

FACULTY MEETING

May 14, 2014

MOTION

Motion: The IP Policy Working Group moves that the Faculty endorse the Intellectual Property Policy (attached).

Rationale: The purpose of this policy is to: (a) Promote the creativity of the entire College community and to reflect the contributions of inventor(s) and the institution in the determination of the rights of ownership, use, and the distribution of equity interest; (b) Ensure that discoveries, inventions, and other creations generated by the Skidmore College community, are utilized in ways most likely to benefit the public; (c) Assist the Skidmore community in properly disclosing their scholarly work, in complying with applicable laws and formal agreements, and in gaining the protection available under US law; and (d) Sustain and enhance the College's ability to engage in sponsored research and scholarship, funded by federal, state and private sponsors who require that policies and procedures exist for the management of intellectual property interests.

Federal Compliance Context: U.S. Federal Law (37 CFR Section 401) mandates that all recipients of federal grants or contracts must: (1) have intellectual property policies in place regarding the ownership of derivative intellectual property and that such policies require employees to disclose all such inventions; (2) report the details of inventions and patents that have been made through federal grants or contracts; (3) notify the federal sponsor that it will retain ownership of the invention and take steps to commercialize the invention or request permission to transfer title to a third party; and (4) provide a nonexclusive, nontransferable, irrevocable, paid-up license for the government to practice or have the invention practiced on its behalf throughout the world. The above requirements are also stipulated in Notices of Grant Award, contract terms and in the award policies of each agency.

REVISED INTELLECTUAL **PROPERTY POLICY**

Introduction

This policy on intellectual property acknowledges the critical role that creativity plays in the intellectual fabric and identity of the College.

The purpose of this policy is to:

- *ensure that members of the Skidmore community remain free to create and enjoy the benefits of their creations;*
- *establish a framework for making intellectual property developed at Skidmore available for the public benefit;*
- *encourage the prompt and open dissemination of research results;*
- *ensure that the College's legal obligations under externally funded grants and third party agreements are met; and*
- *articulate those circumstances where the College has a legitimate ownership interest in the creations of its employees and students, to establish procedures for the transfer of ownership of such creations from the creator(s) to the College and for the administration of such assigned intellectual property.*

Intellectual Property at Skidmore College¹

The following policies apply to ownership of patents and copyrights in works invented or created by members of the Skidmore community using College funds, facilities, or other resources.

Definitions

Author is defined as a person who creates a copyrighted work.

Community members are defined to be the President, members of the President's cabinet, faculty, staff and students.

Copyright is defined as a form of protection the law provides to the authors of "original works of authorship: for their intellectual works that are "fixed in any tangible medium of expression," both published and unpublished. Examples of works which are eligible for copyright protection include: books; periodicals; software; musical or dramatic works; pictorial or other artistic works; and audiovisual works. Copyright includes a bundle of rights: The right to reproduce the copyrighted work; the right to distribute copies of it; the right to prepare derivative works based upon the copyrighted work; and the right to make public performances or displays of most copyrighted works.

Institutional Works is defined as works created by non-faculty employees (either staff or student employees) within the scope of their employment.

Intellectual property is defined as creations of the mind or intellect, the ownership of which is recognized and protected by law. It includes any patentable invention, tangible research property, copyrightable subject matter, trademarks, trade secrets, works of art and inventions or creations that might normally be developed on a proprietary basis.

Invention is defined as any new or useful process or discovery, art, method, technique, product, machine, device manufacture, software, composition of matter, or improvement thereof.

Invention Disclosure Form is a form that reports and describes a new invention, signed by the inventor(s).

Inventor is defined as any individual associated with the College who makes an invention.

Patent is defined as a grant issued by the United States or a foreign patent office that gives the inventor or the entity to whom the inventor has assigned ownership rights, the right to exclude others from making, using, or selling the invention within the country within which the patent is issued for a period of twenty years.

Proceeds are defined as all compensation of whatever kind received from the sale, license, or other transfer of intellectual property rights by the College to a third party. This includes, but is not limited

¹ *In developing this policy, we have consulted intellectual property policies from a number of schools. We have borrowed language directly from the policies of Amherst, Colgate, Swarthmore, Hamilton, Dartmouth and Boston College.*

to, percentage payments, up-front fees, milestone payments, shares of stock, and any other financial or in-kind consideration.

Routine support is defined as whatever resources are regularly provided to that sort of person in that department at that time. Examples of routine support include office or laboratory space and equipment, secretarial and clerical services, divisional travel grants, access to generally available and departmental computer and network facilities, software, and support, sabbatical leaves, start-up funds at the time of hire (e.g., one-time funding to help a newly hired science faculty set up a laboratory does count as routine support because it is regularly provided in science departments at this time), grants for endowed chairs, fellowships, and other grants from the Faculty Development Committee or other similarly constituted intramural grant committees.

Costly, exceptional, individually dedicated resources are generally not routine support. For instance, if an individual faculty member gets one-time money from the budget or the Dean of the Faculty/Vice President for Academic Affairs (DOF/VPAA), that money is not routine support unless it is funding that is regularly offered.

Software is defined as any computer or computer-based materials, including but not limited to computer programs, databases, operating systems, and application programs, or parts thereof, designed to accomplish a task or allow a user to produce, manage, analyze, or manipulate a product, such as data, text, a physical object, or other software. Software may be protected by patent, copyright, or trade secret.

Sponsored Project Agreement (SPA) is a contract between the College and a sponsoring organization that sets the terms and conditions for the conduct of Community member's research or other professional or scholarly activity. Sponsored Project Agreements include, but are not limited to, Notices/Letter of Grant Award, Sponsored Research Agreements, Contracts, Subaward Agreements, Material Transfer Agreements, Non-Disclosure/Non-Use Agreements, etc. These third party agreements identify the expectations and needs of all parties and address a variety of issues, including for example: period of performance; amount of funding; scope of work; the disposition of data; deliverables; intellectual property rights; ownership of equipment or derivative products; liability; publication rights; termination; governing law; space; indirect cost rates, etc.

Trademark is defined as a work, name symbol, or device (or any combination) adopted by an organization to identify its goods and services and distinguish them from the goods and services of others.

Work-for-hire is a work prepared by an employee within the scope of his or her employment, or a work specifically ordered or commissioned under a written work for hire contract.

Part A - Copyright

I. Ownership

Skidmore College has historically asserted no ownership interest that it may legally have to copyrightable works created by Community members. Skidmore's fundamental practice with regard to

copyrightable intellectual property remains one in which ownership shall be held by the individual(s) who create(s) the work subject to the exceptions specified below in Section II.

However, the College has the right to protect its good name, and therefore retains a right of approval for the dissemination of any intellectual property that suggests College endorsement, (e.g., by the use of the College name, logo or other trademarks). No approval is necessary when the name of the College is used only to identify the employment/affiliation status of the Community member.

II. Exceptions

A. Work-for-Hire The College shall own intellectual property rights in: 1) works-for-hire; 2) institutional works created by non-faculty employees (either staff or student employees) within the scope of their employment; and 3) works produced in College related service activities, except when otherwise provided in a prior written agreement between the author(s) and the DOF/VPAA of the College or in the case of non-academic affairs staff the Vice President of Finance and Administration. Not included in this exception are works created by non-faculty employees (e.g., student employees) under the supervision of a faculty member. In this case, the College would not claim ownership, except in instances in which the College can claim ownership rights under exception II.B.

B. Sponsored Project Agreements Works created pursuant to a Sponsored Project Agreement with an extramural sponsor will be governed by terms of that agreement, the award policies and procedures of the Sponsor/Grantor, and/or by applicable law governing the ownership of copyrightable intellectual property generated under such agreements. Such agreements are subject to the review and approval or concurrence of the PI/senior personnel responsible for the project and the review and approval of the Dean of the Faculty/Vice President for Academic Affairs. Unless otherwise dictated by the Sponsor/Grantor, the division of intellectual property rights between the College and the creator(s) shall be governed by the principles outlined in this document.

The College will not enter into any Sponsored Project Agreements that prohibit the free use of the intellectual property by the creator(s) for research or educational purposes without consulting with the creator(s). All such agreements shall to the extent practicable provide for the creator's continued free use of the intellectual property for their own ongoing research or education purposes.

Part B - Patents

I. Ownership

Skidmore's fundamental practice with regard to patentable intellectual property when no more than routine support has been received remains one in which ownership shall be held by the individual(s) who create(s) the work subject to the exceptions described below in Section II.

II. Exceptions

A. College-Sponsored Materials. Skidmore shall own intellectual property rights to institutional works, institutionally commissioned works, or when it provides more than routine support to a project.

When the College provides more than routine support to a project, the community member shall request or the College may elect to provide a notice of "More than Routine Support" to the applicant

community member at the time the support is provided. All parties involved shall sign the "Greater than Routine Support Agreement" outlining the scope of the project, and to the extent practicable, the expected outcomes. During the effective period of this agreement, the participants shall promptly disclose any and all intellectual property generated, in accordance with the procedures described below in Section III.A.

Not included in this exception are works created by non-faculty employees (e.g., student employees) when they are working under the supervision of a faculty member who has received no more than routine support for his or her research or teaching project.

B. Sponsored Project Agreements. Works created pursuant to a Sponsored Project Agreement with an extramural sponsor will be governed by terms of that agreement, the award policies and procedures of the Sponsor/Grantor, and/or by applicable law governing the ownership of patentable intellectual property generated under such agreements. Such agreements, when negotiated, are subject to the review and depending on the nature of the agreement, subject to either approval or concurrence of the PI/senior personnel responsible for the project. All such agreements are subject to review and approval of the Dean of the Faculty/Vice President for Academic Affairs. Unless otherwise dictated by the Sponsor/Grantor, the division of intellectual property rights between the College and the creator(s) shall be governed by the principles outlined in this document.

The College will not enter into any Sponsored Project Agreements that prohibit the free use of the intellectual property by the creator(s) for research or educational purposes without consulting with the creator(s). All such agreements shall, to the extent practicable, provide for the creator's continued free use of the intellectual property for their own ongoing research or education purposes.

III. Procedures for Administration of Invention Disclosures and Patents

A. Disclosure and Assignment

Inventions conceived or first reduced to practice using College funds or facilities and for which the College may, pursuant to the principles described herein, have an ownership interest shall be promptly disclosed in writing to the Office of Sponsored Research (acting on behalf of the Office of the DOF/VPAA), Palamountain Hall, Rm. 436, Skidmore College, 815 North Broadway, Saratoga Springs, NY 12866-1632. The creator(s) of the invention shall complete the appropriate Invention Disclosure Form supplied for this purpose. If the College chooses to file a patent application for the invention, to which the College may claim ownership in accordance with the principles described above, the inventor(s) shall execute documents of assignment to convey to the College all of the inventor's interest in the invention owned by the College and shall cooperate and assist the College in all phases of the patent application process. Upon request, each person covered by this policy will sign an appropriate agreement to implement this policy. The Disclosure Form, all supporting documentation and discussions relative to the invention shall be treated as confidential communications. Copies of all such tangible documents and records shall be retained in a locked cabinet in the Office of Sponsored Research.

B. Abandonment

If the College, acting in-a-timely-manner, elects not to patent an invention, the College, upon request, shall reassign ownership to the inventor(s) to the extent possible under the terms of any agreements that support or relate to the work. In this context, "in-a-timely-manner" shall mean a period of time

sufficient to provide for the conduct of background research and investigation and for the DOF/VPAA to render a decision. As a general guideline, such actions shall be completed within a period of 60 to 90 days following receipt of a complete and fully executed copy of the Invention Disclosure. The actual time required will be dependent on considerations, such as the complexity of the invention and the need to secure outside counsel.

C. Proceeds

Income distribution for patents owned by the College shall be as follows: All administrative and legal expenses incurred in connection with the patent will be deducted from the gross income. After these deductions, the income will be divided 50% to the inventor(s), with the other 50% divided between a research account in the Office of Sponsored Research, and the College.

Skidmore anticipates that a portion of its proceeds will be used to support education or research.

Part C - Resolution of Disputes

Disputes concerning application of this policy shall be resolved by a review panel of three members of the Skidmore community: a representative of the creator(s), a person designated by the DOF/VPAA, and a third person selected by the two other members.

The review panel may request meetings with relevant individuals and may review additional materials necessary to understand the issues on which there is disagreement. Such materials may include, but are not limited to appropriate financial information, sponsored project agreements, human or animal protocols, laboratory notebooks, presentation materials and manuscripts or other relevant materials. The Review Panel will prepare written findings of fact and a ruling, based on their review. Such findings and the ruling will be provided to the creator(s), the DOF/VPAA, and the President. The findings of the Review Panel, when approved by a majority of its members, shall be binding.

The existence of a review panel does not preclude any of the parties from retaining and/or consulting legal counsel.

In the event of disputes between co-inventors, all claims and disputes are to be settled by binding arbitration, pursuant to the rules of the American Arbitration Association, in the state of New York.

Part D - Revisions to Policy

Skidmore College reserves the right to amend this policy as it deems necessary to achieve programmatic and policy objectives, consistent with the procedures prescribed in the College's Policy on Policies.

Part E - Effective Date

This policy applies to intellectual property conceived on or subsequent to the date of policy adoption or to any intellectual property interests that are subject to the terms of a Sponsored Project Agreement.