

GEORGIA STATE UNIVERSITY INTELLECTUAL PROPERTY POLICY

I. INTRODUCTION

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

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

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

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

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

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

II. APPLICATION

This Policy addresses both individual and University intellectual property rights, and applies to all persons creating intellectual property at Georgia State University. The Policy applies to students and all university employees, including but not limited to, faculty and staff. The Policy also extends to persons receiving compensation or funding from the University, or funds administered by the University.

III. DEFINITIONS

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

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

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

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

“Intellectual Property” shall be deemed to refer to Patentable Inventions, Biological Materials, Copyrighted Materials, Software, and Trade Secrets, whether or not formal protection is sought. Trademarks are specifically excluded from this definition.

“Mask Work” means a series of related images, however fixed or encoded: (1) having or representing the predetermined, three dimensional pattern of metallic,

insulating, or semi-conductor material present or removed from the layers of a semiconductor chip product; and (2) in which series the relation of the images to one another is that each image has the pattern of the surface of one form of the semiconductor chip product. (See 17 U.S.C. § 901.)

“Net Equity” means the value of the equity received by the University as a result of transferring rights in the Intellectual Property less the University’s out-of-pocket expenditures (including legal fees) directly attributable to protecting, developing, and transferring that Intellectual Property.

“Net Income” means the gross monetary payments the University receives as a result of transferring rights in the Intellectual Property less the University’s out-of-pocket expenditures (including legal fees) directly attributable to protecting, developing, and transferring that Intellectual Property.

“Novel Plant Variety” means a novel variety of sexually reproduced plant. (See 7 U.S.C. § 2321 et seq.)

“Patentable Inventions” shall be deemed to refer to subject matter (a new, non-obvious, useful process, machine, manufacture, composition of matter or improvement thereof) which reasonably appears to qualify for protection under the patent laws of the United States or other protective statutes, including Novel Plant Varieties and Patentable Plants, whether or not patentable there under.

“Patentable Plant” means an asexually reproduced distinct and new variety of plant. (See 35 U.S.C. § 161.)

“Scholarly Work” means books, articles and other publications, artistic creations, literary manuscripts, visual and auditory creations, and musical works, irrespective of their medium of storage or presentation. The former items are meant to include Software, computer programs, and databases but only if they are accessory to or part of a scholarly text. Textbooks and related Software developed as a Specific University Assignment are not considered Scholarly Work for the purpose of this definition.

“Significant Use of University Resources” is the use of University resources that is over and above the normal usage of library resources, secretarial help, word processing equipment, or other support services. Prior to the completion of the creation of Intellectual Property, or as early as possible in the creation of Intellectual Property, the Creator shall seek a determination of whether this definition applies to the Intellectual Property by fully and openly disclosing the facts surrounding the creation of Intellectual Property to the Creator’s Department Chair or Director who shall issue a written opinion. The Creator may appeal this decision, in writing, to the Vice President for Research or the Vice President’s designee.

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

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

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

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

IV. RIGHTS AND EQUITIES IN INTELLECTUAL PROPERTY

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

A. INDIVIDUAL EFFORT

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

- i) the Intellectual Property is course material developed at the University by faculty or other employees. The University shall retain a non-exclusive, royalty-free license to use such material for educational purposes for up to twelve (12) months following the termination of the Creator’s employment at the University; or
- ii) the Intellectual Property was created by a student, not employed by the University, solely for the purpose of satisfying a course requirement. This does not apply if the transfer of ownership rights is made a condition of participation in a course; or
- iii) the Intellectual Property is a Scholarly Work, unless

- a) the Scholarly Work was developed by the Creator as a Specific University Assignment; or
- b) the Scholarly Work was developed with Significant Use of University Resources.

It shall be the responsibility of the Creator to disclose Intellectual Property to the University, through the Vice President for Research, and demonstrate that this classification applies, in accordance with Section V of this Policy.

B. UNIVERSITY-ASSISTED EFFORT

Ownership rights to Intellectual Property developed by individuals with Significant Use of University Resources shall reside with the University. Proceeds from the commercialization of Intellectual Property will be shared in accordance with Section IX of this Policy as an incentive to encourage further development of Intellectual Property.

C. UNIVERSITY-ASSIGNED EFFORT

Ownership rights to Intellectual Property developed as a result of a Specific University Assignment shall reside with the University. Proceeds from the commercialization of Intellectual Property will be shared in accordance with Section IX of this Policy as an incentive to encourage further development of Intellectual Property.

D. SPONSOR-SUPPORTED EFFORT

Ownership rights to Intellectual Property developed as a result of a grant or contract with the University or the Georgia State University Research Foundation, Inc. (GSURF) shall reside with the University or GSURF. However, ownership rights may be influenced or determined by the terms of such grant or contract. Proceeds from the commercialization of Intellectual Property will be shared in accordance with Section IX of this Policy as an incentive to encourage further development of Intellectual Property.

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 nine (9) members. The President shall appoint one (1) representative each from the Office of Finance and Administration and the Office of Legal Affairs. The Senate Research Committee and the Senate Faculty Affairs Committee shall each nominate up to two (2) faculty members for this Committee. From these nominations, the President shall appoint one (1) faculty member to serve as a representative of the Senate Research Committee, and one (1) faculty member to serve as a representative of the Senate Faculty Affairs Committee. In addition, each College/School shall nominate up to two (2) faculty members for this Committee from which the President shall appoint five (5) additional faculty members to the Committee. To ensure broad representation, each college/school shall be represented by at least one (1) faculty member, but by no more than two (2) faculty members. The President shall designate one (1) Committee member to serve as Chair of the Committee. Committee appointments will be for three (3) years provided, however, that in the first year, one-third (1/3) of the members shall be appointed for a term of one (1) year, one-third (1/3) of the members shall be appointed for a term of two (2) years, and one-third (1/3) of the members shall be appointed for a term of 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 shall appoint a successor to fill the remaining term in accordance with the procedures outlines above. The Committee shall meet as necessary.

VII. ADMINISTRATIVE PROCEDURES

Once the Vice President for Research has received the Intellectual Property Disclosure Form from the Creator, the University's interest in patenting and/or licensing the disclosed Intellectual Property must be determined in a timely fashion. After preliminary evaluation by the Vice President, the Vice President in consultation with the Chair of the Intellectual Property Committee and the Dean of the Creator's College, will initiate one or more of the following actions within forty-five (45) business days of receiving the disclosure:

- i) Initiate an external evaluation of the disclosed Intellectual Property.
- ii) Develop and manage the disclosed Intellectual Property through the Georgia State University Research Foundation, Inc.
- iii) Submit the disclosed Intellectual Property to the Intellectual Property Committee for its evaluation and recommendation.
- iv) If rights in the disclosed Intellectual Property are subject to the terms of a grant or contract, comply with the terms of the grant or contract.
- v) Assign title to the disclosed Intellectual Property to the Creator.

If the disclosure is referred to the Committee for a recommendation, the Committee shall review the disclosure and, if appropriate, hear an oral presentation by the Creator, supported by such visual material as may be required for clarity. Use may be made of appropriate ad hoc members, including external agencies, who can best assist in evaluating the Intellectual Property. The Committee shall recommend whether the University should exert an interest in the Intellectual Property, based on a determination that the disclosed Intellectual Property is novel, useful, non-obvious and/or has commercial potential.

Within thirty-five (35) business days of the disclosure being submitted to the Committee, the Committee will make a recommendation to the Vice President for Research as to whether the University should pursue development of the Intellectual Property. If the Committee requires additional time, it shall request such additional time from the Vice President, in writing, including a justification for the request. Such additional time must be at the agreement of the involved parties and shall not exceed an additional thirty-five (35) business days.

The Vice President will consider the recommendation of the Committee and respond to the Creator, in writing, whether the University intends to pursue development of the Intellectual Property. The Vice President's determination will be due to the Creator no later than thirty-five (35) business days from the Vice President's receipt of the Intellectual Property Committee's report.

If the Vice President for Research decides that the University will not pursue development of the Intellectual Property, or such agreed upon decisions are not made or responded to in writing during the specified time period, or a mutually agreeable extended time period, the University shall have waived its rights to

pursue development of the Intellectual Property, except that the University will retain royalty-free license rights to the Intellectual Property.

VIII. INVESTMENT IN BUSINESS ENTITY

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

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

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

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, Net Equity will be distributed as follows:

Net Equity Distribution

Creator(s)	Creator's Dept./Unit*	Creator's College	Georgia State University Research Foundation, Inc.
33 1/3%	23 1/3%	10%	33 1/3%

*When Net Equity 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.

If a Creator receives extraordinary compensation from or has a significant equity ownership interest in the company to which the Intellectual Property is licensed, then such Creator shall not participate in any distribution of proceeds. 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 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 Net Equity.

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 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. All appeals will be referred by the Vice President to the Intellectual Property Committee, which will make a recommendation to the Vice President within thirty (30) business days of its receipt of the appeal. Appeals that are time-sensitive will be referred by the Vice President to the Intellectual Property Committee, which will make a recommendation in a timely manner to the Vice President. The Vice President will then make a final decision concerning the appeal, which shall be made no later than forty-five (45) business days of 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 of the Vice

President's decision. The Provost shall make a decision no later than forty-five (45) business days of 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 no later than forty-five (45) business days of 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.

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 at least every two (2) years. 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 to comply with the provisions of this Policy is a violation and may result in discipline of an individual in accordance with applicable University policies and procedures.

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.

-Approved by the University Senate on December 5, 2002