

COLLEGE of CHARLESTON

OFFICIAL POLICY

9.1.13

Intellectual Property Policy

10/14/2020

Policy Statement

This Policy addresses the ownership, disposition, and use of Intellectual Property which includes, but is not limited to, patents and/or inventions, copyrights (including computer software), and trademarks/services marks relating to the College of Charleston (hereinafter "College"), its faculty, staff, students and others using College Resources as defined below:

Policy Manager and Responsible Department or Office

This Policy will be managed and maintained by the Office of the Provost in consultation with the Office of Legal Affairs.

Purpose/Reason for the Policy

To create an environment that encourages research resulting in the generation of intellectual property and to promote use of the intellectual property for the public good;

To encourage development and commercialization by facilitating access to methods of protection for Intellectual Property and the protection of producers of scholarly activity that may have commercial value.

To acknowledge the traditional right of faculty members to disseminate products of their work, research and creative activity for scholarly purposes;

To promote the identification and disclosure of all products of work having commercial value; except those exempted from intellectual property inclusion herein or not covered or defined herein as intellectual property.

To ensure compliance with applicable laws and regulations.

POLICY

Going forward from the effective date of this Policy, all parties and individuals employed by the College of Charleston, including, but not limited to all faculty and staff, are required to comply with the terms and conditions of this policy as a condition of their employment and/or continued employment with the College.

This Intellectual Property Policy applies to:

A. All parties and individuals employed by, paid by or under any personal services agreement with the College, including full and part-time faculty and staff, adjunct faculty, visiting faculty and researchers, and graduate and undergraduate students, unless expressly exempted by a written agreement, properly executed.

B. Anyone using College Resources, as defined below.

Definitions

Intellectual Property

The term “Intellectual Property,” as used in this policy is broadly defined as property protectable by patent rights and copyrights, including machines, articles of manufacture, compositions of matter, and any method for making or using these; and works of authorship.

College

College of Charleston and University of Charleston, South Carolina.

College Resources

College funds or external funds administered through the College, College facilities, space, equipment, personnel, tangible or intangible research materials, information and/or materials that are not freely available to the public. “College Resources” does not include the use of ordinary office space, library facilities, and ordinary access to personal computers and networks.

Copyright

Exclusive rights, as set forth in Title 17 U.S.C. Section 106, in the original works of authorship when those works are reduced to a tangible medium of expression. Works of authorship are literary works, pictorial works, graphic works, musical works, dramatic works, sound recordings, audiovisual works, motion pictures, pantomimes, choreographic works, sculptural works and architectural works.

Course

All educational objectives included in the syllabus created for and provided to College students by an instructor or under the supervision of an instructor.

Course Content

All educational or instructional materials provided by an instructor to College students as part

of a Course. Course Content does not include personal notes created for an instructor's personal use.

Institutional Works

University ownership of works that are supported by a specific allocation of either college resources or funds or that are created at the specific direction of the College of Charleston and/or the University of Charleston, S.C., for a specific purpose of either. Also, the mere fact that multiple individuals have contributed to the creation of a work shall not make the work an institutional work. Rather, institutional works are those in which authorship cannot be attributed to one or a discrete number of authors, but rather result from simultaneous or sequential contributions over time by multiple faculty members and students. Institutional works belong to the College of Charleston and/or the University of Charleston, S.C., as appropriate.

Inventor

The individual who invented or discovered the subject matter of an invention.

Digital Course Content

All educational or instructional materials created by an instructor for use in a College Course taught to students online, in whole or in part.

Originator

The individual who created an original work of authorship.

Owner

The Owner is the entity, whether a person or organization, that owns the Intellectual Property. The Owner may be the Inventor or an organizational entity that supported the particular work by providing resources, facilities or compensation.

Patent rights

Exclusive rights, as set forth in Title 35 U.S.C. Section 271, in inventions which are new, useful and nonobvious machines, articles of manufacture, compositions of matter and method for making and using these.

Royalties

Compensation for rights in intellectual property and are usually a percentage of revenue received by the licensee from sales of the product or service.

Scope of Employment

The range of activities encompassed by one's employment, (i.e., acts done while performing one's job).

Substantial Use of College Resources or facilities

College resources are: funds, programs, equipment, space, grounds, facilities or other physical

assets that go above and beyond those customarily and currently provided to employees as part of their ordinary conditions of employment. So, in general, the use of University funds or external funds administered through the University, the use of students or employees as support staff to develop work or the use of specialized or unique facilities, laboratories, and equipment or other special subventions provided by the University, would be constructed as “substantial use” unless specifically accepted by agreement. However, the University does not construe the use of ordinary office space, library facilities, ordinary access to computers and networks or salary as “substantial use.”

Trademark/Service Marks

A Trademark or a Service Mark is a word, phrase, symbol or design (or any combination thereof) that identifies and distinguishes the source of goods or services.

Trade Secret

Information kept secret by a business to maintain an advantage over competitors.

University

College of Charleston and University of Charleston, S. C.

Intellectual Property Committee (“IPC”)

The Intellectual Property Committee (“IPC”) is a committee at the College comprised of the inventor’s Dean, the Provost, the Executive V.P. for Business Affairs and the General Counsel or their respective designees. In addition, the Provost may appoint additional non-voting individuals to serve on or advise the IPC as appropriate. [The inventor or originator may suggest additional members for the IPC subject to the discretion of the Provost.] The College recognizes the IPC as an advisory body to the Office of Research and Grants Administration and the Provost on all matters involving Intellectual Property.

Ownership Rights of the College in Intellectual Property

1. The College shall generally have rights to Intellectual Property conceived, created, developed, fixed or first actually reduced to practice by College employees, including faculty and staff, or students:

a. Within the scope of their employment or official association and/or appointment with the College, inclusive of summer months and holidays; or

b. Pursuant to research at the College, whether funded internally or externally, or pursuant to a sponsored research agreement or contract of any type, including gifts between the College and a third party; or research data or results created by an employee are owned by the University, unless the University has contractually assigned or licensed it to a third party. The creator will have a non-exclusive, but permanent license to use the data for nonprofit educational research and scholarly purposes within the scope of the employee’s employment, but subject to other provisions of this policy; or

c. By or with substantial use of College Resources or facilities;

2. Except that the College acknowledges:

- a. Copyrights are owned by the originator, unless created as a “work-made-for-hire” as that phrase is defined in Title 17 U.S.C. Section 101 and copyright materials’ ownership and control shall remain with the creator unless the work is: (a) commissioned by the College of Charleston and/or University of Charleston, S.C.; (b) supported by a direct allocation of funds from the College of Charleston and/or the University of Charleston, S.C., for a specific project; (c) is a work for hire; or (d) is otherwise subject to contractual obligations. Pedagogical, scholarly or artistic books, articles and similar works including non-patentable software are not subject to university claims of ownership unless specifically for hire. Such works include those of students created in the course of their education, such as dissertations, papers and articles. Additionally, the University claims no ownership in novels, textbooks, nonfiction books, poems, musical compositions, non-patentable software or other artistic imagined works, unless created using institutional works or the services of University non-faculty employees working within the scope of their employment.
- b. Inventions owned by the inventor, unless assigned by the inventor or result from the inventor being hired by the College to invent in addition to other job duties.
- c. Traditional Teaching Material, excepting the syllabus, to include faculty lectures, audio files, databases and various forms of digital media created for instructional purposes by faculty shall not be intellectual property for which the College has rights, unless specifically and voluntarily created as works made for hire or for which a stipend has been paid. The syllabus to a course remains the property of the Institution.
- d. Distance Education Teaching Material developed without a stipend from the Institution or without substantial use of College resources or facilities would have all rights retained by the course author, with the College holding rights to the use of the materials only for one year following the conclusion of the author’s employment at the College. Said courses can be treated as intellectual property if the faculty member agreed to treat the course as a work made for hire with such ownership rights residing in the institution. No online course can be assigned in whole to another instructor without the consent of the faculty member who created it, unless the faculty member agreed to treat the course as a work for hire for the institution, was paid a stipend for its development, or it was developed by an employee hired as a part of his or her job duty to create Distance Education Teaching Material. For clarification purposes, the College/University shall retain rights to classes and course work developed at the College/University, including the syllabus, which are software, digital material in any media, videotaped or recorded using any other media or used for distance education, when the College/University has paid a stipend to the faculty member for such development or recording or it was developed with substantial use of College resources or facilities.

3. The College acknowledges a general right of students of the College to have ownership rights in Intellectual Property developed by them independently as part of their coursework, except for any “work-made-for-hire” as that phrase is defined in Title 17 U.S.C. Section 101 or under an agreement requiring the College and/or student to assign rights to the College or a third-party. Students have a duty to disclose any agreement entered into with a third party to the IPC, and, such agreement shall be valid only upon IPC approval.

4. No transfer of ownership rights in any other Intellectual Property owned by the College shall be transferred from the College to any employee of the College, whether faculty or staff, any student, or any other person making use of College Resources, unless the College expressly and specifically grants the ownership rights, in whole or in part, to the employee by means of a signed written agreement.

DISCLOSURE OF INTELLECTUAL PROPERTY

All Intellectual Property that emanates from the work of any employee of the College or any other person making use of College Resources not excepted or exempted herein, shall be promptly disclosed to the College, and shall be made prior to any public release of information in any form about the subject matter. All disclosures will be treated confidentially and will not be considered, in and of themselves, a surrender or determination of ownership. Public release in any form may have the effect of consigning the intellectual property to the public domain. This would preclude the College and the inventor from pursuing patent protection. Therefore, prompt disclosure is needed.

Disclosures shall be made by completing the Disclosure Form [attached hereto as Ex. A] and by submitting it to the appropriate office as directed on the form. If it is believed that the Intellectual Property was conceived independently, a written statement of this claim with supporting documentation shall be submitted in addition to the Disclosure Form.

DETERMINATION OF OWNERSHIP

Following receipt of a properly completed and signed Disclosure Form, the Provost, in consultation with the IPC, will determine whether the College is entitled to ownership of the Intellectual Property. The College acknowledges the obligation of the IPC to promptly evaluate and provide the requested determination. The College will strive to issue the determination in writing within 15 business days of submission. However, if the College makes, in its sole discretion, a determination that additional time is necessary for review, evaluation and consultation of the requested determination, the College will inform the submitting parties in writing of the expected date of the determination. At any time, the College may request additional information.

The determination issued by the IPC will assert one of the following alternatives:

- a. Assertion of sole interest in the Intellectual Property with a recommendation for pursuit of protection; or
- b. Waiver or Assignment of the Intellectual Property rights of the College.

In the event that a waiver is indicated, a waiver agreement will be provided by the College within sixty (60) days after the determination is issued. All waivers will include a perpetual, royalty-free right and license retained by the College to use the Intellectual Property for its own purposes, with additional terms as selected by the College. Waivers will only be granted if doing so would be consistent with any external agreements to which the inventor or originator may be a party. The inventor or originator shall make the IPC aware of any such external agreements and shall timely provide, within thirty (30) days, the agreement to the IPC

for review.

COMMERCIALIZATION

Upon any recommendation of the IPC for pursuit of protection of the Intellectual Property, the Provost shall make a determination regarding commercialization in consultation with the inventor or originator and any other parties at the College whose input the Provost or IPC deems appropriate. The Provost's decision will be based on the objectives of the College according to this policy and the available resources of the College. The College shall have the authority to engage a third-party commercialization or licensing agent on behalf of the College. The College will bear the costs of licensing the intellectual property. If the College cannot, or decides it will not proceed to license and/or patent an invention, the College can enter into an agreement with the inventors or originators for a transfer of all or part of the intellectual property back under an agreement. Said agreement must be subject to the terms of any agreement that supported the related work. If a Research Foundation is created on behalf of the College, such Foundation shall work with the College regarding matters related to commercialization and licensing. In addition, nothing in this Policy shall be interpreted to preclude the College from partnering with other institutions and non-profit organizations for the joint conduct of technological commercialization activities.

The inventor or originator shall work and cooperate, in good faith, with the College throughout the entire commercialization process.

Nothing herein shall prevent the College from entering into license agreements with a third party business entity in which the inventor or originator has a business interest. The option decided on by the College shall be based on what serves the mission and strategic plan of the College in the best way and is fair.

SPECIAL CASES AND UNIQUE SITUATIONS

Any special cases and unique situations relating to Intellectual Property which are not specifically covered by this Policy or which arise because of a conflict of interest, shall be brought to the IPC for consideration and determination.

DISPUTES/APPEALS

Any dispute concerning application of this Policy shall be resolved upon written appeal to the Provost. The appeal will be considered by a three-member panel comprised of a representative selected by the Provost, a representative selected by the inventor or originator, and a representative chosen by the Executive Vice President for Business Affairs. Each representative must be an employee of the College and no third parties will be permitted to participate. A majority decision of the panel shall be final and binding upon both the inventor/originator and the College, unless an appeal is filed with the President within ten days of a decision by the three member panel. The President shall have twenty (20) working days thereafter to render a decision, which shall be final and binding on all parties, including the inventor/originator and the College. A failure to issue a decision shall make the decision of the panel the final and binding decision of the College.

DISTRIBUTION OF REVENUE FROM ROYALTIES OR SALE OF EQUITY INTEREST

The College shall maintain a revenue distribution plan that is comparable to those of other colleges or

universities of equivalent size, nature and scope. After recovery of expenses incurred after disclosure, including those made to obtain protection for the Intellectual Property, and to develop, market and/or license the Intellectual Property, the inventor or originator's share of aggregate net revenues resulting from royalties and/or sale of equity interests will be 50%. In the event of joint inventors or originators, the 50% net revenue will be shared equally among all inventors or originators absent any written agreement otherwise. The Provost, in consultation with the Executive Vice President of Business Affairs, will determine distribution of the remainder.

Departments/Offices Affected by the Policy

This policy has campus-wide application.

Procedures Related to the Policy

Related Policies, Documents or Forms

- A. Disclosure Form
- B. 9.1.9 Ethics Policy

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Related Policies, Documents or Forms

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Review Schedule

Issue Date: 2/24/2016 Date of Policy Review: 10/14/2020	Next Review Date:10/24/2025
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POLICY APPROVAL (For use by the Office of the Board of Trustees or the Office of the President)	
Policy Number: 9.1.13 (adopted by BOT on 2/24/16)	
President or Chairman, Board of Trustees	 _____
	Date: <u>10/14/2020</u>

College of Charleston – Intellectual Property Disclosure Form

Discovery and Invention Disclosure Form Disclosure No. _____

In accordance with the College of Charleston Intellectual Property Policy 9.1.13.

(for office use only)

Date Received: _____

Case Assigned to: _____
(Office/Department/Reviewer)

Emphasis Area:

Health_____ Information Technology_____ Energy/Environment_____

Sciences_____ Other_____

I. Discoverer(s) or Inventor(s):

Name:			
Position:			
Campus Address:			
Campus Telephone:			
E-mail Address:			
Home Address:			
Home Telephone:			

Has any discoverer or inventor performed related research at any other institution? Yes No

If yes, explain:

II. Type and Title of Discovery or Invention:

___ Patent ___ Print (copyright) ___ Software (copyright) ___ Trademark

III. Brief Description of Discovery or Invention:

Describe, in non-technical terms, the nature and key features of your discovery or invention. Use additional sheets as necessary and attach descriptive material (manuscripts, diagrams, data, etc.), if available.

Please describe with specificity the College Resources that assisted you in the development of this creation.

IV. Dates and Records:

A. What is the earliest date of conception of the invention? _____

Give reference to substantiate evidence: _____

B. Do you have laboratory records and data? Yes No

If yes, give reference and physical location: _____

C. Have your records been witnessed? Yes No

V. Disclosures:

A. Has work related to the invention been published or submitted for publication? Yes No

If yes:

Date submitted: _____

Date published: _____

Reference (attach reprint): _____

B. Has the work been presented? Yes No

If yes:

Date of abstract submission, if any: _____

Date of abstract publication (attach copy): _____

Date of presentation: _____

Place of presentation: _____

C. Has the work been otherwise publicly disclosed? Yes No

If yes, give date:

Explain circumstances:

D. Has disclosure been made to any company? Yes No

If yes:

Date	Name of Company	Address	Confidentiality Agreement Signed?
			<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/> Yes <input type="checkbox"/> No

VI. Utility:

A. What are the possible uses of the discovery or invention?

B. Briefly outline results which suggest usefulness:

VII. Non-Obviousness

From the description provided in Section III, expand on what is different from current technology. If known, give reference(s) to closest current technology.

VIII. Support:

A. Was College time used in work relating to the discovery or invention? Yes No

If yes, explain:

B. Other than those persons named in Section I, did any other College staff or students contribute to the discovery or invention? Yes No

If yes, explain:

C. Were College facilities or equipment used in work relating to this discovery or invention? Yes No

If yes, explain:

D. Was any work relating to the discovery or invention sponsored by non-College funds? Yes No

If yes:

1. Was any work relating to the discovery or invention sponsored by federal funds? Yes No

If yes:

Name of Agency:

Grant or Contract Number:

2. Was any work relating to the discovery or invention sponsored by private funds? Yes No

If yes:

Name of Sponsor:

IX. Commercial Interest:

A. Has any company shown an interest in the invention? Yes No

If yes:

Name of Company	Name of Contact Person	Telephone Number	E-mail Address

B. Do you know any (other) companies that may be interested? Yes No

If Yes:

Name of Company	Location of Company	Contact Person	Telephone Number

X. Discoverer's/Inventor's Recommendations:

A. Was this discovery or invention made in the course of College activities? Yes No

If no, please give justification:

B. Does there exist any written agreement among other discoverers/inventors which provides for other than equal division of proceeds among the parties? Yes No

If yes, explain:

C. Do you have any recommendation of a patent attorney or a technology transfer organization (such as Research Corporation Technologies) to manage your discovery or invention? Yes No

If yes:

Name of Firm or Organization	Name of Contact Person	Telephone Number	E-mail Address

D. Is this discovery or invention related to class curriculum? Yes No

If yes, explain:

E. If you claim that the College has no ownership interest in this property, please describe, with specificity, exactly why the College has no interest, and describe which resources, independent or otherwise, that you used in the development of this creation and/or intellectual property and/or invention.

XI. Signatures:

Printed Name of Discoverer/Inventor	Signature	Date	Witness

XII. Endorsement: (To be completed by Department Chair or Unit Director)

I have reviewed the information provided above with particular reference to "Support," which addresses source of funds contributing to the discovery or invention. To the best of my knowledge, I believe the above information to be accurate.

Printed Name	Signature	Date