

WEST VIRGINIA UNIVERSITY RESEARCH CORPORATION

West Virginia University Intellectual Property Policy

Preamble

West Virginia University (the "University") is dedicated to teaching, research, and serving the public good. In pursuit of those missions, new discoveries and creative and scholarly works that are eligible for intellectual property protection are frequently produced. The objectives of this Policy are to encourage research at the University, provide financial compensation to Creator(s), and protect and serve the public interest.

Policy Statement

This document sets forth the University Policy related to intellectual property.

The University shall retain all rights, title, and interest in any and all intellectual property generated, created, or developed in facilities operated or controlled by the University, supported by funds administered by the University, or performed in the course of regular employment or duties by Creator(s) unless exempted by other provisions of this Policy. This Policy is subject to any applicable laws, regulations or agreements with research sponsors which govern the rights concerning inventions made in connection with sponsored research.

University Administration of Intellectual Property

The Vice President for Research and Economic Development shall have the right to exercise broad discretion as necessary via the [West Virginia University Research Corporation](#) (the "WVURC") for and on behalf of the University to encourage, develop, protect and commercialize Applicable Intellectual Property. Primary responsibility for identifying, protecting, and managing Applicable Intellectual Property resides with the [WVURC's Office of Technology Transfer](#) (the "OTT"). The OTT will also be responsible for implementing and educating University members about this Policy.

Who Should Read This Policy

This Policy shall apply to all Creators and each shall read and sign this Policy. The failure of any Creator to read and sign this Policy shall in no way limit its application.

Contacts

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1. Definitions

- "Applicable Intellectual Property" is defined as:

any creation, discovery, improvement, innovation, invention, or product resulting therefrom, developed with University Resources or within the scope of the Creator's employment or duties to the University. Applicable Intellectual Property includes, but is not limited to, patents, copyrights, trademarks, and trade secrets.

- "Creator" is defined as:

any faculty, staff, other employee of the University or any person, including students, who creates or discovers Applicable Intellectual Property using University Resources or within the scope of the Creator's employment with the University.

- "University Resources" are defined as:

all tangible resources provided by the University to Creator(s), including but not limited to office, lab, and studio space; computer hardware, software and support; secretarial service; research, teaching, lab assistants; supplies; utilities; funding for research and teaching activities, travel; and other funding or reimbursement.

2. Disclosure and Assignment

Creator(s) shall promptly disclose to the OTT all Applicable Intellectual Property prior to public disclosure. Failure to disclose Applicable Intellectual Property in a timely manner may result in loss of revenue to the University and the Creator(s). In the event such a failure to disclose is found to be willful, the Creator(s) may forfeit distribution of any derived revenue (see Revenue Distribution). Forfeited revenue shares shall be distributed by the University to the appropriate college(s) and department(s).

Creator(s) shall assign rights in Applicable Intellectual Property to the University. All assignments must be in writing and conform to the requirements of this Policy. The failure of Creator(s) to agree in writing to assign Applicable Intellectual Property rights to the University shall in no way constitute a waiver of the University's rights to the Applicable Intellectual Property as set forth herein.

Disclosure and assignment shall be made on an [Intellectual Property Disclosure and Assignment Form \(IP Disclosure Form\)](#) to the OTT. IP Disclosure Forms shall require the signatures of the Creator(s), the Chair(s) of the Creator's Department(s)/Division(s), and the Dean(s) of the Creator's School(s)/College(s). The OTT shall routinely report all disclosures to the Vice President for Research and Economic Development.

The OTT shall be charged with determining whether the University will seek protection of disclosed intellectual property. The OTT will make a reasonable effort to evaluate and to notify the Creator(s), in writing, within ninety (90) days of receiving the completed IP Disclosure Form, whether or not the WVURC will pursue protection of the Applicable Intellectual Property on behalf of the University.

Creator(s) of Applicable Intellectual Property shall, as is reasonably necessary, assist the OTT to obtain protection for the intellectual property, including executing appropriate disclosures, assignments, declarations and other documents required to effectively establish, protect and set forth the ownership and rights to the Applicable Intellectual Property.

The OTT shall have the right to determine the means for legally protecting Applicable Intellectual Property rights retained by the University (e.g., applying for patent protection and/or for copyright or trademark registration). All costs associated with obtaining, managing, and enforcing such legal protection are the responsibility of the WVURC unless otherwise contracted.

The OTT shall have the right to determine the disposition of Applicable Intellectual Property under this Policy. That determination shall take into account the interests of the Creator(s), the University, and the public.

3. Creator Rights and Revenue Distribution

Creator(s) shall retain the rights to pursue related research activities, determine methodologies, draw conclusions, and develop related intellectual property, except to the extent that the Creator(s) are bound by contrary contractual agreements (e.g. sponsored research agreements) or are required by legal or professional considerations to do otherwise.

Creator(s) shall retain rights to intellectual property that does not fall into the definition of Applicable Intellectual Property (created outside the scope of employment or duties to the University and without University Resources). The classification of intellectual property as Applicable Intellectual Property or non-Applicable Intellectual Property shall be determined by the Chair(s) of the Creator's Department(s)/Division(s), and the Dean(s) of the Creator's School(s)/College(s). Non-Applicable Intellectual Property may, at the discretion of the Creator(s), be assigned to the University for management under the terms of this Policy.

Net proceeds, after the WVURC is reimbursed for all direct expenses for obtaining intellectual property protection, derived from the license or sale of Applicable Intellectual Property rights to a third party shall be dispersed as follows:

Creator(s): 40%
Creator's Department/Division: 10%
Creator's College/School: 10%
WVURC: 40%

When co-Creators exist, the Creator's 40% portion is to be distributed in a ratio determined by the Creators, reduced to a writing (see IP Disclosure Form) and submitted to the OTT. In the absence of such a written determination, the Creator's share will be distributed evenly between all co-Creators.

If the University opts not to pursue the protection of Applicable Intellectual Property (see Section 2, Paragraph 4 above), the Creator may individually finance the protection, marketing, and licensing of the Applicable Intellectual Property. The University may, at its sole discretion, determine to release to the Creator(s) its ownership rights to any intellectual property upon such conditions as the university deems beneficial and fair to all parties. The transfer of rights must be approved and secured by an assignment agreement with the OTT.

4. Equity Interests

The OTT may negotiate, but shall not be obligated to negotiate, for equity interests in lieu of or in addition to monetary consideration as part of an agreement between the WVURC and an external entity relating to Applicable Intellectual Property.

If and when monetary proceeds are generated by the sale or licensing of equity interests, those proceeds shall be distributed according to the policies set forth herein for revenue distribution.

5. A "University Mark"

A "University Mark" is any name, logo, or other mark that identifies the University to the public (e.g., the "flying WV" logo). All written and broadcast material containing a University Mark for advertising, marketing or other promotional purposes shall be submitted to [WVU Trademark Licensing Services](#) for approval prior to such use of the University Mark. A faculty or staff member must complete and submit a request describing the intended use of a University Mark. A statement on the use of University Marks shall be included in all appropriate contracts between industry and the University stating such Marks must not be used without written permission of the University. For more information contact [WVU Trademark Licensing Services](#).

Non-"University Mark" trademarks (for products) or service marks (for services) can be applied for on behalf of the University. The OTT can provide assistance in securing such marks.

6. Confidentiality

Each faculty and staff member acknowledges the duty to protect all confidential information and use such information only in the performance of University duties. Such confidential information includes, but is not limited to any Intellectual Property, patents, copyrights, trademarks, trade secrets, confidential business and technical information, process, application, business practices and agreements, financial information, drawings, plans, methods, manufacturing information, engineering, research and development, and know-how learned in connection with his/her employment with the University.

7. Dispute Resolution

If a dispute about the application of this Policy arises between a Creator and the University that cannot be resolved by the Office of Technology Transfer, the dispute shall be presented to the Vice President of Research and Economic Development for informal mediation. If the mediation is not satisfactory to all parties to the dispute, any unsatisfied party may appeal in writing to the Executive Committee of the WVURC Board of Directors. The Executive Committee's decision shall be final and there will be no further appeal within the University.

8. Amendment and Periodic Review of this Policy

This Policy shall be reviewed by the Executive Committee of the WVURC Board of Directors, and amended if appropriate, at least every five years. Broad University input should be sought as part of this review.