

Authority: Approved by the President

Chapter 14 Intellectual Property and Technology Transfer

14.1 Policy

Although the research and teaching missions of the OIST Graduate University (the University) take precedence over development of intellectual property, the University recognizes that its teaching and research have the potential to generate an array of new ideas, processes, materials, devices and the like, which may be of benefit to the larger world as well as to the University.

Owners of qualifying new or novel ideas, processes, materials, devices, creations, and discoveries may be granted exclusive rights to use and commercialize their intellectual property. Thus, intellectual property has the potential to generate unrestricted income to support the University's research and education. After its faculty, students, staff and other human resources, intellectual property is the University's most important asset.

Consequently, all intellectual property (IP) conceived, created, developed, or first reduced to practice in whole or in part by members of the University's faculty (including student employees) or staff in the course of their University responsibilities, or with more than incidental use of University resources (which may be the case with visiting scholars and others not in the University's employ), belongs to the University unless otherwise provided. All members of the University community are expected to preserve, manage and protect IP in the same manner as they would for any other University asset. Even an invention that may not be patentable for any reason may still be valuable and important - for example, as a trade secret [\[link: 14.8.9\]](#) or as technical "know-how."

It is University policy that royalties and similar remuneration deriving from its IP shall be shared [\[link: 14.3.7.3\]](#) with the inventor/author.

In addition to faculty and staff (including student employees), the provisions of the University's IP policy extends to:

- All graduate students and postdoctoral fellows, and
- Non-employees who participate in research projects at the University (e.g., visiting faculty, industrial personnel, fellows, etc.).

14.2 General Considerations

14.2.1 Confidentiality Obligations.

Nondisclosure and Confidentiality Agreements raise significant concerns. The terms of such an agreement may conflict with the University's Openness in Research Policy [\[link: 1.3.1\]](#). A contractual commitment to keep information secret can severely restrict the ability of University faculty to pursue research in the manner they choose and can make it impossible for the University to protect ideas and inventions deriving from the work of its faculty and researchers. Once signed, any violation of a nondisclosure or confidentiality agreement can result in an injunction or monetary damages being assessed against the discloser. It is imperative that the General Counsel [\[link: 2.5\]](#) be consulted whenever it appears that the University may be the recipient of information or items that are proprietary, confidential, or otherwise subject to a promise not to disclose. It is forbidden to sign or otherwise bind the University to a confidentiality obligation without first having obtained written approval from the General Counsel.

14.2.2 Intellectual Property

"Intellectual Property" includes, among other things, new or novel devices, processes, compounds, materials, and authored works (such as software) that may be eligible for protection under laws governing patents [\[link: 14.8.6\]](#), copyrights [\[link: 14.8.2\]](#), trademarks [\[link: 14.8.10\]](#), and trade secrets [\[link: 14.8.9\]](#).

14.2.3 More than incidental use of University resources

"More than incidental use of University resources" [\[link: 14.8.5\]](#) refers to more than minimal use of specialized, research-related facilities, equipment, supplies, or staff provided by the University for academic purposes, as well as significant use of "on-the-job" time.

The occasional and infrequent use of the following would typically not constitute "more than incidental use of University resources":

- Routinely available, office-type equipment, including desktop computers and commercially-available software, and
- Reference materials or other resources collected on the University campus, and which are generally available in non-University locations.

14.2.4 Assignment of Rights

If the Technology Licensing Section (TLS) cannot, or decides not to, proceed in a timely manner to patent and/or license an invention, TLS may assign ownership to the inventor or inventors upon request to the extent possible under the terms of any agreement with a sponsoring agency that supported or related to the work. In such cases, the inventor may request and be granted rights by the sponsoring agency to an invention made under such an agreement provided that a well-conceived and detailed plan for commercial development accompanies the request.

14.2.5 Public Domain

Following consultation with the TLS, the inventor, or inventors acting collectively when there are more than one, may place inventions in the public domain [\[link: 14.8.7\]](#) if that would be in the best interest of technology transfer and if doing so is not in violation of the terms of any agreements that supported or governed the work. The University will not assert IP rights when inventors have thus placed their inventions in the public domain.

14.2.6 Reports

Agencies sponsoring research at the University usually require reports of all inventions, whether or not they are considered patentable.

14.3 Rules

14.3.1 Duty to Disclose Potential IP

All potentially patentable inventions or copyrightable works that were conceived or first reduced to practice in whole or in part by members of the faculty or staff (including student employees) of the University in the course of their University responsibilities, or with more than incidental use of University resources, must be disclosed on a timely basis to the University, through its TLS using the form “Invention Disclosure Form [\[link: 14.6\]](#)”.

14.3.1.1 Graduate students, postdoctoral fellows, visiting researchers and scientist, and other non-employees must disclose to the University all potentially patentable inventions conceived or first reduced to practice in whole or in part in the course of participation in research projects at the University, or with more than incidental use of University resources.

14.3.1.2 Title to such inventions shall be assigned to the University (PCA) [\[link: 14.6\]](#), regardless of the funding source.

14.3.2 Confidentiality Obligation

No member of the University may sign an agreement binding the University to a confidentiality obligation without first obtaining written approval to do so from the General Counsel (See 14.2.1 [\[link: 14.2.1\]](#)).

14.3.3 Royalty Sharing

The University shall share royalties [\[link: 14.3.7.3\]](#) from inventions assigned to the University with the inventor in accordance with provisions set out elsewhere in this Policy.

14.3.4 Assignment of Ownership

(See 14.2.4 [\[link: 14.2.4\]](#)).

14.3.5 Waivers

Waivers of the provisions of this policy may be granted by the President or the President's designate on a case-by-case basis, giving consideration to, among other things, the University's obligations to sponsors, whether the waiver would be in the best interest of technology transfer, whether the waiver would be in the best interest of the University, and whether the waiver would result in a conflict of interest. In addition, the President may expand upon these provisions and shall adopt rules, based on the same factors as well as appropriateness to the University's relationship with inventors, for the ownership of potentially patentable inventions created or discovered with more than incidental use of University resources by students when not working as employees of the University, by visiting scholars and by others not in the University's employ.

14.3.6 Rules Regarding Patents

14.3.6.1 Patent Agreements. All faculty, staff, student employees, graduate students and postdoctoral fellows must sign the OIST Graduate University Patent and Copyright Agreement ("PCA") [\[link: 14.6\]](#) at the time of their assignment. In addition, non-employees who participate or intend to participate in research projects at the University must also sign a PCA.

A variation of this agreement has been created for individuals with prior obligations regarding the disclosure and assignment of

intellectual property. See, “OIST Graduate University Patent & Copyright Agreement for Personnel at OIST Graduate University Who Have a Prior Existing and Conflicting Intellectual Property Agreement with Another Employer (PCA2) [\[link: 14.6\]](#)”. Each hiring division is responsible for getting a PCA, or PCA2, signed at the time of the individual's initial association with the University.

14.3.6.2 Invention Disclosures [\[link: 14.8.4\]](#). Inventors must prepare and submit on a timely basis an invention disclosure for each potentially patentable invention conceived or first actually reduced to practice in whole or in part in the course of their University responsibilities or with more than incidental use of University resources. An Invention Disclosure Form [\[link: 14.6\]](#) describing the invention and including other related facts should be prepared by the inventor and forwarded to TLS. TLS shall decide whether the invention should be evaluated at the Business Potential Evaluation Committee [\[link: \]](#) in 10 business days.

14.3.6.2.1 Practical Considerations. Individuals covered by this policy are expected to apply reasonable good faith judgment as to whether a new finding may qualify as an invention [\[link: 14.8.3\]](#) to be disclosed to the University for evaluation for potential patentability. The TLS will decide whether to convene the Business Potential Evaluation Committee to evaluate the value of the invention with appropriate professional expertise at the earliest possible date.

14.3.6.2.2 Value of Unpatented Inventions. An invention, although not patentable for any reason, may still be valuable and important - for example, trade secrets and technical “know-how” encompassing proprietary information of a valuable and confidential nature. Agencies sponsoring research at the University usually require reports of all inventions, whether or not they are considered patentable.

14.3.7 Patent Licensing

The University encourages the development of inventions and technology resulting from University research by industry for public use and benefit. It recognizes that protection of proprietary rights in the form of a patent or copyright are often necessary - particularly with inventions derived from basic research - to encourage a company to risk the investment of its

personnel and financial resources to develop the invention. In some cases an exclusive license may be necessary to provide an incentive for a company to undertake commercial development and production. Nonexclusive licenses allow several companies to exploit an invention.

Not all inventions are patentable. Questions relating to patentability are often complex and usually require professional assistance. Nonetheless, it can be said that an important criterion of patentability is that an invention must not be obvious to a person with ordinary skill in that particular field. It must also be novel, in the sense that it not have been previously publicly known or used by others or patented or described in a printed publication anywhere.

14.3.7.1 Priorities. The research and teaching missions of the University always take precedence over patent considerations. While the University recognizes the benefits of patent development, it is most important that the direction of University research not be established or unduly influenced by patent considerations or personal financial interests. This priority to research and teaching does not exonerate inventors of their obligation to disclose inventions to TLS.

14.3.7.2 Responsibility for Licensing. The TLS handles the evaluation, marketing, negotiation and licensing of University-owned inventions with commercial potential.

14.3.7.3 Royalty Distribution and Equity Participation. Cash royalties and equity participation shall be handled, in principle, as set forth below.

14.3.7.3.1 Cash Royalties. After deductions for TLS expenses, royalty income is divided one-third to the inventor, one-third to the inventor's laboratory, and one-third to the University. When more than one laboratory is involved, the inventor shall designate the distribution of the one-third allocated for the laboratory based on support of the work. If the inventor's laboratory dissolved, the University shall assign the distribution of the laboratory to the University.

14.3.7.3.1.1 A deduction of 15% to cover the administrative overhead of the TLS is taken from gross

royalty income, followed by a deduction for any directly assignable expenses, typically patent filing fees.

14.3.7.3.1.2 Disagreements involving royalty distribution will be reviewed and resolved by the TLS; involved parties may appeal the TLS resolution to the President.

14.3.7.3.2 Equity Participation. The University may at times accept equity from a corporate licensee as part of the licensing agreement (all other cash payments, including royalties based on sales, will be distributed in accordance with the provisions of 14.3.7.3.1, above.)

14.3.7.4 Loss of Patentability. Inventions that are patentable initially may become non-patentable for a variety of reasons. An invention becomes non-patentable if a formal application is not filed with the Patent Office within a prescribed period of time of disclosure in a publication or of any other action that results in the details of the invention becoming generally available.

14.3.7.5 Filing for International Patent Protection. International patent protection is important for industry to develop its product world-wide. An International Patent application may be executed through the Patent Cooperation Treaty (PCT) route. The PCT procedure has many advantages for the applicant, including giving the applicant up to 18 months to seek protection in foreign countries.

14.3.8 Rules Regarding Copyright

Copyright is the ownership and control of the intellectual property in original works of authorship, including software, which are subject to copyright law. It is the policy of the University that all rights in copyright shall remain with the creator unless the work is a “work-for-hire” (the contract for the work stipulates that copyright vests in the University), is supported by a direct allocation of funds through the University for the pursuit of a specific project, is commissioned by the University, makes more than incidental use of University resources or personnel, or is otherwise subject to contractual obligations.

The Copyright Policy of the University is intended to accomplish the following:

- Enable the University to foster the free and creative expression and exchange of ideas and comment;
- Preserve traditional University practices and privileges with respect to the publication of scholarly works;
- Establish principles and procedures for sharing income derived from copyrightable material produced at the University; and
- Protect the University's assets and imprimatur.

All faculty, staff, student employees, graduate students and postdoctoral fellows, as well as non-employees who participate or intend to participate in teaching and/or research or scholarship projects at the University are bound by this policy. They are also required to sign a Patent & Copyright Agreement (PCA or PCA2) [\[link: 14.6\]](#). The PCA assigns, with certain exceptions, rights to copyrightable works resulting from University projects to the University. However, this policy applies, and those subject to this policy are deemed to assign their rights to copyrightable works, whether or not a PCA is signed and is on file. Royalty income received by the University for such works will normally be distributed in accordance with University policy set forth below. Physical embodiments of copyrightable works may also be subject to the University's Tangible Research Policy [\[link: 14.3.9\]](#).

14.3.8.1 Scope of Copyright Protection. Copyright protection does not extend to any idea, process, concept, discovery or the like, but only to the work in which it may be embodied, illustrated, or explained. For example, a written description of a manufacturing process is copyrightable, but the copyright only prevents unauthorized copying of the description; the process described could be freely copied unless it enjoys some other protection, such as patent. Subject to various exceptions and limitations provided for in the copyright law, the copyright owner has the exclusive right to reproduce the work, prepare derivative works, distribute copies by sale or otherwise, and display or perform the work publicly. Ownership of copyright is distinct from the ownership of any material object in which the work may be embodied. For example, if one purchases a videotape, one does not necessarily obtain the right to make a public showing for profit.

14.3.8.1.1 Books, Article, and Similar Works, including Non-

patentable Software. Except to the extent set forth in this Chapter, the University does not claim ownership to pedagogical, scholarly, or artistic works, regardless of their form of expression. Such works include those of students created in the course of their education, such as dissertations, papers and articles. The University claims no ownership of popular nonfiction, novels, textbooks, poems, musical compositions, non-patentable software, or other works of artistic imagination, which are not institutional works and did not make significant use of University resources or the services of University non-faculty employees working within the scope of their employment.

14.3.8.2 Institutional Works. The University shall retain ownership of works created as institutional works. Institutional works include works that are supported by a specific allocation of University funds or that are created at the direction of the University for a specific University purpose. Institutional works also include works whose authorship cannot be attributed to one or a discrete number of authors but rather result from simultaneous or sequential contributions over time by multiple faculty and students. For example, software tools developed and improved over time by multiple faculty and students where authorship is not appropriately attributed to a single or defined group of authors would constitute an institutional work. However, the mere fact that multiple individuals have contributed to the creation of a work does not, in-and-of itself, compel the conclusion that the work constitutes an institutional work.

14.3.8.3 Works of Non-Employees. Works by non-employees, such as consultants, independent contractors, etc. (“third-party non-employees”) generally are owned by the creator and not by the University, unless there is a written agreement to the contrary. However, as it is University policy that the University obtains ownership of such works, the University will generally require a written agreement from third-party non-employees that ownership of such works will be assigned to the University and the third-party non-employees will agree not to prevent the University from freely using and licensing the copyrighted material. All faculty, staff, student employees, graduate students and postdoctoral fellows, as well as non-employees who participate or intend to participate in

teaching and/or research or scholarship projects at the University are required to contact the General Counsel immediately to execute a proper agreement with any third-party non-employees. Examples of works which the University may retain third-party non-employees to prepare are:

- Contract Research
- Reports by consultants or subcontractors
- Computer software
- Architectural or engineering drawings
- Illustrations or designs
- Artistic works

14.3.8.3.1 As discussed in Chapter 21, Use of University Resources [\[link: 21\]](#), the University's resources are to be used solely for University purposes and not for personal gain or personal commercial advantage, nor for any other non-University purposes. Therefore, if the creator of a copyrightable work makes more than incidental use [\[link: 14.8.5\]](#) of the services of University non-faculty employees or University resources to create the work, he or she shall disclose the work to the TLS and assign title to the University. Questions about what constitutes incidental use should be directed to the Executive Vice President for Technology Development and Innovation .

14.3.8.4 Open Source Software. The University encourages the exploration of open source software solutions in any areas of application for research use. The University provides, for software intended for distribution under an open source license, a general waiver of the policy that the IP rights in software reside with the University and must not be distributed without explicit permission. The University encourages all staff members involved in software development for research purpose to make that software available under Open Source license terms (for example, the GNU General Public License), and to contribute, as appropriate, to existing open source software projects.

14.3.8.5 Videotaping and related Classroom Technology. Courses taught and courseware developed for teaching at the University belongs to the University. Any courses that are videotaped or recorded using any media are property of the University, and may

not be further distributed without permission from the Dean of Graduate School. Blanket permission is provided for evanescent video or other copies for the use of students, or for other University purposes. Prior to videotaping, permission should be obtained from anyone who will appear in the final program as well as from the Vice President for Communications and Public Relations (Chapter 16[[link: 16](#)]).

14.3.8.6 Contractual Obligations of the University. This Copyright Policy shall not be interpreted to limit the University's ability to meet its obligations for deliverables under any contract, grant, or other arrangement with third parties, including sponsored research agreements, license agreements and the like. Copyrightable works that are subject to sponsored research agreements, or other contractual obligations of the University, shall be owned by the University, so that the University may satisfy its contractual obligations.

14.3.8.7 Reconveyance of Copyright to Creator. When copyright is assigned to the University because of the provisions of this policy, the creator of the copyrighted material may make a request to the General Counsel that ownership be reassigned to the creator. Such a request can, at the discretion of the General Counsel, be granted if it does not:

- (i) violate any legal obligations of or to the University,
 - (ii) limit appropriate University uses of the materials,
 - (iii) create a real or potential conflict of interest for the creator,
- or
- (iv) otherwise conflict with University goals or principles.

14.3.8.8 Administration of Policy. Questions of ownership or other matters pertaining to materials covered by this policy shall be resolved by the General Counsel.

14.3.8.9 Licensing and Income Sharing. The TLS seeks the most effective means of technology transfer for public use and benefit and, toward that end, is responsible for the evaluation, marketing, negotiation and licensing of University-owned inventions or copyrightable materials with commercial potential. Computer databases, software and firmware, and other copyrightable works owned by the University, are licensed through TLS. Exceptions to

this procedure must be approved in advance by the Executive Vice President for Technology Development and Innovation.

14.3.8.10 Royalty Distribution. Royalties will normally be allocated in accordance with the University's policy set out in this Chapter under Royalty Distribution & Equity Participation [\[link: 14.3.7.3\]](#). If copyright protection alone is claimed, royalties normally will be allocated in a similar manner, with the "inventor's share" allocated among individuals identified by the relevant faculty member (or project head if not under a sponsored agreement), based on their relative contributions to the work. Where royalty distribution to individuals would be impracticable or inequitable (for example, when the copyrightable material has been developed as a laboratory project, or where individual royalty distribution could distort academic priorities), the "inventor's share" may be allocated to a research account in the laboratory where the copyrightable material was developed. If the inventor's laboratory dissolved, the University shall assign the distribution of the laboratory to the University. Such determination will be made on a case-by-case basis by the TLS after consultation with the faculty member or the Dean of Research , and is subject to the approval of the Executive Vice President for Technology Development and Innovation.

14.3.8.11 Assignments. No assignment, license or other agreement may be entered into or will be considered valid with respect to copyrighted works owned by the University except by an official specifically authorized to do so.

14.3.8.12 Use of the University Name in Copyright Notices (See Chapter 16 "External and Internal and Public Relations"[\[link: 16\]](#)). No other institutional, department, laboratory, or project name is to be used in the copyright notice, although the name and address of the laboratory or project to which readers can direct inquiries may be listed below the copyright notice. The date in the notice should be the year in which the work is first published, i.e., distributed to the public or any sizable audience. Additionally, works may be registered with the Copyright Office using its official forms. Forms may be obtained from the TLS, to which questions concerning copyright notices and registration also may be addressed.

14.3.8.13 Copying of Works Owned by Others. Members of the University community are cautioned to observe the rights of other copyright owners. Contact the Dean of the Graduate School's office or the General Counsel concerning policies pertaining to copying for classroom use. Policies regarding copying for library purposes may be obtained from the office of the University Librarian (Chapter 6.3.4[\[link: 6.3.4\]](#)).

14.3.8.14 Sponsored Agreements. Contracts and grants frequently contain complex provisions relating to copyright, rights in data, royalties, publication and various categories of material including proprietary data, computer software, licenses, etc. Questions regarding the specific terms and conditions of individual contracts and grants, or regarding rules, regulations and statutes applicable to the various government agencies, should be addressed to the University's Grants and Research Collaborations (GRC) [\[link: 2.5\]](#).

14.3.9 Rules Regarding Tangible Research Property (TRP)

The following is directed toward the administration and distribution of Tangible Research Property (TRP) [\[link: 14.8.8\]](#), which is owned and/or controlled by the University. TRP may be subject to the University's contractual obligations and these rules are to be interpreted and applied consistent with and complementary to other policies affecting the administration of tangible properties.

14.3.9.1 Ownership of TRP. TRP normally is either owned by the University or is subject to the ownership and other provisions of contracts and grants. For example, items such as microorganisms produced under a government grant or contract usually belong to the University as expendable property, subject to the terms and conditions of the grant or contract. Equipment fabricated at the University for subsequent off-campus use by a research sponsor (e.g., an instrument fabricated at the University under contract with the sponsor) is usually owned exclusively by the sponsor.

14.3.9.2 Control of TRP. It is the responsibility of the faculty member (or laboratory director or project head, if the TRP is not developed as part of a Grants and Research Collaborations project) to control the development, storage, use, and distribution of TRP made in the course of research activity, subject to provisions of applicable grants or contracts and University policy. Such control includes

determining if and when distribution of the TRP is to be made beyond the laboratory for scientific use by others.

14.3.9.3 Freedom of Access. The University's Openness in Research Policy [\[link: 1.3.1\]](#), states: "... the principle of openness in research - the principle of freedom of access by all interested persons to the underlying data, to the processes, and to the final results of research - is one of overriding importance." Consistent with this principle, it is the University's policy to promote the prompt and open exchange of TRP and associated research data with scientific colleagues outside the investigator's immediate laboratory.

14.3.9.4 Commercial Considerations. Because TRP may have potential commercial value as well as scientific value, the investigator may wish to make TRP broadly available for scientific use by others by means that do not diminish its value or inhibit its commercial development or public use. Although valid non-commercial reasons may exist for the temporary delay of TRP distribution outside the laboratory for scientific use by others (e.g., safety factors or the need to more fully characterize the TRP prior to distribution, etc.) scientific exchanges should not be inhibited due to potential commercial considerations.

14.3.9.4.1 Income from TRP. TRP may not be sold for profit, although licensing agreements, which include provision for royalty income may be negotiated through the TLS for commercial use of the intangible property rights associated with the TRP. When distributing TRP to research colleagues outside the laboratory, costs of the raw materials and handling may be recovered from the recipient, with the income returned to the account, which funded those costs.

14.3.9.4.2 Contractual Obligations. If any of the initial costs were funded from sponsored agreements, the SRS should be asked to advise on the contractual obligations regarding distribution of the TRP and disposition of the recovered costs. If any costs are charged for TRP distribution, adequate documentation must be maintained for audit purposes.

14.3.9.5 TRP Procedures. The following procedures for identification and distribution of TRP are designed to aid the traditional open

distribution and exchange of TRP for research purposes, preserve the potential commercial value of TRP, assist the further development of TRP for public use, and protect the University and its employees from liability claims arising from the use of University TRP by others.

14.3.9.5.1 Identification System. When public or commercial values were identified by the above evaluation, each item of TRP must have an unambiguous identification code and name sufficient to distinguish it from other similar items developed at the University or elsewhere. The TLS should be consulted for assistance in developing appropriate identification systems and for information regarding use of existing University systems.

14.3.9.5.2 Ownership of Marks. Where applicable (e. g., computer software), each item should also carry the name of the TRP owner and such other marks and legends as may be required to meet the University's contractual obligations and administrative needs, including notice of copyright, trademark, government rights, etc. Information regarding identification, marks, and legends required under research contracts and grants can be obtained from the SRS or TLS.

14.3.9.6 Distribution of TRP for Research Purposes. Each distribution for non-commercial research purposes should be accompanied by a letter of transmittal which includes the following, or equivalent, wording:

"For OIST Graduate University records, please indicate your agreement (1) to accept S- (insert Biological Registry No.) to be used only for non-clinical research by you in your research laboratory, and (2) to not distribute S- to any other individual or entity, by signing and returning a copy of this letter to me."

14.3.9.6.1 CAUTION: If there is a possibility of biohazard or other risk associated with the transport, storage or use of a particular TRP, or if the recipient is likely to use the TRP for clinical research, the Research Safety Section should be consulted regarding appropriate precautionary language in the TRP distribution agreement. Alternatively, SRS can

provide standard TRP distribution forms or Material Transfer Agreement [\[link: \]](#), which contain appropriate precautionary language. (Note: For information about regulations regarding transfer of infectious agents or recombinant DNA material, contact the Research Safety Section (research_safety@oist.jp[\[link: \]](#).)

14.3.9.7 TRP Software Distribution. Distribution, for research purposes only, of computer software owned by the University may be made without restrictions if control of subsequent use by the faculty member is not desired. For example, a faculty member may wish recipients to follow a specific research protocol. Any such distribution is subject to the applicable contract or grant provisions and an agreement by the recipient that commercial development of the software is not to be undertaken.

14.3.9.7.1 TRP Distribution Agreement. If software owned by the University has commercial value or if it is considered desirable to control subsequent use, distribution for research purposes must be coordinated with TLS and must be accompanied by an appropriate agreement with the recipient. TLS will arrange for trademark and copyright registration as needed. TLS will also provide wording for the distribution agreement as necessary to preserve commercial value and provide coordination with existing or prospective commercial licensing activities.

14.3.9.7.2 TRP Contractual Obligations. When software results from Grants and Research Collaborations, SRS should be consulted regarding contractual obligations and regulations affecting ownership, disposition of various rights, and restrictions on the distribution and use of TRP and any associated income with TLS support.

14.3.9.8 Other Forms of TRP. Distribution of TRP other than biological products should normally follow the procedures outlined above for the example of computer software.

14.3.9.9 Distribution of TRP for Commercial Purposes. If TRP developed by the University as a result of research activities is to be distributed to outside users for commercial purposes, the

distribution agreement *must contain provisions negotiated by TLS* covering the terms under which the property may be used, limits on the University's liability for the property or products derived therefrom, and disposition of any royalty income to the University from the licensing of intangible property rights associated with the use of the tangible property.

14.3.9.10 Income Distribution. Distribution of any TRP-related royalty income other than patent royalties will be similar to the patent royalty income distribution policy [\[link: 14.3.7.3\]](#) except that the "inventor's share" will normally be distributed to a research account in the laboratory which produced the TRP (subject to any contractual obligations regarding distribution of income). Questions regarding distribution of any royalty income to individuals should be referred to TLS. Any distribution to individuals is subject to prior approval of the Executive Vice President for Technology Development and Innovation.

14.3.9.11 Contractual Obligations. If the TRP results from Grants and Research Collaborations, the SRS [\[link: 2.5\]](#) should be consulted regarding contractual obligations and regulations affecting ownership, notices, acknowledgments, disposition of various rights, and restrictions on the distribution and use of the TRP and any associated income.

14.3.10 Other Intellectual Property

14.3.10.1 Trade and Service Marks. Trade and service marks (collectively, "marks") are distinctive words or graphic symbols identifying the sources, product, producer, or distributor of goods or services. Trade or service marks relating to goods or services distributed by the University are owned by the University; see Chapter 15 [\[link: 15\]](#). Examples include names and symbols used in conjunction with computer programs or University activities and events. Consult the TLS for information about registration and protection of marks. Consult the Office of Communication & Public Relations for information concerning the use of University marks.

14.3.10.2 Proprietary Information and Trade Secrets. Proprietary information arising out of University work (e.g., actual and proposed terms of research agreements, financial arrangements, or

confidential business information) shall be owned by the University. “Trade secret” is a legal term referring to any information, whether or not copyrightable or patentable, which is not generally known or accessible, and which gives competitive advantage to its owner. Trade secrets are proprietary information.

14.3.10.2.1 Any request that a University employee sign a Nondisclosure or Confidentiality Agreement must be referred to the General Counsel to ensure, among other things, that all research involving proprietary information owned by others is subject to the University’s Openness in Research Policy [\[link: 1.3.1\]](#).

14.4 Responsibilities

14.4.1 The Grants and Research Collaborations

The Grants and Research Collaborations [\[link: 2.5\]](#) reviews terms and conditions of the University’s grants and academic contracts for compliance with University policies on intellectual property rights and openness in research with TLS support.

14.4.2 The Technology Licensing Section

The Technology Licensing Section [\[link: 2.5\]](#) promotes the transfer of the University’s technology and intellectual property for society’s use and benefit while generating unrestricted income to support research and education. TLS is responsible for the administration of the University’s invention reporting and licensing program, the commercial evaluation of inventions, patent-filing decisions, petitions to agencies for greater rights in inventions, and negotiation of industrial agreements.

14.4.3 The Dean of Research and the Executive Vice President for Technology Development and Innovation

The Dean of Research and the Executive Vice President for Technology Development and Innovation respond to questions of ownership or similar matters (through consultation with the SRS and the TLS); the Dean of Research must inform faculty members of their responsibilities under this Policy;

14.4.4 Dean of Research

The Dean of Research must inform faculty members of their responsibilities under this Policy.

14.4.5 All employees

All employees must know and comply with the requirements of this Chapter.

14.4.6 All supervisors and managers

All supervisors and managers must inform their subordinates of the requirements of this Chapter.

14.5 Procedures

14.5.1 Faculty Grievance procedure

([Chapter 3.8](#)[\[link: 3.8, Faculty Handbook\]](#))

14.5.2 Questions

contact the Dean of Research and Executive Vice President for Technology Development and Innovation

14.6 Forms

- OIST Graduate University Patent and Copyright Agreement (PCA)
- Prior Existing and Conflicting Intellectual Property Agreement with Another Employer (PCA2)”
- Invention Disclosure Form
- Standard TRP distribution forms

14.7 Contacts

14.7.1 Policy Owner

Executive Vice President for Technology Development and Innovation

14.7.2 Other Contacts:

Grants and Research Collaborations

Technology Licensing Section

14.8 Definitions

14.8.1 Confidentiality Obligation (also known as Nondisclosure Agreement, Confidentiality Agreement)

A confidentiality obligation is any legal undertaking whereby one party agrees to keep information disclosed by another party secret. The obligation to keep disclosed information secret is typically accompanied by an obligation to protect the disclosed information at least as stringently as

the recipient protects its own confidential information and an obligation not to use the disclosed information for any purpose other than as permitted by the agreement signed by the recipient of the information. This obligation is typically embodied in a written Confidentiality Agreement (CA) or Nondisclosure Agreement (NDA). The obligation to maintain information in confidence can take many forms and such obligations are often found in license agreements and other legal contracts.

14.8.2 Copyrightable Works

Under the copyright law, copyright subsists in “original works of authorship” that have been fixed in any tangible medium of expression from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. These works typically include the full array of literary, artistic, and musical works, pictorial and other graphic works, dramatic works, motion pictures and other audiovisual works, and sound recordings. Copyright protection is also available for software and integrated circuit masks.

Except as set out otherwise in this policy (for example, with regard to software and integrated circuit masks), the University does not claim ownership of pedagogical, scholarly, or artistic works, regardless of their form of expression. Such works include those of students created in the course of their education, such as dissertations, papers and articles. The University claims no ownership of popular nonfiction, novels, textbooks, poems, musical compositions, non-patentable software, or other works of artistic imagination, which are not institutional works and which did not make more than incidental use of University resources or the services of University non-faculty employees working within the scope of their employment.

14.8.3 Invention

An invention is a novel and useful idea relating to processes, machines, manufactures, and compositions of matter. It may cover such things as new or improved devices, systems, circuits, chemical compounds, mixtures, etc. It is probable that an invention has been made when something new and useful has been conceived or developed, or when unusual, unexpected, or nonobvious results have been obtained and can be exploited. An invention can be made solely or jointly with others as co-inventors. To be recognized legally, a co-inventor must have conceived of an essential element of an invention or contributed substantially to the general concept.

14.8.4 **Invention Disclosure**

An invention disclosure is a document that provides information about inventor(s), what was invented, circumstances leading to the invention, and facts concerning subsequent activities. It provides the basis for a determination of patentability and the technical information for drafting a patent application. An invention disclosure is also used to report technology that may not be patented but is protected by other means such as copyright or trade secret.

14.8.5 **More than Incidental Use**

For purposes of this Chapter, the phrase “more than incidental use of University resources” means use *for more than a minimal amount of time* of specialized, research-related facilities, equipment or supplies, provided by the University for academic purposes, and use of more than a minimal amount of “on-the-job” time. The occasional and infrequent use of the following would typically not constitute “more than incidental use of University resources”:

- Routinely available, office-type equipment, including desktop computers and commercially-available software, and
- Reference materials or other resources collected on the University campus, and which are generally available in non-University locations.

14.8.6 **Patent**

A patent is a grant issued by a national government office (usually called the Patent Office) giving an inventor the right to exclude all others from making, using, or selling the invention within the territory of the country, its territories and possessions for a period of 20 years. When a patent application is filed, the Patent Office reviews it to ascertain if the invention is new, useful, and nonobvious and, if appropriate, grants a patent - usually two to five years later. Not all patents are necessarily valuable or able to withstand a challenge after being issued.

14.8.7 **Public Domain**

Public domain ownership means that society, as a whole, owns the item and anyone can make free use of it for any purpose desired. Authorship doesn't have to be noted. A particular item enters the public domain when the author or creator relinquishes her/his rights to the item or when a predefined length of time has passed.

14.8.8 Tangible Research Property (TRP)

TRP is defined for purposes of this Chapter as tangible (or corporeal) items produced in the course of research projects supported by the University or by external sponsors. TRP includes such items as: biological materials, engineering drawings, computer software, integrated circuit chips, computer databases, prototype devices, circuit diagrams, equipment. TRP is separate and distinct from intangible (or intellectual) property such as inventions, patents, copyright and trademarks which are subject to other policies and guidelines set forth above. Individual items of TRP may be associated with one or more intangible properties such as copyright or patents.

14.8.9 Trade secret

“Trade secret” is a legal term referring to any information, whether or not copyrightable or patentable, which is not generally known or accessible, and which gives competitive advantage to its owner. Trade secrets are proprietary information.

14.8.10 Trademark

Trade and service marks are distinctive words or graphic symbols identifying the sources, product, producer, or distributor of goods or services. A service mark is the same as a trademark, except that it identifies and distinguishes the source of a service.

14.8.11 work-for-hire

“work-for-hire” is a legal term defined generally as “a work prepared by an employee within the scope of his or her employment.” This definition includes works prepared by employees in satisfaction of sponsored agreements between the University and outside agencies. Certain commissioned works also are works for hire if the parties so agree in writing.

The employer (i.e., the University) by law is the “author,” and hence the owner, of works for hire for copyright purposes. Works for hire subject to this principle include works that are developed, in whole or in part, by University employees. For example, significant use of staff or student employee programmers or University film production personnel will typically result in University ownership of the copyright in the resulting work. Where a work is jointly developed by University faculty or staff or student employees and a third-party non-employee, the copyright in the resulting work typically will be jointly owned by the University and the third party. In such instances, an agreement must be executed to explicitly define

the rights of both the University and the other party. If a copyright jointly shared by the third party is expected, immediate consultation with the General Counsel is required. Whether the University claims ownership of a work will be determined in accordance with the provisions of this policy, and not solely based upon whether the work constitutes a work-for-hire under the copyright law. For example, copyright in pedagogical, scholarly or artistic works to which the University disclaims ownership under this policy shall be held by the creators regardless of whether the work constitutes a work-for-hire under copyright law. University ownership in a work-for-hire may be relinquished only by an official of the University authorized to do so by the Board of Governors.

14.9 Appendices

(There are no appendices associated with this Chapter.)