

XIII. GEORGETOWN UNIVERSITY INTELLECTUAL PROPERTY POLICY

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 employees, including faculty, administration, and staff, as well as students and fellows, who may not be compensated for their activities (hereinafter collectively referred to as "Covered Individual(s)"). 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 Intellectual Property Policy (hereinafter "this Policy") has 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 Covered Individual, provided such invention was made:
 - a. during a research or other assignment given to a Covered Individual 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 Covered Individual exclusively on his or 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 an employee ;
 - c. In order to avoid a conflict of interest, a Covered Individual 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 Covered Individual 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. A Covered Individual who has developed an invention under Paragraph B1 or B3 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 B1, B3, and B4 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. Once rights have been released to the Inventor, University funds (including funds in discretionary GD accounts) may not be used to file a patent application or commercialize 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 this Policy shall be deemed to be a part of the terms of employment of University faculty, administrators and staff, and the terms of enrollment of University students.

C. Patent Law and the Inventor

The 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 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 OTL 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 OTL 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 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. Duty to Disclose Inventions

Inventions conceived and/or reduced to practice and which are covered by B1, B3, or B4 must be disclosed fully and in good faith to the OTL. When an Covered Individual conceives or reduces to practice an invention and judges that it may be valuable and serve the public good, that individual is required to report the invention through the Chair or Director of his or her Department, Center, or Institute to the OTL 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 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 an Inventor of patents on inventions to which the University has a right of ownership as described in Paragraph B1 without disclosure of the invention to the OTL 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 OTL. The University retains this right of approval exclusively to itself.

E. The University Office of Technology Licensing (OTL)

The Office of Technology Licensing (hereafter "OTL") shall be administered by a Vice President for Technology Licensing reporting to the Senior Vice President & Chief Administrative Officer of Georgetown University.

1. *Patenting of Inventions.* The OTL 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 OTL'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 OTL. 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 OTL, and the Inventor will be advised throughout the interaction with potential sponsors.

2. *Licensing of Inventions.* The OTL 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.

Once a company has decided to develop or commercialize an invention, the appropriate agreements will be drafted and negotiated with the licensee. Inventors will be kept informed of the negotiations and their input will be sought as appropriate. The University does not differentiate as to the validity of the views of different inventors on the same patent application, but shall give due consideration to these views, and shall negotiate at all times in the interest of the University as a whole. Model agreements for interactions with commercial sponsors are available (Appendix B). Legal counsel will be consulted as required. The licensing agreement will be maintained by the OTL which will be responsible for its administration.

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.

3. *Service to Inventors.* The OTL 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 OTL will ultimately benefit the development of the idea. Members of the OTL 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.

4. *Financial Records and Reports.* The OTL 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 G below. The Inventor has the right to examine the financial records of the OTL related to his or her inventions and copyrights.

5. *Assignment of Ownership to Inventors.* It shall be the policy of the OTL, when a decision is made not to file a patent application on a particular invention, or to abandon all patents on a particular invention, to offer to assign to the inventor(s) ownership of the particular invention, subject to the rights of the United States Government in federally funded inventions. The University shall not differentiate between inventors. Circumstances may require that a written agreement be submitted to the University signed by all inventors concerning the inventors' joint decision as to the invention's disposition.

F. The University Committee on Intellectual Property (CIP)

The University Committee on Intellectual Property (hereafter "CIP") shall be appointed by the President with representation from the principal faculties potentially affected by policies in this area and from the administration. It is chaired by, and is advisory to, the Vice President for Technology Licensing.

1. *CIP Membership and Meetings.* Membership of CIP shall comprise eleven faculty members, the Chief Financial Officer and Treasurer (or his/her designee), the General Counsel (or his/her designee), and the Vice President for Technology Licensing (Chair). The faculty membership shall include six faculty members nominated by the EVP of the Medical Center, three faculty members nominated by the Provost, and two faculty members nominated by the Faculty Senate. The CIP will meet at least quarterly, or more often if needed.

2. *CIP Functions.* It shall be the function of the CIP to advise the Vice President for Technology Licensing with respect to:

- a. guidelines and procedures for implementation of the this Policy;
- b. interpreting and applying this Policy in individual cases;
- c. resolving disputes concerning the interpretation and application of this Policy;
- d. recommending such changes in University policy, as may from time to time be desirable, to the Faculty Senate for formal deliberation and vote, and thereafter, for final approval to the President and the Board of Trustees. In particular, the CIP will periodically review specific dollar figures in this policy, and recommend revision as appropriate.

3. *Dispute Resolution.* The CIP will assist in the resolution of all disputes between individuals, or individuals and the institution, regarding ownership of patentable inventions or copyrights. The CIP will also assist in the resolution of disputes between Departments and other units over the distribution of royalties and other proceeds as described in Section G1 of this Policy. The CIP will review as appropriate the factual

background of the dispute, which may include examining relevant documents and records relating to the invention's inception and development and/or interviewing potential Inventors and others who might be able to assist the CIP in its understanding of the dispute. After its review, the CIP will recommend a proposed course of action to the Vice President for Technology Licensing, whose decision is final.

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

Georgetown University assumes financial responsibility for inventions to which it takes ownership. This responsibility includes but is not limited to the costs of assessing patentability, filing and maintaining patents, marketing and licensing inventions, maintaining records, and defending against 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 OTL is required to use the University's resources carefully, with a view to promoting the fiduciary interest of the institution as a whole.

1. *Distribution of Royalties and Other Income.* Distribution of all royalties and other income from intellectual properties owned by the University shall be as follows:

a. Deductions from Gross Receipts. All direct expenses related to prosecuting and maintaining a patent, including fees for outside legal counsel, shall be reimbursed to the OTL from receipts related to the invention. In addition, 15% of gross receipts from each invention shall be allocated to the budget of the OTL. When the overall revenues from such receipts are sufficient to support the activities of the OTL, the percentage amount of the allocation may be reduced so that only the actual costs of the OTL's operations are deducted from gross receipts.

b. Net Receipts. "Net Receipts," which shall be defined as gross receipts less the deductions in the preceding subsection a," shall be distributed as follows:

One-half of Net Receipts (50%) shall be distributed to the Inventor(s) of the intellectual property. With respect to all intellectual property reported to the University pursuant to Section D of this Policy on or after May 4, 2006, the Inventor(s)' share shall be reduced to thirty per cent (30%) of Net Receipts once the Inventor(s) have received \$5M in cumulative Net Receipts.¹ Thereafter, thirty percent (30%) of Net Receipts shall be distributed to the Inventor(s). An Inventor's entitlement to payment under this paragraph is not dependent upon his/her continued employment at the university. In the case of the death of the Inventor, payment will be made to the Inventor's estate. If the payment is to be made over time, the payments will be made over the life of the patent. At the option of the

¹ Inventors who reported intellectual property to the University under Section D above prior to DATE, the effective date of the amendment of this section, remain entitled to that percentage of Net Receipts allotted them under University policy applicable at the time of the report.

Inventor, the Inventor's share may be returned to the Inventor's laboratory rather than to the Inventor personally. When there are two or more Inventors of a property, the Inventors' share of Net Receipts shall be allocated equally among the Inventors, unless a prior written agreement executed by all Inventors, the Executive Vice President for Health Sciences, and the Vice President for Technology Licensing provides a different allocation.

10% of Net Receipts shall be distributed to the President of the University (or his/her designee) for support of research and development throughout the institution;

30% of Net Receipts (40% of Net Receipts following the reduction of the Inventors' share from 50% to 30%) shall be distributed to the Executive Vice President of the Inventor's campus area (Main Campus, Medical Center, or Law Center). If the Inventor holds appointments on more than one campus, the campus share shall be divided among the EVPs proportional to the percentage of support provided. 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% of Net Receipts (20% of Net Receipts following the reduction of the inventors share from 50% to 30%) shall be divided among the Departments, Centers, Institutes, Programs, Sectors, and Schools (hereinafter in this paragraph collectively "the Department(s)") in which the Inventor holds an academic appointment or staff position and from which the Inventor received his or her support, with the royalties to each proportional to the support it provided. Support shall be defined as financial support including without limitation, indirect costs and overhead recovered through grants and funded research (RX accounts), departmental funds (GX, GP or GD accounts), and lab space. In the event an Inventor reports an invention within a year after changing Department(s), there is a presumption that the royalty shall be split equally between the Department in which the Inventor formerly held and subsequently holds academic appointment(s).. A Department's entitlement to payment under this paragraph is not dependent upon the Inventor's continued employment by the University. Disputes arising under this section shall be resolved by the EVP for Health Sciences with advice from the CIP.

In any case involving multiple Inventors, the proportionate allocation of Net Receipts to the Inventors' respective campuses and Departments shall parallel their proportionate distribution to the Inventors.

2. Distributions of Equity. Distributions for license agreements containing equity arrangements will follow the same formula. Such distributions may require stock liquidation. All such distributions will be determined by the Chief Financial Officer and Treasurer.

H. Copyright and Traditional Scholarship

“The primary objective of the copyright is not to reward the labor of authors, but ‘[t]o promote the Progress of Science and useful Arts.’ To this end, copyright assures authors the right in their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.” (Feist Publications, Inc.. v. Rural Telephone Service Co., 499 U.S. 340, 349 (1991), Justice Sandra Day O’Connor)

1. *Purposes.* A main goal of Georgetown University, as a student-centered research 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.

2. *Traditional Independent Scholarship.* These 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. In general, the University does not claim “work for hire” status under Title 17 of the U.S. Code for such works. Traditionally, most published works written by members of the faculty have been viewed as the property of the author and have been published under agreements made by those authors without participation of the University. Where the criteria in Section II below apply, a formal agreement between the University and author must be made pursuant to the procedure described in Section I4 below.

3. *Support for Fair Use.* The University strongly encourages faculty members who publish traditional scholarly works to become familiar with their rights under copyright law, and to negotiate contracts with publishers that preserve rather than waive these rights. The University will seek to make available scholarly work of faculty on institutional servers in a manner consonant with copyright law, and encourages faculty to negotiate terms with publishers that allow access by the Academy and students. For information on copyright and fair use, see <http://www.lib.umn.edu/copyright/map.phtml>.

I. Copyright and Other Intellectual Property.

While the University generally has not sought assignment by Covered Individuals of the copyrights in their traditional scholarly works (written or edited), it has generally required assignment of ownership rights in all other Intellectual Property made or conceived by Covered Individuals utilizing the facilities, equipment, funds or other contributions of the University to a degree that is substantially in excess of what is normally provided to Covered Individuals. Consequently, in cases not involving traditional scholarly works, when the University provides substantially more than the usual support for the creation of copyrightable material or commercially valuable

collections of information – for example, by subventing publication of scholarship or by committing University resources for the development of digital materials for teaching and learning – formal arrangements (created at the OTL) must be drafted in order to ensure that rights, responsibilities, and prospective revenues are shared equitably between those who develop the Intellectual Property and the University as the provider of auspices and facilitating resources.

1. *Publication Subvention.* In those instances when both (1) the University pays the full or a substantial part of the cost of publication (including such costs as printing, editing, etc., but excluding the salary of the primary author(s), and (2) the royalties or revenues from the publication are likely to exceed \$10,000, formal agreements concerning the ownership of the copyright and the division of these royalties must be made pursuant to the procedure described in Section I4 below.

2. *Software and Digital Resources.* Distinctions that once were common between texts intended to convey information (and subject to copyright guidelines) and research tools (potentially subject to patent guidelines) have become less tenable at a time when software is both copyrightable and potentially patentable and when courseware and digital academic resources are characterized by a high degree of interactivity. Software development by Covered Individuals frequently receives extensive support from the University. Similarly, digital resource for teaching and learning – that is, software (including Web pages programmed in native HTML, XML, or similar protocols, or created using an authoring package or a courseware-development system) and digital content materials designed for display and dissemination over the internet or over the University's own network frequently are based upon the work of many hands (including instructional designers and technical staff), and they frequently depend upon the University's network and computer systems and the staff who support them. Consequently, the University may require assignment of an ownership interest in software, including courseware and digital academic resources, developed by Covered Individuals at the University. Formal agreements for these categories of Intellectual Property must be created in order to spell out the respective rights of the individual developers and the University. However, in order to encourage the development of technology-based instructional materials, the University may choose not to exercise its claim to such resources and instead to consider the copyright to lie with the developer(s). In particular, the University will not require assignment of ownership for basic web pages or entries in a course management system that are created and maintained by Covered Individuals without substantial assistance, and that simply provide information (including but not limited to reading assignments, other course requirements and links to relevant external Internet resources) specific to a faculty member's course(s) and/or information about or copies of publications and other professional activities of a Covered Individual.

3. *Collections of Information.* The creation and maintenance of collections of information also frequently require extensive technical, staff, and systems support from the University. Consequently, the University may require assignment of an ownership interest in collections of information developed by Covered Individuals as resources for scholarship and research. Formal agreements for this category of Intellectual Property

must be created in order to spell out the respective rights of the individual developers and the University. However, in order to encourage the development and maintenance of such collections of information, the University may choose not to exercise its claim to such materials and instead to consider copyright and other ownership interests to lie with the individual developer(s)

4. *Formal Agreements.* Formal agreements between the University and Covered Individuals who develop software, digital resources, or collections of information will be created by the OTL. Because ownership of Intellectual Property is divisible in many ways, these formal agreements will generally be based upon an unbundling and distribution of ownership rights in order to grant the developers and the University the rights each finds more advantageous and the responsibilities each is best qualified to discharge. For example, if the University has made a substantial contribution (through its systems and support expertise) to the creation of software, digital resources, or collection(s) of information, a formal agreement may assign or license to the University the ability to exercise certain rights, including but not limited to:

- a. the right, on a limited, non-exclusive basis for the University to make and distribute copies of the material for use in teaching, scholarship, and research within the University.
- b. the right to control whether the University's name or logo is displayed in association with the material.
- c. the right to require an appropriate acknowledgement of University support in the creation of the material.
- d. the right to reproduce and distribute portions of the material in compilations or other composite works,
- e. the right to reproduce and distribute portions of the material for uses directly related to advancing the mission or maintaining the culture of the University.
- f. the right to be informed in advance of any licenses or assignments of the material by the author(s) or developer(s).

In addition, the formal agreement may specify certain situations or conditions that would trigger the application of a secondary policy. For example, if software, digital resources, or collection(s) of information are commercialized and they generate revenues, the University may reserve the right to a certain percentage of royalties to recover any investment it may have made in such software, digital resources, or collection(s) of information. As a second example, if the University, as an incentive for development, pays a stipend to a researcher to create software, digital resources, or collection(s) of information, that stipend must be repaid to the University from any revenues that accrue from the subsequent marketing of the materials.

5. *Responsibility to Initiate Formal Agreements.* In the case of software, digital resources, or collection(s) of information likely to require the use of University resources for creation, expansion, or maintenance, it is the responsibility of the Covered Individual(s) to initiate a formal agreement with the OTL. In the absence of an agreement to the contrary, the University will claim all authorship rights in software, digital resources, or collection(s) of information created with University assistance as works made for hire under the Copyright Act Title 17 of the United States Code. However, a Covered Individual need not report or initiate formal agreements for basic Web pages or entries in a course management system that are created and maintained by that individual without substantial assistance, and that simply provide information (including but not limited to reading assignments, other course requirements, and links to relevant external Internet resources) specific to a faculty member's course(s), and/or information about or copies of the publications or other professional activities of the Covered Individual. A Covered Individual also need not report or initiate formal agreements for that employee's personal archives of data or of other materials relating to scholarship or research.

J. Consulting.

Problems may attend the disposition of Intellectual Property that results from activities of Covered Individuals while engaged in the service or at the direction of a firm or institution other than the University. In general, the University recognizes the benefits of such activity to Covered Individual, and often to itself. However, the University is concerned about conflicts of interest that may arise from such activity. (Please refer to the Faculty Handbook under "Extramural Professional Activity" and the Financial Conflicts of Interest Policy.) In addition, the University is concerned not only about the potential loss of revenue but also about the imposition of noncompete clauses that may hinder Covered Individuals from pursuing the University's mission of teaching and research or prevent Covered Individuals from participating in University-sponsored research-and-development projects.

1. *Consulting, Intellectual Property and University Resources.* In the cases of consulting activities involving the use of Intellectual Property developed with University resources, the Covered Individual should provide to the OTL a copy of any contract for work sponsored by an entity other than the University when the terms of the contract vest control of any resulting intellectual property in that entity. In such cases, the University may require that a formal agreement be created concerning the ownership of such resulting intellectual property, pursuant to the procedures described in Section I4 above. No consulting contract shall restrain or inordinately delay publication of the results of a researcher's University-related activities.

2. *Consulting, Intellectual Property, and Non-print Media.* In the cases of consulting activities resulting in the production of non-print analog or digital instructional materials (for example, for distance learning) for an entity other than the University, the Covered Individual should provide to the OTL a copy of any contract for such activity. In such

cases, the University may require that a formal agreement be created concerning the ownership of the resulting intellectual property, pursuant to Section I4 above.

K. Intellectual Property and Work for Hire

1. *Employees.* In general, copyrightable material created by a Covered Individual 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 property of the University. However, in the case of software, digital resources, collection(s) of information, or other audiovisual educational materials created by Covered Individuals pursuant to specific direction or assignment, the University may choose to share ownership with the individual developer(s). In such cases, formal agreements between the University and the individual employees will be created pursuant to the procedures described in Section C4 above, except that it is the responsibility of the University department or unit overseeing creation of the material to initiate review by the OTL.

2. *Students.* 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. As a condition of matriculation, however, the University reserves the right to make copies of dissertations as needed for the academic and archival purposes of the institution. In addition, the University requires that students waive any claims against the University, its employees, or fellow students arising out of the reproduction, excerpting, and/or distribution of student-authored postings to University-sponsored courseware Web sites or course management systems as needed for the academic, research, and archival purposes of the institution. Students working on a project governed by a contract or agreement to which the University is a 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 authorship or ownership rights in that work unless they have a prior written agreement with the author.

L. 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.

Covered Individual: For purposes of this policy, any Georgetown University employee, (including without limitation faculty, administration, and staff members) or any student or fellow, who is engaged, whether or not for compensation, in University research work from which an invention or copyrightable work is developed.

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

Invention: Any new and 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 Development: Investigation of fundamental knowledge or its applications 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.

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

Work Made For Hire: Intellectual property produced in the performance of a grant or contract or as a part of an employee's assigned work responsibilities.

Appendix B – Documents

Copies of the following documents can be obtained from the OTL or its website (<http://otl.georgetown.edu/>).

Georgetown University Invention Disclosure Form

Model Confidential Disclosure Agreement

Model Materials Transfer Agreement

Model Exclusive and Non-Exclusive Licensing Agreements

Revised May 4, 2006