

# HOWARD UNIVERSITY POLICY

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**Policy Number:** 100-006 Academics and Research  
**Policy Title:** TECHNOLOGY TRANSFER POLICY  
**Responsible Officer:** Senior Vice President for Research  
**Responsible Office:** Office of Research  
**Effective Date:** August 30, 2023  
Approved by the Board of Trustees on  
September 23, 1993 as *Intellectual Property*  
*Policy*, Revised November 6, 2014

## 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 and adopted in 2014, which amended 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 Technology Transfer 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 training, 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. **“TTAC”** – The Technology Transfer Advisory Committee described in Section V.2.D. 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** - A novel device, method, art, machine, manufacture, design, composition of matter, plant, or any new and useful improvement thereof, which is or may be patentable or protected under trade secret.
- 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 *Technology Transfer 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 above, in which the University has a right to assignment under Section V.1.B and V.1.C.
- N. **University Invention** – An Invention, as defined above, in which the University has a right to assignment under Section V.1.B and V.1.C.
- O. **Technology Transfer Unit** (“Technology Transfer”) – A unit of the Office of Research dedicated to the protection, administration, and marketing of University Inventions.

## V. **POLICY PROCEDURES**

### V.1 **Duties and Rights**

#### A. **Disclosure Duties**

##### 1. **Duty to Disclose Inventions 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 assign, as described in Section V.1.C, shall promptly disclose such Intellectual Property to Technology Transfer through the process set forth by head of Technology Transfer.

##### 2. **Duty to Disclose an Intent to Publish or Publicly Disclose Inventions**

All Employees of the University have an ongoing duty to promptly notify Technology Transfer 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 should reasonably suspect may be a University Invention. Such notification must occur with enough time for Technology Transfer 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.
- c. As a general principle, the University will not assert ownership of articles for publication in peer-reviewed scholarly journals that do not otherwise contain University IP.

### 2. **Inventions**

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 Technology Transfer.

### 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 Student Intellectual Property Rights

Howard University students retain all their rights under United States Patent Law and have no duty to disclose or assign Intellectual Property to the University unless that student: 1) is an University Employee, such as, but not limited to, a graduate assistant or undergraduate research assistant, 2) utilizes the University's laboratories and research facilities outside of the uses contemplated in any enrolled academic program at the University; 3) utilizes direct research funding from the University in the development of the Intellectual Property; or 4) utilizes other substantial University resources. 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.

### 5. **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 "Bayh-Dole Act" (*University and Small Business Patent and Procedures Act*, 35 U.S.C. §§ 200-212) as amended.

### 6. **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.

### 7. **Presumption of Rights**

With regard to the burden of showing rights in IP, this Policy creates a legal presumption that any Intellectual Property described in this Section V.1 is subject to a right to assignment to the University and is property of the University unless an Originator can demonstrate to Technology Transfer 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 Invention Administration, Management and Commercialization**

### **A. Invention Administration**

#### **1. Overall Administration**

The Unit Head and staff of Technology Transfer shall administer all Inventions owned by and on behalf of Howard University.

#### **2. Patent Administration**

In the implementation of Howard University's policies and procedures with respect to the patenting of Howard University-owned Intellectual Property, the Unit Head of Technology Transfer may elect any of the following courses:

- i Request that the Office of the General Counsel direct outside patent counsel to draft, file, and prosecute patent or trademark applications;
- ii or  
Direct the release and transfer of title or Howard University's rights in an Invention to the Inventor within a prescribed period and seek the assistance of the Office of the General Counsel to effectuate the same.

#### **3. Licensing Administration**

In the implementation of Howard University's policies and procedures with respect to the licensing of Howard University owned Inventions, the Unit Head of Technology Transfer may elect any of the following courses:

- i Develop and manage a licensing program through an independent patent assistance organization;
- ii Develop and manage a licensing program through an affiliated nonprofit corporation;
- iii Develop and manage a licensing program within the Technology Transfer Unit; or
- iv Release, in accordance with Article V.2.A.2., an invention to which Howard University has title or interest to the Inventor for management and development as a private venture after the execution of an agreement providing for the division of income and for managing any potential conflicts of time, interest, and commitment.

#### **4. Reporting**

Senior Vice President for Research shall report annually to the Howard University Faculty Senate, the President of Howard University: Key intellectual property & innovation metrics.

#### **5. Legal Matters**

It will be the sole responsibility of the Unit Head of Technology Transfer in close consultation with the Office of General Counsel to determine ownership of Inventions, to negotiate the intellectual property terms of all technology transfer

agreements, collaboration agreements, and related confidentiality agreements, and to resolve disputes among co-Inventors and co-authors/co-creators.

#### **6. Dispute Resolution**

Any disagreement between the Inventor(s) or author(s)/creator(s) and the Unit Head of Technology Transfer concerning ownership of Intellectual Property may be appealed to the Senior Vice President for Research at Howard University. If the issue is not resolved at this level, a final appeal may be made to the Provost and the President of Howard University.

#### **7. Income**

The income received by Howard University from the transfer of Intellectual Property to third parties that is subject to this policy shall be shared with the Inventor(s) or the author(s)/creator(s) as stated in Section V.C.1 below; it should be understood that if there is a plurality of Inventors or authors/creators, the portion accruing to the Inventors or authors/creators will be distributed on an equal share basis unless otherwise specifically agreed to in writing by all of the Inventors or authors/creators. The Inventor(s) or author(s)/creator(s) at or before the time of filing a patent application or copyright registration must agree to sign any required declarations or assignments and assist Technology Transfer in perfecting the title in the name of Howard University.

### **B. Invention Management**

#### **1. Evaluation Period for Inventions**

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

Technology Transfer shall inform the disclosing Originator (s) of its decision to assert or decline to assert the University's right to assignment of an Invention within three months of disclosure of the Invention to Technology Transfer if the Originator(s) has or have fully cooperated with Technology Transfer in its protection and commercialization efforts. This three-month period begins on the date that a formal disclosure is made by the Originator(s) to the Technology Transfer and is not in effect if Technology Transfer learns of a work of Intellectual Property through other means. This period may be extended by Technology Transfer for an additional three months upon notice to the Originator(s) if the nature of the disclosure necessitates such an extension.

## **2. Publications and Patents**

Technology Transfer shall approve any public disclosures and publications related to Howard University-sponsored research that may contain information related to a University Invention. Technology Transfer 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, Technology Transfer 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 brief period, but in no event shall such delay exceed three months from the date of submission of the disclosure to Technology Transfer.

The advancement and dissemination of knowledge via a scholarly publication is a central part of the University's mission and is critical to the career development of its faculty. Technology Transfer shall avoid unreasonably restricting academic and research publications, including the publication of research results. However, publication, public use, or non-confidential disclosure of an Invention before 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, Technology Transfer will work with the Originator(s) to protect the Invention in a manner that will allow for timely publication.

## **3. License Negotiation Guidelines**

In licensing, selling, or otherwise disposing of rights to Intellectual Property, Technology Transfer will consult with the Originator(s) and include their views in the decision-making process. Royalty rates shall be reasonable and consistent with 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 a license to Intellectual Property for non-commercial uses.

## **4. Review of Older Patents**

Technology Transfer shall establish a process to conduct a periodic review of the patent portfolio to determine whether to abandon patents where support is no longer warranted.

After a Patent has been issued by the Patent and Trademark Office, Technology Transfer 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 Technology Transfer 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**

- i 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 Technology Transfer, such expenses shall be deducted, and the Originator(s) shall be reimbursed. The income remaining shall constitute "Net Income."
- ii 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 Technology Transfer that another proportion is appropriate.
- iii When more than one Originator is involved in creating an Invention or Intellectual Property, Technology Transfer shall seek the concurrence of the Originators in determining the relative distribution of Net Income among them and the corresponding schools or colleges. If they cannot agree, the Unit Head of Technology Transfer 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.
- iv The right of an Originator(s) to receive Net Income shall extend until the expiration of Intellectual Property's legal protection or the period 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 their estate.

### **2. Directing the University's Share of Net Income from Inventions**

The Senior Vice President for Research shall ensure Net Income from University Inventions is distributed in accordance with this Policy and inform the University's finance division of such Income Distribution for Donated Patents and Otherwise Protected Inventions

When an Invention 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 license 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 by Technology Transfer and the University's finance division. If this Section should conflict with a specific gifting agreement, that gifting agreement shall control unless the University obtains a legal waiver.

## D. Committees

### 1. **Technology Transfer Advisory Committee (TTAC)**

A Technology Transfer Advisory Committee composed of:

- a. Senior Vice President for Research (or designate)
- b. Chief Financial Officer (or designate)
- c. General Counsel (or designate)
- d. The Dean, Howard University College of Engineering and Architecture (or designate)
- e. The Dean, Howard University School of Business (or designate)
- f. Unit Head of Technology Transfer
- g. Faculty members appointed by the Senior Vice President for Research:
  - i. One (1) from the faculty of the College of Medicine;
  - ii. One (1) from the faculty of the School of Law;
  - iii. One (1) from the faculty of the College of Art and Sciences;
  - iv. One (1) from among the University non-faculty staff at-large;
  - v. One (1) as nominated by the Howard University Faculty Senate;

shall make recommendations to the Senior Vice President for Research regarding procedures, guidelines, and responsibilities for the administration and commercialization of Intellectual Property owned by and on behalf of Howard University and such other matters as the Senior Vice President for Research shall determine.

- i. **Technology Assessment Committee (TAC)** - A private-public Technology Assessment Committee will assess, guide, and champion opportunities to commercialize intellectual property owned by and on behalf of Howard University. The committee shall be comprised of subject matter experts, entrepreneurs, mentors, venture capitalists, leaders in the business community, and government representatives selected by the Unit Head of Technology Transfer and approved by the Senior Vice President for Research.
- ii. The committee and the Unit Head of Technology Transfer will work in partnership to advance protectable opportunities with significant market impact through start-up, licensing, and business development strategies. By leveraging resources, the committee will become a catalyst to increase commercialization and broaden the impact of Howard's intellectual property.
- iii. The Technology Assessment Committee provides important insights, potential access to resources, and market information so that the Unit Head of Technology Transfer and the business community can make educated decisions on whether to expend resources protecting and commercializing existing and promising inventions.

### **V.3 Administration of Trademarks**

The distribution of rights and duties regarding Trademarks is outlined in Article V.I.C.3 above, of this Policy. Administration of all Trademarks will be governed by the applicable trademark policy.

### **V.4 Administration of Copyrights**

The distribution of rights and duties regarding Copyrights is outlined in Article V.I.C.1 of this Policy. Administration of Copyrights (except for those protecting Inventions) is governed by the applicable copyrights policy.

### **V.5 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 the Board of Trustees. Such changes or discontinuance shall not affect rights accrued before 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 licenses or assignments should contact the Technology Transfer team through the University's Office of Research.

#### **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 <sup>TM</sup>Howard 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. OTHER RESOURCES**

[University Policy Office](https://secretary.howard.edu/policy-office): <https://secretary.howard.edu/policy-office>

[Office of Research](#)

Other Resources:

- [\*Copyright Act of 1976, as amended\*](#)
- [\*University Small Business Patent and Procedures Act: \(35 USC §§200-212, as amended\)\*](#)