

Intellectual Property Guidelines for Faculty & Employees

A. Ownership

The State of Oregon by and through the State Board of Higher Education on behalf of Oregon Institute of Technology (OIT) owns the Intellectual Property created by employees at OIT. Section 6.215 of the Oregon University System Internal Management Directives states:

"The Board reserves the ownership rights to all institutional work-related inventions, and to educational and professional materials developed with institutional resources, including the right to a free and irrevocable license for usage, and if desired, the licensing for use by others. The foregoing does not preclude an institution employee from granting copyright privileges to the publisher of a scholarly or professional journal when no compensation or royalty is involved."

B. Disclosure

Pursuant to OAR 580-043-0011, university employees are required to disclose the intellectual property developed in the course of their employment with institutional resources to the Office of Innovation and Technology Transfer (OITT) at Oregon Institute of Technology. The OITT manages invention disclosures in accordance to OAR 580-043-0016, and ensures compliance with the OARs, IMDs, and federal guidelines for sponsored projects. The State of Oregon by and through the State Board of Higher Education on behalf of Oregon Institute of Technology reserves ownership rights to all institutional work-related inventions, professional materials, and educational materials developed by employees using institutional resources or in the course of an assigned project.

C. Technology Transfer & Licensing

Oregon Institute of Technology is committed to a policy that intellectual property developed at the university should be used for the greatest possible public benefit, and accordingly believes that every reasonable incentive should be provided for the prompt introduction and technology transfer of such intellectual property into public use, all in a manner consistent with public interest and IP policies. In order to achieve this objective and depending on the particular business needs, Oregon Institute of Technology is able to consider several types of intellectual property licenses including non-exclusive, exclusive, and exclusive with field of use restrictions licenses.

D. Royalty-Sharing

Oregon Institute of Technology has one of the most liberal royalty distribution policies in the nation. OIT employees are eligible to share in the net royalty income from each invention at 40% for the first \$50,000, 35% for the next \$50,000, and 30% of all additional net royalty income received by the Board for inventions or technological improvements.

Intellectual Property Guidelines for Students

A. Ownership

Intellectual property conceived or first reduced to practice by a student at Oregon Institute of Technology ("University") as a work product of a “for credit” course will normally be owned by the student. The University does not normally claim ownership of such intellectual property. This includes senior projects, theses, course projects and assignments, and special and independent study projects, conducted without the use of extensive or extraordinary university resources. Note, however, that if extensive university resources are used by the student, the Board might reserve ownership rights to the IP.

B. Special Situations

The above treatment of IP ownership applies as long as the student is not an employee of the university, in which case they abide by the same IP guidelines as faculty and employees. Undergraduate students, graduate students, and assistants who receive monetary support from OIT are required to assign their intellectual property rights that specifically relate to those projects for which the students receive financial support.

Additionally, situations may occur in certain courses where students are presented with the opportunity to participate in projects or activities in which the ownership of any resulting intellectual property must be assigned to a sponsoring entity (such as a company) as a condition of the student's participation. Students are never obligated to participate in projects or activities that require the assignment of the student's intellectual property to an outside entity. In these situations students will always be presented with a choice of two options:

1. To participate in projects or activities, which do not require the student to assign their intellectual property.
2. To participate in projects or activities that requires the student to assign their intellectual property.

The student's grade and/or evaluation of performance in the course will not be affected by the student's decision to participate or not to participate in projects or activities requiring the assignment of the student's intellectual property.

C. Confidentiality & Assignment

In order to protect their competitive positions, sponsors may also require students to sign a confidentiality agreement as a condition for working on their project. This agreement obligates the student to observe due diligence in protecting the confidentiality of company-provided information (data, drawings, design intent, etc).

Students should understand that the assignment of intellectual property and confidentiality agreements are binding legal documents and that they have the right to seek independent legal advice at their own expense prior to signing these agreements.

Intellectual Property Guidelines for Industry Sponsors

A. Sole Ownership

Intellectual property solely conceived or created by Sponsor's employees is solely owned by the Sponsor. Intellectual property solely conceived or created by employees of Oregon Institute of Technology (OIT) is solely owned by OIT.

B. Joint Ownership

Intellectual property jointly conceived or created by OIT's employees and Sponsor's employees is jointly owned by both parties. In the case of patentable subject matter, ownership is determined based on inventorship. The inventive entity (i.e., the inventors) for a particular patent application is based on contribution to at least one of the claims made by each of the named inventors. Each joint inventor must generally contribute to the conception of the claimed invention. A co-inventor need not make a contribution to every claim of a patent. A contribution to one claim is enough. See MPEP 2137.01 (Inventorship).

In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, without the consent of and without accounting to the other owners. See 35 U.S.C. 262.

As a joint owner of the patent rights, the Sponsor would be free to practice the invention without a licensing agreement. However the Sponsor may be interested in obtaining an exclusive license in order to prevent the university from negotiating licenses with other parties. Licenses cannot be negotiated a-priori, that is, the intellectual property must be developed in order for a license agreement to be negotiated.

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