

Effective

**WILKES UNIVERSITY INTELLECTUAL PROPERTY POLICY:  
RECOMMENDATIONS OF THE IP TASK FORCE**

**Task Force Members:**

**2.7. Staff.** Staff shall mean any employee of the University other than members of the

- C. The material subject to copyright or trademark was created outside the scope of employment or contract by the member(s) of the Staff or Contractor(s).

### **3.3. General Rule – Patent.**

**3.3.1. Faculty and Students.** The University shall be the owner of all patents and patent applications that disclose and claim inventions (including but not limited to software inventions) made or conceived by member(s) of the Faculty or Student(s) subject to the exceptions provided in section 3.4.1.

**3.3.2 Staff and Contractors.** The University shall be the owner of all patents and patent applications that disclose and claim inventions (including but not limited to software inventions) made or conceived by member(s) of the Staff or Contractor(s) in the course of performing services for which they were hired by the University, subject to the exceptions provided in section 3.4.2. Any obligation to assign ownership of patents resulting from contract work must be explicitly expressed in the contract and must receive approval of the Provost.

**3.3.3. Execution of Documents.** At the request of the University, the Inventor(s) shall execute assignments or other documents assigning to the University all rights in patents; to the extent such patents are not subject to any exception set forth in Sections 3.4 below.

### **3.4. Patent Exceptions.**

**3.4.1. Faculty and Student.** Member(s) of the Faculty or Student(s) shall be the owner of all patents and patent applications that disclose and claim inventions (including but not limited to software inventions) made or conceived by member(s) of the Faculty or Student(s) where any of the following conditions apply:

- A. Member(s) of the Faculty or Student(s) has expressly contracted with the University to invent or discover the subject matter to which the patent and/or patent application is directed and the University has agreed to provide member(s) of the Faculty or Student(s) with all or some proprietary interest in the patent or patent application; or
- B. The University has voluntarily transferred the patent or patent application, in whole or in part, to the member(s) of the Faculty or Student(s); or
- C. The subject matter of the patent or patent application was invented or discovered by the member(s) of the Faculty or Student(s) outside the scope of employment of the Faculty member or outside the scope of the Student relationship to the University; or
- D. The University actually or constructively abandons the patent or patent application or commercialization of the patent or patent application by failing to take all appropriate actions in a timely and reasonable manner. In such a case the University shall execute all appropriate documents to vest ownership of the patent in the member(s) of the Faculty or Student(s).

**3.4.2. Staff and Contractor.** Member(s) of the Staff or Contractor(s) shall be the owner of all patents and patent applications that disclose and claim inventions (including but not limited to software inventions) made or conceived by the Staff or Contractor(s) where any of the following conditions apply:

- A. The member(s) of the Staff or Contractor(s) has expressly contracted with the University to make the subject matter of the patent or patent application and the University has agreed to provide the member(s) of the Staff or Contractor(s) with all or some proprietary interest in the patent or patent application; or
- B. The University has voluntarily transferred the patent or patent application, to the member(s) of the

4.4[C], below.

- B. Making decisions, taking into consideration any pertinent IPC recommendations under Section 4.2[C], as to whether the University should exploit the disclosed IP or otherwise cede the IP to the Author(s), Creator(s), or Inventor(s) if the IP is not to be exploited by the University based upon the recommendation of the IPC, and to communicate such decisions to the IPC and to the Author(s), Creator(s), or Inventor(s).

**4.4. Duties of Author, Creator and Inventor.** Author(s), Creator (s) and Inventor(s) shall, to the extent consistent with this policy, do the following:

- A. Disclose promptly the creation of University-owned IP to their respective supervisor (in the case of member(s) of the Staff), or department chair (in the case of member(s) of the Faculty), or instructor (in the case of Student[s]). Furthermore, in the case of member(s) of the Faculty, disclosure may take the form of information shared on an annual basis in connection with the faculty self-evaluation report (as defined in the *Faculty Handbook*). Supervisors, department chairs, and instructors shall promptly notify the IPC of the creation of University-owned IP. Such disclosure shall include disclosure of the identity(ies) of all individuals involved in the process that produced the work.

policy, for University sponsorship similar to that described in this section. In cases where the IPC decides that the University should move forward with a patent application that is fully or partially owned by the University, the University may require a delay of at least 90 days before the IP can be publicly disclosed or submitted to any third party including for purposes of any form of disclosure.

**6. Appeals.** An individual who is subject to this policy shall have the right to appeal any decision of the Provost with respect to such IP to the President. Such appeal shall be initiated in writing upon receipt of the decision rendered by the Provost. The appeal shall include detailed facts supporting the requested change in the decision. The President shall consider the information included in the appeal. The \_\_\_\_\_ shall be final and may be communicated to the appellant.

**7. Fees & Costs.** Fees and costs incurred in connection with any dispute surrounding the application of this policy shall be borne by the respective parties to that dispute.