

Utah Tech University Policy

160: Intellectual Property



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I. Purpose

- 1.1 Utah Teche University (hereinafter referred to as “University”) is committed to providing an atmosphere that is conducive to excellence in teaching, scholarship and research, including undergraduate research and creative activity. Faculty, staff and students are encouraged to engage in scholarly pursuits. Though not a primary University goal, the results of such pursuits sometimes lead to the development of Intellectual Property that may be copyrighted, patented, or otherwise have commercial value. The University has interest in protecting this Intellectual Property for several reasons. Through promoting the disclosure, dissemination, and utilization of Intellectual Property, the University and members of its community support the public good.
- 1.2 In addition, the creation and development of Intellectual Property provides professional benefits to the individuals involved, contributes to the intellectual life of the University, and may provide monetary benefits to the Inventors and to the University. With this in mind, the University seeks to provide an environment in which creative efforts and innovations are encouraged and rewarded.

II. Scope

- 2.1 With the adoption of Policy 160, the University articulates the principles and processes to guide decision-making related to the ownership of Intellectual Property. Policy 160 covers all forms of Intellectual Property created at or under the auspices of the University, including but not limited to those covered by copyrights and patents. The purpose of Policy 160 is to clarify for members of the University community their collective

rights and responsibilities regarding Intellectual Property.

- 2.2 Policy 160 also describes the ways in which the University's faculty, staff and students can protect the Intellectual Property that they create, both for their benefit as well as to preserve the interests of the University.
- 2.3 Policy 160 complies with the Employment Inventions Act (Utah State Code § 34-39) and the Bayh-Dole Act (35 U.S.C. § 200-212) and affords University faculty, staff, and students benefits above and beyond those required by law. These benefits are designed to encourage an environment that fosters discovery, creation, disclosure, entrepreneurship, and innovation of Intellectual Property to benefit Utah and its citizens.
- 2.4 Policy 160 is established with the understanding that it may be augmented by statements of policy or practice focused on particular types of Intellectual Property, especially those arising out of new or evolving media or technology. Further, Policy 160 itself may be amended over time to effect changes deemed to be in the best interest of the University community.
- 2.5 Absent a signed agreement to the contrary, Policy 160 is deemed to be a part of the conditions of employment of every employee of the University, including student employees, and of the conditions of enrollment and attendance by every student at the University.
- 2.6 Applicability: Policy 160 applies to all University employees, including faculty, administration, and staff, and to all University students. When a patentable discovery or Invention is made or conceived by the student other than in the course of employment by the University and without the Use of University Resources, the Invention will be wholly-owned by the student.
- 2.7 Title: The University acquires and retains title to all University IP, unless otherwise specified herein.

2.7.1 Title Exceptions

- 2.7.1.1 Sponsored Research or Other Third-Party Agreements: title to Intellectual Property created as a result of work performed under a sponsored research agreement or other third-party Agreement shall be subject to the sponsored research or third-party agreement.

2.7.1.2 Consulting Agreements: The University makes no claim to Intellectual Property created as a result of work performed by a University employee under a consulting agreement, provided that no University IP is used in the work performed under the consulting agreement.

III. Definitions

- 3.1 **Intellectual Property**: Creations of the mind or intellect, the ownership of which is recognized and protected by law now or in the future. Intellectual Property includes copyrightable subject matter, any patentable invention, tangible research property, trademarks, trade secrets, works of art and inventions or creations that might normally be developed on a proprietary basis.
- 3.2 **University Intellectual Property** (University IP): Any inventions, patents, copyrights, trademarks, service marks, tangible research property, trade secrets, and know-how that is:
- 3.2.1 Created by University employees within the scope of their employment and/or with the use of University facilities, equipment, materials, or financial support; or
- 3.2.2 Created by non-University employees, such as students who use University facilities, equipment, materials, or financial support.
- 3.3 **Biological Materials**: Includes, but is not limited to, organisms, transgenic animals, plants and plant varieties, cells, cell lines, plasmids, vectors, viruses, cell products, cloned DNA and RNA, protein fragments, nucleic acid sequences, and protein sequences.
- 3.4 **Copyright**: An original work of authorship fixed in any tangible medium of expression, now known or later developed, from which it can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. A work of authorship includes the following categories: literary works; musical works, including any accompanying words; dramatic works, including any accompanying music; pantomimes and choreographic works; pictorial, graphic, and sculpture works, motion pictures and other audiovisual works; sound recordings; and architectural works. *See* 17 U.S.C. §102.

The requirement the law places on the Copyright ability of any of the above works is that the work must be in a form that can be perceived directly or by means of a machine or other device. Both published and unpublished works are under statutory protection.

3.4.1 Scope of Works Protected by Copyright

3.4.1.1 Literary works;

3.4.1.2 Musical works including accompanying words;

3.4.1.3 Dramatic works including accompanying music;

3.4.1.4 Pantomimes and choreographic works;

3.4.1.5 Pictorial, graphic, and sculptural works;

3.4.1.6 Motion pictures and audiovisual works;

3.4.1.7 Sound recordings; and

3.4.1.8 Computer programs and documentation.

3.5 **Commercialization:** The activities involved in taking University IP from its conceptual, emerging, prototype, or early developmental state to a point where commercial financial gains can be realized. It also encompasses the activities involved in developing collaborations, partnerships, contracts, and similar agreements with commercial companies to achieve mutually beneficial commercial outcomes. These activities may include, but are not limited to, technology maturation, development of product prototypes, joint proposals to other funding entities, and performing technology demonstrations.

3.6 **Invention:** Any new or useful discovery, process, machine, manufacture, or composition of matter, or any new and useful improvement thereof. Inventions are novel, useful, and not obvious to individuals skilled in the field in which they are developed. The Bayh-Dole Act further defines a **subject invention** as "any Invention of the contractor that is conceived or first actually reduced to practice in the performance of work under a funding agreement. "See 35 U.S.C. §101.

3.7 **Inventor:** An individual who contributes to the conception of the Invention. In this context, conception is the formation in the mind of the

Inventor, of a definite and permanent idea of the complete and operative Invention, as it is to be applied in practice. Individuals—including students—who help to test or perform work with the conception of another are not Inventors. However, anyone—including a student—who contributes to the conception of the Invention must be recognized as a co-Inventor.

- 3.8 **Revenues:** Any (i) royalties, (ii) fees (*e.g.* license fees, maintenance fees, and exit fees), and/or (iii) Revenues derived as a result of equity (*e.g.* dividends and the sale of shares) that are actually received by the University as a result of the Commercialization of a particular work of University IP less any Cumulative Expenses associated with the particular work.
- 3.9 **Cumulative Expenses:** Any expenses incurred by the University for the protection and/or Commercialization of a particular work of University IP. Cumulative Expenses includes, for example, expenses associated with the preparation and prosecution of a patent application and the maintenance of an issued patent.
- 3.10 **Sponsored Project:** An externally funded activity governed by a written agreement between the University and the sponsor. Sponsored Project agreements typically involve grants, contracts, cooperative agreements or letters of agreement.
- 3.11 **Use of University Resources:** A contribution of University resources beyond what is ordinarily available and specifically provided to Members of the University Community in a given area to carry out their duties.

Unless otherwise provided in writing, none of the following would constitute the Use of University Resources for faculty members: normal use of offices, office computers, libraries, secretarial services, photocopying, software that is readily available to all faculty and other types of resources, property and personnel that are readily and regularly available to faculty in a specific program, department or school.

- 3.12 **Scholarly Works:** Journal articles; theses; dissertations; textbooks for higher education; classroom instructional materials for higher education, *e.g.* tests, course or lecture notes, handouts, slides, or worksheets; and works that are purely artistic or musical in nature. Scholarly Works exclude any University IP described in the Scholarly Work itself, such as Inventions, patents, Tangible Research Property, Trademarks, service marks, Trade

Secrets, and know-how.

- 3.13 **Tangible Research Property:** Tangible items produced in the course of research, such as compositions, chemical compounds, Biological Materials, materials, drawings, devices, integrated circuit chips, computer databases, computer software, prototypes, circuit designs, and equipment.
- 3.14 **Trademark:** A word, phrase, symbol, or design, or a combination thereof that identifies and distinguishes the source of the goods or services of one party from those of others.
- 3.15 **Trade Secret:** Information, including a formula, pattern, compilation, program, device, method, technique, or process, that: (i) derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use; and (ii) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy. See Utah State Code §13-24-2.
- 3.16 **Work for Hire Agreement:** A work prepared by an employee within the scope of his or her employment; or a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work. See Copyright Code for further clarifications: <http://www.copyright.gov/title17/92chap1.html#101>

IV. Policy

4.1 Copyright Ownership

- 4.1.1 The University encourages the preparation and publication of Copyrightable works that result from teaching, research, scholarly and artistic endeavors by members of the faculty, staff and student body by upholding ownership rights of authors in their writings and scholarship that result from usual teaching, research or artistic activities. Normally, the Copyright of these works is held by the author.

However, because of advancing technology, new forms of educational materials are being developed which require a substantially greater level of direct support from the University than does the writing of a "traditional" textbook and the like. The use or

purchase of equipment and production facilities, computers, and the expertise of a variety of individuals with special training may be required to augment the talents of an author. When the investment of time and money by the author and the University differs substantially from that involved in the creation of customary educational material, as defined by departmental norms, such material shall be designated as University-sponsored and the University may claim Copyright.

4.1.1.1 Examples of “use of University resources” that will result in University ownership:

- 4.1.1.1.1 Sponsored support from outside entities will be considered Use of University Resources (because of the infrastructure required to secure sponsored program support);
- 4.1.1.1.2 Internal University grants when the grant is made as a Work for Hire Agreement;
- 4.1.1.1.3 Dedicated computing resources not generally open to the University premise or a college or department as a whole, such as computing time on super-computers;
- 4.1.1.1.4 Purchase of specialized equipment assigned to the employee;
- 4.1.1.1.5 Assignment of employees to assist the development of software in a manner not typically provided to other employees of the unit.

4.1.2 Ownership of Material Subject to Copyright Protection

4.1.2.1 The policies articulated in this section apply to all forms of Copyrightable material, with the exception of courseware which is covered in a separate section.

4.1.2.2 Works Created by Faculty

4.1.2.2.1 Subject to the exceptions noted below and in keeping with longstanding academic tradition, ownership of pedagogical, scholarly, artistic and creative works resides with the faculty creator. This includes such

things as scholarly articles and books, novels, plays, musical creations, works of art, films and textbooks. The only exceptions to faculty ownership of such works are as follows:

- 4.1.2.2.2 Sponsored Project: When Copyrightable material is created by a faculty member using funding from a Sponsored Project, the terms of that Sponsored Project will supersede Policy 160 with regard to ownership. Ideally, the terms of any such Sponsored Project should be specified clearly and prior to the work being undertaken or produced.
- 4.1.2.2.3 Works commissioned at the request of the University: When a faculty member is commissioned by the University to perform a specific task with a defined outcome that includes Copyrightable material, said work shall be considered a *Work-for-Hire* and shall be wholly-owned by the University. Unless a particular Copyrightable work is specifically commissioned by the University, ownership remains with the faculty creator even though the faculty member may have been supported by sabbatical or other internal grant that is not specifically designated as a *Work For Hire Agreement* during the time the work was undertaken.
- 4.1.2.2.4 University use of material: The University may display, copy and distribute works of faculty-developed material, including Copyrightable material, for University use without payment of royalties or other fees to the faculty member. Should a faculty member separate from the University, the University shall retain these rights without payment of royalties or other fees to the faculty member.

4.2 Ownership of Courseware

- 4.2.1 The policies articulated in this section apply to all forms of courseware.

4.2.2 Courseware Created by Faculty

4.2.2.1 Subject to the exceptions noted below, ownership of courseware resides with the faculty creator. The only exceptions to faculty ownership of courseware are as follows:

4.2.2.1.1 Sponsored Project: When courseware is created by a faculty member using funding from a Sponsored Project, the terms of that Sponsored Project will supersede Policy 160 with regard to ownership. Ideally, the terms of any such Sponsored Project should be specified clearly and prior to the work being undertaken or produced.

4.2.2.1.2 Courseware commissioned at the request of the University: When a faculty member is commissioned by the University to create specific courseware for use by the University, said work shall be considered a Work-for-Hire and shall be wholly-owned by the University.

4.2.2.1.3 Use of University Resources: When courseware is developed with the Use of University Resources, ownership of said courseware is negotiable, as long as said courseware was not commissioned by the University or created using funding from a Sponsored Project. Whether a particular instance of courseware has been developed with the Use of University Resources is determined by the Office of General Counsel in consultation with the Intellectual Property Advisory Committee. Once it has been determined that there has been an Exceptional Contribution of University resources, ownership is determined by the Office of General Counsel after consultation with the Intellectual Property Advisory committee. For purposes of Policy 160, sabbaticals and internal grants would not, in and of themselves, be considered Use of University Resources unless there is written agreement to the contrary between the faculty member and the University.

4.2.2.1.4 University use of courseware: Faculty who develop courseware will not be entitled to charge the University a fee for using their author-owned courseware in their teaching at the University. If the author leaves the University, the University shall have the right, without cost or payment to the author, to use, reproduce, adapt, modify, update, exhibit and display all courseware created during the period of employment for a period of three years after conclusion of the author's employment at the University. The University's right to the use of author-owned courseware does not prevent the author from using said courseware elsewhere or from otherwise exercising the rights associated with ownership.

4.3 Inventions & Patents

4.3.1 The University is the owner of all patentable discoveries or Inventions made or conceived by faculty members and other University employees (including student employees) in the course of their responsibilities to the University or with the Use of University Resources. Provisions of Policy 160 include the following:

4.3.1.1 Duty of Disclosure. All University IP shall be disclosed to the Office of General Counsel by the Creator(s) promptly after the discovery or creation thereof and prior to any public disclosure (publication, presentation, poster, etc.). If a public disclosure has occurred, then the Creator(s) shall disclose the University IP as soon as possible to avoid further loss of rights, such as patent rights. The disclosure shall be in writing, and shall include sufficient detail to evaluate the commercial potential of the disclosed work and to seek legal protection, when deemed appropriate. See *Invention Disclosure Form* in Appendix A.

4.3.1.1.1 Whether a particular Invention has been developed with the Use of University Resources is determined by the Intellectual Property Advisory Committee after consultation with the Office of General Counsel.

- 4.3.1.1.2 When a potentially patentable Invention has been developed using funding from a Sponsored Project, the terms of that Sponsored Project will supersede Policy 160 with regard to ownership. Ideally, the terms of any such Sponsored Project should be specified clearly and prior to the work being undertaken or produced.
- 4.3.1.1.3 The University shall share royalties from Inventions owned by or assigned to the University with the Inventor according to the schedule that appears later in Policy 160
- 4.3.1.1.4 If the University elects not to pursue the patenting and Commercialization of a disclosed Invention, and elects not to pursue other means of attaining University benefit and encouraging public use and benefit of a disclosed Invention, it may assign ownership to the Inventor(s).
- 4.3.1.1.5 In cases where the University elects to pursue the patenting and Commercialization of a disclosed Invention, or elects other means of attaining University benefit and encouraging public use and benefit of a disclosed Invention, the Inventor(s) may nonetheless petition the Office of General Counsel to assign ownership to the Inventor(s). The grant or denial of such a petition is at the discretion of the Office of General Counsel who will consult with the Intellectual Property Advisory Committee. The standard to be applied is whether assignment from the University to the Inventor(s) is in the best interest of the University. An appropriate case for such an assignment may be one where the University has been unsuccessful for a substantial period of time in its attempts to patent, license, commercialize, or otherwise encourage significant public use of the Invention.
- 4.3.1.1.6 Waivers of the provisions of Policy 160 may be granted by the Office of General Counsel after consultation with the Intellectual Property Advisory Committee. Only written waivers signed by the Office of General Counsel

shall be valid and enforceable waivers of Policy 160.

4.3.1.2 Publication and Patent Rights

4.3.1.2.1 Because patents exclude others from using inventive methods or materials for a defined period of time, they provide opportunities for Inventions to be commercialized. Commercialization provides opportunities for the general public to benefit from the Invention and remuneration to accrue to the Inventors and other interested parties. Because of the potential value inherent in a patent, establishing ownership is a legally defined process that requires Inventors to adhere to specific steps.

4.3.1.3 To protect an Invention's potential value as it is being developed, Inventors are advised to:

4.3.1.3.1 Establish the date of Invention through maintaining bound notebooks recording the development of the Invention on signed and dated numbered pages that are witnessed. Signed and dated entries also should be maintained if further efforts are made to reduce the Invention to practice.

4.3.1.3.2 Members of the University community are encouraged to publish research results and scholarly information in a timely manner. At the same time, Inventors should be aware that publication of an idea embodied in an Invention or any other non-confidential disclosure, such as abstracts, websites and posters, bars the filing of a patent application in many countries. In the United States, the Inventor has one year to file from the date of publication. For these reasons, publication has important implications, particularly if the Inventor and the University desire to commercialize the Invention.

For these reasons, Inventors are encouraged to disclose their Inventions prior to publication to help ensure that patentability is not compromised. (Inventors should

note that describing an Invention in a federal grant application constitutes publication and compromises patentability if the grant is awarded because funded applications are publicly available through the Freedom of Information Act. With this in mind, when submitting a grant application Inventors should identify any section of an application that contains confidential and/or proprietary information in order to protect an Invention.)

Inventors should exercise care in discussing an Invention with other individuals so as not to compromise the ability to patent or otherwise protect ownership of the Invention. It is particularly important to obtain non-disclosure agreements before discussing an Invention with potential commercial partners. Inventors should retain all non-disclosure agreements in a secure place and provide copies to the University upon request.

V. References

- 5.1 Employment Inventions Act (Utah State Code § 34- Chapter 39)
- 5.2 Utah Public Officers' and Employees' Ethics Act (Utah Code Ann. § 67-16-1 et seq. prohibits University employees from soliciting or accepting a gift that is intended to, or could, improperly influence a public employee in the performance of his/her public duties. Occasional non-monetary gifts with a value of not more than \$50 are generally excluded from the Act. Employees who violate the Act are subject to termination and criminal penalties.
- 5.3 BAYH DOLE ACT OF 1980 (35 U.S. Code Section 200)
 - 5.3.1 The Bayh-Dole Act was passed in 1980. The purpose of Policy 160 is to encourage the utilization of Inventions produced under federal funding.

The Bayh-Dole Act resulted in a unified patent rights clause that is included in all federal funding agreements, and it permits non-profit organizations, including non-profit institutions, and small businesses to elect to retain title to Inventions made in the

performance of federally-funded research. The objectives of the Bayh-Dole Act include using the patent system to promote licensing and Commercialization of new Inventions and creating collaborations between nonprofit organizations and industry.

5.4 COPYRIGHT AND FAIR USE: <http://www.copyright.gov/fls/fl102.html>

5.5 University Policy 145: Copyright

VI. Procedures – N/A

VII. Addenda

7.1 Utah Tech University Invention Agreement

7.2 Award and Revenue Distribution

Policy Owner: General Counsel

Policy Steward: General Counsel & Office of Sponsored Programs

History:

Approved 10/25/16

Editorial 07/01/2022