

## HOPE COLLEGE INVENTION AND PATENT POLICY

**Introduction:** Hope College (the "College") is a private liberal arts college with programs in the natural and applied sciences with a national reputation. While the primary focus of these activities is to lead students to lives of leadership and service, the College recognizes that inventions and discoveries of commercial importance may be a natural outgrowth of activities within the College community. The following policy statement clarifies the ownership rights to inventions made by faculty, staff and students of Hope College.

The goal of the inventions and patent policy is to ensure that discoveries, inventions, and other creations generated by faculty, staff, and students of Hope College are utilized in ways most likely to benefit the public. The College seeks to assist its faculty and other researchers in properly disclosing their scholarly work, in complying with applicable laws and formal agreements, and in gaining the protection available under United States laws governing patents. Likewise, the College seeks to ensure that commercial benefits are distributed in a fair and equitable manner that recognizes both the contributions of the inventors and the interests of Hope College.

**Definition of Invention:** Inventions means any and all ideas, processes, inventions, machines, technology concepts, designs, manufacture, programs, trade secrets, compositions of matter, discoveries, other proprietary information, or an improvement thereof, whether patentable or unpatentable, that have been or are created, discovered, acquired, conceived or reduced to practice.

**Administration:** The administration of this patent policy will reside with the Patent Advisory Committee. The committee shall consist of the Dean of Natural and Applied Sciences, the Chief Fiscal Officer of the College, the Provost, the President or his/her appointee. If the President does not serve on the committee then the Provost shall act as chair. When an invention is submitted for consideration, it will be the responsibility of the Patent Advisory Committee to consult with the inventor(s) and appropriate experts in order to:

1. evaluate the patentability and commercial or other value of the invention;
2. determine a course of action for patenting and commercializing the invention;
3. ensure that all sales or licensing of inventions and/or discoveries are implemented to bring the inventions and/or discoveries to the public while securing financial reward for the College and the inventors.

The Chair of the Patent Advisory Committee shall report to the President of the College. An experienced Intellectual Property attorney shall be consulted on all legal matters pertaining to this policy.

**Applicability:** This policy, as amended from time to time, applies to all inventions conceived or first reduced to practice by full-time, part-time or visiting faculty, post-doctoral researchers,

staff, students, or any other persons performing research or engaging in work at the College where such inventions may be created or discovered as a condition of ongoing employment or enrollment. All College personnel may be required to sign a Patent Agreement with the College which will detail the parties patent related rights and responsibilities and the ownership of the invention as provided herein. The absence of such a signed agreement will not in any way be interpreted in any as lessening or reducing the College's claim on such inventions.

**Ownership:** Ownership of inventions, including any intellectual property rights therein, that are conceived or reduced to practice by faculty, staff or any other person performing research or engaging in work or study at the College, where such inventions are created or discovered within the course of their employment or with substantial use of College resources, personnel or facilities beyond the usual office and library provisions, will reside with Hope College. Inventions or discoveries that are made off College premises, are unrelated to teaching and professional activities and without College support and resources are exempt from this policy.

Any student invention will be deemed made under College auspices and therefore the property of the College pursuant to the patent policy only if it is made in the course of the student's employment by the college for an assigned work project, or when the student pursues faculty- or staff-guided or assigned research projects in research courses or on a voluntary basis. Royalties from the College's licensing of any student invention will be shared with the student on the same basis that royalties are shared with faculty or staff employees.

When an invention is developed through a sponsored grant or contract, the special provision contained in the grant or contract will prevail. In the absence of such special provisions, the College policy will apply. Generally, while the College is assigned the rights to intellectual property generated during the course of federally-sponsored research activities, the government retains the option to claim ownership under certain circumstances. In the event that the government does not exercise its option and regardless of ownership, the government retains a non-exclusive, non-transferable, irrevocable, royalty-free, worldwide license to the invention produced under government sponsorship.

**Procedures for Reporting an Invention:** When any person makes a discovery or invention to which this policy applies, a report of the invention should be made promptly to the Chair of the Patent Advisory Committee. The report should be made on the attached Invention Disclosure Form. If ownership of the invention resides with the College, the inventor(s) shall assign all intellectual property rights to the invention to the College upon the committee's request.

Within sixty (60) days of receipt of an Invention Disclosure Form, the Chair will convene a meeting of the Patent Advisory Committee to evaluate the invention. The Patent Advisory Committee shall have the sole right to determine the disposition of inventions in which the College has a proprietary interest. A decision to exercise this right shall be transmitted in writing to the inventor within one hundred and twenty (120) days of the date of disclosure of the invention to the committee. If the committee decides to pursue a patent, it may recommend that the College alone, or with the assistance of an external organization such as a technology transfer company, make applications for letters of patent. Title to all such patent applications and resulting patents shall be held by the College. If the committee decides not to patent an

invention, or not to commercialize a patented invention, the College will release to the inventor its interest in the invention. In this case, the College will get a perpetual, royalty free license to use the invention for research and non-commercial purposes.

**Legal Expenses and Distribution of Income:** An account will be opened to which expenses associated with patenting and marketing inventions will be charged. Expenses include, but are not limited to, invoiced costs such as legal fees, patent filing fees, licensing agent fees, development fees, production fees and other out-of-pocket expenses. Revenues attributable to a particular invention will first be used to recover expenses incurred according to the following formula:

- One Hundred percent (100%) of the income shall go to the College until all its out-of-pocket expenses associated with the protection and exploitation of the invention have been reimbursed. After the College's full recovery of expenses, the net revenues received by the College will be distributed according to the following formula:

<u>Net Income</u>	<u>Inventor</u>	<u>Department</u>	<u>Division</u>	<u>College</u>
Up to \$10,000	75%	15%	5%	5%
Next \$90,000	50%	15%	15%	20%
Next \$900,000	40%	15%	15%	30%
Over \$1 Million	35%	15%	15%	35%

- Royalties attributable to inventions developed as a result of assigned College duties are normally divided as follows: seventy-five percent (75%) to the College and twenty-five percent (25%) to the inventor.
- In the event of multiple inventors, the inventors will be expected to agree among themselves on the fractional distribution of each inventor's share of any royalties. The inventors shall sign a written agreement specifying the fractional distribution of their share of royalties. The inventor's share will continue even if s/he leaves Hope College.
- In the event of multiple Departments or Divisions included in an invention, the Department and Divisions will be expected to agree among themselves on the fractional distribution of each inventor's share of any royalties. The Departments or Divisions shall sign a written agreement specifying the fractional distribution of their share of royalties.

**Express Agreement:** In the event the College and the inventor pursue an invention or patent pursuant to an express written agreement between them, the provisions of the written agreement regarding division of royalties shall control.

**Consulting Agreements:** 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, and with the College's commitments or agreements with third parties and that the College's rights and the inventor's obligations to the College are in no way abrogated or limited by the terms of such agreements, without the express written consent of the College.

**Dispute Resolution:** In the event of any dispute regarding a decision of the committee, or a decision of the inventors in the case of multiple inventors, under this policy, including, without limitation, the ownership of an invention or the allocation of the inventor's share of royalties, the President shall have the final decision concerning the College's position in the matter.

## HOPE COLLEGE INVENTION DISCLOSURE FORM

Inventor(s): \_\_\_\_\_

Department(s): \_\_\_\_\_

Sponsor(s): \_\_\_\_\_

Invention Name or Title: \_\_\_\_\_

Abstract of Invention:

### Background of the Invention

To what discipline, sub-discipline or commercial field would the invention belong? \_\_\_\_\_

What are the immediate and/or future applications of the invention (i.e. medicine, chemical industry, etc.)? \_\_\_\_\_

Why is the invention/innovation better or more advantageous than present technology? \_\_\_\_\_

What problem(s) does it solve? \_\_\_\_\_

Is work on the invention continuing? \_\_\_\_\_

Are there any test data? \_\_\_\_\_

Have products, apparatus or compositions been made and tested? \_\_\_\_\_

### Detailed Description of the Invention

Please attach documentation as necessary and provide examples, drawings and a description of how the invention works:

**Publications, Public Use and Sale**

Has there been a disclosure related to the invention in an abstract, paper, talk, news story or thesis?      \_\_\_\_\_ Yes      \_\_\_\_\_ No

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

Is a publication or other disclosure related to the invention planned in the next six months?  
\_\_\_\_\_ Yes      \_\_\_\_\_ No

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

Has there been any public use or sale of products embodying the inventions?  
\_\_\_\_\_ Yes      \_\_\_\_\_ No

Describe and give date: \_\_\_\_\_  
\_\_\_\_\_

Are you aware of related developments by others?      \_\_\_\_\_ Yes      \_\_\_\_\_ No

If available, attach copies of any related patents or publications.

**Sponsorship**

Is the research or work that led to the invention externally sponsored?      \_\_\_\_\_ Yes      \_\_\_\_\_ No

Type of agency:      \_\_\_\_\_ Federal      \_\_\_\_\_ Industry      \_\_\_\_\_ University  
                                 \_\_\_\_\_ Foundation      \_\_\_\_\_ Other

Grant Number: \_\_\_\_\_

Has the invention been disclosed to industry representatives?      \_\_\_\_\_ Yes      \_\_\_\_\_ No

If yes, please provide date, company name, address, names of company representatives, contact information and describe the context of disclosure: \_\_\_\_\_

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\_\_\_\_\_

**Signatures of Inventors**

Name(s) and title(s): \_\_\_\_\_

Country of Citizenship: \_\_\_\_\_

Mailing Address: \_\_\_\_\_

\_\_\_\_\_  
Telephone number and e-mail address: \_\_\_\_\_

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

Name(s) and title(s): \_\_\_\_\_

Country of Citizenship: \_\_\_\_\_

Mailing Address: \_\_\_\_\_

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