



The Rensselaer Intellectual Property Policy

Effective January 1, 2007

Section I: The Rensselaer Intellectual Property Policy

Part I – Introduction

Rensselaer has devised *The Rensselaer Intellectual Property Policy* to benefit the public by encouraging and enabling technology development and transfer. The Rensselaer community is inherently creative, and Rensselaer's physical and intellectual resources enhance the creativity of members of that community. This policy reflects, in part, Rensselaer's contribution to that creativity. It encourages creators to innovate by guaranteeing them a share in the benefits resulting from the Intellectual Property that they develop. At the same time, it also promotes research and education activities at Rensselaer by allowing Rensselaer to retain a share of the benefits flowing from all Intellectual Property developed under its auspices.

There are numerous types of Intellectual Property, and a distinct body of law applies to each one. The primary categories of Intellectual Property are patent, copyright, trademark, and integrated circuit mask work protection, though from time to time other types of protection and other bodies of law may also fall under the broad heading of Intellectual Property. Intellectual Property rights govern the ownership, licensing, distribution, and commercialization of Intellectual Property.

This Policy describes the rights and responsibilities of all the members of the Rensselaer community in all Intellectual Property developments, as well as the rights and responsibilities of Rensselaer itself. Specifically, it describes Rensselaer's policies concerning the ownership, licensing, distribution, and commercial development of Intellectual Property that creators conceive, invent, develop, or use. The policy applies to all Intellectual Property, whether it is patentable, copyrightable, subject to trademark registration or is otherwise proprietary to Rensselaer.

Part 2 - Ownership of Intellectual Property

2.1 Creator-Owned Intellectual Property

Creators retain full ownership rights to Intellectual Property provided that the following three conditions are met:

- (a) Intellectual Property is not subject to a sponsored research or other agreement requiring ownership to reside in some other party including Rensselaer; and

- (b) Intellectual Property was not conceived, created, developed, or first reduced to practice with Significant Use of Rensselaer Support; and
- (c) Intellectual Property was not conceived, created, developed or first reduced to practice as a direct result of his/her duties at Rensselaer.

Creators may choose to use creator-owned Intellectual Property in their research work at Rensselaer. A creator who chooses to do so, however, must grant Rensselaer a free, permanent, irrevocable license for use of that Intellectual Property for Rensselaer's educational and research activities. The creator's discretionary decision to use creator-owned Intellectual Property in a Rensselaer project therefore immediately grants Rensselaer such a license, even in the absence of a formal written agreement.

2.2 Rensselaer-Owned Intellectual Property

Rensselaer retains full ownership rights to:

- (a) Intellectual Property subject to the terms of a sponsored research or other agreement that grants Rensselaer rights of ownership; or
- (b) Intellectual Property whose conception, creation, development or first reduction to practice involved Significant Use of Rensselaer Support; or
- (c) Intellectual Property that was conceived, created, developed or first reduced to practice as a direct result of Institute duties; or
- (d) Copyrighted material created as a “work made for hire” by operation of copyright law or pursuant to a written agreement with Rensselaer transferring copyright to Rensselaer; or
- (e) Trade or service marks relating to Intellectual Property or to goods, services, programs, or Intellectual Property that Rensselaer owns or provides.

2.3 Ownership of Instructional Works

For purposes of this policy, the term Instructional Works covers all materials developed for pedagogical purposes, including Course Materials, Courses, Courseware or any combination thereof.

- (a) **Course Materials** include copyrightable fixed expressions of ideas, resources, content and/or Information-Like Works that may be used as the basis of a Course. In keeping with academic tradition and without regard to the medium of expression, Rensselaer treats Course Materials as

Exempted Scholarly Works, which are presumed to be owned by the author. As such, unless the work is subject to contractual restrictions or is a “work made for hire,” Rensselaer does not claim copyright ownership of Course Materials.

- (b) A **Course** is a comprehensive set of works that has been developed and combined to substantiate a presentable program of study. Courses often transcend a single faculty member’s design, to engage institutional sanction and authority. As such, Rensselaer owns all Courses developed for teaching at Rensselaer. The use within a Course of Course Materials or other Exempted Scholarly Works, standing alone, shall not deprive creators of their ownership of such materials.
- (c) **Courseware** includes works that can act as tools or devices in the task of creating, managing, presenting and/or publishing Course Materials to produce a Course. Courseware may be patentable, non-patentable, copyrightable or otherwise protectable. Courseware ownership shall be in accord with Section 2.1 and 2.2 of this Policy.

Rensselaer personnel may produce Instructional Works under several different sets of conditions that will affect ownership and rights. As such, Rensselaer requires that the relevant parties establish written agreements amongst themselves in all cases involving a work for hire, an assigned duty, a sponsored work or works involving potential or actual joint ownership

2.4 Ownership of Textbooks, Theses, and Other Exempted Scholarly Works

In keeping with longstanding academic tradition, Rensselaer will grant to the creator all of the rights in such scholarly or artistic works which copyright law would otherwise give Rensselaer unless a written agreement provides otherwise. The ownership of other Intellectual Property disclosed in theses remains subject to the terms expressed in Parts 2.1 and 2.2, above. For more details, see the definition of Exempted Scholarly Works in Appendix A.

2.5 Ownership of Intellectual Property Financed By Outside Sponsors

Rensselaer will retain title to all Rensselaer-Owned Intellectual Property (see Section 2.2) including, but not limited to, that which is conceived, created, developed or first reduced to practice in the course of Rensselaer research or other sponsored activities funded by third parties, including private persons, businesses, not-for-profit entities, and state, local, or federal governmental agencies unless there is a written agreement between Rensselaer and the Creator to the contrary.

2.6 Intellectual Property and Conflicts of Interest

Rensselaer personnel engaged in consulting work with third parties are responsible for ensuring that their consulting agreements do not conflict with Rensselaer's Intellectual Property policies. These individuals should consult and must comply with *Rensselaer's Conflict of Interest Policy*. Rensselaer personnel undertaking consulting that involves the commercialization of Rensselaer Intellectual Property must submit a *Conflict of Interest Report* as specified in *Rensselaer's Conflict of Interest Policy*.

2.7 Ownership, Control, and Transfer of Tangible Research Property (TRP)

Rensselaer shall own any and all Tangible Research Property (TRP) that a creator conceives, creates, makes, develops, or first reduces to practice, in whole or in part, during or pursuant to his or her employment, participation in Rensselaer programs, or Significant Use of Rensselaer Support. Creators must coordinate the distribution of all Rensselaer TRP with the Office of Research Administration and Finance (RAF). All distributions of TRP for research purposes are subject to RAF approval. A material transfer agreement (MTA) is required prior to any such distribution.

Part 3 - Intellectual Property Reporting, Evaluation, Protection and Commercialization

3.1 Disclosures

Creators need to make a careful evaluation of Intellectual Property that he or she has created at Rensselaer in order to determine whether or not that Intellectual Property has any possible commercial or other value. If it does, for the protection of the interests of the creator and Rensselaer, every creator is obligated to disclose all Intellectual Property that he or she has created at Rensselaer. Rensselaer's Office of Technology Commercialization (OTC) is the primary contact for the creator with regard to their disclosure of Intellectual Property. The OTC is responsible for protecting, marketing, negotiating and licensing Rensselaer Intellectual Property. The creator must submit a complete disclosure form to the OTC before notifying outside parties, including sponsors. The OTC will then determine whether the technology is ripe for commercialization and/or protection. The decision to protect, develop, market and/or commercialize any Rensselaer Intellectual Property is at Rensselaer's sole discretion. The OTC will provide a timely response to creators and may employ outside evaluators and other consultants to review the disclosure, as well as to assist in the licensing, commercialization and protection of the Intellectual Property. The OTC will also monitor the progress of the commercialization effort and distribute any resulting

Intellectual Property revenue in accordance with Section 4.1 of this Policy. All departing Creators will also be asked by Rensselaer's Department of Human Resources as part of the normal exit interview process to disclose any Intellectual Property not previously disclosed.

3.2 Rensselaer's Commercialization of Creator-Owned Intellectual Property

Creators may request that Rensselaer pursue the commercial development of Intellectual Property owned by the creator. The OTC will evaluate the commercial potential of any Intellectual Property and determine whether or not Rensselaer will accept it for licensing. If Rensselaer has determined to pursue commercialization, the creator will be required to assign their ownership of the Intellectual Property to Rensselaer. The terms of such assignment will be negotiated between Rensselaer and the creator.

3.3 Transfer of Rensselaer Intellectual Property to Creators

If Rensselaer chooses to waive its rights in disclosed Intellectual Property, and to grant those rights to the creator, the creator may protect the Intellectual Property as he, she, or they may wish. If external funds supported the work leading to the Intellectual Property, this waiver is subject to any provisions in the sponsoring agreement. For example, under current federal law, if Rensselaer waives its rights in Intellectual Property conceived or reduced to practice with federal funding, the federal funding agency, rather than the creator, becomes the assignee. The creator may then petition the agency for the license rights in such cases.

Part 4 Intellectual Property Revenue

4.1 Distribution of Income From Intellectual Property

The OTC will calculate and distribute the Net Adjusted Income from each Intellectual Property license or licensing related transaction, according to the following:

1. Net Adjusted Income = gross revenue, minus current and reasonable projected expenses that Rensselaer deems necessary to defend or maintain the Intellectual Property.
2. Creator's Share = 35% of the Net Adjusted Income.
3. Unit Share to the creator(s) respective Academic School or Institute Center = 15% of the Net Adjusted Income.
4. Institute Share = 50% of the Net Adjusted Income.

Distribution of Net Adjusted Income will occur on a semi-annual basis.

4.2 Distribution of Net Equity Income Received From Intellectual Property

Rensselaer may elect to accept equity in lieu of cash payments, licensing fees, royalties, or other consideration. The decision whether to accept equity and, if so, precisely when to liquidate such equity, is at the sole discretion of Rensselaer. When liquidating or otherwise disposing of any equity interests, Rensselaer may incur the payment of commissions, other fees or charges and other expenses. All such expenses are considered development expenses in determining the Net Equity Income that is to be distributed according to Sections 4.1 as net adjusted Income.

4.3 Revenue from Instructional Works

Creators involved in the development of Instructional Works will share, when appropriate, in Intellectual Property revenue generated from external use and distribution via licensing, assignment, licensing related transactions of such materials, as further set forth in Sections 4.1.

Part 5 - Faculty, Student, Staff, and Visitor Obligations with Respect to Intellectual Property

5.1 Introduction

Many members of the Rensselaer community participate in the creation of Intellectual Property. Anyone positioned to participate in this process must sign the Rensselaer Intellectual Property agreement or other relevant documents in accord with this policy. This requirement extends to all who:

- (a) Are students or employees of Rensselaer regardless of payroll classification (e.g., faculty, student, administrative, staff, etc.); or
- (b) Make Significant Use of Rensselaer Support; or
- (c) Receive support through Rensselaer from externally or internally sponsored projects; or
- (d) Otherwise may be in a position to make, conceive, develop or reduce to practice inventions or otherwise develop Intellectual Property under externally or internally sponsored and/or gift-supported Rensselaer

projects, whether or not salary or other support is received from such projects. This requirement specifically extends not only to Rensselaer employees and students, but also to visiting scientists, fellows, and project participants or others who may participate in research programs or sponsored projects at Rensselaer.

5.2 Policy Implementation

- (a) This Policy, as currently set forth, and as it may change from time to time, constitutes an understanding that is binding on Rensselaer, creators, and Rensselaer faculty, staff, and students. It is also binding on any participants in Rensselaer projects or programs as a condition of their participating in Rensselaer projects or research programs or their Significant Use of Rensselaer Support.
- (b) Rensselaer may, at its sole discretion, require a formal written Intellectual Property agreement or other relevant documents to facilitate implementation of the Policy as appropriate. The absence of such executed agreements shall not invalidate the applicability or enforceability of this Policy as it currently exists and as it may from time to time be amended. This Policy shall take effect immediately upon adoption by the President of Rensselaer. Amendments will become effective in a similar manner.
- (c) Due to their central role in the creation of Intellectual Property, principal investigators are responsible for ensuring that faculty, students, staff, visitors, and any other project participants, who may be, or who are involved with sponsored projects administered by Rensselaer, comply with this Intellectual Property Policy and sign the appropriate documents. Failure to execute any such agreement, acknowledgement or other related document shall not release any party from any obligation to conform to or be bound by any of Rensselaer's policies, including this Intellectual Property Policy. Rensselaer will provide assistance to principal investigators with this process. The Office of the President or its designee is the final arbiter at Rensselaer of any disputed issues or questions of interpretation relating to this Policy.
- (d) With respect to Intellectual Property developed during the course of employment at Rensselaer, this Policy shall continue to bind any person whose relationship with Rensselaer becomes terminated.

APPENDIX A

Intellectual Property

All products of the mind, including technical innovations, Improvements, discoveries and Inventions whether patentable or not; works of copyright and writings and other information and/or knowledge in various forms, including computer software, and other forms of technology; Tangible Research Property; trademarks and service marks; and Mask Works.

Exempted Scholarly Works

Copyrightable works that are academic, artistic, scholarly, or pedagogical in nature and constitute the author's original expression of scholarly ideas and/or beliefs. Such works result from independent academic effort, reflect the author's research and/or creativity, and evidence professional advancement or accomplishment within Rensselaer. The scholarly work exemption is an exception to the work made for hire rule that otherwise applies to copyrightable work wherein Intellectual Property rights generated by employees within the scope of employment normally belong to the employer (Rensselaer). In the typical work made for hire situation, employees prepare works under the control and direction of the employer. In the case of works of independent academic effort, however, the designated academic appointee or faculty employee, rather than the institution, determines the subject matter, intellectual approach, direction, and conclusions; and there is a presumption of ownership by the author. Such works may include, but are not limited to, textbooks, course materials, knowledge-like works, scholarly publications, journal articles, research bulletins, monographs, books, plays, poems and works of art. Exempted Scholarly Works shall also include copyrightable works of academic degree effort (e.g., theses and dissertations). Such works reflect the research and/or creativity of the student author who is the presumed owner. However, Exempted Scholarly Works shall not include courseware, device-like works or institutional works and Rensselaer employees who fulfill the support staff role in the development of Exempted Scholarly Works shall be considered to be performing a work made for hire.

Knowledge-like Works

Are defined as copyrightable software, digital and/or electronic works that are intended primarily, and are reasonably likely, to provide information to the user. Such works are akin to a textbook or electronic book and are deemed exempted scholarly works.

Device-like Works

Are defined as copyrightable software, digital and/or electronic works, that are intended primarily, and are reasonably likely, to accomplish a task or to produce, manage, analyze, or manipulate a product, such as data, text, a physical object, or more software. Such a work acts as a tool or building block in the accomplishment of such a task or in the creation or management of such a product or result.

Tangible Research Property (TRP)

Those research results that are in a tangible form, as distinct from intangible property. Examples of Tangible Research Property may include, but are not limited to, integrated circuit chips, computer software, biological materials, engineering prototypes, engineering drawings, and other property, which can be physically distributed. Tangible Research Property may often have associated intangible property rights.

Significant Use of Rensselaer Support

A. DEFINITION

Any use of Rensselaer personnel or facilities that is not exempted by this Policy, including, but not limited to: space, funds, equipment, facilities or services, employee on-the-job time, laboratories, computers, software, paid student time, (e.g. research assistants, teaching assistants, fellows, students who provide services under sponsor agreements that require Rensselaer ownership), attending, participating in or benefiting from a Rensselaer Course, the supervision of a faculty or staff member, confidential information or Rensselaer-owned Intellectual Property (such as TRP), Rensselaer organized software development projects or recordings of presentations of Course Materials.

B. EXCEPTIONS

- (i) Rensselaer does not construe the provision or incidental use of office, residence hall, and incubator or library facilities as constituting Significant Use of Rensselaer Support.
- (ii) Rensselaer supplied internet access, data storage, and office computers are not construed by Rensselaer as Significant Use of Rensselaer Support.

C. EXEMPTIONS

- (i) In accord with academic tradition, Rensselaer does not claim copyright ownership of pedagogical, scholarly, or artistic works such as Course Materials or textbooks that may express the author's scholarly ideas and beliefs derived from independent academic effort.
- (ii) Rensselaer treats such works as Exempted Scholarly Works that are owned by their authors, unless the work is not an independent academic work but rather an assigned work; commissioned work, work made for hire; a work subject to contractual restrictions; or an institutional work that was developed using Significant Use of Rensselaer Support paid specifically to support the development of the work itself. In the case where the development of a work that is normally considered an exempted work, is pursuant to an agreement with an outside sponsor, the authors can request the rights to the resulting scholarly work.
- (iii) As a condition of such treatment as an Exempted Scholarly Work, Rensselaer retains rights of internal use and distribution for works that an author develops either in the course of normal duties or with Significant Use of Rensselaer Support. In such cases, the author is deemed to have granted to Rensselaer a free, irrevocable, and permanent world-wide non-exclusive, royalty-free license to use, reproduce, adapt, exhibit, display, distribute, and use in compilations all such Exempted Scholarly Works for internal use and distribution, and all derivatives

thereof, for educational, research and/or academic purposes, including Course offerings via distance delivery.