**Intellectual Property and Technology Transfer**

**Provost Office**

**2.12.2.1 Purpose and Objectives**

**A. Purpose**

It is Juniata College's mission to prepare individuals for satisfying and beneficial lives by instilling qualities of character and intellect which encourage students to strive for excellence in their personal lives and professional careers. Consistent with that mission, it is the policy of the College to promote a lively spirit of intellectual inquiry among its students, staff, and faculty, and to encourage scientific research and academic scholarship.

 The College believes that inventors should share in the fruits of their labor, and that policies must reflect this principle. With this principle in mind, the College has formulated objectives and policies concerning intellectual property, and technology transfer.

 The emphasis of this policy is not whether the invention is patentable or copyrightable, but rather, an equitable determination of ownership and reward, consistent with any contractual obligations to sponsors. This determination will be made with the understanding that the policy is not meant to reverse the traditional ownership of, for example, the copyrights in a poem, scholarly work, or painting by the creator.

**B. Objectives**

 The global objective of this policy is to promote the pursuit of knowledge for the benefit and use of society, while at the same time achieving fair and equitable determinations of the rights of ownership, use, and distribution of intellectual property which acknowledge both the contributions of inventors and the College. Specific objectives of the College's policy on intellectual property include the following:

1.      To provide motivation and incentive to inventors and authors in the form of personal development, professional recognition, and financial compensation;

2.      To identify and safeguard the intellectual property rights of students, faculty, the College, and research sponsors by fostering appropriate disclosure, evaluation, and protection of new inventions and copyrightable works;

3.      To educate students and faculty concerning intellectual property rights so as to maximize the potential of new inventions and copyrightable works, while minimizing potential infringement of the intellectual property rights of others;

4.      To provide for the effective and equitable administration and supervision of scientific research and academic scholarship; and

5.      To generate revenue from patentable inventions and copyrightable works that can be used to support the academic and social missions of the College.

**C. Definitions**

 "Inventions" will be used herein to broadly include inventions, copyrightable works, creations, new processes, innovations, methods, software, compositions of matter, organisms, plant varieties, or other technology.

 "Intellectual Property" refers to Inventions, and the patents, copyrights and trademarks that are obtained by the College pursuant to this policy in order to preserve and protect rights to them. It also includes works of art, and inventions, creations, or data bases developed on a proprietary basis.

 "Creator" means any person(s) who is an inventor of a patent, author of a copyrightable work, or who otherwise creates an Invention.

**D. Persons Subject to The Policy**

 This policy applies to all full-time and part-time faculty members, administrative officers, and staff members engaged in teaching, research, study, or other forms of activity within the College or in connection with any College program and any students who are engaged in any research sponsored by a third party. Such individuals are required as a condition of their employment, enrollment, or association to review this policy and comply with the terms and conditions of all sponsored research, academic scholarship, and policies of the College. Such individuals may also be required as a condition of their employment, enrollment, or association to execute, and shall execute whenever requested by the College, certain contracts or agreements necessary to implement the policies and guidelines herein, including specifically an assignment to the College (or its assigns) of some or all interest they may have in any Inventions and/or Intellectual Property.

**E. Procedure with Respect to Ownership of Inventions**

 The Office of the Provost will be responsible to the President of the College for the supervision and administration of all sponsored and institutional research, as well as all work which potentially involves use of the funds, facilities, personnel or other resources of the College that might result in Intellectual Property.

 **1. Reporting of Inventions**

 Inventions should be disclosed fully and in writing at the earliest time possible to the Provost. This reporting requirement does not apply to copyrightable works described in Section F hereof. In order to facilitate such disclosures, the College shall provide invention disclosure forms through the Office of the Provost. The Provost will promptly acknowledge in writing the receipt of such invention disclosures.

 Disclosure should be made to the Provost at the time when legal protection for the Invention is contemplated, and it must be made before the Intellectual Property is sold, used for profit or disclosed to the public. Whenever legal protection for Inventions is contemplated, all persons engaged in such creative activity shall keep regular notebooks and records. Invention Disclosures must fully set forth the nature and scope of the Invention, and should be updated to include any new developments or aspects of the Invention.

 **2. General Principle**

 All right, title and interest in and to all potentially patentable Inventions, including Intellectual Property rights in computer software and databases, conceived or first reduced to practice in whole or in part by full-time and part-time faculty members, administrative officers, staff members, and students engaged in teaching, research, study, or other forms of activity within the College or in connection with any College program, shall be the sole property of the College. The Creator shall cooperate and assist the College in all phases of Intellectual Property protection, including, where applicable, the patent application process, and shall assign such applications or any patents resulting therefrom to the College.

 **3.** **Ownership of Inventions**

 Following receipt of a written invention disclosure, the Provost will promptly consult (the "Initial Consultation") with the Creator in considering all aspects of the Invention, including but not limited to issues of ownership, intellectual Property protection for the Invention, and the licensing and commercialization potential of the Invention.

 Except where limited by external sponsorship agreements, the Creator and the College may negotiate individual agreements to govern ownership of Intellectual Property at the time of the Initial Consultation. Intellectual Property which is the subject of a specific agreement between the College and the Creator thereof shall be owned as provided in said agreement. It is anticipated that in most cases a swift and amicable determination will be reached between the Creator and the College at or following the Initial Consultation. Such agreements by the College and the Creator are encouraged.

 The Provost shall have absolute discretion in making the initial determination as to ownership interests in an Invention, and shall prepare a written summary of the determination in every presented case. The Provost shall be guided by the following principles in making its determination:

**a.                   Ownership in an Invention which is made subject to a duly authorized written agreement shall be controlled by such agreement;**

**b.                  The College's assertion of ownership in any Invention not governed by prior agreement shall reflect the commercial viability of the Invention, the extent of use of College resources, whether the Invention falls within the scope of the Creator’s duties as an employee, and the College's best interests from the perspective of the College's social and academic missions; and**

**c.                   In considering the Invention’s commercial viability, the Provost shall determine whether the Invention has sufficient value or is of a sufficient interest to the College to warrant its retention, or whether the same should be relinquished to the Creator or shall be otherwise dealt with.**

 In the event the Creator objects in writing to the Provost’s determination, the Provost will provide the invention disclosure, supporting documentation and written determination to the Creator and to the President. The President, or the President’s designee, is hereby empowered and authorized, after reviewing the specific circumstances of the case and considering the desirability of asserting the College's interests, to act on or reject the Provost’s determinations. The President shall then provide the Creator and the Provost with the President's final and binding written determination.

 Ordinarily, the College will pay the reasonable costs of conducting patent searches and obtaining patents on any such Inventions selected by the College for patenting.

 **4. Reacquisition of Rights to Invention by Creator**

 If at any point in time the College determines that it has no interest in an Invention to which it has asserted ownership rights under this policy, it may assign or release all rights therein to the Creator. Similarly, if the College cannot, or decides not to, proceed in a timely manner to patent and/or license an Invention, or elects not to commercially develop the Invention, it may reassign ownership to the Creator upon request, to the extent possible under the terms of any agreements that supported or related to the work. At the time the Intellectual Property is disclosed to the Provost as required by Section E-1, or at any time thereafter, the Creator may request that the College decide whether it will commercially develop the Intellectual Property or execute an assignment of the Intellectual Property rights to the Creator. Such a decision will ordinarily be made within six (6) months of the formal request by the Creator, however, extenuating circumstances involving approvals from a sponsor, or contacts with prospective licensees must be resolved prior to assignment.

 Upon reassignment, the Creators shall be free at their own expense, to pursue patent, copyright and/or trade secret protection and negotiations with third parties independently. The College assumes no liabilities or obligations in such cases, shall be released from all liability by the Creator. The Creator shall agree to require appropriate liability and indemnity clauses protecting the College to be included in any licenses or commercialization agreement. Further, the College shall receive a non-exclusive, non-transferable, royalty-free, perpetual, worldwide license to use the Invention, including rights of practicing, revising, adapting, reproducing and displaying the Invention. In the case of software, this license includes access by specified College personnel to the source listings, consistent with the educational mission of the College, and the College shall require each person to whom a disclosure is made to execute in advance a binding confidentiality agreement in favor of and enforceable by the Creator.

 **F. Exceptions to Institutional Ownership**

 **1. Intellectual Property Created Outside the Scope of Employment**

 Intellectual Property that is: 1) made by Creators on their own time and/or without the use of College resources, and 2) are outside the scope of the Creator’s scope of duties as an employee, shall belong to the individual Creator. Computer programs written on the job by staff computer programmers do not fall under this provision, absent written agreement with the College.

 **2. Scholarly Works**

 Unless governed by other provisions of this policy, and in keeping with academic traditions at the College, the Creator retains all rights to the following types of scholarly intellectual property, without limitation: books (including textbooks); educational courseware, articles, non-fiction, novels, poems, musical works, dramatic works including any accompanying music, pantomimes and choreographic works, pictorial, graphic and sculptural works, motion pictures and other similar audio-visual works, and sound recordings, regardless of the level of use of the College's facilities. Creators shall not license or use such works in any manner that would constitute a conflict of commitment to the College.

 **3. Future Written Agreements For Externally Sponsored Work**

 The College recognizes that future situations may arise where Intellectual Property is created pursuant to agreements (sponsorships, consulting, grants and contracts) between the College and government agencies, private sponsors, and other third parties. Intellectual Property created as a result of work conducted under an agreement between an external sponsor and the College that specifies the ownership of such Intellectual Property shall be owned as specified in said agreement. It is the College's policy that all such agreements must be memorialized in writing, and must contain appropriate provisions governing the ownership, equity, responsibilities, and obligations of all parties with respect to resulting Intellectual Property. No contract or agreement involving externally sponsored or funded scientific research or academic scholarship may be entered into on behalf of the College without written authorization and approval of the President. Lastly, no assignment, license or other contract or agreement may be entered into with respect to any interest the College may have in any Invention and/or Intellectual Property except as authorized and approved in writing by the President. Accordingly, the early submission of such contracts to the President for review and approval is necessary.

 **4. Exemption for Existing Agreements**

 The College does not intend this policy to alter the terms of any agreement in existence as of [insert date policy is to take effect], 2003 concerning prior Inventions. Intellectual property provisions of such prior agreements shall control over the provisions herein.

 **G. Royalty Distribution and Administration**

 For any Invention owned by the College pursuant to part E above, and in recognition of the efforts and contributions of the Creator, total net royalty income shall be distributed according to the following schedule:

a.                   the first $500,000 of net royalty income shall be distributed as follows:

20% to the College;

80% to the Creator(s) (or the heirs and legatees of the Creator(s)).

b.                  net royalty income in excess of $500,000 but less than $2,000,000 shall be distributed equally between the College and the Creator(s):

50% to the College;

50% to the Creator(s) (or the heirs and legatees of the Creator(s)).

c.                   net royalty income in excess of $2,000,000 shall be distributed as follows:

80% to the College;

20% to the Creator(s) (or the heirs and legatees of the Creator(s)).

 Net royalty income shall mean gross royalties received by the College less directly assignable expenses resulting from patenting and licensing the particular Invention, including but not limited to the costs of pursuing and obtaining patent protection, developing the invention, and all marketing, promotion and licensing costs. Deducted costs shall be reasonable and fair, and shall be properly disclosed; the sources and amounts of compensation shall also be properly disclosed.

 The College may make suitable arrangements not inconsistent with the provisions of this Policy with patent management agencies or firms for the purpose of obtaining services and advice with respect to the patentability of inventions, the obtaining of patents thereon and the management and licensing of any such patents.

**H. Continuing Responsibilities of Creator(s) and the College**

 Unless otherwise determined by written agreement, the College assumes no liabilities, responsibilities or obligations with respect to the continued authorship, conception, reduction to practice, and/or development of a disclosed Invention. Nonetheless, the College shall have right of first refusal to participate in the continued authorship, conception, reduction to practice, and/or development of any Invention in which the College holds an ownership interest (whether pursuant to Section E above, or other ownership interest under contract or by operation of law). Should the College be unwilling or unable to exercise its right of first refusal or to provide support reasonably necessary to patent or commercialize an Invention, the College shall permit the Creator to petition for reassignment of the invention from the Creator, under paragraph E-4 of this Policy. The parties will agree upon an equitable apportionment of revenues from any subsequent commercialization to reimburse the College, the Creator, and any involved third parties, for their respective investments in the Invention.

**2.12.2.2. Intellectual Property of Others**

 The College recognizes the importance of respecting the Intellectual Property rights of others. Therefore, it is the College's policy that faculty, staff, students, and all other persons affiliated with the College shall be provided with copies of this Policy. Such persons shall exercise due care and diligence in identifying the Intellectual Property of others, and shall obtain appropriate permissions and licenses prior to use of such Intellectual Property in connection with any endeavor related to the College.

 Because any failure to obtain appropriate permissions can result in liability of the infringer, and potentially the College, understanding is critical to avoiding infringement. In furtherance of education and understanding necessary to promote adherence to this policy, the following definitions and insights are provided:

 1. Copyrights. Copyright protects any expression of an author which is fixed in any tangible format, including writings, drawings, sound recordings, computer software and screen displays, among other things. U.S. copyrights are governed by Title 17 of the United States Code (U.S.C.), and by regulations and guidelines. The U.S. copyright laws, regulations, guidelines, and helpful overviews are available on the Library of Congress website [www.loc.gov/copyright](http://www.loc.gov/copyright).

 The College recognizes that recent attempts (such as by Napster) have been made to challenge copyright in computerized expressions. However, recent judicial and legislative developments, including the Digital Millenium Copyright Act of 2000 ("DCMA"), have clearly established that copyright protection for computerized works is enforceable. Importantly, the DCMA generally precludes the argument that unauthorized sharing of computer files is a "fair use of a copyright work." Therefore, faculty, staff, and students are advised against unauthorized sharing of the works of other authors, whether for classroom use or otherwise.

 2. Patents. Patent protection is available for machines, compositions of matter, articles of manufacture, designs, plants, methods, and software. A patent is a federally granted right which provides an inventor with a 20-year monopoly on the invention in exchange for the dedication of the invention to the public at the end of the patent term. During the term of a patent, any imitator or unauthorized user of the invention can be held liable for infringement. U.S. patents are governed by Title 35 U.S.C., and by regulations set forth at Title 37 of the Code of Federal Regulations (C.F.R.). The U.S. patent laws, regulations, guidelines, and helpful overviews are available on the U.S. Patent and Trademark Office (USPTO) website [www.uspto.gov](http://www.uspto.gov/).

 3. Trade Secrets. Trade secret protection is a form of intellectual property which can be extended to information (including a formula, pattern, compilation, program, device, method, technique or process) that (a) has an independent economic value due to the fact that it is not generally know to (and not readily ascertainable by proper means by) other persons who can obtain economic value from its disclosure or use, and (b) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy. The essence of trade secret is that those persons who are provided with access to the information are under strict obligation to keep the details secret. Therefore, confidentiality and non-disclosure agreements are required, and any violation of such an agreement may destroy the trade secret and may subject the violator to liability. Trade secrets in Pennsylvania are currently governed by common law, as the state legislature has yet to pass legislation adopting the Model Uniform Trade Secrets Act.

 4. Trademarks. Trademarks are words, slogans, and designs which are used to identify the source of a good or service. Federal trademark registration provides benefits such as notice to competitors of the use of a trade mark or service mark in interstate commerce. Unauthorized use of trade marks or service marks results in liability for the unauthorized use. U.S. trademarks are governed by Title 15 U.S.C. Chapter 22, by regulations and guidelines. The U.S. trademark laws, regulations, guidelines, and helpful overviews are available on the U.S. Patent and Trademark Office (USPTO) website [www.uspto.gov](http://www.uspto.gov/)

 The College encourages students, faculty and staff to make inquiries prior to use of Intellectual Property of others. Questions are encouraged, and can be directed to the Office of the Provost.