

Intellectual Property Policy

Southern Illinois University - System

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The purpose of this Intellectual Property Policy is to delineate the obligations of the persons that are governed by this SIU-S Intellectual Property Policy and those obligations of the Southern Illinois University – System (SIU-S). This Intellectual Property Policy does not apply to logos, identifiers or other branding materials related to SIU-S and/or its campuses. The Board encourages its faculty, staff and students employed or enrolled at Southern Illinois University Carbondale (SIUC), Southern Illinois University Edwardsville (SIUE), the Southern Illinois University School of Medicine (SIU-SOM) and the Southern Illinois University- System Offices (each of which shall be individually referred to as SIU Entity and shall encompass their respective satellite sites) to undertake research and other scholarly and creative endeavors. Basic policies of the Board support freedom of research and unrestricted dissemination of information. Research and other scholarly activities that produce and disseminate new knowledge are an important part of the work of a comprehensive academic institution. The philosophy of the Board is that such activities should always maintain an intrinsic relationship to the mission of the institution.

As a state institution, the Board of Trustees is responsible to itself and to the public for the kinds of research and other scholarly and creative activities that the Board supports and for obtaining the greatest public benefit from such research and activities. The Board therefore encourages faculty and staff to seek intellectual property protection when warranted. Such protection promotes investment that advances the development and availability of discoveries to maximize the public benefit achieved via faculty and staff research. All faculty and staff members are required by the conditions of their employment to abide by this Intellectual Property Policy.

Each SIU Entity may have its own intellectual property committee to assist in advising on the disposition of disclosures presented to the SIU System’s Office of Technology Transfer (OTT). The SIUC University Intellectual Property Committee’s composition and

authority is dictated by Addendum C collective bargaining agreement between the Board of Trustees of Southern Illinois University and the SIUC Faculty Association, IEA-NEA. Addendum C of that Agreement applies to tenured and tenure-track Faculty employees represented by the SIUC Faculty Association. For all other employees and students, the use of the University Intellectual Property Committee shall be at the discretion of the Vice Chancellor for Research. A School of Medicine Intellectual Property Committee, appointed by the Dean and Provost of the School of Medicine, exists to review and make recommendations for the disposition of intellectual property developed at the School of Medicine. The Associate Provost of Research at Southern Illinois University Edwardsville may convene an ad hoc intellectual property advisory committee based on his/her discretion for recommendations. The OTT shall govern this policy as it applies to the faculty, employees, administrators, staff, students and other persons under the auspices of the Board and shall advise each SIU Entity on matters related to the disposition of intellectual property assets that benefit the university and the community it serves as a whole.

The Intellectual Property Policy concerning new technologies, discoveries, inventions or potential inventions (including products, processes, or any improvements thereof) (hereinafter collectively referred to as “innovations”), and copyrightable materials that accrue from research or scholarly and creative activities conducted by faculty, employees, administrators, staff, students and other persons (hereinafter referred to as creator(s)/author(s)) is as follows:

I. Intellectual Property Covered by this Policy

This Intellectual Property Policy supersedes all previous policies that cover intellectual property matters at the individual SIU Entities and shall apply to all intellectual property (innovations and copyrightable materials as defined below). Furthermore, as a condition of their employment with the Board, all employees **will assign and hereby do assign** their ownership rights in intellectual property covered by this Intellectual Property Policy to the Board of Trustees of Southern Illinois University, pursuant to the details below.

A. Innovations:

Any innovation, including discovery, records (such as laboratory notebooks), data (including databases, tables and spreadsheets), trade secrets and know-how, developed by an employee, student, or other user of facilities or resources of the Board that meets the criteria detailed in this section belongs to the Board and shall be used and controlled according to the discretion of SIUC, SIUE, and SIU-SOM in ways that will produce the greatest benefit to the university and to the public. All employees are required to report any such innovation through their respective SIU Entity where the employee resides and the SIU Entity will determine the disposition thereof, in the manner set forth below.

Innovations include anything: 1) developed within the scope of an employee's duties; 2) developed in whole or in part by the use of University facilities or resources; 3) developed as the result of efforts carried on by, or under the direction

of, any employee, student, or other user of University facilities or resources; or 4) developed in part or in full from University funds or from funds under the control of or administered by the Board.

B. Copyrightable Material:

The Board shall not place any claim or restriction on any copyrightable material resulting from scholarly activity. Copyrightable materials include but are not limited to: 1) textbooks, workbooks, articles, online content and other forms of literary matter; 2) dramatic works and materials; 3) educational television/radio programs and works in such other media as films, videotapes, and recordings; 4) musical compositions and visual art; 5) tests and other measurement devices; and 6) computer software. Scholarly activity shall be defined as academic work done by the independent initiative of the copyright creator(s). These copyrightable materials shall be owned by the copyright creator. Examples of works that may be deemed scholarly activity include, but are not limited to:

- Classroom materials, including syllabi, notes, handouts, tests and other academic assessment devices;
- Educational courseware, including web-based and other electronic based materials, used on campus or in distance learning;
- Theses and dissertations;
- Articles, manuscripts and book chapters;
- Books, including textbooks, workbooks, scholarly monographs and anthologies;
- Works of non-fiction, fiction, and poetry;
- Educational television/radio programs and other works in audio-visual media;
- Musical compositions and performances;
- Dramatic works, including any accompanying music, pantomimes, and choreographic works;
- Pictorial, graphic, or sculptural works;
- Technologically based works such as blogs, tweets, and other forms of social media; and
- Other works of art that are not created as an institutional initiative.

Copyrightable material produced under specific written contract with the Board or copyrightable material that has a commercial application outside of the academic field belongs to the Board and shall be used and controlled according to the discretion of SIUC, SIUE, and SIU-SOM in ways that will produce the greatest benefit to the university and to the public. Copyrightable material produced under specific written contract means any copyrightable material which (1) a faculty or staff member prepares under the scope of his or her employment responsibilities with the Board and (2) falls under one of the following scenarios: (a) results in a commercially viable application, (b) is governed by a 3rd party sponsored research or work-for-hire contract, or (c) is commissioned by an SIU Entity or the Board.

II. Innovations Developed Independent of SIU-S

If an innovation is developed by an employee or student of the university outside the criteria as defined in Section I(A), it belongs to the employee or student. This would allow the creator/author to pursue his or her own intellectual property rights or to pursue joint intellectual property rights with the Board. In either case, detailed documentation should be kept by the creator/author about when, where, and by whom the innovation occurred. Such documentation may be needed to establish the rights of the creator/author to the innovation, as well as to pursue the pertinent intellectual property rights, in the event that the resources used to create or discover the innovation are not obvious.

If an innovation is developed by a non-paid student of the university independent of his or her interaction with the university, then the innovation is presumed to reside with the student. Intellectual property created as part of a course will belong to the Board when some or all of the course work involved is governed by a 3rd party agreement obligating the Board to assign or transfer intellectual property rights to the sponsoring entity or the student uses significant Board funding or resources. All paid students are considered employees of the Board and the innovation that occurred as a result of their employment shall be governed by Section I.A. If the non-paid student uses substantial funding or resources of the university such as lab equipment, materials, or faculty or staff mentorship, innovations developed by the use of this funding or resources shall be owned by the Board. Board affiliates, such as medical residents, unpaid adjunct professors, and students may petition the Board to support innovation that would otherwise be owned by the affiliate. In the event that the Board agrees to support the innovation, then the Board will support the intellectual property assets that may be secured as a result of their innovation in accordance with this policy. In the event of such support, the Board affiliate or student shall enjoy the income distribution as defined in Section VI.

III. Procedure for Disclosure and Approval

Innovations covered by this policy must be disclosed by the creator(s)/author(s) in writing to the Office of Technology Transfer (OTT). If the innovation is the subject of a contract, grant or sponsored research agreement, the OTT will dispose of the intellectual property asset consistent with the terms of the governing contract, grant or sponsored research agreement. When a request to evaluate an innovation is received, the OTT will then evaluate the innovation based on its protectability and likelihood of market success to develop a recommended course of disposition. The OTT will present their opinion related to the disposition of the innovation to the creator(s)/author(s). To ensure maximum protection and preservation of intellectual property rights, disclosure of an innovation to the OTT should occur **prior** to any publication or other public disclosure of the innovation. After review, the creator(s)/author(s) may elect to advance the disclosure for institutional approval through the appropriate advising committee, should one apply. In the event that the OTT believes the innovation has commercial merit and the creator(s)/author(s) elect not to advance the innovation for institutional approval, the OTT may advocate for the support and ownership of the innovation by SIU-S in place of the creator(s)/author(s).

The individuals authorized to approve institutional support for innovation protection and development shall be the Vice Chancellor for Research for SIUC (excluding SIU-SOM employees and students), the Dean and Provost of the School of Medicine for the SIU-SOM, and the Associate Provost for Research for SIUE. Collectively and individually, these administrators shall be referred to as “Senior Research Administrators” and “Senior Research Administrator” and their duties as outlined within this Intellectual Property Policy may be delegated. In the event that innovations are developed by personnel at more than one SIU Entity, the OTT shall have the discretion to decide which Senior Research Administrator to solicit for institutional support. The Senior Research Administrator shall have the discretionary right to use their institutional resources to support the protection and development of the intellectual property asset on the condition that ownership rights to those assets are assigned to the Board of Trustees of Southern Illinois University.

IV. Options for Disposition of Innovations

The Senior Research Administrators will determine the disposition of the innovation. In the event that an innovation has contributing work from more than one SIU Entity, a consensus on the appropriate disposition shall be sought from all Senior Research Administrators of which the innovation has a contributor. Such disposition may include, but is not limited to, the following options: A) release to the creator(s)/author(s) of a defined scope of intellectual property interest subject to the repayment clause at the end of this section; B) retention by the university for development, licensing, etc.; or C) release to the individual or agency sponsoring the project in the course of which the innovation was made. The release will only be limited to the innovation that was disclosed to the OTT. Upon request by the creator(s)/author(s), any disposition decision for an innovation may be reconsidered by the procedure outlined in Section III based on further developments that occur after the initial disposition decision is made.

The OTT will provide the creator(s)/author(s) an evaluation within three (3) months from the date of the received evaluation request form. Should the creator(s)/author(s) elect to have the appropriate SIU Entity pursue the innovation, the creator(s)/author(s) shall be notified of the disposition decision within three (3) months of that election. Should the OTT or the SIU Entity fail to adhere to either of these three month time periods, the creator(s)/author(s) may petition OTT to relinquish all rights or portion thereof in any intellectual property interests that have been established. Often, the OTT works with the creator(s)/author(s) to work out a plan to enhance the likelihood of institutional support. Under this scenario, the time periods discussed above may take longer than three months and the OTT may elect not to support the relinquishment of the rights of the university’s intellectual property interest. At any time, the Senior Research Administrator on the respective SIU Entity shall have the ultimate decision making authority to relinquish the university’s rights in the innovation. Should any intellectual property be returned to the creator(s)/author(s), the creator(s)/author(s) shall be required to repay the appropriate SIU Entity for its sunk intellectual property costs subject to the creator(s)/author(s) profiting from said

intellectual property. The recovery of these sunk intellectual property costs, including those internal costs as defined and accounted for in the published fee schedule, may be recovered in a manner or waived altogether as deemed appropriate by the Senior Research Administrator.

V. Impact of Grants and Contracts on Intellectual Property Rights

Grants/contracts between the Board and any other agency shall, whenever feasible, state clearly the obligations and rights of the Board and of the cooperating agency, and the procedure to be followed should the activity result in innovations. Grants and contracts from various agencies frequently require the agency's prior approval of the terms and conditions of intellectual property agreements dealing with the development and dissemination of products resulting from activities performed under the grant/contract. In such cases, the OTT shall assist as applicable in negotiating with the sponsoring agency about future intellectual property rights and licensing agreements. Situations not specified in the agreement with the sponsoring agency will be subject to this Intellectual Property Policy.

If innovations are created with federal funding, the federal government will retain various rights in intellectual property created with the support of that federal funding. If an innovation is retained by the Board, then the Board will be responsible for compliance with all federal regulations. If an innovation is released to the creator(s)/author(s), then the creator(s)/author(s) will be responsible for compliance with all federal regulations.

VI. Income Distribution

If revenue is received by the Board from any intellectual property rights (patents, copyrights, technology products, trade secrets, trademarks, trade dress, etc.) associated with an innovation or commercial application outside of the academic field, all costs of procuring, developing, and administering such intellectual property rights, as well as costs for license agreement(s) and consulting services associated with those rights, shall first be paid from such revenue. Such costs may further include substantial undertakings by the OTT such as drafting patent applications and are subject to a fee schedule as outlined in Section VII. All income in excess of such expenses shall be distributed amongst the creator(s)/author(s), the SIU Entity from which the innovation was generated and creator/author's college/school and department. The creator(s)/author(s) shall receive 45%, the SIU Entity from which the innovation was generated shall receive 45%, the creator/author's college/school shall receive 5% and the creator/author's department shall receive 5% of net income received. If the creator/author does not report to a department (i.e. such as an administrative employee), then the unit to which the creator/author resides shall receive 5% of the income received, the SIU Entity from which the innovation was generated shall receive the other 50% and the creator/author shall receive 45%. If the creator/author is a Board affiliate, then the SIU Entity shall receive 55% and the Board affiliate shall receive 45% of income received.

Multiple creators/authors sharing in income shall decide among themselves how their share is to be divided, with the stipulation that the creators/authors shall divide one share of the 45% interest defined above. The allocation of the share among multiple creators/authors should be reported to the OTT at the time the creators/authors elect to proceed with seeking institutional support for their innovation. If the allocation of the share is not reported, the share will be allocated equally among all creators/authors. Income allocation for each distinct innovation is a one-time, irrevocable decision.

VII. Services Performed by the OTT

As warranted, the OTT may submit and prosecute patent applications with the United States Patent and Trademark Office. Those services constitute an internal cost for effort and shall be subjected to a fee schedule as published by the OTT after approval by the Senior Research Administrators. Those costs shall be recovered by the SIU Entity from which the innovation originated before a distribution is made as outlined in Section VI.

VIII. Responsibility of Creator(s)/Author(s) Regarding Intellectual Property Rights

If the Board elects to retain ownership in an innovation, the creator(s)/author(s) shall supply on a timely basis all information and execute all papers necessary for: A) preparing and/or pursuing intellectual property rights; B) pursuing and/or executing licensing agreements; and C) executing formal assignment documents for such innovations covered under this policy.

IX. Resolution of Controversy between SIU-S and Creator(s)/Author(s)

Any controversy or claim arising out of this statement of policy, or an agreement between the creator(s)/author(s) and the Board delineating individual and Board rights, claims, and responsibilities, or the breach thereof, shall follow the internal grievance procedures of the SIU Entity to which the creator(s)/author(s) report. If no agreement results from internal grievance procedures, the parties may seek resolution through mediation with an experienced mediator, who has knowledge of intellectual property matters and, preferably, experience with institutions of higher education. Neither party will unreasonably withhold consent to the selection of a mediator. The parties will share equally in the costs of mediation, and each party will be responsible for its own attorneys' fees, if any..

X. Amending this Policy

Any amendment to this policy shall be subject to consultation by an IP Policy Advisory Group that shall comprise of the Director of Office of Technology Transfer and the Senior Research Administrators and two faculty representatives from each SIU Entity as appointed by the Senior Research Administrators. The faculty representatives shall have at least one invention disclosure on file with the OTT and have generated copyrightable material. The Board reserves, and shall have, the ultimate authority to approve the amendment as presented by IP Policy Advisory Group.

Board Policy