

	MOREHOUSE SCHOOL OF MEDICINE	POLICY NUMBER	
	INTELLECUTUAL PROPERTY	EFFECTIVE DATE	16 December 2010
	POLICIES AND PROCEDURES	PAGE (S)	9
	SUBJECT COPYRIGHTS & ROYALTIES	SUPERSEDES	

## I. **PURPOSE**

To set policy regarding copyrights and royalties for all copyrightable material created by Morehouse School of Medicine (MSM).

## II. **STATEMENT OF PRINCIPLES**

Morehouse School of Medicine (the "School" or "MSM") encourages the dissemination of knowledge and development of creative work that fulfills its educational, research, and service missions and benefits the public it serves. The School supports the preparation and publication of copyrightable works resulting from the teaching, research, scholarly, and artistic endeavors of faculty, staff, and students as part of their unique roles at the School. The School seeks to foster an intellectually stimulating environment in which creative efforts and innovations are encouraged and rewarded, the careers of its members are enhanced, and the School's reputation and prestige are furthered. The School respects, acknowledges, and promotes the intellectual property rights in works created by its members, where applicable. The School strives to maintain a balance among the interests of Creators, sponsoring bodies, and the School in copyrightable material and income resulting from such works.

All MSM personnel are encouraged to retain ownership of the copyright to Traditional Works of Scholarship (as defined herein) or to obtain a perpetual license from the copyright owner to reproduce, distribute, perform, and/or display the work and to make Derivatives Works therefrom.

Scientific publications, including original articles, review of articles, and books, for which copyright is normally transferred to the publisher and for which no revenue is obtained, are exempt from all reporting requirements of this document. In addition, works that generate less than \$1,000 in revenue are also exempt from reporting requirements of this document unless otherwise required under the terms and conditions of an applicable grant, contract, or other arrangement with a third party, such as the federal government, a foundation, or corporate research sponsor.

## III. **ACCOUNTABILITY**

Under the direction of the President, the Dean and Senior Vice President for Academic Affairs, and the Senior Vice President and Chief Operating Officer shall ensure compliance with this Policy. The Senior Associate Dean for Research Affairs shall implement this Policy. The Senior Associate Dean for Research Affairs shall ensure that each new faculty member receives a copy of this Policy or is directed to it on the MSM web site. [www.msm.edu](http://www.msm.edu). Creators (as defined below) shall take all steps necessary to make this Policy effective, including executing

all necessary or desirable agreements, applications, assignments, or other documents if requested or required by the School. A failure by a Creator to execute such a document shall not in any way affect the applicability of this Policy.

#### **IV. APPLICABILITY**

This Policy applies to all faculty, staff, postdoctoral fellows, residents, students, and any other person employed by the School.

#### **V. DEFINITIONS**

1. The following terms are defined as set forth below with respect to the School's policy on Intellectual Property: Copyrights and Royalties (the "Policy").
  - a. **"Annual Net Income"**: The Income received by the MSM in each fiscal year from the licensing or other utilization of any Copyrightable Material owned in whole or in part by it after deduction of all unreimbursed costs reasonably attributable to protecting the Copyrightable Material and making it available to the public. These deductions shall include any expense of patent prosecution and interference, copyright registration, litigation, marketing, licensing, acquisition of related rights or permissions needed to license or utilize the Copyrightable Material, and the like incurred prior to the end of such fiscal year.
  - b. **"Creator"**: Individual or group of individuals as referenced above in Article IV who transform ideas into a tangible form of expression thereby creating Copyrightable Material.
  - c. **"Copyrightable Material"**: Material that is subject to U.S. copyright laws, including, but not limited to, literary works, musical works, dramatic works, choreographic works, graphic works, Software, photographic works, cardiographic, radiographic and pictorial works (e.g., - x-rays, images), sculptural works, audiovisual and videotaped works, sound recordings, films, theses, and works in electronic media (e.g., digitized works and network transmission of digitized works, multimedia broadcast, web-based products, recorded materials, remote transmission of information, instructional software, CD/DVD-ROMs). Copyrightable Material includes, but is not limited to, Derivative Works, Instructional Materials, Institutional Works, and Traditional Works of Scholarship, each as defined hereunder.
  - d. **"Derivative Works"**: Copyrightable Material based on or derived from one or more already existing copyrighted works. Derivative Works include, but are not limited to, new versions, translations, dramatizations, fictionalizations, reproductions, compilations, revisions, and condensations.
  - e. **"Equity"**: Stock, stock options, or a contractual or other right to acquire stock or options or interests as an owner, proprietor, partner, or beneficiary, or a beneficial interest in any of the foregoing.
  - f. **"Income"**: From the licensing or other utilization of Copyrightable Material, income means sale proceeds, license fees, royalties, and other such revenues attributable to the use or sale of the property, but does not include revenues explicitly earmarked in

the license or distribution agreement to reimburse patent, development or other costs incurred by MSM, to fund future research or other activity, or to compensate the MSM for providing training or other benefits other than the property or property rights themselves.

- g. **“Instructional Materials”**: A type of “Institutional Work,” including textbooks study guides and electronic media (CDs, DVDs, computer software) used for the instruction of MSM students, residents, and/or postdoctoral fellows.
- h. **“Institutional Resources”**: Tangible resources provided by MSM to a Creator, including funds, office space, lab space, equipment, electronic network resources (hardware and software), support personnel, secretarial support, research, teaching and lab assistants, assistance from medical and graduate students or residents, media specialists or illustrators, supplies, and utilities. Funds include grants and contracts or awards made to MSM by an extramural sponsor.
- i. **“Institutional Works”**: Copyrightable Material created (1) specifically or predominantly for use by or at MSM, or (2) at the request or on behalf of MSM, or (3) under the specific direction of MSM, or (4) by a person acting within the scope of his or her employment at MSM, or (5) under a written contract between the Creator and MSM, or (6) under a contract between MSM and an external agency. “Traditional Works of Scholarship” will not be considered “Institutional Works” for purposes of this Policy.
- j. **“Intellectual Property”**: Includes, but is not limited to, Inventions (whether patentable or not) patents, patent applications, Copyrightable Materials, Trademarks, service marks, domain names, Trade Secrets, trade dress rights, formulas, designs, Software, programming code, New Media, intangible rights in machines, compositions of matter and devices, techniques, processes, procedures, systems, or formulations.
- k. **“Invention”**: Any discovery of a subject matter that is humanly made, whether patentable or not, including any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereon. Examples of Inventions include but are not limited to new and improved devices, systems, circuits, and compounds; novel biological materials such as proteins, genes, DNA constructs, cell lines and transgenic animals, diagnostics, immunoassays, and therapeutics; new uses of known articles or substances; new methods of producing or manufacturing any articles or substances; algorithms; Software; and any other Tangible Research Property.
- l. **“New Media”**: Means digital or electronic media, including but not limited to software, video/audio tapes, CD-ROM, DVD-ROM, Internet-based media, and other multimedia materials that are used for the purpose of education or the dissemination of knowledge, but does not include technology that may be embodied in the New Media.
- m. **“Software”**: All computer-readable, computer-based, or computer-related materials as determined in the broadest sense, including but not limited to computer programs, user’s manuals and other accompanying explanatory materials or documentation, mask works, firmware and computerized databases. “Software” includes, for example, micro code, subroutines, operating systems, high-level languages, and application programs in whatever form expressed (e.g., machine or assembly language, source or object code) or embodied (e.g., chip architecture, ROM, disk or tape storage, program

listing). While some materials defined here as Software may not be covered by United States copyright laws (mask works, for example, are protected separately under the Semi-Conductor Chip Protection Act), any and all Software is treated as Copyrightable Material for purposes of this Policy; in many cases, however, Software will constitute or embody Inventions as well as Copyrightable Materials and shall be subject to this Policy as well MSM's Patent Policy. The Intellectual Policy Committee shall have the sole authority to clarify, modify, or define this term at its discretion from time to time.

- n. **"Sponsored Activity"**: Copyrightable Material or other Intellectual Property that is subject to any grant, contract, or other arrangement with a third party, such as the federal government, a foundation, or corporate research sponsor.
- o. **"Tangible Research Property"**: Biological materials, Software, and any other tangible results of research conducted at MSM.
- p. **"Trademark"**: means any word, phrase, logo, design, or other symbol used to identify and distinguish the source of goods or services. As used here, the term includes any trademark, service mark, trade name, or trade dress.
- q. **"Trade Secret"**: means any scientific or technical information, know-how, design, process, formula, listing, or other information of MSM that is kept reasonably confidential and that has economic value. A Trade Secret may, but need not, be patentable or copyrightable.
- r. **"Traditional Works of Scholarship"**: Copyrightable Material reflecting research and/or creativity that is considered evidence of accomplishment in the Creator's academic discipline or professional field, and is specifically created by the Creator in the course of customary research and educational activities; is prepared at the Creator's own initiative and not at the request or under the auspices of MSM, for MSM purposes, or through substantial use of Institutional Resources; and is not owned by or obligated to a third party through any MSM arrangement. The Creator's mere receipt of salary support, or use of office space or word processors provided by MSM, shall not be considered substantial use of Institutional Resources for purposes of this definition.
- s. **"Work Made for Hire"** has the meaning given in the Copyright Act of the United States: a Copyrightable Material that is (i) prepared by an employee within the scope of his or her employment, or (ii) specially ordered or commissioned for use as a contribution to a collective work, a part of an audiovisual work, a translation, a supplementary work, a compilation, an instructional text, a test or answer material for a test, or an atlas. In the case of (ii) but not (i) if MSM and the Creator expressly agree in writing that the Copyrightable Material shall be deemed as a Work Made for Hire.

## VI. POLICY

### 1. Copyright Ownership

- a. The terms of a Sponsored Activity or other agreement may determine the ownership of all Copyrightable Material that a person creates in the course of or pursuant to such an

agreement. If the agreement does not contain terms relating to the ownership of Copyrightable Material, or if the Copyrightable Material is not a Sponsored Activity, the following provisions of this policy will govern ownership of the material.

- b. MSM shall own all Copyrightable Material in the following categories (which may overlap) and all rights in the copyright of such Copyrightable Materials (the "Supported Works"):
  - (1) Copyrightable Material which a person creates as Work Made for Hire;
  - (2) Copyrightable Material created through substantial use of Institutional Resources; and
  - (3) Copyrightable Material otherwise created in the scope of the Creator's employment with MSM or otherwise constituting Institutional Works. By way of example, such Copyrightable Material may include training or policy materials prepared by staff, handbooks created by staff at the request of MSM, or Software created by Staff in the course of their staff duties or by individuals who are employed by MSM as programmers.
- c. MSM shall own all "Related Software," defined as Software created by the Creator that is not a Sponsored Activity or a Supported Work but that arises out of or relates to the clinical, research, educational, or other activities of the Creator at MSM. Exception: In circumstances deemed appropriate by the Intellectual Property Committee, MSM will waive its claim to any Related Software that is created in the performance of consulting services under a consulting agreement approved by the President, or is in the conduct of any other independent enterprise proposed in advance by the Creator and approved by the Intellectual Property Committee as appropriate for such a waiver.
- d. Any disputes regarding ownership of Copyrightable Material shall be submitted to the Intellectual Property Committee, which, after investigation into the appropriate facts, shall formulate a recommendation for consideration by the President, who will make the final determination in consultation with the MSM Office of General Counsel and Dean.
- e. To the extent that any Supported Work or Related Software constitutes Work Made For Hire, MSM shall own such Copyrightable Material as the author, in accordance with United States copyright law. To the extent that any Supported Work or Related Software does not constitute a Work Made for Hire, MSM shall own such Copyrightable Material by assignment from the Creator.
- f. The Creator of all other Copyrightable Material that does not comprise Supported Activity, Supported Work, or Related Software (e.g., Traditional Works of Scholarship) shall own such material notwithstanding any employment relationship with the School. Creators will own all works they create of an artistic nature, such as music, graphic art, poetry, fiction, or popular nonfiction, except in rare instances where those works comprise Sponsored Activity, Supported Works, or Related Software.

## 2. Marking and Disclosure

- a. Copyrightable Material shall be marked at the earliest possible opportunity with the copyright symbol "©" or the word "copyright" or the abbreviation "**Copr.**" the year of the first production or publication, and the name of the owner of the copyright in the work. Individuals are encouraged to consult with the MSM Office of General Counsel for more information on copyright protection.
- b. The Creator shall promptly complete and file an Intellectual Property Disclosure Form (Exhibit A) with the Office of Sponsored Research Administration ("OSRA") for any Copyrightable Material that comprises Supported Activity, Supported Work, or Related Software, unless otherwise expressly exempt from such reporting obligation under Article II above. In the case of Copyrightable Material that a Creator believes does not comprise Supported Activity, Supported Work, or Related Software, if the Creator wishes to make or permit use of such Copyrightable Material for commercial purposes or private gain, he or she must first disclose the Copyrightable Material in accordance with this Section 2, b unless otherwise expressly exempt from such reporting obligation under Article II above.
- c. MSM, in its discretion, may release its ownership rights in the Copyrightable Material to the Creator when, as determined by the Intellectual Property Committee and MSM Office of General Counsel: (i) there are no overriding special obligations to a sponsor or other third party, and/or (ii) the best interests of the School would be so served. The School shall make this decision within 30 days of receipt of the completed Intellectual Property Disclosure Form.
- d. If the Intellectual Property Committee denies the Creator's request that the School's ownership rights in the Copyrightable Material be released to the Creator, the Creator may appeal this decision to the Senior Associate Dean for Research Affairs, who will make the final determination in consultation with the MSM Office of General Counsel.
- e. The Office of Sponsored Research Administration shall file an application to register the School's copyright interest in the disclosed Copyrightable Material when copyright ownership remains with the School, and the Creator shall be notified thereof in writing.
- f. MSM will retain a nonexclusive, royalty free, non-transferable license for research, clinical, and education purposes in any Copyrightable Material in which it has released its ownership rights to the Creator in accordance with Section 2, c of this Article VI, unless the parties agree otherwise.

## 3. Use of Copyrightable Materials. With respect to Copyrightable Material owned by MSM under this Policy:

- a. MSM, through the Office of Sponsored Research Administration, shall have the right to determine the licensing, marketing, and use of material for which the MSM shall have copyright ownership. This determination shall take into consideration the interests of MSM, the public, and the Creator, as well as the Creator's expressed preferences.

- b. The Creator shall have the right to be identified or to refuse to be identified as the Creator by MSM and by subsequent licensees and assignees, except as required by law.

#### **4. Privacy and Related Rights of Others**

Creators of Copyrightable Materials must seek appropriate permissions before making any use of the name, likeness, or other identifying information of a patient or other individual. Such use may be subject to the individual's rights of privacy or publicity and other legal restrictions unrelated to Intellectual Property. In the case of patients, MSM policy requires obtaining prior authorization in writing.

#### **5. MSM Names and Trademarks**

Individuals shall obtain approval from the Intellectual Property Committee before seeking publication of any Copyrightable Material, whether or not owned by MSM, that displays MSM's name or any other name or logo used to identify MSM, or that uses such a name or logo in any advertising, promotional, or sales material in any medium, except where such name is used solely to identify the individual's association with MSM.

MSM's name, logo, or other identifying symbol shall not be used as a Trademark or to imply any endorsement, without MSM's prior written permission. Trademarks shall be owned by MSM if they are created by individuals in the course of their employment or other appointment with MSM or if they are used to identify any product or service originating with or associated with MSM.

#### **6. Trade Secrets**

As a nonprofit corporation, MSM is in general dedicated to open disclosure and discussion of information. However, MSM keeps confidential certain information, including, but not limited to, patient data, business information, and Software. To the extent any such confidential information relating to any activity conducted at or supported by MSM constitutes a Trade Secret, the Trade Secret shall be owned by MSM. If requested by MSM, individuals shall take appropriate steps to keep such Trade Secrets confidential.

#### **7. Other Intellectual Property**

Any Intellectual Property not specifically covered by the foregoing sections of this Policy shall (as between MSM and Creator) be owned by MSM if it is created in the performance of Sponsored Activity at MSF or through use of Institutional Resources.

#### **8. Royalties and Revenue Distribution**

- a. MSM may choose to use Copyrightable Material owned by it for internal purposes only. If, however, it appears that a Copyrightable Material owned by MSM should

be commercialized, the Senior Associate Dean for Research Affairs will consult with the Creator who disclosed it and the Intellectual Property Committee, and will determine the appropriate action, which may include promoting and licensing the Copyrightable Material to make it available to the public. MSM shall provide such professional services as it deems necessary or desirable to protect the copyright and other proprietary rights in the Copyrightable Material, which may be limited to reliance on unregistered copyright protection.

- b. Unless the Intellectual Property Committee recommends, and the President and Associate Dean of Research Affairs adopt, a different distribution warranted by the circumstances, and subject to any written agreement to the contrary between MSM and the Creator, Annual Net Income derived from the Copyrightable Material shall be distributed as follows:

(1) Formula for Distribution of Income –

- (a) 60% of the net patent income and/or milestones to the Inventor(s); and

- (b) 40% of the net patent income and/or milestone to the Institution.

The Institution's distribution shall be divided:

- i. 50% to the Office of the Dean; which shall be distributed at the discretion of the Dean to support the research infrastructure; and
- ii. 50% to the Research Development to help defray the cost of administrating Intellectual Property related activities (i.e., provisional patents, full patents, legal services, marketing, etc.).

- c. Income from Other Research Results, Trademarks, Trade Secrets, and Other Intellectual Property. Income from the use of the name MSM shall belong to MSM and shall not be distributed to individuals. Otherwise, in the case of Trademarks, Trade Secrets, or other research results or Intellectual Property that are not covered by Section 8, b of this Article VI, any Annual Net Income received by MSM shall belong to MSM and shall be distributed or not distributed as determined by the Intellectual Property Committee.

- d. Determination of Shares among Multiple Creators. If the Intellectual Property Committee determines that more than one Creator was involved in the creation of a Copyrightable Material, the Creator's share of Income shall be divided among the multiple Creators as determined by the Senior Associate Dean for Research Affairs. If requested by any Creator, the determination of the Senior Associate Dean for Research Affairs will be reviewed by the Intellectual Property Committee.

- e. Departure from MSM. Should any or all of the Creators leave MSM, the allocation and payment of Income shall remain the same as if the Creators were still at MSM, unless otherwise approved by the Intellectual Property Committee. In the event of the death of an individual entitled to receive a share of Income, his or her share shall inure to his or her estate.

## **9. Exceptions to Income Distribution Rules**

- a. Grant-Related Conditions. Income generated under grants from federal agencies and some other sources may be subject to conditions in the grant or grant-related regulations, which must be complied with before any Income can be distributed.

For example, in some cases license income produced under a grant must be applied against the amount of the grant. Creators are encouraged to consult with the Office of Research and Development (“ORD”) to be sure they are aware of any applicable conditions.

- b. Anticipated Expenses. If MSM anticipates incurring unreimbursable expenses in connection with any Intellectual Property (such applicable costs to be determined by the Intellectual Property Committee and may include costs of patent prosecution or litigation, or other expenses of a type that are deductible from Income under the definition of Annual Net Income), it may hold in reserve all or a portion of any Income derived from such Intellectual Property to the extent deemed necessary by the Intellectual Property Committee to cover such anticipated expenses. In such a case, the relevant Creator will be notified of the amount being held in reserve and the reasons for holding it in such manner.
- c. Waivers. Any Creator or other party entitled to receive any share of income under this Policy may waive that share with the approval of the Senior Associate Dean for Research Affairs or the Intellectual Property Committee or in accordance with guidelines established by the Intellectual Property Committee.

By Direction of the President: \_\_\_\_\_  
Dean and Senior Vice President for Academic Affairs Date

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Office of General Counsel Date