



Intellectual Property Policy

(Effective October 28, 2014)

I. Preamble

St. John's University is committed to the advancement of knowledge through research and innovative developments and recognizes that inventions and discoveries may benefit the public and be of commercial interest. The creation of intellectual property (IP) is complementary to the University's core objectives of teaching and learning, research and discovery, community engagement and public service. As an institution of higher education, St. John's University has a duty to develop, support and implement a policy that creates an environment for IP to be cultivated and to be transferred into practical use for the benefit of humanity. This Policy describes the protection, ownership and commercialization of IP developed by faculty, staff, and students and by third parties that may collaborate and/or fund research leading to the creation of IP. Any inventions and related IP rights that result from research and scholarly activities should be consistent with St. John's status as a Catholic and Vincentian University.

II. Definitions

- (a) "University" or "St. John's": St. John's University, New York, an institution of higher education organized and existing under the laws of the state of New York with its principal campus at 8000 Utopia Parkway, Queens, New York 11439. This Policy shall be applicable to all St. John's campuses, including but not limited to its Queens, Oakdale, Staten Island and Rome campuses, and any other sites or locations, including but not limited to sites or locations abroad.
- (b) "Inventor(s)": (i) all employees of St. John's University, whether full time or part time, paid or unpaid, nonacademic or academic (whether tenure track or non-tenure track), including but not limited to, academic appointments with a modified title (e.g., visiting, courtesy, adjunct, etc.), clinical and affiliation appointments, assistantships and fellowships (e.g., research and teaching assistants, graduate assistants, fellowship recipients and training grant recipients); (ii) graduate and undergraduate students; and (iii) third party individuals/institutions/organizations including but not limited to visiting scholars, individuals employed by outside organizations, consultants or individuals with honorary appointments. Inventors are covered under this Policy and subject to its terms and conditions, irrespective of their obligations to other companies, institutions or third parties.
- (c) "Invention": Includes, without limitation, all patentable and non-patentable inventions, creations, innovations, discoveries, know how, creative works, trade secrets, computer software (including but not limited to microcode, subroutines and operating systems), mask works, trademarks, service marks, tangible research property and any associated or supporting technology. Copyrighted Works, which are hereinafter defined, are excluded

from the definition of Invention. In the event that an Invention can be protected by both Copyright and Patent Law, the defined term Invention shall be controlling.

- (d) “St. John’s Resource”: Includes, without limitation, the University’s facilities, library resources, equipment, personnel, materials, tangible research materials, information that is not freely available to the public, or funds, including but not limited to funds provided through an externally funded grant, contract, sponsorship or other type of award, gift or arrangement between St. John’s and a private or governmental sponsor who furnishes funds, equipment or other resources to support research, the creation of creative work, or any other educational or scientific activity to be performed.
- (e) “Incidental Use”: Use of St. John’s Resource(s) shall be considered an Incidental Use where: (i) only a minimal amount of St. John’s Resources have been used; (ii) where use of St. John’s Resources is ordinary (i.e., a routine use of St. John’s office space, desktop or library facilities); or (iii) the Invention has been made on the personal, unpaid time of the Inventor and the Invention is wholly unrelated to the research that the Inventor is conducting and/or involved with for St. John’s. The Disclosure Committee (as hereinafter defined) shall determine, in its sole discretion, if there was an Incidental Use of St. John’s Resources.
- (f) “Author”: Shall be defined as: (i) all employees of St. John’s, whether full time or part time, paid or unpaid, nonacademic or academic (whether tenure track or non-tenure track) including but not limited to, academic appointments with a modified title (e.g., visiting, courtesy, adjunct, etc.), clinical and affiliation appointments, assistantships and fellowships, student interns (e.g., research and teaching assistants, graduate assistants, fellowship recipients and training grant recipients); and (ii) independent contractors and third party consultants with whom St. John’s has hired pursuant to a contract (oral or written). Authors are covered under this Policy and subject to its terms and conditions, irrespective of their obligations to other companies, institutions or third parties.
- (g) “Copyrighted Work”: Shall be defined as original works of authorship that are fixed in a tangible form of expression and which are afforded legal protection under 17 USC §102(a), including without limitation, literary works (e.g., books, articles, memoranda, texts); musical works, including any accompanying words; dramatic works, including any accompanying music; pantomimes and choreographic works; pictorial, graphic and sculptural works (multimedia works and web pages); motion pictures and other audiovisual works; sound recordings (music, drama or lectures); and architectural works.
- (h) “Disclosure Committee”: The Disclosure Committee shall consist of five (5) members. The composition of the Disclosure Committee shall include the following members: (i) Vice Provost for Graduate Studies and Research (the “Vice Provost”), (ii) Director of The Office of Grants and Sponsored Research, (iii) the Dean from the respective school or college of the Inventor, and (iv) two faculty members selected by the Dean of the Inventor’s respective school or college experienced in the Inventor’s subject matter.

- (i) “Institutional Work”: those Copyrighted Works that have been created with a specific allocation of St. John’s’ funds or created at the direction of St. John’s for a specific St. John’s’ purpose. In addition, Institutional Works shall also include those works for which authorship cannot be attributed to a discrete number of authors, but rather result from contributions made over time by various faculty, staff and/or students. The fact that a work has been contributed to by multiple Authors does not in and of itself make it an Institutional Work.
- (j) “Research”: Shall be defined as all educational, scientific activities or other related activities that have the potential, regardless of how likely, to produce an Invention.
- (k) “Tangible Research Property” or “TRP”: tangible (or corporeal) items produced in the course of research projects supported by St. John’s or by external sponsors. TRP includes such items as: biological materials, engineering drawings, computer software, integrated circuit chips, computer databases, prototype devices, circuit diagrams, equipment. TRP is separate and distinct from intangible (or intellectual) property such as inventions, patents, copyright and trademarks which are subject to other policies and guidelines). Individual items of TRP may be associated with one or more intangible properties such as copyright or patents.

III. Ownership

- (a) St. John’s shall have an ownership interest (“Ownership Interest”) in all Inventions conceived, created, discovered, devised, produced, originated, or reduced to practice by a an Inventor (collectively “Discovered”), whether alone or in conjunction with other individuals not covered by this Policy, if the Invention was conceived, created or reduced to practice in whole or in part, directly or indirectly: (i) with the use of financial support from St. John’s, including without limitation, funding or support from any outside source awarded to or administered by St. John’s; (ii) with the use, other than Incidental Use, of any St. John’s Resource; or (iii) under or subject to an agreement between St. John’s and a third party which creates or defines any obligations with respect to the Invention.
- (b) The Disclosure Committee, upon receipt of the Disclosure Form (hereinafter discussed) shall determine, in its sole discretion, whether St. John’s has an Ownership Interest in an Invention.
- (c) If the Disclosure Committee determines that St. John’s does not have an Ownership Interest in the Invention, an Inventor will be under no obligation to assign his/her rights pursuant to section IV of this Policy. However, an Inventor shall grant to St. John’s, an irrevocable, perpetual, royalty-free, non-exclusive, unlimited, world-wide right to use the Invention for St. John’s research, educational and other non-commercial activities.

IV. Assignment of Rights

If St. John's has an Ownership Interest in the Invention, an Inventor must assign all rights, titles and interests to/in the Invention to St. John's University, irrespective of obligations to third parties, and assist St. John's in all phases of the filing application process.

V. Disclosure Obligations

- (a) All Inventions Discovered by an Inventor, with or without use of St. John's Resources, must be promptly disclosed in writing to the Disclosure Committee using the Disclosure Form, attached hereto as Exhibit A. Such disclosure shall include all necessary documentation fully describing the Invention, the Inventor's relationship with St. John's, the circumstances under which the Invention was created, a description of the St. John's Resources that were used, the existence of a grant, contract or other similar agreement which resulted, directly or indirectly, in the Invention being Discovered, if and to what extent a third party was involved in the Discovery of the Invention, and its potential utilization and/or commercialization. The Disclosure Committee together with external consultants will then determine if St. John's has an Ownership Interest in the Invention.
- (b) Disputes regarding the Ownership determination must be appealed to the Provost whose decision will be final and binding upon the parties.
- (c) If the Disclosure Committee determines that St. John's has an Ownership Interest and further determines that it will not file a patent application for an Invention or abandons the patent application or abandons an issued patent on an Invention, an Inventor may request in writing a release of the Invention. If St. John's determines that the release will not violate the terms of any agreement pertaining to the Invention and that the release is in the best interests of St. John's, its students and the public, St. John's University may release and reassign the Ownership Interest in the Invention to the Inventor within a month after the date of the disclosure meeting. If the said release and reassignment transpires, the Inventor shall: (i) share with St. John's 15% of "Invention Income", which is later defined in this Agreement; (ii) grant to St. John's an irrevocable, royalty-free, perpetual, unlimited, non-exclusive worldwide right and license to the Invention for research, educational and non-commercial purposes; (iii) assume any and all obligations contractually imposed on St. John's relating to the Invention; and (iv) agree to such limitations on St. John's liability and indemnity provision as St. John's may request.
- (d) It is expressly acknowledged that inappropriate or premature disclosure of an Invention to persons, firms, or corporations outside of St. John's may jeopardize the ability of St. John's University and/or the Inventor to commercialize and/or obtain legal protection of an Invention. Accordingly, prompt disclosure to St. John's University of Inventions is essential to the proper administration of this Policy.
- (e) Upon the submission of a Disclosure Form, the Disclosure Committee shall convene a disclosure meeting within three (3) weeks of disclosure form submission. The Disclosure Committee shall be responsible for determining whether a patent application shall be

filed on an Invention within a month of the disclosure meeting. Filing determinations may be made on the basis of commercial potential, the public interest, obligations to and rights of third parties, or any other legal and/or practical reason which the Disclosure Committee deems appropriate. Notwithstanding the foregoing, St. John's believes that Inventors have the primary responsibility for the development and commercialization of an Invention. The Inventor and St. John's University shall confer with and advise each other on the potential commerciality of an Invention. If St. John's elects to commercialize an Invention, St. John's may, with the assistance of the Inventor and/or business, management and law firms, negotiate appropriate licenses or other agreements with third parties, monitor and manage progress of the patent, and distribute royalties and/or equities further to the Invention Revenue provision of this Agreement. The Inventor shall cooperate and assist St. John's in all phases of the patent application, which shall be filed in the name of St. John's only, including without limitation, the execution of documents and the required assignment of Ownership Rights. All costs and expenses incurred in connection the procurement of a patent, including but not limited to the cost of filing, prosecuting and maintaining any patent right, shall be borne by St. John's exclusively.

- (f) This Policy does not commit or otherwise obligate St. John's to license, assign or otherwise commercialize an Invention which may be developed by an Inventor in the future.

VI. Copyrighted Work

- (a) An Author, and not St. John's, has an Ownership Interest in Copyrighted Works unless the Copyrighted Work is an Institutional Work in which event St. John's shall be the owner.
- (b) An Author may not commercialize course content that is currently taught at St. John's, even if St. John's does not have an Ownership Interest, without the prior written consent of the Provost, which can be withheld, delayed or conditioned in his/her sole discretion.
- (c) St. John's shall require a written agreement that provides it with an ownership interest in all Copyrighted Work that is Discovered or commissioned by either (i) a non-academic Author (i.e. a consultant, subcontractor, or independent contractor retained by St. John's) within the scope of his/her engagement/employment with St. John's or (ii) by academic Authors pursuant to a specific direction by St. John's or an assigned duty.
- (d) St. John's will not assert an ownership interest in Copyrighted Works created, developed, or commissioned by students working in their own individual capacity, who are not otherwise in an employment relationship with St. John's, whether written or oral, and who use St. John's Resources Incidentally.
- (e) If St. John's has an Ownership Interest in a Copyrighted Work, an Author will nonetheless be permitted to continue to use the copyrighted work for his/her own non-commercial purposes.

- (f) Except as otherwise provided in this Article, the terms and provisions of this Policy which govern an Invention shall apply equally and to the same extent to Copyrighted Works. In the event that there is any inconsistency between the terms set forth in this Article VI and the remaining provisions of this Policy, the remaining provisions of this Policy shall control and be binding upon the parties.
- (g) If a Copyrighted Work has more than one Author, the Authors shall be considered “Joint Authors” and absent a written agreement between the parties, shall share royalties equally.
- (h) Courses taught and courseware developed for teaching at St. John’s will, as indicated above, be Institutional Works that shall be owned by St. John’s. Any courses which are videotaped or recorded using any media are also the sole property of St. John’s, and may not be further distributed without written permission of the academic Dean of the relevant department. Prior to videotaping, written permission shall be obtained from anyone appearing in the video.

VII. Invention Revenue

- (a) In the event that an Invention produces revenue through commercialization, including without limitation, a sale, licensing, royalties or otherwise (hereinafter “Invention Revenue”) St. John’s shall initially receive all Invention Revenue. Upon receiving Invention Revenue, St. John’s shall deduct from Invention Revenue and all costs and expense incurred in connection with the procurement of the patent, including without limitation, attorneys’ fees, filing costs, development, promotion, marketing, commercialization, licensing, maintenance and administering of the Invention (hereinafter “Invention Expenses”). St. John’s shall, upon written request from an Inventor, identify the Invention Expenses. The amount remaining after subtracting the Invention Expenses from the Invention Revenue shall hereinafter be referred to as the “Invention Income.” St. John’s shall distribute Invention Income within three months of its receipt of Invention Revenue pursuant to the following formula:

Total Invention Income	Inventor(s) Personal Income	SJU Research Account for Inventor	Inventor’s Department	Inventor’s College	University
First \$500,000	25%	10%	10%	25%	30%
\$500,001 -	20%	5%	5%	20%	50%

As Invention Income may be received in multiple installments, over extended periods of time and/or from different sources, Invention Income shall be counted cumulatively. For example, if \$500,000 of Invention Income is disbursed in May, 2015 and \$55,000 in Invention Income is scheduled to be distributed in September 2015, the formula for Total Invention Income over \$500,001 shall be applied to the September, 2015 distribution.

- (b) Where there are multiple Inventors/Authors the Inventor's personal income share shall be shared as stipulated in a written agreement between the inventors/authors. In cases where multiple departments and/or schools are involved, they shall share the respective percentage share as stipulated in a written agreement between the departments and schools.
- (c) Definition:
- (i) For purposes of this provision, Invention Income paid to an Inventor shall be referred to as "Inventor(s) Personal Income".
 - (ii) For purposes of this provision, the College or School in St. John's that is affiliated with Inventor shall be referred to as "Inventor's College". If there is more than one Inventor and the Inventors are affiliated with different Colleges or Schools at St. John's, absent any agreement to the contrary, the Inventors' Colleges shall share Invention Income in equal shares. If the Inventor is unaffiliated with any particular College or School at St. John's, the Invention Income which is ordinarily distributed to Inventor's College shall be distributed to the University.
- (d) If an Invention has more than one Inventor, in the absence of a written agreement to the contrary which is signed by St. John's, Personal Income of Inventor(s) shall be shared equally. The existence of multiple Inventors shall not impair the distribution of Invention Income in full to the University or the Inventor's Department, regardless of whether one of the Co-Inventors is not otherwise covered by this Policy.
- (e) If an Inventor shall leave the employment of the University, his/her share of Inventor Personal Income shall continue; however, income that would normally be deposited into a SJU Research Account for the Inventor shall instead be distributed equally to the Inventor's College and the University. In the event of an Inventor's death, the Inventor's Personal Income shall be paid to the Inventor's estate.
- (f) Proceeds from the liquidation of an equity interest received by St. John's shall be distributed pursuant to the above-referenced table.
- (g) All irresolvable disputes regarding the distribution of Invention Income shall be determined solely by the Provost whose decision will be final and binding upon the parties. Either the Inventor and/or St. John's may request the Provost to submit a written explanation in connection with its decision.
- (h) St. John's obligation to pay to Inventor Personal Income shall survive the termination of the Inventor's relationship with St. John's. Further, Invention Income to St. John's, Inventor's College, Inventor's Department and SJU Research Account n shall remain unaffected and shall be payable to St. John's in full, regardless of the Inventor's relationship with St. John's University. If the Inventor's School or College ceases to exist, Invention Income shall be payable to St. John's. If the Inventor transfers from one school or college to another school or college within St. John's, Invention Income distributed to the Inventor's College shall transfer move with the Inventor to the new College or School.

- (i) This Invention Revenue provision shall not apply retroactively and shall not modify any pre-existing written agreements between St. John's and an Inventor. This Invention Revenue provision is applicable to all Inventions which are disclosed to St. John's on or after [Insert Date].

VIII. Tangible Research Property

- (a) Ownership of TRP: TRP normally is either owned by St. John's or is subject to the ownership and other provisions of contracts and grants. For example, items such as microorganisms produced under a government grant or contract usually belong to St. John's as expendable property, subject to the terms and conditions of the grant or contract. Equipment which is fabricated at St. John's for subsequent off-campus use by a research sponsor is usually owned exclusively by the sponsor.
- (b) Freedom of Access: St. John's abides by the principle of openness in research - the principle of freedom of access by all interested persons to the underlying data, to the processes, and to the final results of research. Consistent with this principle, it is St. John's policy to promote the prompt and open exchange of TRP and associated research data with scientific colleagues outside the investigator's immediate laboratory.
- (c) Control: It is the responsibility of the PI (or other designee, as appropriate, e.g., laboratory director or department chairperson) to control the development, storage, use, and distribution of TRP made in the course of research activity, subject to provisions of applicable grants or contracts. Such control includes determining if and when distribution of the TRP is to be made beyond the laboratory for others' scientific use.
- (d) Commercial Considerations: Because TRP may have potential commercial value as well as scientific value, the PI may wish to make TRP broadly available for others' scientific use by means which do not diminish its value or inhibit its commercial development or public use. Although valid non-commercial reasons may exist for the temporary delay of TRP distribution outside the laboratory for others' scientific use (e.g., safety factors or the need to more fully characterize the TRP prior to distribution, etc.) scientific exchanges should not be inhibited due to potential commercial considerations.
- (e) Distribution: Each distribution of TRP, whether it be biological, software or other TRP, should be accompanied by a transmittal letter that includes any conditions imposed, or reference to any agreements imposing obligations, upon the recipient of the TRP

IX. Miscellaneous

- (a) Subject to the other provisions contained herein, all rights conferred upon St. John's pursuant to this Policy, including but not limited to Ownership Rights, Assignment, and Invention Revenue, shall survive the termination of an Inventor's relationship with St. John's.
- (b) An Inventor shall have the right to use an Invention for non-commercial purposes, including but not limited to teaching and research, provided however, that the Inventor obtains the prior written consent of the Provost which can be withheld, delayed or

conditioned in his/her sole discretion. This right shall survive the Inventor's relationship with St. John's.

- (c) Whenever St. John's issues a license, assigns, or otherwise transfers its Ownership Interest in an Invention to an Inventor and/or other third party, St. John's hereby reserves for itself, without further act or deed, the non-exclusive, revocable and royalty-free right to use the Invention for its own educational, research and other non-commercial purposes.
- (d) Conflict of Interest: If an Inventor enters into a consulting and/or other agreement with a third party which provides the third party with ownership rights in an Invention and/or otherwise pertains to the subject matter of this Policy, the Inventor shall promptly notify the Vice Provost and obtain the prior written consent of the Vice Provost prior to executing the Agreement. In the event that the third party agreement conflicts with this Policy, this Policy shall be controlling upon the parties. Furthermore, Research to be conducted pursuant to the third party agreement cannot be conducted with St. John's Resources if the Research is similar to the Research that the Inventor is conducting for St. John's. In connection with any consulting and/or agreement, an Inventor is prohibited from diverting St. John's Resources to an outside party without the prior written consent of the Vice Provost, which can be withheld, delayed or conditioned for any reason in its sole discretion.
- (e) St. John's reserves the right to amend this Policy from time to time, including but not limited to the Invention Revenue provision set forth in Article VII. No amendment, modification, or discharge of this Policy shall be valid unless set forth in a written instrument and signed by the Provost.
- (f) The Disclosure Committee, in consultation with the Provost, shall be responsible for all matters and issues relating to this Policy, including but not limited to the interpretation and enforcement of this Policy. All disputes arising out of or relating to the interpretation or enforcement of this Policy and/or a decision of the Disclosure Committee shall be appealed to the Provost. In connection therewith, the Provost will render a decision which will be final and binding upon the parties.
- (g) St. John's will not endorse or lend its support to any Invention which is inconsistent with St. John's status as a Catholic and Vincentian University. Inventors who commercialize Inventions which are inconsistent with St. John's status as Catholic and Vincentian University shall not use St. John's name and/or logo in any manner, including a manner that implies, directly or indirectly, St. John's endorsement of the Invention. However, an Inventor may use St. John's name and/or logo for purposes of identification provided that the Inventor obtains the prior written consent from the Vice Provost which can be delayed, withheld or conditioned for any reason within his/her sole discretion.
- (h) If an Inventor anticipates that an Invention will have more than one Inventor, it is strongly recommended that the parties execute a written agreement, prior to the commencement of said Research, promulgating the responsibilities and rights of each respective Inventor.



EXHIBIT A

Disclosure Form

Disclosure # _____

Date received: _____

Disclosure meeting date: _____

Intellectual Property Disclosure Form

This is a confidential, nonpublic document. Please email the completed Intellectual Property Disclosure Form (IPDF) and any supporting documentation to:

Director, Office of Grants and Sponsored Research)

St. John's University

Newman Hall, Room 108

8000 Utopia Parkway

New York, 11439

littmanj@stjohns.edu

You will be contacted by The Office of Grants and Sponsored Research upon receipt of the completed IPDF to arrange for a disclosure meeting. This IPDF and the disclosure meeting form part of the invention evaluation process. If you wish to discuss your invention, have questions related to this form or have any questions about the evaluation process please contact Director.

A copy of this form will be forwarded to the department chair(s) and the Dean(s) of the college(s) in which the inventor(s) developed the technology.

Intellectual Property Title/Name of invention
Name of inventor(s) and relationship(s) with St. John's University
Date of conception of the invention Describe how this has been documented.
Key features of your invention Describe briefly the key features of your intellectual property.
Description of invention Provide a detailed description of your invention.
St. John's University resources Describe the nature and to what extent St. John's University resources were used during the invention process.
Applications Describe the main applications of your invention.
Novelty and inventiveness How is the described invention/intellectual property different from existing technology?
Prior art List prior art references and public disclosures with dates related to your invention and attach copies of any relevant disclosures. A public disclosure date represents the date the material was available to the public or others not affiliated with the invention.

<p><i>Journal articles:</i></p> <p><i>Books/book chapters:</i></p> <p><i>Theses:</i></p> <p><i>Patents:</i></p> <p><i>Conference presentations:</i></p> <p><i>Conference Abstracts:</i></p> <p><i>Poster presentations:</i></p> <p><i>Grant proposals:</i></p> <p><i>Industry disclosure:</i></p> <p><i>Web postings:</i></p>
<p>Commercial market</p> <p>Describe the commercial market space of your invention, and in which industries and countries your invention could be sold.</p>
<p>Development requirements</p> <p>Detail the technical risk associated with your invention. Is the technology proven or does it require further improvements for a commercial market?</p>
<p>Funding</p> <p>List all funding (external and internal) related to the conception and development of the invention.</p>
<p>Contributors</p> <p>List the name and affiliation of every person that has provided intellectual input in developing the intellectual property. This includes, but is not limited to, faculty, staff, administrators, post-doctoral associates, graduate students, undergraduate students and third parties.</p>

Contracts or agreements that have resulted from the invention

Describe any contracts or agreements, directly or indirectly, that have resulted from the disclosed invention.

Industry contacts

Provide names and contact details for any industry contacts that may be approached during a commercialization process.