



POLICY & PROCEDURE DOCUMENT

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DIVISION: Research

TITLE: Policy on Intellectual Property

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I. PURPOSE AND SCOPE

The policies set forth herein constitute an understanding which is binding on Western Kentucky University (WKU) faculty, staff, and students as a condition of their participation in WKU research, teaching, and service programs and for their use of WKU funds, facilities, or other resources.

A. PURPOSE

1. to make clear the university's values with regard to intellectual property;
2. to encourage research, scholarship, creative activity and the creation of new knowledge;
3. to facilitate the dissemination of knowledge and technology for the benefit of the University community, regional business and industry, and society;
4. to provide an administrative system to assist faculty and staff members in bringing new discoveries and developments into public use;
5. to provide an administrative system to evaluate, where appropriate, the commercial significance of new discoveries and developments;

6. to provide for the equitable disposition of interests in shared intellectual property among the author, creator, developer, the university and, where applicable, the external sponsor;
7. to provide incentives to creators in various forms, including professional development, recognition, and financial compensation; and
8. to safeguard intellectual property, so that it may receive adequate and appropriate legal protection against unauthorized use.

B. SCOPE

1. This policy covers all intellectual property conceived, first reduced to practice, written, or otherwise produced by faculty, staff, or students of WKU using WKU funds, facilities, or other resources.

C. DEFINITIONS

Intellectual property, for the purpose of this policy, is defined as the tangible or intangible results of scholarship, research, development, teaching, or other intellectual activity. Intellectual property may include but is not limited to the following (non-exclusive) categories:

1. Inventions, discoveries, or other new developments that are appropriate subjects of patent applications;
2. Written materials; exhibits; sound, video, and other media productions; computer programs and software (including mobile apps); computer-based instructional materials; works of art including paintings, sculptures, and musical compositions; and all other material that may be copyrightable;
3. Tangible research materials including biological, chemical, physical, and technological products; as well as analytical procedures and laboratory methods. These may or may not be patentable or copyrightable.

II POLICY

1. By law, all rights to intellectual properties, except those exempted hereafter, shall be owned and controlled by WKU. When a WKU faculty member, staff member, or student creates an item of intellectual property that, under the terms of this policy may be owned and controlled by WKU, the creator shall report the intellectual property to the President of the Western Kentucky University Research Foundation (WKURF) who is charged with the responsibility for Intellectual Property, Technology Transfer, and Commercialization, by completing an Intellectual Property Disclosure and Assignment Form.

2. The creator shall also: cooperate in the execution of legal documents and in the review of literature and prior art (e.g., patent searches); be given the opportunity to assist in the further commercial development of the intellectual property and have an interest in and share in any income derived from the commercialization of such property.
3. Traditional products of scholarly activity that have customarily been considered to be the unrestricted property of the author or creator are exempted from this general policy. Such traditional products include books, monographs, articles, reviews, and works of art (including paintings, sculptures, plays, choreography, musical compositions, film and video); and individual course materials such as syllabuses, exams, transparencies, study guides, workbooks, and manuals. Also included are instructional software, webpages, and internet-based instructional materials developed by faculty members in the course of their usual scholarly, pedagogical, and service activities. The latter include projects undertaken during sabbatical leaves, faculty fellowships, and other special assignment periods intended for such activities. WKU will not claim ownership rights to such traditional works, and it specifically disclaims any potential rights to do so under the “work made for hire” provisions of the U.S. Copyright Act, unless there is a predetermined written agreement.

WKU encourages student innovation, creativity, and entrepreneurship, and students have opportunities to make original creations, inventions, and discoveries as part of their activities both within and outside of classes. Students shall own any intellectual property that they make, discover, or create as part of a course, as long as the resources used were part of the course and were available to all students in the course; and the course or project was not sponsored by a corporation, grant, or contract. To the extent permitted by this Policy, students shall own any intellectual property that they make, discover, or create unless:

- a. The student performed research while receiving financial support from the University in the form of wages, salary, stipend, or grant funds.
- b. The student made use of university resources (including university administered funds, facilities, or equipment) in connection with the research. In this context, the term “university resources” does not include resources such as a computer lab, a commonly available 3D printer, or other resources commonly available in a WKU Makerspace, the Center for Entrepreneurship and Innovation, or Student Business Accelerator. It does cover other unique WKU resources without which the invention could not have been made or tested.
- c. The research was funded by a sponsor pursuant to a grant, contract or sponsored research agreement or is subject to a Material Transfer Agreement, Confidentiality Disclosure Agreement, or other legal obligation

that restricts ownership of Intellectual Property.

4. Works produced in certain WKU support units (non-academic departments) whose mission includes the production of works for instructional, public service, or administrative use, and which employ designated staff or faculty for the purpose of producing such works (e.g., Career Services, Sponsored Programs, Recruitment & Admissions, Alumni Relations), are deemed to be works made for hire and, therefore, the property of WKU. Such works may include brochures, films, videotapes, web-based courses, recordings, displays, drawings, slides, models, computer programs, and the like. WKU shall own and control all such works produced in such units for such purposes. Income from the use of such works shall be subject to WKU resource management and budgeting policy.
 - a. The U.S. Copyright Act defines a "work made for hire" as: (1) a work prepared by an employee within the scope of his or her employment; or (2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.
 - b. For the purpose of the foregoing sentence, a "supplementary work" is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes; and an "instructional text" is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.
5. The utilization of WKU support units to prepare instructional materials does not automatically transform such materials into work made for hire or deprive faculty of ownership rights. Rather, it generally continues the university's traditional role of facilitating the faculty member's usual teaching activities and thus may fall under the exemption in II 3. Exceptional cases and interpretative disagreements will be brought to the Intellectual Property Committee (IPC; see Section III.A.2) for adjudication. Disposition shall be made by the IPC or its designee(s) according to the following factors: the initiation of the creative effort, control over the work's content and form of expression, and the amount of extraordinary or non-usual support afforded by the university. Creators should consult with their immediate administrative superiors and the WKURF to determine whether an official disclosure of such materials is required. The WKU support unit should discuss with the creator the ownership, use, and disposition of all materials prior to their creation.

6. Arrangements for expertise or talent from other units, or from outside WKU, may be utilized to create, further develop, produce or commercialize the creation. Compensation for these arrangements may include a fixed fee payment or payments based on sales or usage of such works, to be negotiated by WKU, the creator and the party providing the additional expertise or talent. Such payments are considered to be a part of the costs of production. Commercialization of such works outside WKU must be through assignment to WKU, which shall be responsible for the commercial development.
7. WKU shall own and control the rights to intellectual property resulting from sponsored projects. In some instances, the provision of additional or unusual funding, background information, product samples, or confidential proprietary data by a sponsor may create a situation in which the sponsor may claim ownership of intellectual property that might result from the sponsored project. In such cases, final disposition of the property may be negotiated as a part of the sponsored project agreement.
8. In those cases where the final disposition of the property has not been negotiated as part of a sponsored project agreement, WKU will proceed as described under Commercialization (III B).

III PROCEDURE

A. GENERAL

1. The legal interests of WKU and its faculty members, staff members, and students in any intellectual property, except traditional products of scholarly activity (as noted in II.3 and II.4) shall be determined in accord with this policy by the President of WKURF, with advice from the Intellectual Property Committee (IPC) and WKU General Counsel (or designee) as needed.
2. The IPC shall be a sub-committee of the WKURF Board of Directors. The IPC will have at least three members with at least one Board member who is a WKU employee and one Board member who is not a WKU employee. The third member may or may not be a Board member. Additional expertise may be sought by the IPC or President of WKURF as needed in the consideration of a particular intellectual property matter. The IPC shall be advisory to the President of WKURF, who serves in an *ex officio* capacity on the IPC.
3. All intellectual property except traditional products of scholarly activity (as noted in II.3-II.4) shall be disclosed by the creator(s) to the WKURF prior to public disclosure via an Intellectual Property Disclosure and Assignment form.
 - a. If the President of WKURF, after consultation with the EVP-SOF, Provost, and WKU General Counsel (or designees) determines that the intellectual property under consideration is exempted, the property shall be released to

- the creator and WKU shall not claim the property.
- b. The President of WKURF, in consultation with the EVP-SOF, Provost, and WKU General Counsel (or designees) may determine that WKU has a legal interest in the property but that the chances of successful commercialization are minimal or that the costs of pursuing such commercialization outweigh the income potential. In such cases the President of WKURF may, in writing, release the property to the creator as above, with copies to the EVP-SOF, Provost, and WKU General Counsel.
 - c. If the President of WKURF finds that WKU has an ownership right in the creation but that the creation has not been developed to the point where a decision as to patentability or commercialization is possible then. The President of WKURF will work with the creator to establish alternative ways of further development.
 - d. If the President of WKURF determines that WKU has a legal interest in the property and judges that there is a reasonable chance for successful commercialization, then:
 - i. the President of WKURF shall inform the creator in writing that WKU claims ownership rights to the property;
 - ii. the President of WKURF shall determine and record the rights of the creator to share in any income with WKU according to the royalty sharing procedure; and
 - iii. the creator shall execute an acknowledgment and, where applicable, an assignment of ownership rights to WKU.
4. The President of WKURF, in consultation with the IPC, will have the responsibility for valuing the intellectual property so that WKU's interests in any subsequent negotiations are protected. The process for licensing, selling, or otherwise conveying intellectual property will comply with any applicable federal or state statutes. With close consultation with the creator and written advice from the WKU General Counsel, Provost, EVP-SOF (or designees), and the President of WKURF shall determine the appropriate method of protection of the property and, where appropriate, obtain such protection. All costs of protection shall be borne by WKU or WKURF and shall be offset against future income. The Provost and EVP-SOF will be copied on all such determinations.
5. The President of WKURF may, after obtaining written advice from the WKU General Counsel (or designee), file a provisional, utility, or design patent application after receiving sufficient information from the creator for filing of said application. President of WKURF may apply for a utility patent before the twelve-month deadline in which to file a utility patent application claiming priority to the

provisional patent application, or, following consultation with the WKU General Counsel (or designee), may release the creation to the creator.

6. If, after obtaining written advice from the WKU General Counsel (or designee), the President of WKURF decides not to proceed with the filing of intellectual property protection, the inventor shall be allowed to pursue intellectual property protection at his or her own expense. The President of WKURF shall keep the creator informed of these actions in a timely manner. In the event protection and exploitation usage of intellectual property proceeds at the expense of the creator, WKU/WKURF shall not be considered to have waived part of its share of net royalties.
7. If, after obtaining written advice from the WKU General Counsel (or designee), the President of WKURF decides not to proceed with the filing of foreign intellectual property protection, the inventor shall be allowed to pursue foreign intellectual property protection, and foreign exploitation of said intellectual property, under the same conditions as the preceding section.
8. The Office of the WKU General Counsel is the only source of legal advice within the University and shall only provide legal advice to the University, not to individual inventors with respect to works in which they own the copyright.
9. The WKU Research Foundation (WKURF) serves as the university's agent in the receipt of intellectual property income, and in the protection, development, and commercialization of intellectual properties under this policy on behalf of the University.
10. WKU faculty, staff, students, or external parties, may request that WKURF accept, for management and commercialization, intellectual properties not originally subject to this policy. If WKURF accepts management and commercialization responsibilities for such intellectual property, the intellectual property shall become subject to, and shall be treated in accord with, all provisions of this policy. If the management and commercialization of the intellectual property includes an offer of sale of the intellectual property, WKURF and the owner of the intellectual property shall come to an a written agreement as to percentage of the sales price to be retained by WKU, with concurrence obtained from the EVP-SOF, the Provost, and General Counsel (or designees) before an offer of sale may be extended.
11. Intellectual property given to WKU by external parties shall be assigned to the WKURF for management in accord with appropriate parts of this policy. The EVP-SOF, the Provost, the President of WKURF, and the WKU General Counsel shall be informed, in writing, of such assignments.

B. COMMERCIALIZATION

1. All intellectual property assigned to WKU shall be further assigned to WKURF for purposes of protection and commercialization. Patent or copyright coverage may be sought, or the property may be treated as proprietary information, technical know-how, or trade secret.
2. In seeking and developing commercialization of intellectual property, WKURF shall be guided by the following principles:
 - a. The primary objective and responsibility of WKURF shall be to exercise due diligence so that the products of its intellectual activity are brought into the widest possible use for the general benefit of WKU and the broader public. This objective includes the possibility of the granting of an exclusive or non-exclusive license for or sale of intellectual property. If the commercialization of the intellectual property includes an offer of sale of the intellectual property, WKURF and the creator of the intellectual property shall enter into a written agreement as to percentage of the sales price to be retained by WKURF, before an offer of sale may be extended. The EVP-SOF, the Provost, the President of WKURF, and the WKU General Counsel shall be informed of and provided a copy of such agreements.
 - b. Intellectual property should be treated as an asset and an appropriate return should be sought.
 - c. Active creator participation in all commercialization efforts shall be vigorously sought.
3. In an effort to commercialize the intellectual property, WKURF will seek a variety of written arrangements such as licenses, outright assignment or sale of rights, partnerships, collaborations, and joint ventures. The selection of arrangements will depend on the circumstances of each. In all cases, the EVP-SOF, the Provost, the President of WKURF, and the WKU General Counsel shall be provided a report annually summarizing such agreements annually or upon request.
4. In some situations, it may be in the best interest of WKURF, the general public and the creator to enter into commercialization arrangements with entities wholly or partially owned or controlled by the faculty, staff, or students who originated the property. Due to the potential of such arrangements for contributing to the economic development of the state and local areas, such arrangements may be considered and accepted, provided they are not specifically prohibited by law and that adequate provisions, including full disclosure of interests, are made to avoid or otherwise protect against conflict of interest on the part of those involved.

5. Commercialization of intellectual property by WKURF may involve discussions and negotiations over months and sometimes years. Based on national data, the process more often fails than succeeds. If no commercialization has occurred within a reasonable period after the property has been transferred to WKURF, the creator may submit a written request to the WKURF, with a copy to the President of WKURF and WKU General Counsel, that all rights be transferred.
6. Such requests should be directed to the President of WKURF, who shall explain what efforts have been made, and what additional efforts are planned. If the President of WKURF, following consultation with and written advice from the President of WKURF and the WKU General Counsel (or designee), determines that there is little chance of successful commercialization, all rights may be transferred to the creator. If the President of WKURF, following consultation with and written advice from the EVP-SOF, Provost, and the WKU General Counsel (or designee), determines that WKURF has undertaken reasonable efforts to commercialize and that further WKURF efforts offer reasonable chances of success, the creator's request shall be denied. Such denials will be accompanied by a written report, copied to the EVP-SOF, the Provost, and the WKU General Counsel, summarizing the factors considered by the President of WKURF in arriving at the decision. The creator may request a review of the disposition in accordance with this paragraph annually. Such requests should be directed to the President of WKURF, with a copy to the EVP-SOF, the Provost, and the WKU General Counsel.

C. PROCEDURE FOR SHARING ROYALTY INCOME

1. Gross receipts refer to agreed-upon payments specified in a license or other commercialization agreement. Net revenue is defined as gross receipts, which include royalties, license fees, profits from sales, and similar payments received by WKURF, minus necessary deductible costs incurred by WKU or WKURF (e.g., patent applications, patent search fees, patent services, patent maintenance fees, mailing, phone/facsimile, or courier costs; necessary travel; and auditing fees and expenses). WKURF shall reserve the rights to suspend distribution of net revenue when there is reason to believe that substantial deductible costs will be incurred in the future. The creator shall be informed of such decisions. A detailed accounting of revenue and costs shall be made available to the creator upon distribution of royalties or upon request.
2. Net revenues as defined in Section III.C.1, or an agreed-upon percentage of the gross revenues, derived from the commercialization of intellectual property covered by this policy shall be shared as follows: 40% to the creator, 25% to the WKURF. The remaining 35% will be distributed as follows: 15% to the creator's department or lab/center, and 15% to the college of the creator and 5% to the Office of Research and Creative Activity (or similar office if name is changed). The exact distribution of this 30% (15%+15%) may be negotiated based upon actual expenditures and relative administrative roles involved in the creation.

(these last two percentages may be negotiated based on actual expenditures). Funds distributed to the WKURF may be transferred to the Office of Research & Creative Activity, for IP-related expenses, with consent from the WKURF. A report shall be made annually to the IPC and the WKURF on the division of revenues and activities in support of intellectual property creation and protection.

A report shall be made annually to the WKURF and the EVP-SOF on the division of revenues and activities in support of intellectual property creation and protection.

Net Revenue	Creators	Colleges	Department/Lab/Center	ORCA	WKURF
	40%	15%	15%	5%	25%

3. In the case that WKURF decided not to pursue either domestic or foreign protection of intellectual property, and where the creator pursued this at their own expense, net royalties are, by default, still subject to the same distribution as specified in the preceding section. In this case, the creator shall provide the President of WKURF, Provost, and EVP-SOF a detailed accounting of costs incurred.
4. The creator's rights to share in revenue as stated above shall remain with the individual or pass to the individual's heirs and assigns for so long as net income is derived from the property.
5. When two or more individuals have made substantial creative contributions to intellectual property, such persons will determine among themselves, in writing with a copy to the President of WKURF, EVP-SOF, the Provost, and the WKU General Counsel, the individual share each will receive. A copy of the agreement will be filed with the President of WKURF at the time of disclosure. In the event that they cannot reach such agreement, each individual will have the opportunity to present written and oral statements to the IPC. After such presentations, the IPC will make a recommendation to the President of WKURF who, following consultation with and written advice from WKU General Counsel (or designee), shall make a final determination.
6. The creators may, among themselves, request to amend the distribution of royalties due to the creators among themselves, and/or may add creators to share in their allocation. In the case of a unanimous request of this type, the President of WKURF may, following consultation with and written advice from the WKU General Counsel (or designee), agree to an amended distribution.
7. Creators may make a charitable gift of all or part of their income shares to the WKU Foundation to support WKU creative activities. Upon request by a creator, and the consent of the Vice President for Philanthropy and Alumni Engagement,

the WKU Foundation will retain all or part of the creator's share in a separate account within the WKU Foundation for expenditure in accord with the creator's wishes. The creator may restrict such gifts to any program or unit of WKU, as permitted by applicable law. Such requests may be limited in duration to a specific time period or to some specific future event (e.g., the creator's retirement or resignation from WKU) and may be cancelled or modified by the creator at any time upon written request to the Vice President for Philanthropy and Alumni Engagement, and the President of WKURF.

8. All appeals of decisions of WKU or WKURF under this policy will be referred to the IPC for resolution.
9. This revised policy will replace all previous revenue-sharing agreements.

D. SHARING OF RESEARCH MATERIALS

There is a long tradition in some fields of sharing research materials. WKU encourages this cooperation. However, commercialization rights and product liabilities make it advisable that there be a written agreement among the parties prior to entering into any type of sharing arrangement. This agreement is generally referred to as a Material Transfer Agreement. When significant costs to WKU are involved in producing the material, provision for the recovery of those costs not covered by sponsor support shall be considered in making a sharing agreement. A copy of any such agreement shall be maintained by the Office of Research and Creative Activity, and provided to the Provost, the President of WKURF, EVP-SOF, and WKU General Counsel.

E. CONSULTING AGREEMENTS

1. Any faculty or staff member engaged in consulting work or in business is responsible for ensuring that clauses in the individual's agreements are not in conflict with this policy, with WKU's Consulting Policy, or with WKU's commitments or agreements with third parties; and that WKU's rights and the creator's obligations to WKU are in no way abrogated or limited by the terms of such agreements. Questions about potential conflicts should be directed to the EVP-SOF and Provost (or designees), with a copy to WKU General Counsel.
2. Faculty and staff members shall make clear to those with whom they make such agreements their obligations to WKU and shall ensure that other parties to the agreement are provided with a current copy of this policy.

F. REVISIONS AND MODIFICATIONS TO THIS POLICY

This policy is subject to ongoing assessment and future modification. The version of this policy in effect at the time of disclosure is binding. Faculty members and others are therefore expected to acquaint themselves with the current version, which is posted on the [WKU Policies](#) website.

IV REASONS FOR REVISION

Revised and Approved by WKU Board of Regents – January 31, 2003, January 25, 2013

August 2021

(1) Co-authorized by EVP and Provost

(2) Revised to reflect the separation of duties for the Associate Provost for Research and Graduate Education and the President of WKURF. The President of WKURF has responsibility for Intellectual Property, Technology Transfer, Commercialization, and development of the Innovation Campus at WKU.

(3) The IP Committee will become a sub-committee of the WKURF Board of Directors. The IPC will have WKU and non-WKU representation.

(4) The WKU RAMP budget model no longer has a category of “General Fund” to which 25% of the net revenue was distributed under the previous IP Policy. This percentage has been redistributed in the current revision (see table on page 11).

(5) This distribution is retroactive for standing agreements.

Note: Initial revisions to this policy were started in July 2019, and the applicable edits were incorporated into the current revision.