

Appendix D: Copyright, Patents and Inventions commercialization Policy

D. 1. Copyright

In regard to copyrights, the University believes that the publishable work of its faculty, staff, and student body should be available to all interested scholars. The University also believes that the author should be given full credit for any work, and should be entitled to retain proprietary rights to the product of the individual's own initiative and independent labors. Occasionally, however, faculty and staff produce materials as a result of specific University assignments. In such cases, the University reserves the right to determine whether or not the material will be copyrighted, and in whose name, and what rights, if any, the author will retain to the materials. Normally, when materials published under the University's copyright are distributed or sold for educational or scientific purposes only, the author receives no payments. If the materials are marketed commercially, however, the author often receives royalty payments based upon an agreed rate.

Any arrangement relating to copyright matters involving a sponsored project must be referred to the VCAA. Some sponsors have established regulations governing the copyright and/or publication of the results of investigations they finance. Before entering a sponsored project, an understanding among the principal investigator, the University, and the sponsor should be reached regarding the rights to any copyrightable materials produced by the project.

Traditionally, the right of first publication is the property of the author unless the terms of the grant or contract specify otherwise. Copyrights secured for the University or any of its units are placed in the name of the University, and become University property. The VCAA will provide interested persons with information concerning the procedures to be followed in applying for a copyright.

Databases created in the course of research may be copyrightable and thus fall under the copyright policy. This Policy is concerned with the ownership of, and the right to use, original data collected or measured in the course of teaching, academic and research activities involving academic personnel. It is not concerned with data from external sources used in research at the university, other than to assert the obligation that publications or theses using such data must recognize and fully document their sources. Academic personnel have the obligation to protect and preserve, for a reasonable period (defined by the norms of the discipline), and to make available to other scholars and non-commercial users, the data on which their work is based. Ownership of data assembled by academic personnel in the course of their research may be contentious and, because access to it is important for research and scholarship, ownership shall be jointly held by the university and the creator(s), subject to the following conditions:

- a. To the extent that the creator(s) have rights in such data, the creator(s) grant the university a perpetual, non-exclusive, royalty-free, irrevocable license to copy and use any or all such data in teaching (including distance and continuing education), research and academic activities within the university.
- b. The creator(s) shall make available the resulting data set(s), after completion and publication of the thesis or paper on which the data set is based, to other university

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personnel for royalty-free, non-commercial use in teaching, research and academic activities within the university.

Notwithstanding the above, all university personnel have the collegial obligation to allow the owner(s) of such data a first opportunity to exploit those data for published work.

The American University of Sharjah owns the copyrights to all multimedia and distance education products and courses produced by AUS full-time faculty members as part of their assigned teaching load at AUS. The University reserves the rights to all electronic and computer based instructional materials produced and delivered by faculty while employed at AUS. Furthermore, AUS shall have the right to use the course materials developed by AUS faculty as it deems necessary, and maintains the right to reproduce, update, distribute, transmit, alter, and prepare derivative works based on the course materials. AUS may retain copies of the course materials indefinitely for archival purposes and make them available to any other institutions, universities, or persons it deems appropriate. AUS faculty members shall not include in the content of multimedia, electronic, computer based, or distance education courses developed while employed at AUS, any content that constitutes libel, invasion of privacy, infringement of copyright or literary rights or otherwise violates the legal rights of any persons under Sharjah, UAE, the State of Delaware or United States Federal law. Multimedia and distance education courses, as well as all electronic and computer based courses created by AUS faculty members while employed by AUS are to be treated as "work-for-hire" by AUS under the U.S. Copyright Act. AUS faculty members may, however, use these materials for non-commercial purposes while working at AUS or after leaving AUS.

D. 2. Patents and Inventions

The American University of Sharjah believes that its faculty and staff should be encouraged to contribute to the development of science and technology. For this reason, it is the objective of AUS that any member of the University who invents a patentable device or procedure should benefit financially from its commercial exploitation wherever possible. While AUS could claim rights in all inventions of faculty or staff members that are in any way related to their employment, to do so would be inconsistent with that objective. At the same time, however, patentable inventions resulting from the creativity of AUS faculty and staff also may reflect significant investments of University resources. Under some circumstances, therefore, it will be appropriate for AUS to share in the proceeds of an invention's commercialization. The objective of this Policy is to define the relative rights of faculty/staff inventors and AUS in a variety of different situations.

D.2.1 Timely Disclosure

For the provisions on the division of rights in inventions outlined below to be put into effect, this Policy requires that any member of the AUS faculty or staff who believes that he or she may have devised a patentable invention, under any circumstances and without regard to whether such invention was devised on University premises or with the use of University facilities, shall immediately notify VCAA of their intentions prior to any publication or presentation that would have the effect of putting the new intellectual property into the public domain. Such disclosure

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must include the nature of the intellectual property, the names of all co-creators, the source of funding for the research project out of which the intellectual property emerged, and any other relevant information using the AUS-IP disclosure form.

The VCAA shall submit the notification report to the AUS-IP Committee (described in section D.4.1) within 30 days of receiving it, or 30 days from the start of the academic year in case a notification is submitted between May 31 and August 30, whichever shall be longer.

The AUS-IP Committee shall have 90 days, or in the case of a notification received by it between May 31 and August 30, until November 30, whichever shall be longer, in which to respond to a report of a possibly patentable invention by indicating into which of the categories detailed in this Policy that invention falls. During this period, the faculty/staff member may publish accounts of his or her invention in accordance with the ordinary academic or professional practice. The VCAA shall inform the faculty or staff member of the university's decision within 15 days from receiving the recommendation of the AUS-IP Committee, or 15 days from the end of the specified review period of the Committee, whichever is shorter. The VCAA's response will specify the manner in which rights in the invention shall be apportioned between the individual inventor, AUS, and any third-party grantor or sponsor.

D. 2. 2 Classifications of Inventions and ownership determination

D.2.2.A. Inventions resulting from wholly personal research

These are inventions that a faculty or staff member has devised while working on non-University premises, without the use of University facilities, outside his or her regular working hours, and that have no other connection to his or her duties as a University employee.

Rights in the proceeds of these inventions belong exclusively to the inventor. In the event that he or she seeks University assistance in perfecting, protecting, and/or marketing the invention, an allocation of rights and proceeds will be negotiated between the inventor and AUS.

D.2.2.B. Inventions resulting from authorized consulting activities external to AUS

These are inventions devised by a faculty member while pursuing projects on behalf of entities other than AUS, as permitted by University policies on outside consulting activities. These inventions must be devised while working on non-University premises, without the use of University facilities, outside regular working hours and with no connection to duties as a University employee.

Ownership of rights in inventions of this category is governed by the agreement between the inventor and the entity for which the work that gave rise to his or her invention was performed. AUS claims no share in any proceeds from such inventions. In the event that the inventor seeks University assistance in perfecting, protecting, and/or marketing the invention, an allocation of rights and proceeds will be negotiated between the inventor and AUS. To the extent that faculty consulting activities exceed the limits imposed by AUS, rights in inventions arising from them will be governed by other provisions of this Policy as appropriate.

D.2.2.C. Inventions resulting from the use of AUS facilities and services

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These are inventions devised by faculty and staff members while working on University premises, with any use of University facilities, during the faculty member's regular working hours, or with any connection to the faculty member's duties as a University employee. This category also includes inventions that result from research projects receiving specific AUS financial support, including research grants and other special University awards, or that were devised using special equipment supplied by AUS for the use of a particular researcher or research group.

Rights in the proceeds of inventions of this category shall be shared between AUS and the inventor, and in default of an agreement to the contrary, each will be entitled to a 50% share of such proceeds.

D. 2. 2.D. Inventions devised in the course of performance of grants of contracts administered by AUS:

This category includes all inventions that result from activities undertaken with external financial support.

The ownership of rights in inventions of this category will be governed by the terms of the grant or contract in question. When those terms permit the retention of rights by the contractor or grantee, the inventor and AUS each will be entitled to a 50% share, unless there has been an agreement to the contrary. AUS and the inventor may negotiate mutually agreeable alternative arrangements with respect to such inventions at any time, but such negotiations shall not involve the grantor or contracting agency in any way.

Where this Policy provides for negotiations between a faculty or staff researcher and AUS concerning the allocation of rights in an invention or the proceeds from its exploitation, the officer negotiating on behalf of AUS shall seek the advice of the AUS-IP Committee prior to concluding any final agreement. In such event, the AUS-IP Committee may advise for or against the conclusion of an agreement on particular terms, or recommend additional or alternative terms. The VCAA must approve all agreements.

D.2.2.E. Inventions resulting from Collaborative Research

The university encourages researchers to share information and to work in collaboration with others, where this is likely to advance the state of knowledge. Collaboration agreements between academic personnel and researchers at outside institutions, agencies, and companies must specify, in advance and in writing, how the process by which the rights to intellectual property arising out of the collaboration will be determined. The determination of rights shall be based on the extent and nature of the contribution; the university must be a party to the agreement. Any waiver or modification of rights requires informed consent.

D.3 Commercial Exploitation of inventions

At the time of disclosure (D.2.1), the VCAA will determine under which of the categories listed in section D.2.2. the invention falls and based on that the ownership will be determined. In the case of category D.2.2.A. or D.2.2.B., the university will inform the creator(s) that they may commercialize the intellectual property themselves, or may offer it to the university to commercialize, and will provide sources of information about those options. The time line described in section D.2.1 should be followed.

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D.3.1. Commercialization by the Creator(s)/Inventor(s)

When creator(s) elect to commercialize the intellectual property, they assume responsibility for legally protecting and marketing it, finding a licensee, negotiating a license agreement, and administering that agreement. Any such license agreement must contain full and complete releases and indemnification in favor of the university with respect to the commercialized intellectual property. In cases where AUS has rights to the invention ownership, such creator(s) will pay the university 25% of Net Revenues arising from the intellectual property or 10% of Gross Revenue, whichever is greater, on an annual basis. Any such intellectual property shall remain subject to the license and other rights of the university under these policies. The VCAA shall represent the university's interest in all matters related to this intellectual property, including but not limited to patents, sale, licensing or any other commercialization activity. If creator(s)/inventor(s) pursue commercialization on their own, the university is not responsible for any legal, development, marketing and other costs they may incur, including patent prosecutions.

D.3.2. Commercialization by the University

In cases where the University claims no ownership in an invention, the creator(s)/inventor(s) may, at their option, offer the intellectual property to the University for Commercialization. The university retains the absolute and sole right to determine if it wishes to accept such intellectual property for commercialization. Before the university accepts any assignment, it may seek a commercial and/or technical assessment. Prior to the university conducting any such assessment, the university shall require the creator(s) to enter into an agreement with the following terms and conditions:

- a. If the university accepts the offer, the creator(s) agree to assign all intellectual property Rights and other rights to the university, including assignments of Patents, if any. The university shall thereafter deal with such rights, including any further assignment to some specialized external agency, as it deems most expedient. The university shall assume sole responsibility and authority for legally protecting and marketing the intellectual property, finding a licensee or buyer, determining the terms of the license or sale, negotiating a license or sale agreement, and administering that agreement. The university shall retain 75% of Net Revenue arising from the intellectual property, and the creator(s) shall receive 25%, payable on an annual basis, unless the university and the creator(s) agree to a fixed percentage of Gross Revenue that is of equal or greater value for the university.
- b. If, because of this assessment, the university decides not to act to protect and/or commercialize the rights to the intellectual property, these rights shall be returned to the creator(s).
- c. If, the university has accepted the assignment of the intellectual property and if, after a period of two years from the later of the date of such assignment (or if a Patent is involved, the date of issuance of the Patent), the rights to the intellectual property have not been assigned or licensed, they may be, at the creator's request, assigned back to the creator, in return for an agreement by the creator to: (1) reimburse the university for all

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Development Expenses prior to any distribution of revenues, and (2) pay to the university 25 % of the Net Revenue arising from the intellectual property or 10% of Gross Revenue, whichever is greater, on an annual basis.

University personnel are not obliged to use the university's services, nor is the university obliged to take on any intellectual property brought to it.

D.4 Miscellaneous

D.4.1. Administration and Amendments

Subject to the dispute resolution provision set out in section D.4.2, the VCAA is responsible for the administration of this Policy. The VCAA is also responsible for making determinations regarding various matters referred to in this Policy, including determining time periods, limitations on ownership rights, what constitutes private research, and ownership rights of academic personnel conducting externally-sponsored or research activities. Obviously, a Policy such as this one cannot anticipate all cases that may arise or dictate exactly how each case will be categorized in terms of that Policy when it does arise. Under this Policy such determinations are to be made by the VCAA, acting on the advice of a standing AUS-IP Committee.

The AUS-IP Committee shall have a membership of five, including no fewer than three members of the full time faculty, one of whom shall serve as Chair. Decisions of the AUS-IP Committee shall be made by a majority of the members present and voting at any regularly scheduled or specially called meeting, except that no decision of the Committee shall be effective unless it has the support of at least two full time faculty members.

It is the responsibility of the VCAA to review and evaluate these policies on an annual basis. Any changes to these policies that the VCAA recommends, shall be provided to the Board of Trustees of the University for Consideration.

D.4.2. Dispute Resolution

The university recognizes that disputes may arise between the university and Academic or non-academic personnel and students with respect to intellectual property and the implementation of these Policies. When an agreement cannot be reached between the university's and the creator, the dispute will be referred to an internal three-person panel consisting of persons respected within the community for their knowledge of intellectual property issues. The membership of the panel shall be determined by the Chancellor in consultation with the President of the Faculty Senate. The Chancellor designates the chair of the panel. The panel will attempt to resolve the dispute through mediation but, if that fails, it will arbitrate. The panel will serve as an advisory body to the chancellor. The final decision, including the results of any arbitration, is subject to approval by the chancellor. The decision of the chancellor is final and binding and is not subject to appeal.

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Exceptions to these rules are allowed only when the research is subject to confidentiality requirements due to contractual arrangements with a sponsoring agency, to publication delays associated with patent applications, or to university ethics constraints on research involving human subjects or animals, which are contained in the AUS guide to research: Policy and Procedures; the latter may be found on the university's website. In the case of contractual limitations, all collaborators must be made aware of, and agree in advance to, such constraints.

D.4.3. Revenues and Expenditures

- An accounting of incomes and expenditures related to each invention will be provided to the Inventor annually or more frequently by special arrangement where circumstances warrant.
- Any net income earned by an invention will be distributed annually as provided for in Section D.3. or more frequently by special arrangements where circumstances warrant.

D.4.4 Confidentiality

All University personnel involved in the process of invention disclosure, ownership determination, patentability evaluation, commercialization, and commercial exploitation will make every effort to maintain the confidentiality of the invention until it is protected by patent. Where appropriate, the VCAA will use confidentiality agreements to ensure confidentiality when dealing with non-University personnel. All parties involved may be required to sign an AUS-IP confidentiality form.

D.4.5. Execution of Contracts

Contracts arising from patents or inventions will be executed in accordance with established University policies and procedures.

D.4.6. Acknowledgement of the University

In reporting their work, university personnel shall acknowledge the American University of Sharjah for the support it provided. In the spirit of collegiality, creators of intellectual property are encouraged to recognize the university's support through a financial contribution.

D.4.7. Use of the University's Name and Marks

To protect its reputation, the university must control the use of its name and marks. This requirement is especially important in the context of non-university sponsored commercialization of intellectual property. Under no circumstances may the university be presented, directly or indirectly, as endorsing or warranting a particular product. Accordingly, any use of the university's name or any university-owned mark in connection with any product, service, research project or work, apart from indication of the institutional affiliation of the creator(s), requires explicit written permission from the VCAA.

D.4.8. Definitions

The following definitions shall apply for the purposes of interpreting these **Policies on Intellectual Property**:

1. **"Academic Personnel"** shall include all core, complementary, adjunct and visiting faculty, instructors, teaching assistants, post-doctoral fellows, undergraduate and post-graduate students.
2. **"Contributor"** shall mean an individual or organization that contributes to a work. Possible contributions include, but are not limited to ideas, expression, form, design, computer software and criticism.
3. **"Copyright"** shall mean the sole rights granted for specified periods pursuant to the *Copyright Act*, as amended or re-enacted from time to time, or any successor legislation, including the sole right to produce or reproduce an original literary, dramatic, musical and artistic work in any form. Literary works within the meaning of the *Copyright Act* include works consisting of text as well as computer programs. Copyright also includes the sole right to perform a work in public, to publish an unpublished work, to produce, reproduce, perform or publish any translation of a work, to convert a dramatic work into a novel or other non-dramatic work, to convert a novel, non-dramatic work or artistic work into a dramatic work, to make a sound recording, cinematographic film or other mechanical contrivance of a literary, dramatic or musical work, to reproduce, adapt or publicly present a work as a cinematographic work, to communicate a work to the public by telecommunication, to present an artistic work at a public exhibition, and to rent out a computer program or a sound recording of a musical work. Similar rights are included with respect to performers' performances, sound recordings and broadcast communication signals. All of these rights extend both to the work and a substantial part of it, and include the right to authorize any of these actions.
4. **"Creator"** shall mean a member of university Personnel who creates intellectual property.
5. **"Data"** shall include databases, results of scientific measurements, results of surveys, and the results of computational or experimental simulations, together with a documented description of the format or structure of the data set(s) and, where appropriate (e.g., in scientific experimental measurements), estimates of experimental uncertainties which would allow a non-originator to use them.
6. **"Development Expenses"** shall mean all moneys paid to protect, develop, and/or enhance the marketability or any other aspect of intellectual property, including, but not limited to, the drafting, filing, prosecution, maintenance and enforcement of patent or other registrations, marketing expenses, consulting fees, expenses incurred in dealing with equity interests, travel, legal fees, and research costs. Salaries and general operating expenses of administrative personnel are not included within development expenses.
7. **"Gross Revenue"** shall mean the proceeds from the sale, lease, transfer, assignment, license, grant of right of access, or other conveyance or grant of rights in respect of intellectual property or intellectual property Rights therein, including without limitation, any license issue fees, option fees, royalties, and equity interests, except that any equity interests, or portion thereof, received by the university shall not be included in "Gross Revenue" unless and until such time as the equity interests, or portion thereof, are sold by the university. The Gross Revenue in a transaction between affiliated parties, or any

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parties that are otherwise associated with each other or acting in concert, or in any other non-arm's length transaction, will be the greater of: (i) the actual amount paid, and (ii) the amount that would have been paid in a similar transaction at arm's length.

8. **"Independent Efforts"** with regard to intellectual property means that the ideas for the intellectual property came from the creator, the intellectual property was not made with the use of university support, and is not related to the creator's responsibilities, work or employment at the university.
9. **"Intellectual Property"** shall mean works, data, Inventions, ideas, industrial designs, trade-marks, trade names, domain names, integrated circuit topographies, plant varieties, know-how and trade secrets, which can be registered or protected under the law.
10. **"Intellectual Property Rights"** shall mean copyright, Patent, industrial design, trademark, domain name, integrated circuit topography, plant breeders' and trade secret rights, and moral rights.
11. **"Invention"** shall mean any new and useful art, discovery, process, machine, composition of matter, article of manufacture, design, model, technological development, biological material, strain, variety, culture of any organism, computer software, research data and tools, whether or not patentable.
12. **"Moral Rights"** shall mean a creator's rights to claim ownership and to protect the integrity of a work under the *Copyright Act*.
13. **"Net Revenue"** shall mean Gross Revenue less Development Expenses.
14. "Non-academic personnel" shall include full-time and part-time administrative, professional, support staff and other persons paid by or through the university and anyone working under university auspices, excluding academic personnel other than undergraduate and post-graduate students performing paid work for the university.
15. **"Patent"** shall mean the grant of exclusive rights, pursuant to the *Patent Act*, as amended or re-enacted from time to time, or any successor legislation, for a period of 20 years from the patent application filing date, to make, construct and use an invention, and sell it to others to be used. In exchange, the patent application is made public by the Patent Office 18 months from the earlier of the filing date, or the filing date abroad under an international treaty. For an invention to be patentable it must be new, useful, and not obvious to someone skilled in the area.
16. **"Teaching Materials"** shall include all printed and digital products created by academic personnel, the presentation of which may or may not be influenced by non-academic personnel, including course notes, course outlines, teaching notes, presentations, and examinations, and including materials used for distance and continuing education.
17. **"University"** shall mean the American University of Sharjah.
18. **"University Personnel"** shall include both Academic and non-academic personnel.
19. **"University Support"** shall include the use of university funds, university Personnel, facilities, equipment, materials, technological information, or proprietary know-how.
20. **"Work"** shall include all material capable of being protected by copyright including student theses, and all printed material, computer software, data, audio and visual material, circuit diagrams, architectural and engineering drawings, lectures, musical or dramatic compositions, choreographic works, and pictorial or graphic works.