**TENNESSEE STATE UNIVERSITY**

**INTELLECTUAL PROPERTY POLICY**

**I. Objectives**

The objectives of this policy are to encourage an environment and incentives for research and scholarship at Tennessee State University (TSU), to provide financial compensation as well as professional recognition to inventors and authors, and to protect and best serve the public interest. To these ends, this policy encourages disclosure of inventions, discoveries, and works; provides a process for evaluation of inventions, discoveries, and works for possible patenting, copyrighting, trademarking, and licensing; and establishes principles for determining the rights of the University and inventors/authors. Tennessee State University encourages scholarly publication of the results of faculty and student research.

**II. Applicability**

1. This policy is considered a material part of the conditions of employment for every employee of the University and a material part of the conditions of enrollment and attendance at the University by students. It is also the policy of the University that individuals (including visitors) participating in a sponsored research project and/or making significant use of University resources accept the principles of ownership of intellectual property as stated in this policy unless an exception is approved in writing by the University.  All University creators of intellectual property shall execute appropriate assignment and/or other documents required to determine ownership and rights as specified in this policy.
2. This Intellectual Property Policy applies to all University personnel, including all paid and unpaid full-time and part-time faculty members, staff, and other employees (including those on approved leaves, including but not limited to sabbatical); students, volunteers, and fellows; and other persons making use of University facilities and resources.
3. This policy shall not be interpreted to limit the University's ability to meet its obligations for deliverables under any contract, grant, or other arrangement with third parties, including sponsored research agreements, license agreements and the like. Copyrightable, patentable, or trademarkable works or inventions that are subject to sponsored research agreements or other contractual obligations of the University shall be owned by the University or other individual or entity as set forth in such agreements, so that the University may satisfy its contractual obligations.
4. This policy should not be interpreted to limit the ability of University personnel to seek or participate in outside consulting activities that are separate and apart from the University and do not use University Resources. *See Outside Employment Policy.*

**III.** **Definitions**

1. **Author**

The person or persons responsible for creation of a copyrightable work.

1. **Commissioned Copyrightable Work**
A copyrightable work or work made for hire that is specifically ordered or commissioned by the University or a funding sponsor. The following are specifically included within this definition if authored in connection with University teaching duties: curriculum designs and networked instructional resources.
2. **Copyrightable Work**An original work of authorship which has been fixed in any tangible medium of expression and is eligible for protection under the copyright laws of the United States. Copyrightable works also include works whose authorship cannot be attributed to one or a discrete number of Authors, but rather result from simultaneous or sequential contributions over time by multiple Authors. For example, software tools or Software Code developed and improved over time by multiple faculty and students, where authorship is not appropriately attributed to a single or defined group, would constitute a copyrightable work.
3. **Division**

The administrative subdivision, i.e. college, school or center, of the University that provided the environment in which the research program(s) of the Inventor(s) or Author(s) is (are) conducted.

1. **Gross Income**

Proceeds from the sale, lease, or licensing of intellectual property by the University; dividends derived from equity received in consideration for the sale, lease, or licensing of intellectual property by the University; or proceeds from the sale of equity received in consideration for the sale, lease, or licensing of intellectual property by the University.

1. **Intellectual Property**The term “Intellectual Property” is broadly defined to include inventions, discoveries, know-how, show-how, processes, unique materials, Copyrightable Works, original data and other creative or artistic works which have value.  Intellectual property includes that which is protectable by statute or legislation, such as patents, registered or unregistered copyrights, registered or unregistered trademarks, service marks, trade secrets, mask works, and plant variety protection certificates.  It also includes the physical embodiments of intellectual effort, for example, models, machines, drawings, compositions, devices, designs, apparatus, equipment, instrumentation, circuits, computer programs and visualizations, biological materials, materials, chemicals, or other evidence produced in the course of research, other compositions of matter, plants, and records of research and experimental results.
2. **Invention**

Any discovery, invention, new use or application, process, composition of matter, article of manufacture, know-how, design, model, technological development, or biological material, or inventive conception and reduction to practice that is patent-eligible under the patent laws of the United States.

1. **Inventor**

The person or persons responsible for conception of an idea or ideas leading to an Invention. An individual or individuals who has (have) made a contribution to the conception and/or reduction to practice of an Invention, discovery or development and who is (are) identified as such on the licensed patent, patent application or unpatented technology. In the case of a patent or patent application, this contribution must be applicable to at least one claim. In cases of joint inventorship, it is not necessary that each Inventor make the same type or amount of contribution to the Invention and it is not necessary that each Inventor make some contribution of each claim.

1. **Net Income**

Gross income minus the direct costs associated with patent prosecution, copyright registration, commercialization, defense, maintenance, and administration of Intellectual Property.

1. **Scholarly Work**A Copyrightable Work created by any individual subject to this policy primarily to express and preserve scholarship as evidence of academic advancement or academic accomplishment. Such works may include, but are not limited to, scholarly publications, journal articles, research bulletins, monographs, books, plays, poems, musical compositions and other works of artistic imagination, and works of students created in the course of their education, such as exams, projects, theses or dissertations, papers and articles.
2. **Scope of employment**

Activities which have been assigned to an employee by his/her/their supervisor, or which are performed during normal working hours, or which fall within the employee’s job description or duties of their employment; or whenever the creator's duties include research, investigation, or the supervision of research or investigation and the Invention or work is relevant to the general field of inquiry to which the creator was devoted or assigned.

1. **Significant use**

Includes but is not limited to the use by any individual of specialized, research-related facilities, equipment or supplies, provided by the University for academic purposes; more than incidental use of University staff personnel, including but not limited to Graduate Assistants; or more than incidental use of a researcher’s own on-the-job time. Significant use does not include office space, library facilities, ordinary access to computers and networks, or salary except for those situations where the funds were paid specifically to support the development of an invention(s) and/or work(s).

1. **Software Code**A Copyrightable Work in the form of Software Code that is (a) either a Commissioned Copyrightable Work or authored in any part by University researchers with the aid of University Resources and (b) not contributed to an open-source coding project.
2. **Traditional Academic Copyrightable Works**

A subset of Copyrightable Works created independently and at the Author’s initiative for academic purposes.  Examples may include class notes, online course materials, books, theses and dissertations, articles, non-fiction, fiction, poems, musical works, dramatic works including any accompanying music, pantomimes and choreographic works, pictorial, graphic and sculptural works, or other works of artistic imagination that are not created as an institutional initiative. Educational software or Software Code (also known as courseware or lessonware) that the creators may design for courses they teach are not considered Traditional Academic Copyrightable Works.

1. **Trademark**Any word, name, symbol or device, or any combination thereof, whether or not registered as a trademark, that is used to identify goods or services and distinguish them from those manufactured or sold by others.
2. **University Resources**Any research support administered by or through Tennessee State University, including but not limited to funds, facilities, equipment or personnel.
3. **Work**

Any copyrightable material, including but not limited to literary works; musical works, including any accompanying words; dramatic works, including any accompanying music; pantomimes and choreographic works; pictorial, graphic, and sculptural works; motion pictures and other audiovisual works; sound recordings; architectural works; computer software or databases; circuit diagrams; architectural and engineering drawings; and lectures.

1. **Work Made for Hire**

A work created by an individual within his/her/their Scope of Employment or a work created by a third party under contract with TSU and which contract specifically provides that the contract is a Work Made for Hire or that the resulting deliverable (the work) is the property of, or is assigned to, TSU.

**IV. Ownership of Intellectual Property**

1. The University has a right to ownership of any Intellectual Property in which it has an interest. Unless otherwise agreed, this policy also applies to any Intellectual Property in which the University has an interest under the terms of contracts, grants or other agreements. An Invention or Work in which the University does not have a legal interest may be offered to the University and, if accepted, the University will administer such Intellectual Property in accordance with this policy or as otherwise agreed to in writing.
2. Prior to the University providing support (for example, release time or University funding) to a person to whom this policy applies (including Work Made for Hire), where that support could reasonably be expected to result in creation of an Invention, Trademark, or Copyrightable Work with commercial value, the University and the person or persons receiving that support should agree in writing as to the ownership interest of any Intellectual Property produced. If no such agreement is in place, then any Intellectual Property produced is solely owned by TSU.
3. Except under special circumstances, the University will not assign rights in future Inventions or Works to private corporations or businesses.
4. Copyrights
	* 1. Academic Works Created by Faculty. The “work-for-hire” provision of the Copyright Act of 1976 gives the University ownership of the copyrights to Works produced by its employees within their Scope of Employment. However, only in the case of Traditional Academic Copyrightable Works as defined in section 3.N. above produced by academic and research faculty, the University cedes copyright ownership to the Author(s), except in the case of Significant Use of University Resources (including sponsor-provided resources) in creation of the Work, the Work is directed by the University, or is subject to a sponsor’s agreement that provides for a different ownership. When the University transfers copyright in Traditional Academic copyrightable Works to faculty under this policy, the University reserves the nonexclusive right to use the Works for educational, promotional, or administrative purposes consistent with its educational mission and academic norms. If an Author transfers an interest in a Traditional Academic Copyrightable Work subject to this policy, the Author must use reasonable efforts to secure for the University the right to reproduce such Works, royalty free, for all traditional, customary or reasonable academic and promotional uses.
		2. Other Works Created by Faculty. Courses taught and courseware developed for teaching at TSU belong to TSU. Any courses which are videotaped or recorded using any other media are TSU property, and may not be further distributed without permission from the relevant academic dean. Blanket permission is provided for the use of students as part of their academic program at the University, or for other University purposes. Prior to videotaping, permission must be obtained from anyone who will appear in the final program.
		3. Works Created by Staff. Copyrightable Works created within the Scope of Employment at the University by individuals who are not faculty engaged in teaching and research are considered Works Made for Hire under the Copyright Act, and the University owns the Copyright. In cases where University staff members, within the course and Scope of Employment, create Works, course and teaching materials, or Scholarly Works, the University will work collaboratively with the individual to ensure that fair and equitable treatment of rights to attribution and reuse are reasonably addressed.
		4. Works Created by Students. The University does not make claim to Traditional Academic Copyrightable Works as defined in section 3.N. above made by students while satisfying regular course requirements. The University shall have, as a condition of awarding the course credit or degree, the royalty-free right to retain, use, and distribute, including by electronic and digital technologies now known or developed in the future, on a non-commercial basis, copies of the Traditional Academic Copyrightable Work, together with the right to require its publication for archival use. When a student undertakes a project involving significant University Resources, Intellectual Property, research team collaboration, or work for an outside body, the University retains the right to claim ownership of any Intellectual Property produced by the student which was created through Significant Use of University Resources.

* + 1. Dedicating Works to the Public. If an Author of a Work whose copyright is owned by the University, including an Author of a Work Made for Hire, wishes to make a Work freely available to the public, through noncommercial licensing or other noncommercial means, the University, subject to the terms of any applicable agreements with third parties under which the Work was created, will accommodate such wishes as long as it determines that the benefits to the public of making such Works freely available outweigh any advantages that might be derived from commercialization. The University will act as expeditiously as reasonably possible in making such determination.
1. Trademarks

Trade and service marks are distinctive words or graphic symbols identifying the sources, product, producer, or distributor of goods or services. Trade or service marks relating to University goods or services shall be owned by the University.

1. Patents and Other Intellectual Property

Except as otherwise specified in this policy or by the University in writing, Intellectual Property developed by individuals to whom this policy applies shall be the sole and

exclusive property of TSU if the subject Intellectual Property is:

* + 1. Developed within the person’s Scope of Employment with the University;
		2. Developed in the course of a project sponsored by the University;
		3. Developed with the Significant Use of the University's facilities, services, or equipment, or University Resources; or
		4. Developed in the course of a project arranged, administered or controlled by the University and sponsored by persons, agencies or organizations external to the University, absent prior written agreement to the contrary.

**V. Responsibilities of Tennessee State University and Delegations of Authority**

1. The University shall: (1) act with reasonable promptness and in good faith on all Inventions or Works disclosed to it, (2) notify the Inventor or Author promptly whenever it decides not to pursue or to abandon the pursuit of patenting, copyrighting, or commercialization of an Intellectual Property, (3) execute, upon request, all contracts, assignments, waivers or other legal documents reasonably necessary to transfer to the Inventor or Author the appropriate University interest in any Intellectual Property which it has so chosen not to pursue, and (4) remit to the Inventors their shares of Net Income from Inventions as specified in this policy. Subject to these responsibilities, the University at any time may decide not to pursue or to abandon the pursuit of patenting, copyrighting, and/or commercialization of an Intellectual Property in which it has an interest.
2. Authority and responsibility for the Intellectual Property Policy, including implementation and operation of its provisions and processes, is delegated to the President (or designee, as determined by the President, which can include a non-profit organization). The President or designee shall develop procedures for implementing this policy and holds the authority to modify the application of policy provisions as necessary.

**VI. Responsibilities of Inventors and Authors**

1. Inventor(s) and Author(s), either alone or in association with others, must prepare and submit on a timely basis a disclosure form to the President or designee for each Invention or Work that could be reasonably expected to have commercial value. Such disclosure is required regardless of whether the University may have an interest in the Invention or Work. If an Inventor or Author fails to disclose an Invention or Work, the University’s ability to protect the Intellectual Property rights in the Invention or Work may be jeopardized. Therefore, processes and procedures related to an undisclosed Invention or Work may, at the University’s discretion, diverge from those detailed in this policy and the final decision on ownership of an undisclosed Invention or Work will be made solely by the University.
2. The Inventor or Author shall fully cooperate with TSU in the disclosure process and, when the University has an interest in the Invention or Work, in other subsequent activities associated with patenting, copyrighting, and/or commercialization of the Intellectual Property, including promptly executing all contracts, assignments, waivers or other legal documents necessary to vest in the University, or its assignees, any or all rights in the Intellectual Property.
3. Inventors and Authors: (1) may not sign patent, trademark, or copyright agreements with outside persons or organizations that may abrogate or otherwise conflict with the University's rights and interests as stated in this policy, nor (2) use the name of the University in connection with any Invention, Trademark, or Work without prior authorization,.
4. In the event that two or more persons are entitled to claim ownership of the Intellectual Property, the Inventors or Authors shall reach agreement between or among themselves regarding relative contributions for the purposes of distribution of Net Income from the Invention or Work. That agreement should be in writing and signed by all Inventors or Authors.
5. Inventors should particularly note that certain acts (for example, enabling disclosure of the Invention in an academic journal, a paper, a poster presented at a conference, or offering to sell rights in the Invention before a patent application has been made) can constitute a statutory bar to patent protection. An Inventor contemplating public disclosure activities prior to filing an invention disclosure form should contact the Division of Research and Sponsored Programs prior to engaging in those disclosure activities.

**VII. Administration**

1. The Intellectual Property Committee makes recommendations regarding procedures, guidelines, and responsibilities for the administration and development of intellectual property.
2. The Intellectual Property Committee consists of the Vice President for Research and Sponsored Programs or designee, at least one staff member from the Office of Technology Transfer, and no more than four other members selected and appointed by the President or designee.
3. The Intellectual Property Committee convenes at the call of the Vice President for Research and Sponsored Programs or designee, who determines when implementation or interpretation of the Intellectual Property Policy requires consideration by the Committee. The matters that may be referred to the Committee for recommendation include, but are not limited to: whether the University has ownership or an interest in an Intellectual Property; whether patent, trademark, or copyright protection should be sought; whether to seek commercialization opportunities; and whether provisions of this policy should be waived.
4. When the Committee is considering a particular Invention or Work, the Inventor/Author and/or his/her/their representative may examine all materials submitted to the Committee, may make written and oral presentations to the Committee, and may be present during oral presentations of others.
5. The Committee shall conduct investigations as it deems necessary in the preparation of its recommendations. Upon completion of the evaluation, the Committee shall provide the Vice President for Research and Sponsored Programs or designee with its recommendations as to ownership of the Intellectual Property; whether patent, trademark, or copyright protection should be sought; and/or whether to seek commercialization opportunities. The Vice President for Research and Sponsored Programs or designee shall then decide, after conferring with the President or the President’s designee as appropriate, ownership interests and determine whether to pursue protection and/or commercialization of the Intellectual Property and shall communicate this decision in writing to the Inventor(s) or Author(s).
	* + 1. If the decision of the Vice President for Research and Sponsored Programs or designee is not to seek patent or copyright protection of the Intellectual Property, and the University has an ownership interest as provided in this policy in the Intellectual Property, the Vice President for Research and Sponsored Programs or designee may abandon the application, request further development of the Invention, or in the University’s discretion, in some cases assign the University’s ownership interest to the Inventor or Author in a written agreement to be negotiated by the parties and which shall provide for allocation of ownership interests between the University and the Inventor/Author in the event of commercialization of the Intellectual Property. The Division of Research and Sponsored Programs may administer this action.
			2. In the event that the Vice President for Research and Sponsored Programs or designee deems it appropriate to pursue intellectual property protection, the University shall bear all necessary costs, not limited to, but including attorney fees, USPTO fees, Copyright Office fees, and/or foreign filing fees.
			3. For those Inventions or Works in which TSU is deemed to have an ownership interest, and the Vice President for Research and Sponsored Programs has determined to pursue protections and/or commercialization, the Vice President for Research and Sponsored Programs or designee shall arrange to have these activities undertaken and oversee the execution in consultation with the Office of General Counsel.
			4. For Inventions made in the course of a project funded in whole or in part by the Federal Government, the Bayh-Dole Act (37 CFR 401) imposes certain reporting requirements associated with the technology transfer process. The Vice President for Research and Sponsored Programs or designee is responsible for ensuring that those reporting requirements are satisfied.
6. The evaluation of Inventions and Works and the administration, development and processing of patents involves substantial time and expense and requires talents and experience not ordinarily found in University staff. Therefore, the University may enter into a contract with third parties in connection with the administration of identified Inventions, disclosures of Invention, and developed patents.

**VIII. Request for Re-Evaluation**

In the event the Vice President for Research and Sponsored Programs or designee decides not to pursue patent, trademark, or copyright protection or commercialization efforts, the Inventor or Author may request a re-evaluation by the President or designee. The request must be received within thirty calendar days of notification to the Inventor or Author of the initial decision. The Inventor or Author may submit documents or other evidence in support of his/her/their position. A decision by the President or designee relating to ownership or royalty distribution shall be final.

**IX. Revenue Sharing**

A. The University shall share with the Inventor or Author the Net Income that may accrue from the commercialization of the Intellectual Property created by the Inventors or Authors. Specific provisions of grants or contracts may govern rights and revenue distribution regarding Intellectual Property made in connection with sponsored research. Consequently, revenues received from such Intellectual Property may be exclusive of payments of royalty shares to donors or contractors. Moreover, the University may contract with outside persons or organizations for the obtaining, managing and defending of patents, trademarks, or copyrights, and any royalty share or expenses contractually committed to such persons or organizations may be deducted before revenues accrue or before the Inventor's or Author’s share is distributed.

* 1. The Gross Income will be applied first to reimburse the University for expenses incurred in seeking and maintaining patent protection or copyright or trademark registration; in pursuing commercialization of the Intellectual Property; or in marketing, licensing and defending the Work, patent, or licensable Invention. After reimbursement of direct expenses, the remaining Net Income shall be shared as follows (or as otherwise determined by the President): (1) the first $5,000 shall be distributed to the Office of Technology Transfer; (2) thereafter, any Net Income received from the commercialization of the Intellectual Property shall be distributed as follows: forty percent (40%) to the Inventor(s) or Author(s); fifteen percent (15%) to the Inventor's or Author’s Division; and forty-five percent (45%) to the University.
	2. If any Division, unit, program, or Inventor/Author does not exist, the designated Net Income will revert to the Division of Research and Sponsored Programs, or as directed by the President.
	3. In the case of multiple Inventors or Authors, the Inventor/Author share of Net Income is split equally among all Inventors or Authors, unless all Inventors or Authors previously have agreed in writing to a different distribution of such share, or as directed by the President. If the multiple Inventors or Authors are affiliated with separate divisions, the Division’s share shall be split as directed by the President.
	4. TSU may elect to accept equity in lieu of cash payments for a license fee or royalty. The decision to accept equity in lieu of cash is made at the sole discretion of TSU and does not constitute an obligation on behalf of TSU to make a disbursement of equity to the creator(s) or Division or department until the equity is sold. TSU will own and exercise all rights of ownership, including the rights to vote equity interests on all matters which are subject to the consent or approval of the holders of similar equity interests. TSU will remain and own the equity interest until the sale or exchange of the interest. The decision as to when to sell or exchange equity resides with the President in his/her/their sole discretion.

**X. Special Cases**

The University recognizes that a special case may arise which is not specifically covered by this policy or which may justify waiver of this policy. Only the President or designee has authority to waive the provisions of or make exceptions to this policy.