

V:01:06 INTELLECTUAL PROPERTY/PATENTS AND COPYRIGHTS

PURPOSE

To provide guidelines and protect the interests of the public; of individual creators of novel concepts, inventions, and materials; of Volunteer State Community College; and of sponsorships of research and scholarship.

POLICY

It is the policy of Volunteer State Community College to: (1) encourage inventions and the production of copyrightable works by employees of the College; (2) facilitate the utilization of such inventions and works to the benefit of the public, the College, and the members of the College Community; and (3) provide for the equitable sharing of any proceeds derived from the commercial exploitation of inventions and copyrightable works in which, pursuant to this policy, the College is determined to have an interest. This policy is intended to protect the interests of all concerned parties: The College, members of the College community, external sponsors of research, and the public.

DEFINITIONS

“Author” means the person or persons responsible for the creation of a copyrightable work.

“Gross Income” as defined here is income coming to Volunteer State Community College and means proceeds from the sale, lease, or licensing of Intellectual Property by the College; dividends derived from equity received in consideration for the sale, lease, or licensing of Intellectual Property by the University; or proceeds from the sale of equity received in consideration for the sale, lease, or licensing of Intellectual Property by the College.

“Intellectual Property” means inventions and creative works.

“Invention” means any discovery, invention, new use or application, process, composition of matter, article of manufacture, know-how, design, model, technological development, or biological material.

“Inventor” means the person or persons responsible for the conception of an idea or ideas leading to an invention.

“Net Income” is gross income minus the direct costs associated with patent prosecution, copyright registration, commercialization, defense, maintenance, and administration of intellectual property.

“Scholarly works” include, but are not limited to, articles written for publication in academic journals, textbooks, work of art, musical compositions, and literary works. Theses and dissertations are not, for the purposes of this policy, scholarly works. Works by non-faculty employees shall not, for the purposes of this policy, be consider scholarly works.

“Scope of employment” refers to activities which have been assigned to an employee by his/her supervisor or which are performed during normal working hours or which fall within the

employee's job description.

“Significant use” means utilization of College funds, personnel, facilities, equipment, materials or other resources resulting in a cost to the College (direct, indirect, or depreciative) of more than \$2,500.

"Work" means any copyrightable material, such as literary works; musical works, including any accompanying words; dramatic works, including any accompanying music; pantomimes and choreographic works; pictorial, graphic, and sculptural works; motion pictures and other audiovisual works; sound recordings; architectural works; computer software or databases; circuit diagrams; architectural and engineering drawings; and lectures.

Authorization

Volunteer State Community College is authorized to seek and hold patents and copyrights, to assign its rights in intellectual property, and to execute agreements concerning royalty distribution.

Applicability

This policy shall apply to all persons employed (either as full-time, part-time or temporary employees) by Volunteer State Community College to students enrolled at Volunteer State Community College, and to other persons using the College facilities and resources. Contracts for works for hire between Volunteer State Community College and independent contractors should define the respective rights and responsibilities of the parties with respect to ownership of any intellectual property developed as a result of the contract.

Ownership of Intellectual Property

Intellectual property developed by persons to whom this policy applies shall be the sole and exclusive property of the College if the subject intellectual property is: (1) developed within the person's scope of employment with the College, (2) developed in the course of a project sponsored by the College, (3) developed with the significant use of the College's facilities, services, or equipment (personal office space, libraries and the inventor or author's personal computer provided by the College excluded), or (4) developed in the course of a project arranged, administered or controlled by the College and sponsored by persons, agencies or organizations external to the College, absent prior written agreement to the contrary. With respect to students, use of resources or facilities typically available to students in their educational activities shall not be considered "significant".

Prior to the College providing support (for example, release time or College funding) to a person to whom this policy applies, where that support could reasonably be expected to result in an invention or creation of a copyrightable work with commercial value, the College and the person or persons receiving that support shall agree in writing whether any intellectual property potentially arising from the supported activities would qualify as a scholarly work.

Intellectual property developed outside an employee's scope of employment, on the employee's own time and without the use of significant College resources shall be the sole and exclusive property of the Inventor or Author. In consideration of Institutional support in evaluating the intellectual property, seeking patent protection and / or pursuing commercialization activities, the College and the Inventor or Author may agree to assign all or a portion of the ownership rights to his/her invention or work to the College.

The College shall not assert ownership of "scholarly" works, regardless of whether the circumstances surrounding creation of the work satisfy one or more of the four tests outlined in this section for determining Institutional ownership. Disclosure of "scholarly" works is nonetheless required, subject to the condition that only those copyrightable works which could reasonably be expected to have commercial value must be disclosed.

Nothing in this policy shall preclude a mutually agreed upon contract between the College and persons to whom this policy applies wherein either party may agree to waive their rights under this policy.

ADMINISTRATIVE RESPONSIBILITIES

Inventors and Authors

Persons to whom this policy applies are responsible for disclosing to the College his/her invention or production of a copyrightable work which could reasonably be expected to have commercial value. Disclosure shall be made to the President of Volunteer State Community College, or to such person as the President may designate, using an Invention Disclosure Form (see Attachment 1) or Copyrightable Work Disclosure Form (see Attachment 2). The Inventor or Author shall fully cooperate with designated College personnel or Advisory Committee in the disclosure process and in other subsequent activities associated with patenting and / or commercialization of the invention or work.

In the event that two or more persons are entitled to claim ownership of the intellectual property, the Inventors or Authors shall reach agreement between or among themselves regarding relative contributions for the purposes of distribution of net income from the Invention or Work. That agreement should be in writing and be notarized. The agreement will be required prior to the President's initial decision regarding whether to pursue patent protection or commercialization of the intellectual property.

Inventors should particularly note that certain acts (for example, enabling disclosure of the Invention in an academic journal) can constitute a statutory bar to patent protection. An Inventor contemplating public disclosure activities prior to filing an Invention Disclosure Form should contact the TBR Office of the General Counsel prior to engaging in those disclosure activities.

Intellectual Property Advisory Committee

The President of Volunteer State Community College shall at his/her discretion, appoint faculty, staff and other persons experienced in intellectual property matters to an Intellectual Property Advisory Committee. The Disclosure Form shall be forwarded to the Committee for an

evaluation of the ownership, patentability and/or commercial potential of the invention or work. The Committee shall conduct an interview with the Inventor or Author and other persons as needed to make this evaluation. A patentability evaluation shall in particular include a thorough evaluation of acts by the Inventor or items of prior art which would bar patent protection. The Committee shall provide the President of the College with its recommendations as to ownership of the intellectual property, whether patent protection should be sought, and whether to seek commercialization opportunities. The Committee shall conduct investigations as it deems necessary in the preparation of its recommendations to the President. The Committee is authorized to seek outside assistance in preparing its recommendations. Any compensated assistance obtained from private legal counsel must be approved in advance by the Attorney General of the State of Tennessee. The Committee shall also generally advise the President in all matters relating to this Policy.

For those inventions or works in which the College is deemed to have an ownership interest, following a decision by the President (or the President's designee) to seek patent protection, copyright registration, and / or commercialization of the intellectual property, the Committee will arrange to have those activities undertaken. All direct costs associated with those activities shall be borne by the Volunteer State Community College.

TBR Office of the General Counsel

The Tennessee Board or Regent's Office of the General Counsel is available to support Volunteer State Community College, and specifically the Intellectual Property Advisory Committees, in evaluating the inventorship, ownership, and patentability of inventions disclosed to the College. To the extent that appropriate resources exist, the TBR Office of the General Counsel shall be available to support prosecution of patent applications. The Office of the General Counsel is further available to the Volunteer State Community to support the drafting of licensing agreements. The Office of the General Counsel shall receive and evaluate disclosures originating from the College when no Advisory Committee has been appointed.

College President

The President of Volunteer State Community College is responsible for decisions regarding ownership of the intellectual property and for the decision of whether to pursue patent protection or commercialization of the Invention or Work. These decisions are to be based on the recommendations of the Intellectual Property Advisory Committee, as well as additional counsel the President may choose to seek from other sources. The President will inform the Inventor or Author of his/her decisions through the Advisory Committee. The President is authorized to make decisions regarding royalty distribution which deviate from the royalty distribution rules adopted by the College, subject to the provisions of Section 8 of this Policy.

If the College decides to neither seek patent protection nor pursue commercialization of the intellectual property, and the College has an ownership interest in the intellectual property, the President may decide to assign the College ownership interest to the Inventor or Author.

For inventions made in the course of a project funded in whole or in part by the Federal Government, the Bayh-Dole Act (37 CFR 401) imposes certain reporting requirements

associated with the technology transfer process. The President shall designate the party responsible for ensuring that those reporting requirements are satisfied.

Subject to other Volunteer State Community College or TBR Policies, the President shall have the responsibility for approving any and all agreements associated with commercialization of the intellectual property.

The President is authorized to delegate any or all of these responsibilities, subject to the approval of the Chancellor of the Tennessee Board of Regents.

Appeals

The Inventor or Author may appeal decisions of the President or those of his/her designee. If the Inventor or Author disagrees with an initial decision, he or she may request a re-evaluation by the President. The President is not authorized to delegate responsibilities relative to appeals. The request must be received within thirty (30) calendar days of notification to the Inventor or Author of the initial decision. The Inventor or Author may submit documents or other evidence in support of his/her position. A second and final decision by the President relating to ownership or royalty distribution may be appealed to the Chancellor of the Tennessee Board of Regents. Decisions of the TBR Chancellor shall be binding.

Income from Intellectual Property

Income derived from the commercialization of intellectual property in which the College has an interest shall be first applied toward any direct expenses incurred by the College in seeking patent protection or copyright registration or in pursuing commercialization of the intellectual property.

The portion of the net income the College retains from royalties and any other intellectual property-related income shall be deposited in a restricted account, and used by the College where the income-producing creation originated for the enhancement of research and instructional programs. The funds may be used for other purposes if specifically approved by the Chancellor of the Tennessee Board of Regents System.

Volunteer State Community College shall adopt rules regarding income distribution between the College and Inventors or Authors. In no case shall the Inventor's or Author's share be less than 40 percent of the annual net income from the intellectual property.

Volunteer State Community College is authorized, subject to the approval of the Chancellor of the Tennessee Board of Regents System, to accept equity in lieu of cash in total or partial consideration for use of the College intellectual property rights. Dividend income and income received from the sale of equity shall be divided in accordance with the distribution rules adopted by the College.

DISTRIBUTION OF PROCEEDS

For all discoveries, inventions or developments for which Volunteer State Community College receives proceeds, Volunteer State Community College shall deduct all expenses incurred pertinent to the technology and not recovered previously for patent protection, copyright registration, or in pursuing commercialization of the intellectual property.

The remaining net proceeds shall be distributed as set forth below:

Cumulative Net Lifetime Proceeds	Inventor*	Division‡	College and/or Affiliated Org.
0-\$100K	50%	10%	40%
>\$100K	40%	15%	45%
‡In the event the Division/Department is dissolved, this fraction reverts to the College and/or affiliated organization.			

TBR Source: SBR Meeting, September 24, 1982; TBR Meeting, September 21, 1990, TBR Meeting, June 21, 2001.

VSCC Source: November 11, 1987, President; November 4, 1998, President; December 1, 2008, President's Cabinet



ATTACHMENT 1

COPYRIGHTABLE WORK INVENTION DISCLOSURE FORM

Attach additional sheets as needed.

1. **Title of the Invention:**

2. **Inventor information:**

Name: _____

Phone: _____

Position: _____

Department: _____

E-mail: _____

Nature of Contribution: _____

3. **Funding:**

Please indicate any source of funding associated with the research leading to the invention:

- Federal Government
- External, other than Federal Government
- Internal
- None

If the invention was made wholly or in part as a result of external funding, please provide the following information:

Sponsoring Agency: _____

Contract or Grant Number: _____

Please attach a copy of the contract associated with the external funding.

4. **Other support:**

For each of the inventors, were you specifically assigned to work on the invention by your supervisor? Did you work on development of the invention during your normal work hours?

Has the Institution provided support to the development of the invention by providing resources, materials or access to facilities and equipment? If yes, please describe.

5. Background of the Invention:

Please list any prior work or reference from which this invention was derived.

Does the invention incorporate any materials provided by a third party? If so, please describe and provide a copy of the materials, if possible.

6. When was the invention conceived? If the invention has been reduced to practice (built or synthesized), when did that occur?

7. Invention Description:

Briefly summarize the nature and function of your invention. State such factors as: novelty which distinguishes your invention from existing technologies; what problem(s) it solves, and advantages over existing technologies; specific utility in the marketplace and potential commercial interests. Describe the current stage of development of the invention, enclosing any photographs or drawings of a prototype or conceptual design.

8. Prior Disclosures:

Has the invention been described in a printed publication in sufficient detail to allow a skilled person to understand and to make or use the invention? If so, please provide date of the publication and a copy of the article.

Have you presented any information about your invention at any conferences or meetings? If so, please provide the name of the conference or meeting, its date, a copy of any paper presented, and a copy of any visual aids used in the presentation.

Has there been any offer to sell the invention? If so, please describe when, where, to whom and whether the offer was accepted

Has the invention been used in public (for example, has there been testing of the invention witnesses by persons outside of the research team)? If so, please describe the circumstances, and indicate if non-disclosure statements were signed by persons witnessing the use.

9. **Potential licensees:**

Please list any companies, and contacts within those companies, if known, which you believe might be interested in licensing this invention or sponsoring further research:

Author 1 Signature and date _____

Printed Name _____

Author 2 Signature and date _____

Printed Name _____

I have reviewed and concur with the information contained in the statement.

Department Head/Chair (s)

Date

Dean (s) Signature

Date

Vice President (s) Signature

Date

ALL INFORMATION CONTAINED HEREIN IS CONSIDERED CONFIDENTIAL
INFORMATION OF VOLUNTEER STATE COMMUNITY COLLEGE AND THE
TENNESSEE BOARD OF REGENTS.



ATTACHMENT 2

COPYRIGHTABLE WORK DISCLOSURE FORM

Attach additional sheets as needed.

1. Title of the Work:

2. Author information:

Name: _____

Phone: _____

Position: _____

Department: _____

E-mail: _____

Nature of Contribution: _____

Name: _____

Phone: _____

Position: _____

Department: _____

E-mail: _____

Nature of Contribution: _____

3. Funding:

Please indicate any source of funding associated with the research leading to the work:

Federal Government

External, other than Federal Government

Internal

None

If the work was created wholly or in part as a result of external funding, please provide the following information:

Sponsoring Agency: _____

Contract or Grant Number: _____

Please attach a copy of the contract associated with the external funding.

4. Other support:

For each of the inventors, were you specifically assigned to work on the invention by your supervisor?

Yes No

Did you work on development of the invention during your normal work hours?

Yes No

Has the College provided support to the development of the invention by providing resources, materials or access to facilities and equipment? If yes, please describe.

5. Description of the Work:

Briefly summarize the nature of the work. Describe any commercial potential you see for the Work.

6. Potential Licensees:

Please list any companies, and contacts within those companies, if known, which you believe might be interested in licensing this work:

Author 1 Signature and date _____

Printed Name: _____

Author 2 Signature and date _____

Printed Name: _____

