

Intellectual Property Policy
Kean University
Approved 12.4.10 and Amended and Restated 9.14.15
Kean University Board of Trustees

I. Introduction

Kean University's ("University") policy on intellectual property is intended to encourage, support and motivate research, scholarship, creative activities, innovation and the development of new ideas by defining, recognizing and protecting respective rights and obligations; providing incentives and assistance in commercializing intellectual property where applicable; and, providing for the fair distribution of benefits.

The University recognizes that one part of its mission as an interactive public university is to serve as a major resource for regional advancement. Therefore, the University seeks to encourage and reward activities that may lead to the development of intellectual property for the public good.

This policy applies to all University employees, faculty and non-faculty, and anyone using university facilities under the supervision of university employees, as well as to undergraduate and graduate students who receive compensation from the University as research assistants and/or laboratory assistants.

II. Definitions

A. Intellectual Property

Intellectual property ("IP") is a term used to describe creations of the human intellect. The term "intellectual property" broadly includes, but is not limited to: inventions, discoveries, processes, know-how, machines, designs, composition of matter (including chemical compounds and microorganisms), asexually propagated plant varieties, methods, formulae, software, databases, writings, literary works, books, journal articles, art works, music, films, and architecture. Intellectual Property may be protected under four general categories of law: Patents, Trademarks, Copyrights, and Trade Secrets. For purposes of this policy, intellectual property means copyrighted materials, patentable materials, software, trademarks, service marks and trade secrets, whether or not formal protection under law is sought.

B. Patent

A **patent** is an exclusive right officially granted by a government to an inventor to make or sell an invention. Patents protect inventions that, by definition, are novel, useful and not obvious to one skilled in the art. A patent gives the owner the right to exclude others from making, using, or selling an invention. Patent applications must be filed with the U.S. Patent and Trademark Office ("USPTO"). Patent rights in the United States begin when the patent is granted by the USPTO and expire 20 years after the application for the patent was filed with the Office.

C. Copyright

Copyright is the legal right of authors, artists, or publishers to control the use and reproduction of their original works. Copyrights protect the tangible expression of original literary and artistic works such as books, papers, photographs, music, movies, and software. Copyright exists automatically when a work is created. Copyrighted works may be registered with the U.S. Copyright Office in the Library of Congress.

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III. Ownership of Intellectual Property

A. Inventions, Discoveries and Improvements

All inventions, discoveries and improvements, whether or not patentable, that are made, conceived, or reduced to practice in whole or in part by faculty or staff (including student research assistants) or by non-employees who participate in research projects at the University, using the facilities, equipment, funds or other resources of Kean University or who participate in research projects for the University regardless of whether University facilities are being used, will be the sole property of Kean University. All original data, records, and other documents relating to the invention will be the sole property of the University.

The University does not claim intellectual property rights to inventions by employees that are unrelated to their responsibilities or assignments *and* that were invented or improved without the use of University resources.

B. Copyrights

Copyrightable works that also qualify for protection under patent laws will be owned by the University and governed by the Inventions, Discoveries and Improvements section of this policy. The University's copyright ownership rights herein are subject to any applicable collective negotiations agreement that provides for an employee's ownership of copyrightable works. To the extent that this policy is inconsistent with such an agreement, that agreement, and not this policy, will control with respect to any employee to whom the agreement applies.

1. Traditional Academic Copyrightable Works

Scholarly and Artistic Works: All works that have traditionally belonged to faculty such as scholarly books, monographs, and journal articles, and artistic works such as musical compositions and artwork, created with their individual effort, with only incidental use of University resources, and published in pursuit of their research, in whatever format they are created, print or electronic, continue to belong to faculty and the University makes no claim to them.

Courseware: Faculty members hold copyright to all course materials they create on their own initiative in the course of their teaching responsibilities using resources ordinarily available to all or most faculty members. Course materials include materials in print, in electronic format or posted to a website.

Kean University reserves a royalty-free, non-transferable right to use all scholarly and artistic works and pedagogical materials created by faculty during the course of their employment at Kean, for academic and research purposes.

Works for Hire: All works that are created as a condition of employment (see description below) will be the sole property of the University.

2. Substantial Use of University Resources

Kean University may elect to own the copyright on works created using substantial University resources (this does not apply to traditional scholarly or artistic work). The use of substantial University resources

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refers to the use of University funds, facilities, equipment or other resources which might not be ordinarily available to all or most faculty members.

Use of substantial University resources may include internal research funding, paid or released time awarded for the specific purposes of supporting the creation of the copyrightable work, use of University laboratories, specialized equipment or unique facilities, and dedicated assistance by University employees. This is a listing of examples and is not intended to be complete.

Faculty members who expect to use substantial University resources in the creation of a copyrightable work are encouraged to consult with his or her dean for advice. Deans may consult the Office of the Dean, Office of Technology Commercialization (OTC) which will, whenever feasible, make a determination on copyright before the work is created and inform the faculty member of this determination as expeditiously as possible.

3. Works Created as a Condition of Employment

A “work for hire” under copyright law is:

- Work prepared by an employee within the scope of his/her employment (examples include a software programmer, graphic artist, script writer, etc.), or
- If the work is created by an independent contractor or freelancer, the work may be considered a work for hire **only if all** of the following conditions are met:
 - The work must come within one of the nine limited categories of works considered works for hire under copyright law (US Copyright Act of 1976):
 1. Contribution to a collective work
 2. Part of a motion picture or other audiovisual work
 3. Translation
 4. Supplementary work
 5. Compilation
 6. Instructional text
 7. Test
 8. Answer material for a test
 9. Atlas
 - The work must be specially ordered or commissioned
 - There must be a written agreement between the parties specifying that the work is a work made for hire.

C. Sponsor-Supported Efforts

The rights of the University may be subject to the terms of a sponsored research project, contract or other agreement. To the fullest extent allowed under such agreements, the University will be the owner of all inventions or improvements conceived or reduced to practice in the performance of the sponsored work. If not specified, the University owns the intellectual property.

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D. Other Efforts

Intellectual Property developed by faculty or staff under “other efforts”, which may include consulting for outside organizations or collaborating with non-university personnel, can result in joint ownership of the IP by the University and other persons or their employers. Protection and possible commercialization of jointly owned IP can be difficult without prior agreement among the potential inventors. Accordingly, any outside agreement must be provided to the University for approval, and any outside agreement must include a statement that the faculty or staff member has intellectual property obligations to the University and a copy of this policy should be attached to the outside agreement.

IV. Disclosure of Intellectual Property

University employees are required to promptly disclose the development of all intellectual property in writing, through a fully-completed invention disclosure form, to the Dean, OTC.

This timely and confidential disclosure requirement is intended to protect the rights of the inventor and the University. The United States has a “first to invent” patent system rather than a “first to file” system. Therefore, it is essential to formally document your invention through the completion of the invention disclosure form as soon as possible after you conceive it.

These disclosures are confidential and must be made prior to any public disclosure including submission for publication or attempt to patent, presentation at a professional meeting, and any private disclosure to a commercial entity or investor. The publication of an invention starts a one-year clock running on the right to file for patent protection in the United States and automatically bars filing for patent protection in almost every other country. In a global economy, loss of foreign patent rights can substantially diminish the economic value of your invention.

V. Invention and Copyright Agreements

This policy constitutes an understanding which is binding on University faculty, staff, students, and others as a condition of their use of University resources or participation in University research programs. Where the University has an obligation to disclose the creation of intellectual property to a sponsor, or where the University itself will acquire rights under this policy, it will require a formal invention and copyright agreement.

VI. Procedure for Requesting Return of Rights

The University will make a decision whether or not to initiate the filing of patent application within 120 days after receiving the invention disclosure form and will notify the inventor of its decision. If the University decides not to file a patent application, the inventor may request a transfer of title. This request must be made in writing to the Dean, OTC, who may ask for the recommendation of the University’s Intellectual Property Committee before either granting the request or advising the inventor that the University will file for patent protection.

If the University obtains a patent but makes no effort to commercially develop the invention within a three (3) year period, the inventor may request a transfer of title. This request must be made in writing to the Dean, OTC, who may ask for the recommendation of the University’s Intellectual Property Committee before either granting the reassignment of ownership back to the inventor or advising the

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inventor of the University's plans for commercial development of the invention. If the request to return title is granted, the University will retain a 10% Interest in the patent.

VII. Royalties and Proceeds Distribution

Realizing financial return from intellectual property usually requires licensing those rights to interested companies. The University shares royalties and other income from intellectual property after it has recovered direct costs related to processing the patent or copyright application and costs of commercializing the property.

Net revenues from commercialization will be divided as agreed on a case-by-case basis by the inventors/creators/authors and the Executive Committee for Technology Development (ECTD). In the case of multiple authors/creators/inventors, net revenues to authors/creators/inventors will be divided equally unless the authors/creators/inventors unanimously agree in writing to a different distribution, which is accepted by the University.

VIII. Administration

The Dean, OTC (or designee) is responsible for the administration of Kean University's Intellectual Property Policy. The University's Intellectual Property Committee makes recommendations to the Dean, OTC on matters regarding University policy and intellectual property. The Finance Committee of the Board of Trustees reviews and approves patent agreements.

A. Office of Technology Commercialization

The Office of Technology Commercialization (OTC) is charged with administering the development, disposition (including assignment of ownership and licensing rights) and commercialization of Kean's intellectual property in a manner consistent with the objectives of this Policy. In fulfilling its obligations, OTC shall: report to the Office of General Counsel all purported violations of this Policy or instances involving suspected misuse, misappropriation, infringement or improper encumbrance of any interest that Kean may hold in an invention and/or discovery; maintain oversight and actively review the status of all inventions, completed and developing; coordinate and participate as needed in the evaluation and protection processes employed, concerning inventions and/or discoveries; and, at the direction of the Executive Committee for Technology Development (ECTD), following consultation with and consideration of appropriate input by the Intellectual Property Committee, actively pursue the commercialization of inventions. OTC shall issue a comprehensive, annual, written report to the President, including the status of all inventions, discoveries and recommendations for further development and commercialization.

B. Intellectual Property Committee

The Intellectual Property Committee (IPC) is comprised of five members: one member appointed by the President, who will also appoint the Committee Chair; three members appointed by the Provost/Vice President for Academic Affairs; one member appointed by the Dean, OTC.

All members of the IPC shall, as a condition of membership on IPC, maintain strict confidentiality of the contents of all matters brought before it except those that are specifically and expressly identified as

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disclosable. The representatives of the Faculty Senate may disclose the subject of the matters discussed, without disclosing the contents, in order to report back to the organization. Breach of this covenant shall be considered serious misfeasance, if not malfeasance and dealt with accordingly.

IPC shall meet at least quarterly. Additionally, upon the issuance of a ten day notice to the other members, made at the request of the Chair of the Committee, IPC may convene at any time. IPC recommendation shall not issue from IPC absent a quorum of the Committee taking part in deliberations and recommendation. Three (3) members of the Committee shall constitute a quorum.

C. Executive Committee for Technology Development

The University's commercialization determination will be the primary responsibility of the ECTD. In this regard, ECTD will consult with OTC, IPC, independent scientific and technology transfer experts as needed and, as appropriate, other university officials and render a decision as soon as practicable on behalf of Kean, published to the appropriate parties, including the inventor(s), as to whether to file a patent application, the protective processes to be employed, and, when and as appropriate, the manner and method of commercialization intended.

1. Appeal of Commercialization Determination

If the inventor(s) disagree(s) with the determination concerning commercialization of the invention or discovery, the inventor(s) may, as the exclusive process for this type of challenge, appeal this determination to the President. This appeal, stating all the facts and bases for the inventor's position, must be in writing and filed within thirty (30) days following the date of notice of the determination being challenged. The President shall review the appeal and shall issue a decision setting forth the reasons therefore, if there is a substantial basis in fact, policy or law for either reconsideration or adjustment. The application will be remanded to ECTD for reconsideration based upon the President's decision. The decision of the President will be final and binding. Remand shall be available only once per ECTD review and accompanying Kean commercialization decision. In the case of a commercialization decision, the President's decision will be implemented.

2. Additional Responsibilities of ECTD

In addition to the ultimate commercialization determinations that are the responsibility of ECTD, it shall provide executive oversight of the program, directing concerns raised by interested parties (e.g. inventors, IPC, OTC, State of New Jersey, investors, labor constituents, legal counsel) to proper resolution, either through decision, publication and effectuation or through employing appropriate resources to resolve disputes or unsettled controversies. ECTD will provide expertise or identify those who are responsible for same and where appropriate, will identify and facilitate university authorized alternatives to matters brought before it.

NOTE: ECTD's responsibilities and concomitant authority do not subjugate standing policy and procedure for dispute resolution; it offers administrative streamlining services and, where appropriate, potential alternative(s) to standing practices and protocols.

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3. ECTD Composition

The ECTD shall be comprised of the following permanent members, or their designees:

- Provost And VP Academic Affairs (Permanent Chair)
- Executive Vice President, Operations
- Associate Vice President and General Counsel
- Dean, Office of Technology Commercialization

Additionally, consultative experts in scientific and technological, innovation and exploitation will be employed and engaged as needed to make effective recommendations for maximum utility of Kean's technology innovation, development, protection, and commercialization program.

4. Signatory Authority

The President of Kean, the incumbents in the positions comprising ECTD or their expressly specified designees, as set out in a signed written authorization, are the only officers and/or representatives of Kean authorized to bind Kean concerning any and all such matters under the jurisdiction of this policy. By way of illustration and not limitation, this includes assignment of ownership, sale of assets, acceptance of encumbrances, term and perpetual licensing of intellectual property, commitment of funds and engagement of legal and/or technology transfer services.

IX. Appeals

Appeals of an Intellectual Property decision must be made to the University's President (or designee) in writing within thirty (30) days of written notice of a decision. The determination made by the President or the President's designee constitutes the University's final decision regarding any appeal.

X. Review and Amendments to the Policy

The Intellectual Property Committee shall periodically review this policy. This policy may be amended at any time by the Kean University Board of Trustees or the Executive Committee of the Board of Trustees. Intellectual property that is already developed or under development at the time that an amendment to the policy is adopted will not be bound by the terms of the amendment without the voluntary written consent of both the author/creator/inventor and the University.

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