

XAVIER UNIVERSITY OF LOUISIANA INTELLECTUAL PROPERTY POLICY AND PROCEDURE

1. Overview

The mission of Xavier University of Louisiana is the promotion of a more just and humane society. To this end Xavier prepares its students to assume roles of leadership and service in a global society. This preparation takes place in a diverse learning and teaching environment that incorporates all relevant educational means, including research and community service. While the research of Xavier faculty members is not primarily focused on the production of intellectual property that is commercially viable, this sometimes occurs. When it does, it is important that the University have a policy and process in place to effectively bring such ideas/inventions into practice so that they might benefit society. Moreover, federal granting agencies typically require such written policies and procedures for intellectual property resulting from work supported through their grants. This document is intended to clarify ownership, control, and use of such Intellectual Property at Xavier. The purpose of this policy and procedure is to encourage Xavier faculty, employees, students and any others covered by this policy to disclose and protect intellectual and other property resulting from their research so that the benefits of that research may reach society at the earliest opportunity. The definitions appearing in attached Appendix 1 are incorporated into and made a part of the policy.

2. Applicability

This policy applies to all University Employees and students. In addition to University Employees, but subject to Section 12 below, this policy also applies to any individual who:

- (a) is supported by University facilities or staff, or by funds administered by the University; and/or
- (b) is working at the University by virtue of a grant or a contract with an outside agency, whether government or private.

Upon prior written agreement with the University, this policy may also apply to individuals who do not fall into any of the above categories. (All those to whom this policy and procedure applies, as identified in this Section 2, are collectively referred to sometimes as “Applicable Individuals,” including without limitation Faculty, staff and students whether or not they are Employees of the University.)

3. Conditions of Employment, Enrollment and Support

This policy and procedure, as amended from time to time with the approval of the University Academic Assembly, shall become a part of the conditions of (a) the employment of every Employee and (b) the enrollment of every student, whether such Employee or student was employed or enrolled before or after its adoption. Moreover, as

a condition of their impending or continuing employment with, work at, enrollment at, or support by the University, all Applicable Individuals are required upon request to execute all lawful and appropriate patent applications, assignments and other documents as may be reasonably requested by the University so that it may implement, secure and protect the Intellectual Property to which it is entitled pursuant to this policy and procedure.

4. Ownership of Intellectual Property

- a. All Intellectual Property that is conceived or reduced to practice by any and all Applicable Individuals within the Course and Scope of their employment with, work at or support by the University, except for copyrights waived and released by the University pursuant to Section 7 below and subject always to Section 12 below, shall be the property of, and shall be assigned in writing to, the University.
- b. The Inventor shall cooperate and assist the University in all phases of securing, enforcing and commercializing the Invention, at no out-of-pocket expense to the Inventor.
- c. Inventions made by individuals on their own time and without the use of University resources shall belong to the Inventor, except as follows: if the subject matter of such Invention(s) is the same as or is directly related to subject matter on which the Applicable Individuals have worked at the University and/or with University support, then such Invention shall belong and be assigned to the University regardless of whether such Invention is made by the Applicable Individuals on their own time or with the use of their own resources.
- d. In cases in which the University has an ownership interest in an Invention pursuant to Section 4(a) above and fails to notify the Inventor that the University wishes to retain the Intellectual Property within the period set forth in Section 11.1.2, the University's right shall be reassigned to the Inventor upon written request.
- e. Any questions of Intellectual Property ownership, inventorship or revenue distribution which are disputed and remain unresolved shall in the first instance be referred to, and considered by, the Senior Vice President for Resource Development. The Senior Vice President for Resource Development may seek advice of the University Intellectual Property Committee. If the dispute is not resolved thereby, it shall be referred to and considered by the President or the President's designee, whose decision shall be final.

5. Disclosure

All Applicable Individuals shall disclose to the University, in accordance with the procedure set out in Section 11.1 below, any and all of their Invention(s) of Intellectual Property in which the University may have a right or claim under this policy and procedure.

6. Waiver and Release of Ownership Rights

In cases in which the University declines to accept, abandons or reassigns to the Inventor(s) any rights of ownership in an Invention to which it would otherwise have rights under this policy and procedure, all rights revert to the Inventor(s), except that the University shall retain a paid-up, non-transferable right to use the Invention for teaching and research at the University. The University shall, in such a case, execute all necessary documents for the waiver and release of ownership rights.

7. Copyrights

Books, Articles, Musical compositions, and Fine arts: Pursuant to U.S. copyright law, if a work of authorship is prepared by an employee within the course of his/her employment, the employer is considered to be the author and copyright owner of that work in the absence of an agreement to the contrary. Nevertheless, the University waives and releases, to their respective Inventors, the copyrights that the University would otherwise own in connection with articles, books, course materials, musical compositions, and fine arts (hereinafter referred to collectively as the “Particular Works”) written/created by Applicable Individuals except under circumstances in which (1) the Applicable Individual is specifically assigned and paid by the University to develop the Particular Work (as opposed to, for example, writing an article or an instructional manual as part of normal, ongoing faculty research or teaching duties); (2) the cost of publishing the Particular Work is specifically financed by the University; (3) the University is prohibited, by contract or by law, from waiving and/or releasing such copyrights; or (4) the Particular Work is fixed in a medium (e.g., a computer program) having a primarily functional or utilitarian purpose (such as the operation of an industrial or commercial process) rather than being primarily educational or informational. The University’s waiver and release of copyrights in and to Particular Works is subject to a paid-up, non-transferable right in favor of the University to use the Particular Works for teaching and research at the University.

If there is any dispute as to whether an Invention is a Particular Work which is to be released or retained by the University, such dispute shall in the first instance be referred to, and considered by, the Senior Vice President for Resource Development. The Senior Vice President for Resource Development may seek advice of the University Intellectual Property Committee. If the dispute is not resolved thereby, it shall be referred to and considered by the President or the President’s designee, whose decision shall be final.

8. Tangible Research Materials

“Tangible Research Material” means tangible items that are created, produced, discovered or otherwise developed in the course of research carried on at, by, or with the support of the University. Examples of Tangible Research Material include, but are not limited to, assay techniques, cell lines, compositions or procedures to make a formulation, and synthetic or biosynthetic chemicals for therapeutic or non-therapeutic uses. All Tangible Research Materials shall (subject always to Section 12 below) be the

property of the University. All such Tangible Research Materials shall be disclosed to the University in a manner analogous to the procedure described in Section 11.1 below.

9. Revenue Sharing

Revenue received by the University in the form of cash revenues and/or equity holdings which result from a license, sale or other commercialization of Intellectual Property which is owned by the University pursuant to Section 4 above, shall be distributed in such a manner as to encourage innovative technology development within, and technology transfer from, the University. The Cumulative Net Revenue (defined below) will be distributed by the Office of Resource Development in accordance with Table 1 below:

Table 1. Distribution of Cumulative Net Revenue⁽¹⁾

Cumulative Net Revenue	Inventor's Personal Share	Inventor's Research Share	Inventor's Department Share	University Share
First \$100,000	50%	0%	0%	50%
\$100,000-\$500,000	40%	5%	5%	50%
\$500,000-\$1,000,000	30%	10%	5%	55%
Over \$1,000,000	25%	10%	5%	60%

⁽¹⁾The Cumulative Net Revenue from a particular Intellectual Property means Gross Revenue⁽²⁾ proceeds from that Intellectual Property less Allowable Deductions⁽³⁾.

⁽²⁾The Gross Revenue from Intellectual Property means gross revenues, licensing fees or similar payments actually received from the sale, assignment, or licensing of the Intellectual Property concerned.

⁽³⁾Allowable Deductions comprise: (1) all direct expenditures made for the purpose of protecting the concerned Intellectual Property, including without limitation attorney fees incurred in patenting, licensing, and/or enforcing rights to the Intellectual Property; and (2) 10% of the remaining Gross Revenue from Intellectual Property, after deduction of (1), above, for the support of the Office of Resource Development.

Joint Inventors shall share the percentage of net revenue allocated to the Inventor pursuant to Table 1 above. The University will assume that all Inventors contributed equally to the development of the Intellectual Property, and should therefore share equally the net revenue allocated to the Inventor pursuant to Table 1 above, unless the Inventors request a different allocation. To be effective, such a request must be signed by all Inventors and be submitted to the Office of Resource Development. Any individual hired or retained for the purpose of producing an Intellectual Property shall not be entitled to a distribution of net revenue with respect to the concerned Intellectual Property.

The Inventor's Research Share shall be dedicated to the Inventor's own research needs, unrestricted as to use. If the Intellectual Property is created jointly by Inventors within the same college or department of the University but different laboratories, the Inventor's Research Share shall be distributed equally among all the Inventors, unless the Inventors request a different allocation. To be effective, such a request must be signed by all Inventors and be submitted to the Office of Resource Development. If the Intellectual Property is created jointly by individuals employed at different colleges or departments of the University, then besides distributing the Inventor's Research Share among Inventors as described earlier, the college or department's share (if applicable) shall also be distributed equally among the different colleges or departments, unless the Inventors request a different allocation. To be effective, such a request must be signed by all Inventors and be submitted to the Office of Resource Development.

10. Licensing Policy

It is the general policy of the University to encourage the development and marketing of Intellectual Property resulting from University research so as to reach a public usefulness and benefit. It is recognized that furtherance of such policy may require various forms of agreements including agreements to sell and the granting of exclusive licenses. The University, in appropriate circumstances with due consideration to the prospective parties and when consistent with law applicable to federally supported research, may license Intellectual Property on an exclusive basis for a reasonable period and may sell or otherwise commercialize Intellectual Property.

11. Procedure and Administration of Policy

The Senior Vice President for Resource Development or his/her designee(s), as appropriate, shall be responsible for the implementation and administration of this policy. This office shall develop, disseminate and implement policies and procedures relating to Intellectual Property. In addition, this office, coordinates the process of seeking appropriate protection of Intellectual Property, and assist faculty and staff in this regard. During the process, the office shall reasonably consider the interests of the individual Inventor of Intellectual Property, and take reasonable steps to involve the Inventor in the process.

11.1. Disclosure Procedures

11.1.1 All Applicable Individuals shall report promptly (within 30 days of conception or creation) to the University's Office of Resource Development any Invention that is subject to the obligation of disclosure as set forth in Section 5 above. This disclosure shall be made using Xavier University Confidential Disclosure Form. If additional information is required, the Office of Resource Development shall notify the individual Inventor, and shall specify the type of information it requires. Upon the receipt of sufficient information, or upon the expiration of ninety (90) days from the date of an inquiry as to sufficiency by the Inventor to which there has been no response by the

Office of Resource Development, whichever is earlier, the disclosure shall be deemed complete.

11.1.2 The Office of Resource Development shall notify the individual Inventor whether it wishes to retain the Intellectual Property in the disclosure or whether the University is obliged or voluntarily wishes to waive and release its ownership rights. Such notification may be demanded by the individual Inventor at any time after the University's receipt of a complete disclosure, and if so demanded, shall be given within a period of ninety (90) days after making of the demand, or within a period of six months from complete disclosure to the University, whichever period is longer.

11.1.3 If and after the University notifies the Inventor(s) that the University intends to file a patent application for the Invention, the Inventor(s) will cooperate reasonably with the University to try to avoid publication or use of the Invention in a manner which would compromise its patentability.

11.2. Procedures for the Protection, Development and Exploitation of Intellectual Property

The University shall, with respect to Intellectual Property owned and retained by it, take all reasonably appropriate measures to protect the property and exploit or otherwise develop it, and shall, upon reasonable request provide the individual Inventor with a written report describing the measures it has taken. In the event that the University decides subsequently not to take such measures, and to abandon the property, it shall notify the individual Inventor promptly of its decision.

11.3. Resolution of Disputes

Any dispute arising under this policy, involving the University and/or any Applicable Individual, shall in the first instance be referred to and considered by the Senior Vice President for Resource Development, after consultation and with the concurrence of the following: (a) the Senior Vice President for Academic Affairs, for such disputes involving Faculty or students - when appropriate and necessary, the Senior Vice President for Academic Affairs will consult the Vice President for Student Services; and (b) for such disputes involving staff, either the Senior Vice President for Administration or the Senior Vice President for Academic Affairs, depending upon and in accordance with where that staff member is located in the University's organizational structure. The Senior Vice President for Resource Development may seek advice of the University Intellectual Property Committee. If the dispute is not resolved thereby, it shall be referred to and considered by the President or the President's designee whose decision shall be final.

12. Agreement with Outside Agency

This policy shall not affect, in any way, any provisions in any grant, or sponsored research and/or publication agreement between an outside agency (government or public) and the University.

Appendix 1. Definitions

Invention: Invention refers to a creation of Intellectual Property.

Inventor: Inventor refers to person(s) who make(s) a creative input to the conception and/or creation of Intellectual Property, pursuant to and consistent with the applicable patent and/or copyright laws of the United States.

Intellectual Property: Intellectual property refers to creations of the mind, including without limitation the following: utilitarian ideas, concepts, know-how and trade secrets, whether or not patentable; trademarks, symbols, names, images, and designs which may be used in commerce; literary and artistic works such as novels, poems, plays, films, musical works, drawings, paintings, photographs and sculptures; architectural designs; and other works of authorship which may be subject to Copyright such as computer software.

Patent: Patent refers to a right granted to anyone who invents or discovers any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof, as set forth in 35 U.S.C. § 1 et seq. and other corresponding laws of other countries.

Copyright: Copyright refers to the exclusive legal rights set forth in U.S. copyright law under 17 U.S.C. § 106, including without limitation the right to reproduce, publish, sell, and distribute the work of authorship.

License: License refers to a contract which awards to a party other than the owner(s) of the Intellectual Property the right to make, use, or sell the Intellectual Property. Licenses may be awarded on an exclusive or non-exclusive basis and may provide for payment or fees.

Tangible Research Material: Tangible Research Material refers to all tangible items that are created, produced, discovered or otherwise developed in the course of research carried on at, by, or with the support of the University.

Employee: Employee refers to all full time and part time employees of Xavier University, whether faculty members, staff or students.

Faculty: Faculty refers to all full time, part time, adjunct, voluntary and emeritus members of Xavier University as defined in the Xavier University of Louisiana Faculty Handbook.

Student: Student refers to all full time and part time students enrolled in a course at Xavier University of Louisiana.

University: University refers to Xavier University of Louisiana.

Gross revenue: Gross revenue refers to revenue, licensing fees, or similar payments actually received from the sale, assignment, or licensing of the Intellectual Property conceived.

Allowable deductions: Allowable deductions refer to (1) all direct expenditures made for the purpose of protecting the concerned Intellectual Property and (2) 10% of the remaining Gross Revenue from Intellectual Property, after deduction of (1) above, for the support of the Office of Resource Development.

Course and scope of employment: Activities of an employee that are in furtherance of duties that are owed to an employer and where the employer is, or could be, exercising some control, directly or indirectly, over the activities of the employee.

Applicable Individuals: Applicable Individuals refers to all those to whom this policy and procedure applies, as identified in Section 2 above.