

INTELLECTUAL PROPERTY POLICY

Purpose

The purpose of the Earlham College intellectual property policy is to clarify issues related to the ownership, use, and sale of intellectual property created by college personnel, i.e. students, faculty and/or staff.

Earlham College fosters an intellectual environment that encourages creativity and innovation. This policy wishes to continue to promote this intellectual environment while managing Colleges resources for the benefit for all constituents and stakeholders. Through this policy, the College seeks to promote these goals and recognize applicable state and federal laws.

Definitions

Intellectual property (IP) refers to any copyrightable or patentable work and covers all types of intellectual property such as inventions, discoveries, trade secrets, service marks, writings, art works, musical compositions and performances, software, literary works, architecture, and other types not listed here, regardless of whether they may be protected by patent, copyright, trademark, trade secret or other law.

Copyrightable work includes original works of authorship fixed in a tangible format including syllabi and other course materials, books and other literary work, articles, dramatic works, musical compositions, sound recordings, choreographic works, visual artworks, photographs, motion pictures, multimedia products, software, websites, or other material that qualifies for protection under United States copyright law.

Incidental IP is any intellectual property conceived or developed with incidental use of college resources.

Patentable work is any new and useful discovery, process, machine, device, manufactured product, composition of matter, or other invention that qualifies for protection under United States patent law.

Scholarly and artistic works are works of research and/or creativity that within the College are considered as evidence of professional advancement or accomplishment. Examples include publications, dramatic works, musical compositions, sound recordings, choreographic works, visual artworks, photographs, motion pictures, multimedia products, software, and products of science.

Works for hire refer to works prepared by an employee within the scope of employment. (Note that the law recognizes that the copyright for works for hire rest with the institution. Materials created by faculty for their courses and for scholarly publications, however, have been considered an exception since the Institution provides very little control and direction for their development.)

The phrase *college resources* refers to college funds, facilities, equipment and personnel.

Substantial use of college resources indicates extensive use of resources beyond what is ordinarily made available to employees. For example, this might be a reduction in teaching load for faculty, use of College facilities for personal projects, access to the time and expertise of college personnel, and/or other usage of the human, financial, material, and technological resources of the College.

Supported IP is any intellectual property conceived or developed with substantial use of college resources.

Ownership of Intellectual Property

Intellectual property of a scholarly or artistic nature shall be the sole and exclusive property of the creator unless a specific contract with alternative provisions has been negotiated prior to the creation of the property. The latter may be desirable when the production of intellectual property involves “substantial use” of college resources. In this case, the Academic Dean, on behalf of the Institution, is responsible for negotiation with the creator.

In cases where employees (with or without the participation of students) create intellectual property for an agency outside of the institution and make “substantial use” of college resources, prior negotiation to determine whether Earlham owns a share of the IP will be carried out by the Academic Dean on behalf of the College. In general the agency will control the distribution of the intellectual property, while copyright ownership will remain with the creators. In situations where an external agreement with a third party such as a funding sponsor includes obligations regarding intellectual property, a decision will be reached consistent with the prior agreements.

In the case where Earlham College commissions a piece of work with a person within or outside of the college, ownership is determined by a written contract prepared prior to the start of the project.

Policy with respect to pedagogical materials seeks to balance the needs of all faculty members and the College as an institution. Materials created for pedagogical purposes, such as syllabi and tests, are considered to be owned by the person who authored them. However, the Institution and its personnel are permitted to use or modify such materials for internal educational and administrative purposes, including reporting to accreditation agencies. Excluded from the understanding in this paragraph are works published by an established publishing house and sold to students through a vendor. In addition, in selected cases (for example, cases that involve substantial use of college resources) Earlham may negotiate a different understanding than is identified here; such an understanding must be negotiated prior to the creation of the property and should be initiated by the College.

Works for hire that would not customarily be considered of an artistic, software or scholarly nature, nor created for pedagogical purposes, shall be considered jointly owned by the creator and the College.

Intellectual property created by a college employee outside of work time, outside of the scope of the employee's job responsibilities, and without the use of college resources is the sole property of the creator even though the work may be similar to that produced as part of the employee's institutional responsibilities.

With respect to students, intellectual property created by students is considered the property of the student. The College, however, reserves the right to use such material, with appropriate discretion and student consent and attribution, in promotion of the College. Intellectual property created by student(s) and employee(s) jointly is considered to be jointly owned by the creators. The employee(s) and the student(s) shall have decision-making powers in regard to permissions and sales of jointly created property.

Procedure

The creator should notify the Academic Dean of creation of marketable intellectual property created with use of college resources through the *Early Disclosure Statement* found in Appendix A. Further, such notification should be provided when the creator is embarking on work with external sponsors so agreements regarding ownership and public disclosure can be negotiated in advance.

Upon review of the disclosure document, the Academic Dean will determine whether the intellectual property is a Supported IP or an Incidental IP and, in the case of a Supported IP, shall further determine, with assistance from patent counsel, who are the legal Inventor(s), consistent with United States patent law.

In instances when the creator and Institution share ownership of intellectual property rights, what expenses the College will cover to develop the property will be determined in negotiation with the Academic Dean, and counsel as pertinent. In situations in which it is deemed the College holds no ownership of the intellectual property, the creator is free to pursue development of their intellectual property at their own discretion.

Fund Distribution for College-owned Intellectual Property

When the Academic Dean determines that the College owns a share of the intellectual property, all initial revenue (100%) from the sales or the rights of the intellectual property will go to the College to cover expenditures associated with the development, patent filing, copyright registration, and any other continuing costs associated with licensing and other commercialization of the intellectual property in order to recover all expenses in full and support future innovation. After initial College expenditures have been recovered, shared net revenues will be distributed as follows:

Any invention created using substantial college resources and time, or for the work of the college.	75% net revenue to the College 15% goes to the creator's department 10% goes to the creator(s) to be shared equally in the case of more than one inventor unless otherwise negotiated.
Invention created using some college resources and time, but not directly, created for the college.	20% net revenue goes to the institution. 80% net revenue goes to the creator(s) to be shared equally in the case of more than one inventor unless otherwise negotiated.

Confidential Disclosure Agreements

Maintaining confidentiality of intellectual property can be key during the development stages. When involving non-Earlham vendors or non-creators in the commercialization, marketing, and/or evaluation period, intellectual property may be safely disclosed outside the Institution under the protection of a Confidential Disclosure Agreement or CDA. This is because disclosures made under an appropriate CDA are not considered public disclosures, unless the recipient of the information breaches the CDA. When an employee wishes to disclose an invention to an external researcher associated with a company or other for-profit organization, or directly to the company or organization itself, they should have a confidentiality agreement signed that states the obligation of the recipient not to use the intellectual property for any other purposes than to evaluate it. Refer to Appendix B for the Earlham College Confidential Disclosure Agreement.

Responsible party. Responsibility for this policy lies with the Academic Dean.

Policy review. This policy is to be reviewed every three years. Review will be initiated by the Office of Sponsored Programs and Foundation Relations.

Distribution. This policy is posted to the Earlham College website on the Grants and Sponsored Research page which is accessible via the Academic Dean's Faculty Resources page.

Questions or disputes regarding the interpretation of this policy shall be mediated by a mutually agreed upon third party.

Adopted and approved by the Academic Affairs committee of the Earlham College Board of Trustees, with support of the faculty on June 2, 2018.

APPENDIX A

**EARLHAM COLLEGE
INTELLECTUAL PROPERTY (IP) EARLY DISCLOSURE STATEMENT**

Title of IP: _____

Name(s) of Creator(s): _____

Description of IP: _____

Sponsorship (if any): _____

Design Date and Date put into practice: _____

Publication Dates (existing or projected, if any): _____

Please submit form to Academic Dean's Office

Supported IP - Refer to patent counsel

Incidental IP only

Academic Dean's Signature

Date

APPENDIX B

EARLHAM COLLEGE CONFIDENTIAL DISCLOSURE AGREEMENT

This Confidentiality Agreement (“Agreement”) is made and effective the _____ DAY OF _____, 20__ by and between Earlham College (“Owner/Institution”) or their agent and _____ for _____ (“Recipient”).
Company or Organization

1. **Confidential Information.** Owner proposes to disclose certain of its confidential and proprietary information (the “Confidential Information”) to Recipient. Confidential Information should include all data, materials, products, technology, computer programs, specifications, manuals, business plans, software, marketing plans, financial information, and other information disclosed or submitted, orally in writing, or by any other media, to Recipient by Owner. Confidential Information disclosed orally shall be identified as such within ten (10) days of disclosure. Nothing herein shall require Owner to disclose any of its information.
2. **Recipient’s Obligations.**
 - A. Recipient agrees that the Confidential Information is to be considered confidential and proprietary to Owner and Recipient shall hold the same confidence, shall not use the Confidential Information other than for the purposes of its business with Owner, and shall disclose it only to its officers, directors, or employees with specific need to know. Recipient will not disclose, publish or otherwise reveal any of the Confidential Information received from Owner to any other party whatsoever except with the specific prior written authorization of Owner.
 - B. Confidential Information furnished in tangible form shall not be duplicated by Recipient except for purposes of this Agreement. Upon the request of Owner, Recipient shall return all Confidential Information received in written or tangible form, including copies, or reproductions or other media containing such Confidential Information, within ten (10) days of such request.
 - C. Signer of this document affirms that he/she has full authority to undertake this agreement for his/her company that is represented herein.
3. **Term.** This Agreement will cover all disclosures of Confidential Information made by Owner to Recipient during the period that ends one year after the Effective Date of this Agreement. Recipient’s obligations under this agreement with respect to Confidential Information disclosed to Recipient will continue in effect until three years after the Effective Date.
4. **Other Information.** **Recipient shall have no obligation under this Agreement to Confidential Information which:**
 - A. Is or becomes publicly available without breach of the Agreement by Recipient;

- B. Is rightfully received by Recipient without obligations of confidentiality; or
- C. Is developed by Recipient (or its agents, contractors, and employees) without breach of this Agreement.

These exceptions provide, however, that such Confidential Information shall not be disclosed until thirty (30) days after written notice of intent to disclose is given to Owner along with the asserted grounds for disclosure.

5. General Conditions:

- A. No License. Nothing contained herein shall be construed as granting or conferring any rights by license or otherwise in any Confidential Information.
- B. No Publicity. Recipient agrees not to disclose its participation in this undertaking, the existence of terms and conditions of the Agreement, or the fact that discussions are being held with Owner without the express consent from Owner.
- C. Governing Law and Equitable Relief. This Agreement shall be governed and construed in accordance with the laws of the United States and the State of Indiana.
- D. No assignment. Recipient may not assign this Agreement or any interest herein without Owner’s express prior written consent.
- E. Severability. If any term of this agreement is held by a court of competent jurisdiction to be invalid or unenforceable then this Agreement, including all of the remaining terms, will remain in full force and effect as if such invalid or unenforceable term had never been included.
- F. Headings. Headings used in this Agreement are provided for convenience only and shall not be used to construe meaning or intent.

IN WITNESS WHEREOF, the parties have executed this Agreement as of the date first and above written.

Dated this _____ day of _____, 20__ by

Name and Title

Company or Organization Represented

Witnessed by:

Name (Acting for Earlham College as recipient of this Confidential Nondisclosure Agreement)