

XIII. GEORGETOWN UNIVERSITY POLICY AND PROCEDURES For Inventions, Copyrights, Patents, and Technology Transfer

A. Preamble and Objectives

Georgetown University has among its primary purposes teaching, research, and the expansion and dissemination of knowledge. Although development of patents and commercial applications is not a primary institutional goal, patentable inventions and other marketable forms of intellectual property do result from the research activities of Georgetown University's faculty, staff, other employees, and students and fellows (hereinafter collectively referred to as staff members). The University has an interest in protecting such intellectual properties in order to:

1. Serve the public good by promoting the disclosure, dissemination, and utilization of inventions which arise in the course of the University's research through established channels of commerce;
2. Encourage and provide tangible rewards to members of the University community who create such inventions;
3. Support further research and development by securing for the University a share in the proceeds of such inventions.

The Georgetown University Policy and Procedures for Inventions, Copyrights, Patents and Technology Transfer have been established to provide for an equitable allocation of responsibilities and rewards among Inventors, their departments and schools, the University, and any external organizations that have sponsored and financed research activities at the University. These policies and procedures apply to the reporting of inventions by investigators, prosecution of patent rights by the University, development of commercial applications, distribution of financial benefit and expense within the University, and distribution of a share of net income from inventions to the Inventor(s).

B. Ownership of Inventions and Patents

1. Georgetown University acquires ownership in all inventions--any new and useful process of discovery, art or method, machine, manufacture, or improvement thereof--made or conceived by a staff member, provided such invention was made:
 - a. during a research or other assignment given to a staff member pursuant to a research project, grant or contract, or any other University administered program; or
 - b. utilizing facilities, equipment, funds, or other contributions of the University; and provided
 - c. that the University has not entered into a research grant or contract agreement with express provisions to the contrary.
2. Inventions made by a staff member exclusively on his/her own time and without the

aid of any Georgetown University resources are the sole property of the Inventor, and:

- a. Patents from such inventions should be administered so as to not involve the name, facilities, or resources of Georgetown University;
- b. Time spent in administering such patents should conform to the University policy on outside activities by a staff member;
- c. In order to avoid a conflict of interest, a staff member should not patent inventions which are in the specific field of the investigator's work in Georgetown University's research programs without permission from the University;
- d. Inventor-owned patents may, upon acceptance by the University, be assigned to Georgetown University at the option of the Inventor for administration under University patent policies, or in accordance with a specific agreement between the Inventor and the University.

3. Ownership and disposition of invention rights resulting from research financed wholly or partially by governmental, industrial, philanthropic or other organizations shall be determined by the rules, regulations, and procedures of the sponsoring organization and in accordance with the terms of the related research agreement and the policies of Georgetown University. A staff member or student who elects to perform research on governmental, commercial, or other projects undertaken by the University is required to sign such supplemental agreements as are necessary to enable the University to fulfill its legal obligations with respect to patentable discoveries.

4. Any staff member who has developed an invention under Paragraph B.1 or B.3 above shall be required, at the request of the University, to execute the papers required for making application for patents in the United States and abroad and assignment of such patent applications or patents to Georgetown University or its designee. The expenses of any resulting patent proceedings are to be paid by the University or by its assignee.

5. Georgetown University may dispose of its rights obtained under Paragraph B.1, B.3, and B.4 above as follows:

- a. by selling, licensing, assigning, or otherwise exploiting such rights;
- b. by operating such rights for public use, if in the sole determination of the University after consultation with the inventor, principles of charity or public policy so demand;
- c. by releasing such rights to the Inventor, provided expenses already incurred by the University or an assignee are reimbursed by the Inventor or from the proceeds of commercial exploitation of the invention.
- d. by including such rights in a research contract with a third party under which such rights are assigned or licensed either in advance or otherwise, to the third party.

6. The conditions enumerated in the Georgetown University Policy and Procedures for Inventions, Copyrights, Patents and Technology Transfer shall be deemed to be a part of each contract of employment of staff members or acceptance of students at the

University.

C. Patent Law and the University Inventor

The University Inventor is subject to many pressures in the academic community to publish materials describing research. Premature publication may, however, adversely affect the public use and benefits of scientific data. Ideas promulgated in the literature without adequate prior protection may ultimately be lost to the public good due to their limited commercial potential. It is important for the University Inventor to be aware of the potential harm of premature publication, which severely undermines the patentability of an invention. Because of the great costs associated with bringing a product to market, companies are usually willing to develop technology only if it is protected by patents. The inventor should consult the University Office of Technology Transfer whenever he or she has a question about patent rights. This section of the policy is designed to acquaint the inventor with the basics of a complex and sophisticated area of the law. The Office of Technology Transfer is available to assist in the application or interpretation of this policy.

In general, a patent owner in the United States has a grace period of one year to file an application after disclosure through publication or public presentation of the nature of the invention. If the U.S. patent application is filed prior to any publication or presentation, worldwide patent rights are preserved for one year from the U.S. filing date. If, however, an invention or innovation is published or presented before filing a U.S. patent application, most foreign patent rights are lost. To fully protect foreign patent rights, it is therefore essential to file a U.S. patent application prior to any publication or presentation.

The University Inventor can help to safeguard inventions in the early stages of development by carefully noting ideas conceived in a lab notebook. As entries are made in the notebook, a dated signature by the Inventor and a witness should help protect the invention under U.S. Patent Law. In order to protect the discovery's conception date, the Inventor must continue to make signed and dated entries for experiments where attempts to reduce the invention to practice are made. Diligence in recording efforts to reduce an invention to practice is vital. Without such diligence, efforts to establish the first invention date and to take advantage of the legal benefits flowing from it may be in vain. Careful notebook practices will help to protect the invention from subsequent Inventors even if an interloper reduces the invention to practice first, and/or files a patent application first.

D. Disclosure of Inventions--Duty to Disclose

Inventions conceived and/or reduced to practice and which are covered by B.1, B.3, or B.4 must be disclosed fully and in good faith to the Director of the Office of Technology Transfer. When a staff member has an idea (conceived invention) or an invention (patentable or not) has been reduced to practice, that individual is required to report the invention through the Chair or Director of his/her Department, Center, or Institute to the Office of Technology Transfer on the Georgetown University Invention Disclosure Form (Appendix B). It is the obligation of the Inventor to correctly identify any and all co-inventors on the Disclosure Form. The inventors must also agree in writing upon their percentage shares in the invention at the time of disclosure. This agreement will govern

the distribution of the Inventors' share of net proceeds from the invention. The percentage share is binding throughout the life of the patent unless all sharing Inventors agree to and file a new written agreement; provided, however, that an Inventor may, at any time, relinquish any right to share in the net proceeds. The Inventor also has an obligation to disclose any potential conflict of interest in accordance with the University's Conflict of Interest Policies, and to execute all contracts, assignments, waivers, disclosures, or other legal documents necessary to vest in the University the rights to any invention in which it retains an interest. These obligations remain effective even after Inventors leave the University. Prosecution by a University Inventor of patents on inventions to which the University has a right of ownership as described in Paragraph B.1 without disclosure of the invention to the Office of Technology Transfer and (if so requested by the University) assignment of ownership to the University, constitutes grounds for disciplinary action. Inventors may not enter into any patent agreements related to University intellectual properties with outside organizations without prior authorization from the Office of Technology Transfer. The University retains this right of approval exclusively to itself.

E. The Office of Technology Transfer and the University Committee on Patents, Licensing, Copyrights, and Technology Transfer

The Office of Technology Transfer shall be administered by a Director reporting through the Associate Dean for Research Operations* to the Dean of Research** of Georgetown University Medical Center. A University Committee on Patents, Licensing, Copyrights, and Technology Transfer shall provide oversight and policy direction for the Office of Technology Transfer.

1. **Committee Membership.** This Committee will be chaired by the Dean of Research and will include the Director of the Office of Technology Transfer, the Associate Dean for Research Operations, the Vice President and Treasurer of the University or his/her designee, the Chief Fiscal Officers of the Main, Medical, and Law Campuses, the University Counsel or his/her designee, two representatives appointed by the Faculty Senate, and one faculty representative each from the Main, Medical, and Law campuses appointed respectively by the appropriate Executive Vice President. The faculty representatives appointed by the Faculty Senate and by the Executive Vice Presidents shall serve three year terms.

2. **Function and Authority.** The Committee will meet quarterly, or as needed, and will advise the Dean of Research and the Director of Technology Transfer on all policy and procedural issues related to the University's intellectual property. The Committee will advise the Dean of Research with respect to the structure and finances of the office, will oversee the Working Groups that review invention disclosures and proposals for patent applications, and will hear appeals of decisions made by the Working Groups. All deliberations and communications of the Committee and its Working Groups are confidential and regarded as privileged information. All disclosures to the Committee are on a "need to know" basis only.

3. **Working Groups functioning as technical subcommittees of the Committee on Patents, Licensing, Copyrights, and Technology Transfer** will review all invention disclosures and proposals for patent applications. A Working Group will decide whether the Office of Technology Transfer will pursue patenting and commercialization of each invention it reviews. The Working Groups will also review existing patents at least annually to

determine whether the University will continue to maintain those patents. The Working Groups will each be chaired by the Director of the Office of Technology Transfer and will be composed of one or more administrative members of the full Committee and at least one faculty member with relevant expertise drawn from the Committee membership or from a pool of consultative faculty drawn from all campuses; individuals from outside the University may be consulted if specific expertise is required in a particular case. Appointments to Working Groups will be made by the Director of Technology Transfer in consultation with the Associate Dean for Research Operations. Ad hoc external reviewers will be non-voting members of the working group. Working Groups will meet as needed. Except as otherwise provided by these policies, the procedures of the Working Groups shall be confidential. In general, each Working Group will include at least one faculty member from the campus on which the invention originated to assure availability of appropriate expertise.

When a Working Group decides not to pursue or maintain a patent, the Director will provide the reasons for the decision to the Inventor(s), who may appeal the decision in writing to the full Committee. In cases where the University releases its rights to an invention to the inventor, the inventor(s) may pursue a patent for the invention at his/her own expense. Individual Schools, Departments, Divisions, Centers, Institutes, and other organizational units of the University may not pursue a patent or invention that has been abandoned by the University, nor may they provide funding to do so. An individual member of the University community who chooses to pursue a patent or invention abandoned by the University must do so in accordance with the guidelines in Paragraph B.2.a and b above as if the invention had originally been made on his/her own time. (*Associate Dean for Research Operations, Office of the Dean of Research and Graduate Education, Georgetown University Medical Center, **Dean of Research and Graduate Education, Georgetown University Medical Center)

F. Dispute Resolution

The Committee on Patents, Licensing, Copyrights, and Technology Transfer will entertain and attempt to resolve, all disputes between individuals regarding ownership of patentable inventions or copyrights. The Committee will review all relevant documents and records relating to the invention's inception and development, and interview potential Inventors and others who might be able to assist the Committee in its resolution of the dispute. After its review, the Committee will recommend a proposed course of action to the Dean of Research.

The Committee will also determine the scope, coverage, and application of these Policies and Procedures. The Committee's responsibilities will include, but not be limited to, determining whether software is textual or a device-like work. The Committee will also establish recommended record keeping guidelines to be followed by staff members and students in their research to establish and protect intellectual property rights. The Committee will also hear appeals of decisions of the Working Groups. Inventors wishing to appeal a Working Group decision must file a written appeal with the Dean of Research, stating the basis for the appeal and setting forth evidence supporting a reversal of the Working Group's decision. The Dean will convene a meeting of the Committee to hear the appeal, reviewing the reasons for the decision of the Working Group. The Inventor will be provided with an opportunity to present his/her case. The meeting will be convened in a timely fashion intended to minimize risks to the patentability of the

invention. The Director of the Office of Technology Transfer and the Associate Dean for Research Operations will not vote on appeals of Working Group decisions, but may participate in the Committee's review of the appeal. The decision of the Committee is final and is not a grievable matter under the University Grievance Code.

G. Distribution of Financial Benefit and Expenses, and Net Income

Georgetown University assumes financial responsibility for inventions to which it takes ownership. This responsibility may include, for example, the costs of assessing patentability, filing and maintaining patents, marketing and licensing inventions, maintaining records, and defending infringements and interferences. The University is not, however, obligated to protect or develop any particular technology or invention unless it has made an explicit contractual commitment to do so. Activities related to the protection and marketing of University intellectual properties are intended to be self-supporting. The Office of Technology Transfer is required to use the University's resources carefully, with a view to promoting the fiduciary interest of the institution as a whole.

Distribution of all royalties and other income from intellectual properties owned by the University shall be as follows: Gross Receipts. All direct expenses related to prosecuting and maintaining a patent, including fees for outside legal counsel, shall be reimbursed to the Office of Technology Transfer from receipts related to the invention. In addition, 15% of gross receipts from each invention shall be allocated to the budget of the Office of Technology Transfer. When the overall revenues from such receipts are sufficient to support the activities of the Office, the percentage amount of the allocation may be reduced so that only the actual costs of the Office's operations are deducted from gross receipts.

Net Receipts. One-half of Net receipts shall be distributed to the Inventor(s) of the intellectual property. "Net Receipts" are defined as gross receipts minus the deduction of expenses outlined in the preceding section on "Gross Receipts." At the option of the Inventor(s), the Inventor's share may be returned to the respective laboratory rather than to the Inventor personally. When there are two or more Inventors of a property, allocation of the Inventors' share of net receipts shall be made in accordance with the Inventors' agreement made for that purpose at the time of disclosure of the invention. After the distribution to the Inventor(s), the remainder of the net receipts shall be divided as follows:

10% to the President of the University or his designee for support of research and development throughout the institution;

30%* to the Executive Vice President of the campus area (Main Campus, Medical Center, or Law Center) in which the Inventor holds a primary academic appointment or staff position (that is, the campus from which the Inventor receives 50% or more of his or her support). These funds are to be used for support of research and development on this campus or in interdisciplinary programs involving two or more campuses.

10% to the Department, Center, or Institute in which the Inventor holds a primary academic appointment or staff position (that is, the Department, Center, or Institute from which the Inventor receives 50% or more of his or her support). These funds are to be

used for support of research and development within the department or in interdisciplinary programs.

*In any case where there is more than one inventor, noted percentages are shared proportionally by Inventors, their respective schools, or departments/laboratories, as applicable, in accordance with each inventor's share in the invention as specified on the Georgetown University Invention Disclosure Form.

H. Copyrights

One of the major goals of Georgetown University, as a research-oriented academic institution, is the discovery, production, and dissemination of knowledge. The copyright policies of the University are intended to further that goal by providing appropriate incentives to faculty and members of the academic staff for the production of new knowledge. The policies are not intended to disturb the customary relationship between the University and the author of traditional scholarly works such as books, manuscripts, artistic works, movies and television programs.

Traditionally, most published works written by members of the faculty have been the property of the author and have been published under agreements made by the faculty members without participation of the University. In general, the University does not claim "work for hire" status under Title 17 of the U.S. Code for such works. However, the University is concerned about publishers who publish scholarly articles by members of the academic community and then charge those same members and other academics substantial fees to reproduce their articles for use in class, for reserve readings in the library, or for other educational purposes. Accordingly, Georgetown University suggests that members of the faculty, when publishing an article in a scholarly journal shall request (but not require) that the publisher place a note on the first page of the article giving nonprofit organizations the right to make copies of all or any portion of the article for educational purposes without written permission or payment of an additional fee. Where the University pays the full, or a substantial part of, the cost of publication, such as printing, editing, etc., arrangements concerning the ownership of the copyright and the division of any royalties must be made with the Dean of the pertinent School working together with the Treasurer of the University. Such arrangements should be made prior to the publication of the work and should be mutually beneficial to the faculty member and the University.

Unlike traditional written works of scholarship, the University has generally acquired ownership and the patent rights in all inventions made or conceived by a staff member utilizing the facilities, equipment, funds or other contributions of the University. A new type of scholarly production that can create a similar kind of potentially valuable property is computer software. Such software is most often protected by copyright, although in some cases it may be protected by patent or trade secrecy agreements.

Software may be divided conceptually into two categories:

(1) "textual software" that is primarily intended and likely to result in informing or educating the user or in improving his or her general capabilities, and (2) functional "device-like software" that is primarily intended and likely to result in the accomplishment of a task or in allowing the user to produce, manage, analyze, or manipulate a product, such as data, text, a physical object, or more software. Device-like

software acts as a tool or building block in the accomplishment of a task, or in the creation or management of a product or result.

"Device-like" software that is a product or by-product of research activity conducted at or for the University, or utilizing the University's facilities, equipment, funds, or other contributions will be considered a work made for hire and treated like other inventions. Ownership will be acquired by the University and the appropriate copyright or patent protection will be sought by the Office of Technology Transfer on behalf of the University, with any royalties to be divided as indicated in section VII of this Policy.

Examples include: inventory or billing systems, statistical programs and graphics design software.

Textual software may be pure text or may be an interactive package intended to train the user in a skill as part of the user's education, or may teach the user elements of software design or engineering. It is akin to a textbook and, for the purposes of this policy, will be treated like traditional written work rather than as an invention. Examples include: electronic textbooks and journal articles published electronically.

In instances where the nature of the software is disputed, the question shall be referred to the University Committee on Patents, Licensing, Copyrights, and Technology Transfer. The Committee's decision on whether the software is textual or device-like will be final. The copyright of material created by a non-academic employee within the scope of University employment or by academic employees pursuant to a specific direction or assigned duty (other than the teaching of courses) from the University, or any of its units, shall be considered a work made for hire and shall be the property of the University. In general, the foregoing terms also apply to students at the University. The University makes no claim of ownership to works created by students or other staff members working on their own, outside of an employment relationship with the University. Students working on a project governed by a contract or agreement to which the University is party shall be bound by the terms of that contract or agreement. Students who are hired to perform specific tasks that contribute to a copyrightable work will ordinarily have no rights to the ownership of that work unless they have a prior written agreement with the author. The University reserves the right to make copies of dissertations as needed for the academic purposes of the institution.

I. Licensing of Inventions

The Office of Technology Transfer will be responsible for identification of potential commercial sponsors to develop intellectual property owned by the University, for marketing of properties to potential sponsors, and for negotiation of all research and development, licensing, and royalty agreements with sponsors in cooperation, as appropriate, with the Office of Sponsored Programs. Such agreements must conform to University policies, including but not limited to those governing academic freedom and conflicts of interest. Inventors may not independently market or license properties owned by the University. Sponsors may not use the name or logo of Georgetown University or those of any school or other component of Georgetown University, nor imply approval or endorsement of any product by the University in any commercial promotion without the written permission of the University.

The Inventor is, however, central to the licensing process. The Inventor is usually the best advocate and source of expertise for the invention. Throughout the search process for prospective companies to commercialize an invention, the Inventor is encouraged to actively participate and provide guidance. The Inventor's active involvement is often essential to the successful commercialization of a discovery.

During the course of negotiation the Inventor's advice and opinions will be routinely sought. In the process of negotiations, the University will use its best efforts to guard the Inventor's freedom to publish, collaborate with other non-profit institutions, and transfer materials for non-commercial purposes to other researchers.

J. Services to Inventors

The Office of Technology Transfer is available to advise Inventors on all questions concerning copyrights, patents, licensing and technology transfer. When an Inventor has an idea, early disclosure to the Office of Technology Transfer will ultimately benefit the development of the idea. Members of the Office staff may advise Inventors on the types of experiments the U.S. Patent Office might require for patentability or to strengthen an application. Searches may also be instituted to review other inventions in the field in order to avoid comparable development. Advice may be sought from others knowledgeable in the field and from patent attorneys. Early planning is crucial to both the development of inventions and to cost effective, commercially valuable technology. The Office of Technology Transfer will be responsible for initiating patent searches and will act as a liaison to the Office of University Counsel on patent, copyright and licensing issues. The Office's oversight responsibilities help to ensure that all Inventors receive consistent service from patent attorneys and have a central resource for the coordination, handling, and retention of records related to their inventions. Patent files will be appropriately maintained by the Office with the assurance that all fees will be paid as required by the U.S. Government.

Inventors will receive evaluations of the marketability of their inventions as well as reports on subsequent marketing to companies and other interested parties. Information on inventions will be disseminated broadly to many companies. Meetings to discuss the marketability of inventions will be arranged by the Office of Technology Transfer, and the Inventor will be advised throughout the interaction with potential sponsors. Once a company has decided to develop or commercialize an invention, the appropriate agreements will be drafted or reviewed, and then negotiated with the Inventor's input. Model agreements for interactions with commercial sponsors are included in the Appendices. Legal counsel will be consulted as required. The marketing agreement will be maintained by the Office of Technology Transfer which will be responsible for its administration.

The Office of Technology Transfer will maintain financial records of the expenses and income related to each invention. The inventor will receive periodic financial reports on royalties paid to the University and distributed as described in Section VII above. The inventor has the right to examine the financial records of the Office of Technology Transfer related to his/her inventions and copyrights.

APPENDICES

Appendix A - Definitions

Device-Like Software: Computer software primarily intended and likely to result in the accomplishment of a task or in allowing the user to produce, manage, analyze, or manipulate a product such as data, text, a physical object, or more software.

Disclosure: Executed form reporting the existence of a new invention.

Intellectual Property: Patent applications, patents, copyrights, inventions, trade secrets relating to said inventions, know how, improvements, and discoveries.

Invention: Any new or useful process or discovery, art, or method, machine, manufacture, device-like computer software, or improvement thereof.

Inventor(s): The individual(s) responsible for conceiving and reducing to practice an idea which becomes an invention.

Reduction to practice: Occurs at the time when an inventor can prove the product or process was produced or applied successfully. As a matter of law, the time of the filing of the patent application is presumptively the time of reduction to practice unless the inventor can demonstrate an earlier date. Diligence in recording efforts and successes in reducing an invention to practice are vital in establishing the earliest possible date of invention.

Research and Investigation of fundamental knowledge or its applications

Development: in any academic discipline germane to the university, and reduction of that knowledge to practice.

Specific Field: Area of research for which the inventor is supported by external or intramural funding or other institutional resources such as office or laboratory space, or has written investigational protocols on file at the University.

Staff Member: For purposes of this policy, a Georgetown University Faculty member or employee, and any student or fellow engaged, whether or not for compensation, in University research work from which an invention or copyrightable work is developed.

Textual Software: Computer software primarily intended and likely to result in informing or educating the user or in improving his/her general capabilities

Work Made For Intellectual property produced in the performance of a

Hire: grant or contract or as a part of an employee's assigned work responsibilities.

*Appendix B-

Georgetown University Invention Disclosure Form

*Appendix C-Model Confidential Disclosure Agreement

*Appendix D-Model Materials Transfer Agreement

*Appendix E-

Model Exclusive and Non-Exclusive Research and Development Licensing Agreements

*A copy of this document can be obtained from Research and Technology Development

Services, 4000 Reservoir Road, NW Building D Suite 177

Current as of 12/97