

HOWARD UNIVERSITY POLICY

Policy Number: Series 100: Academics and Research
Policy Title: 100-006 INTELLECTUAL PROPERTY POLICY
Responsible Officer: General Counsel
Responsible Office: Office of the General Counsel
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I. POLICY STATEMENT

The development, protection, and commercialization of Intellectual Property in a manner consistent with applicable law and respectful of academic traditions are critical elements of Howard University's operations as a national research university. This Policy controls the University's overall program for identifying, protecting, utilizing, and commercializing the University's Intellectual Property.

This Policy replaces the *Intellectual Property Policy* approved by the Howard University Board of Trustees in 1993. It is applicable to all faculty, students, and staff at the University. The terms and conditions of this Policy are a material term of employment and/or enrollment for all Howard University faculty, students, and staff.

II. RATIONALE

The *Intellectual Property Policy* is established to:

- Benefit Howard University through the protection and commercialization of Intellectual Property that would not have been developed but for access to: 1) the University's laboratories and research facilities; 2) direct research funding from the University; 3) the knowledge base and labor of the University community; 4) the ability to leverage Howard University's reputation and tradition to obtain research funding; and 5) other substantial University resources;
- Provide the University's authors and inventors with resources for the protection and marketing of Intellectual Property while providing them with an incentivizing share of the financial benefits of commercialization;
- Respect academic tradition by allowing authors to maintain personal ownership of most copyrightable works;
- Commercialize Intellectual Property developed at Howard University for the benefit of society at-large; and
- Comply with applicable federal laws and regulations when the University accepts federal funds for research and, further, to assist in the fulfillment of the terms of private research grants and contracts.

III. ENTITIES AFFECTED BY THIS POLICY

This Policy affects the entire University enterprise and any affiliated entities including, but not limited to, Howard University Hospital. It applies to all faculty and staff employed by the University, and all students enrolled at the University.

IV. DEFINITIONS

For the purposes of this Policy, the following definitions apply:

- A. **1993 Policy** - The *Intellectual Property Policy* approved by the Howard University Board of Trustees in 1993.
- B. **“The Committee” or “IPC”**- The Intellectual Property Committee described in section V.2.A of this Policy.
- C. **Copyright** - A property right in an original work of authorship fixed in a tangible medium of expression, giving the holder the exclusive right to reproduce, adapt, distribute, perform, and display the work.
- D. **Employee** - Any member of the faculty, staff or member of the student body who works for the University and is compensated for such services by the University including, but not limited to, via a University payroll check. Graduate assistants compensated for their services are specifically considered to be Employees of the University for the purposes of this Policy.
- E. **Intellectual Property or “IP”** - A concrete or abstract product of the human intellect protected by a category of intangible rights such as those granted by Patents, Copyrights, Trademarks, and Trade Secret protections.
- F. **Invention** - Any art, machine, manufacture, design, composition of matter, plant, or any new and useful improvement thereof which is or may be patentable.
- G. **Patent** - The right, granted by a government through “Letters Patent,” to exclude others from making, using, marketing, selling, offering for sale, or importing an Invention for a specific time period within a specific territory.
- H. **Policy** – The term “Policy” refers to this Howard University *Intellectual Property Policy*.
- I. **Originator** - The creator of a work of Intellectual Property, such as the author of a copyrighted work, the inventor of a patentable work, or the creator of a Trademark or Trade Secret.
- J. **Trademark** - Any word, name, symbol, or device, or any combination thereof adopted and used by persons in commerce to identify their goods and distinguish them from those manufactured or sold by others. When used herein, the term also encompasses “service

marks” which specifically refer to marks used in the sale or advertising of services to identify the services of one person or organization and distinguish them from the services of others.

- K. **Trade Secret** - Any formula, process, device, or other business information that derives independent economic value from not being generally known or ascertainable by others who can readily obtain economic value from its disclosure or use and is subject to reasonable efforts to maintain its secrecy. Trade Secrets must be kept in a manner consistent with applicable law in order to meet this definition.
- L. **University** - The Howard University or any foundation or affiliated entity that Howard University may have formed to develop, hold or manage any part of its Intellectual Property portfolio.
- M. **University IP** - Intellectual Property or “IP”, as defined in IV.E, in which the University has a right to assignment.

V. POLICY PROCEDURES

V.1 Duties and Rights

A. Disclosure Duties

1. Duty to Disclose Intellectual Property Generally

All Employees of the University who, within the scope of their employment with the University, create any Intellectual Property subject to the University’s right to assignment, as described in Section V.1.C, shall promptly disclose such Intellectual Property to the Intellectual Property Committee (IPC) through the process set forth by the IPC.

2. Duty to Disclose an Intent to Publish or Publicly Disclose Intellectual Property

All Employees of the University have an ongoing duty to promptly notify the IPC, through its ex officio member, in advance of any planned dissemination of IP content to any third parties, including but not limited to any planned submission for publication or any presentation, scholarly or otherwise, which the Employee would reasonably be expected to suspect may be University IP. Such notification must occur with enough time for the IPC, or its ex officio member, to be reasonably able to react before said submission or presentation.

B. Assignment Duty

1. Right to Assignment

As defined by this Policy and applicable law, the University has the right to assignment of certain Intellectual Property, as described in Section V.1.C., created by University Employees.

2. Operational Assignment of Intellectual Property

University Employees hereby assign all rights, titles, and interests in works of Intellectual Property that are subject to University's right to assignment to the University by operation of this Policy.

3. Separate, Written Assignment of Intellectual Property

When, separate from this Policy, written assignments or agreements are necessary under the law to assign all right, title, and interest in works of Intellectual Property that are subject to University's right of assignment to the University, University Employees have the duty to and shall, when directed by the University, promptly execute all contracts, assignments, waivers, or other documents and formalities necessary to assign to the University all the rights, title, and interest in the Intellectual Property.

C. Rights to Intellectual Property

1. Copyrightable Works

- a. The University has a right to assignment of copyrightable works that are "works for hire" as defined by the *Copyright Act of 1976, as amended*, to the extent that such copyrightable works are created within the scope of the author's employment including, but not limited to, online courses commissioned by the University, with the University, or within the scope of work of the author's contract with the University.
- b. The University has a right to assignment of other copyrightable works authored by University Employees under the following, limited circumstances:
 - i. The copyrightable work is created within the scope of the author's employment, is not a scholarly publication in a peer-reviewed journal, and the work would not have been created but for the use of substantial University resources.
 - ii. The copyrightable work is a work of computer software developed within the scope of the author's employment with the University.
 - iii. The copyrightable work is a foreign language translation of a copyrightable work owned by the University.

2. Inventions

- c. The University has a right to assignment of any and all Inventions created by University Employees during their employment at the University if:
 - i. Such Inventions would not have been created but for the use of substantial University resources; or
 - ii. Such Inventions resulted from activities consistent with the inventor's scope of employment at the University.

3. Trademarks

The University has the right to assignment of any and all Trademarks used in commerce to signify the University, any physical aspect of the University, or any program conducted by the University once it is used in commerce, whether or not it is disclosed to the IPC.

4. Trade Secrets

The University hereby asserts ownership in Trade Secrets that it maintains in accordance with applicable law. Staff, faculty, and students shall keep Trade Secrets confidential and shall not disclose Trade Secrets to any third party unless required by law.

5. Student Intellectual Property Rights

Howard University students have no duty to disclose or assign Intellectual Property to the University unless that student is also a University Employee, such as a graduate assistant. However, all non-Employee students who are co-inventors of Inventions developed by a University Employee are required to make a good faith effort to cooperate with the University's efforts to protect and commercialize that Intellectual Property, including but not limited to making themselves available to answer questions and review draft applications as requested.

6. Government Rights

The University's right to assignment of Intellectual Property may be subject to or co-existent with the rights of the United States Government pursuant to the *University and Small Business Patent and Procedures Act* (35 U.S.C. §§ 200-212) as amended.

7. Additional University Rights

All Employees hereby grant to the University the perpetual, royalty-free rights to use, at no cost and for educational purposes only, all Intellectual Property created while the Employee is working at the University and utilized during the course of their teaching or employment activities.

8. Presumption of Rights

The IPC presumes that any Intellectual Property described in this Section V.1 as subject to a right to assignment to the University is property of the University, unless an Originator can demonstrate to the IPC by a preponderance of the evidence that the University does not have a right to assignment of the Intellectual Property created by the Originator.

V.2 Intellectual Property Administration

A. The Intellectual Property Committee (IPC)

1. IPC Duties

The President of the University shall appoint an Intellectual Property Committee, which shall be responsible for the overall administration of this Policy. The Intellectual Property Committee shall consist of nine (9) voting members and one ex officio, non-voting member. The Intellectual Property Committee shall:

- a. Receive all Intellectual Property disclosures submitted under this Policy;
- b. Keep all Intellectual Property disclosures confidential and proprietary;
- c. Determine the ownership of rights to Intellectual Property, and enforce the University's right to assignment to certain Intellectual Property in accordance with this Policy and any necessary guidelines developed by the Committee;
- d. Determine whether to seek protection through Patent, Copyright, Trademark registration, or Trade Secret protection;
- e. Evaluate potential commercial use and determine possible courses of action for protection and/or marketing intellectual properties assigned to the University or subject to the University's right to assignment;
- f. Consult with the Originator(s), the Office of the General Counsel, and outside consultants in its Intellectual Property commercialization efforts;
- g. Approve licensing and technology transfer agreements;
- h. Maintain complete records on all disclosures and other Intellectual Property matters of interest to the University administration;
- i. Prepare periodic reports of the Intellectual Property Committee to the President and the Board of Trustees as requested;
- j. Administer this Policy and serve as a clearinghouse for proposed revisions; and
- k. Delegate these responsibilities to its ex officio member as it deems necessary and proper for the efficient administration of this Policy.

2. Voting Members of the IPC

- a. The nine (9) voting members shall be appointed by the President.
- b. The Committee shall have nine (9) voting seats. The voting seats on the Committee shall be filled as follows:
 - i. One (1) from the faculty of the College of Engineering, Architecture, and Computer Sciences;
 - ii. One (1) from the faculty of the College of Medicine;
 - iii. Two (2) from among the University faculty at-large;
 - iv. One (1) from among the University non-faculty staff at-large;
 - v. One (1) as nominated by the Howard University Faculty Senate;
 - vi. The Dean, Howard University School of Business or his or her designee;
 - vii. The Vice President, Entrepreneurship and Research or, if not available, the designee of the Provost; and
 - viii. The Associate Provost for Research or the functional equivalent of this position.
- c. All Committee members serving on the Committee established by the 1993 Policy will be allowed to remain on the Committee upon the adoption of this Policy. The Committee will nominate new members as set forth in sections V.2.A.2.b.i-iv. The membership as defined in sections V.2.A.2b.v-vii shall be filled in accordance to those Sections.
- d. To the extent that the University merges or eliminates any of the schools or departments listed in section V.2.A.2.b., the Committee shall nominate a University faculty member to fill that vacancy.

3. Ex Officio Member of the IPC

- a. The General Counsel to the University, or his/her designee, shall serve as the ex officio, non-voting member of the Committee, shall advise the Committee members, and shall carry out the day-to-day administrative functions of the Committee as directed, pre-approved, or ratified by the Committee. The ex officio position shall be filled at all times and shall not be left vacant.
- b. The ex officio member shall evaluate potential commercial use of Intellectual Property disclosed to the IPC, investigate possible courses of action for protecting and/or marketing properties in which Howard University has an ownership interest or a right to assignment, and advise the Committee members.
- c. The Office of the General Counsel is the only entity that can procure legal representation for the protection of University Intellectual Property and/or the enforcement of the University's Intellectual Property rights.

- d. The role of the Office of the General Counsel to advise the Committee and University on Intellectual Property matters shall not be supplanted.

4. Vacancies and Terms

- a. In the event of a vacancy, the Intellectual Property Committee shall collect nominations to fill that vacancy as outlined in Section V.2.A.2.b. of this Policy. The Committee shall then submit the nomination to the President for his or her approval.
- b. The voting members of the Committee shall serve three-year terms with dates starting either on the date of approval of this Policy, if the voting member was appointed under the 1993 Policy, or when the voting member is appointed by the President.

5. Dispute Resolution

- a. Decisions of the IPC may be appealed to the President of the University in writing within thirty (30) days of the Committee's decision. The President will base his or her decision on a preponderance of the evidence and hear the appeal de novo. The decision of the President shall be final.
- b. Only an Employee who is also an Originator of Intellectual Property subject to a decision of the IPC may appeal the decision of the IPC.

6. Rules of the Committee

- a. The Committee shall meet quarterly, or as needed to perform its duties.
- b. The Committee may create its own internal operational rules where this Policy is silent, including but not limited to the determination of quorum. Such rules shall be put into effect by a vote of the majority of the Committee's voting members.

B. Intellectual Property Management

1. Evaluation Period for Inventions and Copyrightable Works

Once the IPC receives an Intellectual Property disclosure for an Invention or copyrightable work, it will consider whether the University can assert a right to assignment of the Invention or copyrightable work. If the IPC determines that the University has a right to assignment, it shall then evaluate the protection and commercialization prospects for Invention(s) or copyrightable work(s) disclosed to it. If the IPC determines that neither commercial possibilities nor potential contribution to the public good warrants proceeding further with the legal protection or marketing of the Invention or copyrightable work, the Committee may decline to assert the University's right to assignment of the Invention or copyrightable work.

The Committee shall inform the disclosing Originator (s) of its decision to assert or decline to assert University's right to assignment of a copyrightable work or

Invention within six months of disclosure of the copyrightable work or Invention to the IPC, assuming that the Originator(s) has or have fully cooperated with the Committee in its protection and commercialization efforts. This six-month time period begins on the date that a formal disclosure is made by the Originator(s) to the IPC and is not in effect if the IPC learns of a work of Intellectual Property through other means. This time period may be extended by the Committee for an additional six months upon notice to the Originator(s) if the nature of the disclosure necessitates such an extension.

2. Publications and Patents

The advancement and dissemination of knowledge via scholarly publication is a central part of the University's mission and is critical to the career development of its faculty. The IPC shall avoid unreasonably restricting academic and research publications, including publication of research results. However, publication, public use, or non-confidential disclosure of an Invention prior to the filing of a Patent application has a significant negative impact on University and Originator rights. In the event of an imminent publication or public disclosure of an Invention, the IPC will work with the Originator(s) to protect the Invention in a manner that will allow for timely publication.

The Intellectual Property Committee shall determine, after conferring with the Originator(s) and any relevant sponsor, whether such publication, use, or disclosure will jeopardize any Patent application in process or under consideration to be filed. If a delay is desired, the Intellectual Property Committee will notify the Originator(s) to withhold the submission of the manuscript to a publisher, or delay the use or disclosure of the Invention for a short period of time, but in no event shall such delay exceed three months from the date of submission of the disclosure to the IPC.

3. License Negotiation Guidelines

In licensing, selling, or otherwise disposing of rights to Intellectual Property, the University will consult with the Originator(s) and include his/her views in the decision-making process. Royalty rates shall be reasonable and consistent with the goal of the University's goal of transferring technology effectively in the public interest. In many cases, the University will grant non-exclusive, reasonable royalty-bearing licenses to all qualified licensees. However, the University recognizes that non-exclusive licensing in many cases may not maximize the commercial potential of Intellectual Property. In such cases, the University may grant an exclusive license. In all cases, the University will attempt to reserve, for itself, a license to Intellectual Property for non-commercial uses.

4. Review of Older Patents

After a Patent has been issued by the Patent and Trademark Office for over ten years, the Intellectual Property Committee shall consider whether the University will likely make any additional efforts to license or sell the rights assigned to it by

the Originator(s). If the IPC determines that the University will not likely make additional efforts, it may, at its sole and absolute discretion, assign all rights in the Invention to the Originator(s).

C. Division of Income

1. Income Distribution

- a. When the University receives income from the commercialization of Intellectual Property, the University will first deduct any direct expenses incurred by it in connection with the preparation, filing, marketing, commercialization, or defense of the Intellectual Property. If any such expenses are incurred by the Originator(s) with the prior written approval of the Intellectual Property Committee, such expenses shall also be deducted and the Originator(s) shall be reimbursed. The income remaining shall constitute "Net Income."
- b. Unless otherwise agreed between the University and the Originator(s), the University will then pay to the Originator(s) fifty-percent 50% of the Net Income derived from the sale, license, or other commercialization of all Intellectual Property assigned to the University by the Originator(s). This income shall be distributed equally if there are multiple Originators unless the Originators demonstrate to the satisfaction of the Intellectual Property Committee that another proportion is appropriate. The remainder of the Net Income shall be distributed in accordance with the instructions of the Intellectual Property Committee to (a) defray its costs and/or (b) support further research activities at the University.
- c. When more than one Originator is involved in the creation of an Invention or Intellectual Property, the Committee shall seek the concurrence of the Originators in determining the relative distribution of Net Income among them. If they cannot reach an agreement among themselves, the Committee shall make the determination in good faith. The joint Originators shall hold the University harmless in its determination in good faith of the appropriate Net Income distributions.
- d. The right of an Originator(s) to receive Net Income shall extend until the expiration of Intellectual Property's legal protection, or the period of time that the University continues to receive income from the Intellectual Property, whichever is longer. An Originator's personal interest shall survive termination of affiliation with the University and, in the event of the death, shall inure to his/her estate.

2. Directing of the University's Share of Net IP Income

The IPC shall determine how IP income shall be credited to University departments, in accordance with this Policy, and inform the University's finance division of such.

3. Income Distribution for Donated Intellectual Property

When Intellectual Property is donated or bequeathed to the University, and is under the care of a specific department, school or college, that department ordinarily would receive a percentage of the University's Net Income from any sale or licensing of the donated Intellectual Property. These proceeds are intended, in part, to assist the department in the proper maintenance, public display (where appropriate) and preservation of such IP assets. This amount may be determined differently by the Committee and the University's finance division. If this Section should be in conflict with a specific gifting agreement, that gifting agreement shall control unless the University obtains a legal waiver.

V.3 Miscellaneous Terms

A. Use of University's Name

Any use of the University's name by a third party for promotional or publicity purposes must be approved in writing in advance by the University.

B. Binding Effect

This Policy as amended from time to time shall be deemed to be a condition of initial and continuing employment of every University Employee (whether faculty, staff, student Employee or other), and a condition of enrollment and attendance of every student who works on any research project under University control. Any use of University funds or facilities after the effective date of this Policy shall be subject to this Policy. Additionally, with respect to projects sponsored by third parties, certain faculty, staff and students working on such projects may be required to sign separate agreements incorporating the terms of this Policy and certain requirements specific to the related grant or contract. The failure of any Employee or student to sign an agreement incorporating the terms of this Policy shall not affect the applicability or validity of this Policy nor relieve any Employee or student from the obligations imposed by it.

C. Survival and Modification

This Policy may only be changed or discontinued by action of the Board of Trustees. Such changes or discontinuance shall not affect rights accrued prior to the date of such action.

D. Severability

If any term or provision of this Policy is found by a court of competent jurisdiction to be invalid, illegal, or otherwise unenforceable, the same shall not affect the other terms or provisions hereof or the whole of this Policy.

E. Applicable Law

This Policy shall be interpreted, controlled, and enforced in accordance with the substantive laws of the United States of America and the District of Columbia, without reference to the District of Columbia's Conflict of Laws Rule.

F. Improper Licenses and Assignments Void; Notice to the Public

Any assignment or license agreement that an Originator enters into with a third party involving Intellectual Property that the Originator had or has a duty to assign to the University as defined in this Policy is hereby void and without effect, despite any representations made by the Originator to third parties.

This shall serve as notice to third parties and the public at-large that Howard University inventors or other Originators may be estopped by contract from unilaterally assigning Intellectual Property in which Howard University may have an interest under this Policy. Third parties seeking license or assignment should contact the Howard University Intellectual Property Committee through the University's Office of the General Counsel.

G. Guidance on Form Notices

When notices are used, University IP should contain notices substantially similar to the following, having the same legal effect:

1. Copyrights – © [date] Howard University, all rights reserved
2. Patents – “Patent Pending” or “Patent No. _____”
3. Trademarks – ® Howard University or TMHoward University

VI. SANCTIONS

Violations of this Policy will be subject to Howard University's discipline process. The University reserves the right to take legal action against any violators of this Policy, whether or not that person remains employed at the University.

VII. HYPERLINKS AND WEBSITE ADDRESS

University:

www.howard.edu/policy
[Intellectual Property Commercialization Center](#)

Other Resources:

[Copyright Act of 1976, as amended](#)
[University and Small Business Patent and Procedures Act \(35 U.S.C. §§ 200-212\), as amended](#)