

# UA Huntsville Patent Policy

(Appendix G of the Faculty Handbook)

From the University of Alabama Board of Trustees Manual

## 509. Patent Policy

### I. Purpose

In view of the far-reaching research on the various campuses of The Board of Trustees of The University of Alabama (hereinafter referred to as University), it is inevitable that new discoveries and inventions will be made. The members of the Board of Trustees (hereinafter referred to as the Board) recognize the importance of obtaining the greatest public benefit and usefulness from the products of the University's scientific research and inventiveness, and that the protection and control provided under patent laws or other legal means for the protection of property rights may be necessary to obtain this goal. It is further recognized that employees of the University need assistance in determining and evaluating patentability and in prosecuting patent applications for or otherwise protecting inventions made by them. Furthermore, many such inventions involve equities beyond those of the inventor since the use of University facilities, the assignment of duties as a condition of employment, and the use of research funds with contractual obligations regarding patent rights give rise to questions concerning the rights and equities of all concerned. The purpose of this patent policy is to establish a mechanism to serve the public benefit and interest, to determine and apprise all concerned parties of relative rights and equities, to facilitate patent applications, the licensing of inventions, the equitable distribution of any royalties or other financial returns, to provide necessary uniformity in patent matters, and to provide for adequate reporting of patent activities.

### II. Policy and Procedure

**A.** It shall be the policy of the Board to encourage the concept that patentable inventions produced at the University shall be used for the greatest possible public benefit and to provide every reasonable incentive to the faculty, students and staff for the disclosure, evaluation and dissemination of such inventions. When University support makes the research effort possible or when it provides support for the development of a patentable invention, it is reasonable for the University to participate in the fruits of such development, including reimbursement for its costs. To that end, the University encourages the procurement of patents for such inventions and the licensing or other commercialization thereof in the interest of the public, the inventor, and the University.

**B.** The President of each campus shall appoint an officer or Patent Committee or designate a non-profit organization established for the benefit of the campus to administer this policy. Each campus President may promulgate additional regulations and guidelines pursuant to this Policy to administer this policy within his/her respective campus.

**C.** This patent policy of the University, as amended from time to time, shall be deemed to be a condition of employment and contractual obligation, both while employed and thereafter, of every employee of each campus, including student employees, and a condition of enrollment and attendance and contractual obligation, both while in attendance and thereafter, by every student at each campus.

**D.** Any invention or discovery (1) which is the result of research carried on by or under the direction of an employee of a campus of the University and/or having the costs thereof paid from funds provided by, under the control of or administered by a campus of the University, or (2) which is made by an employee of a campus of the University and which relates to the employee's field of work, or (3) which has been developed in whole or in part by the utilization of resources or facilities belonging to a campus of the University, shall be the property of the applicable campus of the University. The applicability of the above stated criteria to any invention or discovery will be determined at the sole discretion of the President of the respective campus of the University or his/her designee.

**E.** As a condition of their employment by or enrollment at a campus of the University, each faculty member, employee and student agrees that he/she shall be contractually bound by this patent policy as implemented by the respective campuses of the University and shall report to the officer or non-profit organization so designated by the President of the campus of the University to manage and commercialize such inventions and discoveries with respect to that campus, any invention or discovery which such faculty member, employee or student has conceived, discovered, developed and/or reduced to practice by them or under their direction at any time following their initial appointment by, employment by, or enrollment with that campus of the University. All inventions and discoveries that meet the criteria of II.D. shall be automatically assigned to the University for the benefit of the appropriate campus of the University immediately upon creation or discovery or reduction to practice of the invention or discovery. The President of each campus of the University is authorized to further assign any invention or discovery it is deemed to own pursuant to this policy to a designated nonprofit organization established for the benefit of the respective campus of the University, which said assignment shall be conditioned on full compliance with this policy, regulations promulgated hereunder by the Board or by the President of the respective campus of the University, and appropriate state and federal law.

**F.** If the invention or discovery is one which is determined to be owned by a campus of the University, the President of the applicable campus or his/her designee shall further evaluate the invention or discovery and determine if and how best to develop, commercialize and protect the invention as he/she deems appropriate, including, but not limited to, applying for patent protection, or requesting further development of the invention or discovery. In making this determination, the benefits that might accrue to both the campus of the University and the inventor(s) shall be considered. The designee shall act promptly in carrying out these duties so that the rights of the inventor(s) and the campus of the University may be protected.

**G.** If it is determined that the invention or discovery is one which is owned by the University pursuant to this policy but is one in which a campus of the University has no interest in retaining ownership, a campus of the University (or the non-profit organization to which an invention may

have been assigned in accordance with the terms of this policy) may, but is under no obligation to, release its ownership rights to the inventor(s) on terms and conditions determined by the President or his/her designee, subject to any third party rights.

**H.** In consideration of the automatic assignment of ownership set forth in this policy, the Presidents or their designees are authorized to pay to the inventors, their heirs or assigns, a percentage of the royalties, fees, or other financial returns received by the campus of the University (or the non-profit organization to which an invention may have been assigned in accordance with the terms of this policy) from such invention after a deduction of fifteen percent (15%) thereof for overhead costs, plus a deduction for costs of patenting and protection of intellectual property rights and any unusual expenses paid by the campus or its non-profit designee or the inventor (which have been approved by the campus or its non-profit designee). Each campus President shall be responsible for the development of a policy governing the percentage of royalties, fees, and other financial returns on an invention paid to the inventor and governing the internal distribution of the campus of the University's share of such financial returns.

**I.** It is understood that many research contracts, grants, and consulting agreements from or with the United States Government or its agencies, corporations, or individuals contain ownership of intellectual property clauses that may be at variance with this policy but which, if agreed to, require compliance. Such documents which are at variance with this policy may be referred to the appropriate designated officer of the campus for recommendations prior to approval.

**J.** Annual reports of patent matters will be made to the Chancellor for his/her information and that of the Board within thirty days (30) following the end of each fiscal year, to include as a minimum identification of each patent and patent applied for, the distribution of patent revenue including the share going to the inventor, and the expenses of obtaining and managing patents. The Chancellor may prescribe appropriate formats for such reporting.

(Adopted February 23, 1980 as Rule 510; amended September 16, 1981, February 27, 1986; renumbered December 5, 1997; amended June 19, 2009.)