

## **Policy 1107**

**Title: Intellectual Property**

**Date of Current Revision: December 2024**

**Primary Responsible Officer: Vice President for Research, Economic Development, and Innovation**

### **1. PURPOSE**

This policy is designed to state the rationale and the mechanisms used to establish intellectual property ownership criteria and resolve ownership questions, if such arise. Additionally, the policy is meant to define the responsibilities, rights, and privileges of those involved and develop basic administration guidelines.

### **2. AUTHORITY**

The Board of Visitors has been authorized by the Commonwealth of Virginia to govern James Madison University. See Code of Virginia § 23.1-1600; § 23.1-1301. The board has delegated the authority to manage the university to the president.

Article I, section 8 of the United States Constitution  
Title 35, US Code § 200  
1976 Copyright Act (P.L. 94-553)

### **3. DEFINITIONS**

#### **Author**

Individual(s) who create original works that qualify for protection under U.S. copyright law.

#### **Assignment**

A document executed by creators which confers legal transfer of title and interest from one party to another, for example, from creator(s) to James Madison University and/or to James Madison Innovations.

#### **Commercialization and Licensing Office (CLO)**

The office at the university designated by the IPO to protect, manage, and commercialize university intellectual property.

#### **Common Use**

Use of routinely available and accessible university resources, including spaces (virtual and tangible), equipment, materials, and the services of JMU members acting in their professional capacities as employees of the university.

#### **Copyright**

The body of exclusive rights granted by law to copyright owners for protection of their original works of authorship, including literary, dramatic, musical, artistic, and certain other intellectual works, under the copyright laws of the United States (see 17 U.S.C. 101 et seq.) or other

protective statutes, whether or not registered thereunder. Copyright protection does not extend to an idea, procedure, process, slogan, principle, or discovery.

**Course**

Includes a set of educational objectives, which are identified in a syllabus, and the learning materials, assignments, and assessments delivered either by an instructor, or under an instructor's supervision and pursuant to the university's policies.

**Creator**

Individual(s) who is an author or developer of any intellectual property. Creatorship shall be determined in accordance with intellectual property law.

**Derivative Work**

A work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a derivative work. The copyright in a derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work and does not imply any exclusive right in the preexisting material. The owner of a copyright has the exclusive right to prepare derivative works based upon the copyrighted work.

**Intellectual Property (IP)**

Anything developed by anyone covered by the university's intellectual property policy that fits one or more of the following categories:

- A potentially patentable item
- An item that has been issued a patent
- Anything that is copyrightable
- An item that is copyrighted
- Anything that is trademarkable
- An item that is trademarked
- Trade secrets

**Intellectual Property Disclosure**

The document by which a university member reports a creation of IP to JMU.

**Intellectual Property Committee (IPC)**

Evaluates disclosures prepared by university members to ascertain ownership. Members of the IPC are faculty members and students from across the university and are appointed by the university president.

**Intellectual Property Officer (IPO):**

The member of the administration appointed by the president to administer Policy 1107 and be the final decision maker in all matters arising under this policy; the duties of the IPO are assigned to the Vice President for Research, Economic Development, and Innovation.

**Invention**

Any new and useful process, machine, composition of matter, article of manufacture, software, or tangible property.

**Inventor**

Individual(s) covered by this policy who discover, create, or develop an invention.

**James Madison Innovations (JMI)**

The non-profit organization designated by, and affiliated with JMU to manage, protect, license, and help with commercialization decisions of any and all IP created at JMU. For clarification, any IP forthcoming from more than incidental use of university resources shall be subject to ownership by JMU as defined in this policy, and management by JMI.

**Net Revenue**

The total revenue received from the licensing of intellectual property, less the costs/expenses of patent, copyright and/or trademark filings and direct "out-of-pocket" marketing expenses associated with the generation of revenues, including legal expenses.

**Patent**

A property right granted by the government to the creator of an invention or design to exclude others from making, using, offering for sale, or selling the invention or design in the United States, or importing the invention or design into the United States.

**Patentable Materials**

Items which qualify for protection under the patent laws of the United States, including any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof (see 35 U.S.C. 101 et seq.), or which qualify for protection under the patent laws of other countries.

**Software**

One or more computer programs or the source code of such computer programs existing in any form, along with any associated operational procedures, manuals, or other documentation, whether or not protectable or protected by patent or copyright.

**Substantial Use of University Resources**

Use of specifically assigned resources, materials, or specialized university owned space; assigned or designated university time of creator(s) and/or personnel under their control funds supplied by the university and/or funds originating from sponsored research projects and/or donations to the university or any affiliated entity utilization of university laboratories, special instrumentation, dedicated services provided by university employees, special financial assistance, or extensive use of shared facilities constitutes substantial use. In contrast, use of a computer, a faculty office, shared facilities accessible to all university members, commonly used equipment for teaching and learning activities, and incidental supplies are not considered substantial use.

**Trade Secret**

Information that individuals or entities keep secret in order to give them an advantage over their competitors, so long as (1) the information is actually secret, because it is neither known to, nor readily ascertainable by, another person who can obtain economic value from the disclosure or use of the information; (2) the owner has taken reasonable measures to maintain the secrecy; and (3) independent economic value is derived from that secrecy.

**Trademark and Service Mark**

A trademark is a word, name, symbol, or device, or a combination thereof that is used in trade with goods to indicate the source of the goods and to distinguish them from the goods of others. A service mark is the same as a trademark except that it identifies and distinguishes the source of a service rather than a product. The terms “trademark” and “mark” are commonly used to refer to both trademarks and service marks.

**University Member**

All JMU full-time and part-time faculty, classified employees, administrative staff, post-doctoral employees, students paid by externally sponsored or internal research grants, student employees (including but not limited to graduate assistants, graduate research assistants, graduate teaching assistants, undergraduate students), fellows and trainees, visiting faculty, visiting scholars, instructors, and researchers, and those employees and visitors covered by sponsored program agreements or other contractual arrangements are considered university members for purposes of this policy, and are subject to its terms.

**Work for Hire**

A work created by an employee within the scope of their employment or a work specifically commissioned by the university is a work for hire. The university generally has ownership of works for hire, subject to the provisions of Section 6 of this policy. For purposes of this policy, a work for hire does not include the creation of a course, course materials, or course delivery, except where there is evidence of substantial use of university resources or where the work is specifically commissioned by the university.

**4. APPLICABILITY**

This policy applies to all university members, as defined above.

**5. POLICY**

James Madison University's vision is to be the national model for the engaged university: engaged with ideas and the world. Such ideas involve scholarly works that may include intellectual and creative endeavors engaging real world problems reaching into and beyond classroom instruction. Such real-world engagement promotes innovation; enhances research by connecting creators and the local, regional, and global communities; and fosters economic development through protecting and commercializing Intellectual Property (IP).

The university's mission includes dissemination of IP in the most efficient and effective manner possible. The identification and optimization of opportunities for the industrial/commercial utilization of some IP is also part of this mission, as is the protection of the ownership rights of both the creators and the university.

While some IP is best disseminated by publication and placement in the public domain, there are a significant number of works that are most effectively handled by protection under the IP laws (i.e., patenting and copyright) and licensing (or other transfer) to private sector entities, with attendant financial considerations.

- 5.1 University members are required to disclose intellectual property resulting from research, substantial use of university resources, or created as a work for hire to the university intellectual property committee (IPC) for evaluation of ownership as described in section 6.
- 5.2 University members must secure authorization to utilize property owned by the university or external entities or individuals.

## **6. PROCEDURES**

This section outlines the criteria to be used by the Intellectual Property Committee (IPC) and its working groups in their deliberations, findings, and recommendations. To the extent that individual questions are not specifically addressed, these guidelines give a general indication of intent and philosophy.

Prior to engaging in activities, partnerships, agreements, and/or contracts involving existing IP or the potential to generate IP, university members are encouraged to consult with the Division of Research, Economic Development, and Innovation.

### **6.1 Ownership of IP**

#### **a. Ownership of IP Generated by University Members**

For purposes of this policy, creations are divided into two groups:

Group 1. The traditional results of academic scholarship, i.e., textbooks, scientific papers, literary works, artistic creations and artifacts, software, etc. In general, such works are subject to protection by copyright law.

Group 2. The novel results of research, i.e., products, processes, machines, software, biological technology, etc. In general, such works are inventions that are subject to protection by patent law.

Intellectual properties in Group 1 are usually considered to make their full contribution to the university's benefit by their creation and continued use by the university in teaching, further scholarship, and enhancement of the university's academic stature; the presumption of ownership is to the creator(s). In the absence of evidence that the work was commissioned by the university as a creation of work, the IP rights remain with the creator(s) and the university's rights are limited to no cost use in teaching, research, extension, etc. in perpetuity.

Intellectual properties in Group 2 are owned by the university, if the work was created as a condition of employment or required substantial use of university resources, inventor(s) will be afforded a share in the benefits derived therefrom as described in Section 6.4.

When disclosing intellectual property, the applicant is expected to describe, account for, and quantify the university resources *specifically devoted to the* creation of the work.

**b. Ownership of IP Developed by Students**

Ordinarily, the university will not claim ownership of IP created by students, with the following exceptions:

- Joint creation by students and university members will fall under Section 6.1.a.
- IP creation resulting from the substantial use of university resources.

With the growing importance of externally sponsored projects, student assignment of IP may be a condition for participation in a course, especially when sponsors are sharing confidential information required for project completion. In such situations, it is the responsibility of the instructor to inform students of their IP rights, including the right to assign any resulting IP rights to the external entity in exchange for the opportunity to work on the project. In the event that the student is not willing to assign their IP rights to the external entity, the faculty will provide an alternative project for course credit.

Unless separately negotiated between the student and the external entities, a student may choose to assign the ownership right in such student-owned IP to the university if all the parties agree to such a transfer.

If students develop IP in their capacity as employees (and herein considered as university members), such IP is a work for hire and shall be governed as set forth in 6.1.a., and ownership is automatically vested in the university, including novel results of research.

**c. Use of University IP**

Any use of university IP requires permission and, in most cases, a license agreement for its use. Such agreements, negotiated with the CLO, JMI, and original creator(s), will outline expectations for use and ownership of derivative IP.

**d. Sponsor Rights**

In the case in which an IP is generated as a result of research funded by a private sector company under a sponsored research project, the IP rights of the sponsor as defined in the applicable clauses ("Patents & Copyrights," "Intellectual Properties," "Inventions," etc.) of the sponsored research agreement (as approved by the IPO or their designee and signed by an authorized officer of the university) shall take precedence over the rights of the university/creator(s). Any residual rights not accruing to the sponsor shall be as defined in the general guidelines above.

**e. Federal Agency Rights**

Research projects sponsored by an agency of the federal government have statutory IP rights that are limited (in almost all cases) to a non-exclusive non-transferrable royalty-free license to any patent generated by the research, provided the inventor(s)/university advise the agency in a timely manner of their intent to retain their rights and provide for legal protection (i.e., patenting). It is the responsibility of the creator to advise the agency of the creation of the IP and (with the assistance of JMI or IPO or their designee) advise of the protection steps being undertaken. The residual rights not belonging to the sponsoring agency shall be as defined in the general guidelines above.

**f. Special Situations**

In the event that an IP ownership situation arises which is not addressed in either the general or specific guidelines outlined above, the IPC shall make a recommendation based on the spirit of the guidelines. A record of the rationale used to arrive at their recommendation shall be kept and used as a precedent for the handling of future special situations if applicable and communicated to the creator(s).

**g. Commissioned Works**

There are times when the university will choose to enter into a contractual arrangement to commission a specific work or undertaking. The university, as the commissioning party, may be expected to maintain certain rights of third parties. These rights are negotiable on a case-by-case basis, but generally the university expects, at a minimum:

- Exclusive right to give premiere performances of the commissioned work; and,
- Exclusive performance rights for a limited period of time; and,
- Exclusive right to give premieres in other venues; and,
- Right to make the first commercial recording of the work; and,
- The right to be credited as the commissioner of the work in published editions, recordings, and programs for all future performances; and,
- The nonexclusive right to use the commissioned work, without cost, in teaching, research, and outreach in perpetuity.

**h. Audio and Video Recordings**

The university reserves the right to use the recordings made by the university of performances by its employees and students for archival, educational, and commercial purposes, as described below. Copyright in the recording itself, but not in the performance, is assigned to JMU. Performances of university employees and students made in any format can be duplicated for preservation in the same or any other appropriate analog or digital format to maintain an archival record at the university.

- The university can use such recordings, in whole or in part, for educational purposes, including activities in criticism, comment, news reporting, teaching, scholarship, research, library services and institutional promotion in any appropriate format.
- When the university uses such recordings, in whole or in part, for commercial or profit-making purposes, it will normally obtain the permission of the performers for such endeavors before the recording is made. If no permission is obtained in advance, the university will make reasonable good faith efforts to obtain such permission from the performers when the decision to offer the recording for sale is made. If the university is unable to secure permission from the performers for such an endeavor, the university will make available to each performer a pro rata portion of any net profits realized from the commercialization of the recording. The university will determine the amount of the share of profits for each performer.

The university office that makes and archives the recording may provide each JMU performer involved in it with one personal copy, under a reimbursement arrangement determined by the university to provide reimbursement up to the cost for the duplication.

## **6.2 Obligation to Disclose**

Creators of IP who are university members must submit an IP Disclosure when any IP is developed (even if there are non-university members as co-creators). Timely (i.e., a minimum of 15 days prior to publication, presentation, or other enabling non-confidential disclosure) submission of an IP disclosure form is required.

If, in the absence of a timely disclosure, commercial utilization and/or licensing of IP takes place with the direct or indirect involvement of the creator(s) but without involvement by the university and/or JMI, it will be deemed that the creator(s) have not fulfilled their obligation to disclose and the university may:

- a. Take whatever legal and/or business action is necessary to protect its rights and rightful share of financial benefits and ownership.
- b. Deny to creator(s) any share of monies which would otherwise accrue to them under this policy.

## **6.3 Dispute Resolution**

If a creator disputes a decision of the IPC regarding the application of this policy, then the dispute must first be referred to the IPC in accordance with the procedure described in Section 6.5. At the culmination of that process the creator may request in writing within 30 days that the IPO review the IPC's decision and render a final decision. The final decision of the IPO represents the conclusion of the matter and no further avenues for appeal or dispute resolution exist within the university.

## **6.4 Disclosure**

Creators of IP who are university members must submit a disclosure when any IP is developed to the university through the designated commercialization and licensing office (CLO). Timely (i.e., at a minimum of 15 days prior to publication, presentation, or other enabling non-confidential disclosure) submission of an IP Disclosure Form is required. The CLO reviews the IP Disclosure and works with the creator to ensure completeness and consistency and forwards the completed IP disclosures to the IPC chair. Signatures of all university member creators and JMU students are required. Non-JMU university members who are creators should be included on the IP disclosure, but signatures are not required.

## **6.5 Evaluation of University Ownership**

The IPC reviews the IP disclosure to determine ownership. The IPC shall report its evaluation of any IP disclosures to the CLO and the creator(s) within sixty (60) days from the date of receipt of the IP disclosure by the IPC, unless it is mutually agreed by IPC and the creator that additional time is needed and an alternative deadline is established. The creator shall have the right to make recommendations pertaining to such determinations.

JMI, acting on behalf of the university, may decide to file for IP protection and/or commercialize IP for which the university has ownership rights on a case-by-case basis.

## **6.6 Notification and Granting Back Rights to the Creator(s)**

As a general rule, IP, and the corresponding IP rights, may be transferred back to the creator(s) if JMI and the university do not wish to pursue protection or other use. The creator can request that the rights be released to them. In the event ownership is released to the creator(s), as a condition of the transfer, JMU shall be granted a non-exclusive, fully paid-up, royalty free license



to use the IP for internal teaching and research purposes. Any request to release the IP rights by the creator(s) should be communicated to the CLO in a timely manner to preserve the potential for IP protection. It is at the university's discretion to consent to such a request (if permissible under university policies, applicable law, sponsorship agreements or other contractual obligations).

### **6.7 Licensing and Royalty Distribution**

JMI is the university's designated entity to manage IP transactions, and to negotiate any license and/or royalty arrangement for IP. The university Finance Office is responsible for the collection, accounting, and investment of funds resulting from licensing and royalty arrangements.

Net revenue generated by the licensing and/or commercialization of university-owned IP (whether or not protected by patent and/or copyright) shall be allocated as outlined below:

Of the first \$100,000

- 20% to JMI
- 50% to creator
- 10% to creator's academic unit or department
- 20% for reinvestment in research and innovation at the university

Above \$100,000

- 20% to JMI
  - 40% to creator
  - 10% to creator's academic unit or department
  - 10% to creator's college or division
  - 20% for reinvestment in research and innovation at the university
- a. In the event of multiple creators, it is the responsibilities of the creators to provide written agreement to JMI outlining the distribution of the share of the aggregate income. Each share of the creator(s) will continue to be paid to the creator(s) even if the creator(s) leave the university. Upon death, each share of the creator(s) will become part of the estate of the creator(s). Creator(s) have the option of allowing the university to retain their personal share.
  - b. In the event that there are multiple assignees, the CLO shall work with all assignees to determine any licensing and/or commercialization opportunities and the disbursement of any income among the assignees. Any disbursements to assignees other than JMU will be subtracted before the distributions outlined herein.
  - c. For purposes of clarification, under all circumstances the university retains a non-exclusive license to use the IP for its own educational and administrative purposes, unless excluded by contract.

### **6.8 Appealing decision of the IPC**

Within 30 days of receiving a written decision from the chair of the IPC regarding the committee's determination of IP ownership, a creator may file an appeal with the IPC by writing to the chair of the IPC. The chair of the IPC must:

- a. Acknowledge receipt of the appeal in writing
- b. Inform the IPC of the appeal
- c. Inform the IPO of the appeal
- d. Convene a meeting of the IPC to hear the appeal

- e. Invite the creator to attend that IPC meeting
- f. Invite the creator to submit additional evidence to the IPC regarding the dispute; this may take the form of oral evidence presented to the IPC in the meeting and/or additional written evidence or documentation
- g. Communicate the IPC's determination to the creator, including a written statement explaining the committee's rationale for its decision in the appeal
- h. Advise the creator of their rights arising under Section 5.5

## **7. RESPONSIBILITIES**

The Vice President for Research, Economic Development, and Innovation is responsible for administering this Intellectual Property Policy, serving in their capacity as Intellectual Property Officer (IPO).

The designated CLO has the responsibility for the management of IP protection, helping with commercialization decisions as required, and the administration of applicable royalty and licensing arrangements associated with IP in which the university has a proprietary interest. A member of the CLO serves in an ex-officio role on the IPC.

James Madison Innovations (JMI), a non-profit corporation affiliated with the university, has been established and charged with the mission of protecting and utilizing IP for the benefit of the university. All IP assigned to the university shall be assigned from the university to JMI for operational management. The creators' inputs/suggestions to JMI are considered in licensing and commercialization decisions.

The Intellectual Property Committee (IPC) has the responsibility to determine ownership of university IP. The IPC members are appointed by the university president or delegate (or Intellectual Property Officer (IPO)).

All departments, offices and employees that generate, receive, or maintain public records under the terms of this policy are also responsible for compliance with Policy [1109](#) – Records Management.

## **8. SANCTIONS**

Failure to adhere to this policy may result in legal action by the university, including recovery of any benefit that would inure to the university and/or forfeiture by the creator of any net revenue that the university would otherwise be obligated to pay to the creator pursuant to this policy.

Failure to disclose IP is considered professional misconduct under the terms of JMU's Faculty Handbook and/or Classified Employee Handbook, and noncompliance under the terms of the JMU Student Handbook.

Sanctions will be commensurate with the severity and/or frequency of the offense and may include termination of employment.

## **9. EXCLUSIONS**

The university claims no interest in an invention or copyrightable work if the work is produced completely outside of the university and without substantial university resources. An example would be works resulting from pursuance of a hobby, not related to the university member's activities, and conducted off-campus.

## **10. INTERPRETATION**

The authority to interpret this policy rests with the president and is generally delegated to the Vice President for Research, Economic Development, and Innovation.

**Previous versions:** December 2002

**Approved by the president:** December 2024