

Southern University Law Center Intellectual Property Policy

I. Policy Statement

The Southern University Law Center's Intellectual Property Policy governs inventions, copyrights, trademarks, and other intellectual property developed by Southern University Law Center's employees and students.

II. Preamble

The Southern University Law Center's policy governing the ownership and disposition of intellectual property, which includes, but is not limited to, inventions, copyrights, trademarks, service marks, computer software, and tangible research property, is based on the following principles.

First, the policy is designed to encourage the viewpoint that ideas or creative works produced by the Southern University Law Center should be used in ways that are meaningful to the public interest. This may be accomplished through widespread dissemination. Thus, dissemination and use of ideas and creativity should be encouraged throughout the Southern University Law Center community. In other circumstances, the public may benefit from a stronger application of legal protection to the innovations and creative works of inventors and authors so that they may be developed into useful products. Although this policy recognizes that public benefit should be placed before financial gain, it is appropriate and often desirable for the Southern University Law Center and inventors and authors to benefit financially from the use of a particular invention or creative work. In deciding how to proceed in regards to a particular invention or creative work covered by this policy, the Southern University Law Center will consider the benefits and consequences to the public and the institution, as well as for individual inventors and authors.

Second, the policy is designed to protect the traditional rights of scholars with respect to the products of their intellectual endeavors. For instance, the policy should not interfere with the rights of a scholar to publish a book or an article. Where the Southern University Law Center takes ownership or control over scholarly works, it will consult with authors on their plans for publication.

Third, where financial or other support in terms of facilities, equipment or staff for development of intellectual property has been provided or administered by or through the Southern University Law Center, this institution may have outside contractual commitments which must be recognized or may have made financial investments for which reimbursement through commercial application is appropriate.

The Southern University Law Center also has a compelling interest in ensuring that its name, trademarks, service marks, or logos are properly used, especially when such use may imply an association with the institution. Such use must be accurate and appropriate, and must ensure that the Southern University Law Center receives a fair share of any commercial fruits from the use of its name.

The following policy is applicable to all full and part-time faculty, staff, employees, students, and non-employees who use Southern University Law Center funds, facilities or other resources, or participate in SULC-administered research, including visiting faculty, industrial personnel, and fellows, regardless of their obligations to other companies or institutions.

From time to time, Southern University Law Center may determine that it to be in its best interest to enter into agreements with third parties that are exceptions to the policies reflected in this document and the persons covered by this policy.

III. Objectives

The Southern University System's Intellectual Property Policy provides the following objectives for its five (5) campuses as they develop and implement their intellectual property policies in compliance with applicable state and federal guidelines:

- A. To encourage research and scholarship as creative academic endeavors while recognizing that commercially valuable intellectual property may result from such endeavors;
- B. To delineate procedures that encourage creators to report discoveries with broad commercial potential and public benefit, and to assist creators, while at the same time safeguarding the interests of all concerned parties;
- C. To make intellectual property developed in the course of academic research available to the public under conditions that will promote its effective and timely use and development;
- D. To optimize the environment and incentives for research and scholarly activity and for the creation of new knowledge throughout the Southern University System; and
- E. To ensure that the educational mission of the Southern University System and its five (5) campuses is reinforced.

Southern University Law Center adheres to these objectives in establishing the policy herein.

IV. Definitions

The following definitions apply throughout the Southern University System's Intellectual Property Policy and are adopted by Southern University Law Center in establishing the policy herein:

- A. Computer Software—means one or more computer programs existing in any form or any associated operational procedures, manuals, or other documentation, whether protectable or protected by patent or copyright.
- B. Confidentiality Agreement—means an agreement that outlines the terms under which

proprietary information will be exchanged between two parties.

C. Conflict of Interest—means an instance where two or more goals or ends might not be advanced simultaneously, placing them in potential competition with each other.

D. Contract—means a legally binding mutual agreement between two or more parties in which an exchange of value (“consideration”) occurs, and which obligates each party to certain duties covering this exchange. Those signing such an agreement must be authorized to bind the entity that they represent.

E. Copyright—means the intangible property right granted by federal statute for an original work fixed in a tangible form of expression. Copyright provides the owner with the following exclusive rights in a work: to reproduce, to prepare derivative works, to distribute by sale or otherwise, to perform publicly, and to display publicly.

F. Copyrightable Works—include, but are not limited to books, periodicals, lectures, dramatic compositions, musical compositions, maps, works of art, drawings or plastic works of a scientific or technical character, computer programs, programmed instructional material, photographs, pictorial illustrations, motion pictures, and audiovisual works, and sound recordings. Copyright protection does not extend to an idea, process, concept or discovery, but only to the work in which it may be embodied, illustrated or explained.

G. Creator—means an individual or group of individuals who make, conceive, reduce to practice, author, or otherwise make a substantive intellectual contribution to the creation of intellectual property. The term “Creator” may denote Employees as defined in this policy or students. The term "Creator" shall include the definition of "inventor" as used in the U.S. Patent Act and the definition of "author" as used in the U.S. Copyright Act.

H. Direct Expenses—means costs associated with the protection and licensing of Intellectual Property.

I. Employee—includes, but is not limited to, faculty as defined in this policy, full-time and part-time classified and unclassified staff, student employees, appointed personnel, student assistants, and persons with "no salary" appointments. The term “Employee” shall also include visiting faculty, persons on leave, and academic professionals, such as fellows, who develop Intellectual Property using SULC resources and facilities unless there is an agreement providing otherwise. Persons who are not otherwise SULC employees and who come to the institution as guest lecturers, or to teach colloquia or short courses may not be considered employees for purposes of this policy to the extent of their teaching and classroom activities.

J. Faculty—means all employees who meet the definition of "faculty members" contained in the most recent version of the faculty handbook issued by the SULC. The term shall also include instructors and special faculty appointments, such as joint faculty members and part-time faculty.

K. Five (5) Campuses—means the campuses of Southern University System (“SUS”), which includes Southern University and A & M College at Baton Rouge (“SUBR”);

Southern University at New Orleans (“SUNO”); Southern University at Shreveport, Louisiana (“SUSLA”); Southern University Law Center (“SULC”); and the Southern University Agricultural Research and Extension Center (“SUAREC”).

L. Gross Income—means funds obtained from the commercialization of technology under a License Agreement. Gross Income may include license fees, milestone payments, minimum annual royalties, earned or running royalties, equity, equipment, or reimbursement of patent expenses and fees. It does not include research support in a mixed purpose Research Contract/License Agreement.

M. Institutional Resources—means support as office space, library facilities, ordinary access to computers and networks. The phrase does not include use of students or employees as support staff to develop the work, or substantial use of specialized or unique facilities and equipment, or other special subventions provided by the institution unless approved as an exception.

N. Institutional Work—means any copyrightable work made by SULC employees in the course and scope of their employment. Except as otherwise provided in this policy, SULC shall own all copyrights to institutional works.

O. Intellectual Property—means inventions, discoveries, know-how, show-how, processes, unique materials, copyrightable works, original data, and other creative or artistic works which have value. Intellectual property includes that which is protected by statute or legislation, such as patents, copyrights, trademarks, service marks, trade secrets, mask works, and plant variety protection certificates. It also includes the physical embodiments of intellectual effort, for example, models, machines, devices, designs, apparatus, instrumentation, circuits, computer programs and visualizations, biological materials, chemicals, other compositions of matter, plants, and records of research.

P. Invention—means any new or useful process or discovery, art, method, technique, machine, device manufacture, software, composition of matter or improvement thereof.

Q. Inventor—means any employee or individual associated with the SULC who is the originator(s) of Intellectual Property.

R. License—means a contract which awards to a party other than the owners of the Intellectual Property the right to make, use, sell or import products or services based on the owner's Intellectual Property. Licenses may be awarded on an exclusive or non-exclusive basis and may provide for payment of license fees, milestone fees, royalties, equity, or other income to the owners) of the Intellectual Property.

S. Mask Work—means a series of related images, however fixed or encoded, having or representing the predetermined, three dimensional pattern of metallic, insulating, or semiconductor material presented or removed from layers of a semiconductor chip product; and in which series the relation of the images to each other has the pattern of the surface of one form of the semiconductor chip product.

T. Originator—means one who produces a work by his or her own intellectual labor. When there is more than one originator, the ownership of each originator's contribution

shall be considered separately pursuant to this policy.

U. Patent—means a legal grant provided by the laws of the United States giving an inventor for a term of years the right to exclude all others from making, using, or selling his or her invention within the United States, its territories and possessions. A patent may be granted to the inventor or discoverer of any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, or any distinct and new variety of plant, (other than a tuber propagate plant) or any new, original, and ornamental design for an article of manufacture.

V. Royalties—means compensation of whatever kind received from the sale, license, or other transfer of Intellectual Property right by the SULC to a third party. This includes, but is not limited to, percentage payments, up-front fees, milestone fees, shares of stock, and any other financial or in-kind consideration.

W. Sponsor—means an organization or agency that provides funding, equipment, or other support to the SULC to carry out a specified project in research, training or public service pursuant to a written agreement. Sponsors include federal, state, local and other government entities as well as private industry, educational institutions, and private foundations.

X. Sponsored Research Agreement—means a contract, grant, cooperative agreement, or other funded research instruments between the SULC and a sponsoring organization that sets the terms and conditions for the conduct of a faculty or student research or training project. A Sponsored Research Agreement typically includes a description of the work to be performed, the terms of payment, ownership of Intellectual Property, publication rights, and other legal assurances.

Y. Trademark—means 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.

Z. University Resources—means all tangible resources, including facilities, provided by the SULC to authors, creators, and inventors, including, but not limited to, office laboratory, studio space and equipment, computer hardware, software, and support, secretarial service, research, teaching, and laboratory, assistants, supplies, utilities, funding for research and teaching activities, travel, and other funding or reimbursement. University Resources do not include salary, insurance, or retirement plan contributions paid to, or for the benefit of the author, creator or inventor.

V. Ownership Rights in Intellectual Property

A. Copyrights: Except as provided below, copyrightable works authored by a member of the SULC faculty shall be presumed to be owned by the faculty member. Faculty members may register, license, or sell such works without permission or payment to the SULC.

Copyrightable works authored by non-faculty employees, however, shall be presumed to

be "works for hire" as described below.

1. SULC Assertion of Ownership Rights to Copyrightable Works

a. Works created pursuant to agreements with governmental or private entities shall be governed according to such agreements. Where the agreement does not specify the disposition of the work, or refers to disposition pursuant to SULC policy, such work shall be considered subject to a claim of ownership by the SULC.

b. "Works for hire" shall be considered the property of the SULC. Works for hire are defined in the Copyright Act of 1976, as amended, and generally arise in the following situations:

i. The author is a non-faculty employee of the SULC and the creation of the copyrightable work is within the scope of the author's employment; or

ii. The author is a faculty employee of the SULC and the copyrightable work was prepared in an administrative capacity, including, but not limited to, faculty committee work product, tests, and test answers.

iii. The SULC specifically orders or commissions a work from an SULC employee, whether faculty or non-faculty. Agreements for such works shall be in writing and executed prior to the employee's preparation of the work.

c. Works created using substantial SULC resources as determined by the Intellectual Property Committee shall be considered the property of the SULC. The use of SULC libraries, classrooms, office space, word processing equipment or other minor computer uses may not, by themselves, be considered use of substantial SULC resources.

2. Student Works

a. Ownership of copyrights to works produced by enrolled students that are produced outside any SULC employment and are not sponsored or commissioned works, shall reside with the student creators. In all cases students' final papers, graduate theses, or dissertations shall be deemed a student work under this policy, but as a condition of enrollment and awarding a degree, the SULC reserves an irrevocable, non-exclusive, free-of-cost and world-wide right to reproduce in any media and distribute to the public, on a non-commercial basis, copies of said final papers, theses and dissertations, unless to do so would impair the ability of the student creator to commercially or professionally exploit the work.

b. If a use of the work by the SULC is reasonably determined by the student creator to impair the exercise of such rights, the SULC shall, upon written notice, discontinue the impeding use but otherwise shall remain free to use the work as described in this section.

3. Software

a. Software is a form of Intellectual Property covered by this policy. It differs considerably from inventions due to the fact that software may be copyrighted. Some software can also be the subject of a patent. This option may provide broader protection for the Intellectual Property, but at a greater expense.

B. Patents: In general, patentable works created by SULC employees while employed by this institution shall be presumed to be subject to a claim of ownership by the SULC. Patentable works shall be subject to ownership claims by the SULC where the creation of the work involves the use of substantial SULC resources, as determined by the Intellectual Property Committee. The use of SULC libraries, classrooms, office space, word processing equipment or other minor computer uses may not, by themselves, be considered use of substantial SULC resources.

1. Sponsored Efforts

a. Sponsored project agreements often contain specific provisions with respect to ownership of Intellectual Property developed during the course of such work, in which case the terms of the sponsored project agreement shall establish ownership.

b. The SULC may enter into a contract or contracts with an external sponsor covering specific inventions or discoveries believed to be patentable and patents developed therefrom or covering all such inventions/discoveries in which the SULC has an interest.

C. Trademarks and Service Marks: In general, trademarks and service marks relating to SULC, its departments, or its units shall be considered the property of SULC.

Trademarks and service marks not relating to SULC, its departments, or its units that are created by a faculty member shall be presumed to be owned by the faculty member. Except as provided below, faculty members may register, license, or sell such marks without permission or payment to the SULC.

Trademarks and Service marks created by non-faculty employees, however, shall be presumed to be "works for hire".

1. SULC Assertion of Ownership Rights to Trademarks and Service Marks

a. Works created pursuant to agreements with governmental or private entities shall be governed according to such agreements. Where the agreement does not specify the disposition of the works, or refers the disposition to SULC policy, such works shall be considered the property of the SULC.

b. "Works for hire" shall be considered the property of the SULC. Works for hire generally arise in the following situations:

i. The creator of the trade or service mark is a non-faculty employee and the creation of the work is within the scope of the creator's employment; or

ii. The SULC specifically orders or commissions a work from an SULC

employee, whether faculty or non-faculty. Agreements for such works shall be in writing and executed prior to the employee's preparation of the work.

c. Works created using substantial SULC resources as determined by the Intellectual Property Committee shall be considered the property of the SULC. The use of SULC libraries, classrooms, office space, word processing equipment or other minor computer uses may not, by themselves, be considered use of substantial SULC resources.

VI. Other Intellectual Property

A. The SULC owns all other Intellectual Property arising from SULC research, including but not limited to know-how, unless the know-how is related to Intellectual Property otherwise not owned by the SULC.

B. Other Intellectual Property may exist in the form of material that is not patentable, but which by its nature can be protected. An example of this would be anything produced from a biological material harvested from a unique continually growing culture. Such Intellectual Property may be protected and licensing agreements with parties interested in its commercial production may generate revenue. Such Intellectual Property shall be treated by its creator and the SULC in the manner described in Section V ("Ownership Rights in Intellectual Property") of this policy.

VII. Individual Efforts

Ownership of Intellectual Property created or developed by employees or students of the SULC outside of the scope of their employment shall reside with the creator of such Intellectual Property provided that:

A. SULC resources used to create or develop the Intellectual Property were limited to resources such as SULC libraries, classrooms, office space, supplies, word processing equipment or other minor computer uses.

B. The Intellectual Property was not created or developed using substantial SULC resources, or using SULC resources not commonly available to employees or students of equal rank or status.

C. The Intellectual Property was not created or developed in accordance with the terms of a sponsored project agreement; and

D. The Intellectual Property was not created or developed in accordance with a special order or commission by SULC.

It shall be the responsibility of the creator of the Intellectual Property to demonstrate that this ownership classification is applicable.

VIII. Consulting

A. An employee who anticipates engaging in off-campus consulting shall inform the Chancellor in writing prior to commencing the consulting activity. The employee must communicate the nature and scope of such activity in the writing. Such activities may include, but are not limited to, independent off-campus research or consultation and other related activities in which a third party may claim an ownership interest in the resulting work or work product.

B. Employees of the SULC who engage in consulting agreements or who are otherwise employed by an external company shall ensure that the company executes or has executed a license agreement with the SULC regarding development of Intellectual Property in which SULC may claim ownership. The consulting or other agreement shall be submitted to the Chancellor and the SUS President.

C. The SULC does not ordinarily assert ownership to Intellectual Property produced by employees engaged in consulting agreements who produce said Intellectual Property in the scope of their consulting activity. In cases where SULC resources are used to support the consulting activity, the consultant shall negotiate an agreement with the Chancellor to determine disposition of the Intellectual Property produced.

IX. Jointly Originated Works

Collaboration between SULC employees or students and persons not employed or associated with the SULC, including researchers at other universities or companies may result in the development of Intellectual Property jointly owned by the SULC and other persons or their employers. Protection and commercialization of such joint Intellectual Property can be difficult without extensive cooperation and agreement among the owners. SULC employees who are engaged in or who anticipate engaging in collaborative activities that may result in the development of Intellectual Property shall advise the Chancellor of such activities. Ownership of jointly originated works shall be determined by separately assessing the work of each creator as provided for in this policy and relevant law.

X. Distribution of Income from Intellectual Property

A. In the event that royalties are generated by Intellectual Property rights assigned or licensed to the SULC, an appropriate share of such royalties shall be paid to the creator. The SULC may recover its costs before commencing payment of such royalties.

The creator's share shall be determined by the following:

1. In cases where the SULC or creator, as the case may be, assigns such Intellectual Property rights to a research corporation under contract to the SULC or to the SUS, the share of royalties to be paid to the creator shall be governed by the terms of the contract between the SULC or SUS and the research corporation.
2. In cases where the Intellectual Property is covered by a contractual agreement with

a sponsoring agency, the financial arrangements shall be in accordance with the contractual agreement as negotiated between the institution and the contracting agency.

3. In cases of sponsorship by federal agencies, compliance with the appropriate federal regulations shall be effected in the ultimate agreement.

4. In cases where the SULC retains ownership of an Intellectual Property from a creator or creators, and/or expends funds to develop and market the Intellectual Property, any royalties generated will be used first to cover the expenses of filing, procuring, maintaining, and marketing the Intellectual Property. Forty percent (40%) of the net royalties will be paid to the creator, and sixty percent (60%) will be retained by the SULC.

5. Net royalties retained by the SULC shall be used for research, development, and other scholarly activities.

6. In cases where the SULC chooses not to retain ownership of the Intellectual property, the creator may not use the SULC's name, logos, trademarks, or service marks in association with or promotion of the Intellectual Property without written permission from the SULC's Chancellor.

7. The SUS Board of Supervisors may approve exceptions to this royalty policy in extraordinary circumstances.

XI. Management of Intellectual Property

A. Acknowledgement of Institutional Impact and Authority

In conformity with SUS policy, the SULC recognizes that the evaluation of Intellectual Property claims and that the administration, development, and processing of Intellectual Property involve substantial time and expense and require special talents and experience. Therefore the SULC shall establish a committee which has responsibility for administering SULC policies regarding Intellectual Property as defined in this policy. The Intellectual Property Committee shall encourage research and scholarly activity, review and recommend to the Chancellor changes in policies, resolve questions of Intellectual Property ownership, and develop procedures to encourage disclosures and to ensure prompt and effective handling, evaluation, and prosecution of Intellectual Property opportunities and to protect the interests of the SULC, its employees, its students, and the public.

1. Intellectual Property Committee—Composition and Duties

a. SULC shall establish a standing Intellectual Property Committee ("IPC"). No fewer than one-third (1/3) of the members of the IPC shall be appointed by the SULC faculty.

b. The IPC shall be charged by the Chancellor to address any issues concerning

the proper interpretation of this policy and to resolve disputes between creators and the SULC concerning ownership of works and what constitutes substantial use of SULC resources. SULC employees and students may obtain advice from the IPC. Disputes regarding Intellectual Property shall be resolved through the process described in Section XII (“Dispute Resolution”) of this policy.

c. In order to ensure continuity of the activities of the IPC, members may be appointed for varying terms of service, provided that any member may be reappointed upon the expiration of his or her term of service. Vacancies occurring on the committee, whether by reason of expiration of a term of service, resignation, death, retirement, or otherwise shall be filled by appointments made by the Chancellor and SULC faculty.

B. Disclosure of Intellectual Property

All employees of the SULC who, during their associations with the SULC, who create or develop Intellectual Property whether or not on SULC time or using SULC facilities, shall cooperate with the institution in defining the rights to such properties by promptly reporting to the Intellectual Property Committee (“IPC”). This disclosure obligation shall apply to all works where there is a reasonable basis for the assertion of SULC ownership. The information included in such disclosure shall be confidential and may not be revealed to others until reviewed by the IPC.

The disclosure should be in the form of a written report and should identify the contract, if any, under which the Intellectual Property was created. If the Intellectual Property at issue is an invention, the disclosure should identify any publication, sale, or public use of the invention and whether a manuscript describing the invention has been submitted for publication and/or accepted for publication at the time of disclosure. In addition, after disclosure, the employee shall promptly notify the IPC of the acceptance of any manuscript describing the invention for publication or of any planned sale or public use.

C. Protection, Development and Exploitation of Intellectual Property

After evaluation of the Intellectual Property and review of applicable contractual commitments, the SULC may develop the property through licensing, may release it to the sponsor of the research under which it was made (if contractually obligated to do so), may release it to the creator if permitted by law, or may take such other actions as are determined to be in the public interest. Exploitation by the SULC may or may not involve statutory protection of the Intellectual Property rights, such as filing for patent protection, registering the copyright or securing plant variety certification.

In respect to Intellectual Property not owned by the SULC, or owned by it but not retained by it, or owned and retained but subsequently abandoned by it, the SULC may assist the individual creator in taking at his or her own expense, the measures necessary for the protection, exploitation and development of the property.

1. Abandonment of Intellectual Property

Should the SULC decide to abandon development or protection of SULC owned

Intellectual Property, ownership may be assigned to the creator as allowed by law subject to the rights of sponsors and to the retention of a license to practice for institutional purposes. The minimum terms for such license shall grant the institution the right to use the Intellectual Property in its internally administered programs of teaching, research, and public service on a perpetual, royalty-free, non-exclusive basis. The SULC may retain more than the minimum license rights, and the assignment or license may be subject to additional terms and conditions, such as revenue sharing with the institution or reimbursement of the costs of statutory protection, when justified by the circumstances of development.

D. Commercialization by Creator

The SULC may, at its discretion and consistent with the public interest, license Intellectual Property to the creator on an exclusive or nonexclusive basis. The creator must demonstrate technical and business capability to commercialize the Intellectual Property. Agreements with creators will be subject to review and approval of conflict-of-interest issues in accordance with applicable policy.

XII. Dispute Resolution

A. General Provisions

1. The Vice Chancellor for Institutional Affairs shall attempt to resolve any claim, dispute, or controversy involving rights to any type of Intellectual Property originating at the SULC. Any dispute that cannot be settled through informal discussion shall be submitted to the Intellectual Property Committee (IPC), which shall investigate the dispute and make a determination as to the rights of the parties.
2. Following a determination by the IPC, a party interested in the assignment of rights may seek a review by submitting a written notification of appeal which shall be forwarded to the SUS Executive Counsel. Counsel shall review the determination of the IPC to establish whether the determination is in contradiction with written policy, or is otherwise flawed or unsubstantiated. If this review finds that the determination of the IPC is in contradiction to written policy, or is otherwise flawed or unsubstantiated, the matter may be referred for a judicial hearing before the Chancellor, the Executive Counsel, the chairperson of the IPC, the aggrieved individual and his/her legal representative, and any other person who can offer "expert testimony" or contribute substantively to the hearing. Subsequent to such judicial hearing, the aggrieved individual and his/her legal representative may further appeal the decision to the SUS Board of Supervisors through the President. The decision of the SUS Board of Supervisors shall be final and binding upon all parties.
3. IPC members or administrators directly involved with the development of the Intellectual Property in question shall withdraw from IPC proceedings at such times as necessary to avoid conflicts of interest.

XIII. Official Acceptance of Intellectual Property Policy

All SULC employees shall adhere to the provisions of this policy. Students and others working on research projects and all other persons associated with the SULC who use University resources shall be required to agree to this policy and its related procedures.