



WSSU PATENT POLICY

A. General

1. As defined by the Patent and Copyright Policies of The University of North Carolina Board of Governors (“Patent and Copyright Policies”) to which this Policy is expressly subject, Winston-Salem State 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 commercialization and management under terms to be agreed between the inventor and the University.
3. The provisions of this Patent Policy are subject to any applicable laws, regulations, or specific provisions of the grants or contracts that govern the rights in inventions made in connection with sponsored research.
4. Under the terms of certain 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. Except as provided in specific written contracts and agreements, the University will not agree to assign rights in future inventions.

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 the Invention Report (IR) form provided for this purpose by the Intellectual Property Committee (IPC). The inventor shall submit the IR form to his/her supervisor or department head. The supervisor or department head shall ascertain that the IR form is prepared in conformity with guidelines and shall check its accuracy and completeness, especially with respect to the circumstances in which the invention was developed, and shall forward the IR form and whatever comments s/he may deem to be necessary or desirable to the IPC. The supervisor or department head shall add to the file whatever information s/he may have concerning the governmental and commercial value of the invention. If the inventor specifically requests that the University determine his/her rights in the invention, the supervisor or department head shall state his/her conclusions with respect to such rights. The Chair of the IPC will promptly acknowledge receipt of completed IR forms and the comments and recommendations of the supervisor or department head. The IPC shall be appointed and shall have duties pursuant to the University Copyright Policy Section VII and will review each written disclosure and make recommendations promptly. The inventor or his or her representative shall be allowed to examine all written materials submitted to the Committee, to provide any additional written materials and, where practicable, to make an oral presentation to the Committee in order to clarify the potential associated with the ideas (inventions). The IPC will then 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:

- a. To submit the invention for review by a patent or invention management firm;
- b. To make confidential inquiries of potential licensees as to their interest in the invention and their willingness to finance a patent application, where applicable;
- c. To study the practicality of applying for a patent with University resources (an option with limited application because of financial constraints);
- d. In certain cases, to release the University's 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, where necessary, to recognize the University's contribution.
- e. To dedicate the invention to the public.
- f.. To confirm that the University has no rights in the invention.

Within 90 days after receipt of the IR, 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, nor 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 decides to abandon the patent, the University will promptly notify the inventor 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 commercial development within a twelve month period from the date of the issuance of the patent, the inventor(s) may request in writing a release of the University's interest, which the IPC shall grant, unless the University is in negotiations or serious discussions regarding commercial development.

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

2. University personnel may not: (a) sign patent agreements or any other agreement with outside persons or organizations that may abrogate the University's rights and interests as stated in the University of North Carolina Patent and Copyright Policies or as provided in any grant or contract funding the invention, or (b) without prior written 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 publications of the results of faculty and student research. Though the University of North Carolina 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 each inventor to assure that a report is filed with the Chairperson of the Intellectual Property Committee notifying that office of any publication, submission of manuscript for publication, sale, public use, or plans for sale or public use, of an invention for which an Invention Report has previously been filed. If an invention is disclosed to any person who is not employed by the University or is not otherwise committed to maintain such invention in confidence, the inventor shall keep a written record of the date and extent of each such disclosure, the name and address of the person to whom the disclosure was made, and the purpose of the disclosure.

After the invention has been disclosed to the Intellectual Property Committee, the inventor shall promptly notify the Chair of the Intellectual Property Committee if he or she submits for publication, or has accepted for publication, any manuscript describing the invention, or if he or she plans or makes any sale or public use of the invention.

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 University of North Carolina 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 University of North Carolina Patent and Copyright Policies.

E. Revenue Sharing

1. The University shall share technology transfer revenue that it receives from patents or inventions with the inventors. 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 may contract with outside persons or organizations for the obtaining, managing and defending of patents. Any expenses incurred for the services of such persons or organizations, as well as any and all incremental expenses incurred by the University in obtaining and maintaining patents and/or in marketing, licensing and defending patents or licensable inventions, shall be deducted before the University distributes revenues as provided in Section E.2 below.

2. The revenues that the University receives from a patent or invention (net of expenses described in Section E.1) shall be distributed as follows:

<u>Net Revenue</u>	<u>Inventor/co-inventor(s)</u>	<u>Department</u>	<u>College</u>	<u>University</u>
First \$100,000	50%	10%	5%	35%
\$100,000-\$500,000	40%	10%	10%	40%
Above \$500,000	35%	10%	10%	45%

Applicable laws, regulations or provisions of grants or contracts may, however, require that a lesser share be paid to the inventor. In the case of co-inventors, each percentage share described in this paragraph as due a sole inventor shall be subdivided equally among the co-inventors unless all the co-inventors provide the University a written instrument signed by each of them allocating ownership among them other than in equal shares. 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, amounts allocated to the University pursuant to Paragraph E.2. will be dedicated to support University research and commercialization activities, including research in the inventor's department or unit, if approved by the Chancellor.

F. Administration

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 necessarily found in its staff; therefore it may enter into a contract or contracts with an outside organization or organizations covering specific inventions or discoveries believed to be patentable or covering all such inventions, discoveries and patents in which the University has an interest.

G. **Works subject to both copyright and patent protection.**

As provided under the Winston-Salem State University Copyright Policy where an invention is subject to protection under both patent law and copyright law, if the University through the Intellectual Property Committee determines to retain title to its patent rights, the inventor/creator shall assign copyright to the University. On commercialization of such works, the inventor/creator shall be compensated in accordance with the provisions of this Policy and such procedures as may be developed hereunder. The Intellectual Property Committee may on its own initiative investigate whether a copyrighted work reported to it may also be subject to patent protection.

Effective Date: This policy becomes effective upon adoption by the Board of Trustees.

Adopted:

This the 17th day of March, 2006.

Kevin A. Myatt
Chairman, Board of Trustees
Winston-Salem State University

Earline M. Richardson
Secretary, Board of Trustees
Winston-Salem State University