

POLICIES

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Responsible Official: Vice President for Research

Responsible Office: Vice President for Research

Policy Statement

Policy Statement

This policy covers the ownership, distribution and commercial development of the intellectual property of all faculty, staff, student employees, students and postdoctoral fellows, as well as non-employees who participate or intend to participate in teaching and/or research or scholarship projects at The University of Memphis.

Purpose

- To support the research and creative activity of members of The University of Memphis community;
- to preserve traditional University practices and privileges with respect to the publication of scholarly works;
- to contribute to society's well-being and economic development locally, nationally and globally;
- to establish principles and procedures for ownership as well as the sharing of income derived from copyrightable materials, patentable inventions, and other intellectual property produced at the University; and
- to protect and exploit the University's assets and reputation.

Definitions

Author/Creator

The person or persons responsible for creation of a copyrightable work.

Copyright	An original work of authorship which has been 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.
Gross Income	The proceeds from the sale, lease or licensing of intellectual property, dividends derived from equity received in consideration for the sale, lease, or licensing of intellectual property, proceeds from the sale of equity received in consideration for the sale, lease, or licensing of intellectual property.
Intellectual Property	Any invention, patent or works.
Invention	Any discovery, new use of application, process, composition of matter, article of manufacture, know-how, design, model, technological development, or biological material.
Inventor	The person or persons responsible for the conception of an idea or ideas leading to an invention.
Net Revenue	The gross income minus the direct costs associated with the patent prosecution, copyright registration, commercialization, defense, maintenance, and administration of intellectual property.
Institutional Works	Works that are supported by a specific allocation of University funds, that are created at the direction of the University for a specific University purpose, that are created with University resources or that are developed in the course of a project arranged through the University.
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.
The University of Memphis Research Foundation (UMRF)	A nonprofit corporation established to provide support for activities related to the research mission of The University of Memphis including the management of intellectual property.
Work	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.

Procedures

TYPES OF INTELLECTUAL PROPERTY

Copyrightable Materials

Copyright is the ownership and control of the intellectual property in original works of authorship that are subject to copyright law. It is the policy of the University that all rights in copyright shall remain with the creator unless the work is a work-for-hire (and copyright vests in the University under copyright law), is supported by a direct allocation of funds through the University for the pursuit of a specific project, is commissioned by the University, was made or created with significant use of University resources, including personnel, or is otherwise subject to contractual obligations.

A. BOOKS, ARTICLES, AND SIMILAR WORKS

Except as otherwise stated in this policy, The University of Memphis does not claim ownership to pedagogical, scholarly, or artistic works, regardless of their form of expression. Such works include those of students created in the course of their education, such as dissertations, papers and articles. The University claims no ownership of popular nonfiction, novels, textbooks, poems, musical compositions, or other works of artistic imagination that are not “Institutional Works” as defined herein and were not made or created with the services of University staff employees working within the scope of their employment.

B. RECONVEYANCE OF COPYRIGHT TO CREATOR

When copyright is assigned to the University because of the provisions of this policy, the creator of the copyrighted material may make a request to the Vice President for Research that

ownership be reconveyed back to the creator. Such a request may, at the discretion of the Vice President, be granted if it does not: (i) violate any legal obligations of or to the University, (ii) limit appropriate University uses of the copyrighted material, (iii) create a real or potential conflict of interest for the creator, or (iv) otherwise conflict with University policies or its mission.

C. WORKS OF NON-EMPLOYEES

Under the Copyright Act, works of non-employees such as consultants, independent contractors, etc. generally are owned by the creator and not by the University, unless there is a written agreement to the contrary. As it is the University's policy that the University shall retain ownership of such works (created as institutional rather than personal efforts), the University will require a written agreement from non-employees that ownership of such works will be assigned to the University.

Examples of works which the University may retain non-employees to prepare include:

- Reports by consultants or subcontractors
- Computer software
- Architectural or engineering drawings
- Illustrations or designs
- Artistic works

D. VIDEOTAPING AND RELATED CLASSROOM TECHNOLOGY

Any course that is videotaped or recorded using any media is University property, and may not be further distributed without permission from the Vice President for Research; however, blanket permission is provided for use by students only as part of their academic program at the University, or for other University purposes. Prior to videotaping, permission must be obtained from anyone who will appear in the final program.

E. USE OF THE UNIVERSITY'S NAME IN COPYRIGHT NOTICES

The following notice should be placed on University-owned materials in order to protect the copyright:

Copyright © [year] The University of Memphis. All Rights Reserved.

No other institutional or departmental name is to be used in the copyright notice, although the name and address of the department to which readers can direct inquiries may be listed below the copyright notice. The date in the notice should be the year in which the work is first published, i.e. distributed to the public or any sizable audience. Additionally, works should be registered with the United States Copyright Office using its official forms. (<http://www.copyright.gov/>) Forms may be obtained from and questions concerning copyright notices and registration may be addressed to the Office of Technology Transfer (OTT) or the Office of Legal Counsel.

Institutional Works

The University shall retain ownership of works and inventions created as institutional works. Institutional works include works that are supported by a specific allocation of University funds, that are created at the direction of the University for a specific University purpose or that are 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 written agreement to the contrary. Institutional works also include works whose origin cannot be attributed to one or a discrete number of authors or inventors but rather result from simultaneous or sequential contributions over time by multiple faculty and students. For example, software tools developed and improved over time by multiple faculty and students where authorship/inventorship is not appropriately attributed to a single or defined group of people would constitute an institutional work. The mere fact that multiple individuals have contributed to the creation of a work shall not cause the work to constitute an institutional work.

Trade and Service Marks

Trade and service marks are distinctive words or graphic symbols identifying the sources, product, producer, or distributor of goods or services. Trade or service marks relating to goods or services distributed by the University shall be owned by the University. Examples include names and symbols used in conjunction with computer programs or University activities and events.

Proprietary Information

Proprietary information arising out of University work (e.g., actual and proposed terms of research agreements, financial arrangements, or confidential business information) shall be owned by the University. "Trade secret" is a legal term referring to any information, whether or not copyrightable or patentable, which is not generally known or accessible, and which gives competitive advantage to its owner. Trade secrets are proprietary information, and all University employees shall take all necessary steps to protect trade secrets from disclosure.

NOTE: All research involving proprietary information owned by others is subject to the provisions of the sponsored research agreement or other agreement between the owner of the proprietary information and the University. Contact the office of the Vice President for Research for further information.

Tangible Research Property

Tangible Research Property (TRP) is defined for purposes of this Policy as tangible (or corporeal) items produced in the course of research projects supported by the University or by external sponsors. 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 inventions, patents, copyright and trademarks. Individual items of TRP may be associated with one or more intangible properties such as copyright or patents.

TRP normally is either owned by the University or is subject to the ownership and other provisions of contracts and grants. For example, items such as microorganisms produced under a government grant or contract usually belong to the University as expendable property, subject to the terms and conditions of the grant or contract. Equipment that is fabricated at the University for subsequent off-campus use by a research sponsor is usually owned exclusively by the sponsor.

Use of University Resources

University resources are to be used solely for University purposes and not for personal gain or personal commercial advantage, nor for any other non-University purposes except on a *limited and incidental* basis. Therefore, if the creator or author of a copyrightable work, or inventor, makes significant use of

University resources or of staff University employees in creating the work, the creator or inventor must disclose the work to the OVPR and assign title to the University.

"Significant use of University resources" includes, but is not limited to:

- the use of specialized, research-related facilities, equipment or supplies, provided by the University for academic purposes
- more than incidental use of University staff personnel, including, but not limited to Graduate Assistants
- more than incidental use of researcher's own "on-the-job" time

The occasional and infrequent use of the following would typically not constitute "significant use" of University resources:

- routinely available, office-type equipment, including desktop computers and commercially-available software used during non-business hours.
- reference materials or other resources collected on the University campus, and which are generally available in non-University locations.

Intellectual property developed outside an employee's scope of employment, without a significant use of University resources shall be the sole and exclusive property of the inventor or author. Even if the inventor retains ownership, in consideration of University and UMRF support in evaluating the intellectual property, seeking patent protection and/or pursuing commercialization efforts, the University and the inventor or author may agree to assign all or a portion of the ownership rights to his or her own work to the University or UMRF.

All students own the intellectual property they develop as a result of their own for-credit class work including but not limited to theses and dissertations. When a student is undertaking a project involving significant University resources, intellectual property, research team collaboration or work for an outside body, the University may insist upon ownership of any intellectual property produced by the student. In such instances the student will be required to sign a student intellectual property agreement.

Contract Obligations

This policy shall not be interpreted to limit the University's ability to meet its obligations for deliverables under any contract, grant, or other arrangement with third parties, including sponsored research agreements, license agreements and the like. Inventions, patents and copyrightable works that are subject to sponsored research agreements or other contractual obligations of the University shall be owned by the University, unless otherwise provided in the contract.

Responsibility to Disclose Inventions and Creation of Copyrightable Works

An invention disclosure is a document that provides information about the inventor(s) or creator(s)/author(s), the invention or creation, the circumstances leading to the invention or creation, and the anticipated subsequent activities. Invention disclosures provide the basis for a determination of patentability and much of the technical information necessary for drafting a patent application. An invention disclosure is also used to report technology that may not be patented but can be protected by other means such as copyrights.

Inventors and creators/authors must prepare and submit on a timely basis a disclosure form for each invention or copyrightable work that could be reasonably expected to have commercial value. Inventors are also expected to file in a timely manner, a disclosure form for each potentially patentable invention conceived or first actually reduced to practice in whole or in part in the course of their University responsibilities or with more than incidental use of University resources. Inventors should particularly note that certain acts (for example, publication of the invention in an academic journal or presentation of invention at a conference) can constitute a statutory bar to patent protection. **An inventor contemplating public disclosure must first file an invention disclosure and should contact the OTT prior to engaging in such activities.** Research disclosure forms for both inventions and copyrightable works are available from the OVPR and OTT websites. Questions about filing research disclosure forms should be directed to the OTT.

Application of Intellectual Property Policies

All new faculty must sign a Notice of Appointment and Agreement of Employment for Faculty, in which they acknowledge and agree to abide by the University's Intellectual Property policy. In addition, existing faculty, staff, student employees, graduate students and postdoctoral fellows also must

abide by the University's Intellectual Property policy. Non-employees who participate or intend to participate in research projects at the University are also governed by this policy.

Administration of Policy

The VPR is responsible for administration of this policy and for reviewing terms and conditions of the University's grants and contracts for compliance with University policies on intellectual property rights and openness in research. The OTT is responsible for the administration of the University's invention reporting and licensing program, the commercial evaluation of inventions, patent filing decisions, petitions to agencies for greater rights in inventions, and negotiation of licensing agreements with industry.

The VPR and the University's Office of Legal Counsel are available to advise on questions arising from this policy, and to assist with the negotiation and interpretation of the provisions of proposed formal agreements with third parties.

A. SPONSORED RESEARCH AGREEMENTS

Contracts and grants frequently contain complex provisions relating to intellectual property rights, including copyright, rights in data, royalties, publication and various categories of material including proprietary data, computer software, licenses, etc. Questions regarding the specific terms and conditions of individual contracts and grants, or regarding rules, regulations and statutes applicable to the various government agencies, should be addressed to the VPR.

B. DETERMINATIONS OF OWNERSHIP AND POLICY IN UNCLEAR CASES

Questions of ownership or other matters pertaining to materials covered by this policy shall be resolved by the Vice President for Research (or his or her designee) in consultation with the President, the Provost and the Office of Legal Counsel.

C. ASSIGNMENTS

No assignment, license or other agreement may be entered into or will be considered valid with respect to patents, inventions or copyrighted works owned by the University unless entered into by a University official specifically authorized to do so. In addition, the University may at the direction of the Vice President for Research assign its rights to intellectual property to

the University of Memphis Research Foundation (UMRF). UMRF 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.

Questions regarding assignment of intellectual property rights should be addressed to the VPR.

D. WAIVER OF POLICY PROVISIONS

Waivers of the provisions of this policy may be granted by the President, or the President's designee, on a case-by-case basis, giving consideration to, among other things, whether the waiver would be in the best interest of the University, the University's obligations to any sponsors, and/or whether the waiver would result in a conflict of interest.

E. COOPERATION OF FACULTY AND STAFF

Faculty and staff must cooperate with the University, including but not limited to the Office of Legal Counsel, the VPR, the UMRF, OTT and any outside University counsel or other University representatives, in the administration of this policy, including any activities related to the preparation, filing, prosecution or maintenance of any patent application.

F. INTELLECTUAL PROPERTY ADVISORY COMMITTEE

The Vice President for Research shall appoint a standing committee on intellectual property. The committee will consist of at least five people who have some experience in intellectual property matters. The members can be drawn from the faculty, staff or community. All members of the committee shall execute confidentiality agreements to insure that all information concerning the intellectual property is kept confidential. The committee shall review invention disclosures to determine whether patent protection should be sought and whether to seek commercialization opportunities. The committee shall provide the VPR with its findings.

H. APPEALS

In the event the VPR decides not to pursue patent protection or commercialization efforts, the Inventor or Author may appeal

the decision and request a re-evaluation of the subject intellectual property by the President. The request must be received within thirty calendar days of notification to the inventor or author of the initial decision. The inventor or author must submit documents or other evidence in support of his or her position.

Inventions and Patents

The University of Memphis desires to promote the transfer of the University's intellectual property for society's use and benefit while generating income to support research and education and to reward the University's researchers.

All potentially patentable inventions conceived or first reduced to practice in whole or in part by members of the faculty or staff (including student employees) of the University in the course of their University responsibilities or with significant use of University resources must be disclosed on a timely basis to the University. Title to such inventions shall be assigned to the University, regardless of the source of funding, if any.

A. APPLICATION

The provisions of this section apply to:

- all University faculty and staff, including student workers
- all graduate students and postdoctoral fellows
- non-employees, including students, who participate or intend to participate in research projects at The University of Memphis (including visiting faculty, industrial personnel, fellows, etc.)
- non-employees, including students, who create or discover potentially patentable inventions through or with significant use of University resources

In the case of non-employees, all potentially patentable inventions conceived or first reduced to practice in whole or in part in the course of their participation in research projects at The University of Memphis, or with significant use of University resources, shall be disclosed on a timely basis to the University, and title shall be assigned to the University, unless a waiver has been approved.

B. RELEASE OF INVENTION

If the University decides not to proceed in a timely manner to patent and/or license an invention, upon request of the inventor(s), it may reassign ownership to the inventor(s) to the extent possible under the terms of any agreements that supported or otherwise related to the work.

C. ALTERNATIVE DISPOSITION OF RIGHTS

In the case of an invention resulting from a government-sponsored project, where the OVPR cannot or chooses not to retain ownership, rights would then typically be retained by the government. In such cases, the inventor may request and be granted rights by the sponsoring agency to an invention made under such an award, provided that a well-conceived and detailed plan for commercial development accompanies the request.

Licensing and Income Sharing

A. LICENSING

The VPR seeks the most effective means of technology transfer for public use and benefit and, toward that end, the OTT handles the evaluation, marketing, negotiations and licensing of University-owned inventions or copyrightable materials with commercial potential.

Computer databases, software and firmware, and other copyrightable works owned by the University, are licensed through the OTT. Exceptions to this procedure must be approved in advance by the Vice President for Research.

The University encourages the development by industry of products resulting from University research for public use and benefit. The University recognizes that protection of proprietary rights in the form of a patent or copyright are often necessary - particularly with inventions derived from basic research - to encourage a company to risk the investment of its personnel and financial resources to commercialize the product. In some cases, nonexclusive licenses allow several companies to exploit an invention. An exclusive license may be necessary to provide an incentive for a company to undertake commercial development and production.

B. INCOME SHARING

The OTT handles the evaluation, marketing, negotiations and licensing of University-owned inventions with commercial potential. Royalty distribution is as follows:

Patents: A deduction for any directly assignable expense, typically patent filing fees and/or attorney's fees is initially taken from the gross income. After the deductions for all expenses, fifteen percent of gross income is returned to the OTT for indirect costs and support of research. After these deductions, the remaining revenue (known as "net income") shall be distributed as follows:

Inventor(s)	UMRF	Fed Ex Institute	College	Department
40%	30%	10%	10%	10%

When Research Centers, Institutes or Bureaus designated by the Vice President for Research to receive Facilities and Administration revenue are involved in the creation of the intellectual property, the Center, Institute or Bureau shall receive 5% of net revenues which share shall be taken equally from the college and department shares. When more than one department is involved, the inventor(s) shall designate the distribution of the department and college percentages based upon the relative level of a particular department's support of the work leading to the invention. Disagreements involving royalty distribution will be reviewed and resolved by the VPR; involved parties may appeal the VPR resolution to the Provost.

Copyrighted Works: Royalty income from copyrighted works will normally be allocated in accordance with this section. If copyright protection alone is claimed, royalties will be allocated in a similar manner, with the "inventor's share" allocated among individuals identified by the investigator (or department head, or the Vice President for Research if the individuals are from different departments and/or if the work was not created under a sponsored agreement), based on their relative contributions to the work. Where royalty distribution to individuals would be impracticable or inequitable (for example, when the copyrightable material has been developed as a laboratory project, or where individual royalty distribution could

distort academic priorities), the "inventor's share" may be allocated to a research or educational account in the laboratory where the copyrightable material was developed. Such determination will be made on a case-by-case basis by the Vice President for Research after consultation with the principal investigator or department head, and is subject to the approval of the President.

Equity in lieu or in addition to Cash Payment

UMRF may elect to accept equity in lieu of cash payments for a license fee or royalty. The decision to accept equity in lieu of cash is made at the sole discretion of the UMRF and does not constitute an obligation on behalf of the UMRF to make a disbursement of equity to the creator(s) or to department(s) and college(s) until the equity is sold. UMRF will own and exercise all rights of ownership, including the rights to vote equity interests on all matters which are subject to the consent or approval of the holders of similar equity interests (including voting such equity interests for the election of the directors, approving or disapproving amendments to articles of incorporation, etc.). UMRF will retain and own the equity interest until the sale or exchange of the interest. The decision as to when to sell or exchange equity resides with the UMRF Board of Directors in its sole discretion. **Upon the sale or exchange of the equity, the inventors, as a group, receive the same fraction of revenue derived from equity as they would for the Royalty distribution mentioned above. These guidelines and policies also apply to all University spinout companies.**

Revision Dates

UM1607 -- revised November 18, 2016
UM1607 -- revised May 25, 2009
UM1607 -- revised October 14, 2005
UM1607 -- issued June 22, 2004 - supercedes policy number 1:2B:01:11
RE7004 supersedes UM1607

Subject Areas:

Academic	Finance	General	Human Resources	Information Technology	Research	Student Affairs
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