

December 2014

Hamilton College

Policy on *College-owned Intellectual Property (IP)*¹

Introduction

(I) Hamilton College seeks to encourage creativity among its faculty, students, and staff. The College invests in this endeavor by making available its facilities, equipment, personnel, and information resources. The College also actively seeks specific support for creative activity from external sources, both public and private.

To help meet these policy objectives, the College makes available (through the office of the Vice President for Academic Affairs (VPAA)) technical and legal assistance in procedures necessary to protect ownership of intellectual property and to aid in its commercial development.

The specific aims of this policy include the following:

- 1) to encourage creativity among the faculty, students and staff;
- 2) to increase the likelihood that creative works produced at the College are used to benefit the public;

(II) For purposes of this policy, “College Personnel” refers to College faculty, administrators, office and technical staff, and other employees (including students working for the College as part-time employees) and students. College Personnel are covered by this policy to the extent that their creative work involves the use of College Resources.

(III) For purposes of this policy, “College Resources” refers to any type of resources and/or assistance provided, directly or indirectly, by the College, including, but not limited to, space, facilities, equipment, staff, or funds, as may be provided by the College for the particular circumstances described in the sections below entitled "Determination of Rights...." for intellectual property (as defined below).

(IV) All IP owned by the College as defined by the Hamilton College Policy on Determination of Ownership of Intellectual Property is covered by this policy. The three types of IP are copyrightable, patentable, and trademark/ service mark materials.

(V) For the purposes of this policy, “Identity Interest” is a College interest in IP that is more integral to, and reflects more directly on, the identity of the College than on the

¹ This policy draws, with permission, from a similar policy at Swarthmore College

identity of the individuals who create it. In particular, the College has an identity interest in College publications disseminated beyond the College, such as the catalog, institutional web pages, the alumni bulletin, admissions brochures, and campaign materials.

(VI) For the purposes of this policy, “Functional Interest” is a College interest in IP that is used or intended to be used to ensure the effective functioning, coordination and management of ongoing operations. For example, it has a functional interest in administrative and personnel procedures, including software used for College operations, and internal handbooks and reports.

(VII) Determination of Rights to Intellectual Property: As defined by the Hamilton College Policy on Determination of Ownership of Intellectual Property, the College owns IP when:

- The College has an identity or functional interest in the IP.
- The College directed, or assigned the creators to a project that resulted in the development of the IP.
- The College and the creators of the work have entered into a written agreement regarding the work. Ownership will then be determined by the terms of the agreement.
- Development of the IP was funded as part of an externally sponsored research program under an agreement that allocates rights to the College.

Deliberative Determination

(VIII) In some cases, for instance, those involving substantially more than normal support by the College to individuals, or questions related to identity or functional interest, a process called “deliberative determination” of IP ownership and associated matters is required. The deliberative determination will be provided by the VPAA or his/her designate. In such cases, potential IP development is best reported to the VPAA before it is well underway, so that an agreement on ownership, responsibilities, rights and benefits can be reached. Creators should report, as soon as the situation is reasonably clear, on the production or planned production of any IP that meets one or more of the following conditions:

- Creating the IP would require more than normal support from the College.
- The creator intends to seek a patent or other commercialization for which the process of commercialization involves substantial cost and effort, **and** the creator wishes the College to consider providing some or all of that support.

- The IP would be created under a government or private sponsor grant that specifies IP rights.

(IX) Should the VPAA and the creator of a work not be able to reach agreement as to IP ownership, a Review Committee shall make the recommendation to the President who will make the final determination. Initially Review Committees shall be chosen ad hoc (no standing committee). One member shall be chosen by the VPAA and one by the creator; these two members shall then choose the third member. Similarly, if a group doing an IP project cannot work out an ownership proposal among themselves or with the VPAA, or a member in the group expresses concerns to the VPAA, a Review Committee shall be constituted. In this case, if the group cannot agree on the choice of a Review Committee member, then the VPAA shall choose two members, who will again choose a third member. In any event, the Review Committees shall have the authority to consult as needed with experts to make their determinations, subject to approval to avoid excessive expenses. Whether the VPAA and the creator reach accord on their own, or whether a Review Committee is needed, in each case, an agreement shall be put in writing and signed by all concerned.

(X) The Office of the VPAA will be responsible for day-to-day management of all College IP issues, and shall be empowered to negotiate the College's rights under this policy and resolve matters described under "deliberative determination." All IP to be disclosed to the College pursuant to this policy shall be disclosed to the Office of the VPAA (the "Office"), which will be responsible for timely review of all disclosures. The Office will complete a review of the patentability and marketability of IP and prepare a recommendation for the VPAA regarding the IP. The Office shall be responsible, working with creators, for obtaining patent, copyright, or other protection of IP owned by the College hereunder, and for marketing and licensing of all such IP rights. The Office shall also set up and manage individual expense and income accounts for IP that is vested in the College under this policy.

(XI) College Personnel who wish to pursue the commercialization of their independently developed and owned IP through the College may offer such intellectual property to the College by disclosing the IP to the Office of the VPAA. The Office will evaluate the commercial potential of the intellectual property and make a recommendation to the VPAA regarding the acceptance of the intellectual property. Acceptance of such IP by the College will be made at the sole discretion of the College and will require creator(s) to accept all provisions of this policy, including the assignment of rights and income distributions.

Net Revenue Distribution

(XII) Costs and Net Revenue: Unless otherwise agreed, Net Revenue shall mean Gross Revenue, consisting of any cash or cash proceeds that the College receives from the exploitation or use of, or grant of rights in respect of, or otherwise in connection with, an Invention or Copyrightable intellectual property (excepting payments to the College for research, or contributions to the College of equipment, which payments shall be the sole

property of the College and shall not be considered Gross Revenue for purposes of this policy), less (1) actual commercialization costs incurred by the College, including but not limited to costs for protection of intellectual property, marketing, advertising, legal fees, filing fees, licensing costs, and other costs actually incurred by the College, and (2) a percentage of Gross Revenue (to compensate the College for non-reimbursed costs) to be determined as follows: 10% of Gross Revenue up to the first \$150,000 of such Gross Revenue, and 2% of Gross Revenue over \$150,000.

(XIII) Distribution of Net Revenue: With respect to intellectual property owned by the College hereunder Net Revenue shall be distributed (usually annually), subject to the limitation on such distribution set forth below in the “Inventor/Creator Equity Participation” section, as follows:

60% to the Inventor(s)/creator(s) (personal)

40% to the College

In the event of joint inventors or joint authors, the amount allocated to the inventor/creator under the above schedule shall be divided equally among the joint inventors/creators, except as may be otherwise agreed to by the joint inventors/creators and approved by the Office of the VPAA.

In the event the College receives other than monetary consideration in connection with any intellectual property, such as equity in a business formed to commercially develop the intellectual property, such consideration shall be considered Gross Revenue and shall be apportioned according to the above schedule upon liquidation of the equity interest by the College. Any equity received by the College may be held by the College until such time that the College decides to liquidate such equity. The College has the sole right to determine the disposition of intellectual property in which it has an interest, and the sole right to determine when and in what manner to liquidate an equity position in a business formed to commercially develop the intellectual property.

The College may postpone the distribution of Net Royalty Income when future expenses relating to the applicable technology, such as patent prosecution costs, or an infringement suit, are reasonably anticipated.

Inventor/Creator Equity Participation

(XIV) College policy on conflict of interest allows inventors and creators to receive equity in return for their contributions to companies as founders or consultants, as long as the inventor or creator discloses his/her equity position to the College and is otherwise in compliance with the College Conflict of Interest Policy. In the event the inventor or creator receives equity from such company, and the College has negotiated as licensor with such company a royalty bearing license, or an option for such a license, with respect to intellectual property, the inventor/creator shall not be entitled to any share of Net

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Revenue received by the College and the College shall retain the portion that would have otherwise been allocated to the inventor/creator according to the above schedule of Net Revenue distribution.

College Personnel who are planning to direct or participate in a research program sponsored by a company in which they hold equity must disclose their equity position to the College, and agree to periodic review of their participation in the project by the VPAA or her/his designee. The purpose of such review is to assess potential conflicts between company sponsored research and other research programs in the inventor's laboratory and to monitor compliance with College policies.

Conflict Resolution

(XV) Administration of this policy shall be the responsibility of the VPAA. Questions should be directed to the Office of the VPAA regarding the application, interpretation or implementation of the policy, or regarding disagreement among inventors and/or creators concerning assignment of rights or sharing of royalties. Disagreement with any determination made by that Office may be directed to the VPAA or his/her designee for a final determination.

Use of Hamilton Name, Trademark, Service mark, or Insignia

(XVI) Hamilton College has an identity interest in trademarks and service marks, including the name, seal, and logo of the College. As such, these may not be used without the prior specific written consent of the College for any purpose, including:

- In conjunction with any private or commercial enterprise.
- In tandem with the advertisement of any product.
- By any individual or group promoting itself.

Use of the College's name, seal or logo on letterhead and business cards is standardized and regulated by the Office of Communications and Development.

Any questions regarding the use of the College's trademarks and service marks, including the name, seal, or logo of the College, in circumstances other than the ones listed above should be referred to the Vice-President for Communications and Development.

Additional College Personnel Responsibilities

(XVII) College Personnel shall execute any and all documents as the College may determine in its sole discretion may be necessary or desirable to effectuate the requirements and provisions of this policy.

Changes to this Policy

(XVIII) The College reserves the right to change this policy from time to time. The VPAA will normally develop proposed changes in consultation with appropriate committees of the faculty, college officers, and College Counsel. The President of the College has sole authority to approve changes to this policy.

Appendix

(Normal support) for College personnel is whatever sort of resources are regularly provided to that sort of person in that department at that time. Costly, exceptional, individually dedicated resources are generally not normal support. For instance, if an ITS staff member works on a special software project under a special budget request to the College for one-time money, that is not normal support to that staff member or to the ITS department. Similarly, if a faculty member gets one-time money, from the budget or the VPAA, that money is not normal support unless it is funding that is regularly offered. One-time funding to help a newly hired science faculty set up a laboratory *does* count as normal support, because it is regularly provided in science departments at this time.

Currently, normal support for a faculty member would include salary, an office, a basic computer, routine clerical services, access to the network and to site-licensed software, and occasional help from library and ITS staff. Funding and staff provided by outside sources (for instance, grants) is not considered when determining whether the College is providing only normal support. It is fully expected that the boundary between normal and special (non-normal) support will change over time.