

Policy Title: *Intellectual Property*

Applicability: Campus-Wide

Oversight: Provost & Senior Vice President of Academic Affairs

Effective Date: September 7, 2017, in effect during the review and comment period.

Comment Period Closed 10/7/17.

I. Introduction/Purpose:

Providence College's faculty, staff, and students are regularly involved in scholarly activities which support and further the College's mission and strategic plan. Providence College believes it is important to share discoveries and inventions resulting from the core teaching, learning, research, and service missions of the College with the greater community to benefit society.

Intellectual property (IP) generally consists of patents, copyrights, trademarks and trade secrets. By establishing a policy on IP, Providence College seeks to support the activities of the faculty, staff, and students in identifying, protecting, and administering intellectual property matters and defining the rights and responsibilities of all involved.

The following are the objectives of the College's policy on intellectual property:

- To encourage the creation and sharing of knowledge, & to promote understanding of such knowledge.
- To clarify ownership rights and responsibilities of all parties involved in the creation of intellectual property; and,
- To outline a system to help authors and inventors and the College bring new knowledge to society.

II. Application and Definitions:

A. Application

This policy applies to all persons employed by Providence College and any person using Providence College facilities under the supervision or sponsorship of College personnel (including students, visitors, volunteers, fellows, and scholars). This policy governs the development and ownership of intellectual property. The Providence College [Copyright Policy and Guidelines](#) outlines policy and guidelines for the appropriate use of content subject to copyright law.

B. Definitions

1. **Copyright** is secured automatically when the work is created, and a work is created when it is fixed in a copy or recording for the first time. Copyright is a type of intellectual property protection that protects the manner in which an idea is expressed.
2. **Creator** means faculty, staff, administrators, students, or groups thereof that use funds, facilities, or other resources of the College as the authors, inventors, or originators of intellectual property.
3. **Intellectual Property** is a new creation, such as patentable inventions, trade secrets, new processes, written compositions, computer software, new chemical compounds, music,

other artistic creations, new forms of plants or animals, or any copyrightable subject matter. Intellectual Property is granted legal aspects of a property right, including patents, copyrights, and trademarks.

4. **Invention** is any new or useful process or discovery, method, technique, machine, device, manufacture, software, or other improvement thereof. Inventions are novel, useful, and not usually obvious to individuals skilled in the field in which they are developed.
5. **Patent** is a legal instrument issued by the federal government, acting through the Patent Office, that protects and preserves the intellectual property rights of the creator and the College, and facilitates the transfer of intellectual property for commercialization and public benefit.
6. **Trade Secret** is any valuable information that is not generally known and for which reasonable efforts to preserve confidentiality are necessary and legally mandated.

III. **Determination of Ownership**

A. *General Rule*

Subject to applicable law, any IP created or developed by members of the Providence College Community shall be owned by the creator(s) of such IP.

The following (B-F) are exceptions to the General Rule (A).

B. *Rights of ownership are determined by a contract or grant agreement.*

Ownership of the IP in works created through projects or programs funded by an external agency or sponsor, such as a grant or contract, will be determined by the terms of agreement with the external party. For example, legal requirements of government-sponsored projects (e.g. the Bayh-Dole Act) normally transfer IP rights to the institution. An agreement concerning ownership must be signed by the College, the external agency and the individuals involved in creating such works if ownership is not included in the terms or conditions of the grant or contract.

C. *Providence College owns IP when an identity interest exists.*

The College has an *identity interest* in works that are integral to, and reflect more directly on, the identity of the College than on the identity of the individual(s) who create the works. For example, the College has an *identity interest* in items disseminated beyond the College, such as various catalogues, institutional web pages, alumni magazines or College publications, admissions brochures, and fundraising materials. An *identity interest* also occurs when there is a prominent use of the College's name, or of any image, trademark or logo of the College. Simply identifying the author of a work as a Providence College faculty or staff member, in and of itself, would not be considered prominent use of the College's name.

D. *Providence College owns IP when it has a functional interest.*

The College has a functional interest in works that are used to enhance the effective functioning and coordination of ongoing operations of the College, or in which the College has a contractual or legal obligation. This may include College directed or commissioned works produced by an individual or group as a specific job requirement or work for hire. Examples include, but are not limited to: software developed by technical staff, internal handbooks and reports, administrative procedures and policies. Excluded from this category are materials created by faculty in connection with their teaching, research, or other

scholarly activities that are not specifically commissioned by the College, even though teaching and engaging in scholarly activities are considered part of their job. Certain collaborative agreements also require the College to negotiate IP rights with other entities, creating a functional interest in the work.

- E. *Providence College owns IP if it is developed in connection with a specific, institutionally-defined and commissioned project.*
- F. *Providence College may share IP with the creator if there is exceptional use of College resources.*

An exceptional use of College resources for faculty or student work means that the College has provided funding, facilities, or staff support of a degree or nature not typically made available for faculty or student work. Ordinary use of desktop computers or the College library, routine support from College staff, or use of College office space does not constitute exceptional use. In addition, the College's provision of standard labs, funding for pre-tenure research leaves or sabbatical leaves, and funding from internal grant funds (such as Committee on Aid to Faculty Research (CAFR)) and start-up funds, are not considered to be exceptional use of College resources. In the event that a faculty member expects to be provided exceptional or atypical support from the College, a written agreement or formal determination should be reached before resources are provided. This agreement should specify the allocation of resources and the extent, if any, of College ownership that may result from the work.

IV. Providence College Use and Access Consistent with the Purpose of the Work

- A. *Works Specifically Created for Teaching, Administration, or Other College Activities.*

It is understood that the College may use without charge any copyrighted work developed for the specific purpose of making it available for use by persons, other than the author, in teaching and to perform administrative duties or other College activities. The creators of reusable teaching and classroom materials for Providence College provide a license to the College, which will include broad non-exclusive world-wide, royalty-free, perpetual, and irrevocable rights to use, display, copy, distribute, modify and prepare derivative works of such materials for the ordinary course of its teaching, scholarship, service and administrative functions.

- B. *Use of College Facilities*

In general, College facilities are not to be used for personal gain or commercial advantage. If in the development of copyrightable materials that result in royalties or other payments, a faculty member makes significant use of College equipment, facilities, and supplies, wherein the College incurs real costs, the faculty member should reimburse the College for these costs; or, in the alternative, ownership of the resulting works should be assigned to the College. Similarly, significant use of College facilities may not be made by faculty members in connection with outside consulting, done on a fee-for-service basis. Otherwise, the College should be reimbursed for any significant real costs incurred.

V. Institutional Support for Commercialization of IP Owned by Providence College

- A. **Reporting:** The creator(s) must file a report as soon as circumstances make it reasonably clear as to the production or planned production of any IP: 1) that would require extraordinary support or resources of the College; 2) for which the creator

intends to seek a patent or other commercialization and the process of commercialization involves substantial cost and effort, and the creator wishes the College to consider providing some or all of that support; and/or, 3) that would be created under a government or private sponsor grant that specifies IP rights. Reports should be made to the Intellectual Property Committee using the IP Disclosure and Reporting Form.

B. **Determinations:** If the creator seeks a patent on, or otherwise plans to commercialize IP the process of protection or commercialization may involve a substantial cost and effort, and the creator may wish the College to consider providing some or all of the support and share the net rewards, liabilities, or risks with the College. The Intellectual Property Committee will determine whether Providence College will provide assistance in the protection and commercialization of such IP. In good faith consultation with the creator, the Intellectual Property Committee will undertake a patentability review (with the assistance of patent counsel if necessary) where, in the discretion of the IP Committee, such a review is reasonable to procure based upon the potential value of the invention. Where, in the Committee's sole discretion, the filing of a patent application is deemed appropriate, it shall be the College's responsibility to undertake such a filing at its own expense and in its own name. The College may choose to waive rights of IP ownership and such waiver will be made in writing to the creator within 90 days of the IP disclosure.

C. **Net Revenue Distribution:**

Unless otherwise agreed, Net Revenue shall mean Gross Revenue, consisting of any cash or cash proceeds that the College receives in connection with an invention or copyrightable property (excepting payments to the College for research, or contributions to the College of equipment, which payments shall be the sole property of the College and shall not be considered Gross Revenue for purposes of this Policy), **minus** actual commercialization costs incurred by the College, including but not limited to costs for protection of IP, filing fees, legal fees, marketing, advertising, licensing costs, and other costs actually incurred by the College.

With respect to IP owned by the College, Net Revenue shall be distributed (usually annually) as follows: 50% creator and 50% Providence College.

In the event of joint creators, the amount allocated to the creator under the above schedule shall be divided equally among the joint creators, except as may be otherwise agreed to by the joint creators and documented in a written agreement submitted to Intellectual Property Committee.

In the event the College receives equity in a business, stocks, or shares in connections with any intellectual property, such equity shall be considered Gross Revenue and shall be apportioned according to the above schedule upon liquidation of the equity interest by the College. Any equity received by the College may be held until the College decides to liquidate the equity.

