

Intellectual Property

Intellectual Property Policy of Carnegie Mellon University (<https://www.cmu.edu/policies/administrative-and-governance/intellectual-property.html>)

1. Purpose

The policy reflects the following goals:

- To create a university environment that encourages the generation of new knowledge by faculty, staff, and students.
- To facilitate wide transfer of useful inventions and writings to society.
- To motivate the development and dissemination of intellectual property by providing appropriate financial rewards to creators and the university, and administrative assistance to creators.
- To ensure that the financial return from the development of intellectual property does not distort decisions and operations of the university in a manner contrary to the mission of the university.

The policy is based upon the following principles relating the university to society:

- The mission of the university remains the generation and dissemination of knowledge.
- Intellectual property will be generated within the university, and there exists an obligation to disseminate it. An interface is needed if better technology transfer is to be achieved, and the university will provide mechanisms for that function.^[1]

The policy is based upon the following principles relating faculty, staff and students to the university.

- Intellectual property is created by individuals, or by groups of individuals, who are entitled to choose the course of disclosure; academic freedom of individuals is a higher priority than possible financial rewards.
- There exists an historical tradition allowing authors to retain ownership of intellectual property rights from textbooks and works of art.
- The university is the support of the whole campus community, and is thereby entitled to share in financial rewards.
- There should be incentives for all parties to pursue financial rewards together, consistent with the expressed goals of the policy. The distribution of these rewards should reflect, insofar as possible, the creative contributions of the creator, and the resources contributed by and risks assumed by both the creator and the university in developing intellectual property.
- Since it is frequently difficult to meaningfully assess risks, resources and potential rewards, negotiated agreements are to be encouraged whenever possible.

Footnote:

^[1]This document presumes the existence of a university office to facilitate technology transfer (<http://www.cmu.edu/cttec/>). Such an office would serve as a clearinghouse for contacts with outside partners, would perform patent and copyright tasks, and would develop an effective marketing capability.

2. Definitions

Certain terms are used in this document with specific meanings, as defined in this section. These definitions do not necessarily conform to customary usage.

Intellectual Property includes any patentable invention, any copyrightable subject matter, or trade secret. It also includes works of art, and inventions or creations that might normally be developed on a proprietary basis.

University means Carnegie Mellon.

Student means any full-time or part-time graduate or undergraduate student, regardless of whether the student receives financial aid from the university or from outside sources. It is the responsibility of students who are also employees of other outside entities to resolve any conflicts between this policy and provisions of agreements with their employers prior to beginning any undertaking at the university that will involve the development of intellectual property.

Faculty means members of the university's Faculty Organization as defined in the Faculty Handbook, plus instructors and special faculty appointments (even in the first year), and part-time faculty.

Staff means any employee of the university other than students and faculty as defined above. If a student is also a part-time university employee, he is considered as staff with regard to intellectual property developed as a result of his employment, and as a student with regard to other intellectual property. A full-time non-faculty employee who is also taking one or more courses is considered to be staff. Visitors to the university who make substantial use of university resources are considered as staff with respect to any intellectual property arising from such use. (The distinction between faculty and staff does not affect intellectual property rights except for representation on the Intellectual Property Adjudication Committee [see Section 5]).

Creator means any person or persons who create an item of intellectual property.

Net proceeds to the university means all proceeds received by the university on intellectual property that it assigns, sells or licenses, minus any application, litigation, interference, or marketing costs directly attributable to the intellectual property being licensed. Deducted costs shall be reasonable and fair, and shall be properly disclosed; the sources and amounts of compensation shall also be properly disclosed.

Net proceeds to the creator means all proceeds received by the creator from intellectual property owned by him that he sells, assigns or licenses, less the costs of application, legal protection, or litigation, interference, travel and other marketing costs directly attributable to the intellectual property being exploited. Such net proceeds do not include compensation legitimately received by the creator for consulting services or interest or other return on invested labor or capital. Deducted costs shall be reasonable and fair, and shall be properly disclosed; the sources and amounts of compensation shall also be properly disclosed.

Substantial use of university facilities means extensive unreimbursed use of major university laboratory, studio or computational facilities, or human resources. The use of these facilities must be important to the creation of the intellectual property; merely incidental use of a facility does not constitute substantial use, nor does extensive use of a facility commonly available to all faculty or professional staff (such as libraries and offices), nor does extensive use of a specialized facility for routine tasks. Use will be considered "extensive" and facilities will be considered "major" if similar use of similar facilities would cost the creator more than \$5000 (five thousand dollars) in constant 1984 dollars if purchased or leased in the public market. Creators wishing to directly reimburse the university for the use of its facilities must make arrangements to do so before the level of facilities usage for a particular intellectual property becomes substantial. (This provision is not intended to override any other department or university policy concerning reimbursement for facilities usage.)

In General:

In any given year the equivalent figure for a particular amount of money in constant 1984 dollars will be obtained by multiplying that amount of money by the ratio of the most recent quarterly Disposable Personal Income Deflator divided by the average monthly Disposable Personal Income Deflator for the year 1984.

As used in this policy, the masculine gender includes the feminine gender, singular or plural, wherever appropriate.

3. Policy Provisions

This section states the policies concerning ownership of intellectual property created at the university. In order of precedence, ownership of intellectual property shall be as follows:

3-1. Externally Sponsored Work

Ownership Provisions: Intellectual property created as a result of work conducted under an agreement between an external sponsor and the university that specifies the ownership of such intellectual property shall be owned as specified in said agreement. If the university declares itself to be a sponsor, but does not declare itself to be the owner of the intellectual property, ownership shall be determined in accordance with 3-6-4 below.

Procedural Provisions: It is the responsibility of the Office of Sponsored Research of the university to inform each person whose intellectual property rights are limited by an externally sponsored contract of the intellectual property provisions of that contract in advance of the beginning of work thereon. Such notice is to be in writing and the university may require written acknowledgment of such provisions by any person working on externally sponsored projects. A summary of external sponsorship agreements limiting the intellectual property rights of potential creators will

be maintained by the Office of Sponsored Research and will be available to the general university community.

If the university fails to notify a creator, effectively and in advance, of limitations imposed on his intellectual property rights by external sponsorship agreements, the creator is entitled to receive from the university 50% (fifty percent) of the net proceeds to the university resulting from his intellectual property.

3-2. Internally Sponsored Work

Ownership Provisions: When the university provides funds or facilities for a particular project to the extent of substantial use, it may also choose to designate itself as sponsor of that work. The university may declare itself the owner of intellectual property resulting from said work. In such cases the university must specify in advance the disposition of any intellectual property rights arising from the project. If the university declares itself to be a sponsor, but does not declare itself the owner of the intellectual property, ownership shall be determined in accordance with **3-6-4** below.

Procedural Provisions: It is the responsibility of the Office of Sponsored Research of the university to inform each person whose intellectual property rights are limited by internally sponsored work of the intellectual property ownership rights specified by the university as to that work in advance of the beginning of work thereon. Such notice is to be in writing and the university may require written acknowledgment of such provisions by any person working on internally sponsored projects. A summary of work for which university sponsorship limits the intellectual property rights of potential creators will be maintained by the Office of Sponsored Research and will be available to the general university community.

If the university fails to notify a creator, effectively and in advance, of limitations imposed on his intellectual property rights by internal university sponsorship, the creator is entitled to receive from the university 50% (fifty percent) of the net proceeds to the university resulting from his intellectual property.

3-3. Individual Agreements

Ownership Provisions: Intellectual property which is the subject of a specific agreement between the university and the creator(s) thereof shall be owned as provided in said agreement. Such agreements by the university and the faculty are encouraged.

Procedural Provisions: Except where limited by external sponsorship agreements, creators and the university may negotiate individual agreements to govern ownership of intellectual property regardless of the applicability of any other provision hereof.

3-4. Intellectual Property Created Within Scope of Employment

Ownership Provisions: Intellectual property created by university employees who were employed specifically to produce a particular intellectual property shall be owned by the university if said intellectual property was created within the normal scope of their employment. Faculty are presumed not to be hired to produce a particular intellectual property. On the other hand, computer programs written on the job by staff computer programmers would fall under this provision.

3-5. Public Dedication

Ownership Provisions: Except when limited by subparts **3-1**, **3-2**, **3-3** or **3-4** above, the creator of any intellectual property may choose to place his or her creation in the public domain. In such cases both the creator and the university waive all ownership rights to said property.

Procedural Provisions: Creators wishing to place their intellectual property in the public domain are responsible for ascertaining that the right to public dedication of that intellectual property is not limited by any external agreement, university sponsorship arrangement or terms of employment as described in Provisions **3-1**, **3-2** or **3-3** above. The university provost will provide such a determination in writing upon request by the creator. It is also the creator's responsibility to ensure that disclosure does not include valuable intellectual property owned by others. (This provision does not release the university from its general obligation to notify creators of limitations to intellectual property rights specified in Provisions **3-1** and **3-2** above.)

To facilitate the actual transfer of knowledge of the intellectual property to the public at large, the creator shall provide the university with a complete description and documentation of the property placed in the public domain, specifically including a copy of the property in the case of printed material, and complete machine-readable source code in the case of software. All such material provided to the university will be placed in the University Library and made available to the public at large. The university will take appropriate action on a regular basis to publicize summary descriptions of intellectual property recently placed in the public domain. The university will

also provide any member of the general public copies of such material on a cost-recovery basis.

The provisions of this section do not apply to the normal scholarly or creative publication processes unless the creator intends to waive all proprietary rights to the publication.

3-6. In General

Unless governed by subparts **3-1**, **3-2**, **3-3**, **3-4** or **3-5** above, ownership of intellectual property created at the university shall be determined as follows:

3-6-1. Traditional Rights Retained

Ownership Provisions: In keeping with academic traditions at the university, the creator retains all rights to the following types of intellectual property, without limitation: books (including textbooks), educational courseware, articles, non-fiction, novels, poems, musical works, dramatic works including any accompanying music, pantomimes and choreographic works, pictorial, graphic and sculptural works, motion pictures and other similar audio-visual works, and sound recordings, regardless of the level of use of university facilities. This provision does not include computer software (other than educational courseware) or data bases.

Procedural Provisions: The types of intellectual property listed in the preceding paragraph share the attribute that they display information or visual or auditory appearances which are fully revealed to the purchaser or consumer. Thus, for example, source code listings would also be considered within this category. On the other hand, most computer software and data bases do not share this attribute; they are characterized by their capacity to perform tasks. Because of their utilitarian nature, ownership rights with respect thereto are governed by **3-6-3** or **3-6-4**. Educational courseware is included in this provision in all cases because of its role in furthering the primary educational mission of the university.

This provision applies regardless of any university sponsorship of the work, and it may be modified only by a specific prior agreement between the creator and the university. The use of university-owned computers and other facilities in the preparation of books and similar works does not alter this provision, though other university policies may limit such use or require reimbursement to the university. Similarly, the use of externally sponsored resources does not alter this provision, unless the creator is effectively notified in advance of such limitations to his rights in accordance with **3-1**.

3-6-2. No Substantial Use of University Facilities

Ownership Provisions: The creator owns all intellectual property created without substantial use of university facilities, including intellectual property rights in computer software and data bases.

3-6-3. Substantial Use of University Facilities - No External or Internal Sponsorship

Ownership of intellectual property created with substantial use of university facilities, but not directly arising from externally sponsored work, or from work for which the university has declared itself as sponsor, shall be determined as set forth hereinafter depending on whether the creator or the university develops said property.

3-6-3-1. Development by Creator

Ownership Provisions: The creator originally owns intellectual property created with substantial use of university facilities but no external or internal sponsorship, and retains said ownership by commercial development of said property subject to the following: (i) the university shall receive 15% (fifteen percent) of the net proceeds to the creator above \$25,000 (twenty-five thousand dollars) in constant 1984 dollars from all sources (in the case of patents and copyrights, this provision shall be limited to the life of the patent or copyright), and (ii) the university shall receive a perpetual, non-exclusive, non-transferrable, royalty free license to use said intellectual property. In the case of software, this license includes access by specified university personnel to the source listings, and the university shall require each person to whom a disclosure is made to execute in advance a binding confidentiality agreement in favor of and enforceable by the creator. If the intellectual property is created solely by a student or students, the creator is exempt from the obligation to pay to the university a fraction of his net proceeds, but not from the provision of this paragraph for a non-exclusive license to the university.

Procedural Provisions: If the creator develops an intellectual property that is covered by this provision, he must make full and fair disclosure to the university of all such sources of compensation relating to that intellectual property.

3-6-3-2. Development by the University

Ownership Provisions: When intellectual property is created with substantial use of university facilities, but not directly arising from sponsored research, the creator will originally retain the rights to the property, provided that he desires to commercially develop the property

himself or to make it available to the public. If, however, the creator elects not to commercially develop same or fails to show diligence in pursuing such development, then the ownership rights to that property may be acquired by the university. Intellectual property acquired by the university in this fashion will be treated as in **3-6-4-1** below.

Procedural Provisions: At the time the intellectual property is disclosed to the university's provost as required under Section **4-1**, or at any time thereafter, the university may request that the creator decide whether he will develop the intellectual property or will grant the rights to the university, and execute documents to pass on the title. Such a decision must be made within one year of the request or the creator will automatically lose his rights in favor of the university.

3-6-4. Substantial Use of University Facilities - External or Internal Sponsorship

Ownership of intellectual property created with substantial use of university facilities and directly arising from work sponsored under an agreement between an external sponsor and the university, or from work for which the university has declared itself a sponsor, but for which neither the external sponsor nor the university have specified the ownership of resulting intellectual property shall be determined as set forth hereinafter depending on whether the creator or the university develops said property.

3-6-4-1. Development by University

Ownership Provisions: The university originally owns intellectual property created with substantial use of university facilities provided by an external agreement or internal university sponsorship and retains said ownership by commercial development of said property, subject to the following: in all cases, the creator shall receive 50% (fifty percent) of the net proceeds to the university.

Procedural Provisions: When an intellectual property is created with substantial use of university resources provided by an external research contract or a specific university sponsorship agreement, and when that contract or agreement either does not specify the disposition of the intellectual property rights arising from that sponsorship, or it permits the university and/or creator to retain or acquire such intellectual property rights, the university will originally retain the rights to such intellectual property.

3-6-4-2. Development by Creator

Ownership Provisions: When intellectual property is created with substantial use of university facilities provided by external or internal sponsorship, the university will originally retain the rights to the property, provided that it desires to commercially develop the property or to make it available to the public. If, however, the university elects not to commercially develop same or fails to show diligence in such development, the ownership rights to that property may be acquired by the creator. Intellectual property acquired by the creator in this fashion will be treated as in **3-6-3-1** above. This assignment of rights to the creator may be prohibited by the terms of an external sponsorship agreement with the university or by an internal university sponsorship declaration, but in such cases the creator must be notified in advance, as in Provisions **3-1** and **3-2**.

Procedural Provisions: At the time the intellectual property is disclosed to the university's provost as required by Section **4-1**, or at any time thereafter, the creator may request that the university decide whether it will commercially develop the intellectual property or execute an assignment of the intellectual property rights to the creator. Such a decision must be made within 120 (one hundred twenty) days of the request or the university automatically waives its rights in favor of the creator, and it must execute an assignment of these rights to the creator.

3-6-5. Consulting Agreements

Ownership Provisions: Work done by individuals as consultants to outside firms is presumed not to involve unreimbursed substantial use of university facilities, and the rights to intellectual property created under consulting agreements are retained by the outside firms or the individual as specified by the terms of the consulting agreement and the terms of Provision **3-6-2** above.

Procedural Provisions: Under university policy consulting work must not make substantial unreimbursed use of university facilities except by explicit prior agreement. Any member of the university community who is engaged in consulting work or in business is responsible for ensuring that provisions in his agreements are not in conflict with this policy of the university or with the university's commitments. The university's Innovation Transfer Office will, upon request, provide assistance in this respect. The university's rights and the individual's obligations to the university are in no way abrogated or limited by the terms of such agreements. Each creator of intellectual property should make his obligations to the university clear to those with whom he makes such agreements and should ensure that they are provided with a current statement of the university's intellectual property policy.

Appropriate sample contract wording to cover various possible external consulting arrangements shall be available from the university provost.

4. General Procedures

4-1.

The creator of any intellectual property that is or might be owned by the university under this policy is required to make reasonably prompt written disclosure of the work to the university's provost, and to execute any document deemed necessary to perfect legal rights in the university and enable the university to file patent applications and applications for copyright registration when appropriate. This disclosure to the provost should be made at the time when legal protection for the creation is contemplated, and it must be made before the intellectual property is sold, used for profit, or disclosed to the public. Whenever legal protection for intellectual property is anticipated all persons engaged in such creative activity are encouraged to keep regular notebooks and records.

4-2.

Whenever the university undertakes commercial development it shall do so, if possible, in a fashion that provides for the widest possible dissemination, avoiding suppression of inventions from which the public might otherwise benefit, providing for non-exclusive licensing at reasonable royalties, and giving consideration to more favorable or royalty-free licensing to non-profit charitable institutions, minority businesses or enterprises in developing countries.

4-3.

The university's share of any proceeds under this policy will be used to reimburse the university for its expenses for commercial development of intellectual property. Any additional return to the university will be used to further the academic purposes of all the disciplines of the entire university.

5. Resolution of Disputes

This policy constitutes an understanding which is binding on the university and on the faculty, staff, and students upon whom it is effective according to the terms of Section 6 below, as a condition for participating in research programs at the university or for the use of university funds or facilities.

Any question of interpretation or claim arising out of or relating to this policy, or dispute as to ownership rights of intellectual property under this policy, will be settled by the following procedure:

1. The issue must first be submitted to the university's Intellectual Property Adjudication Committee in the form of a letter setting forth the grievance or issue to be resolved. The committee will review the matter and then advise the parties of its decision within 60 days of submission of the letter.
2. If any of the parties to the dispute is not satisfied with the committee's decision, the party may seek binding arbitration in Pittsburgh, Pennsylvania and in accordance with the Rules of the American Arbitration Association then in effect. Judgment upon the award rendered by the arbitrator(s) may be entered in any court having jurisdiction thereof. The arbitrator(s) will give some weight to the decision of the Intellectual Property Adjudication Committee in reaching a decision. The losing party of the arbitration hearing will pay for all costs of the arbitration unless the arbitrator(s) specifies otherwise.

The Intellectual Property Adjudication Committee will consist of a chair who is a member of the tenured faculty, four other members of the faculty, and four other members representing, respectively, the university administration, the technical staff, and the graduate and undergraduate student bodies. Initially, half of the members of the committee (including the chair) will be appointed for two-year terms of office, and the remaining half will be appointed for a one-year term. After one year new members of the committee will be appointed for two-year terms of office. The chair will be appointed by the chair of the Faculty Senate, with the advice and consent of the Faculty Senate Executive Committee, and the remaining eight members of the committee will be appointed by the president of the university or his designee. At all times at least one of the faculty members will have had significant practical experience with intellectual property development and exploitation. The faculty members appointed by the president of the university will be selected from a list of nominees prepared by the Faculty Senate or its designated committee and nominees with experience in intellectual property development will be identified as such by the Faculty Senate. The staff representative will be selected from a list of nominees prepared by Staff Council, and the administration representative will be named directly by the president of the university or his designee. The graduate student representative will be selected from a list of nominees prepared by the Graduate Student Organization. The undergraduate

representative will be chosen from a list of nominees prepared by the Student Senate. The committee will use the guidelines set forth in this policy to decide upon a fair resolution of any dispute.

If possible, the committee will also provide on request informal advisory opinions to creators and the university indicating how it is likely to interpret the provisions of this policy as it applies to special cases.

6. Effective Date of Policy

This policy will become effective August 27, 1985. Once effective this policy will be binding on new faculty, administration, and staff when hired, and on graduate and undergraduate students when admitted. Current faculty and staff will also become bound by this policy when they sign new employment contracts as the result of the renewal of limited-term appointments or promotion. Other university personnel, including tenured faculty, and current staff and students may choose to become bound by this policy for future and pending intellectual property by voluntary written consent. Unless the creator and the university agree to a different arrangement, intellectual property that is already partially developed at the time this policy becomes effective will be treated according to the provisions of the patent policy by which the creator is currently bound. Similarly, members of the university working under contracts signed before the effective date of this policy who do not choose to accept this policy will remain bound by the patent policies that already apply to them. With respect to intellectual property developed during the course of employment at the university, this policy shall continue to be binding on any person whose relationship with the university becomes terminated. The university should take all administrative steps necessary to ensure that employees and students sign, upon initial employment, registration or at other appropriate times, forms that indicate their acceptance of this policy.

7. Amendments of the Policy

Amendments of this policy may be proposed by the Faculty Senate, Staff Council or university administration. Proposed amendments must be approved by a two-thirds majority of votes in the Faculty Senate and subsequently approved by a simple majority of votes cast in a referendum administered by the Faculty Senate that is open to all members of the faculty as defined by this policy and to the exempt staff, provided that this majority constitutes at least 25% of those eligible to vote. This referendum must be preceded by an opportunity for public discussion open to all interested faculty, administration, staff and students. Amendments that are supported by the faculty and staff must then be approved by the president of the university and adopted by the university trustees. Once adopted, amendments will become binding on new faculty, administration, and staff when hired, on existing faculty and staff when they sign new employment contracts, and on graduate and undergraduate students when admitted. Other university personnel, including tenured faculty, and current staff and students may choose to become bound by this policy for future and pending intellectual property by voluntary written consent. Intellectual property that is already developed or under development at the time that an amendment to the policy is ratified will not be bound by the terms of the amendment without the voluntary written consent of both the creator and the university.