

## **BRANDEIS INTELLECTUAL PROPERTY POLICY**

**Proposed by the Brandeis Intellectual Property Policy Committee, October, 2003**

**Approved by President Jehuda Reinhartz, February, 2004**

### Article I: Statement of Objectives

- A. Brandeis seeks to encourage creativity and invention among its faculty, students, and staff. The scientific, scholarly and artistic activities of the University community sometimes result in inventions or other creations that have commercial value. The intent of this policy is to provide a framework for appropriate incentives to stimulate scientific, scholarly and artistic creativity, and also help to assure that intellectual property that is produced at the University will be developed, as appropriate, for the benefit of the creators, University research, and the public.
  
- B. Technological developments and changes in the legal environment have blurred the lines defining traditional categories of intellectual property, such as patents and copyrights. This policy is intended to reflect this new environment. It avoids making the treatment of new kinds of intellectual property dependent on the nature of the legal protection that the property carries, in order to minimize the chances that the policy will be rendered obsolete, or result in unintended consequences, as the environment continues to evolve.
  
- C. The specific aims of this policy include the following:
  - 1. to encourage creativity among members of the University community;
  - 2. to increase the likelihood that inventions and other creative works produced at the University are used to benefit the public;
  - 3. to protect academic freedom and the traditional rights of scholars with respect to owning the products of their intellectual endeavors;
  - 4. to make Brandeis an attractive place for members of the University community to work and study;
  - 5. to provide the university an opportunity to recover specific, non-routine investments made in support of the creation of intellectual property;
  - 6. to avoid potentially vague distinctions in the treatment of different kinds of IP;
  - 7. to assure compliance with the provisions of contracts with external sponsors; and
  - 8. to provide that, when intellectual property is introduced for commercial development, any net profits arising therefrom are distributed in a manner that reflects and fosters the above aims.

## Article II: Definitions

*Intellectual property (“IP”)* includes, without limitation, all inventions, tangible research materials, software (including source code and object code), teaching materials, class presentations, books, electronic or paper documents, multimedia or audiovisual materials, artistic works and photographs. IP may or may not be subject to patent, copyright or other protection under U.S. law.

*Invention* shall include any IP that may be patentable.

*University-supported IP* is IP that falls within circumstances described in Article III, Paragraph B.

*University Community* means employees, students and all others whose primary academic or employment affiliation is with the University, including but not limited to faculty, students, research staff, administrators, office and technical staff, visitors, contractors and consultants, whether compensated by the University or not.

*Faculty* means any individual holding a faculty appointment under the terms of the Faculty Handbook.

*Sponsored research agreement* is a contract between the University and an outside agency, firm, or other institution under which funding is provided to the University for the purpose of supporting specified research or other creative activities at the University.

*Creator* is a person who makes a significant contribution to the conception, discovery or reduction to practice of any IP.

*Inventor* is a creator of an invention.

*OIPTT* shall mean the Office of Intellectual Property and Technology Transfer that carries out University responsibilities related to IP.

*Commercial development* includes any efforts that are intended to result in financial benefit from IP.

## Article III: Ownership of IP

- A. Except as set forth below, the creator of IP shall retain his/her rights, and the University shall not assert ownership rights.
- B. The University has ownership rights to IP conceived, discovered, or reduced to practice during the creator’s term of association with the University or within six (6) months after said association ends, under any of the following circumstances:
  1. Development was funded as part of a sponsored research agreement.

2. A faculty member (holding at least a half-time appointment) or student was assigned, directed, or specifically funded by the University to develop the IP, and the creator has agreed in writing that the IP is to be owned by the University.
  3. The IP was developed by an employee or employees of the University (other than students or faculty (holding at least a half-time appointment)) in the course of their employment duties.
  4. The IP was developed with the use of University resources that substantially exceed or are qualitatively different from those that would normally be provided for the creator's employment duties.
- C. Each of the circumstances listed in Paragraph B is explained further below.
1. *Created under an externally sponsored research program* (Subparagraph B.1). IP shall be considered to have been created as part of an externally sponsored research program if either of the following conditions apply:
    - a) The IP was created using equipment or research supplies that were purchased in whole or in part with funds provided under a sponsored research agreement, or is dependent upon data that were generated using such equipment or research supplies.
    - b) The creator of the IP receives compensation from Brandeis, a portion of which is funded by a sponsored research agreement, and the subject matter of the IP falls within the stated scope of the sponsored research (as defined by the research proposal and the reports prepared by the investigator for the funding entity), and significant development of the IP occurred during the time period commencing with the start date of the sponsored research agreement and ending six months after the end date of the sponsored research agreement.

IP developed with the use of equipment that was originally purchased using sponsored research funding falls under this provision. With respect to this provision, "compensation" includes salary, as well as stipends or tuition remission received by students. Research funding or other support that flows directly from a third party to a member of the University community and does not involve the University as a contracting party does not trigger University ownership.

Examples of IP that would be owned by the University under this provision include research tools or laboratory equipment, tangible research materials, and other commercial products that are the direct output of research undertaken pursuant to the research agreement. Any books, articles or other works that report, describe or analyze the results or data generated by sponsored research do not fall under this provision, and so would remain the property of their creator.

2. *IP developed as a University project.* Subparagraphs B.2 and B.3 relate to IP developed as the direct output of a University project. In recognition of the historically liberal treatment afforded faculty and student IP created outside of the realm of sponsored research, it would normally be expected that faculty and students would agree in advance that the output of a particular project would be owned by the University. In the case of other employees, any IP created in the course of their University-assigned responsibilities would be owned by the University. Examples of IP that would come under this category would include software written to perform a University function, or a video or written material created for Brandeis marketing or historical purposes.
  3. *Provision of unusual resources* (Subparagraph B.4). The use of office equipment, libraries and other support that is generally available to faculty or students in a given field for the purposes of teaching, research and creative activities does not create a University ownership interest in IP. If, however, the University provides support that is of a kind not normally provided, or is substantially greater in magnitude than would normally be provided, then the University has ownership. Since, by definition, such funding is something that the creator would not be routinely entitled to, the University should state in writing its intention to claim IP ownership at the time such discretionary funding is granted, so that the potential creator would have the option to decline the special funding to retain ownership of IP. However, failure of the university to secure written agreement would not preclude University ownership of IP developed with unusual resources, provided that the use of those resources can be appropriately documented. Examples might include web-based course materials that the University provided extensive specific funding to develop; output of a research lab supported with the University's funds; software or multimedia works created on a specialized or particularly powerful computer for which special University funding was provided. Receipt of support that is awarded to only a few, but which all are eligible to compete for (e.g. Bernstein awards) would not trigger this provision, unless such treatment is specified in advance by the University as a condition for receipt of such support.
- D. Voluntary Assignment to the University With respect to any IP that does not fall under Paragraph B, the creator may request that the University accept transfer or assignment of the rights to the property, for the purpose of assisting the creator in the protection and/or commercial development of the property. The University, in its discretion, may accept or decline such voluntary assignment or transfer.

#### Article IV: Disclosure

- A. If any creator of University-supported IP seeks intellectual property protection or commercial development, or if s/he is subject to a disclosure required under a sponsored research agreement, s/he must fully and promptly disclose the IP to the OIPTT as early as possible.

- B. If IP is co-created, each creator associated with the University shares the obligation of Paragraph A. All such creators may discharge this obligation by means of a single disclosure form signed by all creators.
- C. Each recipient of funds under a governmental or industrial sponsorship agreement or contract is responsible for understanding and complying with his or her obligations under that agreement. Most such agreements require that all IP arising from sponsored research must be reported to the sponsor.
- D. Inventors are urged to disclose any IP to the University before they release information regarding the IP to people who are not co-inventors. IP rights can be destroyed if an invention is published or disclosed before a patent application is filed unless the disclosure is protected by a written confidentiality agreement.
- E. If an unpublished idea is being discussed with a commercial enterprise, an exchange of confidential information should be covered by a confidentiality agreement. Forms for such agreements are available from, and should be prepared by, the OIPTT. If a confidentiality agreement is received from an outside company by a member of the University community, that member should forward the confidentiality agreement to the OIPTT for review.

#### Article V: Waiver of University Rights

- A. If the University determines that IP disclosed pursuant to Article IV was not University-supported as defined herein, it shall issue a written waiver disclaiming any rights the University might have to the IP as disclosed.
- B. If a creator believes that there is ambiguity as to whether particular IP is University-supported as defined herein, s/he is encouraged to submit to OIPTT a complete written disclosure of such IP, accompanied by a written request that the University waive any rights it may have to such IP as described in the written disclosure. A full and complete statement of facts and information that relate to the request, including any relevant information related to the circumstances of the creation and development of the IP, must accompany any such request. The OIPTT shall evaluate all such completed disclosure forms and formal requests for waiver with good faith and reasonable diligence. If it appears that a waiver of University rights would be consistent with this Policy, then the University shall issue a written waiver disclaiming any rights the University might have to the IP as disclosed.
- C. If the University, at its discretion, chooses not to prepare a patent application or other appropriate protection, or otherwise to pursue commercial development of University-supported IP, it shall waive its rights in writing. In such case, the University may, through negotiations with the inventor, retain a percentage interest in any income from commercial development of the IP. In addition, the University shall retain the right to make and use such IP for any non-commercial

University purposes. Any waiver or other agreement under this paragraph is subject to such external sponsor restrictions as may apply.

- D. If the University fails to make a determination regarding a waiver or a decision to protect the IP within a period of thirty (30) calendar days from the date of the waiver request to it, then the creator may so notify the Director of the OIPTT in writing. Within thirty (30) days after the Director of the OIPTT is so notified, the University must render a decision in writing. Otherwise, all of the University's rights to the IP described in the disclosure shall be forfeited automatically and reassigned to the creator, subject only to such external sponsor restrictions as may apply.
- E. In the event of any waiver of University rights as described in this Article, the creator(s) may develop the IP using University resources only if there is a clear written agreement between the creator(s) and the University to do so.

#### Article VI: Income from IP

- A. With respect to University-supported IP, the University shall reimburse itself from the gross income from such IP for all out-of-pocket and contractual expenses related to the IP, including but not limited to legal and litigation expenses. If an intellectual property management firm is engaged to evaluate, file or market IP, all expenses and fees of said firm will be deducted prior to distribution of income to the University and creators. Remaining and subsequent income shall be distributed as follows:
  - 1. The creator(s), or his/her legal heirs, shall collectively receive 40%. A creator's right to this share continues if s/he departs the University.
  - 2. The department(s) or program(s) with which the creator(s) is associated shall receive 15%. These funds are in addition to the regular University budget for the department or program. At least one-half of these department/program funds shall be allocated for the direct support of the creator's research, scholarly and creative activities, with the remainder used to foster research, scholarly and creative activities in the department or program more generally. In the event of the departure of a creator from the University, the portion otherwise allocated for direct support of the creator's activities shall remain with the department or program.
  - 3. The University shall allocate 15% to a fund under the direction of the Provost for the promotion of research, scholarly and creative activities.
  - 4. The University shall retain 15% for use at its discretion.
  - 5. The University shall allocate 15% in support of the OIPTT.
  - 6. Distributions shall be paid quarterly, and accompanied by reasonable accounting and explanation of how they were calculated.

- B. In the case of multiple creators, creators shall share in the income to which they are collectively entitled. The percentage shall be indicated beside each creator's name on the disclosure. The disclosure may allow for income sharing with people who are not co-creators as defined. In order for income sharing to be other than equally divided among the creators, all creators must agree in writing to any non-standard royalty sharing agreement. To prevent misunderstandings, it is recommended that non-standard royalty sharing be agreed upon at the time of formal written disclosure. If a creator decides to forfeit or waive his/her share of income from the creation, then the distribution of that income will follow Paragraph A.
- C. If the University accepts assignment of non-University-supported IP pursuant to Article III, Paragraph C, the University shall reimburse itself from the gross income from such IP for all out-of-pocket and contractual expenses related to the protection or commercial development of the IP, including but not limited to legal and litigation expenses. After reimbursement of such expenses, the University shall return 90% of remaining and subsequent income to the creator, retaining 10% for use at its discretion, unless an alternative allocation formula is agreed to between the University and the creator. Such alternatives include agreements whereby the University retains a share to distribute to the creator's department for the support of research and creative endeavors.
- D. If the university wishes to provide support to a member of the University community for the development of IP, which support would cause the IP to be university-supported as defined herein, but which is modest relative to the overall scale of the IP development, the University and the creator(s) may agree that the income from any resulting IP shall be distributed in a manner different from that specified in Paragraph A of this Article. Any such agreement as to an alternative sharing formula shall be entered into in writing at the time the University support is initially provided.

#### Article VII: Use of Brandeis Name and Insignia

Members of the University community may not use the Brandeis name or any Brandeis insignia in connection with any commercial product or enterprise, or to promote any non-Brandeis activity or organization, except for the purpose of identification of named individuals by title and University affiliation, unless permission for such use is explicitly granted by the University.

#### Article VIII: Use of IP for University Research and Teaching

With respect to University-supported IP, use of such IP by the University for any non-commercial University purposes shall not generate any obligation to compensate the creator of the property. With respect to non-University-supported IP, the creator shall, if requested, grant the University a royalty-free license for use of the IP for the University's teaching, research and promotional purposes, unless such grant is prohibited by contractual agreement between the creator and a third party (e.g. a publisher). Members

of the University community are encouraged to avoid, to the extent possible, contracts with such third parties that preclude royalty-free use by the University, for any IP for which such use can be anticipated.

#### Article IX: Authority of the Provost; Applicability of the Policy

- A. The Provost and Senior Vice President for Academic Affairs of Brandeis University has the authority to make all decisions on behalf of the University relating to IP, including the preparation and filing of domestic and foreign patent applications, licensing agreements, and all legal, academic or other matters related thereto. The Provost may delegate this authority or portions thereof. Only the Provost or his/her duly authorized designee may execute agreements, waivers, and all other documents on behalf of the University in connection with IP matters.
- B. This policy becomes effective upon its approval by the President of the University. It governs all IP created after its effective date. In the case of any ambiguity regarding the creation date of IP, it shall be deemed to have been created on the date that a Disclosure regarding the IP pursuant to Article IV.A, or a request for Waiver of University Rights pursuant to Article V.B, is submitted to the OIPTT.
- C. If the provisions of this Policy are inconsistent with the requirements of a governing sponsorship or other contractual agreement, then the governing contractual agreement shall prevail.

#### Article X: Intellectual Property Review Committee

- A. To ensure that this policy achieves its goals, an Intellectual Property Review Committee shall be established to oversee its implementation. The Committee shall consist of a representative of the Office of the Provost, appointed by the Provost, two faculty members appointed by the Provost (one of whom the Provost shall designate as Committee Chair), a designee appointed by the Office of the Executive Vice President and Chief Operating Officer, and two faculty members appointed by the Faculty Senate. The Director of the OIPTT and the General Counsel shall serve as *ex officio* members of the committee. Ad hoc non-voting members may be added to the Committee by the Provost or the Committee Chairperson at any time to consider a particular IP issue.
- B. The Committee shall report to the Faculty annually, providing data on the operation of the OIPTT, and description of generic policy issues that have arisen. For this purpose, the Director of the OIPTT shall provide the Committee with appropriate information about its operations.
- C. Any decision by the University regarding treatment of IP may be appealed by the creator to the Intellectual Property Review Committee. In addition, if the University and the creator wish that particular IP should be handled in a way that deviates from the procedures and formulas stated herein, they may request that the Committee approve such deviations. Such approval shall be based on the

Committee's judgment that the proposed course of action fulfills the objectives of this policy.

- D. The Committee shall submit each decision to the Provost, who may accept or reverse it in his or her discretion. If the Committee's decision is reversed, the Provost shall provide a written statement of his or her reasons for the reversal to the Committee's decision.

Article XI: Rights and Obligations of Creators and of the University

- A. The University is obliged to solicit and consider the opinions and suggestions of the creator while evaluating a disclosure, preparing a patent application, licensing IP, or making other recommendations regarding the IP. The creator is obliged to bring to the attention of the Director of OIPTT all relevant facts and developments regarding any University-supported IP, and to cooperate with and assist the University in all matters relating to such IP. The creator shall assign to the University all domestic and foreign rights to any such IP when requested to do so by the University, on forms provided for such purpose by the University. A creator's rights and obligations with respect to such IP shall survive so long as the University owns any property rights relating to such IP.
- B. The creator(s) is obliged to bring to the attention of the Director of OIPTT any contracts or agreements (including but not limited to consulting, material transfer, confidentiality, research, option or license agreements), any prior art or existing related technologies, issues regarding conflict of interest, science, or commitment, and any other issues or information related to University-supported IP.