

ARTICLE 19
INTELLECTUAL PROPERTY

Section 1. University research, copyright, and patent policy

- A. It is the policy of the University, with reference to all creative endeavors of its bargaining unit faculty, conducted on University time or with its facilities, to recognize the interests of the University, the bargaining unit member, sponsor, and other cooperating or participating agencies. However, the University reserves the right to recognize and administer such interests and equities of the participating parties consistent with the public interest as determined by its Board from time to time provided, however, that provisions herein with respect to individual bargaining unit member's rights shall not be altered.
1. In accordance with the custom established in institutions of higher learning, copyright ownership of textbooks and manuscripts and royalties resulting therefrom belong to the author(s) thereof except when the textbook or manuscript is prepared as an assigned project; in which case it is the property of the University and shall be assigned to the University by its author(s). Bargaining unit faculty shall use the following notice when displaying University-owned copyrighted material: "Copyright © (year), The University of Akron, Ohio. All rights reserved."
 2. The University encourages the publication of scholarly works including the results obtained through research and scientific investigation approved, sponsored or conducted as a University project, as well as graduate and undergraduate theses. The University may require that such publications be withheld for a limited period of time to permit the preparation and filing of patent applications or such other activities as may be necessary to protect intellectual property contained in such results, and to otherwise meet applicable government and sponsor contractual obligations.
 3. The following general conditions and restrictions will be observed for the best interests of all parties concerned:
 - a. Research will be the type of work that will enhance the reputation of the University as a seat of higher learning.
 - b. Research will be restricted to the type of work for which the University can provide adequate staff and facilities.
 - c. No extra compensation will be paid any bargaining unit faculty member for participating in sponsored and contract

research during the academic year; however, participation in research during the summer months will be paid for at the same salary rate received by a bargaining unit faculty member during the academic year.

- d. The University will not pay salary or wages for work done by a candidate for academic credit leading to a degree; however, students pursuing degree programs may receive University awards, assistantships, stipends, scholarships or fellowships.

4. Contract research

- a. The Director of Research Services and sponsored programs shall coordinate all contract research.
- b. Bargaining unit faculty who wish to pursue specific projects shall consult the director and the approach to the sponsor shall be made by the director or by the director's designee.
- c. All contracts shall be approved by the President or the Vice President for Research before any work thereunder is begun or any commitments are made.
- d. A bargaining unit faculty member shall have the right to accept or decline participation in any contract research made available.
- e. A plan for graduate assistantships should be put into effect to facilitate contract research whenever such research becomes available.

5. Patent rights and licensing procedure

- a. The Board seeks to stimulate innovative research and to encourage the development and utilization of the discoveries and inventions of research at the University in a manner consistent with the public interest. The Board believes it should make the results of its research available to industry and the public on a reasonable and effective basis.
- b. In compliance with the Ohio Revised Code §3345.14, the Board retains authority, for setting policy in the matter of rights to intellectual property including discoveries, inventions, patents and copyrights which result from research or investigation conducted in any laboratory or

research facility of the University, and no bargaining unit faculty member shall have any rights to or interests in such discoveries or inventions except as set forth herein.

- c. It is the policy of the Board that intellectual property rights belong to the University unless otherwise expressly approved by the Board and stipulated in a written agreement to which the Vice President for Research, or President is a signatory. In the instance of research developed with the support of funding from governmental agencies, the regulations of such funding agencies may take precedence to this policy and Article.
- d. The University will prosecute applications only for those patents that appear to be of potential economic benefit to the University. Within one (1) year following the submission of a written disclosure of invention, should the University elect not to pursue commercialization, the University will surrender its claim to ownership, in the absence of contractual commitments to the contrary, and will allow the inventor(s) to undertake prosecution for patent protection at their own expense. In the absence of any positive action either by the University or the inventor toward commercialization, the Board recognizes a value in such discoveries becoming public domain.
- e. The University is concerned with safeguarding the public interest as well as rewarding the initiative of researchers. In the spirit of public service, the University shall seek aggressively to bring those designs, processes, and products for which it holds patents or rights of ownership into highest public use. Such negotiations, on a "best efforts" basis, may involve granting of exclusive licenses.
- f. In the course of licensing agreements or sale of rights to manufacturers or others, fees and royalties may accrue. From the gross funds received with regard to any intellectual property held solely by the University, the University will be reimbursed its out-of-pocket costs incurred as of the date of receipt of such funds in obtaining, maintaining, enforcing and licensing the intellectual property. Thereafter, forty percent (40%) of the net remaining funds will be distributed to the inventors in recognition of and reward for initiative. An additional ten percent (10%) of net funds will be placed in an account to support the inventor's ongoing University research, five percent (5%) of net funds will be placed in an account to be used for college purposes by the dean(s) of

the college(s) in which the inventor(s) has(have) primary appointment, five percent (5%) of net funds will be placed in an account to be used for departmental purposes by the chair(s) of the department(s) in which the inventor(s) has(have) primary appointment and the balance of net funds will accrue to the University.

- g. Stipulations of P.L. 96-517 may take precedence over any other terms of agreement negotiated by the University in matters of patenting and technology transfer.
- h. Intellectual property resulting from federally sponsored research is disposed of in accordance with the terms of the applicable agency.
- i. Intellectual property resulting from research sponsored by industry or other non-governmental sources of support, other than the University itself, is disposed of in accordance with contract terms negotiated between the University and the sponsor, and approved by both parties. In such negotiations the University may agree to a non-exclusive royalty bearing license; a license of limited exclusivity which is royalty bearing; an exclusive, royalty bearing license for the life of the patent, a one-time payment for the entire technology; or any other mutually acceptable consideration. Acceptable contract terms will depend upon such factors as the initial amount of research support, financial expenditures for further development, costs of patent acquisition, duration of exclusivity, period likely needed for market development, or other pertinent factors.
- j. The amount of royalty shall be based upon arms length negotiation within percentage ranges common to the particular technology and the applicable industry. The potential market, potential profit, and the amount of investment needed for development, as well as other factors should be considered in establishing a royalty. The royalty should be based upon an easily audited item, such as "net sales."
- k. The University has an equity interest in any invention or discovery of its bargaining unit faculty resulting from research that involves a non-*de minimus* use of funds, space, or facilities administered by the University. The University seeks to stimulate innovative research and to encourage the development and utilization of the discoveries

and inventions of its research in a manner consistent with the public interest. The University believes it should make inventions resulting from its research available to industry or the public on a reasonable and effective basis. In this regard, the University actively seeks licensing of its patented technology on the best available terms, subject to the following conditions:

- (i) The University should not be expected to expend additional funds to improve the viability of the patent.
 - (ii) The stipulations of P.L. 96-517 relative to terms of exclusivity, etc., become effective if any federal funds have supported research leading to the invention.
 - (iii) The potential licensee should provide sufficient credentials of financial and marketing capability for University review.
 - (iv) Any agreement should include, as applicable, a royalty fee schedule, term and termination, considerations of "due diligence" provisions which establish levels of expectation and performance of the licensee, and provision for possible license renewal.
- l. The University should retain for itself and, whenever possible, for other public or private institutions, the free right to use non-confidential technology for research and education.
- m. All matters relating to discoveries, inventions, patents or technology transfer in which the University is in any way concerned are administered by the office of the Vice President for Research. Except with respect to agreements involving the waiver or transfer of ownership of intellectual property as provided by this Article, the President or the Vice President for Research shall have authority to execute any agreements, grants, or contracts involving discoveries, inventions, patent rights or technology transfer to the public or industry to the extent that such agreements conform to these regulations. Prior approval of the Board shall not be required with respect to the transfer of intellectual property resulting from research sponsored by governmental agencies that is disposed of in accord with the terms of the applicable agency. At each regular meeting of the Board, the Vice President for Research shall provide an executive

summary to the Board of those agreements negotiated and executed involving licensing of rights or transfer of technology.

- n. Any variance to this policy must receive prior approval of the Board before any commitments, grants, or contracts are made.

6. Use of the name of the University

- a. In soliciting consulting work outside the University, the bargaining unit faculty member may only mention that the bargaining unit faculty member is a member of the University faculty. The University's name shall not be used in advertising.
- b. The name of the University may be used in research reports, books and papers for publication and otherwise as may be set forth in the applicable research contract or as approved by the Board, the President or the Vice President for Research.

7. Waiver of rights in intellectual property

Upon written recommendation of the applicable chair/institute director and dean, and written approval of the Vice President for Research and the President, University center managers are authorized to execute experimental/technical service agreements, and the Associate Vice President for Research and Director and Associate Director of the Office of Research Services and Sponsored Programs are authorized to execute materials and information testing agreements, that waive University rights in intellectual property and related patents and copyrights under the following guidelines:

- a. It is reasonably demonstrated that:
 - (i) Well established and accepted technical procedures, e.g. "ASTM" methodology, are expected to be used in conducting client's project, or all work is expected to be directed by client company personnel with the only intellectual input expected of center personnel or University students to be at a level that would not support a patent; and
 - (ii) There has not been, nor is there expected to be any development of new materials, processing methods,

or reduction to practice of ideas and methodology resulting from significant intellectual input by University personnel in connection with the project.

- b. The principal bargaining unit faculty member has the respective dean verify and certify in writing that there has not been and is to be no input from anyone (e.g., University faculty) other than center personnel or University students, as the case may be, and the client. If there is, in fact, such input, then any such waiver shall be ineffective as to intellectual property rights attributable to said input, and all intellectual property rights will be retained by the University.
 - c. Execution of such agreements shall be on forms drafted or approved by the Office of General Counsel for that purpose, which forms cannot be modified whatsoever without the prior written approval of the Vice President for Research and the Office of General Counsel.
8. Guidelines for use of University research and service centers for economic development.
- a. University research and service centers may expend funds and utilize lands, facilities, equipment, and the services of employees and students to benefit the people of the state of Ohio by creating or preserving jobs and employment opportunities or improving the economic development and welfare of the people of the state when all of the following factors are present:
 - (i) There is reasonable assurance that the proposed use and/or activity would not interfere with or compromise the University's academic and research mission.
 - (ii) There is reasonable assurance that the proposed use and/or activity would not unfairly interfere with, displace or compete with any existing private or public entity's performance of the same or similar activity.
 - (iii) There is reasonable assurance that the proposed activity would result in revenues to the University which shall at least be sufficient to recoup any direct expenses to the University. Depending upon the extent of use and/or activity, as determined by the Controller of the University, the revenues established for any use and/or activity may include a factor to

recover all or a portion of the University's actual or potential indirect costs, including but not limited to any unrelated business income tax liability.

- (iv) There is reasonable assurance that the activity to be undertaken will allow public or private entities or enterprises the opportunity to compete more effectively in the marketplace and/or fulfill needs that are being inadequately met by the private market.
 - (v) There is a reasonable assurance that the proposed use and/or activity is incidental to a viable academic program. All such use and/or activity shall contain substantial and appropriate academic content consistent with the University's academic and research mission.
 - (vi) All contracts regarding the proposed activity must receive prior written approval as to legal form and sufficiency by the Office of General Counsel. All such contracts shall contain provisions for liability insurance naming the University as an insured, indemnity by the agency or person seeking the research or service, or some other measure reasonably appropriate to minimize any University liability. Center managers shall forward these agreements, after respective decanal approval and legal review, to the Associate Vice President for Research and Director of Technology Transfer for signature.
- b. Academic deans for the college in which the respective centers are located, shall assure that the requirements are met before approving any such use and/or activity.