

## **Patent Policy**

### **I. Purpose**

In the course of research and scholarship activities conducted at The University of North Alabama (UNA or the University), new discoveries and inventions will develop. UNA is dedicated to ensuring the public service mission of the university is served through the development of patents and intellectual property rights related to scientific discoveries and inventions. Patent laws and legal ownership rights are an important tool for maintaining accountability and oversight of discoveries and inventions made with support from the University. Employees and students may require assistance evaluating the patentability of new discoveries and inventions and pursuing patents where they may reasonably result in benefits such as future royalties. Questions of ownership may be uncertain as a result of sponsorship or use of facilities in partnership with other entities than UNA, which may require substantial guidance to resolve. The purpose of this policy is to protect the public interest by applying reasonable standards to the development of patents to ensure equity and ownership of new discoveries and inventions that may be generated by UNA, to specify the rights of parties to inventions and discoveries, and to establish a procedure to determine the equity, ownership, and patentability of such inventions and discoveries.

### **II. Policy and Procedure**

A. UNA policies shall encourage and promote inventions and discoveries and provide for their disclosure and ownership for the public benefit. UNA's participation in the production of new inventions through support for research and facilities creates an equity position in new inventions and it is reasonable for UNA to share in the benefits of such inventions, including reimbursement of reasonable expenses. Therefore, UNA will participate in the patent process and commercialization of inventions where such activities and inventions are judged to be sound investments of University resources. Activities undertaken will be performed in the interest of the public, the inventor, and the University.

B. The Vice-President for Academic Affairs and Provost (VPAA) of the University shall administer this policy and may appoint a patent administrator<sup>1</sup> to administer this policy.

C. Adherence to this patent policy shall be a condition of employment at the University of North Alabama for all employees regardless of status of their employment, including student employees, all faculty and staff, and contract employees. This policy shall apply to all students enrolled and attending the University of North Alabama. Its contractual obligations shall extend beyond employment and attendance and continue in perpetuity as necessary to enforce its provisions.

D. Any invention or discovery 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, controlled or administered by the University, or which is made by an employee of the University and which relates to the employee's field of work, or which has been developed in whole or in part by the utilization of resources or facilities belonging to the University, shall be the property of the University, subject to the ownership principles set out below. These principles are presented in order of precedence for clarity and when one applies the higher ordered principles shall not apply. In order of precedence, ownership of intellectual property shall be specified as follows:

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<sup>1</sup> The patent administrator is the Director of Grants and Sponsored Programs.

(1.) Sponsored Project Agreements: The University may negotiate and sign Sponsored Project Agreements including contracts and grants between external sponsors such as corporations, government agencies or foundations and the University that specify completely or partially the ownership of Intellectual Property created as a result of specific sponsored projects. This category includes ownership requirements that result from a government funding source by operation of law (e.g., laws pertaining to Intellectual Property created using federal funds). All individuals working on a project under such a Sponsored Project Agreement shall be notified in advance of the terms of ownership in said agreement for any Intellectual Property they may create during the project. Although most sponsored project agreements would be for funded research projects, they should be available for other kinds of work including pro bono projects.

(2.) Individual Project Agreements: The University may negotiate and sign Individual Project Agreements between the University and an individual member(s) of the faculty, staff or student(s) that specify completely or partially the ownership of Intellectual Property created as a result of work conducted on a specific project. Individual Project Agreements by the University and potential creators are encouraged especially in situations that lack precedent and do not naturally fit into standard Intellectual Property practices.

(3.) University Sponsored Projects: The University may initiate and fund specific projects that produce Intellectual Property and shall own the Intellectual Property created as a result of such projects. Whether or not a project should be undertaken as a University Sponsored Project shall be determined by the purpose of the work and not the form of the Intellectual Property to be created. In particular, the University shall own Intellectual Property created by University employees and students who were assigned or employed specifically to produce (work-for-hire) a particular piece of Intellectual Property. The financial terms or other terms of support for University Sponsored Projects can vary from project to project as long as the participants are properly informed of the terms of the agreement for the project before they begin work on it.

(4.) Traditional Academic Rights: In keeping with academic traditions at the University, the creator shall retain ownership to the following types of Intellectual Property, without limitation unless part of an agreement under the above principles of ownership: books (fiction, nonfiction, poetry, textbooks etc.), articles, poems, published standardized tests, student papers (themes, term papers, reports, exams, etc.) musical works, dramatic works including any accompanying music, pantomimes and choreographic works, pictorial, graphic and sculptural works, motion pictures, video recordings, and sound recordings. This provision does not automatically include computer software, databases, and other electronic media because no academic tradition exists for them. Until standard practices emerge creators of any innovative Intellectual Property are encouraged to pursue Individual Project Agreements with the University.

(5.) Consulting Agreements: Intellectual Property created by University personnel who are consulting with external entities (corporations, businesses, government agencies, foundations, etc.) without making essential use of University funds, resources or facilities and while abiding by University policies on consulting is presumed retained by the external entity or the individuals as specified by the terms of the consulting agreement. Student employment with external entities will be considered as consulting under this policy, and externally employed students will be responsible for respecting the Intellectual Property policies of both the University and their employers.

(6.) Independent Projects: Any Intellectual Property created by a University employee that is not part of its creator's employment responsibilities and that is developed on his/her own time without making essential use of University funds, resources or facilities shall be owned by the creator.

When a student creates Intellectual Property independently, using only resources available in common to all students such Intellectual Property is owned by the student. However, Intellectual Property created by a student(s) when working for pay or academic credit, or voluntarily working on faculty projects or University Sponsored Projects is subject to the other six ownership principles.

(7.) Other Intellectual Property Generated by University Activities: University personnel and/or students frequently produce Intellectual Property from their work within the scope of the mission of the University that is not covered by the above ownership principles. The University shall be the owner of Intellectual Property, when its ownership is not governed by any of the previous items and when said Intellectual Property was created within the normal scope of employment and/or study or a direct result thereof, and shall share any revenues from it as prescribed in section H. The creator of any Intellectual Property that is or might be owned by the University under this policy is required to make reasonably prompt written disclosure of the work to the University. Depending on the nature of this Intellectual Property, it may be subject to patent or copyright policies.

The applicability of the above stated criteria to any invention or discovery will be determined at the sole discretion of the VPAA or his/her designee.

E. Each faculty member, employee and student agrees to report to the VPAA or patent administrator so designated by the VPAA any invention or discovery that such faculty member, employee or student has conceived, discovered, developed and/or reduced to practice at any time following their initial appointment, employment, or enrollment with the University. All inventions and discoveries are hereby assigned according to section II.D. Faculty members, employees and students do not have the authority to assign University rights in such inventions and discoveries to third parties. The patent administrator so designated by the VPAA shall manage and commercialize such inventions and discoveries with the technical support of the faculty member, employee, or student. The University may contract with the inventor to facilitate and provide technical support for commercialization following their appointment, employment, or enrollment at UNA. The VPAA is authorized to further assign any invention or discovery UNA is deemed to own pursuant to this policy to a designated nonprofit organization established for the benefit of the respective campus of the University, which said assignment shall be conditioned on full compliance with this policy, regulations promulgated hereunder by the University, and appropriate state and federal law.

F. If the invention or discovery is one which is determined to be owned by the University, the VPAA or his/her designee shall further evaluate the invention or discovery and determine if and how best to develop, commercialize and protect the invention as he/she deems appropriate, including, but not limited to, specifying the form and procedures for disclosure and recordkeeping, applying for patent protection, or requesting further development of the invention or discovery, or referring the invention to outside counsel for further evaluation. In making this determination, the benefits that might accrue

to both the University and the inventor(s) shall be considered. The designee shall act promptly in carrying out these duties so that the rights of the inventor(s) and the University may be protected.

G. 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 release its ownership rights to the inventor(s) on terms and conditions determined by the VPAA or his/her designee, subject to any third party rights. Neither the University nor any nonprofit entity to which ownership may have been assigned in accordance with this policy is obligated whatsoever under any circumstances to release any right of ownership.

H. In consideration of the assignment of ownership to the University as set forth in this policy, the VPAA or his/her designees are authorized to pay to the inventors, their heirs or assigns, fifty percent of the royalties, fees, or other financial returns received by the University (or the non-profit organization to which an invention may have been assigned in accordance with the terms of this policy) from such invention after a deduction of fifteen percent (15%) thereof for overhead costs, plus a deduction for costs of patenting and protection of intellectual property rights and any unusual expenses paid by the University or its non-profit designee or the inventor (which have been approved by the University or its non-profit designee).

I. Annual reports of patent matters will be made to the Board of Trustees for their information within 180 days following the end of each fiscal year, to include as a minimum identification of each patent and patent applied for, the distribution of patent revenue including the share going to the inventor, and the expenses of obtaining and managing patents. The VPAA may prescribe the appropriate format for such reports.

The Office of Grants and Sponsored Programs is responsible for the review of this policy every four years or as needed.

This policy was adapted in part from policies of the University of Alabama at Birmingham and Lehigh University.

**Approved 10/21/2020**