



BOISE STATE UNIVERSITY

University Policy 1090

Intellectual Property

Effective Date

July 1990

Last Revision Date

June 2015

Responsible Party

Provost and Vice President for Academic Affairs, (208) 426-1212
Division of Research and Economic Development, (208) 426-5732

Scope and Audience

This policy applies to all faculty, staff, student employees, students, and affiliates.

Additional Authority

- Idaho State Board of Education Policy, Section V.M.
 - University Policy 1110 (Conflict of Interest and Commitment)
 - Idaho State Board of Education Institution Technology Licensing Guidelines
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1. Policy Purpose

To establish ownership of copyrights, protectable discoveries and other intellectual property rights and to provide guidelines for the distribution of income received for the sale of those works. While the University claims ownership of intellectual property on behalf of the State Board of Education, the underlying purpose of such claim of ownership is to foster and advance the development of intellectual property through rigorous scientific investigation and research,

and to develop, acquire and license intellectual property for the economic growth and development of Idaho and the nation.

2. Policy Statement

As an integral part of its mission, Boise State University encourages the creation of scholarly works. University participation in the development, marketing, and dissemination of educational and research materials aims for the improvement of the quality, effectiveness, and efficiency of student learning and of faculty and staff development.

The University must protect the investment of public resources that provide for the development of useful discoveries while ensuring that such knowledge is utilized for the betterment of Idaho and the nation. The rights and obligations of Boise State University, its employees and students and other third parties shall be governed by this policy and Idaho State Board of Education (SBOE) Governing Policies and Procedures, including but not limited to SBOE Governing Policy, Section V.M., and the Idaho State Board of Education Institution Technology Licensing Guidelines with respect to all types of intellectual property.

3. Definitions

3.1 Computer Program

A set of instructions that direct a computer to perform a sequence of tasks.

3.2 Copyrightable Works

Anything protectable by copyright, such as:

- a. Study guides, tests, syllabi, course materials, bibliographies, texts, books, and traditional scholarly publications.
- b. Films, filmstrips, photographs, slides, charts, transparencies, illustrations, and other visual aids.
- c. Programmed instructional materials.
- d. Audio and video recordings.
- e. Simultaneously recorded live audio and video broadcasts.
- f. Dramatic, choreographic, and musical compositions.

g. Pictorial, graphic, and sculptural works.

However, computer software, including computer programs, procedural design documents, program documents, and databases as defined below shall be treated for purposes of this policy as a Protectable Discovery and not as Copyrightable Works.

3.3 Course Materials

Any materials prepared by an instructor for use in teaching a course offered by Boise State to its students, including lectures, lecture notes, syllabi, study guides, bibliographies, visual aids, images, diagrams, multimedia presentations, examinations, web-ready content and educational software. These exclude University-Sponsored Materials and University-Directed Materials.

3.4 Database

A collection of data elements grouped together in an accessible format.

3.5 Electronic

Relating to technology having electrical, digital, magnetic, wireless, optical, electromagnetic, or similar capabilities.

3.6 'Employee' or 'Employees'

Faculty, staff, or student employees of the University.

3.7 Natural Person(s)

Individuals or business entities involved in the creation, invention or development of intellectual property. This term is construed broadly as including producers of creative works in the arts and sciences and creators of literary or scholarly writing.

3.8 Net Proceeds

The gross receipts from royalties and all other income from the license, option, sale, lease or rental of Intellectual Property minus (a) the monies specifically directed within the license, option, sale, lease or rental agreement for additional sponsored research or development activities and (b) the amount recovered by the University for reasonable expenses incurred in the development, marketing, protection, registration or dissemination of the materials, including legal expenses.

3.9 Procedural Design Document

Material that describes the procedural steps involved in the creation of a computer program.

3.10 Program Document

Material created for the purpose of aiding the use, maintenance, or other interaction with a computer program.

3.11 Protectable Discoveries

Anything that might be protected by utility patent, plant patent, design patent, plant variety protection certificate, maskwork, or trade secret and computer software, including computer programs, procedural design documents, program documents, and databases as defined above.

3.12 Significant Additional University Support

University assistance that does not include the mere use of library resources, workshops, or University personal computers but may include stipends, significant assistance of University-provided instructional designers or other resources not openly available to employees or students.

3.13 University-Sponsored Materials

Copyrightable materials produced by employees or students where the Natural Person(s) made use of state or university resources not openly available to members of the general public in the creation or development of the specific materials. These exclude traditional scholarly publications and Course Materials written by faculty for courses offered by the University to its students.

3.14 University-Directed Materials

Copyrightable materials produced by employees where the Natural Person(s) developed the material as part of the course and scope of their specific employment duties. These exclude traditional scholarly publications and Course Materials written by faculty for courses offered by the University to its students.

3.15 'Written' on 'In Writing'

Shall include information created, generated, sent, communicated, received, or stored by electronic means, including without limitation email, telecopy, and facsimile transmissions.

4. Arrangements for Federal, State, and Private Funding

- a. Nothing in this policy shall prevent the university from accepting funding from, and conducting sponsored projects for, agencies of the United States Government upon terms and conditions under applicable provisions of federal law or regulations that require a different disposition of rights in any form of intellectual property, including Course Materials. Moreover, nothing herein shall prevent cooperative arrangements with other agencies of the State of Idaho for sponsored projects.
- b. Where receipt of funding in support of a sponsored project from any nonprofit agency or group may be dependent upon acceptance of terms and conditions of the established intellectual property policy of the grantor that differ from those stated herein, the University may specifically authorize acceptance of such funding upon such terms and conditions. The university may also specifically authorize contractual arrangements with an industrial sponsor for different disposition of rights in any form of intellectual property, including Course Materials, resulting from a sponsored project. The terms and conditions of any of the above contractual arrangements must comply with the policies and guidelines of the SBOE and with Idaho state and federal laws.

5. Copyrightable Works

5.1 General Provisions

- a. This policy clarifies the rights of Natural Person(s) and the University regarding ownership and use of Copyrightable Works. The University acknowledges the right of employees and students to prepare and publish copyrightable materials in the name of the natural person and that such publication may generate royalty income.
- b. Employees and students retain all rights in the copyrightable materials they create except in the cases of:
 - University-Sponsored Materials,
 - University-Directed Materials,
 - Materials subject to grant of a non-exclusive license to the University for educational use or public access as described below,
 - Materials created through a sponsored project and covered by a grant, funding agreement or contract as discussed above in section II, and

- Materials covered by a valid written agreement between the Natural Person(s) and the University as discussed below.
- c. Employees and students shall cooperate with reasonable University requests for any documents and records needed to vest and memorialize the University's rights.
 - d. Notwithstanding anything to the contrary in this policy, to permit the University to comply with public access mandates established by state or federal law or regulations and the related terms and conditions of sponsored activity agreements, employees and students accepting grants, funding or contracts from, and conducting sponsored research or other activities for United States Government agencies grant the University an irrevocable, non-exclusive, non-transferable, royalty-free license in copyrightable materials produced as a result of such sponsored activities.

5.2 Course Materials

The provisions of this section apply in the absence of a written agreement between the employee and Boise State.

- a. For courses offered by the university to its students, Course Materials are not University-Sponsored or University-Directed Materials and are generally the property of the Natural Person(s). Such Natural Person(s) may use their Course Materials in any way that does not violate University or SBOE policy.
- b. Occasionally, Course Materials are created with Significant Additional University Support. If a Natural Person(s) creates Course Materials with Significant Additional University Support, the Natural Person(s) retain ownership of the Course Materials, but they grant to the University a perpetual, fully paid-up, royalty-free, nonexclusive, sublicensable worldwide license to use, copy, distribute, display, perform, and create derivative works of such Course Materials. The University will share the Net Proceeds, if any, from the sublicense of these Course Materials to other academic institutions once yearly as follows: forty (40) percent to the Natural Person(s) and sixty (60) percent to Boise State University.
- c. If the Natural Person(s) are expressly commissioned by the University to create certain Course Materials, either as part of the required workload or in exchange for additional financial consideration, those Course Materials shall not be owned by the Natural Person(s) but shall be the exclusive property of the University and such Natural Person(s) irrevocably assign to the University all right, title and interest, worldwide to those Course Materials, applications for legal protection of such Course Materials and copyrights resulting from the creation of such Course Materials.

- d. The Provost is responsible for the development, management, marketing, and licensing of all Course Materials for which the university claims rights under this policy and shall have full power to manage such rights and to enter into contracts and licenses concerning such rights.

5.3 University-Directed Materials

- a. University-Directed Materials are owned by Boise State University and must be registered in the name of the university. Natural Person(s) who produce University-Directed Materials irrevocably assign to the university all right, title and interest worldwide to University-Directed Materials, applications for legal protection of such University-Directed Materials and copyrights resulting from the creation of such University-Directed Materials.
- b. The university may use University-Directed Materials for any lawful purpose of the university and shall retain all income derived from the University-Directed Materials.

5.4 University-Sponsored Materials

5.4.1 Ownership and Registration

University-Sponsored Materials are owned by Boise State University and must be registered in the name of the university. Natural Person(s) who produce University-Sponsored Materials irrevocably assign to the university all right, title and interest worldwide to University-Sponsored Materials, applications for legal protection of such University-Sponsored Materials and copyrights resulting from the creation of such University-Sponsored Materials.

5.4.2 University Rights

The university may register, protect, transfer, convey, license, or otherwise derive income from University-Sponsored Materials. In light of the University's educational mission and its role in the creation of the copyrightable materials, when entering into agreements to transfer, convey, or license the copyrightable works, the University may retain an irrevocable, non-exclusive, non-transferable, royalty-free license in University-Sponsored Materials.

- a. Royalties and Income - Net Proceeds derived from University-Sponsored Materials are distributed once yearly by the University, through its Division of Research and Economic Development ("Research Division") as follows: forty (40) percent to the Natural Person(s) and sixty (60) percent to Boise State University.
- b. Use of University-Sponsored Materials – The use of University-Sponsored Materials is subject to the following conditions:

- “Use” means use by anyone employed by the University, or attending the University as a student, while acting within the scope of their employment or academic enterprise, or any agent of the University acting within the scope of their agency, either directly or through a grant or contract, or by any University department.
- Use of University-Sponsored Materials for any lawful purpose of the University does not require the prior approval or notification of any of the Natural Person(s). However, for as long as any Natural Person(s) involved in the creation or development of the University-Sponsored Materials remains a University employee or student, they may propose revisions to the material in a professionally appropriate manner.

5.5 Waiver

Any person involved in the development of copyrightable materials governed by this policy waives any claim that otherwise legal use of the material by the university, its agents, employees or students creates legal liability by the University, its agents, employees, or students on any theory of indirect liability for allegedly infringing actions of third parties.

6. Protectable Discoveries

6.1 General Provisions; Irrevocable Assignment

- a. Unless specifically provided otherwise, Protectable Discoveries are the property of Boise State University. All Protectable Discoveries, and any data or tangible materials that are associated with or embody Protectable Discoveries, discovered, developed, conceived, or reduced to practice by University employees through work performed within the scope of their duties at the University, by University employees or other persons using University resources not openly available to members of the general public, or by University employees or other persons through work performed under contracts or agreements with the University are the property of the University, effective immediately as of the time such Protectable Discoveries are discovered, developed, conceived, or reduced to practice. Such persons, whether University employees or other persons subject to this Subsection, irrevocably assign to the University all right, title, and interest, worldwide to Protectable Discoveries, applications for legal protection of such Protectable Discoveries, and utility patents, plant patents, design patents, and plant variety protection certificates, or copyrights resulting from such Protectable Discoveries and shall cooperate with reasonable University requests for any documents and records needed to vest and memorialize the University’s rights. Protectable Discoveries made by University employees or such other persons, and for which the University does not expressly disclaim ownership under this policy, are deemed to have been made under the conditions identified above for which ownership is claimed by and all rights in such Protectable Discoveries are assigned to the University. University employees must

refrain from performing any act or entering into any agreement that would impair or attempt to defeat the University's rights in any Protectable Discovery.

- b. Protectable Discoveries made by students, and without the use of University resources beyond those associated with normal coursework, will remain the property of the students, except when a Protectable Discovery is made in the course of employment at the University, or results from work directly related to employment responsibilities at the University, or from work or research performed under a grant or sponsorship.
- c. A Protectable Discovery discovered, developed, or conceived and reduced to practice by University employees wholly on their own time, completely outside the scope of their duties at the University, and without the use of any University facilities (other than library resources) shall belong to that person, even though it falls within the field of competence relating to the natural person's University position. Any Protectable Discovery made by a University employee in the course of private consulting services carried out by the employee in conformance with the University's policy on professional consulting may be assigned to the consulting sponsor.

6.2 Royalties and Income

Net Proceeds derived from Protectable Discoveries are distributed by the University once yearly through its Research Division as follows: 40 percent to the Natural Person(s) and 60 percent to Boise State University. This is done in order to foster and advance scientific investigation and research at the University and to further the development of other intellectual property in order to spur the economic growth of Idaho and the nation.

7. University Processes

7.1 Research Division Responsibilities

The Research Division is responsible for the development, management, marketing, licensing, and financing (such as the initial payment of legal fees) associated with the protection or registration of all Copyrightable Works and Protectable Discoveries (collectively "Intellectual Property") for which the University claims ownership under this policy, except for Course Materials. All such Intellectual Property must be disclosed to the Research Division. The Research Division has full power, responsibility, and authority to manage such rights and to enter into all contracts and licenses, including assignments, concerning such rights subject to SBOE policies and in accordance with the Idaho State Board of Education Institution Technology Licensing Guidelines.

7.2 Disclosure of Intellectual Property

Upon disclosure of Intellectual Property to the Research Division, the Research Division will communicate, as soon as practicable, its determination of whether the University wishes to pursue commercialization and/or a patent or other legal protection. The Research Division shall make reasonable efforts to complete its review and convey its determination to the Natural Person(s) disclosing the Intellectual Property within three (3) months after receiving a full and complete disclosure of the Intellectual Property.

- a. If Boise State does not wish to pursue commercialization and/or patent or other formal legal protection for the Intellectual Property, the Research Division may, when allowable by any sponsored research agreements under which the Intellectual Property was disclosed, enter into a royalty-bearing license in accordance with the Idaho State Board of Education Institution Technology Licensing Guidelines for rights to the Intellectual Property with the Natural Person(s) within sixty (60) days of the date on which the determination not to pursue commercialization or formal protection of the Intellectual Property was conveyed to the Natural Person(s). In any such license, the licensee shall be responsible for all expenses, including legal expenses, relating to the Intellectual Property going forward and for the repayment of any costs and legal fees expended by the University in its prior efforts, if any, to protect or commercialize the Intellectual Property.
- b. If Boise State decides to pursue commercialization and/or patent or other legal protection for the Intellectual Property, the Research Division shall when reasonable:
 - File a patent application and/or other legal protection documents within sixty (60) days of the date on which the determination to pursue legal protection for the Intellectual Property was conveyed to the Natural Person(s);
 - Work with the Natural Person(s) to develop the terms and conditions of any license to the Intellectual Property;
 - Work with the Natural Person(s) to understand and communicate what reasonable expenses shall be deducted from any gross proceeds of the licensing agreement.
 - Not less than annually and for so long as Boise State owns the Intellectual Property, provide reports to the college or center with which the Natural Person(s) are affiliated regarding the Intellectual Property. The report will include (a) the status of any application until such time that protection is granted, (b) the marketing activities for the Intellectual Property being serviced, and (c) an accounting for funds received from the Intellectual Property. If the Research Division is unsuccessful in commercializing a

- property within three years after its first acceptance, the Research Division must notify the college or center in writing.
- c. Boise State may, subject to state laws and to SBOE policies and in accordance with the Idaho State Board of Education Institution Technology Licensing Guidelines, negotiate terms and enter into contracts and licenses, including assignments, concerning the licensing, commercialization, or further development of Intellectual Property. This may include a grant of any or all Intellectual Property or license contract consideration to an affiliated research foundation.

8. Protection

- a. Allegations of unauthorized use or infringement of University owned Intellectual Property should be made to the Intellectual Property Dispute Committee for investigation. The committee will recommend appropriate action to the Vice President for Research and Economic Development.
- b. If an infringement action is initiated by the University, the costs shall be borne by the University and are considered a reasonable expense of protecting the discovery. Proceeds from the action in excess of costs and other expenditures are shared as provided above.
- c. Where the University is the owner of the Intellectual Property, only the University may initiate an infringement action notwithstanding the royalty interest of the Natural Person(s). In such matters, the decision of the University is final and the University will owe no recourse to the Natural Person(s) for such decision.
- d. When licensing or conveying an interest in University owned Intellectual Property, the University will only license or convey interest when the Intellectual Property is to be further developed, used, or used to produce products for the good of society. The University will not license or convey for the sole or primary purpose of monetary gain or bringing an infringement action.

9. Other Intellectual Property Rights

All intellectual property rights of the University, including other intellectual property rights not specifically referred to within this Policy, are to be treated in accordance with state law, SBOE Governing Policies and Procedures, Section V.M. and the Idaho State Board of Education Institution Technology Licensing Guidelines.

10. Dispute Resolution

Occasionally, disputes will arise concerning ownership of the Intellectual Property contemplated in this policy. Resolution of such disputes shall be achieved by the following procedure:

10.1 Intellectual Property Dispute Committee

- a. The Intellectual Property Dispute Committee (“IPD Committee”) is an Ad Hoc Committee formed when necessary by appointments made by the Vice President for Research and Economic Development. Such appointments will be made by the Vice President for Research and Economic Development in consultation with the Provost and Vice President of Academic Affairs if the matter in dispute involves Course Materials. The IPD Committee shall be composed of five (5) individuals and must include both University faculty and staff members. The Vice President for Research and Economic Development shall appoint the chair from among the committee members. Additionally, the university’s Office of the General Counsel shall appoint an ex-officio representative to the IPD Committee.
- b. The IPD Committee considers, investigates, and makes recommendations toward resolution of disputes concerning (1) ownership of copyrightable materials and Protectable Discoveries, and (2) allegations of unauthorized use or copyright infringement of University-Sponsored Materials. It reviews all relevant evidence submitted to it before making its recommendation to the Vice President for Research and Economic Development. The IPD Committee’s recommendation shall be made no later than sixty (60) days after receiving the matter for consideration. The IPD Committee’s recommendation is determined by a majority of all its members voting by secret ballot at a meeting at which over one-half its appointed members are present. No member may participate in any matter in which their ownership rights are being determined.

10.2 Decision by the Vice President for Research and Economic Development

After receiving the recommendation of the IPD Committee, the Vice President for Research and Economic Development makes a decision concerning ownership or infringement. Such decision will be made by the Vice President of Research and Economic Development, in consultation with the Provost and Vice President of Academic Affairs, if the matter in dispute involves Course Materials. The Vice President for Research and Economic Development's decision is made no later than thirty (30) days after receiving the IPD Committee’s recommendation. That decision is transmitted in writing to the Natural Person(s) and to their departmental administrator and dean.

10.3 Appeal

The decision of the Vice President of Research and Economic Development may be appealed to the President of the university. The decision of the President shall be the final decision of the university.

Revision History

July 1995; September 2004; June 2015