



POSITION STATEMENT

UNIVERSITY INTELLECTUAL PROPERTY GUIDELINES

*Adopted by the IEEE-USA
Board of Directors, 15 June 2007*

IEEE-USA recommends that universities and colleges follow these guidelines in developing policies and procedures on intellectual property developed by their faculty, staff and students.

1. Dissemination of Written Policy

University policies and procedures should be in writing and clearly state the intellectual property that the university considers its own and any laws applicable to its intellectual property policies. IEEE-USA suggests that such written policy be disseminated to all faculty, staff and students to whom it applies, and a policy summary should be included in the university catalog or other material sent to applicants. The summary should indicate the procedures required to receive a complete copy of the policy.

IEEE-USA suggests that the university also obtain signed intellectual property agreements from all applicable faculty, staff and students, indicating that they have been informed of the university's intellectual property policies, and agree to abide by them. The university should also inform faculty, staff and students who will be working on a grant or contract whenever that grant or contract contains terms that affect the ownership of intellectual property. [Note: Government policy concerning use of federal funds for research already requires written agreements with researchers that they will promptly disclose all subject inventions in writing, and will assist in securing patents.]

IEEE-USA urges universities to establish programs to educate their faculty, staff and students in intellectual property rights. These programs should provide the necessary steps for securing intellectual property protection, information on events that can cause the loss of intellectual property rights, and information concerning the university's specific intellectual property policies and procedures.

2. Intellectual Property Subject to Policy

IEEE-USA suggests that universities clearly indicate what intellectual property produced by faculty, staff or students is considered to be the property of the university, and what intellectual property is owned by its creator. Such policy should treat intellectual property consistently. The treatment of computer software is of particular concern.

Computer software should be treated in the same manner as other creative works covered by copyright law. If the intellectual property policy gives ownership in textbooks, journal articles, musical compositions, and the like to its creator -- regardless of whether university resources were used in its creation -- then the same ownership should hold for computer software.

Computer software can be protected by copyright and, in some instances, patents. Ownership in intellectual property expression rights to computer software should not depend on whether the software might be patentable.

Several states have laws that limit claims of intellectual property ownership by employers to the business activities of the employers, rather than all intellectual property developed by their employees. IEEE-USA supports laws granting employees ownership of intellectual property developed outside of their employment without the use of employer resources. Students' rights should be no less than those of employees.

Determining what intellectual property a university should own is more complicated. Unlike companies doing business in specific areas, university research activities are simply the sum of the research interests of its faculty. A test other than "related to employer business" should be used in this special case of university faculty.

IEEE-USA recommends that the test for ownership of intellectual property should be whether it was produced as part of a specific job assignment of faculty, staff or students. Intellectual property produced as part of the general activities expected of faculty or students, such as teaching, artistic creation, or unfunded research, should be owned by its creator. Intellectual property developed under a specifically funded research project or a specific university assignment should be owned by the university or as specified in the research agreement.

If intellectual property ownership requirements are associated with a proposed contract or grant, all faculty, staff, or students who will be working on that grant or contract should be made aware of those requirements as soon as they are known to the university.

3. Student-Produced Intellectual Property

IEEE-USA strongly recommends that intellectual property students produce as part of their course work, thesis or dissertation research, other than funded research for which the university has obligations to others, should be owned by the students, not the university. This theory follows because students are not acting as university employees when they are taking a class or writing a thesis or dissertation.

Intellectual property that students create in the course of their university employment on a specific project, except for a student-written thesis or dissertation, as well as intellectual property

developed with university resources to the extent that use exceeds what is normally provided students, should be the property of the university.

4. Sharing of Intellectual Property Income

IEEE-USA recommends that a portion of the net proceeds from the sale or licensing of intellectual property by a university be returned to its creators to foster a culture of practical innovation. This portion should be based not only on cash royalties received, but also on stock or other assets the university receives. While IEEE-USA does not recommend a specific percentage share for the creators, 40 to 50 percent of net proceeds is common. A portion of the university's share should go directly to the creators' academic unit (college or department), to encourage future intellectual property development.

In computing net proceeds from the sale or licensing of intellectual property, IEEE-USA thinks that only the external expenses of securing any necessary protection for the intellectual property should be deducted from the income for that property. Such expenses would include patent application and attorney fees, patent maintenance fees, and copyright registration fees. Operation costs of the university's technology transfer program (whether internal or external), which should be supported through the university's share of the proceeds of intellectual property sales or licensing, or general university funds or other overhead should not be included.

IEEE-USA also encourages universities to make its technology transfer program expertise available on a low-cost basis to faculty, staff and students who wish to have the university assist in the licensing of intellectual property owned by those faculty, staff or students.

5. Other Considerations

IEEE-USA recommends that successful creation of intellectual property be considered during any review of a faculty member for retention, promotion or tenure.

IEEE-USA also recommends that when a faculty members moves to a new university, their prior university should license any intellectual property that the faculty member created for research and development purposes only to the new university at no cost -- to permit the faculty members to continue research without concern for infringing upon intellectual property rights they originally created. The prior university will retain all rights to commercialize or otherwise license the intellectual property, but the new university or the faculty member (as appropriate under the new university's intellectual property policy) will have the rights to any improvements based on the prior university's intellectual property.

This statement was developed by the Intellectual Property Committee of the IEEE-United States of America (IEEE-USA) and represents the considered judgment of a group of U.S. IEEE members with expertise in the subject field. IEEE-USA is an organizational unit of the Institute of Electrical and Electronics Engineers, Inc., created in 1973 to advance the public good and promote the careers and public policy interests of the more than 220,000 technical professionals who are U.S. members of the IEEE. The positions taken by IEEE-USA do not necessarily reflect the views of the IEEE or its other organizational units.

Appendix -- Summary of Points

Written Policy by University or College:

- Disseminated to all applicable faculty, staff and students
- Referenced in university catalog or bulletin
- Written agreement from applicable faculty, staff and students
- Notice of intellectual property terms in grants or contracts

Clear Indication of Ownership of Intellectual Property:

- Consistent treatment for types of intellectual property
- Intellectual property produced in general activities expected of faculty or students should be owned by its creator
- Intellectual property produced by students as part of course work should be owned by the students

Sharing of Income from Intellectual Property:

- Portion of net proceeds should be shared with creators
- Portion of net proceeds should be shared with creators' academic unit
- Only external expenses in securing intellectual property protection should be deducted from gross proceeds

Establishment of Educational Program on Intellectual Property Rights

University Technology Transfer Expertise Available to Assist in Licensing Intellectual Property Owned by Faculty, Staff and Students

Consideration of Intellectual Property Creation During Promotion and Tenure Proceedings

Royalty-free License for Continued Research, if Faculty Member Moves to a New University