

1 **GEORGIA STATE UNIVERSITY**
2 **INTELLECTUAL PROPERTY POLICY**

3
4 **I. INTRODUCTION**

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6 Georgia State University is dedicated to teaching, research, and the extension of
7 knowledge to the public. The faculty recognizes as two of its major objectives,
8 the production of new knowledge and the dissemination of knowledge. Inherent
9 in these objectives is the need to encourage contributions to the various arts, the
10 development of new and useful devices and processes, the publication of
11 scholarly works, and the development of computer software. Such activities
12 contribute to the professional development of the individual, enhance the
13 reputation of the University, provide additional educational opportunities for
14 participating students, and promote the general welfare of the public at large. The
15 dissemination of intellectual property is integral to the purpose and mission of the
16 University.

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18 The purpose of the Georgia State University Intellectual Property Policy is to
19 encourage and recognize research and innovation by members of the University
20 community, clarify ownership of intellectual property rights, create opportunities
21 for public use of University innovations, and provide for the sharing of revenue
22 with the creators of intellectual property when such revenue is derived from the
23 licensing of protected intellectual property. This Policy provides for a fair and
24 consistent procedure for defining intellectual property rights. The circumstances
25 under which intellectual property is created determine ownership rights to such
26 intellectual property. This Policy establishes procedures for the disclosure,
27 determination of interests, and management of intellectual property, and
28 recognizes the rights of the creators of intellectual property to financial benefits
29 while safeguarding the rights of the University.

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31 The University recognizes and encourages the publication of scholarly works as
32 an integral part of teaching, research, and service. The University acknowledges
33 the rights held by individuals who publish articles, pamphlets, books, and other
34 works created through individual effort and initiative that are protected by
35 copyright. The University also recognizes that some publications may result from
36 work supported, either partially or completely, by the University. Generally,
37 while the University retains the rights to intellectual property developed at the
38 University, the University releases rights in scholarly works, as such are defined
39 in this Policy, to the creators of such works.

40
41 Patentable inventions often come about because of the activities of faculty, staff,
42 or students who have been aided, wholly or in part, through the use of the
43 University's resources and/or through the course of their employment by the
44 University. It becomes significant, therefore, to insure the utilization of such
45 intellectual property for the public good and to expedite its development and
46 marketing. The rights and privileges, as well as the incentives, of the intellectual

47 property creator must be preserved so that the creator’s abilities and those of other
48 members of the University community may be further encouraged and stimulated.

49
50 The Georgia State University Intellectual Property Policy serves to clarify the
51 circumstances under which intellectual property ownership resides with the
52 creator or with the University, and aims to establish incentives for the continued
53 development of intellectual property.

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55 **II. APPLICATION**

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57 This Policy addresses both individual and University intellectual property rights,
58 and applies to all persons creating intellectual property at Georgia State
59 University. The Policy applies to students and all university employees, including
60 but not limited to, faculty and staff. The Policy also extends to persons receiving
61 compensation or funding from the University, or funds administered by the
62 University, and volunteers or other persons performing research on campus using
63 University resources, such as visiting scholars.

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65 **III. DEFINITIONS**

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67 For the purpose of this Policy concerning intellectual property, certain terms have
68 meanings as indicated below:

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70 “Biological Materials” shall include, but are not limited to, chemical compounds
71 of biological origin, drugs, mutants, genetically engineered organisms, antibodies,
72 hybridomas, cell lines, sera, supernatants, vectors, antigens, cDNAs, ESTs, and
73 SNPs, and chemical compounds including enzymes and derivatives thereof.

74
75 “Copyrighted Materials” shall include the following: (1) books, journal articles,
76 texts, glossaries, bibliographies, study guides, laboratory manuals, syllabi, tests,
77 and proposals; (2) lectures, musical or dramatic compositions, unpublished
78 scripts; (3) films, filmstrips, charts, transparencies, and other visual aids; (4) video
79 and audio tapes or cassettes; (5) live video and audio broadcasts; (6) programmed
80 instructional materials; (7) Mask Works; and (8) Software and other subject
81 matter or works which qualify for protection under the copyright laws of the
82 United States (see 17 U.S.C. § 102 et seq.) or other protective statutes whether or
83 not registered there under.

84
85 “Course Material” shall include course syllabi, tests, course assignments, lectures,
86 lecture notes, and other materials prepared by the instructor of a course at Georgia
87 State University for the purpose of course instruction or evaluation.

88
89 “Creator” means the individual or group of individuals who authored, or were
90 otherwise responsible for the production of the Intellectual Property.

91

92 “Intellectual Property” shall be deemed to refer to Patentable Inventions,
93 Biological Materials, Copyrighted Materials, Software, and Trade Secrets,
94 whether or not formal protection is sought. Trademarks are specifically excluded
95 from this definition.
96
97 “Mask Work” means a series of related images, however fixed or encoded: (1)
98 having or representing the predetermined, three dimensional pattern of metallic,
99 insulating, or semi-conductor material present or removed from the layers of a
100 semiconductor chip product; and (2) in which series the relation of the images to
101 one another is that each image has the pattern of the surface of one form of the
102 semiconductor chip product. (See 17 U.S.C. § 901.)
103
104 “Net Equity” means the value of the equity received by the University as a result
105 of transferring rights in the Intellectual Property less the University’s out-of-
106 pocket expenditures (including legal fees) directly attributable to protecting,
107 developing, and transferring that Intellectual Property.
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109 “Net Income” means the gross monetary payments the University receives as a
110 result of transferring rights in the Intellectual Property less the University’s out-
111 of-pocket expenditures (including legal fees) directly attributable to protecting,
112 developing, and transferring that Intellectual Property.
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114 “Novel Plant Variety” means a novel variety of sexually reproduced plant. (See 7
115 U.S.C. § 2321 et seq.)
116
117 “Patentable Inventions” shall be deemed to refer to subject matter (a new, non-
118 obvious, useful process, machine, manufacture, composition of matter or
119 improvement thereof) which reasonably appears to qualify for protection under
120 the patent laws of the United States or other protective statutes, including Novel
121 Plant Varieties and Patentable Plants, whether or not patentable there under.
122
123 “Patentable Plant” means an asexually reproduced distinct and new variety of
124 plant. (See 35 U.S.C. § 161.)
125
126 “Scholarly Work” means books, articles and other publications, artistic creations,
127 literary manuscripts, visual and auditory creations, and musical works,
128 irrespective of their medium of storage or presentation. The former items are
129 meant to include Software, computer programs, and databases but only if they are
130 accessory to or part of a scholarly text. Textbooks and related Software
131 developed as a Specific University Assignment are not considered Scholarly
132 Work for the purpose of this definition.
133
134 “Significant Use of University Resources” is the use of University resources that
135 is over and above the normal usage of library resources, secretarial help, word
136 processing equipment, or other support services. Prior to the completion of the
137 creation of Intellectual Property, or as early as possible in the creation of

138 Intellectual Property, the Creator shall seek a determination of whether this
139 definition applies to the Intellectual Property by fully and openly disclosing the
140 facts surrounding the creation of Intellectual Property to the Creator’s Department
141 Chair or Director who shall issue a written opinion. The Creator may appeal this
142 decision, in writing, to the Vice President for Research or the Vice President’s
143 designee.

144
145 “Software” shall include one or more computer programs existing in any form, or
146 any associated operational procedures, manuals or other documentation, whether
147 or not protectable or protected by patent or copyright. The term “computer
148 program” shall mean a set of instructions, statements or related data that, in actual
149 or modified form, is capable of causing a computer or computer system to
150 perform specified functions.

151
152 “Specific University Assignment” means Intellectual Property specifically
153 ordered or commissioned pursuant to a written, signed agreement between the
154 University and Creator.

155
156 “Trademarks” shall include all trademarks, service marks, trade names, seals,
157 symbols, designs, slogans, or logotypes developed by or associated with the
158 University. (See 15 U.S.C. § 1127.)

159
160 “Trade Secrets” means information including, but not limited to, technical or non-
161 technical data, a formula, a pattern, a compilation, a program, a device, a method,
162 a technique, a drawing, a process, financial data, financial plans, product plans, or
163 a list of actual or potential customers or suppliers which: (1) derives economic
164 value, actual or potential, from not being generally known to, and not being
165 readily ascertainable by proper means by, other persons who can obtain economic
166 value from its disclosure or use; and (2) is the subject of efforts that are
167 reasonable under the circumstances to maintain its secrecy. (See O.C.G.A. § 10-
168 1-761.)

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170 **IV. RIGHTS AND EQUITIES IN INTELLECTUAL PROPERTY**

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172 Ownership in Intellectual Property will be determined in accordance with the
173 following categories of creation:

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175 **A. INDIVIDUAL EFFORT**

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177 Ownership rights to Intellectual Property developed by a Creator shall
178 reside with such Creator if:

- 179
180 i) the Intellectual Property is Course Material developed at the
181 University by faculty or other employees. The University shall
182 retain a non-exclusive, royalty-free license to use such material for

- 183 educational purposes for up to twelve (12) months following the
184 termination of the Creator’s employment at the University; or
185 ii) the Intellectual Property was created by a student, not employed by
186 the University, solely for the purpose of satisfying a course
187 requirement. This does not apply if the transfer of ownership
188 rights is made a condition of participation in a course; or
189 iii) the Intellectual Property is a Scholarly Work, unless
190
191 a) the Scholarly Work was developed by the Creator as a
192 Specific University Assignment; or
193 b) the Scholarly Work was developed with Significant Use
194 of University Resources.
195

196 **It shall be the responsibility of the Creator to disclose Intellectual**
197 **Property to the University, through the Vice President for Research,**
198 **and demonstrate that this classification applies, in accordance with**
199 **Section V of this Policy.**
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201 B. UNIVERSITY-ASSISTED EFFORT
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203 Ownership rights to Intellectual Property developed by individuals with
204 Significant Use of University Resources shall reside with the University.
205 Proceeds from the commercialization of Intellectual Property will be
206 shared in accordance with Section IX of this Policy as an incentive to
207 encourage further development of Intellectual Property.
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209 C. UNIVERSITY-ASSIGNED EFFORT
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211 Ownership rights to Intellectual Property developed as a result of a
212 Specific University Assignment shall reside with the University. Proceeds
213 from the commercialization of Intellectual Property will be shared in
214 accordance with Section IX of this Policy as an incentive to encourage
215 further development of Intellectual Property.
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217 D. SPONSOR-SUPPORTED EFFORT
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219 Ownership rights to Intellectual Property developed as a result of a grant
220 or contract with the University or the Georgia State University Research
221 Foundation, Inc. (GSURF) shall reside with the University or GSURF.
222 However, ownership rights may be influenced or determined by the terms
223 of such grant or contract. Proceeds from the commercialization of
224 Intellectual Property will be shared in accordance with Section IX of this
225 Policy as an incentive to encourage further development of Intellectual
226 Property.
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E. OTHER EFFORT

Ownership rights to Intellectual Property developed under any circumstances other than those listed in Section IV, A-D of this Policy shall be determined on an individual basis in consultation with the Intellectual Property Committee and approved by the Vice President for Research.

V. DISCLOSURE

Individuals covered by this Policy must disclose to the Vice President for Research fully, and in a timely manner, all Intellectual Property, **excluding** Scholarly Work as delineated under Section IV.A of the Policy and course material. Disclosure is initiated by the submission of an Intellectual Property Disclosure Form to the Vice President. The Creator must also disclose a brief summary of the Intellectual Property to the Creator's Dean and Department Chair (or Director, if applicable). Individuals covered by this Policy shall treat Intellectual Property in a manner that is consistent with the laws regarding Trade Secrets. The Creator shall execute such declarations, assignments, or other documents as may be necessary in the course of evaluating and protecting the ownership rights of Intellectual Property to ensure that title in such Intellectual Property shall be held by the University, or by such other parties as may be appropriate under the circumstances.

VI. INTELLECTUAL PROPERTY COMMITTEE

The Intellectual Property Committee, appointed by the President, will advise the Vice President for Research regarding the University's and Creator's rights and equities in Intellectual Property in accord with Section VII of this document. The Intellectual Property Committee will consist of up to nine (9) members. The President shall appoint one (1) representative from the Office of Finance and Administration and one (1) representative from the Office of Legal Affairs. Each of the six Colleges may nominate up to two (2) faculty members with Intellectual Property or relevant commercialization or related experience for this Committee from which the President shall appoint at least one, except when no nomination is made. The remaining members of the committee shall be appointed by the President from faculty members familiar with the subject matter of the majority of Intellectual Property disclosures over the previous three years or who have relevant legal or commercialization experiences. The President shall designate one (1) Committee member to serve as Chair of the Committee.

Committee appointments will be for three (3) years. Members of the Committee may be appointed to serve consecutive terms. In the event any seat on the Committee is vacated prior to the expiration of the normal term, the President

275 shall appoint a successor to fill the remaining term in accordance with the
276 procedures outlined above. The Committee shall meet as necessary during the
277 academic year.

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279 **VII. ADMINISTRATIVE PROCEDURES**

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281 Once the Vice President for Research has received the Intellectual Property
282 Disclosure Form from the Creator, the University's interest in patenting and/or
283 licensing the disclosed Intellectual Property must be determined in a timely
284 fashion. After preliminary evaluation by the Vice President, the Vice President in
285 consultation with the Chair of the Intellectual Property Committee and the Dean
286 of the Creator's College, will initiate one or more of the following actions within
287 ninety (90) business days of receiving the disclosure:

- 288
- 289 i) Initiate an external evaluation of the disclosed Intellectual Property.
 - 290 ii) File a patent application.
 - 291 iii) Submit the disclosed Intellectual Property to the Intellectual Property
292 Committee for its evaluation and recommendation.
 - 293 iv) If rights in the disclosed Intellectual Property are subject to the terms of a
294 grant or contract, comply with the terms of the grant or contract.
 - 295 v) Assign title to the disclosed Intellectual Property to the Creator.
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297 If the disclosure is referred to the Committee for a recommendation, the
298 Committee shall review the disclosure and, if appropriate, hear an oral
299 presentation by the Creator, supported by such visual material as may be required
300 for clarity. Use may be made of appropriate ad hoc members, including external
301 agencies, who can best assist in evaluating the Intellectual Property. The
302 Committee shall recommend whether the University should exert an interest in
303 the Intellectual Property, based on a determination that the disclosed Intellectual
304 Property is novel, useful, non-obvious and/or has commercial potential.

305
306 Within sixty (60) business days of the disclosure being submitted to the
307 Committee, the Committee will make a recommendation to the Vice President for
308 Research as to whether the University should pursue development of the
309 Intellectual Property. If the Committee requires additional time, it shall request
310 such additional time from the Vice President, in writing, including a justification
311 for the request. Such additional time must be at the agreement of the involved
312 parties and shall not exceed an additional thirty (30) business days.

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314 The Vice President for Research will consider the recommendation of the
315 Committee and the Vice President or his designee will respond to the Creator, in
316 writing, whether the University intends to pursue development of the Intellectual
317 Property. The Vice President's determination will be due to the Creator no later
318 than thirty-five (35) business days from the Vice President's receipt of the
319 Intellectual Property Committee's report.

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321 The Vice President of Research will complete consideration of the Intellectual
322 Property and inform the Creator within 180 business days of submission
323 regardless of the action(s) chosen. If no decision is documented within this 180
324 business day period, the University shall have decided it has no interest in
325 pursuing the development of the Intellectual Property, and the procedures of the
326 following paragraph apply.

327
328 If the Vice President for Research decides that the University will not pursue
329 development of the Intellectual Property, or such agreed upon decisions are not
330 made or responded to in writing during the specified time period, or a mutually
331 agreeable extended time period, the University shall assign its rights to pursue
332 development of the Intellectual Property back to the Creator(s), except that the
333 University will retain royalty-free license rights to the Intellectual Property.

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335 **VIII. INVESTMENT IN BUSINESS ENTITY**

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337 A Creator who holds an investment in a business entity that intends to license and
338 commercialize University owned Intellectual Property shall disclose his/her
339 investor status and obtain the written approval of the Creator's Department Chair,
340 Dean, and Vice President for Research before the Intellectual Property is licensed.
341 A Creator is encouraged to limit his/her role in such business entity to that of
342 scientific or technical founder, member of a scientific advisory board, or
343 consultant. A Creator is discouraged from serving on such entity's Board of
344 Directors or as an officer. When necessary, a Creator may assume such roles
345 upon the written approval of the applicable Department Chair, Dean, and Vice
346 President for Research.

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348 A Creator who holds an investment in an entity shall not negotiate nor attempt to
349 influence the licensing terms between the University and such entity, unless the
350 University consents.

351
352 Before a Creator may accept sponsorship from an entity that has licensed
353 Intellectual Property developed by the Creator, the Creator must fully disclose the
354 existence of the license, the research proposal, statement of work, budget, and
355 other details to the Creator's Department Chair, Dean, and Vice President for
356 Research, and obtain approval from each.

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IX. DISTRIBUTION OF PROCEEDS

A. NET INCOME

When income is derived from the commercialization of Intellectual Property, Net Income will be distributed as follows:

Net Income Distribution

	Creator(s)	Creator's Dept./Unit*	Creator's College	Georgia State University Research Foundation, Inc.
First \$20,000 of Accumulated Net Income	100%			
Over \$20,000 of Accumulated Net Income	33 1/3%	23 1/3%	10%	33 1/3%

*When Net Income is distributed for Intellectual Property developed by a Creator in the College of Law, the Creator's Department/Unit portion shall be added to the Creator's College Portion.

B. NET EQUITY

When equity is obtained from the commercialization of Intellectual Property, proceeds from Net Equity will be distributed according to the Net Income procedure.

If a Creator or any immediate family member maintains the direct or indirect ownership of more than 25% of the assets of stock or any business to which the Intellectual Property is licensed, or receives extraordinary compensation, then such Creator shall not participate in any distribution of proceeds. Extraordinary compensation is defined as greater than 10% of the up-front revenue received in a license agreement by the Georgia State University Research Foundation. Standard consulting fees shall not be deemed to be extraordinary compensation under this Section, but shall be disclosed to appropriate University officials in accordance with the University's Conflict of Interest Policy.

When the Intellectual Property is the result of joint efforts, the Creator's share of Net Income or proceeds from Net Equity will be divided equally among the Creators, unless a written agreement, signed by all the Creators, provides for a different distribution and is filed with the University **prior to** the first distribution of Net Income or proceeds from Net Equity.

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The Vice President for Research, in consultation with the Intellectual Property Committee and the Dean(s) of the appropriate College(s), may change the distribution of Net Income or proceeds from Net Equity to the Creator's Department/Unit and/or College, if necessary, due to organizational changes or structures at the University, or if the Creator moves among units at the University.

X. APPEALS

Disputes regarding the application of this Policy may be appealed, in writing, to the Vice President for Research. The Vice President will refer all appeals to the Intellectual Property Committee, which will make a recommendation to the Vice President within thirty (30) business days of receipt of the appeal. The Vice President will then make a final decision concerning the appeal, which shall be made no later than forty-five (45) business days from the Vice President's receipt of the appeal. If an individual wishes to appeal the decision of the Vice President, or if a decision is not made within the time specified above, the individual may appeal to the Provost, in writing, within forty-five (45) business days from the Vice President's decision. The Provost shall make a decision no later than forty-five (45) business days from the Provost's receipt of appeal. If the individual wishes to appeal the decision of the Provost, or if the decision is not made within the specified time period, the individual may appeal to the President in writing within forty-five (45) business days of the Provost's decision. The President shall make a decision within forty-five (45) business days from the President's receipt of the appeal. If the individual wishes to appeal the decision of the President, or if the decision is not made within the specified time period, then the individual may appeal to the Board of Regents in accordance with Article IX of the Bylaws of the Board.

XI. PUBLICATION

Nothing in this Policy shall be construed as affecting the rights of a Creator to publish the results of scientific work, except that the Creator must agree to observe a period of delay in publication or external dissemination if the University so requests, and such a delay is necessary to permit the University to secure protection for Intellectual Property disclosed to it by the Creator.

XII. PREVAILING POLICY

In the event of a conflict between the Georgia State University Intellectual Property Policy and any policy of the Board of Regents of the University System of Georgia, the latter shall prevail.

In the event of a conflict between the Georgia State University Intellectual Property Policy and a grant or contract to the University or Georgia State University Research Foundation the latter shall prevail.

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XIII. HEIRS AND ASSIGNS

The provisions of this Policy shall inure to the benefit of and be binding upon the heirs and assigns of those individuals covered by this Policy.

XIV. CHANGES IN POLICY

This Policy will be reviewed and amended, as appropriate, by the Intellectual Property Committee. This Policy may be changed by the President, on the recommendation of the Intellectual Property Committee, and the approval of the University Senate Research Committee and the University Senate.

XV. COMPLIANCE

Failure by a Creator to comply with the provisions of this Policy, including the Disclosure requirements in Section V., is a violation and may result in legal action and discipline of an individual in accordance with applicable University policies and procedures. Failure by a Creator to comply with the provisions of this Policy may also violate the terms and conditions of a funding grant or contract with a third party.

XVI. GEORGIA STATE UNIVERSITY RESEARCH FOUNDATION, INC.

The Board of Regents of the University System of Georgia has, by contract, granted rights to Intellectual Property owned by Georgia State University to the Georgia State University Research Foundation, Inc., an affiliated nonprofit corporation. When this Policy speaks to ownership of Intellectual Property by Georgia State University, the Georgia State University Research Foundation, Inc., shall be the owner.