Intellectual Property Policy

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SECTION I. PURPOSE

The University of St. Thomas mission and convictions affirm the commitment of students, faculty and staff to advance the common good and pursue truth in all its forms through intellectual inquiry, the integration of knowledge, and the imaginative and creative exploration of new ideas. Consistent with this commitment, St. Thomas students, faculty and staff regularly develop, use and share creative work, including original works of authorship, inventions, discoveries and distinctive words, names, symbols and designs. St. Thomas resources support the development, use and sharing of this work, and St. Thomas actively seeks sponsorship and support for the work from external sources.

These original "works of the intellect" comprise a form of property that commonly is referred to as intellectual property. Like other property, intellectual property is subject to rights of ownership and use that can be transferred at the owner's discretion.

When resources of a nonprofit organization like St. Thomas are involved in the development, use or disposition of intellectual property, there are legal, equitable and public interest considerations that can affect rights and obligations related to the intellectual property. This policy is intended to clarify the respective rights and obligations of St. Thomas and its students, faculty, staff, volunteers and visitors with respect to the creation, use and disposition of intellectual property in light of these considerations, and to promote the creation, use and transfer of intellectual property consistent with the St. Thomas mission, convictions and obligations as a nonprofit university.

SECTION II. SCOPE AND APPLICABILITY

This policy applies to and governs the use, ownership and disposition of intellectual property by St. Thomas and its students, employees (faculty, staff and student workers), volunteers and visitors, who are collectively referred to in this policy as ***covered persons***.

SECTION III. GUIDING PRINCIPLES

A. St. Thomas encourages members of the St. Thomas community to engage in creative, innovative and entrepreneurial activity that is consistent with the university's mission and advances the common good.

B. St. Thomas recognizes the importance of academic freedom in the creation, use and dissemination of intellectual property by faculty and students.

C. St. Thomas is committed to protecting the traditional rights of faculty with respect to the academic works they create.

D. St. Thomas is committed to compliance with laws protecting the rights of intellectual property owners.

E. This policy should promote and facilitate the allocation of St. Thomas resources in a manner that is aligned with the university's mission and strategic priorities, contributes to its financial health, minimizes legal risks, and is as simple and transparent as practicable.

SECTION IV. DEFINITIONS

When used in this policy, the following terms have the following meanings:

a. ***Academic works*** are copyrighted works created by faculty in connection with teaching and engaging the profession (whether through research, scholarship or otherwise), and that are not institutional works or inventions. Examples of academic works may include, without limitation, course syllabi, class assignments, tests, class notes, class and conference presentations, articles, papers, books and book chapters, case studies, lab notebooks, musical compositions, journalistic works, artistic works, dramatic works and other performances in discipline, and non-patentable computer software.

b. ***Copyright*** is the exclusive, limited-term legal right to reproduce an original work of authorship that qualifies for copyright protection under U.S. law, make derivative works based on it, distribute copies to the public, and perform or display the work publicly. As a matter of law, original works of authorship are protected by copyright from the moment the work is fixed in a tangible medium of expression.

c. ***Copyrighted work*** means an original work of authorship that qualifies for copyright protection under U.S. law. Copyrighted works include, without limitation, literary works, musical works, dramatic works, pantomimes and choreographic works, artistic works (pictorial, graphic or sculptural), motion pictures, and other audiovisual works.

d. ***Fair use*** is the use of copyrighted work for limited and transformative purposes, such as criticism, commentary and parody. Fair use of a copyrighted work is expressly permitted under federal law and does not require permission from the copyright holder. Whether a use of copyrighted work is fair use depends on the particular facts and circumstances. Factors that courts consider when determining whether a use is fair use include the purpose and character of the use, the nature of the copyrighted work, the amount and substantiality of the portion used in relation to the work as a whole, and the effect of the use upon the potential market for or value of the copyrighted work.

e. ***Institutional works*** are intellectual property created by covered persons under any of the following circumstances:
   1. in the scope of a staff member's or student worker's employment with St. Thomas;
   2. in the scope of a volunteer's volunteer service with St. Thomas;
   3. in the scope of a faculty member's service obligations to St. Thomas;
   4. in the course of a sponsored research project;
   5. under or subject to an agreement or other legally binding instrument between St. Thomas and a third party (for example, a grant agreement, research agreement or services agreement);
   6. as part of an institutional collaboration convened by or at the direction of St. Thomas, acting through its administrators, where the primary objectives and benefits of the project are institutional in nature (such as the development of an institutional policy, plan, publication, curriculum or service);

7. pursuant to a written agreement between St. Thomas and the creator that specifically describes, or addresses the allocation of rights with respect to, the work;
8. pursuant to a specific request, order or commission of St. Thomas, acting through its administrators, in advance of the work's creation that identifies the work as an institutional work, or which work the creator(s) otherwise agree is an institutional work; or
9. with the significant use of St. Thomas resources.

f. ***Intellectual property*** means tangible and intangible works of the intellect including copyrighted works, trademarks, inventions, trade secrets and mask works.

g. ***Invention*** means any invention, discovery, know-how and any other work that is patentable or potentially patentable, including (but not limited to) computer software patentable under U.S. law. In addition to patentable software, examples of inventions include, without limitation, new, nonobvious and useful processes, machines, articles of manufacture, compositions of matter and improvements to any of the above.

h. ***Inventor*** means a covered person who, individually or jointly with others, creates an invention and meets the criteria for inventorship under U.S. law.

i. ***Joint inventions*** are inventions in which two or more inventors each has made a contribution to the conception of the invention.

j. ***Joint works*** are copyrighted works created by two or more creators, with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.

k. ***Patent*** means a limited-duration property right to an invention, granted by the U.S. Patent and Trademark Office in exchange for public disclosure of the invention. For the limited duration of the patent, only the patent owner can determine whether and how an invention may be used by those who do not own the patent. Patent excludes others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States.

l. ***Research data*** includes laboratory notebooks and any other records that are necessary for the reconstruction and evaluation of reported results of research and the events and processes leading to those results, regardless of the form or the media on which they may be recorded.

m. ***Significant use of St. Thomas resources*** means the use of resources (physical, financial or human) provided by or through St. Thomas that are above and beyond the level of support and resources routinely provided or available to covered persons in the respective category, discipline and unit.

n. ***Trademark*** means a brand name or other mark of authenticity that is used or intended to be used to identify and distinguish the goods and services of one seller or provider of goods or services from those of others, and to indicate the source of the goods or services. A trademark can include any word, name, symbol or design, alone or in combination.

SECTION IV. RIGHTS AND OBLIGATIONS WITH RESPECT TO INTELLECTUAL PROPERTY GENERALLY

A. Requirement to Comply with Intellectual Property Rights of Others

Covered persons are expected to understand, protect and honor the intellectual property rights of others, consistent with this policy, contractual obligations and applicable law.

B. Intellectual Property Development, Use, Dissemination, Disposition and Protection

Consistent with the St. Thomas mission and nonprofit status, St. Thomas and covered persons must use the university's property and other resources in a manner that best serves the interests of the university and the public. Accordingly, it is the policy of St. Thomas:

1. To promote the development, use, dissemination and disposition of intellectual property created at St. Thomas or using St. Thomas resources in a manner that advances the common good and, when consistent with that objective, to pursue or support others' pursuit of intellectual property protections and encourage the licensing and commercialization of inventions. St. Thomas has sole discretion to determine whether to license and commercialize intellectual property it owns, subject to applicable contractual and statutory obligations. When making this determination, St. Thomas will take into account its best interests and the public interest and will make reasonable efforts to consult with and keep the creator(s) and inventor(s) apprised of licensing and commercialization efforts.

2. That when negotiating with third parties concerning the development, use, ownership, dissemination and disposition of intellectual property, St. Thomas and its employees (faculty, staff and student workers) will strive to advance the common good while obtaining appropriate latitude and rights for the creator(s), inventor(s) and St. Thomas consistent with this policy and the best interests of the university.

3. To provide assistance with the protection and marketing of intellectual property in which covered persons other than St. Thomas have ownership rights, if the provision of such assistance is consistent with the university's best interests and the public interest. If provided, such assistance will be subject to terms and conditions agreed with the rights owner(s). Requests for assistance should be made to the Office of the Provost.

C. Written Acknowledgments

If any creator, inventor or owner of intellectual property under this policy reasonably requests St. Thomas or another covered person to do so, the covered person(s) promptly will execute appropriate written waivers, acknowledgments or other instruments to establish or acknowledge the intellectual property rights of others consistent with this policy.

SECTION VI. TRADEMARK

A. Ownership and Designation of Trademarks

All trademarks held by or pertaining to St. Thomas are the exclusive property of St. Thomas. Covered persons will not attempt to secure trademarks with respect to St. Thomas, whether through use or registration, except with the approval of the President, the Chief Communication Officer or their respective designees.

B. Use of St. Thomas Name, Logos and Other Trademarks

1. Except as otherwise described below, use of the St. Thomas name, logos and other trademarks requires prior written approval of the President, the Chief Communication Officer or their respective designees, and may be subject to limitations or conditions to ensure appropriate trademark protection. In general, the St. Thomas name, logos and other trademarks will not be approved for use in connection with any other private or commercial enterprise, the advertisement of any goods or services offered by a person, group or entity other than St. Thomas, or the promotion of any person or group of persons, unless a written sponsorship or similar licensing agreement with St. Thomas is in place.

2. The St. Thomas name, logos and other trademarks may be used by employees (faculty, staff and student workers) for purposes of carrying out St. Thomas business and work responsibilities, and by students in connection with the approved activities of recognized student clubs and organizations. Such uses must comply with any applicable brand standards established by St. Thomas.

3. Covered persons may use the St. Thomas name for private purposes solely to identify themselves as a current or former employee, student or volunteer.

4. Questions regarding the use of the St. Thomas name, seal, logos or other trademarks should be referred to brand@stthomas.edu, who may consult with the Office of General Counsel as needed.

SECTION VII. COPYRIGHT

A. Requirement to Comply with Copyright Law

Covered persons are responsible for understanding and complying with copyright law, including their obligations concerning the fair use of copyrighted works. There are many publicly available resources, including on the St. Thomas website, to help covered persons understand the law relating to copyright and fair use. Questions about copyright and fair use compliance should be directed to the University Libraries Copyright Committee at copyright@stthomas.edu. The Copyright Committee will consult with the Office of General Counsel as needed.

B. Ownership of Copyright in Copyrighted Works Created by Covered Persons

1. **Copyrighted Works Other Than Academic Works.**

   a. Unless otherwise agreed in writing by St. Thomas and the creator(s), St. Thomas will be the sole owner of copyright in:

      i. institutional works;

      ii. copyrighted works, other than academic works, created by faculty members in the scope of their employment with St. Thomas; and

      iii. audio and visual recordings or transmissions created by St. Thomas or its agents or contractors of courses, lectures and other presentations delivered by St. Thomas employees (faculty, staff and student workers) or students to St. Thomas students and others in the scope of St. Thomas employment or course work, provided that for faculty whose presentations comprise

teaching or professional engagement responsibilities and for student presentations, St. Thomas will use such recordings or transmissions only for archival and limited non-commercial purposes unless otherwise agreed by St. Thomas and the faculty member or student, and St. Thomas will not own copyright in any recordings made at the instigation of the faculty member or student rather than St. Thomas.

Covered persons will own copyright in all other copyrighted works they create except as otherwise set forth in this policy or agreed in writing by St. Thomas and the creator(s).

b. If a student worker creates a copyrighted work or a joint work as part of the student worker's employment responsibilities as a research assistant to a St. Thomas faculty member, St. Thomas generally will not assert its copyright ownership and will permit the faculty member to use such copyrighted work or joint work in connection with the faculty member's teaching and professional engagement duties at St. Thomas and in connection with any research with respect to which the faculty member is a principal investigator, so long as such activities are non-commercial in nature.

c. St. Thomas may assign, license or otherwise grant rights in the copyrighted works it owns to the creator(s) or others. The decision to grant all, some or none of such rights is at the sole discretion of St. Thomas and will depend on the particular facts and circumstances.

2. <u>Academic Works.</u>

a. Consistent with academic tradition, St. Thomas will decline to assert and will not claim ownership of copyright in academic works, and faculty creator(s) of academic works may claim copyright in such works in their own name(s), unless the works are joint works created with staff, student workers or volunteers (see Section VII.B.4 below), or the work is subject to an agreement or policy that assigns ownership of the work to others (such as agreements or policies that assign research data ownership to the principal investigator of a research project). Except to the extent restricted by a faculty creator's agreement with a publisher, St. Thomas will retain a royalty-free, nonexclusive, nontransferable, worldwide license in academic works created by faculty in the scope of employment with St. Thomas:

   i. to maintain and use such academic works in perpetuity as appropriate for compliance with legal, regulatory, accreditation, course content verification and certification purposes;

   ii. to use and modify course syllabi for the university's non-commercial educational purposes for a period of five years after the faculty member last teaches the St. Thomas course for which the syllabus was used; and

   iii. with the faculty creator's prior consent, to publicly display, excerpt from, promote or feature such academic works for the advancement of the university, or otherwise to use the academic works.

b. St. Thomas encourages faculty to become familiar with their rights in copyright and their options with respect to the preservation of such rights prior to assigning or

licensing such rights to third parties. While St. Thomas has no obligation to provide assistance to protect intellectual property in which St. Thomas has no ownership rights, upon request by a faculty member, St. Thomas may provide such assistance in accordance with Section V.B.3 above.

c. St. Thomas also encourages faculty to make their academic works available for maintenance and publication in St. Thomas institutional repositories and, when possible, to preserve their rights to do so. To the extent faculty make their academic works available to St. Thomas institutional repositories, St. Thomas will retain a perpetual, royalty-free, nonexclusive, nontransferable, worldwide license to maintain, publish and make available for public use copies of such works in St. Thomas institutional repositories, and to publicly disseminate any metadata for such works.

3. <u>Copyrighted Works Created Solely by Students Outside the Scope of Employment.</u>

a. Students will be the sole owner(s) of copyright in the copyrighted works they create, unless the works are institutional works, joint works (see Section VII.B.4 below), or research data generated in connection with research conducted under a principal investigator who is not the student (see Section VII.B.3(c) below).

b. If the copyrighted work is a student thesis or dissertation submitted to St. Thomas institutional repositories, the student hereby grants to St. Thomas a perpetual, royalty-free, nonexclusive, nontransferable, worldwide license to maintain, lend and make available for public, non-commercial use copies of the thesis or dissertation in St. Thomas institutional repositories and to publicly disseminate any metadata for such works. St. Thomas maintains separate policies and procedures regarding the submission of theses and dissertations to St. Thomas institutional repositories and the application of embargoes or access restrictions for theses, dissertations or particular content contained in theses and dissertations pending other publication or patent.

c. Copyright in research data generated by a student that is not institutional work will be owned by the principal investigator or co-principal investigators of the research, if any, unless the research data is subject to an agreement or policy that assigns ownership of the research data to the student. If the research is independently conducted by one or more students for academic credit, outside the scope of employment with St. Thomas, the student(s) will own any copyright in the research data.

4. Joint Works.

Unless otherwise provided in this policy or agreed by the creator(s), copyright in joint works will be jointly owned by the persons who would have had sole ownership of copyright under this policy had the work been created by each of them individually rather than jointly.

SECTION VIII. INVENTIONS AND PATENT

A. Ownership

1. Inventions That Are Institutional Works.

Unless otherwise agreed by St. Thomas and the inventor(s), St. Thomas has the right to require inventor(s) to assign to St. Thomas or a third party the inventor(s)'s ownership and any related patent rights in institutional works, and inventors hereby grant this right to St. Thomas. This right enables St. Thomas to fulfill its contractual obligations under research and grant agreements and to assure compliance with legal obligations applicable to nonprofit universities (such as the Bayh-Dole Act). Subject to applicable contractual and statutory obligations, St. Thomas may assert all, some or none of its rights under this policy, in accordance with the terms of this policy, at its sole discretion, and inventors may not assign any rights in institutional works to others unless the Vice Provost for Academic Affairs or the vice provost's designee first has notified the inventor(s) that St. Thomas will not assert its ownership and other rights under this policy.

2. Inventions That Are Not Institutional Works.

a. Unless otherwise agreed in writing by the inventor(s) and St. Thomas, inventions that are not institutional works, and the related patent rights, will be owned by the inventor(s) unless the work is a joint invention in which St. Thomas has ownership rights (see Section VIII.A.3 below) or is another work in which St. Thomas has ownership rights under this policy. For the avoidance of doubt, unless the invention is an institutional work or a joint invention (see Section VIII.A.3 below), or unless otherwise agreed in writing by the inventor(s) and St. Thomas, inventions conceived or first reduced to practice by students as part of their course work, and the related patent rights, will be owned by the student inventor(s), and St. Thomas will not have the right to own such inventions and patent rights.

b. Inventors of inventions in which St. Thomas has no ownership rights are strongly encouraged to become familiar with their rights in such inventions and their options with respect to the preservation of such rights before disclosing such inventions to third parties or affirmatively waiving, assigning or licensing their rights. While St. Thomas has no obligation to provide assistance to inventors of inventions in which St. Thomas has no ownership rights, upon request by an inventor St. Thomas may provide such assistance in accordance with Section V.B.3 above.

3. Joint Inventions.

Unless otherwise agreed by the inventors, joint inventions and the related patent rights will be jointly owned by the persons who would have had ownership rights in the invention under this policy, had the invention been invented by each of them individually rather than jointly. Inventors of joint inventions in which St. Thomas has ownership rights may not assign any rights in such joint

inventions to third parties unless the Vice Provost for Academic Affairs or the vice provost's designee first has notified the inventor(s) that St. Thomas will not assert its ownership and other rights under this policy.

B. Confidentiality and Disclosure Obligations

Certain disclosures of information about an invention can severely limit or eliminate the ability to protect the intellectual property rights in the invention. Accordingly, covered persons are required to comply with the following requirements relating to confidentiality and disclosure:

1. Contractual Obligations to Third Parties.

Sponsored research projects and other agreements or arrangements with third parties typically are subject to contractual confidentiality and nondisclosure obligations. Covered persons are expected to familiarize themselves with, understand and continuously comply with any contractual confidentiality and nondisclosure obligations that apply to projects in which they are involved.

2. St. Thomas Confidentiality Requirements.

Regardless of whether a project is subject to a confidentiality or nondisclosure agreement with a third party, all covered persons are required to maintain confidentiality regarding the details of an invention that is an institutional work, a joint invention in which St. Thomas has ownership rights, or another invention in which St. Thomas has ownership rights under this policy. Covered persons are not permitted to share any information about such inventions with third parties, or with other covered persons except on a need-to-know basis or as authorized by the Vice Provost for Academic Affairs or the vice provost's designee, until the earlier to occur of:

a. The Vice Provost for Academic Affairs or the vice provost's designee has notified the inventor(s) that St. Thomas will not assert its ownership and related rights to the invention;

b. St. Thomas or a third party has filed a patent application for the invention; or

c. St. Thomas or another person authorized to make the determination (for example, the sponsor of sponsored research) has determined not to file a patent application with respect to the invention.

The requirement to maintain confidentiality on a need-to-know basis prohibits covered persons from publishing, presenting or displaying the invention in any setting that may constitute a public disclosure of the invention.

C. Requirement to Notify St. Thomas of Inventions

Covered persons must notify the Office of the Provost or, for faculty members, their dean, promptly following the covered person's creation, alone or with others, of any invention that is an institutional work, a joint invention in which St. Thomas has ownership rights, or another invention in which St. Thomas has ownership rights. Disclosures should be made using the invention disclosure form, available here. Prompt disclosure is critical to assure contractual compliance and to assess and facilitate the protection of intellectual property rights with respect to such inventions. Prompt disclosure also helps to avoid delays in any publication, presentation or display of such inventions. If inventor(s) have any doubt about whether an invention is an institutional work, a joint invention in

which St. Thomas has ownership rights, or another invention in which St. Thomas has ownership rights under this policy, the inventor(s) should notify the Office of the Provost for assistance.

D. Determination of Ownership and Assignment of Rights

1. Upon disclosure of an invention that is an institutional work, a joint invention in which St. Thomas has ownership rights, or another invention in which St. Thomas has ownership rights under this policy, the Office of the Provost or, for faculty members, the relevant dean, in consultation with the Office of General Counsel, will confirm that the disclosed invention is in fact a work in which St. Thomas has ownership rights. If so, the Office of the Provost or, if applicable, the relevant dean, will determine whether St. Thomas will assert its rights with respect to the invention. In making this determination, St. Thomas will consider its legal obligations, including but not limited to its contractual and statutory obligations to third parties, and whether it is in the university's best interests and the public interest for St. Thomas to own (or jointly own) the invention and related patent rights. The relevant dean will consult with the Office of Provost prior to determining not to assert rights in an invention. The Vice Provost for Academic Affairs, the vice provost's designee, or the relevant dean will notify the inventor(s) promptly after the determination is made.

2. If St. Thomas determines to assert its sole ownership rights, each inventor is required promptly to assign to St. Thomas all of the inventor's right, title and interest in the invention, including but not limited to all patent rights, in the form and manner reasonably requested by St. Thomas. Subject to the statutory and contractual obligations of St. Thomas, the inventor(s) generally will retain the right to create, use and publish academic works with respect to the invention for education, academic research and other non-commercial purposes.

E. Filing of Patent Application; Cooperation

1. Subject to its agreements with third parties, St. Thomas will have sole discretion to determine whether to file a patent application with respect to inventions solely owned by St. Thomas. St. Thomas will consider its best interests and the public interest when making this determination. Factors that St. Thomas may weigh include, without limitation, the potential commercial value of the invention and St. Thomas resource availability. If St. Thomas determines to file a patent application, the inventor(s) will cooperate with the patent process as reasonably requested by St. Thomas, its agent or designees. The process for determining whether and how St. Thomas will patent inventions created by faculty members is outlined in Appendix B. Non-faculty inventors should consult with the Office of General Counsel to discuss the patent process.

2. For inventions jointly owned by St. Thomas and the inventor(s), St. Thomas and the inventor(s) will agree whether to file a patent application and will cooperate with each other to implement their agreement.

F. Licensing and Commercialization; Revenue-Sharing

If inventions that are institutional works are licensed or commercialized, St. Thomas will administer and share revenues it receives from such licensing or commercialization with the inventor(s) of the

invention in accordance with any written agreement between the inventor(s) and St. Thomas or, if none, as follows:

1. **Administration of Revenues**. Revenues derived from the commercialization or licensing by St. Thomas of inventions and related intellectual property rights it owns will be received and administered by the Office of the Provost.

2. Deduction of Expenses**.** Direct expenses incurred by St. Thomas in the process of perfecting, transferring, protecting and licensing/commercializing the rights in such inventions will be deducted before calculating and distributing the net revenues.

3. **Allocation of Net Revenues**. Unless otherwise agreed by the inventor(s) and St. Thomas, the distribution of net revenues will be distributed as follows:

    a. 50% of the net revenues will be allocated to the inventor(s). In the event of multiple inventor(s), the allocation will be divided equally among them, except as otherwise may be agreed by the inventor(s) and approved by the Office of the Provost.

    b. 25% of the net revenues will be allocated to the applicable college, school or division, to be shared equally with the relevant department or program.

    c. 25% of the net revenues will be allocated to St. Thomas to cover indirect expenses, with any excess revenues to be allocated at the discretion of St. Thomas.

G. Equity Participation.

From time to time, covered persons may be offered the opportunity to accept equity in return for their contributions to the development of inventions for third parties. Covered persons may not accept equity in connection with inventions created with the use of St. Thomas resources (regardless of whether the invention is an institutional work, and regardless of whether the use of St. Thomas resources was significant) unless the proposed equity position is disclosed, reviewed and approved in advance in writing by the Office of the Provost. The purpose of this disclosure and review is to assess potential conflicts of interest and ensure compliance with St. Thomas policies. If St. Thomas accepts an equity interest in lieu of cash revenues, the equity interest will be considered to be part of the revenues derived from an invention and will be allocated accordingly.

Appendix A to Intellectual Property Policy

FAQs

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A. GENERAL

1. For the university to own institutional work that I create or use works in which I own the intellectual property rights, must there be a written agreement between St. Thomas and me?

No. Agreements can be made orally or in writing, so long as they are entered into by you and an authorized representative of St. Thomas. However, St. Thomas generally will endeavor to enter into written agreements with respect to the allocation of intellectual property rights where there could be ambiguity about which party owns the rights. If you have questions about whether you are entering into an intellectual property agreement with St. Thomas or whether someone is authorized to enter into an agreement with you, you are strongly encouraged to ask them or to consult with the Office of the Provost.

2. Can St. Thomas change institutional works I create without my permission? Can St. Thomas continue to use those works if I leave St. Thomas?

Yes. If a work is an institutional work, then St. Thomas owns copyright in the work and generally can use or modify the work at its discretion, whether or not you remain employed by St. Thomas. However, St. Thomas generally will agree to consult with the faculty creator of online course materials about potential modifications of those materials so long as the creator remains employed by St. Thomas.

3. Is computer software considered to be academic work under the policy?

Yes, to the extent it is non-patentable. The academic tradition under which universities do not assert copyright interests in academic works created by faculty generally does not extend to patentable computer software. Patentable computer software is considered to be an invention under the policy.

4. In considering whether use of St. Thomas resources is "significant use," what do "category" and "unit" mean?

For purposes of defining "significant use of St. Thomas resources," "category" means the category of covered person (*i.e.*, faculty, staff or student worker, student, visitor or volunteer). "Unit" means the smallest organizational unit within St. Thomas to which the person is assigned, which generally means a department or program.

5. How can I know if my use of specific St. Thomas resources constitutes significant use?

Where resources are provided by St. Thomas for the common benefit of all faculty, staff or students, or all faculty or students in a particular discipline, school, college or department, the use of those common resources will not constitute use of significant St. Thomas resources. Where resources require special acquisitions, additional approvals or otherwise are not provided as a common benefit, they are likely to constitute the significant use of St. Thomas resources. Whether or not there has been significant use of St. Thomas resources in creating a work will be determined by the Office of the Provost, after consultation with the creator, the creator's immediate supervisor, and the Cabinet member with most direct responsibility for the creator.

For purposes of illustration, use of standard-issue university computers, office space, library resources, and STELAR Center resources do not constitute the significant use of St. Thomas resources with respect to creating a work. Faculty Development Center grants also will not be considered the significant use of St. Thomas resources for purposes of this policy. Student use of the Maker Space and resources offered by the Schulze School of Entrepreneurship to students starting new ventures also does not constitute the significant use of St. Thomas resources.

In contrast, any of the following circumstances could constitute the significant use of St. Thomas resources in creating intellectual property, unless otherwise agreed by St. Thomas: the acquisition by St. Thomas of specialty equipment (such as a high performance computer) for use only by select faculty within a department or for use by select faculty for a particular project, the release of a faculty member from regular employment duties outside the routine sabbatical process in order to permit the faculty member to work on a particular project, compensation in excess of the contracted salary level in exchange for specified work outside an employee's regular duties, or financial support by St. Thomas outside the ordinary course. Other situations that could constitute significant use include the use of a chemistry laboratory and supplies by a humanities faculty member for a project that is not clearly related to the faculty member's teaching or professional engagement responsibilities, the renovation of space to accommodate specialized equipment, or the engagement of external consultants or contractors paid by St. Thomas to advise or consult with a particular faculty member on the faculty member's work.

6. Can I use St. Thomas facilities or resources to create intellectual property for my personal benefit or for use or ownership by a third party? If so, will St. Thomas have any ownership rights in the intellectual property I create?

St. Thomas has an obligation to use its assets for purposes that are consistent with its status as a nonprofit university. St. Thomas resources are intended to advance the university's charitable mission and strategic objectives, and covered persons generally are not permitted to use St. Thomas resources for their private benefit or the benefit of a third party without the express agreement of St. Thomas, except for works created in the scope of their employment (such as works created by faculty as

part of their professional engagement responsibilities) or otherwise as permitted by St. Thomas policies.

Reasonable, incidental use of St. Thomas resources that does not result in added expense to St. Thomas (*e.g.*, limited personal emails, local telephone calls, or use of assigned workstations and computers outside of regular work hours for personal reasons or in connection with volunteer work you do that does not conflict with your responsibilities to St. Thomas) generally is acceptable under St. Thomas policies, so long as you are complying with all applicable policies. For example, if an employee uses a St. Thomas computer to write a novel during non-work hours, that would be considered incidental use of St. Thomas resources. Faculty and staff are subject to policies regarding outside employment, consulting and conflicts of interest and may be required to obtain approvals before engaging in such work.

Intellectual property that is developed without significant use of St. Thomas resources and otherwise is not institutional work will be owned by the inventor(s) or creator(s) and subject to any agreements between the inventor(s)/creator(s) and the outside party.

It is important to keep in mind that agreements with St. Thomas regarding intellectual property ownership and rights must be signed by the Executive Vice President and Provost or another authorized St. Thomas signatory. Academic administrators and individual faculty members are not authorized to sign agreements on behalf of St. Thomas unless the EVP and Provost has delegated signature authority to them in writing. This includes confidentiality and nondisclosure agreements. All agreements with St. Thomas involving intellectual property require advance review by the designated contract manager.

7. I'm a faculty member. Can I enter into an agreement directly with a third party to conduct research or create intellectual property that will be owned by the third party? What if the third party also has an agreement with St. Thomas?

You must comply with applicable St. Thomas policies regarding outside employment, consulting and conflicts of interest and obtain any required approvals before engaging in such work. If the outside work is approved or does not require approval, then you can enter into an agreement with an outside party in your own name, to conduct research or create intellectual property in your personal capacity, so long as you do not use St. Thomas resources, or make only incidental use of St. Thomas resources, to conduct the research or create the intellectual property. If you will make significant use of St. Thomas resources to conduct the research or create the intellectual property, then the agreement must be between St. Thomas and the third party, and is subject to approval of your department chair, dean and the Executive Vice President and Provost.

Generally, if a faculty member is seeking to provide paid consulting or other services to a third party and St. Thomas also has entered or will enter into an agreement with that party relating to the work you will perform, your work for the third party must be disclosed to St. Thomas if it has not already been disclosed, to address any potential conflicts of interest. Typically, the fact that you are being compensated directly by the third party will be addressed in the agreement between the third party

and St. Thomas, and you may be added as a party to that agreement rather than maintaining a separate agreement with the third party.

It is important to keep in mind that agreements with St. Thomas regarding intellectual property ownership and rights must be signed by the Executive Vice President and Provost or another authorized St. Thomas signatory. Academic administrators and individual faculty members are not authorized to sign agreements on behalf of St. Thomas unless the EVP and Provost has delegated signature authority to them in writing. This includes confidentiality and nondisclosure agreements. All agreements with St. Thomas involving intellectual property require advance review by the Office of General Counsel.

B. COPYRIGHT AND FAIR USE

1. Who owns copyright under U.S. law?

Under U.S. law, copyright initially and automatically belongs to the creator of the work, unless the work is a work made for hire. A work made for hire is a work created by an employee acting within the scope of employment, or a work created by an independent contractor pursuant to a special order or commission that meets certain conditions established by law. U.S. law provides that if a work made for hire was created by an employee within the scope of employment, then the copyright belongs to the employer rather than the creator of the work.

2. Are all materials created by faculty or students in connection with a course protected by copyright?

No. Copyright only protects works that are considered to be original works of authorship under the law. For example, a course syllabus for an introductory-level course in a discipline with a mandated or well-established curricular progression might not be an original work that qualifies for copyright protection. If a work does not meet this standard, then it is not considered to be a copyrighted work or academic work under the policy.

3. Why are faculty treated differently than other St. Thomas employees when it comes to copyright ownership?

There is a longstanding academic tradition of universities declining to assert copyright in academic works created by faculty, even if the works are created within the scope of the faculty member's employment. Unlike staff and student workers, faculty have substantial freedom to determine the manner in which they carry out their employment responsibilities related to teaching and professional engagement and the content of their academic works. Faculty copyright ownership is consistent with, and helps to reinforce, the academic freedom principles that safeguard faculty autonomy and independence with respect to these academic works. To the extent faculty create institutional work or other copyrighted work in the scope of their employment, copyright in the institutional work or other copyrighted work will be owned by St. Thomas, just as it is for work performed by staff and student workers within the scope of their employment with St. Thomas.

4. Do faculty members own copyright in the courses they teach?

Courses are offered by St. Thomas, and faculty members deliver the content of assigned courses as part of their employment responsibilities at St. Thomas. Copyright only applies to original works of authorship that are fixed in a tangible medium of expression, and St. Thomas courses involve elements that would not constitute copyrighted work. Therefore, a St. Thomas course generally is not in itself subject to copyright.

Rather, faculty members own copyright in works they create and fix in a tangible form for use in their delivery of the courses they teach (such as the class notes, exams and documented presentations), to the extent that:

- the works are sufficiently original to qualify for copyright protection under the law;
- the works are not institutional work as defined in the policy; and
- the faculty member has not assigned the faculty member's copyright (if any) in the work to another person.

Even if a work is an institutional work, or if the faculty member assigns copyright in the faculty member's academic works to others, the faculty member always retains the right to express and share the faculty member's knowledge, thinking, theories and conclusions about the subject matter of the work, and to create new and original works based on such knowledge, thinking, theories and conclusions.

5. Do faculty members own copyright in teaching materials they develop that are incorporated into an online course?

In most cases, yes. If a faculty member incorporates online, electronic or digital academic works into a course the faculty member is teaching (such as recorded lectures, interactive digital presentations or other academic works delivered via electronic or digital means), the faculty member will own copyright in such works unless:

- St. Thomas explicitly requested the faculty member to develop the course or particular materials for the future use by St. Thomas, in which case St. Thomas generally would provide the faculty member with a course release or seek to enter into an online course development agreement or other agreement with the faculty member; or
- the faculty member made significant use of St. Thomas resources; or
- the faculty member developed such work as part of the faculty member's service obligation to St. Thomas.

Significant use of St. Thomas resources means that the faculty member has used resources (physical, financial or human) provided by or through St. Thomas that are above and beyond the level of support and resources routinely provided or available to other faculty in the faculty member's discipline and unit. Use of Faculty Development or St. Thomas e-Learning and Research (STELAR) Center resources

that are available to all faculty who request them is not considered to be significant use of St. Thomas resources.

If St. Thomas requests to use the faculty member's pre-existing academic works in connection with an online course developed by St. Thomas, the faculty member will retain copyright in those works, and any use by St. Thomas would require a license from the faculty member.

6. Can I develop or teach an online course outside St. Thomas while still a faculty member at St. Thomas?

In general, no, unless you are an adjunct faculty member. Developing or teaching an online course for another institution while serving as a full-time faculty member at St. Thomas likely would give rise to an actual or perceived conflict of interest with St. Thomas. Under St. Thomas policies (including the Faculty Handbook, the Policy on Outside Employment applicable to faculty, and the Conflicts of Interest Policy), full-time faculty could not develop or teach a course for another institution unless you obtain advance written approval of the Executive Vice President and Provost, which is unlikely to be granted to full-time faculty members absent unusual circumstances.

7. If a staff member publishes an article in a scholarly journal, who owns the copyright?

It depends on whether the work is within or outside the scope of the individual's employment responsibilities with St. Thomas. Copyrighted works created outside the scope of employment always belong to the creator absent a different agreement with St. Thomas. Copyrighted works created within the scope of employment by individuals who do not have faculty appointments would be owned by St. Thomas. A staff member's publication of a scholarly article is likely to fall outside the scope of employment for most staff members. However, there could be situations where the specific facts might result in a different determination. If you have questions about whether particular work would be within the scope of your employment, contact the Office of the Provost.

EXAMPLES OF COPYRIGHT OWNERSHIP RELATED TO ONLINE COURSES

Example 1: You are assigned to teach a course, which at your own instigation you structure as a "flipped" classroom. With the assistance of STELAR staff and equipment, you record your lectures for the course and make them available to students in advance of each class through an online portal that is available for use by all faculty members, along with discussion questions you would like the students to consider in advance of the class period. During the class period, you engage the students in discussion, and they work collaboratively to answer the questions. In this case, the recorded lectures and discussion guides are academic works, and you own copyright in those works.

Example 2: You are assigned to teach a course. You prepare the syllabus and all of the other instructional materials for the course. Shortly before the course begins, St. Thomas requests you to record a few of your course lectures for the university's use as part of an interdisciplinary online lecture series St. Thomas wishes to offer. You agree and record the lectures over a period of weeks in a studio at St. Thomas with the assistance of STELAR staff, and you also work with St. Thomas to prepare transcripts of the lectures to enable closed captioning of the recordings. St. Thomas provides you with a miscellaneous payment (a payment in addition to your regular salary) to compensate you for this work, which is on top of your regular teaching, professional engagement and service responsibilities. Subject to any agreement you make with St. Thomas, in this case:

- St. Thomas will own copyright to the recordings and transcripts and will have the right to use and alter the recordings and transcripts after they are recorded. So long as you remain employed by St. Thomas, St. Thomas generally will consult with you and offer you the first opportunity to make any modifications to the recordings to assure they remain current.

- St. Thomas will have no right to use other instructional materials you developed for the course, except that St. Thomas may use and modify your course syllabus for non-commercial educational purposes for up to five years after you last teach the course at St. Thomas, and can maintain and use the syllabus as appropriate for compliance with legal, regulatory, accreditation, course content verification and certification purposes, consistent with the terms of the Intellectual Property Policy.

- If you leave St. Thomas for another institution, you can continue to give the same lectures at the other institution and to use all of the other instructional materials at the other institution. You cannot use the recordings of your lectures at the other institution unless St. Thomas agrees in writing to permit such use.

Example 3: You are assigned to teach an introductory-level course that is required for all students majoring in your discipline. Your department chair tells you that St. Thomas wants to experiment with a new, hybrid (partially online) program for a select group of students and would like to record your lectures and potentially incorporate excerpts from them into the experimental program. The program will be developed by another faculty member in your discipline in collaboration with an external consultant retained by St. Thomas. Your colleague has received a course release to develop the program and related instructional materials. The program will be offered to two groups of students and then assessed for effectiveness. Following the assessment, a decision will be made whether to offer the program on an ongoing basis and whether any modifications will be made before it is offered again. You

consent to St. Thomas recording and using your lectures for this purpose. A videographer hired by St. Thomas attends and records each of your classes for the semester.

In this case, the videos of your lectures and the instructional materials prepared by your colleague will be considered to be institutional works, and St. Thomas will own the copyright in the videos and instructional materials. If St. Thomas decides to incorporate excerpts from the videos into the online program it develops, St. Thomas will enter into an agreement with you regarding the long-term use, editing and distribution of the lectures that also addresses your ability to use the recordings for personal, non-commercial educational and research purposes. In general, St. Thomas is likely to permit you to retain copies of the videos and to show the videos to a small number of colleagues at another institution as a reference to prepare for a similar course, but would not permit you to sell the recordings to another institution or for another institution to use them as the basis for an online course it offers, unless St. Thomas receives some compensation or other consideration for such use.

Whether or not you enter into an agreement with St. Thomas, you can continue to use freely the underlying content of the lectures for any purpose you choose, including giving the same lectures at another institution if you leave St. Thomas. Whether or not your colleague can use the specific instructional materials developed for the program at another institution will depend on the agreement between your colleague and St. Thomas, which may vary based on the type of materials and how they are used at St. Thomas. Regardless of the agreement terms, you and your colleague will be able to develop new and original instructional materials based on the academic content of the course and your knowledge, thinking, theories and conclusions about that subject matter.

C. INVENTIONS AND PATENT

1. Who owns patent under U.S. law?

Under U.S. law, the right to patent an invention initially belongs to the inventor unless the inventor assigns these rights to another person or entity, or unless the inventor was hired specifically for the inventor's inventing skills or to create the invention. It is common for academic and other institutions to require employees and others who use institutional resources to develop an invention to assign all ownership and patent rights to the institution.

2. Why does St. Thomas have the right to own inventions that are institutional works?

Having the right to own inventions that make significant use of St. Thomas resources or that otherwise are institutional works enables St. Thomas to fulfill its legal and contractual obligations under external grant and sponsored research agreements and applicable law.

For example, sponsored research agreements typically provide the opportunity for the sponsor to assure intellectual property protection for the invention and to commercialize the invention pursuant to terms consistent with the university's legal and regulatory compliance obligations, while retaining rights for St. Thomas and the inventor, including rights to publish academic works relating to the supported invention and to use the supported invention for non-commercial education and research purposes.

Federal grants require St. Thomas to comply with the Bayh-Dole Act, which requires St. Thomas to preserve certain invention rights for the federal government if government funds were used to create the invention. In order to preserve the rights, St. Thomas must be able to control them, which means it must own the rights itself or have the ability to require the inventor(s) to assign the rights as St. Thomas directs.

Where the invention was created with the significant use of St. Thomas resources, assignment might be required to assure compliance with certain legal obligations applicable to nonprofit universities, such as regulations related to the private use of facilities financed with tax-exempt financing, and laws limiting private benefits from the use of charitable assets.

3. What benefits can I expect in return for the assignment of my invention and patent rights to St. Thomas?

St. Thomas will work with you to determine whether it is worthwhile to protect the invention by filing a patent application and will pay for such protection. If the invention is licensed or commercialized, St. Thomas will facilitate the licensing and commercialization, including funding. If St. Thomas receives any revenues from the licensing or commercialization of the invention, you will personally receive a portion of those revenues, and your department and school or college also will receive a portion of those revenues.

4. What constitutes public disclosure of an invention?

Public disclosure generally is any communication made in an area open to the public or without an obligation of confidentiality, that reveals the existence of an invention and enables a person with appropriate skill to reproduce the invention. Activities that could constitute public disclosure typically are in one of four categories:

- The invention is described in a printed publication.
- Use of the invention in a public forum. Examples may include display of an invention at a student showcase, in a class, or in a public park.
- A public offer to sell the invention.
- The invention otherwise is available to the public.

Examples of public disclosure may include sharing information about an invention as part of a class discussion or at a conference or in email correspondence, a scholarly article, an online blog, a grant proposal, posters and abstracts, copies of presentations, and even notes taken by a conference attendee listening to a talk you give. Disclosure also could occur through submission of the invention to a laboratory for testing or to a manufacturer for manufacture of a prototype, or through display of the invention in a student showcase or in the student center. It is very important to obtain protection for your invention prior to public disclosure.

5. Let's say that a student is taking a course where a required part of the course is a project with an external sponsor who is participating under an agreement between

the sponsor and St. Thomas. The project results in an invention. How would patent ownership work in this case?

Because this invention is invented under an agreement between St. Thomas and a third party, this invention would be considered an institutional work. As an institutional work, St. Thomas has the right to require the student inventor(s) to assign patent rights to St. Thomas or the third-party external sponsor. The agreement between St. Thomas and the external sponsor will allocate specific patent ownership and royalty rights as between St. Thomas and the external sponsor. If the invention is commercialized, the student inventor(s) would be eligible for revenue-sharing under Section VIII.F of the policy unless the students enter into a different agreement with St. Thomas.

UNIVERSITY OF St.Thomas

Appendix B to Intellectual Property Policy

Process for Disclosing and Patenting Faculty Inventions

Date of initial publication: June 6, 2017
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St. Thomas will follow the process outlined below in determining whether and how the university will patent inventions made by faculty members that are considered institutional works under the Intellectual Property policy. This process is intended to ensure St. Thomas makes thoughtful decisions about when to pursue patents, which often involve significant costs. It is also intended to ensure St. Thomas complies with federal grant rules, which require universities to report federally-funded inventions to sponsors and seek commercialization opportunities for such inventions. The EVP and Provost may make exceptions or changes to this process as circumstances dictate.

- Faculty inventors will report inventions considered institutional works to their dean by completing an invention disclosure form, available here.
- The form will be assessed at the college/school level and the relevant dean will decide whether St. Thomas should assert rights in the invention and proceed with a provisional patent, which lasts 12 months. Before pursuing a patent, the dean should consider whether necessary IRB or ethics committee approvals were received. The college/school will be responsible for the costs of the provisional patent if it decides to proceed with one. The dean will first consult with the EVP and Provost prior to deciding not to assert rights in an invention.
- During the provisional patent period, the inventor will be expected to explore opportunities for commercializing the invention and share relevant information with their dean. As available and needed, the college/school can offer support or guidance for the inventor during this process.
- Factoring in costs, commercialization potential, and other issues, the dean and Office of Provost will determine whether to proceed with a full patent, the costs of which will be shared evenly between the college/school and Office of Provost.
- Questions about this process should be directed to the Vice Provost for Academic Affairs.