

EAST CAROLINA UNIVERSITY

GREENVILLE, NORTH CAROLINA 27834

OFFICE OF THE CHANCELLOR

*Received*

January 26, 1984

JAN 27 1984

**FACULTY SENATE**

Memorandum

TO: Members of the Board of Trustees

FROM: Dr. John M. Howell *JM - Howell*

Attached is "Draft Provisions for Patent and Copyright Procedures" which I forward with my recommendation for approval.

The Board of Governors adopted a policy on this topic on June 10, 1983 (attached) which lays down general guidelines for the development of policies by each constituent institution.

The attached is a response to that requirement. The ECU Patent Committee and the Faculty Senate have approved this document.

JMH/ra

enclosure

blind copies: Dr. J. William Byrd  
✓ Dr. James L. Smith



EAST CAROLINA UNIVERSITY  
GREENVILLE, NORTH CAROLINA 27834

College of Arts and Sciences  
Department of Physics

January 24, 1984

Telephone (919) 757-6739

RECEIVED

JAN 25 1984

CHANCELLOR'S OFFICE  
E. C. U.

Dr. John M. Howell, Chancellor  
East Carolina University  
Greenville, NC 27834

Dear John:

You will find enclosed the most recent version of the "Draft Provisions for Patent and Copyright Procedures." This document is now ready to go to the Board of Trustees. I have also enclosed, for your convenience, a copy of the document, "University of North Carolina Patent and Copyright Policies" adopted by the Board of Governors on June 10, 1983.

If I can be of further assistance with this process, please let me know.

Sincerely,

*Bill*

J. William Byrd  
Chair, Patent Committee

JWB:ew

Enclosures



January 24, 1984

DRAFT PROVISIONS  
FOR  
PATENT AND COPYRIGHT PROCEDURES  
EAST CAROLINA UNIVERSITY

A. General

1. As defined by the Patent and Copyright Policies of the Board of Governors,\* to which these Procedures are expressly subject, East Carolina University has an interest in all inventions of University personnel that are conceived or first actually reduced to practice as a part of or as a result of University research, activities within the scope of the inventor's employment by the University, and activities involving the use of University time, facilities, staff, materials, University information not available to the public, or funds administered by the University.

2. The University may also have an interest in inventions under the terms of contracts, grants or other agreements. Faculty, staff, and students, whose inventions are made on their own time and without University facilities, materials, or resources and which inventions are, therefore, their exclusive property as specified by the Patent and Copyright Policies, may avail themselves of the opportunity to submit the invention to the University for possible patenting and/or commercial exploitation and management under terms to be agreed between the inventor and the University.

3. The provisions of the Patent Procedures are subject to any applicable laws, regulations or specific provisions of the grants or contracts which govern the rights in inventions made in connection with sponsored research.

\*"University of North Carolina Patent and Copyright Policies," adopted by the Board of Governors on June 10, 1983.



4.. Under the terms of certain contracts and agreements between the University and various agencies of government, private and public corporations and private interests, the University is or may be required to assign or license all patent rights to the contracting party. The University retains the right to enter into such agreements whenever such action is considered to be in its best interest and in the public interest. Ordinarily the University will not agree to assign rights in future inventions to private corporations or businesses.

B. Responsibilities of University Personnel

1. University personnel who, either alone or in association with others, make an invention in which the University has or may have an interest shall disclose such inventions on forms provided for this purpose by the University Patent Office (Appendix A). The University Patent Office will promptly acknowledge its receipt of completed disclosure forms and will distribute such forms to the University Patent Committee for consideration at its next meeting.

The Patent Committee will review each written disclosure promptly. The inventor or his or her representative shall be allowed to examine all written materials submitted to the Committee in connection with his or her disclosure and to make a written and, where practicable, oral presentation to the Committee. The Committee will decide on the proper disposition of the invention to secure the interests of the University, the inventor, the sponsor if any, and the public. Its decision may include, but is not limited to, one or a combination of the following:

- (1) To submit the disclosure for review by a patent or invention management firm;



- (2) To make inquiries of potential licensees that may have an interest in the invention, including the financing of a patent application, where applicable;
- (3) To study the practicality of applying for a patent with University resources (an option with limited application because of financial constraints);
- (4) In proper cases, to release its rights to the inventor subject to an agreement to protect the interests of the University, the sponsor if any, and the public, including an obligation to pay to the University a percentage of future royalties; and
- (5) To dedicate the invention to the public.

Within four weeks of the receipt of the disclosure, the inventor will be notified in writing of the decision of the Committee on (1) the equities involved including financial participation, (2) whether the University plans to file a patent application, or (3) whether the University will accept assignment of the invention for patenting, licensing and/or commercial handling as applicable. If the University chooses neither to file a patent application or otherwise make available commercially nor to dedicate to the public an invention in which it asserts its rights, the invention at the Committee's discretion may be released in writing to the inventor, with the permission of the sponsor, if any. If, after the University has filed a patent application, it decided to abandon the patent, the inventor will be promptly notified in writing, and all rights at the Committee's discretion may be released by written agreement to the inventor, with the permission of the sponsor, if any.

In those cases in which the University has obtained a patent without obligation to sponsors, if no arrangement has been made for



commerical development within a reasonable period from the date of the issuance of the patent, the inventor(s) may request in writing a release of the University's patent rights. The Patent Committee will promptly either grant the request or will advise the inventor of the University's plans for the development of the invention.

As to any invention in which the University has an interest, the inventor, upon request, shall execute promptly all contracts, assignments, waivers or other legal documents necessary to vest in the University or its assignees any or all rights to the invention, including complete assignment of any patents or patent applications relating to the invention.

2. University personnel may not: (a) sign patent agreements with outside persons or organizations which may abrogate the University's rights and interests as stated in the Patent Policy or as provided in any grant or contract funding the invention, nor (b) without prior authorization use the name of the University or any of its units in connection with any invention in which the University has an interest.

#### C. Publication and Public Use

The University strongly encourages scholarly publication of the results of faculty and student research. Though the Patent and Copyright Policies do not limit the right to publish, except for short periods of time necessary to protect patent rights, publication or public use of an invention constitutes a statutory bar to the granting of a United States patent for the invention unless a patent application is filed within one year of the date of such publication or public use. Publication or public use also can be an immediate bar to patentability in certain foreign countries.

In order to preserve rights in unpatented inventions, it shall be the duty of the inventor, or of his supervisor if the inventor is not



available to make such report, to report forthwith to the University Patent Office any publication, submission of manuscript for publication, sale, public use, or plans for sale or public use, of an invention, if a disclosure has previously been filed. If an invention is disclosed to any person who is not employed by the University or working in cooperation with the University upon that invention, a record shall be kept of the date and extent of the disclosure, the name and address of the person to whom the disclosure was made, and the purpose of the disclosure.

After disclosure to the Patent Committee, the inventor shall promptly notify the University Patent Office of the acceptance for publication of any manuscript describing the invention or of any sale or public use made or planned by the inventor.

D. Inventor Requests for Waiver of University Rights

If the inventor believes that the invention was made outside the general scope of his University duties, and if he does not choose to assign the rights in the invention to the University, he shall, in his invention disclosure, request that the University Patent Committee determine the respective rights of the University and the inventor in the invention, and shall also include in his disclosure information on the following points:

1. The circumstances under which the invention was made and developed;
2. The employee's official duties at the time of the making of the invention;
3. Whether he or she requests waiver or release of any University claims or acknowledgment that the University has no claim;
4. Whether he or she wishes a patent application to be prosecuted by the University, if it should be determined that an assignment of the



invention to the University is not required under the Patent and Copyright Policies; and

5. The extent to which he or she would be willing voluntarily to assign domestic and foreign rights in the invention to the University if it should be determined that an assignment of the invention to the University is not required under the Patent and Copyright Policies.

E. Revenue Sharing

1. The University shall share revenue which it receives from patents or inventions with the inventors. As noted in Section A.4., specific provisions of grants or contracts may govern rights and revenue distribution regarding inventions made in connection with sponsored research; consequently, revenues the University receives from such inventions may be exclusive of payments of royalty shares to sponsors or contractors. Moreover, the University expects to contract with outside persons or organizations for the obtaining, managing and defending of patents, and any royalty shares or expenses contractually committed to such persons or organizations may be deducted before revenues accrue to the University.

2. The revenues (net, if applicable per the preceding paragraph) which the University receives from a patent or invention will be applied first to reimburse the University for any incremental expenses incurred by it in obtaining and maintaining patents and/or in marketing, licensing and defending patents or licensable inventions. After provision for such expenses, the inventor's share of such revenues received by the University shall be as follows: 50% of the first \$100,000, 25% thereafter. In the case of co-inventors, each such percentage share shall be subdivided equally among them, unless the University in its sole discretion determines a different share to be appropriate. Applicable laws, regulations or provisions of grants or contracts may, however, require that a lesser share be paid to the inventor. In



no event shall the share payable to the inventor or inventors in the aggregate by the University be less than 15% of gross royalties received by the University.

3. To the extent practicable and consistent with State and University budget policies, the remaining revenue received by the University on account of an invention will be dedicated to research purposes, including research in the inventor's department or unit, if approved by the Chancellor upon recommendation of the University Patent Committee.

F. Administration

1. The University recognizes that the evaluation of inventions and discoveries and the administration, development and processing of patents and licensable inventions involves substantial time and expense and requires talents and experience not ordinarily found in its staff; therefore, in most cases it expects to contract with outsiders for these services. It may enter into a contract or contracts with an outside organization covering specific inventions or discoveries believed to be patentable and patents developed therefrom, or covering all such inventions, discoveries and patents in which the University has an interest.

2. The Chancellor shall appoint a University Patent Committee consisting of no fewer than three members. The Committee shall review and recommend to the Chancellor or his delegate changes in these Procedures, decide upon appropriate disposition of invention disclosures, resolve questions of invention ownership, recommend to the Chancellor the expenditure of invention royalties, and make such recommendations as are deemed appropriate to encourage disclosures and assure prompt and effective handling, evaluation, and prosecution of invention opportunities and to protect the interests of the University and the public.



G. Copyright Procedures

1. As a general rule, all rights to copyrightable material are the property of the creator. The distribution of royalties, if any, is a matter of arrangement between the creator and his publishers or licensees.

2. Different treatment from 1. above may be accorded in case of specific contracts where the constituent institution or sponsor employs personnel for the purpose of producing a specific work, where different treatment is deemed necessary to reflect the contribution of the institution to the work, as in the case of software or audiovisual material, or where a sponsored agreement requires otherwise. In such cases, an institute, center, or other unit of the University that engages faculty members and other employees to write for publication by that unit or produce other copyrightable materials for the unit, such as audiovisual materials or computer software, may, subject to the approval of the Chancellor, adopt rules providing that copyright in materials prepared by such faculty members and other employees in the course of their professional work for that unit vests in the unit and not in the author. In no case will such rules be implemented retroactively to precede the date of first approval by the Chancellor. In all cases, approval of the rules will be contingent upon the inclusion of a provision that all affected employees be properly informed of the rules and that the accomplishment of this requirement be documented in the employee's personnel file. It is the responsibility of any institute, center or other unit of the University desiring such provisions to present to the Chancellor for his consideration the details of the requested rules. In a specific case in which no rules exist, a unit head may negotiate, before the fact, a specific contract, subject to the approval of the Chancellor, for a University employee to produce a product whose copyright is to be vested with the unit.



APPENDIX A

CONFIDENTIAL

EAST CAROLINA UNIVERSITY

Report of Invention

1. Inventor(s): (List name, professional affiliation, mailing address, telephone. Underline name of person to contact for more information.)

Pursuant to the Patent Policy and Procedures of East Carolina University, I/we hereby disclose details about the following invention:

2. Title of Invention:

3. Date of Invention: (Indicate actual or approximate dates.)

Earliest conception:

Experimentation period:

Reduction to practice:

4. Brief Description of Invention: (Identify whether invention is a new process, composition of matter, a device, one or more products, a new use for or an improvement to an existing product or process. Include nature, purpose, operation and basic characteristics of the invention.)

(Use additional sheets if necessary and attach descriptive materials that may promote a better understanding of the invention.)



5. Publication:

(a) Indicate details of any full or partial disclosure of this invention by any of the inventors named in paragraph 1. The means may have been one or more of the following: manuscript, article, report, grant application, thesis, abstract, demonstration, sales catalog, news release, internal memorandum, or oral presentation. Specify date and attach copies of written disclosures insofar as possible.

(b) Describe in detail any plans for disclosure of this invention in the near future. (This may include submission of a manuscript, a formal publication, oral presentation, a showing, offer of samples, or a sale.)

6. Sponsorship for Work Leading to the Invention:

(a) Sponsor(s):

Contract or grant number:

Funding period:

Principal Investigator:

Attach relevant patent sections from the funding instrument or sponsor's policy manual if available.

7. Prospects for Commercialization:

(a) Indicate any apparent commercial interest. Please name companies and specific persons if possible.

(b) List names of other qualified firms with your comments, if any.

8. Signature(s) of Inventor(s):

_____	Date
_____	Date
_____	Date

9. Signature of Person Witnessing This Disclosure:

_____	_____
Signature	Date
_____	
Typed name and title	

10. Signature of Department Chairperson(s) Affected by This Disclosure:



\_\_\_\_\_  
Signature

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Date

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Typed name and title

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Signature

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Date

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Typed name and title

Please send this form to the University Patent Office, Office of the  
Chancellor, East Carolina University.

11. University Patent Office Use Only:

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Signature

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Date disclosure received in  
University Patent Office

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