

<b>North Carolina Central University Board of Trustee Policy</b>	
<b>Board of Trustees Policy Number:</b>	<b>Date: March 25, 2009</b>
<b>Subject</b>	<b>Intellectual Property Policy</b>
<b>Authority</b>	<b>U.S. Constitution, Article 1, Section 8, Clause 8; Bayh-Dole Act, Volume 37 of Code of Federal Regulations Part 401</b>
<b>Applicability</b>	<b>All Employees, Students and External Collaborating Entities</b>

**Policy Statement and Purpose:**

The University of North Carolina System requires all employees and students to assign title of intellectual property to the institution. Therefore each employee and student has the primary responsibility to ensure compliance with this policy. In accordance with the mission of North Carolina Central University (herein after “NCCU” or “University”), this policy endeavors to encourage intellectual developments, foster open and free exchange of ideas and outline employee and student rights while protecting the University’s interest in its intellectual property.

This policy is accompanied by procedures that guide faculty (including adjunct professors), researchers, staff, students, all others employed by NCCU and those who utilize NCCU’s resources to assist with disclosing and protecting intellectual property. Whenever possible and feasible, NCCU will seek patent, copyright, trademark and trade secret protection for NCCU faculty, staff and students. The scope of the policy includes collaborations with individuals, small businesses, corporations, non-profit organizations and government agencies.

This version of the NCCU Intellectual Property Policy is effective after approval by the Deans’ Council, Academic Planning Council, University Planning Council and the NCCU Board of Trustees.

## INTERNAL OPERATING MEMORANDUM

Memorandum No.

<b>Subject: Intellectual Property Procedures</b>	
<b>Authority: U.S. Constitution, Article 1, Section 8, Clause 8; Bayh-Dole Act, Volume 37 of Code of Federal Regulations Part 401.</b>	<b>Date: Jan. , 2009</b>
<b>Related References</b>	
<b>Purpose</b>	<b>To establish procedures for the transfer of research results and other novel developments to commercial markets.</b>
<b>Signature of Approving Authority</b>	

### **Procedures:**

North Carolina Central University requires all employees and students to assign title of intellectual property to the institution. Therefore each employee and student has the primary responsibility to ensure compliance with these procedures. In accordance with General Statutes 57.1 and 66-57.2 and as stipulated in the Strategic Plan of North Carolina Central University (herein after "NCCU" or "University"), strict adherence to these procedures is required.

These procedures guide faculty (including adjunct professors), researchers, staff, students, others employed by NCCU and those who utilize NCCU's resources to assist with disclosure and protection of intellectual property. Whenever possible and feasible, NCCU will seek patent, copyright, trademark and trade secret protection for NCCU faculty, staff and students. The scope of these procedures includes collaborations with individuals, small businesses, corporations, non-profit organizations and government agencies.

This version of the NCCU Intellectual Property Procedures is effective after approval by the Deans' Council, Academic Planning Council, University Planning Council and the NCCU Board of Trustees.

## **I. Definitions:**

### **A. The Bayh-Dole Act:**

The Bayh-Dole Act allows universities to elect to take title to inventions that emanate from projects funded by federal agencies.

### **B. Non- Disclosure Agreement (NDA):**

The NDA is a legal agreement where parties agree not to disclose confidential information. Once this form is completed by the receiving party, it should be sent to the Office of Technology Transfer, (hereafter known as OTT) immediately for review, processing into the electronic database and execution by NCCU.

### **C. Docket Number:**

A number assigned to each invention disclosure that is submitted to the OTT.

### **D. Intellectual Property:**

North Carolina Central University defines intellectual property (IP) as creations or products of the mind. This may include novel inventions, literary and artistic works, symbols, names, images, and designs that are protected by patents, copyrights, trademarks, trade secrets, service marks and sometimes domain names.

### **E. Intellectual Property Review Committee (IPRC):**

The IPC is a five-seven member (per technology) committee responsible for objectively assessing the merits of all University employees', students' and external collaborating partners' inventions.

### **F. Initial Meeting:**

The first meeting that the inventor has with the OTT staff prior to presenting the invention to the IPRC is called the initial meeting.

### **G. Invention Disclosure Form (IDF):**

The IDF is an electronic form that all university employees, students and external collaborating inventors must complete and submit to the OTT. The form allows for a description of the invention and provides pertinent information regarding the invention. The on-line form when completed will be automatically forwarded to the OTT.

### **H. Royalty Revenue:**

Royalty revenue is revenue generated from the sale or use of university inventions, trademarks, copyrights or other intellectual property.

### **I. Issue Fee:**

The issue fee is the amount assessed by the United States Patent and Trademark Office (hereafter referred to as USPTO) when an invention is deemed patentable. The fee must be paid before the Patent Office will grant a U.S. Patent to an inventor.

**J. License:**

A license gives the right to someone, other than the patent owner, to make, use, sell or offer to sell a patented invention in the United States.

**K. License Agreement:**

A license agreement is a legally enforceable contract between a patent owner “licensor” and a third party “licensee” which sets forth the terms of the agreement.

**L. Maintenance Fee:**

A maintenance fee is an amount assessed by the USPTO that must be paid three times during the life of a U.S. Patent. The first payment must be paid in the fourth year after the patent is issued. The second and third payments must be paid in 8th and 12th years after the patent is issued. Failure to pay maintenance fees timely will cause the patent to expire and become unenforceable in court.

**M. Net Income:**

Net income is revenue generated by the assignment or license of university patents less all expenses or costs related to acquiring, protecting, licensing and marketing NCCU’s intellectual property.

**N. U.S. Patent:**

A U.S. patent is a legally enforceable document that gives the patent owner the right to exclude others from using, making, selling or offering to sell the invention. It is valid for twenty years (20) from the date of filing a patent application.

**O. Non-Provisional Patent Application:**

A non-provisional patent application is a legal document that requests the USPTO to grant a U.S. Patent that will be used to exclude others from using, making, selling, or offering to sell the invention.

**P. Provisional Patent Application:**

A provisional patent application is a patent application that has no legally enforceable rights. It allows the inventor to file a legal adequate description of the invention in the USPTO in order to obtain an early filing date. Provisional patent applications allow inventors up to one year to seek funding before expending too many resources for an invention that cannot be patented or commercialized. These applications are relatively inexpensive.

**Q. Novelty:**

Novelty is a basic requirement for patentability. All inventions must be new before the Patent Office will issue a U.S. Patent.

**R. Obviousness:**

Obviousness is a basic requirement for patentability. The USPTO will issue a U.S. Patent on inventions that are not completely new, but are innovative and have non-obvious improvements over existing technologies.

**S. Prior Art:**

Prior art is any printed publication or patent that pre-dates an invention.

**T. Copyright:**

A copyright is a means of protecting original works that are fixed in a tangible medium of expression. Protection is provided for documents such as technical reports, theses and dissertations. Copyright protection provides the original author with the right to exclude others from copying, distributing or creating derivative works.

**U. Trademark:**

A trademark is a name, logo or slogan that is used to add value and/or recognition to an item or business.

**V. Trade Secret:**

A trade secret is any formula, pattern, device, process, tool, mechanism or compound that is valuable to the developer but has not been protected by a patent and not generally known to others.

**W. University Research:**

University research is any research or development activity which is directly or immediately related to the duties or responsibilities for which a person is compensated by NCCU or one of its units or concluded with more than an insignificant use of facilities or equipment provided by NCCU or one of its units.

**X. Utility:**

Utility is one of three basic requirements for patentability. All inventions must be useful. In most cases, the USPTO will assume that an invention is useful for some purpose unless it clearly falls within the scope of those things that the Patent Office has deemed to lack utility such as: mathematical algorithms.

## **II. Roles and Responsibilities:**

### **A. The Office of Technology Transfer:**

The Office of Technology Transfer, (hereinafter “OTT”) has the primary responsibility for facilitating the commercialization and management of intellectual property, including published works, by faculty, staff, students and collaborating partners. Specifically, the office assists with the disclosure, evaluation and protection of all inventions including, but not limited to, patents, copyrights, trademarks, service marks and trade secrets. A very important role of OTT is identifying commercial partners to which NCCU technology will be licensed. The OTT directs all patent and marketing activities and manages all license negotiations with entities outside of the University.

When an inventor thinks that an invention may have commercial potential, the OTT should be contacted to discuss a disclosure. This should be done before submitting a manuscript for publication, presenting at meetings, conferences, seminars or symposia and prior to divulging the development by any other means to anyone. Failure to disclose development in a timely manner could jeopardize the inventor’s right to the invention. Developers of new or novel processes, products, strategies or services are strongly encouraged to contact the OTT to discuss a new or novel idea in the early stages of an invention that appears promising, even if the development is not yet completely defined. Specific steps for disclosing may be found on page 11 of this Manual.

OTT is responsible for reviewing all contracts, licenses, research and confidentiality agreements with all external entities regarding University discoveries and inventions. Because most agreements will include ownership clauses regarding intellectual property ownership, the OTT and the Office of Legal Affairs must review each document to protect the interest of the University and the researcher.

## **III. Legal Authority:**

### **A. The Bayh-Dole Act:**

Volume 37 of Code of Federal Regulations Part 401 permits universities to retain ownership in all inventions and discoveries funded with federal funds.

### **B. North Carolina Statutes:**

The North Carolina Statutes authorizes the University “to secure, protect, license and otherwise exploit letters of patent, copyrights, trademarks, and otherwise deal with the work product of University personnel”: Section 66-57.1 & 66-57.2.

In addition, “University personnel, who discover, invent, create or design a product, method or idea while associated with the University must

cooperate with the University in defining and establishing the rights of such product, methods or idea. This obligation extends to any invention, creation or discovery, whether or not made on University time or with or without University facilities.”

**C. University Authority:**

The Vice- Chancellor for Research shall have the primary responsibility for the implementation of this policy on behalf of the University. All or a portion of the activities affected by this policy may be delegated by the Vice-President of Research to the Director of the OTT.

**IV. Scope of Policy:**

This policy shall cover all inventions made by University employees, students and external collaborating partners during the course of their employment, enrollment or collaboration at the University. However, employees, students of the University and collaborating partners who may have created inventions on their own time and with their own resources may also wish to submit their inventions or ideas to the University.

In order to protect all University inventions, all full-time faculty, researchers, staff and students must submit developments and receive prior approval from the Dean of the College and the OTT before publishing or disclosing to any non-University source.

**V. Applicability of Policy:**

The policy applies to all University employees, students and collaborating partners beginning with the date of employment, enrollment or involvement and is effective for all inventions. The obligations under this paragraph are effective without regard to an inventor’s status when an Invention Disclosure is completed or processed.

**VI. Ownership:**

NCCU owns all inventions developed or made utilizing University resources, including government or University sponsored research by faculty, staff, students and collaborating partners. University employees and students are required to assign their rights to their inventions and discoveries to the University. The same applies to collaborating partners unless the targeted technology was developed prior to the collaboration. All new employees and students must agree to assign their inventions developed during employment and/or enrollment to the University. All assignments must be executed prior to the University seeking legal protection. All other employees must execute **assignment forms** at the point of contract renewal. In any event, the OTT will not process or pursue legal protection for an invention prior to receiving an executed copy of the assignment form.

If the inventor believes that the University has no ownership interest in the invention, a determination must be made by the Dean of the College and the OTT as to whether the University agrees with the determination of the

inventor. In all cases where the University has no rights or waives its rights to an invention made by University employees or students, a **waiver form** must be signed and notarized by all parties involved.

In the event that NCCU collaborates with corporations or certain other private entities regarding joint research projects conducted primarily at NCCU, the University will retain all rights to the inventions and discoveries. If, however, NCCU inventions are the results of sponsored research and the sponsor retains ownership in the inventions or discoveries, NCCU will negotiate a nonexclusive, royalty-fee license from the sponsor.

All NCCU employees who have obtained prior approval to engage in consulting work for external organizations must also seek a waiver from the University for inventions created during the course of the consulting agreement. NCCU retains an ownership interest in all inventions resulting from consulting activities where an employee failed to obtain prior approval from the University.

#### **VII. Royalty Distribution:**

In exchange for the rights of the inventors, the University will share a portion of the royalty proceeds with the inventors. The net income to the University from any royalty agreement or any agreement resulting from an invention shall be distributed as follows: 40% to the inventor(s) and 60% to NCCU (10% of the University's share will be distributed to the College and 10% to the Department where the development originated). For schools and colleges where there are no departments, 20% will be distributed to the unit.

If more than one inventor has contributed to the invention, those inventors shall be allocated equal amounts of the 40% inventors share unless otherwise agreed in writing. Any agreement modifying the distribution of income among the inventors must be approved by the OTT, the Vice Chancellor for Research and the Office of Legal Affairs at the time the assignment is made, and otherwise the distribution will be made in accordance with the above stated University policy.

Royalty payments will be paid to the inventor without regard to employment or enrollment status at the time of the distribution. If an inventor dies before the royalty period terminates, royalties due to the decedent shall be paid to the Inventor's estate or other designee(s) for the royalty period.

#### **VIII. Student Inventors:**

Inventions created by students will remain the property of the students except when an invention is made in the course of employment at NCCU, or is made utilizing University Resources from work directly related to work performed under a grant or other sponsorship, or undertaken with other inventors who may have a duty to assign such work to NCCU. Any invention arising from a thesis or dissertation submitted as part of a requirement for a degree is subject to this policy. In such case, when a student is obligated to assign



rights to the University, the student will share in the distribution of royalties in the same manner as faculty and staff unless otherwise stated in a written agreement.

When University employees, students or collaborating partners determine that an invention or other intellectual property has been developed on University time or with University resources, contact with the OTT should begin by completing an Invention Disclosure Form and an Assignment Form.

**IX. Intellectual Property Review Committee:**

The Intellectual Property Review Committee (IPRC) is composed of five members from various Colleges and representatives from the OTT. The IPC's primary function is to objectively assess the merits of the invention and to determine whether the University has an interest in seeking some form of legal protection for the development. The Director of the OTT will attend all IPRC meetings, but will not participate in the vote unless there is a tie. In order to have a quorum, at least three of the five members must be present. A proper quorum is required before any decisions can be made regarding an invention. If certain members cannot be physically present, telephone or video conferences are acceptable provided that the absent members have all of the supporting documentation describing the invention at the time the vote is cast.

The IPRC shall also review and render an opinion on whether or not the unit should seek formal copyright protection for published works submitted by employees, students and collaborating partners.

**X. Decision of the Intellectual Property Review Committee:**

All decisions made by the IPRC will be in writing and sent directly to the inventor and the Dean of the College within two weeks after the IPC meeting. The Director of the OTT will summarize the Committee's decision and any recommendations for moving forward with the process. Each Committee member's vote is confidential and will not be included in its written decision.

The IPRC can make one of three recommendations:

- 1) OTT will move forward and patent the invention;
- 2) The invention is not ready for patent and suggest that the inventor(s) continue the research and come back before the Committee within a stated period of time for reconsideration; or
- 3) The University may waive its rights to the invention and permit the inventor to pursue the invention without University funding. In the event that the Dean of the College or the Inventor is dissatisfied with the decision of the IPRC, an appeal for reconsideration may be submitted, in writing, to the Director of the OTT within two weeks of the written decision by the IPRC. An inventor has the right to seek

reconsideration by the IPRC no more than two (2) times following the original decision.

If the IPRC votes to pursue patent protection for the invention, a provisional patent application will be filed with the USPTO as soon as practicable. Within one year of filing the provisional patent application, the OTT (or an external legal entity) will file a non-provisional patent application with the USPTO. If the patent is allowed, the University will pay the issue fee and all maintenance fees to keep the patent in force for the entire patent term.

In the event that the University decides to abandon the invention, the University will notify all parties with an interest in the invention, within a reasonable time, before taking such action. The University may opt to waive all of its rights in the invention or some of its rights. If a partial waiver is appropriate, the University will negotiate a written agreement with the inventor regarding the University's interest in the invention.

#### **XI. The Protection Process:**

The intellectual property protections process involves ten very important and distinct steps. All University developments will be subject to the following procedures:

- 1) The inventor must arrange a preliminary meeting with the staff of the OTT (The purpose of this meeting is to discuss the idea with the OTT staff).
- 2) Before the University expends substantial resources on certain inventions, the staff, in collaboration with the Intellectual Property Review Committee (IPRC), must objectively determine whether the University will support the development (assessment).
- 3) Once the docket number has been assigned, the OTT staff will schedule an initial meeting with the inventor to outline and explain the protection process including how the inventor will be expected to interact with the OTT during the disclosure process. The purpose of this meeting is to prepare the inventor for the meeting with the IPRC.
- 4) The Director of the OTT will outline the assessment, patent and licensing phases of the process for the inventor. If the inventor attached evidence of prior art to the form, a discussion regarding the technical aspects of the patent or publication will be necessary.
- 5) The inventor is expected to share any and all relevant information with the OTT staff (disclosure).
- 6) If the OTT staff reviews the submission and makes the decision to pursue protection for the development, the inventor must complete an Invention Disclosure Form. The inventor is expected to actively

participate in this phase. The disclosure process begins when a University employee or student submits an Invention Disclosure Form to the OTT. The form should be as complete as possible and all supporting documentation must be attached. This is a very important aspect of the process because it clearly documents the period which an invention was conceived or made. All forms may be picked up from the OTT or downloaded from the website ([www.osrp.nccu](http://www.osrp.nccu)).

- 7) The OTT staff will assign a docket number once a complete disclosure form is received and the supporting documentation is attached.
- 8) The inventor must participate in the assignment phase by presenting or completing an assignment form.
- 9) At this point, the inventor stays fully engaged in the protection phase and works closely with the OTT staff to pursue a patent, copyright, trademark and or trade secret protection for the invention.
- 10) After the protection phase the OTT will begin to develop a marketing and licensing Strategy for approaching entities external to the University.

## **XII. Processing a Patent Application:**

Once the disclosure form is received, the supporting documentation is attached and the docket number has been assigned, the OTT staff will schedule a meeting with the inventor to outline and explain the patent process including how the inventor will be expected to interact with the OTT during the application process. The purpose of the initial meeting is to prepare the inventor for the discussion meeting with the IPRC. The Director of Office of OTT will review and discuss the information contained on the Information Disclosure Form. The inventor will be given sufficient time to prepare for the meeting with the IPRC. This committee will decide whether patent protection is appropriate following a presentation made by the inventor before the Committee. If the IPRC determines that a patent is the best mechanism for protecting the University's interest in the invention, the patent application process will begin.

In the unlikely event that the inventor has already disclosed the invention, the Director will expedite the meeting with the IPRC.

## **XIII. Assesment:**

A meeting with the IPRC will be scheduled to discuss the technical merits of the invention and all potential commercial aspects of the invention that may be relevant. During the meeting, the inventor will be expected to answer questions regarding the patentability of the invention. The inventor is expected to have at least conducted a literature search on the invention and possibly a preliminary patent search prior to completing the disclosure form.

The literature and patent searches are necessary for objectively evaluating the novelty of the invention before expending University resources on a development that might not warrant protection. While a cursory search may not be definitive on the issue of novelty, it can assist in assessing the commercial value of the invention if protection is warranted. A more in depth prior search will be conducted by The OTT through an external search firm.

The USPTO will assess the patentability of a development by answering three basic questions regarding the invention according to 35 U.S.C. §§ 101-103. The first question is whether the invention is **useful**. The invention must have some utility before a patent can be granted. Utility is generally assumed because most inventions are useful for something. The second question is whether the invention is **novel**. Novelty can be easily determined by reviewing other patents and publications related to the invention. Thirdly, the Patent Office determines whether the invention is **obvious** by reviewing patents and publications. If the inventor satisfies these basic requirements for patentability, the Patent Office will generally issue a patent as long as other minor provisions are also satisfied.

#### **XIV. The Patent Process:**

Making an application for a patent is a critical step for all parties involved. The patent process is very time consuming and very expensive. Once the invention moves into this aspect of the process, the University will begin committing resources for the patenting and licensing of the invention. To begin the process, the Office of the OTT will need to engage the services of a patent attorney to draft the patent application.

There are two types of patent applications that can be filed. One is the **provisional** patent application and the other is a **non-provisional** patent application. In most cases, the University will first file a provisional patent application with the United States Patent & Trademark Office. The provisional patent application is very simple and often easy to file which allows the University to begin seeking out potential commercial partners to assist in exploiting the invention. The provisional application expires after one year. If the University fails to file a non-provisional application, the invention is abandoned.

The inventor is expected to assist the patent attorney with preparing the patent application. The inventors are required to contact the OTT prior to contacting the patent attorney directly. All correspondence will be sent directly to the OTT and then forwarded to the inventor(s).

The second type of patent application is the non-provisional application. After this application is filed, it will be examined in the USPTO to determine the patentability of the invention. During the prosecution of the patent, the Patent Office will send several pieces of correspondence to the patent attorney. The most important piece of correspondence is called an **Office Action**. An Office Action is a document stating whether or not the inventor is entitled to a

patent. If the invention is not patentable, the Office Action will clearly set forth the reasons for the rejection. Generally, several rejections will be outlined in the Office Action. Once the patent attorney receives an Office Action containing rejections, the Director of the OTT and the inventor will be contacted to discuss the merits of the rejection. If feasible and convenient, a meeting will be scheduled at the OTT with the inventor and patent attorney to discuss responding appropriately to the Office Action. The Patent Office will send all correspondence regarding the invention to the patent attorney. The patent attorney will contact the OTT to discuss the invention. If necessary, the patent attorney will contact the inventor directly to assist with preparing a response to the Office Action. The patent process is lengthy and can take up to two years before a patent is issued or longer if an appeal is filed.

#### **XV. Record Keeping**

Each inventor should keep detailed records, preferably in bound notebooks, of the progress of the research and development of any project, which is worked upon. The records are evidence that may be needed later to **prove inventorship**. Ideally the most significant records should be witnessed (i.e. read, signed and dated) by someone who is familiar with the research, but is **NOT** a co-inventor.

#### **XVI. Licensing and Marketing Strategy:**

If the IPC has decided that the invention will be patented and after a patent application has been filed, the Licensing and Marketing personnel will begin efforts to seek commercial partners. The OTT staff will develop a comprehensive strategy designed to generate and establish commercial interest in the University invention. If a company has expressed an interest in the basic invention, a confidential disclosure form must be completed and returned to the OTT. All commercialization agreements must be reviewed by the Office of Legal Affairs before forwarding to the President of the University for approval.

##### **a. Invention Disclosure and Ownership for Inventors from the Different Universities:**

- 1) (a) Where there are two or more inventors representing different Universities, an Invention Disclosure Form will be filed at the institution responsible for administering the external research funds. The same University shall be responsible for obtaining protection, negotiating any agreement for the commercialization of the technology or intellectual property and distributing proceeds to the non-prosecuting university. However, Federal and State law will govern joint ownership. Absent any prior agreement between the universities regarding the distribution of funds, all proceeds shall be divided equally between the universities.

(b) Where there are two or more inventors representing different Universities and there are no external research funds for the project, an Invention Disclosure Form will be filed at both institutions. In this

case, Federal and State law will govern joint ownership of the intellectual property. Subsequently, the Directors of Technology Transfer will meet to determine which University will file and prosecute the patent application and agree upon the distribution of proceeds. Absent any prior agreement between the universities regarding the distribution of funds, all proceeds shall be divided equally between the universities.

**b. Reporting Requirements:**

- 2) Each institution will provide:
  - (a) An annual report of intellectual property activities and costs;
  - (b) A copy of every Invention Disclosure Form received from faculty employed by the University must be shared with the non-receiving University. The Disclosure Form must be sent to the non-receiving University within three business days after disclosure is made to the University; and
  - (c) Each institution is required to report to the other institution the number of disclosures submitted by faculty.

**c. Patent and Licensing Fees:**

- 3) Each institution will be required to submit an assessment of patent related costs to the non-prosecuting technology transfer office within 90 days after the end of the fiscal year. All outstanding fees related to the protection of discoveries/inventions are due within 90 days after the end of the fiscal year.

**d. Royalty Distribution:**

- 4) Each University will make royalty and or other cash distributions annually. All payments will be sent directly to the Technology Transfer Office within 90 days after the end of the fiscal year.

**e. Prior Intellectual Property Agreements:**

- 5) This Agreement does not change the rights or obligations of either University regarding invention disclosures made anytime prior to the effective date of this Agreement.

**XVII. Trademark Protection:**

A trademark can be a name, symbol, color or combination of words in connection with a product that is used or will be used in commerce. Trademark protection lasts as long as the mark is used.

**XVIII. Trade Secret Protection:**

It is within the sole discretion of the University to keep certain discoveries and inventions as a trade secret and not seek patent protection. When appropriate, the OTT will maintain a legally sufficient description of the invention. The OTT will take whatever means necessary to ensure the

confidentiality of the invention including obtaining non-disclosure agreements from all parties with knowledge of the secret.

**XIX. Copyright Protection:**

Absent of a federal law, state law, contractual agreement or written employment obligation prohibiting ownership of copyright materials, all traditional and scholarly work with copyrights obtained by University employees and students remain the property of the creator unless the work was created as work for hire or in which the University has substantial investments.

In the event that a work is considered patentable and copyrightable, the author/inventor of the work will be governed by the patent policy as outlined.

**XX. Forms:**

- A. Confidential Disclosure Form (CDA)
- B. Invention Disclosure Form
- C. University Assignment Form (with Notary Forms)
- D. Intellectual Property Review Committee Assessment Form
- E. University Waiver Form

**A. CONFIDENTIAL DISCLOSURE FORM (CDA)**

Subject Matter: \_\_\_\_\_

Date of Disclosure: \_\_\_\_\_

The undersigned acknowledges and agrees, individually and on behalf of their respective companies or employers, that all disclosures, discussions, demonstrations and exchanges of information taking place between the undersigned and the representatives of North Carolina Central University on this day and all subsequent disclosures, discussions, demonstrations and exchanges of information relating to the above subject shall be confidential; that the information is proprietary to North Carolina Central University \_\_\_\_\_, the developer of the \_\_\_\_\_; and, that the information shall not be disclosed or duplicated in any way, except upon prior written consent of North Carolina Central University and \_\_\_\_\_

Name \_\_\_\_\_

Company and/or Employer: \_\_\_\_\_

Title Held: \_\_\_\_\_

Date: \_\_\_\_\_



**B. INVENTION DISCLOSURE FORM**

**North Carolina Central University  
OFFICE OF TECHNOLOGY TRANSFER  
INVENTION DISCLOSURE FORM**

Docket Number \_\_\_\_\_ (For OTT)

<b>1.</b>	<b>CRITICAL DATES OF THE INVENTION</b>
<p>A. Conception: Date(s) of first written description: _____</p> <p>B. Reduction to Practice/ Invention Date: _____</p> <p>C. Any Pending deadlines? _____</p> <p>D. Any publications (pending/submissions) of the invention anywhere: _____</p> <p>E. Any public use/disclosure of the invention outside of NCCU? _____</p> <p>F. Any sale or officer to sale the invention? _____</p>	

<b>2.</b>	<b>THE INVENTION:</b> Provide a concise statement of the Invention Title

**PARTIES WORKING ON (AND DEVELOPING) THE INVENTION\***

<b>3.</b>	<b>Researcher at NCCU working on the invention</b>	<b>Non-researcher, outside of NCCU Researcher outside of NCCU</b>
	Name	_____
	Department	_____
	Home address	_____
	City	_____
	State	_____
	Zip Code	_____
	Citizenship	_____
	Work phone	_____
	Fax	_____
	Home phone	_____
	Email	_____

\*Contribution to inventive concepts.

	<b>Researcher at NCCU working on the invention</b>	<b>Non-researcher, outside of NCCU</b>
	<b>Researcher outside of NCCU</b>	
	Name	
	Department	
	Home address	
	City	
	State	
	Zip Code	
	Citizenship	
	Work phone	
Fax		
Home phone		
	Email	

\*Contribution to inventive concepts.

*\*If more than two inventors please use additional sheets.*

<b>4.</b>	<b>PROVIDE A DETAILED DESCRIPTION OF THE INVENTION</b> The description should include the problem to be solved; how the invention works; advantages of the invention and closest prior art.

<b>5.</b>	<b>Attach copies of any documents that illustrate the date of invention such as lab notebooks or dated photos</b>

<b>6.</b>	<b>Date Reduced to Practice (Has the invention been made or tested?)</b>
Is test data available?	Yes/ No
If so, please attach copies	

<b>7.</b>	<b>Purpose of the Invention</b>

<b>8.</b>	<b>FURTHER RESEARCH CONTEMPLATED</b> What work remains to complete development?
-----------	--

9.	<b>Has the invention been published?</b>	
	If so, when?	
	Name of publication(s)	
	Attach copies of article or abstract.	
10.	<b>Has the invention been disclosed on the Web?</b>	Yes/No
11.	<b>Has the invention been disclosed to <u>anyone</u> other than a NCCU employee? (Oral Presentation, Poster or other)</b>	Yes/ No
	Date of Disclosure	
	Name of Disclosing Party	
	Provide contact information for <u>each</u> person that has knowledge of the invention (If more than one, please attach additional sheet).	Name Company/University Address City State Zip Code
12.	<b>List all relevant prior art publications</b>	
13.	<b>List all relevant patent numbers</b>	

<b>14.</b>	<b>Source of Funding</b> (If more than one, please attach others)	
	Government Agency/ Company/ Foundation	
	Contract/ Grant #	
	Contact Person	
	Address	
	City	
	State	
	Zip Code	
<b>15.</b>	<b>SOURCE OF FUNDING:</b>	
<b>16.</b>	<b>DO YOU KNOW OF ANY ORGANIZATIONS OR COMPANIES THAT WOULD BE INTERESTED IN LICENSING THE INVENTION?</b> If so, provide the following information.	Yes/ No
	A. Plans for commercial use: B. Describe the real and substantial competitive advantage to be gained from the invention: C. Developments by others:	
<b>17.</b>	<b>GEOGRAPHIC AREAS WHERE THE INVENTION HAS:</b>	
	Most value: No value:	
<b>18.</b>	Inventor	
	Date	
	Co-Inventor	
	Date	
	Co-Inventor	
	Date	

**C. UNIVERSITY ASSIGNMENT AGREEMENT (with Notary Forms)**

ASSIGNMENT AGREEMENT BETWEEN  
North Carolina Central University  
FACULTY/STAFF

This agreement effective on the undersigned date is made by the North Carolina Central University, acting for and on behalf of the Board of Trustees, a public corporate body of the State of North Carolina, hereafter referred to as "University", and [name of inventor], herein after referred to as the "Inventor," of the [name of school or college] at North Carolina Central University (NCCU)

WITNESSETH:

WHEREAS, the North Carolina Statutes empowers the University to consider contributions by University employees in the development of inventions and patents and enter into a written contract with such personnel establishing the interests of the personnel and the University in the invention and patent;

WHEREAS, the Inventor(s) [name of inventor or inventors], of the [name of school or college] at said University have developed "[title of the invention]" herein after referred to as "the invention" with potential commercial value while employed by NCCU. The said product is described in the Statement of Disclosure, attached as Exhibit A, and is incorporated fully into this document by this reference, and

WHEREAS, one hundred percent (100%) of the research work undertaken by the "Inventor" that lead to the development of the unique product was conducted using the facilities within the [name of school or college].

NOW THEREFORE, the University and the Inventor in consideration of the mutual benefits to be attained by the parties do hereby covenant and agree as follows:

1. Definitions as used in this agreement:
  - (a) "Inventions" means discoveries, concepts, and ideas whether patentable or not, relating to any present or prospective activities of the University regarding the invention including but not limited to processes, methods, techniques, and any improvements thereof, and
  - (b) "Net Profits" for purposes of this agreement, shall mean revenue received by the University from the manufacture, use, license, lease or sale of the invention, less all University expenses, including overhead, related to the invention.

2. The Inventor agrees to assign to the University all rights, title, and interest in the above-identified product.
3. The University agrees to seek patent protection of “[title of the invention]” in the name of the University, through its authorized representative.
4. The University and the Inventor agree to divide the net profits on 60/40 (University/Inventor) basis including, but not limited to, financial proceeds from licenses, leases, assignments or any other written document executed by the University and any person, firms, or corporations for the manufacture, use, lease, license, or sale of the product.
5. The University would receive sixty percent (60%) of the proceeds in section (4) above. Ten percent (10%) of the University's sixty percent (60%) allocation will be set aside for the [name of school or college].
6. No compensation will be paid to the Inventor, from the profits until the University has received its costs including, but not limited to, attorney fees incurred while seeking the trademark, copyright, patent or other protection. However, this is subject to the rights, if any of the State of North Carolina and any Federal agencies that may be derived from Sponsored Research in the development or use of the Invention.
7. The Inventor agree to communicate to NCCU or its representatives any facts known to them with respect to the development and to testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing and reissue application, and related documents; make all rightful oaths; and generally do anything necessary to assist the University in obtaining and enforcing proper protection of said Invention.
8. The Inventor agree to communicate and assist the University or its designees in obtaining, defending and enforcing patents, copyrights, or trademarks nationally and internationally, which are based upon or related to the invention.
9. The Inventor shall not at any time, except as properly required, in the conduct of the normal business of the University or except as authorized in writing by the University, publish, disclose or use any information relating to any aspects of the invention.
10. The Inventor, upon termination of their employment with the University, shall promptly return to the University, all documents, records, notebooks, computer discs, and similar repositories containing any information related to the invention, including copies thereof within their possession, whether prepared by him or others. If,

at any time after the termination of employment, the Inventor determines that he has any information in their possession or control, regarding the invention, he shall immediately return to the University all this information, including all copies and portions thereof.

11. This agreement shall be binding upon the parties hereto and upon their respective heirs, executors, administrators, legal representatives, successors and assigns.
12. This agreement is governed by the laws of the State of North Carolina. If any court of competent jurisdiction shall hold any provision of this agreement invalid or not enforceable, such holdings shall not invalidate or render enforceable any other provision hereof
13. This agreement is effective on the undersigned date can only be amended or terminated by mutual written agreement between the parties.

Entered into on this \_\_\_\_\_ day of \_\_\_\_\_, 20\_\_ by the Inventor or Inventors and the undersigned representative of North Carolina central University.

\_\_\_\_\_  
Date

\_\_\_\_\_  
Name and Signature of Inventor  
(Area of Employment)

\_\_\_\_\_  
Date

\_\_\_\_\_  
Vice Chancellor for Research

**ASSIGNMENT AGREEMENT BETWEEN North Carolina Central University  
FACULTY, STAFF AND STUDENTS**

This agreement is entered into as of this \_\_\_\_ day of \_\_\_\_\_, \_\_\_\_\_ by and between North Carolina Central University (**NCCU**), acting for and on behalf of the NCCU Board of Trustees an educational institutional public body corporate, existing under the laws of the State of North Carolina and having offices at Durham, North Carolina, (hereinafter called "University) and \_\_\_\_\_, Inventor of the College/Institute of \_\_\_\_\_ at North Carolina Central hereinafter referred to as "Inventor".

WITNESSETH:

WHEREAS, North Carolina Statutes empowers the University to consider contributions by employees in the development of inventions and patents and enter into a written contract with such personnel establishing the interests of the personnel and University in the invention and patent;

WHEREAS, the inventor is a faculty member in the College/Institute of \_\_\_\_\_ at this University and has developed a \_\_\_\_\_ with potential commercial value, while employed by the University; (The said product is described in the Statement of Disclosure, attached as Exhibit A, and incorporated fully into this document by this reference); and

WHEREAS, the research undertaken by the inventor that lead to the development of the unique product was conducted using the facilities within the College of \_\_\_\_\_.

NOW THEREFORE, the University and Inventor in consideration of the mutual benefits to be attained by the parties do hereby covenant and agree as follows:

- (1) Definitions as used in this agreement:
  - (a) **"Inventions"** mean discoveries, concepts, and ideas whether patentable or not, relating to any present or prospective activities of the University regarding the New and Improved Drug including but not limited to processes, methods, techniques, and any improvements thereof, and
  - (b) **"Net Profits"** for purposes for this agreement, shall mean revenue received by the University from the manufacture, use, license, lease or sale of the invention, less all University expenses, including overhead, related to the invention.
- (2) The inventor agrees to assign to the University all rights, title, and interest in the above identified product.



- (3) The University agrees to seek patent protection of the New and Improved development in the name of the University, through its authorized representative.
- (4) The University and Inventor agree to divide the net profits a on 60/40 (University/ Inventor) basis including but not limited to financial proceeds from licenses, leases, assignments or any other written document executed by the University and any person (s), firms, or corporations for the manufacture, use lease, license, or sale of the product.
- (5) The University would receive sixty (60%) of the proceeds in (4) above. Ten (10) percent of its allocation will be set aside for the College/Institute or Department.
- (6) No compensation will be paid to the Inventor from the profits until the University has been reimbursed for its costs including, but not limited to, attorney fees incurred while seeking the trademark, copyright, patent or other protection. However, this is subject to the rights, if any, of the State of North Carolina and any Federal agencies which may be derived from sponsored research in the development or use of the “\_\_\_\_\_”.
- (7) The Inventor agrees to communicate to said University or its representatives (s) any facts known to them with respect to the development and to testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing and re-issue application, and related documents; make all rightful oaths; and generally do anything necessary to [said] University in obtaining and enforcing proper protection of said development.
- (8) The Inventor agrees to communicate and assist the University or its designees in obtaining, defending and enforcing patents, copyrights, or trademarks on a national and international basis, which are based upon or related to the invention.
- (9) The Inventor shall not at any time, except as properly required, in the conduct of the normal business of the University or except as authorized in writing by the University, publish, disclose or use any information relating to any aspects of this invention.
- (10) The Inventor, upon termination of employment with the University, shall promptly return to the University, all documents, records, notebooks, computer discs, and similar repositories containing any information related to the invention, including copies thereof within his possession, whether prepared by him/her or others. If at any time after the termination of employment, the Inventor determines that he/she has any information in his/her possession or control, regarding the invention, he/she shall immediately return to the University all of this information, including all copies and portions thereof.

(11) This agreement shall be binding upon the parties hereto and upon their respective heirs, executors, administrators, legal representatives, successors and assigns.

(12) This agreement is governed by the laws of the State of North Carolina. If any court of competent jurisdiction shall hold any provision of this agreement invalid or not enforceable, such holdings shall not invalidate or render unenforceable any other provision hereof.

(13) This agreement is effective on the undersigned date and can only be amended or terminated by mutual written agreement between the parties.

Entered into on this \_\_\_\_\_ day of \_\_\_\_\_ 20\_\_ by Inventor and the undersigned representatives of North Carolina Central University.

\_\_\_\_\_  
Date

\_\_\_\_\_  
Inventor

\_\_\_\_\_  
Date

\_\_\_\_\_  
Inventor

**NOTARIZED STATEMENT FOR PROFESSOR**

I hereby certify that on this day before me, a Notary public duly authorized in the State of North Carolina and Durham County to take acknowledgements, Inventor personally appeared, known as the Professor of \_\_\_\_\_ at North Carolina Central University who executed the foregoing instrument for the uses and purposes therein expressed, and acknowledged before me that he/she executed this statement willingly and without undue influence.

Witness my hand and official seal in Durham County, North Carolina above on this day of \_\_\_\_\_, 20\_\_\_\_

\_\_\_\_\_  
Notary Public

My Commission expires: \_\_\_\_\_

**NOTARIZED STATEMENT FOR THE PRESIDENT**

I hereby certify that on this day before me, a Notary public duly authorized in the State of North Carolina and Durham County to take acknowledgements, \_\_\_\_\_ personally appeared, known as the Chancellor of North Carolina Central University, or her/his Designee who executed the foregoing instrument for the uses and purposes therein expressed, and acknowledged before me that the agreement was executed it in the name of North Carolina Central University, and that \_\_\_\_\_ or her/his designee has statutory authority to bind said University.

Witness my hand and official seal in the County of Durham, North Carolina on this day of \_\_\_\_\_, 20\_\_\_\_\_

\_\_\_\_\_  
Notary Public

My Commission expires: \_\_\_\_\_

**D. Intellectual Property Committee Assessment Form**

Name of Inventor(s): \_\_\_\_\_

Title of the Invention \_\_\_\_\_

\_\_\_\_\_

Docket Number \_\_\_\_\_

Assessment Criteria:

1. Is there sufficient information to evaluate the invention?
2. Is the invention substantially complete?
3. Based on the literature provided by the inventor, do you think the invention is novel? If not, please explain.
4. Based on the patents provided by the inventor and the OTT, is the invention different from what is known? If so, explain.
5. Does the invention solve a particular problem or enhance an existing technology?
6. What is the commercial potential for this invention?
7. Have the results of the research been documented and substantiated by others in the department or industry?
8. How would you assess the licensing potential of the invention?
9. What is the Committee's recommendation?

\_\_\_\_\_ OTT should seek patent protection.

\_\_\_\_\_ Inventor should continue the research and return at a later date for reconsideration

\_\_\_\_\_ University should execute a waiver form relinquishing rights to inventor

**Approvals**

Office of Sponsored Research 02/12/09  
Academic Planning Council 03/11/09  
University Planning Council 03/24/09  
NCCU Board of Trustees 03/25/09