

ST. MARY'S UNIVERSITY



Intellectual Property Policy

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Principles of Intellectual Property

Purpose of Principles

The **purpose of these principles** is to define a working philosophy that will express the values the university holds in regard to the intellectual work we do and that will guide the institution in developing the necessary policies and procedures to manage this important asset.

I. Institutional Mission and Core Values as they relate to these Principles:

In accord with the University's mission and traditions, these principles rest upon an intellectual tradition that embraces free inquiry, a commitment to justice and freedom, and to civic responsibility. We affirm the following articulation of purpose for Catholic & Marianist Universities:

“These basic commitments support the most fundamental work of a university: the collaborative efforts of teachers and students to understand and improve the world, the solitary but deeply communal enterprise of the researcher dedicated to exploring the boundaries of what is and can be known.”
(*Characteristics of Marianist Universities, 12*)

II. Principle: Rights and Responsibilities of the University

The commitment to a collaborative, communal venture is reinforced through a long tradition, indeed a fundamental practice among universities, of open sharing of knowledge and information. Our efforts to protect and manage intellectual property through University policies and procedures must not undermine this socially desirable and beneficial tradition. Therefore, the University will not unduly restrict the free flow of ideas among researchers acting within their professional roles at the University. The University will assist researchers in protecting and disseminating research that is beneficial to the University and to the public according to the policies and terms included in this document.

III. Principle: Rights and Responsibilities of Researchers

The University extends both rights and responsibilities to employees at the time of employment.

Non-University affiliations: University employees engaged in activities that may lead to intellectual property claims should carefully weigh alliances and other collaborations outside of their professional roles that may appear to conflict with their obligations to the University. In enterprises and activities in which sharing of ideas and/or research data takes place, the researcher must ensure no financial or other conflict of interest exists between his or her obligations to the University and to other parties. Communication with the department chair and dean, or other supervisor as applicable, regarding situations where conflicts may arise is required. This principle is discussed in Section 2.11.6.5 and following of *The Faculty Handbook*.

University-based affiliations: The highly collaborative nature of today's research and educational ventures requires that we be attentive to the formal policies and procedures that often make these enterprises positive experiences. This attentiveness is especially important in the technology-enabled environment in which we create and communicate our work. The University seeks to support faculty and other researchers who wish to share ideas with colleagues at other institutions and who wish to engage in mutually beneficial research and in the scholarships of teaching or application.

Disclosure: When employees and students participate in research affiliations, contracts, or collaborations in their university roles, University policies and procedures regarding these types of agreements must be followed. Formal agreements between researchers and/or other professionals at other institutions, whether for-profit or non-profit, are an important part of safeguarding the interests of all parties. Therefore, disclosure of any activity that may result in intellectual property claims must be initiated at the earliest point in the research, preferably before formal research begins.

Part I Introduction

1.0 Intellectual Property Defined

Intellectual Property applies to creations of the mind - creative works or ideas embodied in a form that can be shared or can enable others to recreate, emulate, or manufacture them. There are four ways to protect **intellectual property**: patents, copyrights, trademarks, and tangible research property agreements. This policy document is organized around these four types of intellectual property according to the following issues:

- **Definitions**
- **Ownership**
- **Evaluation, protection, and dissemination**
- **Commercialization**
- **Authority and Responsibilities**

1.1 Patents

(1) A patent is a property right, granted by the United States Patent and Trademark Office, that gives the holder the exclusive right to exclude others from the manufacture, use, and sale of the invention in the U.S. for a period of time (in the U.S. 20 years). As property, it may be sold or assigned, pledged, mortgaged, licensed, willed, or donated, and be the subject of contracts and other agreements.

(2) Patents may also be granted in foreign countries. Procedures for securing a patent in foreign countries vary considerably from country to country.

(3) Patent protection can be secured for anything that is (a) novel, (b) useful, and (c) non-obvious. U.S. and most foreign countries issue patents for inventions of new and useful processes, machines, manufactured products, or new and useful improvement to an existing invention. Subject matter that is **NOT** patentable includes theories, ideas *per se*, mathematical formulas, laws of nature, plans of action, results, printed materials, anything repugnant to morals or public policy.

(4) Computer software generally will be patentable if it meets the tests of novelty and non-obviousness **and** if its application is part of a process, machine, manufacture, or composition of matter that can be considered for patent protection. A software invention will be automatically disqualified from patent protection only if it is purely a mathematical equation or formula with no other application.

1.2 Copyrights

(1) Under federal copyright law, copyright subsists in “original works of authorship” which have been fixed in any tangible medium of expression from which they can be perceived, reproduced, or otherwise communicated either directly or with the aid of a machine or device.

(2) As provided by copyright law, a copyright owner has the exclusive right to reproduce the work, prepare derivative works, distribute by sale or otherwise, and display or perform the work publicly.

(3) For an individual author, copyright protection of a work extends for the author's life plus 70 years. For employers, copyright protection of a work extends for 120 years or 95 years from the date of publication.

(4) In contrast to a patent which protects an invention, process or product, copyright protects the "artistic expression" from being copied, as in the particular literary work, musical work, computer program, video or motion picture or sound recording, photograph, sculpture, and so forth, in which the "expression" is embodied, illustrated, or explained; copyright does not protect the "idea."

1.3 Trademarks

(1) A trademark is a distinctive mark of authenticity, through which the products of particular manufacturers or the vendible commodities of particular merchants may be distinguished from those of others.

(2) A trademark is a distinctive mark, motto, device, or emblem, which a manufacturer stamps, prints, or otherwise affixes to the goods he produces, so that they may be identified in the market, and their origin may be verified.

(3) The two goals of trademark law are reflected in the federal scheme of regulation: on the one hand, the law seeks to protect consumers who have formed particular association with a mark, and, on the other hand, trademark law seeks to protect the investment in a mark made by the owner. Stated differently, trademarks serve two distinct yet equally important policy interests: one, to prevent confusion, deception or mistake of consumers, and two, to preserve fair competition and the owner's good will investment, its mark and business.

1.4 Tangible Research Property

(1) The term "tangible research property" refers to those research results that are in a tangible form as distinct from intangible (or intellectual) property. Examples of tangible property include integrated circuit chips, computer software, biological organisms, engineering prototypes, engineering drawings, and other property which can be **physically distributed**.

(2) Although tangible research property may often have intangible property rights associated with it, such as biological organisms which may be patented or computer software which may be either patented or copyrighted, where appropriate, tangible research property may be distributed without securing intellectual property protection by using some form of contractual agreement, such as formal contract, loan agreement, letter agreement, or user license as further set forth in this document.

Part 2 – General Policy Statement

2.0 General Policy Statements

2.1 Ownership

2.1.1 Inventor/Creator Ownership

Inventors/Creators of Intellectual Property are free to acquire ownership of or other rights to works **except** as described under the following conditions.

2.1.2 University Ownership

Intellectual property developed by St. Mary's University (hereinafter "University") faculty, students, staff, or others, including visitors participating in University programs or using University funds or facilities, is owned by the University. The University's ownership claims include, but are not limited to, the following situations:

- The Intellectual Property was developed in the course of or pursuant to a research agreement between the Inventor/Creator and the University (See Section 2.3).
- The Intellectual Property was developed with significant use of funds or facilities administered by the University (See Section 2.2).
- The Intellectual Property was created as a course or graduation requirement (See Section 2.1.4.).

2.1.3 Other Ownership

Intellectual Property developed by University faculty, students, staff, or others, including visitors participating in research or sponsored projects funded in part or whole by other parties, is subject to the *terms and conditions* of the agreement defining the rights and responsibilities of the parties entering into the agreement, or contract, or by federal and/or state laws or regulations.

2.1.4 Student Ownership

When an invention involving the significant use of University resources is made by a student, the student may formally petition the University and for good cause shown, the University may elect to waive its rights to the invention by executing a formal document signed by the student, the student's advisor, the student's department chair, and the President of the University. No other action by the University or its agents shall constitute a waiver of any intellectual property rights or other legal claims the University may have to student work. The university will typically not grant a waiver where the invention is subject to a sponsored research or other agreement. After consultation with the principal investigator and others as appropriate, the University may retain a right to use such invention for purposes of education and research. In addition, a student's rights to such invention may be subject to the terms of any financial aid received, including scholarships, fellowships, traineeships, senior or course projects, thesis/dissertation, or other assistance. Individuals who are both staff members and students shall be considered to be staff members with respect to patentable inventions.

2.1.5 Special Conditions of Ownership

Theses and Dissertations

Copyright ownership of theses and dissertations is retained by the student, but the student must grant to the University royalty-free permission to reproduce and publically distribute copies of the thesis or dissertation for research and/or educational purposes. In circumstances where the research for the thesis or dissertation has been done in conjunction with other policies discussed in this document, those policies will apply with regard to the students.

Electronic Courses

Ownership of electronic courses may reside (1) entirely with the faculty member developing the course, (2) jointly with the faculty member and the University or (3) entirely with the University depending upon the conditions under which the course was created. If a course is to be developed under conditions that will result in full or partial ownership of the course by the University then a written agreement specifying ownership and allocation of royalties must be signed prior to creation of the course.

Research Data

Ownership of “preliminary,” “raw,” and “final” *research data* shall be determined by the agreements in place at the time of development or discovery. Researchers have a custodial responsibility for research data generated through their own research or through research that they supervise; that is, data must be protected, preserved, and retained for a period of time that is either (1) required by the research agreement or University policy, (2) established by federal regulation, or (3) necessary to validate the research. Record retention and ownership of research data may also be subject to other policies established by the university.

2.2 Significant Use of University Resources

The University does not construe the use of office, library, machine shop, desktop work stations, communication and storage servers as constituting significant use of University space or facilities.

Generally, Intellectual Property is considered to have been developed using significant amounts of University funds or facilities if:

- More than a minimal amount of unrestricted funds have been used; or
- The Intellectual Property has been developed within the assigned area of research of the inventor under a Research Assistantship or sponsored project; or
- More than a minimal amount of time has been spent using University facilities or if significant facilities and equipment have been utilized; or
- The inventor has developed the property using time **before** expected and contracted duties have been fulfilled.

See Exemplar A

2.3 Agreements Between Parties

By law, ownership of intellectual property created by University employees in the course and scope of their employment is work made for hire and therefore resides in St. Mary’s University. The University reserves any of its legal rights or claims to intellectual property, subject only to a

formal waiver executed by the University and signed by the President. Notwithstanding this reservation, in accordance with its internal policy, the custom of the University is to permit its employees to exercise ownership rights in works of a personal nature in order to encourage creativity. For information specific to writings, including the University's policy regarding academic scholarship, see Part 3.3 of this policy. Should the employee desire to establish ownership rights in any piece of intellectual property created, or to be created in the future by the employee, it may do so by means of a special contract with the University. Should an employee wish to be compensated for a creative work over and above the rate of compensation for employment, he or she may attempt to do so by means of a special contract with the University. Disclosure should act as a triggering event whereby the University is notified of a potential creative work. At this time, either the University or the employee should, if desired, seek the special contractual arrangements just described.

Whenever the potential exists for creation or development of Intellectual Property through research or other activities affiliated with the university or its sponsored activities, the university requires a Disclosure of Intellectual Property Form (See Part 3). **This form should be initiated as soon as the potential is recognized, preferably prior to conducting the research or beginning the project.**

Appendix C contains Forms relevant to Intellectual Property Agreements.

2.4 Dispute Resolution

In cases where there is a difference of opinion on ownership of inventions, division of proceeds, or other provisions of this policy, the parties involved may initiate a grievance process by following the procedures in the *Faculty Handbook*, *Student Handbook*, or *Personnel Handbook* as appropriate. The Intellectual Property Committee may serve as an expert resource in this process, if requested to do so.

Part 3 – Intellectual Property Evaluation, Protection, and Dissemination

The following sections provide information to researchers about how intellectual property is evaluated, protected, and disseminated for each class of property.

3.0 Responsible Entity

The Intellectual Property Committee (IPC) shall serve as the primary administrative oversight group for patents, copyrights, trademarks, and tangible research property. The Committee's roles and procedures are further defined in *Part 6 – Administration*. The University will engage a technology management group or a qualified attorney to obtain licensing or other legal protections for intellectual property claimed in part or whole by the University.

3.1 Disclosure of Potential Intellectual Property

The initial step in managing Intellectual Property is the submission of a University Intellectual Property Disclosure Form to the IP Committee. This form can be obtained from the Academic Research and Sponsored Projects Office or online at the following web address: www.academicgrants.stmarytx.edu. When submitted, the IP Disclosure Form will initiate action by the IP Committee to investigate the patenting (or other methods of protection) and marketing

of the technology unless accompanied by a letter requesting other action by the University, such as a waiver of the University's ownership rights in the technology.

3.1.1 When sponsored research or other third-party agreements apply

Research or other sponsored projects funded in part or whole by a third party are often governed by federal or state laws and regulations, such as the Bayh-Dole Act. A grant or contract between a sponsor and the University usually contains specific provisions with respect to the disposition of rights to inventions or creative works. See Appendix C for Patents and Inventions Form.

3.1.2 When internal agreements apply

Disclosure agreements shall be completed at the earliest possible point. When third-party sponsors are not involved, internal agreements shall be developed to protect and balance the researcher's interests and the University's interests. See Appendix C for the Intellectual Property Disclosure Form.

3.2 Patents

3.2.1 Evaluation

(1) A patent gives the inventor exclusive rights for a period of 20 years from the date of approval. The period of 20 years is exclusive of certain regulatory delays such as those sometimes imposed by the Food and Drug Administration.

(2) Inventors may apply for a Provisional Patent.

(3) To be patentable in most countries, an invention must be new, useful, and non-obvious. In most foreign countries, an invention is unpatentable unless the application is filed before *public disclosure*.

(4) It is important to understand at the outset that any *publication* that describes an invention (even in minimal detail) prior to filing for a patent may preclude patenting in the U.S. or a foreign country. The implications of "public disclosure" or "publication" upon patent rights should be discussed with the Intellectual Property Committee and a decision on patent filing reached promptly so that publication will not be delayed.

3.2.2 Protection

Acquisition of a patent requires considerable resources in both time and money, often needing specialized legal help. Although patent protection is sometimes sought for various non-commercial reasons (such as professional status), the University will not seek protection for concepts that are not commercially attractive even if the concept is intellectually meritorious. The University will normally seek patent protection on inventions in order to pursue commercial licensing and to comply with the terms and conditions of sponsored agreements.

3.2.3 Dissemination

Intellectual Property that is patented may be disseminated by (1) free, non-exclusive license to use the technology; (2) through Tangible Research Property dissemination processes; or (3) by formal commercialization.

3.3 Copyrights

3.1 Evaluation: Asserting and Registering Copyright

Copyright protection of books, articles, and publications is sought in order to recognize authorship and protect the integrity of the work. It is also essential in order for the University to license copyrightable materials to commercial book publishers and others and to comply with the terms of sponsored research agreements.

The University does not claim ownership of books, articles, and other scholarly publications or of popular novels, poems, musical compositions, or other works of artistic imagination which are created by the personal effort of faculty, staff, and students independent of employment tasks and which do not make significant use of University administered facilities. Although the University claims all other work, its general policy is to only enforce rights to commercially viable work.

In those situations where copyright to such scholarly or artistic work resides in the University under the terms of a sponsored research or other agreement or by operation of the copyright law or otherwise as a result of this Policy, the University may, upon the author's request and to the extent consistent with the intent of the sponsor, convey copyright to the author of such work as further provided under this Policy.

3.3.2 Protection

A copyright is automatically established at the time expression is fixed in tangible medium. For added copyright protection, certain works should be registered with the U.S. Copyright Office using its official forms.

Creators retaining personal ownership of the copyright to their creations, as described in the section above, are personally responsible for copyright notices and registration of their works.

The following notice is to be applied on University-owned works to protect the copyright "Copyright © 2002 St. Mary's University. All Rights Reserved." The date of the notice should be the year in which the work is first published. No notice other than the foregoing is to be used for University-owned works.

3.3.3. Dissemination

Authors are free to disseminate their original works as they see fit. Copyrights held by the University are normally registered through the U.S. Copyright Office except where other arrangements are made in accordance with this Policy. Copyrights for which the University holds royalty-free permission may be disseminated by the University for internal use or for purposes of education, research, or university promotion.

3.4 Trademarks

3.4.1. Evaluation

The two goals of trademark law are reflected in the federal scheme [of regulation]: on the one hand, the law seeks to protect consumers who have formed particular associations with a mark, and, on the other hand, trademark law seeks to protect the investment in a mark made by the owner. *Avery Dennison Corp. v. Simpson, 189 F.3d 868*. Stated

differently, trademarks serve two distinct yet equally important policy interests: one, to prevent confusion, deception or mistake of consumers, and two, to preserve fair competition and the owner's good will investment, its mark and business. *Perfumania, Inc. v. Perfumlandia, Inc.*, 279 F. Supp.2d 86.

3.4.2 Protection

To ensure trademark protection, registration under appropriate federal statutes is advisable. This extends trademark protection to qualifying unregistered trademarks and prevents consumer confusion regarding the source of a product or service. Lanham Trade-Mark Act section 43(a), 15 U.S.C. A. 1125(a).

3.4.3 Dissemination

- (1) The University may grant to a Licensee a nonexclusive license subject to terms and conditions specified in an Agreement to use a Licensed Mark on and in conjunction with the marketing, promotion, and sale of the Licensed Articles in the United States.
- (2) An initial Licensing Fee and royalties based on a percentage of net sales of all licensed articles shall be paid to the University for use of the Licensed Mark.
- (3) An initial term for the Agreement and the provisions for renewal shall be specified in the Agreement.
- (4) The University reserves the right to approve or reject the quality and propriety of any items bearing the Licensed Mark. All such items are subject to approval by the Licensee prior to use or sale.
- (5) The Licensee agrees to indemnify and hold the University harmless from any and all claims, liabilities or other judgments arising from any action by the Licensee.
- (6) A provision for serving notice shall be specified in the Agreement.
- (7) A provision for terminating the Agreement will be specified in the Agreement.

3.5 Tangible Research Property (TRP)

3.5.1 Evaluation

When TRP is not subject to a sponsored research or other agreement but has been developed using significant University funds or facilities and it has been established that the University has ownership of the technology, the IP Committee may recommend licensing the invention to the inventor(s) exclusively or nonexclusively on a royalty basis. The inventor(s) must demonstrate technical and financial capability to commercialize the tangible research property, and the president of the University will have the right to terminate such license if the inventor(s) has not achieved effective dissemination within a reasonable amount of time (generally less than 3 years). The license is also subject to the inventor(s) waiving their rights to royalty sharing under this policy. Where such a license is issued, the inventor(s) may be required to assume the costs of filing, prosecuting, and maintaining any patent rights.

3.5.2 Protection

Protection for TRP deemed suitable for patenting and/or licensing will follow the same procedure as other patentable property. TRP distributed for scientific research will be protected by the Materials Transfer Agreement (MTA).

See Appendix C for Material Transfer Agreement.

3.5.3 Dissemination of TRP for research and other noncommercial purposes

Tangible research property such as biological materials and computer software are frequently patented or copyrighted as appropriate and then licensed for commercial purposes. However, these and other forms of TRP, including those under commercial license, generally are simultaneously distributed solely for research purposes either under simple letters of understanding or more formal licenses. The following sections deal only with dissemination of TRP for research and other noncommercial purposes. Commercial licensing of TRP is covered in 3.2, as such TRP is then considered patentable and licensed for commercial purposes under various types of patent licensing.

Where TRP is developed in the course of research that is subject to the terms of a sponsored research or other agreement, control over its development, storage, distribution, and use is the responsibility of the principal investigator, who will consult with the IP Committee. In other cases, significant use of University resources will be presumed, so control over TRP rests jointly with the laboratory director or department head and with the IP Committee. The responsibility for control includes determining if and when distribution of the TRP is to be made beyond the laboratory for scientific use by others in accordance with the terms of this policy.

TRP owned by the University may usually be distributed for research purposes only with minimal conditions attached. Any such distribution is subject to an agreement by the recipient that commercial development or commercial use or further transfer of the biomaterial is not to be undertaken. The *Materials Transfer Agreement* is an example of such an agreement. In addition, the principal investigator may wish to control subsequent use by requiring recipients to follow a specific research protocol, for example, in the use of the biological materials.

If the TRP was developed under a sponsored research agreement, the IP Committee must be contacted to advise on possible contractual obligations with respect to the TRP prior to its distribution for noncommercial purposes. Distribution of biological TRP that is part of a patent or patent application must be coordinated through the IP Committee.

Part 4 – Commercial Development

4.1 General

Universities exist to educate, to discover and create knowledge, and to advance the public good. To this end, the university encourages development and dissemination of research results that are useful and beneficial in the public domain. Publications and presentations of research results may be sufficient to meet the mandate to educate and disseminate knowledge. However, the

university may find it necessary to encourage other ways of disseminating the results of research, such as the development and production of products and processes for public use.

The university may pursue the licensing or commercialization of technology that it deems beneficial to the public.

4.1.1. Role of Owners

The role of owners is established in the licensing, grant, and/or contract agreements created at the time of disclosure of the intellectual property and must include equity and management roles. Roles may be further refined as the protection and dissemination processes are developed.

Although the University reserves all rights or legal claims in its intellectual property, St. Mary's University may elect to waive its rights or stand aside, by executing a formal legal document signed by the President, in those situations when it would enhance the transfer of technology to the public, when it is consistent with University obligations to third parties, and when it does not involve a conflict of interest. By waiving or standing aside, the University agrees not to exercise its contractual rights to the technology, clearing the way for the inventors to seek ownership.

In cases in which it is advantageous to both the University and the inventors, the University may retain ownership of the invention, but give an exclusive license to the inventor(s).

It is important to recognize that under current law, ownership does not automatically revert to the inventors if the Federal Government is the sponsor. In such cases, the Government retains the option to claim ownership of the invention. In the event the Government does not exercise its option, ownership will revert to the inventors. However, regardless of ownership status, the Government will retain a non-exclusive, non-transferable, irrevocable, royalty-free, worldwide license to practice the invention.

4.1.2 Royalties or Division of Proceeds

When an invention is patented (or patent protection is sought) and/or marketed by the University (whether owned by it, assigned, or subject to the provision of an agreement for sponsored research), the gross proceeds arising from the invention will be distributed as follows depending on equity and management agreements:

Step 1 -- Before Recovery of Specific Expenses: 100% to the University until Specific Expenses associated with the invention are fully recovered.

Step 2 -- After Recovery of Specific Expenses: Inventor
Not less than 35% nor more than 65%

St. Mary's University
Not less than 35% nor more than 65%

Gross proceeds include equity, the acquisition and disposition of which will be governed by a University policy approved by the president. Any consideration received for the performance of research is not to be defined as part of gross proceeds.

4.2 Patents

St. Mary's University will evaluate intellectual property at the time of disclosure (see 3.1) for potential commercial value. The Intellectual Property Committee (IPC) will monitor the development of the technology/intellectual property and determine at what point, if any, the patent process and subsequent commercialization should proceed. The IPC shall provide a status update at least quarterly to the VPAA and President on monitoring activities. If the IPC concludes that the intellectual property has a good possibility of being licensed and that potential royalty returns are sufficient to justify patenting and licensing expenses, the IPC chair shall notify the VPAA and President of the Committee's recommendations. If the President formally approves in writing, an Assignment/royalty sharing Agreement will be executed with the inventor(s) and commercialization will proceed as described in Part 4.

4.3 Copyrights

The University may, at its discretion, publish or otherwise distribute works to which it has copyright in the University's and the public's best interest. Agreements, if any, between the university and the creator will govern any distribution of proceeds from the publication or commercialization of the work. In the absence of formal written agreements, any proceeds from the publication or commercialization of the work will be shared according to the formula in Section 4.1.2.

4.4 Tangible Research Property

It is the University's policy that any commercial distribution of University-owned TRP be handled only through the IP Committee. Software should be submitted to the IP Committee in the same fashion as a patentable invention, for which the first step is preparation and submission of a Technology Disclosure Form.

If TRP developed by the University as a result of research activities is to be distributed to outside users for commercial purposes, the distribution agreement must contain provisions negotiated by the IP Committee and approved by the President covering the terms under which the property may be used, limits on University liability for the TRP or products derived therefrom, and other conventional license agreement terms including those relating to any intangible property rights (such as patents) which also may be associated with the use of the tangible property.

Part 5 – Faculty, Staff, Student and Visitor Obligation

It is the general policy of the University that individuals, by participating in University-sponsored research projects, accept the principles of ownership of intellectual property as stated under this policy. In furthering such undertaking, all participants will sign Invention and Copyright Agreements in accordance with this policy.

These policies pertaining to the ownership and licensing of intellectual property constitute an understanding that is binding on the University, and its academic and non-academic employees, students and others as a condition for their participation in University research, teaching and service programs or their use of University resources. Furthermore, to avoid any potential for a

conflict of interest, members of the University may not enter into a consulting agreement that is in conflict with the policies described here.

Furthermore, regulations applicable to Federal grants and contracts and terms of certain sponsored agreements stipulate that the University has written agreements with their employees which require the prompt disclosure of all inventions to a University representative (IP Committee). To comply with such regulations, all faculty, research staff and students who work or intend to perform work on a federally funded project or other sponsored projects are required to execute such agreements.

5.1 Who Must Sign Invention and Copyright Agreements

Any individual at St. Mary's University who –

1. Receives support from externally or internally sponsored projects; or,
2. Otherwise may be in a position to make, conceive, or reduce to practice inventions or otherwise develop intellectual property under externally or internally-sponsored projects (whether or not salary or other support is received from such projects) must sign the University's Invention and Copyright Agreement. Note that this requirement specifically extends not only to St. Mary's personnel but also to visiting scholars and fellows or others who may participate in sponsored projects at the University.

5.2 Administration

Each department Chair and the Dean of a School is responsible for ensuring that Invention and Copyright Agreements are signed by all faculty, students, staff, and visitors who may be or are involved with sponsored projects administered by that department or school. The Intellectual Property Committee and the Academic Research and Sponsored Projects Office will assist in this process as appropriate. All Invention and Copyright Agreements should be signed in triplicate with one copy retained by the signatory, one copy retained in the department or school, and one copy sent to the Academic Research and Sponsored Projects Office.

Part 6 – Administration

6.1 Acknowledgement of Institutional Authority

The president of St. Mary's University has the ultimate authority for the stewardship of intellectual property as appropriate to the University's mission. The Vice President for Academic Affairs shall assume direct oversight responsibilities, and the IP Committee shall report directly to the VPAA.

The Office of Academic Research and Sponsored Projects, in consultation with Principal Investigators and others as appropriate, is responsible for the pre-award negotiation, implementation, and post-award administration of all University agreements with external sponsors of research grants and contracts and for ensuring compliance with stipulations and mandates of the Terms and Conditions of awards under externally-funded academic grants and contracts.

6.2 Intellectual Property Committee

The Intellectual Property Committee has responsibilities in four areas: (1) **maintaining** currency of Intellectual Property policies and procedures; (2) **reviewing** all disclosures submitted in accordance with the University's intellectual property policies; (3) **recommending** actions to ensure protection of identified intellectual property; and (4) **reporting** the activities of the IPC and the status of identified intellectual property to the VPAA and the President.

All recommendations of the IPC are subject to the approval of the VPAA and the President of the university. In order to fulfill these responsibilities, the IPC shall:

- (1) Review and revise, as required to maintain currency or improve efficiency, St. Mary's University Intellectual Property Policy and Procedures in accordance with University policy revision approval processes.
- (2) Review all Disclosures of Intellectual Property submitted in accordance with this policy.
- (3) Recommend to the VPAA and the President actions that the University should consider in order to protect intellectual property as defined in the Disclosure documents. The IPC may also advise the VPAA and the President concerning the equitable distribution of royalties from the development and marketing of those intellectual property rights in which the University has a vested interest.
- (4) Report on a regular and frequent basis the activities of the IPC and the status of any intellectual property under development.

6.3 Intellectual Property Committee Membership, Qualifications, and Selection

The committee shall consist of seven members as follows:

- **one** full-time faculty members from the School of Science, Engineering, and Technology
- **one** full-time faculty member from the School of Humanities and Social Sciences;
- **one** full-time faculty member from the Bill Greehey School of Business;
- **one** full-time faculty member from either the Blume or Law Library;
- **one** full-time faculty member from the School of Law;
- **the** Director of Sponsored Projects, Academic Research and Compliance

Faculty with strong research credentials are eligible for IP Committee membership, with a preference for members who have produced intellectual property or who are active researchers in fields that commonly produce intellectual property, or who have specialized experience with intellectual property issues.

The VPAA, in consultation with the president, shall appoint members for a two-year term with the exception of the first year, which shall be staggered to ensure continuity thereafter. The VPAA shall select the Chair.

6.4 Intellectual Property Committee Procedures

(1) The Intellectual Property Committee shall meet as necessary, but **no less than** twice during each semester of the Academic Year.

(2) The Committee shall establish policy review procedures that ensure the policies are thoroughly evaluated at least once during the Academic Year. The Committee shall recommend policy revisions according to established review procedures.

(3) The Committee shall review all intellectual property disclosures and potential claims within 30 days of notification/application.

(4) The chair of the Committee shall accept disclosures and claims on behalf of the Committee and shall be responsible for distributing this information to the Committee members in a timely fashion so that action may be taken within the 30 day period.

(5) The chair of the Committee shall notify University officials of any intellectual property that may have commercial potential.

(6) The Committee shall be one of the primary points of contact with the technology transfer group/attorney retained by the University to commercialize intellectual property.

Appendix A Glossary Intellectual Property

- ✳ **Collaborator:** A collaborator is an individual who is not an employee of St. Mary's but who, together with a St. Mary's employee, creates a copyrightable or patentable work. Because collaborators are not employees of St. Mary's, the University does not by law have ownership of the collaborator's interest in the creative work. Should St. Mary's seek to acquire such an interest or ownership, it may attempt to do so via a separate (non-employment) contractual arrangement with the collaborator.

- ✳ **A Copyright** is a grant by the United States of exclusive rights over the writings of an author, including software. Copyright protects only the expression, not the idea. If the author wants the right to sue for infringement, claims to copyright must be registered in the Copyright Office.

- ✳ **Data:** Data is defined in the NIH Grants Policy Statement as “recorded information, regardless of the form or medium on which it may be recorded, and includes writings, films, sound recordings, pictorial reproductions, drawings, designs, or other graphic representations, procedural manuals, forms, diagrams, work flow charts, equipment descriptions, data files, data processing or computer programs (software), statistical records, and other research data.” The term refers to research notebooks, financial records if relevant to a sponsored project, supporting documentation and any other data generated in the conduct of the research.
Data is also defined in OMB Circular A-110 as “the recorded factual material commonly accepted in the scientific community as necessary to validate research findings, but not any of the following: preliminary analysis, drafts of scientific papers, plans for future research, peer reviews, or communications with colleagues.” It also excludes some types of proprietary materials.

- ✳ **Disclosure:** The formal process of notifying (university) officials of potential or expected outcomes of research or other employment-related activities that may lead to a patent, trademark, copyright, or Tangible Research Property.

- ✳ **Electronic Courses:** Electronic courses are those courses taught primarily on-line as opposed to live instruction. Faculty PowerPoint lectures, student assignments, tests and other course requirements are primarily completed on-line. The interaction of faculty and students is primarily asynchronous. The percentage of on-line versus live faculty and student activity in any particular course will result in the classification as an on-line course when 50 % or more of that activity is performed and transmitted via the internet, usually via a network such as Gateway's Blackboard. Electronic courses make distance learning possible and thereby enable St. Mary's faculty to teach students who are in locations remote from St. Mary's. Such courses require extensive preparation of PowerPoint lectures, exercises and tests which are often unique to the on-line environment. They therefore merit copyright protection.

- * **Gross proceeds:** Gross proceeds are the total monetary revenue which is realized from the use or commercialization of a creative work by a licensee. *Gross proceeds* include, but are not limited to (a) option fees; (b) license fees; (c) running royalties; (d) minimum royalty payment; (e) milestone payments; (f) proceeds from the sale of stock or other equity in the licensee company; and (g) funds and other compensation received as a result of the resolution of disputes related to the invention.
- * **Independent Work:** An independent work is a creative work performed by a St. Mary's employee where such creation occurs outside of the course and scope of that employee's employment. As a result, St. Mary's has no claim on the creative work. Any interest in the creative work which the University might seek would have to be acquired via a separate (non-employment) contract.
- * **Intellectual Property** is any invention, discovery, trade secret, technology, scientific or technological development, computer software, or other form of expression that is in a tangible form. Intellectual property can be protected by patent, trademark or copyright laws or it can be protected as a trade secret by not disclosing the “know how” to others.
- * **Materials Transfer Agreement:** An MTA is an agreement between parties that provides protection for intellectual property. Such an agreement establishes the terms of use and the obligations of the recipient when research materials are exchanged or shared. MTAs are limited to any kind of physical material; for example, cell lines, chemical compounds, engineered materials, etc.
- * A **Patent** is a property right granted by the United States, which gives the holder the exclusive right to exclude others from the manufacture, use and sale of the invention in the United States for a period of time. As property, it may be sold, assigned, pledged, mortgaged, licensed, willed, or donated, and be the subject of contracts and other agreements. When an inventor secures a patent, he or she has the opportunity to profit by the manufacture, sale or use of the invention in a protected market or by charging others for making or using it. Patents may also be obtained in other countries, and foreign patents are often important for commercial development.
- * **Publication:** Something is published when it is described or discussed to a third party in a written format, to include electronic text.
- * **Public Disclosure:** This term is primarily used in regard to patents. If the inventor has described the invention, in part or whole, in a public setting, such as at a conference, or if the invention has been used or sold in the U.S. or a foreign country, it is not patentable.
- * **Royalty:** The consideration or compensation paid to the licensor in exchange for certain rights in the technology that the licensor is providing to the licensee.
- * **Royalty-free:** A royalty is either a payment made to the patent owner for the privilege of using a patented invention or a payment made to a copyright holder for the use of the

copyright holder's work. In each instance, the right to use the owner's creative work or invention is based on the owner's granting of a license. A royalty-free license would occur when the license to use the creative work is granted but no payment is required of the user.

- * **Specific Expenses:** Specific expenses are those costs associated with filing a patent application or obtaining a patent, which may include attorney and all filing fees, and costs associated with commercialization of the invention, such as marketing or prototype development. Any expenses related to filing a patent, trademark, copyright, or Tangible Research Property agreement are considered specific expenses. Also refer to Gross Proceeds above.
- * **Sponsored Research, Contracts, and Other Agreements** refers to specific types of research support agreements between researchers, funding sources, and contract parties.
 - Sponsored Research commonly refers to research that is sponsored, or funded either fully or partially, by an entity external to the institution conducting the research or other project. Government and nongovernment agencies/entities “sponsor” research and development projects with resources such as money, equipment, personnel, or other in-kind resources.
 - Contracts are formal agreements that define relationships and responsibilities between two or more parties that create a legal obligation between them to do something, or to not do something. To be binding, a contract must be created between competent persons; the subject matter must be explicitly stated; there must be mutuality of agreement; and there must be mutuality of obligation.
 - Other agreements are documents that establish formal relationships between two or more parties to conduct business. These are most commonly cooperative agreements, memoranda of understanding, or subcontracts in which the relationships, outcomes, or deliverables are explicitly stated.
- * **Terms and Conditions of Award** refers to award documents that set forth the terms and conditions under which an award is made. An Authorized Organizational Representative (AOR) signature is usually required from the receiving institution formally agreeing to meet the requirements of the funding source before the award is finalized. These documents include the assurances for regulatory frameworks of grants, contracts, and other agreements and provide the authorizing legislation (if any) for requiring those assurances as part of an award. Terms and conditions are usually specific to the funding source but may also include federal or state mandated terms and conditions as required by law or regulation.
- * A **Trademark** differs from both patents and copyrights. It is a word, name or symbol adopted or used by an individual, corporation, or other entity to distinguish its goods or services from others’ goods or services. When a mark is registered in the Texas Secretary of State’s Office or the U.S. Patent and Trademark Office, the trademark owner obtains certain rights and benefits. Rights to a trademark are established by adoption and actual use, not by authorship as in copyrights, or by inventorship as in patents.

Appendix B Exemplars

Intellectual properties can generally be described as falling into two categories: technical works and creative works.

Technical works would tend to include intellectual properties that are generally of a scientific, engineering, or technical nature—examples being patentable or unpatentable inventions, devices, machines, processes, methods, and compositions; computer software; and university collections.

Creative works would include all intellectual properties not covered in technical works that are of an artistic, scholarly, instructional, assessment, or entertainment nature. This description might include creative productions, such as works of art or design; musical scores; books, poems, and other types of scholarly or creative writings; films; video and audio recordings; and instructional materials, such as textbooks and multimedia programs.

Creative works would not include those productions of drama, music, athletics, and similar events that are managed by appropriate academic departments, colleges, or academic support units and are expressly approved by university administration as not being subject to this policy.

Traditional academic publications that are produced as a normal outcome of scholarly work and have only minor commercial possibilities are not included except under specific and unusual circumstances. These publications would probably include professional papers published in scholarly journals, monographs of an academic nature, scholarly books of limited use/purpose, or supplementary texts, etc. Likewise, juried artistic creations or performances that are the academic, noncommercial equivalents of such scholarly publications would not be included.

Here are a few exemplars of the types of IP that may be created:

Exemplar 1: A full-time faculty member has created an online course from a traditional course that he has taught for some time. The faculty member has adapted assignments and course materials from his previous traditional course and added new material and exercises to maximize the learning experience online. No additional facilities or equipment is required to transition the traditional course to the online course.

The faculty member owns the intellectual property and has the right to revise and distribute the work commercially. The University has no ownership rights.

Exemplar 2: A faculty member's department is revising its program. Professor Jones has been asked to design a new course and has assigned a graduate assistant to assist her. Additionally, the technology support group will be providing assistance in the development of the design and production of a DVD that will be used in the course.

The faculty member shares ownership of the intellectual property with the University. A written agreement should be completed prior to the development of the course. The agreement should stipulate who will secure copyright registration and who will enforce the copyright. If the course is licensed for commercial purposes either by the faculty member or the University, each party

will share in the royalties as stipulated in the agreement. The graduate assistant may be eligible for commercialization profits as well.

Exemplar 3: A professional staff member is contracted to develop an online tutorial program in study skills for at-risk students. The program is developed during normal work hours.

The University has exclusive ownership of the intellectual property. The staff member is not entitled to royalties. The agreement is Work for Hire.

Exemplar 4: Amy is a law student and an aspiring writer. She writes almost everything by hand. Towards the middle of the semester, she develops a rare pain in her middle finger joint, and writing by hand becomes almost too painful to bear. She tries every ergonomic pen she can find, but none seem to be for the type of injury she has. She tries to switch to typing, but to no avail. She searches for others with her problem, but they too are at a loss. One night, she gets the idea to melt her pen so that it bends around her middle finger rather than presses upon it. After attaching a ring for the middle finger, and a few more adjustments, her pain is gone! Excited, she shares the good news with other middle-finger-pain victims. Inspired by their positive feedback, she decides to patent her idea.

The student owns the intellectual property and has the right to revise and distribute the work commercially. The University has no ownership rights.

Exemplar 5: Aaron decides it is time to take some of his focus from his law school studying and apply it to networking and job searching. Eager to stand out, he brainstorms ways to market himself as a law student. Business cards are a professional, efficient way to get his name out, but, as he thinks of other student's plain-jane cards, he becomes discouraged. While brainstorming, he doodles what he's been doodling since childhood: a blended translucent leaf/fierce eye. He finally gets the idea that that could be his mark. Aaron decides not only to put it on his business cards, but also to preserve the symbol with a trademark.

The student owns the intellectual property and has the right to revise and distribute the work commercially. The University has no ownership rights.

Exemplar 6: In the process of coming up with an idea for his Senior Project in Computer Science, Michael has decided to develop a software tool that would allow others to create on-line libraries/displays of multimedia material on a particular topic. He will be not only developing the tool for his Senior Project, but also using it himself to develop the first library display.

If Michael wishes to retain ownership of the product he develops, then he must submit an Intellectual Property Disclosure Form and request to maintain ownership. Based on this submittal, the IP Committee will make a recommendation to the Academic VP concerning ownership, and the Academic VP will make the final decision concerning ownership.

Appendix C

Intellectual Property Form Descriptions

1. Intellectual Property Disclosure Form

Purpose: To alert committee that there is potential for IP in a project.

Outcome: Initiates discussion at appropriate levels to determine ownership, royalty distribution, protection steps, etc.

2. Trademark License Agreement

Purpose: Establishes permission to use licensed trademarks belonging to STMU.

Outcome: Grants rights and conditions – Establishes fee if any.

3. Materials Transfer Agreement (MTA)

Purpose: Establishes parameters for using materials (cell lines, software, etc.)

Outcomes: Controls and protects distribution of materials shared openly among researchers.

4. Work-for-Hire /agreement

Purpose: Establishes deliverables / products, and the timelines, etc. when a project is contracted separately from or specifically by an employment agreement.

Outcome: Protects all contracting parties and establishes roles and responsibilities in project.

INTELLECTUAL PROPERTY DISCLOSURE FORM
Intellectual Property Policy Committee

The Intellectual Property (IP) Committee reviews all Notice of Potential for IP Development forms as they are received from members of the St. Mary's Community. The purpose of this form is to notify the IP Committee of your potential for an invention and any relevant sponsorship and publication history/potential. The form also serves to establish a legal record of the initial date of that notification and a means for determining ownership rights to the resulting IP. This form should be submitted to the IP committee at the earliest point in time when a member of the St. Mary's community anticipates the potential for the development of something new and useful, or when unusual, unexpected, or unobvious research results might be achieved in the course of their work. This form will be taken in front of the IP Committee and you will be notified when the decision has been completed.

Today's Date: _____ **Case No. (to be used by IP Committee only):** _____

Primary Point of Contact (St. Mary's Affiliation):

Name: _____ E-mail: _____ Phone #: _____

Project Title (may be tentative):

Start Date of Relevant Work:

Estimated Completion Date of Relevant Work:

Brief description of project purpose:

Brief description of potential intellectual property to be developed during this project:

Please list all funds to be used in support of this work (be sure to include federal, non-federal, foundation and industry funding, gifts, etc.)

Grant/Contract No. (Please note that accurate and complete grant/contract information is necessary):

This work is being performed as the result of (check one):

- Your normal duties/obligations as a faculty/staff member of the University course or graduation requirement
- Work-for-hire
- External funding/obligation

In the course of this work, do you anticipate significant use of University resources as described in Section 2.2 of the Intellectual Policy?

- Yes
- No

If Yes, what University funds or facilities might be used?

Categor(ies) of potential invention (circle all that apply):

Copyright Patent Trademark Tangible research property

What will be created?

How will the invention be used?

Do you anticipate any public disclosures of this work during the course of its development? If yes, please be as specific as you can with regard to your intentions/plans.

Do you anticipate any public disclosures of this work at completion of its development? If yes, please be as specific as you can with regard to your intentions/plans.

Please list ALL project team members (including faculty, staff, students, and non-StMU members) – place an astrict next to the primary point of contact:

NAME POSITION AFFILIATION E-MAIL EXT

Are you applying for a trademark?

Yes **No**

COMMITTEE ACTION

- Recommend do not assert University claim**
- Recommend do assert University claim and route to contractor for further review**
- Other:** _____

Signature _____ *Date:* _____

Trademark License Agreement
St. Mary's University

This Agreement is entered into this day of by and between St. Mary's University having its principal place of business at One Camino Santa Maria, San Antonio, Texas 78228, hereinafter referred to as ST. MARY'S, and _____, located at _____ hereinafter referred to as "Licensee."

WHEREAS, ST. MARY'S is the owner of certain designations comprising designs, trade names, trademarks, service marks, logographics, and/or symbols that have come to be associated with ST. MARY'S and have been developed and used in commerce by ST. MARY'S (hereafter collectively called the Licensed Marks);

WHEREAS, Licensee desires to use one or more of said Licensed Marks in connection with the production and marketing of various articles of merchandise; and

WHEREAS, ST. MARY'S is willing to permit Licensee to make such use of the Licensed Marks in such a manner as to preserve the integrity, character, and dignity of ST. MARY'S and to maintain the reputation of the Licensed Marks as designating high-quality merchandise:

NOW THEREFORE, the parties agree as follows:

I. Definitions

The terms set forth below shall have the following meanings when used herein:

- (1) "Licensed Marks" means the designs, trademarks, service marks, trade names, logos, symbols, and other devices associated with and owned by ST. MARY'S identified in Exhibit A hereto.
- (2) "Agreement" means this Agreement and any addenda or exhibits hereto.
- (3) "Licensed Articles" means the articles of merchandise or products using one or more Licensed Marks identified in Exhibit B hereto.
- (4) "Retail Sales" means the sale of Licensed Articles directly to the ultimate consumer at retail outlets (including University outlets) or through mail order or catalogs.
- (5) "Wholesale Sales" means the sale of Licensed Articles to anyone other than the ultimate consumer.
- (6) "Net Sales" means the gross wholesale invoice amounts billed customers, less quantity discounts actually allowed and taken by the customer, and any credits for returns actually made as supported by credit memos issued to customers. No costs incurred in the manufacturing, selling, advertising, or distribution of goods, or any indirect expenses, shall be deducted, nor shall any deduction be made for uncollectible accounts, cash discounts, or similar allowances.
- (7) "Premium" means any article given free or sold at less than the usual selling price for the purpose of increasing the sale of, or publicizing any other product or service, or for any other giveaway or promotional purposes.

II. Grant of License

- (1) Subject to the terms and conditions of this Agreement. ST. MARY'S hereby grants to Licensee a nonexclusive license to use the Licensed Marks on and in conjunction with the marketing, promotion, and sale of the Licensed Articles in the United States.
- (2) Licensee shall have no right to sublicense to others the use of Licensed Marks, nor shall any Marks be transferred, reassigned, or encumbered by Licensee.
- (3) No license is granted under this Agreement for the use of Licensed Marks in connection with Premium programs. Premium programs using Licensed Marks must have the prior written approval of ST. MARY'S.
- (4) All Licensed Marks used by Licensee shall be accompanied by the appropriate trademark or service mark notice.

III. Royalty Payments and Reports

- (1) Rate. Licensee agrees to pay to ST. MARY'S a royalty equal to six (6) percent of Net Sales of all Licensed Articles sold.
- (2) Initial Licensing Fee. **Licensee shall pay to ST. MARY'S an initial fee of \$200.00 at the time this Agreement is signed.** Reports and Records. Licensee shall provide quarterly reports to ST. MARY'S within thirty (30) days following the last day of the months of March, June, September, and December (calendar quarters) on all Licensed Articles manufactured, distributed, and sold. Licensee agrees to keep full and accurate records to show the basis for calculation of royalties, and such records, including sales invoices and Licensee's general accounting records, shall be open to inspection by ST. MARY'S's representative at reasonable times, and within normal business hours. Licensee will be responsible for the costs of this compliance review, if ST. MARY'S's accounting representative shows that Licensee's royalties are understated by more than ten (10) percent. Licensee agrees to retain such accounting records for a period of not less than four (4) years after the accounting pertaining to them is rendered to ST. MARY'S.
- (3) Royalty Payments. For purposes of determining the royalty payments, sales shall be deemed to have been consummated at the time of invoicing or billing for said Licensed Articles or at the time of delivery thereof, whichever is earlier. Payments shall be made quarterly within thirty (30) days from the end of each quarter, to ST. MARY'S.
- (4) Delinquent Payments. All royalty amounts not timely paid will be charged a rate of interest not to exceed one and one-half (1.5) percent per month thereof during which said amounts remain delinquent.

IV. Term

The initial term of this Agreement shall be for two years from the date of the Agreement, and the Agreement shall be renewed for additional two-year terms on December 31st, if mutually agreed in writing by both parties. If the Agreement expires or is terminated, all rights granted to the Licensee herein shall cease, except that Licensee may sell all products on-hand in inventory at the time of termination, provided that Licensee shall pay to ST. MARY'S the royalties and provide reports as required in Section III for said items. Termination can be effected by either party by giving the other not less than ten (10) days written notice and paying any amounts due up to the time of termination.

V. Product Quality and Approvals

ST. MARY'S reserves the right to approve or reject the quality and propriety of any items bearing the Licensed Marks. All such items are subject to approval by ST. MARY'S prior to their use or sale. Licensee agrees to maintain high standards of quality and handiwork as to the Licensed Articles and acknowledges that if the Licensed Articles manufactured and sold by it are of inferior quality in design, material, or handiwork, ST. MARY'S's substantial goodwill in the Licensed Marks will be irreparably impaired. The quality and propriety of items carrying the Licensed Marks must be approved by ST. MARY'S. Until said products are specifically approved by ST. MARY'S, Licensee shall not use the Licensed Marks on the products. Licensee shall, before it sells or distributes any Licensed Article, furnish to ST. MARY'S free of cost, for its approval, representative samples of any such Licensed Article together with representative samples of any new and related cartons, containers, packaging, or wrapping material. ST. MARY'S shall have two (2) weeks from receipt thereof in which to reject said sample and in the absence of rejection within said period, or upon earlier written acceptance, said sample shall be deemed accepted. The Licensed Marks may be applied by Licensee only to such licensed articles as are manufactured in accordance with this Agreement and which have substantially the same relative quality as do the samples thereof. Approval shall not be deemed endorsement by ST. MARY'S of the quality, usefulness, or safety of the product bearing the Licensed Mark. Any changes in the type, composition, or quality of the product must be approved by ST. MARY'S before Licensee can use the Licensed Marks on a product pursuant to this Agreement. Approval of additional products or subsequent changes in approved products of Licensee must again be obtained in writing from ST. MARY'S, and Licensee must furnish appropriate samples thereof.

VI. Indemnity

Licensee hereby agrees to indemnify, defend, and hold ST. MARY'S harmless—and any of its Board of Control members, officers, employees, and agents—for and from any and all claims, liabilities, judgments, costs, and expenses, including court costs and attorney's fees, arising out of any action by Licensee under this Agreement. Licensee shall obtain and maintain product liability insurance providing protection for ST. MARY'S and any of its Board of Control members, officers, agents, and employees in amounts of coverage specified below, against any claims, liabilities, judgments, costs, and expenses, including court costs and attorney's fees, arising out of any alleged defects in Licensee's products, or any use thereof. ST. MARY'S and its Board of Control members, officers, agents, and employees shall be named as an additional insured in said policy of insurance, which shall provide that it may not be canceled without at least thirty (30) days written notice to ST. MARY'S, which shall be furnished with a certificate of such insurance. Licensee agrees that such insurance policy or policies shall provide coverage of one million dollars (\$1,000,000) for personal injuries arising out of each occurrence and three hundred thousand dollars (\$300,000) for property damage arising out of each occurrence.

VII. Notices

A notice given by a party under this Agreement shall be deemed to be given when the same shall have been postmarked, provided that such is mailed Certified or Registered mail, Return Receipt Requested, and the postage is prepaid First Class to the party at the address listed below or to such other party or address as the party may have furnished in writing to the other for that purpose; otherwise notice shall be deemed given when received.

VIII. Termination of Agreement

This Agreement shall automatically terminate if Licensee becomes insolvent, makes an assignment for the benefit of any creditor, or becomes the subject of any bankruptcy or receivership proceedings.

IX. Integration

This Agreement constitutes the entire agreement between the parties, and no modifications or revisions hereof shall be of any force or effect unless the same are in writing and executed by both parties hereto. This Agreement shall be construed in accordance with the laws of the State of Texas.

IN WITNESS WHEREOF, the parties executed this Agreement on the date mentioned above.
Licensee St. Mary's University
Name _____ Title _____ Date _____

Materials transfer agreement

In response to the RECIPIENT's request for the MATERIAL [insert description] _____
_____ to be used for the purpose of _____

the PROVIDER asks that the RECIPIENT and the RECIPIENT SCIENTIST agree to the following before the RECIPIENT receives the MATERIAL:

1. The above MATERIAL is the property of the PROVIDER and is made available as a service to the research community. 2. THIS MATERIAL IS NOT FOR USE IN HUMAN SUBJECTS. 3. The MATERIAL will be used for teaching or not-for-profit research purposes only. 4. The MATERIAL will not be further distributed to others without the PROVIDER's written consent. The RECIPIENT shall refer any request for the MATERIAL to the PROVIDER. To the extent supplies are available, the PROVIDER or the PROVIDER SCIENTIST agree to make the MATERIAL available, under a separate Simple Letter Agreement to other scientists for teaching or not-for-profit research purposes only.

5. The RECIPIENT agrees to acknowledge the source of the MATERIAL in any publications reporting use of it.

6. Any MATERIAL delivered pursuant to this Agreement is understood to be experimental in nature and may have hazardous properties. THE PROVIDER MAKES NO REPRESENTATIONS AND EXTENDS NO WARRANTIES OF ANY KIND, EITHER EXPRESSED OR IMPLIED. THERE ARE NO EXPRESS OR IMPLIED WARRANTIES OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE, OR THAT THE USE OF THE MATERIAL WILL NOT INFRINGE ANY PATENT, COPYRIGHT, TRADEMARK, OR OTHER PROPRIETARY RIGHTS. Unless prohibited by law, Recipient assumes all liability for claims for damages against it by third parties which may arise from the use, storage or disposal of the Material except that, to the extent permitted by law, the Provider shall be liable to the Recipient when the damage is caused by the gross negligence or willful misconduct of the Provider.

7. The RECIPIENT agrees to use the MATERIAL in compliance with all applicable statutes and regulations. 8. The MATERIAL is provided at no cost, or with an optional transmittal fee solely to reimburse the PROVIDER for its preparation and distribution costs. If a fee is requested, the amount will be indicated here: [insert fee] _____

The PROVIDER, RECIPIENT and RECIPIENT SCIENTIST must sign both copies of this letter and return one signed copy to the PROVIDER. The PROVIDER will then send the MATERIAL.

PROVIDER INFORMATION and AUTHORIZED SIGNATURE

Provider Scientist: _____ Provider

Organization: _____

Address: _____ Name of Authorized

Official: _____ Title of Authorized

Official: _____

Certification of Authorized Official: This Simple Letter Agreement __has / __has not [check one] been modified. If modified, the modifications are attached.

_____ Signature of Provider's Authorized Official

Date

RECIPIENT INFORMATION and AUTHORIZED SIGNATURE

Recipient Scientist: _____ Recipient

Organization: _____

Address: _____ Name of Authorized

Official: _____ Title of Authorized

Official: _____ Signature of Authorized

Official: _____ Date: _____

Certification of Recipient Scientist: I have read and understood the conditions outlined in this Agreement and I agree to abide by them in the receipt and use of the MATERIAL.

_____ Recipient Scientist Date

WORK MADE FOR HIRE AGREEMENT

[Note: Words contained in brackets indicate that you must choose among the alternatives listed, insert appropriate language, replace the given variable with another or, if the bracketed material is a note to you, like this one, remove the material. Be sure you have addressed all bracketed issues and removed all brackets before signing your agreement.]

Educational Course Materials

This Agreement made the [date] day of [month], 20[year], by and between [name of author] ("Author," and if there is more than one author, then all of them collectively) and St. Mary's University ("University").

THE AUTHOR AND THE UNIVERSITY AGREE THAT:

1. Title and Copyright Assignment

(a) Author and University intend this to be a contract for services and each considers the products and results of the services to be rendered by Author hereunder (the "Work") to be a work made for hire. Author acknowledges and agrees that the Work (and all rights therein, including, without limitation, copyright) belongs to and shall be the sole and exclusive property of University.

(b) If for any reason the Work would not be considered a work made for hire under applicable law, Author does hereby sell, assign, and transfer to University, its successors and assigns, the entire right, title and interest in and to the copyright in the Work and any registrations and copyright applications relating thereto and any renewals and extensions thereof, and in and to all works based upon, derived from, or incorporating the Work, and in and to all income, royalties, damages, claims and payments now or hereafter due or payable with respect thereto, and in and to all causes of action, either in law or in equity for past, present, or future infringement based on the copyrights, and in and to all rights corresponding to the foregoing throughout the world.

(c) If the Work is one to which the provisions of 17 U.S.C. 106A apply, the Author hereby waives and appoints University to assert on the Author's behalf the Author's moral rights or any equivalent rights regarding the form or extent of any alteration to the Work (including, without limitation, removal or destruction) or the making of any derivative works based on the Work, including, without limitation, photographs, drawings or other visual reproductions of the Work, in any medium, for university purposes.

(d) Author agrees to execute all papers and to perform such other proper acts as University may deem necessary to secure for University or its designee the rights herein assigned.

2. Delivery of the Work

(a) The Author will deliver to the University on or before [date] the completed Work (with all illustrations, charts, graphs, and other material, including syllabi, handouts, reference lists, etc., in the medium mutually agreed upon for the Work) in form and content satisfactory to the University.

(b) If the Author fails to deliver the Work on time, the University will have the right to terminate this agreement and to recover from the Author any sums advanced in connection with the Work. Upon such termination, the Author may not have the Work published elsewhere until such advances have been repaid.

3. Quoted Material

With the exception of short excerpts from others' works, which constitute fair use, the Work will contain no material from other copyrighted works without a written consent of the copyright holder. The Author will obtain such consents at his or her own expense after consultation with the University and will file them with the University at the time the Work is delivered. Any obligations associated with permissions will be the responsibility of the Author.

4. Author's Warranty

The Author warrants that he or she is the sole owner of the Work and has full power and authority to make this agreement; that the Work does not infringe any copyright, violate any property rights, or contain any scandalous, libelous, or unlawful matter. The Author will defend, indemnify, and hold harmless the University and/or its licensees against all claims, suits, costs, damages, and expenses that the University and/or its licensees may sustain by reason of any scandalous, libelous, or unlawful matter contained or alleged to be contained in the Work or any infringement or violation by the Work of any copyright or property right; and until such claim or suit has been settled or withdrawn, the University may withhold any sums due the Author under this agreement.

5. Consideration

In consideration for delivery of the Work in accordance with the provisions of this Agreement, University shall pay Author [amount].

6. Revisions

[Choose one paragraph.]

The Author shall retain the right to revise the Work [at one year intervals] during the term of this agreement in accordance with academic standards. The Author further agrees to update the Work within ninety (90) days upon the receipt of a written request from the University. The provisions of this agreement shall apply to each revision of the Work by the Author as though that revision were the Work being published for the first time under this agreement. In the event that the Author is unable or unwilling to provide a revision within ninety (90) days after the University has requested it, or should the Author be deceased, the University may have the revision made and charge the cost against sums due the Author under Section 5 above, if any, and may display, in the revised Work and in advertising, the name of the person or persons who perform the revision.

or

This paragraph has been deleted because the Author's contribution is not a work expressing academic expertise requiring periodic review and revision.

7. Term and Termination

(a) This agreement shall remain in effect for [three (3)] years unless terminated earlier in accordance with this Section 7.

(b) In the event that either party shall be in default of its material obligations under this agreement and shall fail to remedy such default within sixty (60) days after receipt of written notice thereof, this agreement shall terminate upon expiration of the sixty (60) day period.

(c) Upon the expiration of the term of this agreement, the parties may agree to renew this agreement for an additional [three (3)] year term, upon the same terms and conditions as set forth herein.

8. Options/Contracts with Third Parties

Nothing contained in Section 7 shall affect any license or other grant of rights, options, or agreements made with third parties prior to the termination date or the rights of the University in the income resulting from such agreements.

9. Amendments

The written provisions contained in this agreement constitute the sole and entire agreement made between the Author and the University concerning this Work, and any amendments to this agreement shall not be valid unless made in writing and signed by both parties.

10. Construction, Binding Effect, and Assignment

This agreement shall be construed and interpreted according to the laws of the State of Texas and shall be binding upon the parties hereto, their heirs, successors, assigns, and personal representatives; and references to the Author and to the University shall include their heirs, successors, assigns, and personal representatives.

IN WITNESS WHEREOF, the parties have duly executed this agreement as of the date first written above.

Author:

St. Mary's University

Address:

By Authorized Officer :