

## **BENEDICT COLLEGE INTELLECTUAL PROPERTY RIGHTS POLICY**

LINK: <https://www.benedict.edu/wp-content/uploads/2019/08/Policies-and-Procedures-Manual-Final-07312019.pdf>

### **Introduction**

The Intellectual Property Rights Policy at Benedict College is intended to clarify ownership of intellectual property rights, establish an opportunity for commercialization of works, inventions, and discoveries, and provide for equitable distribution of resources, monetary and other benefits accruing from Benedict College exploitation of these works, inventions, and discoveries. This Intellectual Property Rights Policy at Benedict College is applicable to all faculty (including visiting faculty) and staff, as well as full-time and part-time students at Benedict College.

### **Definitions (as used in this Policy)**

"Intellectual Property" at Benedict College is defined as all materials subject to copyright, patent, trade secret, and/or trademark laws.

Copyright laws protect original works of authorship fixed in a tangible medium of expression. Examples of works that are potentially copyrightable include original writings, works of visual art, musical compositions and recordings, scholarly articles, tests, syllabi, computer programs, photographs, movies and other audiovisual works, dramatic works, compilations, and other artistic creations.

Patent laws protect useful and novel inventions and discoveries, including processes, machines, articles of manufacture, compositions of matter, product designs, and improvements thereof. Examples of inventions and discoveries that are potentially patentable include computer programs, electronic devices, chemical compositions, manufacturing processes, and pharmaceuticals.

Trademark laws protect words, symbols, logos, names, and other devices (whether registered or not) that are used to identify and distinguish one person's, company's, or institution's goods or services from those of others. Benedict College owns a number of trademarks including registrations at the U.S. Patent and Trademark Office for the marks BENEDICT COLLEGE®, the Benedict Tiger logo, and the Benedict College Seal.

Trade secret laws protect economically valuable information, including formulas, processes, methods, compilations, techniques, systems and other matter which is not generally known or reasonably ascertainable, and which is the subject of efforts that are reasonable under the circumstances to maintain secrecy of the information.

"Creator" is defined as the person (being a Benedict College employee or student) or persons who invent, author, or otherwise create the Intellectual Property. Please note that the Creator of Intellectual Property, depending on the circumstances, will not necessarily be the owner of such Intellectual Property.

"Net Adjusted Income" in relation to specific Intellectual Property is defined as equaling the gross revenue received by Benedict College from licensing or exploitation of such Intellectual Property, minus

the current and projected expenses that Benedict College deems necessary to defend, enforce, maintain, register, and/or exploit the Intellectual Property.

"Significant Use of Benedict College Facilities or Resources" is the extensive use of Benedict College facilities (e.g., laboratories, studios, etc.) or human resources.

"Significant Use of Benedict College Funds" means funds provided by Benedict College in excess of \$5,000 and used for developing Intellectual Property.

A "Work Made For Hire" is a potentially copyrightable work: (a) prepared by an employee of Benedict College within the scope of the employee's employment, or (b) specially ordered or commissioned by Benedict College as set forth in a written agreement and that falls within one of nine enumerated categories of works that qualify as a "work made for hire" under the U.S. Copyright Act. Under U.S. copyright law, the owner of a Work Made for Hire is considered the employer—not the employee who may have actually created the work. An employee of Benedict College can include faculty, staff, and students that are employed by Benedict College.

### **Ownership of Intellectual Property Rights**

Intellectual Property may be owned by Benedict College, by the Creator of the Intellectual Property, or by shared ownership. The policy guidelines below are used to determine who owns Intellectual Property that is created by Benedict College faculty, staff, and students:

#### **I. Circumstances Where Benedict College Owns Intellectual Property**

Except where specific exemptions are made, Benedict College will own Intellectual Property created by Benedict College employees or students in the following circumstances:

- A Work Made For Hire; or Works, inventions, and discoveries within the scope of the employment with Benedict College, or resulting from the Significant Use of Benedict College Facilities or Resources, or resulting from the Significant Use of Benedict College Funds. Where a work, invention, or discovery is created within the scope of employment, or through the Significant Use of Benedict College Facilities or Resources or the Significant Use of Benedict College Funds, the Creator agrees to execute any and all written agreements/documents necessary to transfer all right, title, and interest in the work, invention, or discovery to Benedict College; or
- Discoveries, inventions, and works subject to agreements that grant Benedict College rights of ownership; or
- Trademarks and other indicia that signify Benedict College as the source of goods or services.

#### **II. Circumstances Where the Creator Owns Intellectual Property**

The Creator will own Intellectual Property created where all of the following circumstances are met:

- A written agreement does not specifically transfer the rights or ownership in the Intellectual Property to Benedict College or a third party; and
- The discoveries, inventions, or works were made without the Significant Use of Benedict College Facilities or Resources, without the Significant Use of Benedict College Funds, and made outside the scope of employment; and

- The work created is not deemed to be a Work Made For Hire under U.S. copyright law; and
- The Intellectual Property, if a trademark, does not signify Benedict College as the source of goods or services, suggest a sponsorship or endorsement by Benedict College where none exists, or otherwise infringe any rights that Benedict College may have. All Creators at Benedict College will retain any copyrights in the creation of original works in the nature of textbooks, research papers, and scholarship consistent with copyright laws, except:
  - Where performed as a part of contractual obligations or specially commissioned by Benedict College or a third party; or
  - When constituting a Work Made For Hire; or
  - When created with Significant Use of Benedict College Facilities or Resources, or the Significant Use of Benedict College Funds. However, extensive use of a Benedict College facility ordinarily available to most or all employees and/or students (e.g., library, personal office space, office computers) and used in the creation of original copyrightable works in the nature of textbooks, research papers, and scholarship will not constitute Significant Use of Benedict College Facilities or Resources. Creators who choose to use materials in which they claim rights, in the course of creating Intellectual Property at Benedict College, will automatically grant Benedict College a free, perpetual, non-exclusive, and irrevocable license for use (including reproduction, distribution, display, performance, preparation of derivative works, and transmission) of such materials and Intellectual Property for educational and research activities.

Benedict College will continue to encourage faculty, staff, and students, whose works, inventions, and discoveries are made on their own time, outside of the scope of their employment, and without the Significant Use of Benedict College Facilities or Resources or the Significant Use of Benedict College Funds, to work with the College to further develop such works, inventions, and discoveries. Works, inventions, and discoveries not owned by Benedict College are considered the property of the Creators and if the Creators choose, they may avail themselves of the opportunity to submit the works, inventions, or discoveries to Benedict College for consideration of possible patenting and/or commercialization and management under terms to be agreed between the Creators and Benedict College.

### **III. Circumstances Where There is Shared Ownership of Intellectual Property**

Benedict College and the Creator may, by written agreement, decide to share ownership of Intellectual Property.

### **IV. External Sponsorship/Funding**

The ownership of Intellectual Property resulting from research that is sponsored or funded (in whole or in part) by the federal government will be governed in accordance with federal law, including the Bayh-Dole Act. The ownership of Intellectual Property resulting from research or activities funded by other third parties will be determined by the agreement in place between Benedict College and the funding source. Where practicable, Benedict College will attempt to ensure that any external sponsorship/funding agreements explicitly enumerate Intellectual Property ownership issues.

### **Income from Certain Intellectual Property/Revenue Sharing**

Benedict College will share revenue that it receives from exploitation of patents or inventions with the inventors of such patents or inventions who are Benedict College employees, or as agreed upon. In some cases, specific provisions of grants or contracts may govern rights and revenue distribution regarding inventions or other Intellectual Property made in connection with sponsored research. As necessary, Benedict College may contract outside persons or organizations for managing, exploiting, enforcing, and/or defending patents or inventions, and any royalty shares of expenses contractually committed to such persons or organizations may be deducted as expenses in order to calculate Net Adjusted Income.

### **Distribution of Income from Patents or Inventions**

The Office of Sponsored Programs and Research will use the distribution formula listed below as a baseline to calculate and distribute the Net Adjusted Income from each license or other exploitation of the patent or invention. However, the final determination of net distribution will be commensurate with the College resources used to establish, maintain, and exploit such patent or invention. Subject to final determination of net distribution as discussed above, Net Adjusted Income shall be distributed to persons other than Benedict College as follows:

- 30% to the employee-inventor,
- 10% to the Department(s) that supported the creation of the patent or invention,
- 10 % to support the inventor's research group.

In the case of co-inventors, the percentage share allocated to the inventor as listed above shall be subdivided equally among the co-inventors, or as otherwise determined by Benedict College. In some cases, certain laws, regulations or provisions of grants or contracts may require that a lesser share be paid to the inventor, and Benedict College will honor such requirements.

### **Distribution of Net Adjusted Income will occur on an annual basis**

Equity Interest and Income Received From Exploitation of Certain Intellectual Property Benedict College, in licensing or otherwise exploiting patents or inventions, may elect to accept equity in lieu of cash payments, licensing fees, royalties, or other consideration. Benedict College may also incur the payment of commissions, other fees or charges and other expenses when such equity interests are disposed. All such expenses are considered development expenses to be subtracted from gross revenue in determining the Net Adjusted Income.

### **Trademarks**

Benedict College retains all rights to control the use of its name, trademarks (whether registered or unregistered), and other indicia of Benedict College. This reservation of rights includes use of the Benedict College name, trademarks, and other indicia that is on or in connection with materials not owned or created by Benedict College. Faculty, staff, students, and alumni may not use Benedict College's name, trademarks, and other College indicia in a way that would be likely to suggest sponsorship or endorsement by Benedict College, where none exists. Benedict College reserves the right to prohibit the use of its name, trademarks, and other College Indicia in its sole discretion.

### **Intellectual Property Disclosure, Evaluation, Protection and Commercialization**

The Office of Sponsored Programs and Research is responsible for protecting, marketing, negotiating and licensing of Intellectual Property at Benedict College. To protect the interests of the Creator and Benedict College, all creation of Intellectual Property in which Benedict College or a third party sponsor may have an ownership interest must be disclosed timely. Therefore, before notifying outside parties (including sponsors) and for any Intellectual Property in which Benedict College or a sponsor may have an ownership interest, all Creators must submit a complete disclosure form in an approved format to the Office of Sponsored Programs and Research to ascertain if inventions, discoveries, works or other Intellectual Property have commercial value.

The Office of Sponsored Programs and Research will then determine how to protect, develop, market and/or commercialize Intellectual Property on behalf of Benedict College. The Office of Research and Sponsored Programs will provide a timely response to creators and may employ outside evaluators and other consultants to review the disclosure, as well as to assist in the licensing, commercialization and protection of the Intellectual Property.

### **Dispute Resolution**

Benedict College shall appoint an Intellectual Property Committee ("IPC") consisting of no fewer than three members with a Vice President or designee as the chairperson of the IPC. The IPC shall be responsible for the following:

- Review and recommend resolution on any Intellectual Property issues or disputes
- Decide upon appropriate disposition of Intellectual Property disclosures
- Resolve questions of Intellectual Property ownership
- Recommend expenditures associated with invention royalties
- Review and recommend changes in this Intellectual Property Rights Policy

If a Creator believes that the creation of Intellectual Property was made outside the general scope of his or her duties as an employee at Benedict College, or made without the Significant Use of Benedict College Facilities or Resources or the Significant Use of Benedict College Funds, and does not believe that the rights in the Intellectual Property vest in or must be assigned to Benedict College, the Creator shall, in the disclosure form, request that the IPC determine the respective rights of Benedict College and the Creator. In reviewing the request, the IPC evaluation of the request may be based upon criteria including:

- The circumstances under which the Intellectual Property was created and developed;
- Time overlap if any, between the Creator's official duties and when the Intellectual Property was created;
- Creator's scope of employment and job duties; and
- Procedures for patent application and Benedict College's involvement, if any.

### **Use of Third-Party Copyrighted Material**

Benedict College respects the valid intellectual property rights of third parties. Benedict College faculty, staff, and students shall not make reproductions, derivative works, public performances, distributions, or public displays of a work owned by a third party, unless the copyright holder has granted prior written

permission, the work is in the public domain, or the use of the work qualifies as "fair use" under the U.S. Copyright Act.

**NOTE:** *This document may be superseded by legal instruments pertaining to a specific Intellectual Property agreement between the Creator and the authorized representative of the College.*