

MARQUETTE UNIVERSITY INTELLECTUAL PROPERTY POLICY

I. Purpose

In the course of research, scholarship, education, and other activities, Marquette University faculty, staff, and students create patentable inventions, copyrightable works, and other forms of intellectual property that merit legal protection and have financial as well as scientific and scholarly value. As part of its mission, the University promotes the discovery and sharing of knowledge through the protection and licensing of intellectual property. The University is committed to timely assessment of options for legal protection and potential societal benefit of University intellectual property and to sharing equitably the rights and royalties resulting from intellectual property licensing.

The purpose of this policy is to define the rights and responsibilities of the University and its faculty, staff, and students with respect to the ownership and administration of intellectual property.

II. Covered Parties

This policy applies to all University employees, including regular and participating faculty, as defined in the Faculty Handbook (collectively, "**Faculty**"), staff, graduate and undergraduate students, and relates to all forms of intellectual property subject to legal protection in the United States and internationally.

III. Defined Terms

A. **Intellectual Property** means all forms of technology and expression whose ownership is subject to legal protection in the United States and internationally, including patents, copyrights, mask works, trademarks, trade dress, service marks, tangible research property, and rights in data, trade secrets and other proprietary information. Patentable discoveries and inventions may include any new and useful process, machine, article of manufacture, or composition of matter. Copyrightable works include written and graphic works, computer software, and photographic, video, and audio works. A mask work is a visual representation of a semiconductor chip. A trade or service mark is a word, name, symbol, or device used by an organization to identify its goods or services. Tangible research property includes matter such as biological materials, prototype devices, and engineering designs. Protectable data includes the recorded factual material as well as supporting materials such as experimental protocols and code written for statistical analyses commonly accepted in the scientific community as necessary to validate research findings.

B. **Inventor**: A member of the Marquette University Community who participates in the conception of a patentable invention. Multiple Inventors may be involved in a single invention.

C. **Author:** A member of the Marquette University Community who authors or co-authors a copyrightable work.

D. **Marquette University Community:** Faculty, staff, and students at Marquette University.

E. **Marquette University Resources:** Funds, space, equipment, Faculty, students, or facilities used to support research and scholarship, including direct funding such as gifts, contracts, grants, and University-allocated funds; laboratory space or shared research facilities; and supervision or employment, including student employment, on any such University-funded scholarship or research. Use of classroom resources and learning management systems, ordinary use of a University-provided office computer, support for educational program activities (e.g., for class projects), and library resources will not be deemed significant use of Marquette University Resources for the purposes of this Policy.

F. **OCEP:** The Office of Corporate Engagement and Partnerships or its successor office.

G. **Patent Review Committee:** A Patent Review Committee (“**PRC**”) will be maintained with, three (3) faculty members, two (2) representatives from OCEP a member of the Office of General Counsel and an ex-officio member from the Office of Research and Sponsored Programs. Non-faculty members will be appointed by the Vice President responsible for the department. Faculty members of the Committee will serve at the pleasure of the Provost, who will appoint the Committee chair. The normal term of appointment will be two years, which may be renewed.

H. **Vice President(s):** The individual(s) designated by the Provost to handle administrative responsibilities under this policy. Currently the Vice President for Corporate Engagement is designated for administrative responsibility for this policy (“**OCEP Vice President**”) and the Vice President of Research and Innovation is the designated to handle any appeals under this policy (“**Research Vice President**”).

IV. General Policy

A. Ownership

1. Intellectual Property created by Faculty or staff, or by students working on University research or other University projects, is owned by the University if it is created:

(a) within the scope of University employment, or

(b) under University grants and contracts with governmental entities or other third parties; or

(c) with significant use of Marquette University Resources.

2. If the Intellectual Property is created outside the scope of University employment and without any significant use of Marquette University Resources, the individual will own the intellectual property.

B. Application of Policy to Specific Circumstances

1. Ownership of an invention will be determined by reference to the date of invention and to principles of inventorship which, in turn, will be determined according to United States law.

2. Faculty Academic Works. The University recognizes and affirms the tradition in higher education that academic works are owned by the Faculty member authoring them rather than the employing educational institution. Accordingly, the University does not claim ownership to pedagogical, scholarly or artistic works, regardless of the form of expression, and these works are excluded from the scope of Section A.1 above, and such works are not considered "Works for Hire." Faculty ownership of academic works may, however, be affected by the terms of agreements with third-party sponsors or by agreements between Faculty and the University with respect to special projects such as the creation of online courses or other digital education offerings, as discussed below. If a Faculty member enters into a consulting agreement under which Intellectual Property may be created, the Office of General Counsel will approve the provision(s) relating to Intellectual Property ownership.

3. License to University. To facilitate consistency across multiple course sections, assist faculty asked to teach a course previously taught by a departed faculty member, and meet the University's administrative requirements, such as accreditation, a limited license to the University is needed. Accordingly, each Faculty member grants the following licenses to Faculty works incorporated into educational resources designed for classroom use in a particular department, school or college, such as syllabi, exams, lecture materials, and handouts ("**Course Materials**"):

- a. Where Course Materials are intended to be used for teaching by others at the University, the University will have a perpetual, nonexclusive, worldwide, royalty-free license to use, display, copy, distribute, and prepare derivative works of the Course Materials for its administrative and instructional use.
- b. For all Course Materials not intended to be used by others, the University will have a nonexclusive, worldwide, royalty-free license to the Course Materials for its administrative and instructional use in teaching the same or a similar course to that for which the materials were developed for a period of 5 academic years following the departure of the Faculty member who created the Course Materials.

These licenses do not permit use by the University for any electronic course, as described in Section B.5.

4. Student Intellectual Property. If intellectual property is made by a student as part of student coursework at the University, the rights to that intellectual property are ordinarily owned by the student. The University will retain ownership when intellectual property arises from the student's participation in sponsored work. The University may also retain ownership under the terms of an agreement with the student, such as an agreement regarding financial assistance, a research fellowship, or other student employment agreement, or a special agreement.

5. Special Projects and Electronic Courses. The University and an individual faculty member, staff member, or student may negotiate specific written agreements for special projects such as University publications, digital courseware, or distance-learning curricula. These agreements may reallocate rights or otherwise alter application of this Policy.

When Faculty members are Authors of content used in electronic courses (over 75% on-line content), they will assign their rights in the electronic course material to the University in exchange for an agreed-upon payment. An agreement under which a Faculty member creates an electronic course may be included as part of the annual Faculty contract or as part of an independent agreement. The applicable agreement will specify the consideration to which the Author(s) will be entitled upon the completion of the electronic course, such as a fixed fee, and additional terms as may be appropriate under the circumstances. The University's title will include all rights provided by U.S. Copyright law to guarantee the University's exclusive right to control how its educational programs and courses are offered to the public. Persons covered under this Policy may obtain no-cost licenses from the University to develop derivative works therefrom, which licenses will be liberally granted by the Vice President.

6. Sponsored Research. The allocation of rights in intellectual property arising from research or creative work sponsored by government, industry, or other external organizations will typically be governed by the terms of a written agreement between the University and the sponsor. The University ordinarily will be required by the agreement or by law to grant the sponsor a license, maintain or disseminate data, or grant other rights relating to Intellectual Property arising from the research or work and accordingly will take ownership of the Intellectual Property to meet its contractual obligations. Ownership and other provisions of this Policy are subject to these agreements.

7. Federal Grants: The federal government retains Intellectual Property rights to inventions created and reduced to practice under federal grants. Under federal regulations, the University must report all inventions to the funding agency and elect to file for a Patent within a reasonable period of time, i.e. one year before any statutory bar date. If the University elects not to file for a patent it must inform the agency, which then has the right to take title. Authors and Inventors must report all inventions on an Invention

Disclosure to permit the Office of Research and Sponsored Programs or its successor office to submit to the sponsoring agency.

8. Consulting and Private Agreements. Members of the Marquette University Community who enter into consulting agreements or other private agreements with parties outside of the University must ensure that the agreements contain no requirement to assign or otherwise transfer rights in any intellectual property owned by Marquette University under this Policy. Arrangements with other research institutions that involve dual appointments, visiting scientist agreements, and other arrangements that may require exceptions to this Policy require prior University written approval by the OCEP Vice President.

9. Trade Secrets. The University acknowledges the rights of employees and Inventors to protect their inventions as trade secrets when necessary to preserve the University's or a sponsor's Intellectual Property rights. Inventors may take reasonable precautions to assure the confidentiality and physical security of formulas, methods, processes, patterns, computer code, devices, compositions of matter, or other tangible research results. The Provost or his or her designee may take any necessary actions to assure that Faculty and students are not deprived of the opportunity ultimately to publish and otherwise fully participate in, and benefit from, the research, subject only to the University's obligations, if any, to maintain the confidentiality of the proprietary information of others.

10. Research Data. Research at Marquette University should be widely and openly published and made available through broad dissemination or publication of research results. Final research data is generally considered to be classified as public data unless there are specific requirements to maintain the confidentiality of research data, such as when a researcher is bound to protect the confidential information of a collaborating company, when the data relates to human participants, or when the data is part of a database that must be treated as a confidential to maintain its value.

C. Signing of Intellectual Property Assignments

All members of the Marquette University Community who are employed are required to sign a Marquette University Intellectual Property Assignment upon hire ([Appendix A](#)). Individuals employed at other institutions who are given Faculty appointments at Marquette University for the sole purpose of teaching and who are not conducting any research activities or developing any copyrightable works involving Marquette University Resources are not required to sign the Intellectual Property Assignment. In addition, Inventors are required to sign an additional assignment document if a patent application is filed by Marquette to protect the invention.

D. Disclosures, Legal Protection, and Licensing

1. Centralized Administration. The University will provide a centralized administrative office that manages intellectual property disclosures, patent applications, copyright registrations, and patent licensing (“**OCEP**”). OCEP will establish and maintain efficient processes for patentability assessment, license opportunity assessment, patent and copyright application filing, patent portfolio management, and licensing of patents, copyrights, and other intellectual property to third-party entities, including University spin-out companies.

2. Patent Review Committee and Panel. The PRC will be comprised of individuals having knowledge or expertise in science or engineering, technology transfer, or Intellectual Property. The PRC may identify a panel of additional faculty members with areas of technical expertise not represented by the members of the PRC who may be asked to provide input on technical aspects of invention disclosures under review by the PRC.

3. Disclosures. Members of the Marquette University Community will disclose any potentially patentable invention that they make promptly and in reasonable detail through a centralized online system. In the disclosure, the inventor must indicate whether the inventor believes that ownership falls into Section A.1 (University owned) or Section A.2 (Inventor owned) of the Policy definition of ownership in Section IV.A. The PRC will make decisions about whether to pursue patent protection for any invention within ninety (90) days, and OCEP will notify the Inventor if steps will be taken to protect the invention or if additional time is needed to make the determination.

Members of the Marquette University Community will similarly disclose Intellectual Property other than patentable inventions, including copyrightable software, in cases where the development is owned by the University as described in Sections IV A and B. If the Author believes the Intellectual Property may be subject to University ownership, the Author should disclose. OCEP will notify the Author if steps will be taken to protect the Intellectual Property within ninety (90) days or if additional time is needed to make the determination.

4. Determination of Ownership. OCEP will assess the ownership category proposed by the individual Inventor/Author. In cases where the proposed ownership category is disputed, OCEP will forward a written summary of the basis for the disagreement to the individual and to the PRC, which will promptly render a determination as to ownership. As set forth in Section V below, the individual will have a right to appeal the decision to the Research Vice President and to the University Provost and Chief Academic Officer.

5. Patentability Evaluation. For patentable inventions covered by Section A.1 (University owned), the PRC will decide whether to pursue patent protection on behalf of the University. The PRC will consider whether the invention is likely to be awarded a patent if one is pursued, whether there is adequate prospective societal benefit to warrant patent protection, and any other circumstances (e.g., contractual obligations, governmental regulations) that might affect a decision to pursue patent protection.

6. Return to Inventor/Author. If upon review by the PRC it is determined that the disclosure will not be patented, licensed or otherwise commercialized by the University, then the PRC will notify the OCEP Vice President, who will notify the inventor and cause ownership rights to be waived by the University in favor of the Inventor. Upon written request of the Inventor, the University will assign its ownership rights to the Inventor, subject to the University's obligations to third party sponsors and applicable provisions of law. At any time during the review period, the PRC may retain control over a disclosure for up to an additional six (6) months upon written notice to the Inventor so long as it notifies the Inventor within 8 months of any public disclosure of an invention.

7. Royalties upon Return. If the University has contributed significant resources to the support of the work in which the Intellectual Property was developed, the PRC may require, as a condition of the waiver, that Inventors and Authors grant back to the University ten percent (10%) of the annual Royalties they receive as the result of any license or sale of the invention or copyrightable work.

8. Database. OCEP will maintain an accessible database of University disclosures, patents, registered copyrights, and other intellectual property and licenses, and will pursue licenses with a long-term focus on serving the public good.

9. Licensing. The University will endeavor to license its intellectual property in ways that transfer technology for public use. If necessary, the University will vigorously defend and enforce its intellectual property rights through appropriate business and legal channels. In keeping with recommendations of the Association of American Universities, however, Marquette University will seek to avoid selling or licensing patents to patent assertion entities whose sole business strategy is to extract fees or licenses through threat of patent infringement rather than to foster active use of the technology or enable the development of new products and services.

E. Royalties

The University and any Faculty or student Inventor or Author (or the Inventor or Author's estate, if deceased) will divide the net proceeds (gross proceeds less the University's costs for such activities as

obtaining intellectual property protection/registration, production of prototypes, marketing and licensing, distribution, litigation, etc.) from the sale or licensing of patents as follows:

1. Division of net proceeds on inventions:

50% to the Inventor/Author; 25% to the University; 15% to the technology transfer program in OCEP; and 10% to the Inventor or Author's College, School, Program or Unit that supported the creation of the intellectual property, as determined on a case-by-case basis based on the circumstances.

The designation of which schools, colleges, and programs should be included in any royalty distribution will be determined primarily by their connection to the Inventor or Author through their provision of Marquette University Resources used in conceiving and developing the Intellectual Property. In case of disputes about appropriate designation of schools, colleges, and centers, the University Provost will resolve the matter. If more than one inventor or author is involved, the individual share will be divided between them equally unless they agree to a different arrangement. If the invention or copyrightable work that is associated with revenue generation was developed with support from a sponsored research program and the sponsor regulates the distribution of income, such specific regulations will take precedence over University policy with respect to distribution of the net proceeds.

2. University Business Software

These incentives apply to all employees, whether Faculty, staff, or student, who develop software for university purposes. Software developed by Faculty as part of their research or scholarship is excluded. Upon licensing or sale of the University-owned software, the net proceeds (gross proceeds less the University's costs for activities such as preparing the software for commercial markets, obtaining intellectual property protection/registration, production, marketing, distribution, legal fees, litigation, etc.) from the sale or licensing of software will be divided as follows:

67% to the responsibility center, 23% to the center's Dean and 10% to the University. The responsibility center will share its portion with the Author(s), as described below.

Authors will receive a share of the compensation received by the responsibility center in an amount not to exceed 33% of total net Royalties. The amount will be set at the discretion of the Author's Dean or Administrator. Factors to be considered by Deans and Administrators in setting an Author's royalty share will include the number of participants in the project, creative or inventive contribution, extraordinary project leadership, and time devoted to the project outside customary working hours. Royalty payments will cease upon termination of employment.

This Section E does not govern distribution of registration fees received for University electronic courses.

V. Responsible Parties

1. Administration. The OCEP Vice President will be responsible for establishing and maintaining procedures and administrative support needed to implement this Policy.
2. Patent Review Committee. The PRC reports directly to the OCEP Vice President. The PRC will advise OCEP Vice President and the Provost by a) interpreting the terms of this Policy; b) recommending changes or exceptions; c) evaluating invention disclosures and determining how inventions will be protected by the University or returned to the inventor/author; and d) providing guidance and consultation to OCEP, the Research Vice President and the Provost as needed.
3. Dispute Resolution. The PRC will promptly attempt to resolve any claim, dispute or controversy involving the rights to inventions or copyrighted works in conjunction with the Office of General Counsel. Upon the failure of the involved parties to reach a negotiated agreement, the PRC may recommend that that resolution be sought by referring the matter for mediation. Mediated agreements will be binding only when reduced to writing and signed by all the parties.

If the parties do not reach an agreement, then any party to the dispute may refer the claim, dispute, or controversy in writing to the Research Vice President. Upon receipt, the Research Vice President will review all documents and records and accept evidence from all interested parties. The Research Vice President's findings will be made in the form of a written decision directed to the Provost.

Appeals from a decision of the Research Vice President will be heard by the Provost or his or her designee. The decision of the Provost will be final.

VI. Related Policies and References

UPP1-04/Proper Use of University Resources

Data Protection Standards

Two important federal regulations that pertain to University inventions and patents at the time of the writing of this Policy are:

- Bayh–Dole Act or Patent and Trademark Law Amendments Act (Pub. L. 96-517, December 12, 1980)
- Leahy–Smith America Invents Act (AIA) (Pub. L. 112-29, September 16, 2012)

VII. History

This Policy supersedes the Marquette University Intellectual Property Policy dated April 1, 2013.

Appendix A: Intellectual Property Assignment