.doc>).

The IPAC may seek outside assistance in preparing its recommendations. Any compensated assistance obtained from private legal counsel that is paid for by East Tennessee State University must be approved in advance by the Attorney General of the State of Tennessee. Approval by the Attorney General of the State of Tennessee is not required if the outside legal counsel is retained and compensated by ETSURF.

The Committee shall conduct investigations as it deems necessary in performing the evaluation. Upon completion of the evaluation, the IPAC shall provide the Vice Provost for Research and Sponsored Programs with its recommendations as to ownership of the Intellectual Property, whether patent protection should be sought, and whether to seek commercialization opportunities. The Vice Provost for Research and Sponsored Programs shall transmit these recommendations to the President of East Tennessee State University. The final decision to pursue protection of the Intellectual Property rests with the President of East Tennessee State University who shall communicate this decision in writing to the Vice Provost for Research and Sponsored Programs Administration who shall communicate the decision in writing to the inventor(s) or author(s) and the IPAC.

If the decision of the President is not to seek patent or copyright protection of the Intellectual Property, and the Institution has an ownership interest in the Intellectual Property, the President may assign the Institution’s ownership interest to the Inventor or Author. The Vice Provost for Research and Sponsored Programs will administer this action.

For those inventions or works in which East Tennessee State University is deemed to have an ownership interest, following a decision by the President of University to seek patent protection, copyright registration, and/or commercialization of the Intellectual Property, the Vice Provost for Research and Sponsored Programs shall arrange to have these activities undertaken and oversee their execution. All direct costs associated with those activities shall be borne by East Tennessee State University or ETSURF.

For inventions made in the course of a project funded in whole or in part by the Federal Government, the Bayh-Dole Act (37 CFR 401) imposes certain reporting requirements associated with the technology transfer process. The Vice Provost for Research and Sponsored Programs is responsible for ensuring that those reporting requirements are satisfied.

1.13.63 TBR Office of the General Counsel

The TBR Office of the General Counsel is available to support the TBR Institutions, and specifically the IPAC, in evaluating the inventorship, ownership, and patentability of

inventions disclosed to the Institution. To the extent that appropriate resources exist, the OGC shall be available to support prosecution of patent applications. The Office of the General Counsel is further available to the Institutions to support the drafting of licensing agreements. The Office of the General Counsel shall receive and evaluate disclosures originating at TBR Institutions without Advisory Committees.

1.13.7 Appeals

The Inventor or Author may appeal decisions of the President. If the Inventor or Author disagrees with an initial decision, he or she may request a re-evaluation by the President. The President is not authorized to delegate responsibilities relative to appeals. The request must be received within thirty calendar days of notification to the Inventor or Author of the initial decision. The Inventor or Author may submit documents or other evidence in support of his or her position. A second and final decision by the President relating to ownership or royalty distribution may be appealed to the Chancellor of the Tennessee Board of Regents. Decisions of the TBR Chancellor shall be binding.

1.13.8 Income from Intellectual Property

Income derived from the commercialization of Intellectual Property in which the University or ETSURF, acting on behalf of the University, has an interest shall be first applied toward any direct expenses incurred by the University or ETSURF in seeking patent protection or copyright registration, in pursuing commercialization of the Intellectual Property, in maintaining the patents and for legal expenses incurred in the event of infringement defense.

After reimbursement of direct expenses to the University or ETSURF as described in the preceding paragraph the remaining Net Income shall be distributed as follows: 50% to the inventor(s) or author(s), 20% to the inventor's or author's department, 15% to the inventor's or author's college, and 15% to the research support fund administered by the Vice Provost for Research and Sponsored Programs, or, if the Intellectual Property has been assigned to ETSURF, 15% shall go to ETSURF rather than to the research support fund. This distribution system shall also apply to license signing fees, license benchmark and diligence payments, and to payments from the outright sale of the patent or copyright.

The portion of the Net Income from royalties and any other Intellectual Property-related income retained in the Vice Provost for Research and Sponsored Programs research support fund or by ETSURF shall be kept in a restricted account and used for support the enhancement of research and instructional programs at East Tennessee State University and of the research support activities of ETSURF.

Source: SBR Meeting, September 24, 1982; TBR Meeting, September 21, 1990, TBR Meeting, June 21, 2001.