

The University of West Alabama
Intellectual Property Policies and Procedures

Approved by Faculty Senate January 15, 2000

Approved by Deans' Council September 28, 2001

Revised December 7, 2012

Revised September 13, 2016

Approved by President's Council October 24, 2016

UWA Intellectual Property Policies and Procedures

- I. Introduction
- II. Definitions
- III. Patent Policy
- IV. Copyright Policy

I. Introduction

The University of West Alabama (UWA) is a public, state-supported, institution of higher education that believes in creating an intellectual environment whereby creative efforts and innovations are supported and encouraged. In accordance with the University's mission, faculty are "committed to providing leadership and fostering positive growth throughout West Alabama through **research** and public service, with primary emphasis on that which meets the educational, social, cultural, and economic needs of the region." In pursuit of this research mission, UWA faculty, staff and students are encouraged to continue searching for new knowledge in fields in which the university community is active. In view of the far-reaching research interests across campus, it is inevitable that new discoveries and inventions will be made. It is important, therefore, that there be guidelines for intellectual property, and delineating rights, responsibilities and obligations of the University, the inventor, and other interested parties. It is the intent of the University of West Alabama to ensure that intellectual property rights, which it owns, administers, or shares provide reasonable benefits, recognitions, returns and incentives that are equitable to all parties involved.¹

This document is intended to serve as an overview of intellectual property matters of interest to UWA personnel (faculty, staff, students, fellows, and persons with "adjunct" appointments). The overall objective of the policy is to establish a solid framework whereby invention is encouraged and therefore sustain the University climate for innovation and invention. The policies and procedures outlined in this document will be implemented by the Intellectual Property Administrator, hereby designated as the Research Integrity Advisory Board, and University personnel are urged to contact the Office of Sponsored Programs & Research for assistance (Office of Sponsored Programs & Research, Station 47, 205-652-5459, jwedgworth@uwa.edu).

II. Definitions

A. **Assignment of Rights**-transfer of ownership of Intellectual Property in writing from University personnel (faculty, staff, students, fellow, and persons with "adjunct" appointments) to the University.

B. **Intellectual Property**- Generally, it is any material that may be protected under the patent, trademark and/or copyright laws. It is information and original expression that derives its intrinsic value from creative ideas and has commercial value. Ownership is subject to international, federal, and state laws and to this University policy

¹ This policy supersedes the University of West Alabama Intellectual Property Policy (**Revised December 7, 2012**). Inventions disclosed to the University before the effective date of this revised policy (January 1, 2017) will be governed by the December 7, 2012 policy.

- C. **Invention**-Any Intellectual Property that reasonable appears to qualify for protection under United States patent law or other protective statutes in or outside the United States, whether or not patentable, or which appears to be commercially viable.
- D. **Inventor**- Under U.S. law, an inventor is a person who contributes in the conception of the patentable idea (i.e., the claims). Thus, inventorship of a patent application may change as the patent claims are changed during prosecution of the application. An employer or person who furnishes money to build or practice an invention is not an inventor. Inventorship may require an intricate legal determination by the patent attorney prosecuting the application.
- E. **Patent**-In the U.S., a patent gives the holder the right to exclude others from making, using, selling, offering to sell, and importing any patented invention. Thus, a patent does not necessarily provide the holder any affirmative right to practice a technology. Instead, it provides the right to exclude others from practicing it. Patent claims are the legal definition of an inventor's protectable invention. Patentable subject matter includes processes, machines, compositions of matter, articles, some computer programs, and methods (including methods of making compositions, methods of making articles, and in some cases methods of performing business). For more information, see www.uspto.gov/web/offices/pac/doc/general/what.htm
- F. **United States Patent and Trademark Office (PTO)**-The PTO is the federal agency, organized under the Department of Commerce that administers patents on behalf of the U.S. government. The PTO employs patent examiners skilled in all technical fields in order to evaluate patent applications. The PTO also issues federal trademark registrations.
- G. **Copyright**- Copyright is a form of protection provided by the laws of the United States to the authors of "original works of authorship." This includes literary, dramatic, musical, artistic, and certain other intellectual works as well as computer software. This protection is available to both published and unpublished works. Copyright Law ([More Info](#)) generally gives the owner of copyright the exclusive right to conduct and authorize various acts, including reproduction, public performance and making derivative works. Copyright protection is automatically secured when a work is fixed into a tangible medium such as a book, software code, video, etc.
- H. **Copyright Registration**- Copyright automatically applies as soon as the work is fixed in a tangible form, assuming the work is copyrightable. Registration is not required for the rights described above to apply. However, a copyright must be registered with the U.S. Copyright Office before a legal suit for alleged infringement can be filed in a United States court. The copyright owner is eligible for statutory damages and attorney's fees if registration is done prior to infringement.

- I. **Trademark-** A trademark includes any word, name, symbol, device, or combination, that is used in commerce to identify and distinguish the goods of one manufacturer or seller from those manufactured or sold by others, and also to indicate the source of the goods. In short, a trademark is a brand name. A service mark is any word, name, symbol, device, or combination that is used, or intended to be used, in commerce to identify and distinguish the services of one provider from those of others, and to indicate the source of the services.
- J. **Trademark Registration-** Trademark registration is a procedure in which the United States Patent and Trademark Office (PTO) provides at least initial determination of rights based upon legitimate use of the mark. However, it is not necessary to register a trademark or service mark in order to prevent others from infringing upon the trademark. Trademarks generally become protected as soon as they are adopted by an organization and used in commerce, even before registration. With a federal trademark registration, the registrant is presumed to be entitled to use the trademark throughout the United States for the goods or services for which the trademark is registered.
- K. **Substantial Use of University resources-** Substantial use of University resources includes the use of University resources by a University employee beyond the following:
- i. Customary use of office space, laboratories, or studios, or of libraries; of library collections, subscriptions, or services; of secretarial or other staff assistance of computer time or computer or lab equipment on hand; of network or Internet access; of standard office equipment and supplies.
 - ii. Sabbaticals; summer or other research grants provided by the University or University-affiliated units; other support customarily provided to faculty and staff

III. Patent Policy

In order to appraise relative rights and equities of all parties concerned, to facilitate patent applications, licensing, equitable distribution of any royalties or other financial returns, to provide a uniform procedure in patent matters, and to serve the public benefit and interest, The University authorizes the adoption of the patent policy as set forth herein.

- A. The Research Integrity Advisory Board will serve as the Intellectual Property (IP) Administrator and will be responsible for managing the University's Intellectual Property and administering the Intellectual Property Policies. The IP Administrator shall serve at the pleasure of the President and their actions shall be subject to the approval and right of review of the President of the University.
- B. The Research Integrity Advisory Board, as the designated IP Administrator, will be charged with making recommendations regarding the disposition and

ownership of intellectual property. The Research Integrity Advisory Board will be a standing University committee composed of ten members, including representation from both faculty and staff, and will include one representative from Risk Management and one representative of the Comptroller's Office. The UWA Director of Research Integrity will serve as Chair of the Research Integrity Advisory Board. The Research Integrity Advisory Board shall meet as often as necessary. The Research Integrity Advisory Board shall make recommendations on University policies and procedures pertaining to intellectual property to the President and faculty/staff for action; review all intellectual property policy matters submitted to the Research Integrity Advisory Board for compliance with University policies, and contractual or grant-based obligations; and negotiate agreements with faculty, staff, and students of the University in accordance with this policy.

- C. Subject to the approval of the President of the University, the IP Administrator shall have power to adopt such rules and procedures as are deemed appropriate; to determine the interest of the University in all reported inventions; to cause all reported inventions to be investigated in order to evaluate the interest of the University in said invention (with due consideration given to the achievement of the inventor and the financial returns to the inventor and the University); to authorize the release of patent rights when the IP Administrator decides that the University has no interest in the invention or decides that the University does not desire to pursue the patenting or development of the patent; to authorize applications for patents on reported inventions and to retain patent counsel for matters pertaining to patent applications; and to make recommendations to the President of the University with regard to the prosecution and protection thereof and any litigation that may arise therefrom. The IP Administrator shall also have power to do all things appropriate for the investigation of patent rights and for the exploitation of patent rights by direct exercise, exclusive or nonexclusive licensing, and make recommendations to the President of the University with regard to partial or total assignment or sale thereof. All questions concerning the methods by which the patent shall be commercially exploited shall be decided by the IP Administrator.
- D. This patent policy of the University, as amended from time to time, shall be deemed to be a condition of employment and contractual obligation, both while employed and thereafter, of every employee, including student employees, and a condition of contractual obligation, both while in attendance and thereafter, by every student on campus.
- E. Any invention or discovery (1) which is the result of research carried on by or under the direction of an employee of the University and/or having the costs thereof paid from funds provided by, under the control or administered by the

University, or (2) which is made by an employee of the University and which relates to the employee's field of work, or (3) which has been developed in whole or in part by the utilization of resources or facilities belonging to the University, is hereby assigned as property of the University. The applicability of the above stated criteria to any invention or discovery will be determined at the sole discretion of the President of the University or his/her designee.

- F. As a condition of their employment or their continued employment by the University, each faculty member, employee and student agrees that he/she is contractually bound by this patent policy as implemented by the University and shall report to the officer or to any non-profit organization so designated by the President of the University to manage and commercialize such inventions and discoveries, any invention or discovery which such faculty member, employee or student has conceived, discovered, developed and/or reduced to practice by them or under their direction at any time following their initial appointment by, employment by, or enrollment with the University. All inventions and discoveries that meet the criteria of paragraph D above are hereby assigned to the University for the benefit of the University Faculty members, employees and students do not have the authority to assign rights in such inventions and discoveries to third parties. The President of the University is authorized to further assign any invention or discovery the University is deemed to own pursuant to this policy to a designated nonprofit organization established for the benefit of the University, which said assignment shall be condition on full compliance with this policy, regulations promulgated hereunder by the Board of Trustees or by the President of the University, and appropriate state and federal law.
- G. The IP Administrator shall cause each invention or discovery to be investigated in order to determine the interest of the University and, if the IP Administrator determines that the University has an interest in the invention which it desires to pursue, it shall undertake to obtain a patent on the invention. In determining whether or not the University has an interest in the invention, the Administrator shall consider the benefits that might accrue to both the University and the inventor. The IP Administrator is responsible for prompt action for the purpose of protecting the property rights of the inventor and the University.
- H. If it is determined that the invention or discovery is one which is owned by the University pursuant to this policy but is one in which the University has no interest in retaining ownership, the University (or the non-profit organization to which an invention may have been assigned in accordance with the terms of this policy) may, but is under no obligation to, release its ownership rights to the inventor(s) on terms and conditions determined by the President or his/her designee, subject to any third party rights.

- I. As further consideration for the assignment of rights set forth herein, and after a deduction of all University costs incurred in the patenting process and protection of patent rights, including but not limited to attorneys' fees and associated patent costs, the University agrees to pay annually to the inventor, his heirs and assigns, a percentage of the royalties, fees, or other financial returns received by the University from such invention according to the distribution scale below:

Gross Income of Intellectual Property	UWA	Faculty Member(s)
\$100,000 or less	0%	100%
\$100,001-\$250,000	30%	70%
more than \$250,000	50%	50%

- i. After the deduction of all expenses incurred in the patenting and protection of patent rights, the balance of any financial return derived from the licensing of intellectual property owned by the University shall be divided according to the distribution scales presented above. Of the 30% or 50% University share:
- a. 1/3 to the University
 - b. 1/3 to the Inventor(s) College/Division
 - c. 1/3 to the Inventor(s) Department or Center
- J. It is understood that many research contracts, grants, and consulting agreements from or with the United States Government or its agencies, corporations, or individuals contain ownership of intellectual property clauses that may be at variance with this policy but which, if agreed to, require compliance. Such documents which are at variance with this policy may be referred to the IP Administrator for recommendation prior to approval.
- K. Invention Disclosure- A written notice and description of the invention should be submitted to the IP Administrator to begin the formal patent process. University personnel should use the Invention Disclosure Form, a confidential document, to disclose their invention to the IP Administrator. The Invention Disclosure Form should be submitted as soon as possible, preferably a minimum of six months prior to any public disclosure or publication. Note that in most cases foreign protection is lost upon any enabling public disclosure of the invention. All sponsors (i.e., government, industry, and foundation) must be informed if an invention is developed during a project. The IP Administrator will work with you to notify the proper parties.

IV. Copyright Policy

The University of West Alabama accepts an active role in promoting the development of copyrightable materials in a manner consistent with public interest, and acknowledges that public interest requires both academic excellence

and responsible fiscal management. This Policy is written with the intention of promoting excellent, innovative research by identifying and protecting the rights of the University, its personnel, and the public. This University of West Alabama Copyright Policy identifies the copyrightable materials to which UWA will exercise its rights and establishes procedures for determining and protecting those rights. Ownership of materials not described in this policy can be assumed to belong to the creator.

- A. Copyright is a form of protection provided by the laws of the United States to the authors of “original works of authorship.” This includes literary, dramatic, musical, artistic, and certain other intellectual works as well as computer software. This protection is available to both published and unpublished works. The Copyright Act generally gives the owner of copyright the exclusive right to conduct and authorize various acts, including reproduction, public performance and making derivative works. Copyright protection is automatically secured when a work is fixed into a tangible medium such as a book, software code, video, etc.
- B. Although copyrightable works do not require a copyright notice, we do recommend that you use one. The notice should contain all of the following three elements: the symbol © (or the word “Copyright,” or the abbreviation “Copr.”); the year of first publication of the work; and the name of the owner. Additional information may be added afterwards to clarify origination of the work.
- C. A copyright owner has the exclusive right to do and authorize any of the following with the copyrighted work:
 - reproduce the work
 - make derivative works
 - distribute copies of the work
 - perform and display the work publicly
- D. Copyright Registration- Copyright automatically applies as soon as the work is fixed in a tangible form, assuming the work is copyrightable. Registration is not required for the rights described above to apply. However, a copyright must be registered with the U.S. Copyright Office before a legal suit for alleged infringement can be filed in a United States court. The copyright owner is eligible for statutory damages and attorney’s fees if registration is done prior to infringement.
- E. Ownership of Copyright-It is traditional at The University of West Alabama and other universities, for copyrightable works of a faculty member to be deemed the property of the creator, who is considered to be entitled to determine how the works are to be disseminated and to keep any income they

produce. This tradition reflects the University's commitment to encourage members of the University community to write and to publish what they wish.

The University disclaims any ownership interest in the copyright of works created by faculty, staff, postdoctoral fellows and postdoctoral associates and students, whether in traditional or nontraditional forms, except in the following cases:

Supervised Works:

The University will own the copyright to works created

- (i) by student employees in the course of their assigned duties of employment, including duties as teaching or research assistants, or
- (ii) by faculty members, staff members or postdoctoral fellows or associates as part of an assigned task where the University
 - (a) specifically assigns an individual to create a particular work or
 - (b) selects or supervises choice of subject matter and supervises content, course, and direction of the effort to create the work or retains editorial control over the final work product.

Supported Works:

In the event that Substantial Use of University resources (defined below) is involved, the creator and the University will share copyright ownership. Reimbursement of Substantial Use costs and/or a division of royalties may be required. **Substantial Use of University** resources occurs when development or creation involves the use of University resources beyond the following:

1. Customary use of assigned office space, laboratories, or studios, or of libraries; of library collections, subscriptions or services; of secretarial or other staff assistance; of computer time or computer or lab equipment on hand; of network or Internet access; of standard office equipment and supplies.
2. Sabbaticals; summer or other research grants provided by the University or University-affiliated units; other support customarily provided to faculty and staff.

Externally Sponsored Works:

Where copyrighted materials are developed by an investigator in the course of sponsored research funded by an outside agency, ownership of the copyright will be determined by the applicable terms of the funding agreement. The University reserves the right to seek copyright ownership for itself and/or its employees as appropriate during negotiation of the

award or externally sponsored program. If the agreement is silent on copyright ownership, then the creator of the work will have full ownership of the copyright in any works created in the course of sponsored research.

If it is determined that copyright is owned or shared by the University, rights to those materials shall be negotiated individually. Terms to be negotiated may include assignment of copyright, license of rights, and division of royalties.