

INTELLECTUAL PROPERTY POLICY

D-R-A-F-T

Friday, May 3, 2004

I. GENERAL

- A. Purpose. The University is committed to providing an intellectual environment in which all members of the academic community – whether they are faculty engaged in life-long professional development, students pursuing educational objectives, or staff dedicated to their own career goals – learn to the fullest extent possible. The University also recognizes and values creativity and innovation as part of this learning process. Similarly, the University recognizes the importance of, and wishes to encourage, the transfer of new knowledge, generated in the University, to the private sector for the public good. At the same time, as a publicly funded institution, the University must be a good steward of the public resources provided to it, and must safeguard against the use of public funds for the sole purpose of private gain.
- B. Scope. This policy addresses the rights to, interest in, and protection and transfer of intellectual property created by University faculty, staff and students. Issues not directly considered in this policy, including disagreements concerning its application or interpretation, will be addressed and resolved consistent with applicable law or agreements, and the principles and provisions of this policy. Policies affecting the use of the University's names or symbols are covered elsewhere.
- C. Governing Principles. The following principles underlie this policy and should guide its application and interpretation:

1. Academic Freedom and Preeminence of Scholarly Activities. The missions of teaching and scholarship have preeminence over that of the transfer and commercialization of research results. The University's commitment to its educational mission is primary, and this policy does not diminish the right and obligation of faculty members to disseminate the results of research and creative activity for scholarly purposes.
 2. Equity and Fair Play. This policy sets forth general principles and procedures, and it has not been designed to address every conceivable circumstance. Under principles of fair play, the inventor(s)/creator(s) and the University mutually operate so that no one will unfairly exploit inadvertent errors or omissions in the written policy. If the need for corrections or exceptions to this policy are identified, appropriate recommendations shall be made to the President.
 3. Mutual Trust and Goodwill. Throughout all phases of the creation and implementation of this policy, it is assumed that all members of the University community will be guided by a sense of mutual trust and goodwill. In the event of future controversies regarding the rights to intellectual property, the commercialization of particular property, or in the interpretation of this policy, all parties should recognize that mutual trust and goodwill were fundamental tenets in the forging of this policy.
 4. Faculty Governance and Review. University faculty, through the Intellectual Property Review Committee, shall play a primary role in the establishment and periodic revision of this policy, and in the review and recommendation of resolutions to disputes arising under it. This committee shall have a majority of members who are faculty without administrative appointments, and shall be chaired by a faculty member.
 5. Transparency. The principle of transparency promotes both the disclosure and avoidance of actual and apparent conflicts of interest associated with external commercial activities.
 6. Reasonableness in Licensing. When the University owns intellectual property under this policy, the inventor or creator shall normally play an active role in the entire licensing process, including consultation and/or approval of licensing decisions, particularly where the inventor/creator has no financial interest in the licensee. Otherwise, such participation shall be consistent with conflict of interest regulations or University policy.
- D. Policy Application. This policy takes effect immediately and supercedes all prior intellectual property policies.
- E. Key Terms. For purposes of this policy, the following key terms are defined as follows:

1. "Intellectual property" means inventions, discoveries, innovations, and copyrightable works.
2. "Inventions," "discoveries," or "innovations" include tangible or intangible inventions, whether or not reduced to practice and tangible research products whether or not patentable or copyrightable. Such research products include, for example, computer programs, integrated circuit designs, industrial designs, databases, technical drawings, biological materials, and other technical creations.
3. "Copyrightable works" mean original works of authorship fixed in tangible media of expression.
 - a. "Works of authorship" include literary, musical, dramatic, audiovisual, architectural, pictorial, graphic and sculptural works and sound recordings. Computer programs are works of authorship to the extent they are protected by the federal copyright laws.
 - b. "Tangible media of expression" include physical, digital and other formats now known or later developed from which copyrightable works may be stored, reproduced, perceived or otherwise communicated, either directly or with the aid of a machine or device.
4. "Software" means computer instructions (algorithms and code), data and accompanying documentation.
 - a. "Algorithm" means a logical arithmetical or computational procedure that if correctly applied ensures the solution of a problem.
 - b. "Source code" means an original computer program written by a programmer in human-understandable form. It is converted into the equivalent object code (written in machine language) by the compiler or assembler in order to run on a computer.
 - c. "Object code" means the form of a program that is executable by a machine, or usable by an assembler that translates it directly to machine-understandable language. This form of software is not readable or modifiable by human beings other than through extraordinary effort.
5. "Net Proceeds" means the net amount received in each fiscal year from the transfer or licensing of intellectual property after deduction of all costs reasonably attributable to such intellectual property, including without limitation any reasonable expense of patent prosecution, protection and litigation, and commercialization. Such direct costs typically include: legal filing fees; patent application; issuance and maintenance charges, transfer or licensing costs; and product development costs. All expenditures, special advances and repayment terms shall be identified and detailed in writing at the time they are made. The

time of regular University and Foundation personnel will not be included in the determination of costs attributable to intellectual property protection and commercialization.

6. "Equity interest" refers to beneficial rights (such as royalties) derived from intellectual property owned by another.
7. "Disclosure statement" means a written general description of a creation by the creator used to help assess the nature, extent and likely intellectual property interests in and development potential of the creation.
8. "Faculty" means members of Collective Bargaining Unit 3, as well as visiting professors, volunteer professors, and other individuals who may temporarily or sporadically carry out research and creative activities at Cal Poly in a capacity other than staff or student.
9. "Staff" means all non-faculty employees of the University or Foundation.
10. "Extraordinary resources" means, in the case of faculty, resources that would normally not be available to them or easily available to them outside the University, as well as resources that would not normally be available to most faculty at the University. In the case of students, "extraordinary resources" means resources that are not available to the majority of Cal Poly students in the course of their programs of study. The Intellectual Property Review Committee (Section III.A.2) will be responsible for assessing the University's contribution to a specific intellectual property in cases of disagreement between the inventor/creator and the University concerning this contribution.

II. OWNERSHIP AND OTHER INTEREST

A. Copyright.

1. Framework. This section deals with the ownership of copyrightable intellectual property created by faculty, staff and students (in separate sections). Faculty creations are governed by section II. A. 2; staff creations are governed by section II. A. 3; and student creations are governed by section II. A. 4.
2. Faculty Creations.
 - a. Faculty own the copyright to the scholarly and creative publications they develop, and the University is not entitled to an equity share in any profits, except in the circumstances listed below.
 - b. If the University provides extraordinary resources toward the creation of copyrightable property, the faculty will own the copyright but the University will be entitled to an equity interest in the profits derived from the

commercialization of the intellectual property, according to the provisions in section II.D.

- c. If the University initiates a creative project, solicits faculty participation in the project, and provides funding for the project, possibly including compensation/release time for the faculty member, the University will own the intellectual property rights developed through the project. Under these circumstances, there should be a written document, signed by the faculty member, acknowledging the University's ownership of the copyright to all intellectual property. At the discretion of the University and by prior written agreement between the parties, faculty involved in creating intellectual property under these circumstances may share in the profits that result from the project.
- d. If the University and an outside sponsor enter into an agreement to carry out research or other creative activity involving faculty, the faculty who participate in the project shall comply with the conditions of the agreement regarding ownership, protection and licensing of intellectual property developed under the agreement, and may be required to agree in writing that they will so comply. Copyright ownership terms of such agreements, even when they deviate from the ownership provisions of this policy, will be negotiated with the sponsor by the Dean of Research and Graduate Programs, in consultation with the faculty involved and the appropriate Dean(s).

3. Staff Creations.

- a. The University owns the copyright to works created by University staff in the course and scope of their employment.
- b. Staff persons own the copyright to all works created by them without the use of University resources and developed outside the course and scope of their employment, and the University has no equity interest in any proceeds derived from them. Staff persons are advised to notify the Dean of Research and graduate programs about their external activities if they have concerns that the University might claim ownership interests in any intellectual property resulting from those activities.
- c. The University or Foundation may employ or engage individuals under specific contractual terms that allocate copyright ownership rights between the parties in a different manner than specified above.
- d. There may be occasions when University staff also serve as faculty for the University. Under these circumstances, written agreements should be entered into in advance of undertaking any research or creative activity to clarify whether the individual is acting in their staff or faculty capacity in carrying out the activity. Unresolved questions on ownership may be directed to the

Intellectual Property Rights Committee and a recommendation regarding ownership rights will be made to the President.

4. Student Creations.

- a. Students will normally own the copyright to the scholarly and creative publications they develop, including works fulfilling course requirements (term papers and projects), Senior Projects, and Masters Theses/Projects. Students retain copyright ownership as long as they are not paid for the work that results in the creation and do not receive extraordinary University resources in support of the work. Nonetheless, by enrolling at the University, the student grants the University a nonexclusive, royalty-free license to mark on, modify, publicize and retain the work as may be required by the faculty, department, or the University. The University is not entitled to an equity share in any ownership profits, except in the circumstances covered below.
- b. When the student is employed by the University and the creation falls within the scope of that employment, either the University or the faculty member (when the student is hired specifically to work on a faculty project) owns the copyright according to the same standards that apply to staff creations, under sections II.A.3 above, or faculty creations under Section II.A.2 above.
- c. If the student receives extraordinary University resources that further the creation or development of the creative work, then the student owns the copyright, but the University retains an equity interest in the creation, using the same standards that govern faculty creations under section II.A.2 above.
- d. If the student is employed to work on a sponsored project and the creation falls within the scope of the research, then the student is bound by the sponsored project contractual arrangements governing the allocation of copyright ownership.
- e. When the student is employed by an outside entity and the creation falls within the scope of that employment, then the student normally will be bound by a contract with the outside entity, including any provisions for copyright ownership, and the University will have no rights to the intellectual property developed.

B. Patents.

1. Framework. This section deals with the ownership of patentable intellectual property created by faculty, staff and students (in separate sections). Faculty inventions are governed by section II.B. 2.; staff inventions are governed by section II.B. 3; and student inventions are governed by section II.B. 4.

2. Faculty Inventions.

- a. Faculty own the intellectual property resulting from their scholarly activity and the University is not entitled to any profits, except in the circumstances listed below.
- b. If the University initiates a creative project, solicit faculty participation in the project, and provide funding for the project, possibly including compensation/release time for the faculty member, the University will own all intellectual property rights developed through the project. Under these circumstances, there should be a written document, signed by the faculty member, acknowledging the University's ownership of the intellectual property. At the discretion of the University and by prior written agreement between the parties, faculty involved in creating intellectual property under these circumstances may share in the profits that result from the project.
- c. When the University provides extraordinary resources to the creation of intellectual property, then the faculty will own the intellectual property rights, but the University will be entitled to an equity interest in the profits derived from the commercialization of the intellectual property, according to the provisions in section II.D.
- d. If the University and an outside sponsor enter into an agreement to carry out research or other creative activities involving faculty, the faculty who participate in the project shall comply with the conditions of the agreement pertaining to the ownership, protection and licensing of intellectual property developed, and may be required to agree in writing that they will so comply. The intellectual property terms of such agreements, even when they deviate from the ownership provisions of this policy, will be negotiated with the sponsor by the Dean of Research and Graduate Programs, in consultation with the faculty involved and the appropriate Dean(s).

3. Staff Inventions.

- a. The University shall own all intellectual property rights in works created by University staff in the course and scope of their employment.
- b. The University has no equity interest in any proceeds derived from intellectual property that is created by staff without the use of University resources and that is developed outside the course and scope of employment. Staff persons are advised to notify the Dean of Research about their external activities if they have concerns that the University might claim ownership interests in any intellectual property that results from those activities.

- c. The University or Foundation may employ or engage individuals under specific contractual terms that allocate intellectual property rights between the parties in a different manner than specified above.
 - d. There may be occasions when University staff also serve as faculty for the University. Under these circumstances, written agreements should be entered into in advance of undertaking any research or creative activity to clarify whether the individual is acting in their staff or faculty capacity in carrying out the activity. Unresolved questions on ownership may be directed to the Intellectual Property Rights Committee and a recommendation regarding ownership rights will be made to the President.
4. Student Inventions. Students enrolled at the University may create valuable intellectual property while fulfilling course requirements, in conjunction with University employment, and/or through the use of University resources. The ownership interests in such intellectual property depend on the particular circumstances surrounding the creation. In particular, students must be careful to differentiate their own creative contributions from those of their faculty instructors and mentors. The following parameters apply:
- a. The student is not paid for the work that results in the creation and does not receive significant University resources in support of the work. In these circumstances, the student owns the intellectual property interests in the creation. This is true even if the intellectual property is created to fulfill course requirements or other academic requirements. Nonetheless, by enrolling at the University, the student grants the University a nonexclusive, royalty-free license to mark on, modify, publicize and retain the work as may be required by the faculty, department or the University. The University is not entitled to an equity share in any ownership profits, except in the circumstances covered below.
 - b. The student is employed by the University and the creation falls within the scope of employment. In these circumstances, either the University or the supervising faculty owns the intellectual property, according to the same standards that apply to staff creations under sections II.B.3 above, or faculty creations under Section II.B.2 above.
 - c. The student receives significant University resources that further the creation or development of the intellectual property. In these circumstances, the student owns the intellectual property, but the University retains an equity interest, using the same standards that govern faculty creations under section II.B.2, above.
 - d. The student is employed to work on a sponsored project and the creation falls within the scope of the research. Under these circumstances, the student is

bound by the sponsored project contract and its provisions governing the allocation of intellectual property rights.

- e. The student is employed by an outside entity and the creation falls within the scope of that employment. Under these circumstances, the student normally will be bound by a contract with the outside entity, including provisions intended to protect and allocate intellectual property rights, and the University will have no rights to the intellectual property developed.

C. Software.

1. The proprietary protection available for software is unique in that both copyright and patent are available. Copyright protection may cover the expression of the software ideas in a tangible medium, while patent protection may cover algorithmic inventions. Due to this dual approach, software should first be considered under the Patent provisions of this policy at II. B., and is therefore subject to disclosure of any underlying algorithms that appear to have commercial value. After consideration of patent protection for valuable software algorithms, copyright, at II.A, should be considered as additional or alternative protection.
2. In accordance with section I.C.1, the University favors the copyright and publication of source code as well as its underlying object code. This is in contrast with the common commercial practice that utilizes trade secrecy for source code in order to prevent the dissemination and discussion of any innovative ideas it reveals. As with the underlying algorithms that, if patented, must be published so that they may be studied and discussed by other researchers, the University believes that source code should be published in a form that is amenable to research and will promote scientific progress. The object code is similarly subject to copyright.

D. University Equity Interests. When the University provides extraordinary resources to the creation of intellectual properties, it enjoys an equity interest in the net proceeds derived from those properties. The amount that an individual creator/inventor must render to the University, in recognition of its equity interests, is determined as follows:

- a. When the amount of net proceeds received by an individual creator/inventor in a calendar year, from all intellectual properties subject to University equity interests, is equal to or less than \$100,000, then the University is not entitled to any portion of the net income derived from those intellectual properties.
- b. When the amount of net proceeds received by an individual creator/inventor in a calendar year, from all intellectual properties subject to University equity interests, exceeds \$100,000, the allocation of net proceeds in excess of \$100,000 will be negotiated between the University and the individual creator/inventor. Such negotiations will be based upon the extent of use of University resources and the degree of control and initiative exercised by the

University. In no case will the University's share of annual net proceeds that exceed \$100,000 be greater than 50%.

III. ADMINISTRATIVE PROCEDURES

A. The University.

1. University Administration. The University President is responsible for policy matters relating to intellectual property and affecting the University's relations with inventors and creators, public agencies, private research sponsors, industry, and the public. The Office of the Provost, through the Dean of Research and Graduate Programs, and in coordination with the Cal Poly Foundation, shall implement and administer this policy, including negotiation of intellectual property terms in agreements with sponsors, evaluation of patentability or other forms of intellectual property protection, filing for patents, negotiation of use rights, and the pursuit of infringement actions.
2. Intellectual Property Review Committee. The University President shall appoint an Intellectual Property Review Committee. The Committee shall be composed of eleven members, eight of whom shall be members of the faculty, without administrative appointments, and nominated by the Academic Senate. These eight appointees shall represent each college, Professional Consultative Services, and the University Center for Teacher Education. The other three members shall include the Chair of the Academic Senate Research Committee, the Dean of Research and Graduate Programs, and a student representative appointed annually by the ASI President. A faculty member shall chair the Committee. Faculty appointees shall serve three-year staggered terms. The Committee shall review and monitor University activities on matters relating to the administration of this policy. The Committee shall be consulted in advance concerning any material changes to the policy and shall participate fully in the future development of the policy. The Committee shall also administer a review process for the allocation of the University's net proceeds from intellectual property.

When necessary, the Committee shall review invention disclosures and other information to evaluate the University's contribution to the development of particular intellectual properties. In many cases the inventor/creator will reach an agreement with the University concerning ownership rights without the need for review by the Committee. In making its assessment, the Committee will rely on information provided by both the inventor/creator and the University. Committee deliberations will be in closed session to protect proprietary information. Similarly, committee records will be kept confidential and committee members will be bound to maintain confidentiality. The purpose of the review shall be to help the parties reach agreement within the framework of this policy.

In the event of any disagreement among interested parties concerning interpretation or application of this policy, the Committee will serve as the

appellate body advisory to the University President. In cases where the Committee is unable to resolve such disagreements to the satisfaction of the interested parties, then it shall submit a written recommendation for resolution of the dispute to the University President for a final administrative decision.

At the beginning of each academic year, the Foundation will provide to the Dean of Research and Graduate Programs a summary statement of income and expenses from intellectual property in which the University has an interest, if any, and an accounting of income and disbursements of the Commercialization Fund and the Research Fund (see IV-B). The Dean will submit this information to the Intellectual Property Review Committee, in a written report of all the activities in which that Office has been involved in the preceding year.

3. University Assistance. The protection and commercialization of intellectual property requires close attention to relevant laws. For example, for a patentable invention, one must carefully and properly document all activities involved in developing the invention from conception to reduction to practice. In addition, there are reasons to preserve secrecy for certain time periods so that the invention can be adequately protected. These considerations often run counter to the typical academic approach of quickly sharing knowledge in the form of presentations at professional meetings and publications in scholarly journals.

Even when the University does not own intellectual property under this policy, or enjoy an equity interest in it, the Office of Research and Graduate Programs can provide guidance to faculty and students about the basic process for and issues regarding protection of intellectual property. Further, under certain circumstances in which the University holds an equity interest, legal, financial and business assistance may be provided to faculty who wish to protect or commercialize their intellectual property. The University's decision to provide such assistance would be made on a case-by-case basis.

At the very least, inventors/creators should file a disclosure statement (see Section III.C.1. below) with the Office of Research and Graduate Programs. The disclosure serves as an important element in the protection process since it is dated and includes a description of the invention, including when it was conceived and reduced to practice. The Office of Research and Graduate Programs, as a disinterested party, maintains this disclosure as documentation to support potential patent claims. When the University/Foundation provides legal, financial, business and/or other extraordinary services to support intellectual property interests, they are entitled to recoup expenditures from gross proceeds derived from those intellectual property interests that are successfully commercialized.

4. Inactivity. If a determination has been made that the University owns or has an equity interest under this policy in a particular intellectual property, a decision to pursue protection and commercialization of that property will normally be made

within six months of a request by the inventor/creator for such a decision. Failure of the University to respond within six months does not mean that the University relinquishes its rights. Such a waiver of rights requires a positive action by University authorities.

If the University decides to pursue protection and commercialization it must then act diligently in this regard. If the University fails to act diligently the inventor/creator may request reconsideration of the decision to pursue. Alternatively, if the University determines not to pursue protection/development of the intellectual property, it will renegotiate its ownership and/or equity rights with the creator/inventor.

B. The Foundation

The California Polytechnic State University Foundation is a non-profit, public benefit corporation serving as a qualified auxiliary organization in support of the University. The Foundation functions in several roles relating to the perfection, protection, transfer and development of intellectual property held by the faculty, students, staff, or the University. Among these are:

1. Perfection of Rights. The perfection of legal and equity interest in intellectual property generally involves exacting documentation and compliance with statutory and regulatory procedures. The Foundation typically acts as the contracting agency for externally sponsored research and development projects on behalf of the University and the principal investigator. Sponsored agreements may have specific invention or creation disclosure requirements, and patent/copyright and licensing provisions requiring compliance through the Foundation.
2. Protection. At the request of the Dean of Research and Graduate Programs, or in satisfaction of sponsored agreement requirements, the Foundation shall initiate action to further evaluate the need for and practicality of securing appropriate statutory protection over any intellectual property subject to this policy. Results of any such evaluations shall be reported to the Dean of Research and Graduate Programs and the inventor or creator.
3. Transfer and Development. At the request of the University the Foundation may serve as the transfer and development agent for those with legal and/or equity rights to intellectual property under this policy. Actions to evaluate protection typically also involve the assessment of commercial viability, and may require the Foundation to negotiate among the interested parties appropriate assignment and collateral agreements to settle those interests and obligations, and to assure property protection and development opportunities. In its role as agent, the Foundation will involve both the inventor/creator and the University (through the Dean of Research and Graduate Programs) in all negotiations with potential buyers or licensors.

4. Fiscal Agent. The Foundation also serves as the designated fiscal agent of the University in the administration of transactions involving University interests in such intellectual property, and may also serve in a similar capacity for other interest-holders at their request.

In providing the above services the Foundation shall be entitled to recover its direct costs.

C. The Creator/Inventor.

1. Required Disclosures. This policy addresses circumstances in which the University owns intellectual property created by faculty, staff and students, or enjoys an equity interest in it. When these circumstances exist, the faculty, staff or students who create the intellectual property shall file a disclosure statement with the Dean of Research and Graduate Programs. At the appropriate time, the Dean of Research and Graduate Programs may refer the disclosure to the Intellectual Property Rights Committee, which will assess rights of all interested parties consistent with other sections of this policy.
2. Use Rights. When the University owns intellectual property under this policy, the inventor/creator will cooperate with the University and Foundation in the protection and development of disclosed intellectual property, including executing appropriate written instruments to perfect legal and equity rights. It is anticipated that the inventor/creator will be an active participant in the use-rights process, including participation in any licensing decisions. Inventors/creators having an interest in a potential license may request that the potential licensee be given the right of first negotiation, consistent with University policy on conflicts of interest or other applicable University policies.

D. Assignments of Interest. Any transfers of ownership between those with any interest in specific intellectual property shall be documented through appropriate legal instruments, such as assignment agreements, in a form consistent with applicable law and regulations.

IV. INCOME ALLOCATIONS

- A. General Objectives. In the transfer of intellectual property and allocation of net proceeds derived from intellectual property, the general objectives are to direct funds toward the inventor(s)/creator(s), assure the transfer and development of those discoveries for the public benefit, and provide for the funding of future creative effort by University faculty, students and staff.
- B. Intellectual Property Funds. When the University owns intellectual property or enjoys an equity interest in it, the University's share of net proceeds derived from that intellectual property normally shall be allocated among a Commercialization Fund, a Research Fund, the inventor/creator's academic department/academic unit, and college. Nonetheless, allocation of the University's share is ultimately at the discretion of the President. The Commercialization Fund is intended to support the protection and commercialization of

specific intellectual properties developed in the future by University faculty, staff and students. The Research Fund is intended to support research on and development of intellectual property.

V. IMPLEMENTATION

The Dean of Research and Graduate Programs, in cooperation with the appropriate Foundation and University officials, shall develop, document, implement and maintain on a current basis, appropriate procedures and practices to carry out this policy statement including the process for evaluating and determining the allocation of net proceeds derived from intellectual property, subject to Section IV of this policy. The Intellectual Property Review Committee shall be consulted on any significant proposed practices involving the application or interpretation of this policy.

VI. PERIODIC POLICY REVIEW

The Intellectual Property Review Committee shall review this policy as needed, and make recommendations for changes as deemed appropriate.