

DEPAUL UNIVERSITY



Discovery and Copyright

Category: Academic Affairs - Operational

Responsible Department: Academic Affairs

Responsible Officer: Provost

Effective Date: 10/25/2010

Policy Summary

The DePaul University Discovery Policy and *The DePaul University Copyright Policy* that together comprise the *DePaul University Discovery and Copyright Policy* have been established to provide for an equitable allocation of responsibilities and rewards among authors, inventors and creators, their departments and the University, and any external organization that may have sponsored or financed relevant research, scholarly or creative activities at the University

Scope

This policy affects the following groups of the University:

- Full-Time Faculty
- Part-Time Faculty
- Deans

This policy affects all members of the above groups.

Policy

PREAMBLE

DePaul University has among its primary purposes: teaching; scholarship, research and creative activities; and public service. Patentable discoveries, copyrightable materials, and other marketable forms of discoveries and copyrights do result from the scholarship and research activities of DePaul's Faculty, Staff, and other employees.

The DePaul University Discovery Policy and *The DePaul University Copyright Policy* that together comprise the *DePaul University Discovery and Copyright Policy* have been established to provide for an equitable allocation of responsibilities and rewards among authors, inventors and creators, their departments and the University, and any external organization that may have sponsored or financed relevant research, scholarly, or creative activities at the University.

The policies have two main goals:

1. to formalize the traditional and customary practice at DePaul of allocating ownership of the rights in copyrights and discoveries to their respective Author(s) rather than the University;
2. to define precisely the circumstances of exceptions to this traditional allocation and
 - a) to set the parameters for division of any income between the University and the Author(s) in those circumstances and
 - b) to define the obligations both of Author(s) and the University in those circumstances.

In addition, these policies provide a framework and a mechanism by which Faculty, professional personnel and other employees may contract with DePaul for assistance in commercializing a discovery or copyright that they own, whether conceived during their time at DePaul or not. In these cases the University's share of any royalties will be distributed according to these policies.

In the case of unobligated discoveries or copyrights (see below) DePaul University also endorses the doctrine called moral rights that allows Author(s)/Creator(s)/Inventor(s) to safeguard their personal, as opposed to pecuniary, rights in their works. Essentially, the moral rights doctrine encompasses three major components: the right of disclosure, the right of attribution, and the right of integrity.

Underlying the right of disclosure is the idea that the Author(s)/ Creators)/Inventor(s), as the sole judge of when a work is ready for public dissemination, is the only one who can possess any rights in an uncompleted work. The right of attribution safeguards an author's/ creator's/inventor's right to compel recognition for his/her work and to prevent others from naming anyone else as the Author/Creator/Inventor. The right of integrity lies at the heart of the moral right doctrine, as it prohibits any alterations of an Author's/Creator's/Inventor's work that will destroy the spirit and character of the Author's/Creator's/Inventor's work.

In the case of obligated discoveries or copyrights (see below) the right of attribution is also endorsed. However, the rights of disclosure and of integrity are subject to reasonable limitations such as deadlines and the freedom of the University to make subsequent modifications of work done for hire. In the case of all obligated discoveries/copyrights the University retains the right to a royalty-free, perpetual and world-wide license for the *non-commercial* use of the discovery or copyright.

GENERAL CONDITIONS

RIGHT TO DISSEMINATE KNOWLEDGE

1. Right to Disseminate Knowledge

DePaul University, in accordance with its academic mission, places the highest value on the creation and dissemination of knowledge. In the area of research, scholarship or creative activities the freedom of Faculty to communicate, disclose or publish the results of one's work takes precedence over other values. The University will avoid entering into third party contracts which place unreasonable limits on this freedom, including placing the final decision as to what may be published in the hands of the third-party funder and excessively delaying the dissemination or publication of the results of research, scholarship or creative activities.

2. Scope of the Policies

These policies, as amended from time to time, shall be deemed to be part of the conditions of employment for every Faculty member of the University, all professional personnel of the

University, and all other employees of the University. These policies shall be widely publicized and made part of appropriate contracts, offering letters, and policy manuals.

3. Requirement to Execute Documents

Upon the University's request, all faculty and staff are required to execute promptly all legal documents necessary to invest in the University, or its assignees, any or all rights to carry out the provisions of this policy.

4. Use of University Name

The use of DePaul University's name in connection with any Obligated Discovery or copyright or the marketing thereof shall be subject to the Provost's approval, as well as the University policies entitled "University Logos and Signature" and "Trademarks and Licensing."

5. Administration

The Office of Sponsored Programs and Research will serve as the central administrative office to receive inquiries, disclosures, and other discovery and copyright documents. The Faculty Council Research Committee shall review all discovery and copyright inquiries, disclosures, and applications submitted by faculty and staff.

6. Variations from these Policies

Copyright or Discovery ownership may be changed from that established by this policy, provided that the University and the Author(s) sign a written contract establishing the change. The Author(s) may initiate this process by consulting his or her immediate supervisor.

7. Assignment

This policy does not preclude the author(s) of an Unobligated Copyright or Discovery from assigning any or all of his or her rights in such materials to the University. Similarly, to the extent permitted by law, this policy does not preclude the University from assigning any or all of its rights in an Obligated Copyright or Discovery to the Author(s). Finally, it does not preclude the author(s) of an Unobligated Copyright or Discovery from assigning any ownership rights to another party.

8. Use of University Resources

Use of University resources in the creation of Discoveries or Copyrightable Materials is normally appropriate.

Use of shared facilities, however, should not result in significant cost for the university or diminish, distract from, or interfere with normal University activities. If the use becomes significant, or the resources being used, the issue may be brought to the Faculty Council Research Committee for review. In all cases, the Provost has the final decision concerning the continued use of shared facilities.

The Faculty Council Research Committee will review the use of university resources to determine one of the three following decisions:

1. The work may continue as begun and university resources will continue to be provided to support the completion of the work.
2. The work may continue as begun, but a written contract will be provided to describe the appropriate use of university resources.

3. The work must be discontinued and no further use may be made of university resources for that project.

9. Responsibility of Author(s) of Copyrightable Material

Faculty, professional personnel and other employees of the University who create Copyrightable Materials warrant that the material they create is original and that no material copyrighted by others has been or will be knowingly included in the material they create unless:

- 1) the use of the material copyrighted by others constitutes "fair use" within the meaning *of* the United States Copyright Act; or
- 2) the written consent of the copyright owner of such material has been obtained.

POLICIES

A. DISCOVERY POLICY

1. Purpose

Research, scholarship, and creative activity are an integral part of DePaul University. This concept is clearly delineated in the policies of the University. These activities often result in improved or new devices, product designs, or processes or other discoveries or material that may be patentable. Just as DePaul recognizes its responsibility to encourage research among its Faculty, professional personnel and other employees, it also recognizes its responsibility to protect the interests of individuals, the interests of the University, and those of the general public in all matters pertaining to the dissemination of knowledge and creative work for the public good through open communication and publication.

2. General Policy

2.1 Unobligated Discoveries

These are Discoveries by those defined herein as faculty that are NOT covered by a third-party funding agreement or by a specific written work assignment. Discoveries or Copyrights resulting from Faculty research or scholarship are normally Unobligated Discoveries.

The traditional practice of the University has been that, to the extent permitted by law and in the absence of contractual provisions obligating the transfer of all or some proprietary rights in a discovery to a third party, faculty retain ownership of, and have the right to any income derived from, discoveries and copyrights that they conceived and/or developed. This policy continues unchanged.

Discoveries that result from the work of Staff performed outside of University time that, while using knowledge and skills developed while working for the University, do not build upon, complete, extend or replicate projects that are assigned as part of the Staff member's position ARE considered as Unobligated Discoveries.

2.2 Obligated Discoveries -- the exception

These are Discoveries in which (a) either a third-party funding agreement exists that defines the disposition of discoveries/copyrights and/or income from them or b) that in the case of Faculty resulted from a written work agreement (work for hire) or c) work performed in accordance with the requirements of the position of those defined as Staff. Under the first condition, the rights to the discovery shall be assigned either to the university or to a third party as provided for in the funding agreement. Under the second condition, the rights to the discovery shall belong to the University per

the terms of the written work agreement. Under the third condition, the rights to the discovery shall be assigned to the University unless there is a prior written agreement to the contrary. Any income derived from Obligated Discoveries that have been assigned to the University shall be distributed as stated in this policy.

Discoveries that result from research or scholarship of those defined herein as Faculty and were not specifically covered by a separate contract with the University are NOT considered Obligated Discoveries. Discoveries created by a Staff person as part of the performance of his or her position even when they are subsequently used by that person when acting in his or her capacity as a part-time Faculty person ARE considered as Obligated Discoveries.

2.2.a Examples of Exceptions

i. Third-Party Contracts

Much of University research and other scholarly activity is funded by outside parties through formal grants and funding agreements to the University, with various external agencies constituting the major research funding source. DePaul University is the legal recipient of all grants and funding agreements that are accepted in the name of the University by its Authorized Institutional Representative on behalf of faculty and staff. As such, the University has the legal responsibility for complying with all such contractual obligations. Consequently, when a discovery is generated on the basis of external funding, it is necessary that the designated University authorities review such discovery and make determinations in regard to patent rights as set forth by those funding sources that contributed to the making of that discovery.

When a discovery results from federal government funded research, the university shall have a right of first refusal to take title to the discovery pursuant to the Bayh-Dole Act (35 U.S.C. 200-212, 37 C.F.R. 401). Faculty and Staff conducting such research must submit a Discovery/Copyright Disclosure Agreement to the Faculty Council Research Committee in a timely manner. The Faculty Council Research Committee shall review each disclosure and make recommendations to the Provost as to whether the university should take title and pursue commercialization of the discovery. The Provost shall make the final determination. Should the university elect not to take title to the discovery it will either (a) assign all rights to the discovery to the federal government, or (b) petition the federal funding agency to transfer title to the inventor, if the inventor so wishes.

ii. Work Made for Hire

When a Staff person is required to develop a Discovery as a part of the performance of his or her position or a Faculty member working under a written agreement with the University, that discovery shall be owned by the University. Any royalties received by the University for that discovery shall be shared with the employee as described later in these policies.

Sections 3 and 4 have been moved to the procedures section

5. Income from Obligated Discoveries

5.1 Assignment of Rights to Income

It is a policy of DePaul University that the Author(s) share in any proceeds derived from any Obligated Discovery, even though it arises from a University-administered program of research or from work for hire by an employee. In arranging for the development of an Obligated Discovery, the University will protect the rights of the Author(s) to share in income derived from the Obligated Discovery. If the Obligated Discovery was made by more than one individual, the University will

make disbursement of income in proportionate share as those sharing in the income may agree upon. If there is no written agreement on the proportions, royalty Income shall be divided equally among identified Author(s).

5.2 Disbursement of Income

If the University receives income as a result of an agreement for the sale or licensing of information or rights concerning an Obligated Discovery, including any patents or copyrights relating thereto, the University shall disburse a share of this income to the Author(s) according to the following schedule after the University covers its costs incurred in obtaining or maintaining patent, copyright or other like protection, unless a different written agreement regarding disbursement exists. All disbursed amounts are to be considered as referring to the cumulative total income. These amounts shall be reviewed every three years.

5.2. a up to and including the first \$5,000 of income earned shall be paid to the Author(s):

5.2. b any income of \$5,001 or more divided with no less than 50% to the Author(s) and the remainder divided evenly between the Office of Academic Affairs of the University and the originating University department of the Author(s);

5.2. c This policy for sharing income for obligated discoveries does not apply to tuition generating courses or course modules delivered in a distance learning format by DePaul University. Payment for providing such courses will be worked out by the dean of the college and the faculty involved in the distance learning projects and formulated in specific work agreements.

Any commercial licensing or sale by DePaul University with permission of the authors of courses or course modules to an external party would be subject to the payment policies detailed in 5.2a and b. The remaining stipulations in the Discovery and Copyright Policy regarding the ownership of educational materials produced for distance learning programs are unchanged.

5.3 Frequency of Payments

To avoid the necessity of paying out frequent very small checks, the following mechanism will be employed. Income shares shall be posted upon receipt. In the event that such an account accrues a balance of \$500, the account shall be paid out within sixty (60) days, but in any event, every account will be paid out at least once each fiscal year.

5.4 Extraordinary Expenses

The University may incur extraordinary expenses in some instances, which could among other possibilities include the expenses of:

- further developing a concept in order that it be reduced to practice;
- enhancing the marketability of the Proprietary Information for licensing;
- establishing a pilot plant project;
- engaging external legal counsel to draft and file a patent application; or
- enforcing or defending its patents or proprietary rights against infringers.

In those extraordinary instances, before distributing any of the aforesaid royalty Income as set forth in Section 5.3 with the Author(s), the University will reimburse itself for out of pocket expenses incurred. These extraordinary expenses will be credited against any Royalty Income received by the University. If such royalty Income in any given year does not cover all extraordinary expenses, then

any remaining balance of extraordinary expenses will be carried forward to succeeding years until credited in full. However, such extraordinary expenses shall not be charged against royalty Income disbursed in prior years.

6. Use of Outside Patent and Marketing Assistance

The University shall have the right to enter into exclusive or non-exclusive agreements with lawyers and individuals or organizations specializing in patenting and marketing assistance to universities.

7. Interpretation of Policy

Interpretations of this Discovery Policy that cannot be resolved between the Faculty Council Research Committee and the Author(s) shall be referred to the Provost for final determination.

8. Dispute Resolution

Disputes on discovery matters that cannot be resolved between the Faculty Council Research Committee and the Author(s) shall be referred to the Provost, who may use a number of mechanisms which rely solely on members of the University community to resolve them. The mechanisms may include, but are not limited to: informal review, mediation, and arbitration. Appeals from the determination of the Provost may be made by any interested party to the President, whose decision shall be final.

9. Amendment to the Policy

This policy may be amended subject to the approval of the Faculty Council, Staff Council, Faculty Council Research Committee, the Provost, and the President.

POLICIES

B. COPYRIGHT POLICY

1. Purpose

Research, scholarship, and creative activity are an integral part of DePaul University. This concept is clearly delineated in the policies of the University. In conducting these activities, copyrightable materials often are produced. DePaul encourages the creation of copyrightable materials by its Faculty, professional personnel, Staff, and other employees. The University is committed to the dissemination of knowledge and creative work for the public good through open communication and publication.

2. General Policy

2.1 Unobligated Copyrights

These are Copyrights by those defined herein as Faculty that are NOT covered by a third-party contract or by a specific written work assignment. Discoveries or Copyrights resulting from Faculty research or scholarship are normally Unobligated Copyrights.

Where no separate contract exists, the traditional practice of the University has been that in the absence of contractual provisions, Faculty retain ownership of; and have the right to any income derived from, copyrightable works that they conceived and/or developed. This policy continues unchanged.

Scholarly production, lecture notes, videos produced for teaching, and all course materials produced by Faculty, including distance education courses and materials, ARE considered to be either

unobligated copyrightable material or unobligated discoveries unless specifically stated otherwise in a contract signed by the author.

Copyrights that result from the work of Staff performed outside of University time that, while using knowledge and skills developed while working for the University, do not build upon, complete, extend or replicate projects that are assigned as part of the Staff member's position ARE considered as Unobligated Copyrights.

2.2 Obligated Copyrights -- the exception

These are Copyrights in which (a) either a third-party contract exists that defines the disposition of discoveries/copyrights and/or income from them or b) that in the case of Faculty resulted from a written work agreement (work for hire) or c) work performed in accordance with the requirements of the position of those defined as Staff. Copyrights that result from research or scholarship of those defined herein as Faculty and were not specifically covered by a separate contract with the University are NOT considered Obligated Copyrights.

Under the first condition, the copyright shall be assigned either to the University or to a third party as provided for in the funding agreement. Under the second condition, the copyright shall belong to the University per the terms of the written work agreement. Under the third condition, the copyright shall be assigned to the University unless there is a prior written agreement to the contrary. Any income derived from such assignments, however, shall be shared with the Author(s), as stated in this policy (Section 5.1-5.4).

Copyrightable material created by a Staff person as part of the performance of his or her positions even when they are subsequently used by that person when acting in his or her capacity as a part-time Faculty person ARE considered as Obligated Copyrights.

2.2. a Examples of Exceptions

i. Third-Party Contracts

Much of University research and other scholarly activity is funded by outside parties through formal grants and funding agreements, with various external agencies constituting the major research funding source. DePaul University is the legal recipient of all grants and contracts that are accepted for the University by its Authorized Institutional Representative on behalf of Faculty and Staff, and, as such, has the legal responsibility for complying with all contractual obligations.

Consequently, when Copyrightable Material is generated on the basis of external funding, it is necessary that the designated University authorities review and make determinations in regard to rights as set forth by those funding sources that contributed to the making of that material.

To insure that all obligations attaching to third-party contracts and grants will be met, Faculty and Staff who participate in programs having external support are required to complete a Discovery and Copyright Disclosure agreement that recognizes those obligations. The University retains the right to modify this Discovery or Copyright Disclosure agreement as necessary.

ii. Work Made for Hire

When a Staff person is required to develop Copyrightable Material as a part of the performance of his or her position or a Faculty member working under a written agreement with the University, that material shall be owned by the University. Any royalties received by the University for that material shall be shared with the employee as described in these policies (Sections 5.1-5.4).

Sections 3 and 4 have been moved to the procedures section

5. Income from Copyrights

5.1 Assignment of Rights to Income

It is a policy of DePaul University that the Author(s) share in any proceeds derived from any Obligated Copyright, even though it arises from a University-administered program of research or from work for hire by an employee. In arranging for the development of an Obligated Copyright, the University will protect the rights of the Author(s) to share in income derived from the copyright. If the Obligated Copyrightable Material was produced by more than one individual, disbursement of income will be made by the University in proportionate share as those sharing in the income may agree upon. If there is no written agreement on the proportions, royalty Income shall be divided equally among identified Author(s).

5.2 Disbursement of Income

If the University receives income as a result of an agreement for the sale or licensing of information or rights concerning a copyright, the University shall disburse a share of this income to the Author(s) according to the following schedule after set off by the University for costs incurred in obtaining or maintaining copyright protection. All disbursed amounts are to be considered as referring to the cumulative total income. These amounts shall be reviewed every three years and adjusted for an inflation index.

5.2.a up to and including the first \$5,000 of income earned shall be paid to the Author(s):

5.2.b any income \$5,001 or more shall be divided with no less than 50% to the Author(s) and the remainder evenly divided between the Office of Academic Affairs and the University department of the original Author(s).

5.2. c This policy for sharing income for obligated copyrights does not apply to tuition generating courses or course modules delivered in a distance learning format by DePaul University. Payment for providing such courses will be worked out by the dean of the college and the faculty involved in the distance learning projects and formulated in specific work agreements. All distance learning work agreements are subject to the approval of the Provost.

The Provost agrees to report to Faculty Council annually on the working agreements entered into by faculty and deans, indicating the number of them, their general character, and the number of quarter hours that they generate, so that Faculty Council can reconsider from time to time the University's Discovery and Copyright Policy.

Any commercial licensing or sale by DePaul University with permission of the authors of courses or course modules to an external party would be subject to the payment policies detailed in 5.2a and b. The remaining stipulations in the Discovery and Copyright Policy regarding the ownership of educational materials produced for distance learning programs are unchanged.

5.3 Frequency of Payments

To avoid the necessity of paying out frequent very small checks, the following mechanism will be employed. Income shares shall be posted upon receipt. In the event that such an account accrues a

balance of \$500 the account shall be paid out within sixty (60) days, but in any event, every account will be paid out at least once each fiscal year.

5.4 Extraordinary Expenses

The University may incur extraordinary expenses in some instances, which could among other possibilities include the expenses of
further developing a concept;
enhancing the marketability of the concept for licensing; or
enforcing or defending its rights against infringers.

In those extraordinary instances, before distributing any of the aforesaid royalty Income with the Author(s), the University will reimburse itself for out of pocket expenses incurred (for example, legal fees and other expenses). These extraordinary expenses will be credited against any royalty Income received by the University. If such royalty Income in any given year does not cover all extraordinary expenses, then any remaining balance of extraordinary expenses will be carried forward to succeeding years until credited in full. However, such extraordinary expenses shall not be charged against royalty income disbursed in prior years.

6. Use of Outside Marketing Assistance

The University shall have the right to enter into exclusive or non-exclusive agreements with lawyers and individuals or organizations specializing in copyrighting and marketing assistance to universities.

7. Interpretation of Policy

Interpretations of this Copyright Policy that cannot be resolved between the Faculty Council Research Committee and the Author(s) shall be referred to the Provost for final determination.

8. Dispute Resolution

Disputes on copyright matters that cannot be resolved between the Faculty Council Research Committee and the Author(s) shall be referred to the Provost, who may use a number of mechanisms which rely solely on members of the University community to resolve them. The mechanisms may include, but are not limited to: informal review, mediation, and arbitration. Appeals from the determination of the Provost may be made by any interested party to the President, whose decision shall be final.

9. Amendment to the Policy

This policy may be amended subject to the approval of the Faculty Council, Staff Council, the Faculty Council Research Committee, the Provost, and the President.

Procedures

A. DISCOVERY POLICY

3. Responsibilities of the Author(s)

3.1 To Submit Obligated Discoveries for examination by the University

Unless contractual obligations limit publication or disclosure, Faculty may elect to publish or disclose any discovery without submitting the Obligated Discovery for examination by the University. The University shall have the right to examine all Obligated Discoveries that may be conceived or developed by Faculty, professional personnel or other employees, either solely or

jointly with others, during the course of their activities at or on behalf of DePaul and/or through the use of the facilities and/or equipment of the University, whether made during usual working hours or otherwise. Ownership of such Obligated Discoveries is governed by the terms of this policy.

The University has several reasons for requiring disclosure of Obligated Discoveries. The University will need to consider whether it should take or recommend steps to protect the rights of the owner and creator of the Obligated Discovery. In addition, in the case of federally supported research, the University must disclose each subject discovery to the appropriate federal agency within two months after the Author(s) discloses it in writing to University personnel responsible for patent matters. Therefore, the Author shall disclose the existence of the work in writing to the University's Office of Sponsored Programs and Research or other appropriate office designated by the Provost.

In order to secure broad patent protection, it is prudent for the Author(s) to file an application as soon as the discovery can be documented adequately. Publication or disclosure of the nature of a discovery to any third party before filing a patent application results in the loss of foreign patent rights. Thus, it is necessary that Author(s) working under any third party contract, work assignment or written agreements follow the terms of the agreement regarding informing the University as soon as possible after creating a potentially useful discovery.

The written Discovery and Copyright Disclosure Form should be filled out and forwarded to the Office of Sponsored Programs and Research as soon as practical, but no later than thirty (30) calendar days after the discovery is recognized.

4. Obligations and Responsibilities of the University Regarding Obligated Discoveries and Copyrights

4.1 To review disclosures expeditiously

Within sixty (60) days after the receipt of the written Discovery and Copyright Disclosure Form, the Faculty Council Research Committee, with the recommendations of the Office of Sponsored Programs and Research, will review the Discovery and Copyright Disclosure Form to determine whether the Author(s) has any obligation to assign rights to such discoveries to any third party. In particular, the Office of Sponsored Programs and Research will be expected to judge the relation of the related discovery to the purpose of any grant or contract that may be involved.

On the advice of the Office of Sponsored Programs and Research, the Faculty Council Research Committee will refer the discovery, with their recommendation as to the status of property under this policy, and recommended options for disposition and/or commercialization of the discovery to the Provost for review. Within sixty (60) days after receipt of the Discovery and Copyright Disclosure Form, the Provost may make one of the following determinations:

4.1. a University Has No Rights to the Discovery

Inform the Author(s) that, under this policy, the University has no rights in the discovery. The Author(s) is to be provided with a description of his/her options (see below).

- i.** Under his/her own initiative and resources, seek to patent or otherwise protect and/or commercialize the discovery.
- ii.** Put the discovery in the public domain. This may be achieved by publishing findings and taking no legal action. In the United States, if a patent application has not been filed on a discovery within

one year after such publication, the discovery is considered to be in the public domain, and there is then a statutory bar against obtaining a patent on the discovery. Foreign patent protection is generally available only if a U.S. or foreign application has been filed before publication or other public disclosure of discovery. The Author(s) will be informed that this course of action rarely results in commercialization of a discovery.

iii. Negotiate with the University university regarding a contractual agreement to proceed jointly towards commercialization. In this situation, the Faculty Council Research Committee will thoroughly examine the discovery using outside expertise as appropriate, and will recommend options for action to the Provost. These options may include:

iii. a Inform the Author(s) that the University does not wish to participate in the commercialization of the discovery.

iii. b Offer contract terms to the Author(s) regarding University assistance in commercialization of the discovery. Such a contract shall require that the Author(s) assign the rights in the discovery to the University for that period of the contract. Once a contract is negotiated and signed by all appropriate parties, the University thereafter shall exercise efforts that it believes to be reasonable in the circumstances to bring the discovery quickly and effectively into public use.

4.1. b University Has Rights to the Discovery

Instruct the Faculty Council Research Committee that the University has rights regarding the Discovery and to recommend action to the committee that shall be governed by the pertinent contract but may include the following options among others.

i. The University shall accept assignment of the Discovery under these policies, and thereafter exercise efforts which it believes to be reasonable in the circumstances to bring the Discovery quickly and effectively into public use.

ii. The University shall assign the Discovery to the Sponsoring Agency (third party) to dispose of as it sees fit.

Although the Author(s) may make recommendations regarding the University's course of action, the final decision under this policy will be made by the Provost.

4.2 Royalty-free Use

In the case of Obligated Discoveries the University retains the right to a royalty free, perpetual, world-wide license for the noncommercial use of the Discovery.

B. COPYRIGHT POLICY

3. Responsibilities of the Authors)/Creator(s)

3.1 To Submit Copyrightable Materials for examination by the University

Unless contractual obligations limit publication or disclosure, Faculty may elect to publish or disclose any copyrightable material without submitting the Obligated Copyrightable Material for examination by the University. The copyright laws in the United States protect a work from the moment it is created. In other words, once Obligated Copyrightable Material is put into a tangible

form, written down, drawn, sculpted, videotaped, etc., no one is allowed to use or copy it unless the owner grants permission.

Whenever an employee of the University creates copyrightable materials that are, or may be, owned by the University or a third party under Section 2.2 of this policy, the employee or student shall disclose the existence of the material in writing to the University's Director of Sponsored Programs and Research. The written disclosure (Discovery and Copyright Disclosure Form) should be made as soon as practical after the Author knows the Obligated Copyrightable Material is to be created (e.g., written, drawn, videotaped, etc.). The written disclosure shall be made not more than thirty (30) calendar days after any significant portion of the Obligated Copyrightable Material has been created. The purpose of disclosure to the University is to allow the University to determine to whom the material belongs, and to provide protection appropriate to the owner, and Author where required.

The University shall have the right to examine all Obligated Copyrightable Material that may be conceived or developed by Faculty, professional personnel, or other employees, either solely or jointly with others, during the course of their employment and/or through the use of the facilities and/or equipment of the University, whether made during usual working hours or otherwise. Ownership of such material is governed by the terms of this policy.

4. Obligations and Responsibilities of the University Regarding Obligated Copyrights

4.1 To review disclosures expeditiously

Within sixty (60) days after the receipt of the Discovery and Copyright Disclosure Form, the Faculty Council Research Committee, with the recommendations of the Office of Sponsored Programs and Research, will review the Discovery and Copyright Disclosure Form to determine whether the Author(s) has any obligation to assign rights to such material to any third party. In particular, the Office of Sponsored Programs and Research will be expected to judge the relation of the related material to the purpose of any third-party grant or contract that may be involved.

On the advice of the Office of Sponsored Programs and Research, the Faculty Council Research Committee will refer the material disclosure, with their recommendation as to the status of property under this policy, and recommended options for disposition and/or commercialization of the material to the Provost for review. The Provost has the ultimate responsibility for determining if a contractual obligation does exist that defines the University's responsibilities regarding the material, and, if so, to ensure that such obligations are fully met.

Within sixty (60) days after receipt of the written disclosure, the Provost may make one of the following determinations:

4.1. a University Has No Rights

Inform the Author(s) that, under this policy, the University has no rights in the discovery. The Author(s) shall be informed that they are free to:

- i.** Assign, license, sell, or otherwise transfer or use any of his or her rights in the materials on such terms as the Author(s) believes to be beneficial to him or her.

ii. Negotiate with the University regarding a contractual agreement to proceed jointly towards commercialization. In this situation, the Faculty Council Research Committee will thoroughly examine the case using outside expertise as appropriate, and will recommend options for action to the Provost. These options may include:

ii. a Inform the Author(s) that the University does not wish to participate in the commercialization of the material.

ii. b Offer contract terms to the Author(s) regarding assistance in commercialization of the copyright. Such a contract shall require that the Author(s) assign the rights in the copyright to the University for that period of the contract. Once a contract is negotiated and signed by all appropriate parties, the University thereafter shall exercise efforts that it believes to be reasonable in the circumstances to bring the Copyrightable Material quickly and effectively into public use.

4.1. b University Has Rights

Instruct the Faculty Council Research Committee that the University has rights regarding the copyright and to recommend action to the committee that shall be governed by the pertinent contract. Although the Author(s) may make recommendations regarding the University's course of action, the final decision under this policy will be made by the Provost. The options open to the University include the following, among others:

i. The University shall accept assignment of the copyright under these policies, and thereafter determine whether or not to register its copyright ownership with the United States Copyright Office and/or to take other appropriate action to protect its interests in the material.

ii. The University shall determine the manner in which the material is to be distributed or used by others, if at all, and the charges, if any, to be imposed for such distribution or use.

iii. The University may assign the copyright to the Sponsoring Agency to dispose of as it sees fit.

4.2 Royalty-free Use

In the case of Copyrights (and copyrightable material) the University retains the right to a royalty-free, perpetual, world-wide license for the noncommercial use of the copyright (and copyrightable material).

Divisional Collaborations

University Research Council
Faculty Council
Office of the Provost
Academic Affairs
Office of the General Counsel

Contact Information

None.

Appendices

DEFINITIONS

Author(s)/Creator(s)/Inventor(s)

A person who produces a copyrightable work or creates a Discovery in any form. A copyrightable work or Discovery may have more than one Author/Creator/Inventor. Hereafter referred to as Author(s).

Copyright

The bundle of rights described in the United States Copyrights Act; generally, the exclusive rights with respect to a work to reproduce it, distribute it to the public (by sale, rental or other method), publicly display it, revise, prepare a derivative work or public performance based upon it, or authorize another to perform any of these actions.

Copyrightable

Containing enough original authorship to be the subject matter of a copyright.

Copyrightable Material

Anything in which, under the United States Copyright Act, copyright production subsists: including, but not necessarily limited to, written work, lectures and other written works prepared for oral delivery, musical and dramatic works, motion pictures, photographs, drawings, and other pictorial representations, sound recordings, computer programs, instructions, and other software. At the current time, the usual copyright protection does not extend to ideas, procedures, processes, systems, methods of operations, concepts, or principles.

Discovery(ies)

All potentially, licensable proprietary information including but not limited to inventions, discoveries, device-like computer programs, algorithms, processes, machines, methods, uses; manufactured compositions of matter, plants or designs, whether or not patented or patentable at any time under the United States Patent Act as now existing or hereafter amended.

Employees Covered by Collective Bargaining Agreements

Employees who work in budgeted positions as part of a group of workers whose employment is governed by a collective bargaining agreement.

Faculty

Those who are herein defined as Faculty include: Full-time Faculty and Part-time Faculty

Full-time Faculty

The President, the Executive Vice President for Academic Affairs, college deans, professors, associate professors, assistant professors, clinical Faculty on long-term contracts, and instructors constitute the regular full-time Faculty. Hereafter referred to as Faculty.

Part-time Faculty

An employee who has received an appointment to teach for one academic term without a formal contract. These persons are considered by this policy as Faculty in their performance of those activities directly related to the preparation and delivery of a course or courses. Hereafter referred to as Faculty.

Intellectual Property

Concepts, inventions, discoveries, processes, works of authorship that are protectable under patent, copyright, trademark or trade secret law. Owners and holders of intellectual property rights are protected by law against unauthorized use by another person.

License

A legal agreement or contract right granted by the owner of intellectual property that gives another permission to utilize that property in specifically defined or limited ways under mutually agreed terms.

Obligated Discoveries/Copyrights

These are Discoveries or Copyrights in which (a) either a third-party contract exists that defines the disposition of discoveries/ copyrights and/ or income from them or b) that in the case of Faculty resulted from a written work agreement (work for hire) or c) work performed in accordance with the requirements of the position of those defined as Staff. Discoveries or Copyrights that result from research or scholarship of those defined herein as Faculty and were not specifically covered by a separate contract with the University are NOT considered Obligated Discoveries/ Copyrights. In the case of Obligated Discoveries/Copyrights Faculty have an unrestricted right to publish and disclose their discoveries unless this right is restricted by the terms of the contract or written agreement. Discoveries or copyrights created by a Staff person as part of the performance of his or her position even when they are subsequently used by that person when acting in his or her capacity as a part-time Faculty person ARE considered as Obligated Discoveries/ Copyrights.

Patent

A grant of a right to exclude others from the making, using, or selling of an invention during a specified time in a specific jurisdiction. Under the United States Patent Act the subject matter of a patent can be any new and useful process, machine, manufacture or composition of matter, or a new and useful improvement thereof. The subject matter of a patent can also include distinct and new plant varieties and distinct and new animal species.

Patentability

In general the Patent Act requires that in order to be patentable an invention: 1) has to have utility or usefulness (35 USCA 101). 2) must possess novelty with relation to "prior art" (35 USCA 102 (a)-(b)) meaning that somebody skilled in the art would not see it as an obvious extension of the art that did not

require new advances in the art to produce; and 3) must be non-obvious (35 USCA 103). In addition, the listed Authors must include all Authors: that is, everyone who contributed something original to the concept or the reduction to practice of the discovery. Omissions of Authors or additions of individuals who did not really contribute for whatever reason can potentially invalidate the patent.

Proprietary Information

Secret or confidential information or knowledge possessed by a limited number of people. This includes trade secrets and "know how."

Royalty

A share of the product or of the proceeds therefrom reserved by an owner for permitting another to exploit and use his or her property. For the purposes of this policy, Royalty shall be deemed to include all fees, royalties, and other income derived from the marketing of discoveries or copyrights and other income derived from the marketing of discoveries or copyrights after all expenses have been met.

Staff

Those who are herein defined as Staff include: Full-Time Exempt Staff, Full-Time Non- Exempt Staff, Part-time Staff and Student Employees.

Full-time Exempt (Professional) Staff

Those employees scheduled to work on an ongoing basis. Due to the nature of their job responsibilities, these employees are excluded from overtime pay. These persons hereafter will be referred to as Staff.

Full-time Non-exempt Staff

Those employees scheduled to work 35 hours or more on an ongoing basis. These employees are eligible for overtime pay. These persons hereafter will be referred to as Staff.

Part-time Staff

Those employees scheduled to work less than 35 hours per week on an ongoing basis. These employees are eligible for overtime pay. These persons hereafter will be referred to as Staff.

Student Employees

Hourly employees attending DePaul University, (enrolled for a minimum of eight graduate credit hours, nine credit hours undergraduate or six semester hours), who work in a budgeted position 25 hours per week or less on a regular or periodic basis. These persons hereafter will be referred to as Staff.

Temporary Employees

Employees scheduled to work less than six months in a full-time or part-time position. Temporary employees may be classified as exempt or non-exempt, depending on the job responsibilities. Employees hired through a temporary employment agency for a specific assignment are employees of the respective agency and not of the

University. The creations of these employees as part of temporary employment are always considered Obligated Discoveries/Copyrights. These employees are NOT considered Staff and do not share in the rights specified in this document.

Third-Party Contract

A written agreement between the University and an external entity (organization or individual) that defines the scope of work to be performed by DePaul Faculty member(s), Staff member(s) and/or student(s), the budget, and the expected outcomes. The ownership of rights in inventions or discoveries will be governed by the terms of the agreement in question. Individual written agreements between individual Faculty or Staff members and an external organization or entity (for example, book contracts, individual consulting agreements, speaker's honoraria) are not considered third-party contracts and are not covered by these policies.

Unobligated Discoveries/Copyrights

These are Discoveries or Copyrights by those defined herein as Faculty that are NOT covered by a third-party contract or by a specific written work assignment. Discoveries or Copyrights resulting from Faculty research or scholarship are normally Unobligated Discoveries/Copyrights. Discoveries or Copyrights that result from the work of Staff performed outside of University time that, while using knowledge and skills developed while working for the University, do not build upon, complete, extend or replicate projects that are assigned as part of the Staff member's position ARE considered as Unobligated Discoveries/Copyrights.

Work Made for Hire

Discoveries or Copyrightable Material prepared by a Staff person within the scope of his or her employment, or certain types of specially ordered or commissioned works if the parties concerned have expressly agreed in a signed written contract that the work should be a "work made for hire." Discoveries/Copyrightable Material produced by a Faculty member is expressly deemed NOT to be a "work made for hire" unless otherwise explicitly and specifically provided in a written contract with the University.

GENERAL CONDITIONS

RIGHT TO DISSEMINATE KNOWLEDGE

1. Right to Disseminate Knowledge

DePaul University in accordance with its academic mission places the highest value on the creation and dissemination of knowledge. In the area of research, scholarship or creative activities the freedom of Faculty to communicate, disclose or publish the results of one's work takes precedence over other values. In all but exceptional cases the university will avoid entering into third-party contracts which place unreasonable limits on this freedom including placing the final decision as to what may be published in the hands of the third-party funder and excessively delaying the dissemination or publication of the results of research, scholarship or creative activities.

2. Scope of the Policies

These policies, as amended from time to time, shall be deemed to be part of the conditions of employment for every Faculty member of the university, all professional personnel of the

university, and all other employees of the university. These policies shall be widely publicized and made part of appropriate contracts, offering letters and policy manuals.

3. Requirement to Execute Documents

All university Faculty, professional personnel and other employees are required to execute promptly all legal documents necessary to invest in the university, or its assignees, any or all rights to carry out the provisions of this policy.

4. Use of University Name

In no case shall the name of DePaul University be used in connection with any Obligated Discovery or copyright or the marketing thereof without the prior express written permission of the Provost.

5. Administration

The Office of Sponsored Programs and Research will serve as the central administrative office to receive inquiries, disclosures and other discovery and copyright documents. The Faculty Council Research Committee shall review all discovery and copyright inquiries, disclosures, and applications submitted by university Faculty and *Staff*.

6. Variations from these Policies

Copyright or Discovery ownership may be changed from that established by this policy, provided that the university and the Author(s) sign a written contract establishing the change. Such contracts may be signed by the Provost or by such person or persons as the Provost may designate from time to time in writing. The Author(s) may initiate this process by consulting his or her immediate supervisor.

7. Assignment

This policy does not preclude any author(s) of an Unobligated Copyright or Discovery from assigning any or all of his or her rights in such materials to the University. Similarly, this policy does not preclude the University from assigning any or all of its rights in an Obligated Copyright or Discovery to the Author(s). Finally, it does not preclude the author(s) of an Unobligated Copyright or Discovery from assigning any ownership rights to another party.

8. Use of University Resources

Use of university resources in the creation of Discoveries or Copyrightable Materials is normally appropriate.

Use of shared facilities, however, should not be excessive or interfere with normal university activities. If the use becomes significant, or the resources being used, the issue may be brought to the Faculty Council Research Committee for review. In all cases, the Provost has the final decision concerning the continued use of shared facilities.

The Faculty Council Research Committee will review the use of university resources to determine one of the three following decisions:

1. The work may continue as begun and university resources will continue to be provided to support the completion of the work.
2. The work may continue as begun, but a written contract will be provided to describe the appropriate use of university resources.
3. The work must be discontinued and no further use may be made of university resources for that project.

9. Responsibility of Author(s) of Copyrightable Material

Faculty, professional personnel and other employees of the university who create Copyrightable Materials warrant that the material they create is original and that no material copyrighted by others has been or will be knowingly included in the material they create unless:

- 1) the use of the material copyrighted by others constitutes "fair use" within the meaning of the United States Copyright Act; or
- 2) the written consent of the copyright owner of such material has been obtained.

History/Revisions

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Next Review Date: N/A