

**UNCP Patent Policy (revised 2-24-2009)**

**1. Policy**

The University of North Carolina at Pembroke (UNCP) is dedicated to instruction, research, and extending knowledge to the public (public service). It is the policy of UNCP to carry out its scholarly work in an open and free atmosphere and to publish freely the results obtained. Research done primarily in anticipation of profit is incompatible with the aims of The University. The University recognizes, however, that patentable inventions sometimes arise in the course of research conducted by its employees and students using UNCP facilities. The Board of Governors of The University of North Carolina has determined that patenting and licensing of inventions resulting from the work of University personnel, including students, is consistent with the purposes and mission of the UNC constituent universities. The aim of the Patent Policy of UNCP is to promote the progress of science and the useful arts by utilizing the benefits of the patent system consistent with the purposes for which it was established by Article I, Section 8, of the Constitution of the United States:

“The Congress shall have power...To promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”

Patents provide a means to encourage the development and utilization of discoveries and inventions. This Policy has been established to ensure that those inventions in which UNCP has an interest will be utilized in a manner consistent with the public good through patents, licenses, or otherwise. UNCP is also aware of the value of patents in directing attention to individual accomplishment in science and engineering. Where possible, UNCP should make inventions resulting from its research available to industry and the public on a reasonable and effective basis, and at the same time, provide recognition to inventors. Patents, and their exploitation, however, represent only a small part of the benefits accruing to the public from the research program of UNCP.

A portion of the research conducted by UNCP is supported by government and a portion by private industry. Service to the public, including private industry, is an integral part of UNCP's mission. In agreements with private industry or other private organizations, UNCP must keep the interests of the general public in view. The rights and privileges set forth in cooperative agreements or contracts, with respect to patents developed as a result of research partly or wholly financed by private parties, must be fair and just to the inventor(s), the sponsor, and the public. Research should be undertaken by UNCP under support from private parties only if it is consistent with and complementary to UNCP's goals and responsibilities to the public.

## **2. Objectives**

The principal objectives of UNCP Patent Policy set forth herein are:

- 2.1. to provide appropriate incentive to creative intellectual effort by faculty, staff, students, and others associated with UNCP;
- 2.2. to establish principles for determining the interests of UNCP, inventors, and sponsors in regards to inventions and/or discoveries;
- 2.3. to enable UNCP to develop procedures by which the significance of inventions and/or discoveries may be determined and brought to the point of commercial utilization;
- 2.4. to provide the means for placing in the public realm the results of research, while safeguarding the interests of UNCP, inventor, and sponsor;;
- 2.5. to recognize the right of the inventor to financial benefits from the invention or discovery.

## **3. Coverage**

The UNCP Patent Policy applies to all UNCP employees, both full and part time, including faculty, other professionals exempt from the Personnel Act (EPA), staff subject to the Personnel Act (SPA), and students. Upon prior written agreement between other persons and the UNCP chancellor (or his/her designate), this Patent Policy may be applied to persons not associated with UNCP whom make their inventions available to UNCP under circumstances where the further development

and refinement of the inventions are compatible with the research programs of UNCP.

#### **4. Patent Ownership**

- 4.1. Condition of Employment and Enrollment - The Patent Policy of UNCP, as amended from time to time, shall be deemed to be part of the conditions of employment of every employee of UNCP, including student employees, and of the conditions of enrollment and attendance of every student.
- 4.2. Ownership - With the exception of "Inventions made on Own Time," hereinafter defined, every invention or discovery or part thereof that results from research or other activities carried out at UNCP, or that is developed with the aid of the UNCP's facilities, staff, or through funds administered by UNCP, shall be the property of UNCP and, as a condition of employment or enrollment and attendance, shall be assigned by the UNCP inventor to UNCP in a manner determined by UNCP in accordance with this Patent Policy.
- 4.3. Patent Application - Patents on inventions made by UNCP employees or students may be applied for in any country by UNCP or through an authorized agent(s) or assignee(s). UNCP shall exercise its rights of ownership of such patent(s), with or without financial gain, with due regard for the public interest, as well as the interests of inventors and sponsors concerned.
- 4.4. Inventions Made on Own Time - Inventions or discoveries made by UNCP personnel or students entirely on their personal time and not involving the use of University facilities or materials are the property of the inventor except in case of conflict with any applicable agreement between the institution and the Federal or State government or agency thereof. For purposes of this provision, an individual's "personal time" shall mean time other than that devoted to normal or assigned functions in teaching, extension, University service, or direction or conduct of research on UNCP premises or utilizing University facilities. The term "University facilities" shall mean any facility, including equipment and material, available to the inventor as a direct result of the inventor's affiliation with the University, and which would not be available to a

non-University individual on the same basis. Personnel or students who claim that inventions are made on personal time have the responsibility to demonstrate that inventions so claimed are invented on personal time. All such inventions shall be disclosed in accordance with UNCP's disclosure (see applicable invention disclosure form) procedures applicable to inventions made on University time or with the use of University facilities, materials, or equipment, and shall demonstrate the basis of the inventor's claim that only personal time was utilized. In each instance, the chancellor (or his/her designate) shall acknowledge in writing that the invention is the sole property of the inventor in accordance with the "waiver" provision, below. If the inventor so desires, inventions or discoveries made on personal time and utilizing the inventor's own facilities and materials may be assigned to the institution. Under this arrangement, the procedures will be the same as for inventions or discoveries made by University personnel on University time and/or with the use of University facilities and materials.

- 4.5. "University time" versus "Personal time." - The time of day or week when work was done is much less important than whether or not "exceptional" university resources were used. In the absence of exceptional resource use, then an invention or other form of intellectual property is generally believed to be owned in whole or part by the UNCP member. Exceptional resources are any resources not generally available to UNCP members as the inventor.

**"Exceptional use of institutional resources"** means utilizing resources not routinely made available to UNCP employees in a given area. **Exceptional use** does not normally include routine use of University personnel, office space, laboratories, computer hardware and software, libraries, telephones, and information resources in a manner that (a) does not interfere with or delay use for University business purposes, and (b) does not result in substantial direct costs to the University. The following are some examples of situations that are presumed to be exceptional use:

- 4.5.1. waiver of fees normally required to use specialized University facilities (e.g., equipment, production facilities, service laboratories, special

computing resources, studios) where those facilities are used in creation of the work;

- 4.5.2. UNCP grants or gifts in support of the work's creation;
- 4.5.3. reduction in levels of teaching, service or other University employment responsibilities (e.g., course load, student advising, division/department meetings, office hours, administrative tasks) granted solely for the purpose of facilitating creation of a specified work or works;
- 4.5.4. use of University personnel, laboratory space, equipment, or supplies not routinely made available to other employees.

However to avoid and/or minimize any conflict in ownership, the inventor should follow the “Guide for Record-Keeping for Patents” in section 15 of this Patent Policy.

- 4.6. Waiver and Release of University Rights - Pursuant to these Policies and to its patent procedures, after consultation with the inventor, shall cause its rights to subsequent patents, if any, to be waived to the inventor if the UNCP Intellectual Property Committee (IPC) is convinced that no UNCP facilities, time, or materials were used in the development of the discovery or invention, that it was made on personal time, and that such waiver would not conflict with any pertinent agreement between UNCP and a sponsoring agency or agencies. Pursuant to this Patent Policy, after consultation with the inventor, may at its discretion and upon such terms as it deems appropriate, cause its rights to the discovery or invention, if any, to be released and waived to the inventor if the IPC is convinced that the discovery or invention is clearly one that is non-patentable, that it does not warrant further evaluation as to patentability, or if the discovery or invention has been returned to UNCP after negative evaluation by the Office Of Technology Transfer (OTT).

## **5. Income from Patents and Revenue Sharing Formula**

- 5.1. **Gross Revenue** means all income actually received by UNCP as consideration for the licensing, optioning, or other transfer of rights to inventions that are subject to the University's Patent Policy less any amount required to be paid from gross receipts without deduction to another entity pursuant to a sponsored research agreement, inter-institutional agreement or other legally binding agreement. Gross Revenue includes, but is not limited to, option fees, royalties, license issue fees (whether cash or equity when liquidated), and milestone payments.
- 5.2. **Net Revenue** means Gross Revenue minus all direct out-of-pocket costs associated with UNCP's ownership and/or administration of inventions, including but not limited to the costs of:
- 5.2.1. evaluating invention disclosures;
  - 5.2.2. patentability or trademark searches;
  - 5.2.3. drafting and prosecuting intellectual property applications;
  - 5.2.4. preparing and recording assignments;
  - 5.2.5. maintaining patents or other intellectual property;
  - 5.2.6. marketing and licensing of inventions;
  - 5.2.7. litigation for the enforcement or protection of intellectual property, for royalty collection, or for any other claim filed by or for against UNCP and related to UNCP's administration of intellectual property, including prosecution or defense of same, attorneys' fees, court costs, compromise, settlement, and judgment satisfaction.
- 5.3. Any income from licensing activity that is received in the form of support (in cash or in kind or otherwise) for research or any other form of sponsored research is not part of the Gross or Net Revenue.
- 5.4. Net Revenue shall be distributed as follows:
- 5.4.1. 50% to the Inventor/s
  - 5.4.2. 3% to the College/school (to be used for future research)
  - 5.4.3. 7% to the Department/Unit (to be used for future research)
  - 5.4.4. 40% to UNCP's research royalty fund, which is managed by the IPC.

- 5.5. Where there are two or more co-inventors associated with an invention, the applicable percentage of net revenue is divided equally among all co-inventors, unless all co-inventors, prior to the distribution of shared revenue, establish in writing a signed agreement by which all inventors agree to an alternative share of royalties.
- 5.6. In the event that an inventor declines or is unable for any reason to accept the inventor's share of a royalty distribution, that share shall be distributed equally among any other inventors.
- 5.7. The OTT will distribute net revenue on a quarterly basis (January 31, April 30, July 31, and October 31). The Executive Director of the OTT will inform inventors of any exceptional circumstances that may cause a delay of distribution.

## **6. Specific Conditions Governing Sponsored Research**

- 6.1. Government Sponsored Research - Patents on inventions arising from research financed by the United States Government or any other government agency may be controlled by the terms of the grants and contracts specified by the government agency pursuant to Federal Law or any other government agency. In some cases, the government claims rights to patents resulting from research financed under contracts supported by government agencies. Except as provided by Federal law or by government-supported grants or contracts, or when no patent rights are claimed by the United States Government, or when such rights are waived by the government, patents arising from government sponsored research are controlled by this Patent Policy. When a patent arising out of research supported under government grants or contracts is owned by UNCP, UNCP will, if requested, agree to a non-exclusive royalty-free license for use by the government of such patent. If such a patent is owned by the government, UNCP shall be free to use the invention so covered for its own scientific and educational purposes without payment of royalty or other charge, consistent with Federal Law or any other government agency.

6.2. University Research Sponsored by Non-Governmental Entities - UNCP must ensure that its facilities and the results of the work of its employees are applied in a manner which best serves the interests of the public. Likewise, the legitimate interests of a private sponsor who provides financial or other support to research carried out through UNCP must be considered. UNCP should normally reserve the right to ownership of patents on inventions arising out of research supported in whole or in part of grants or contracts with nongovernmental organizations or firms. Contracts or agreements which are entered into between UNCP and such organizations or agencies should contain clauses setting forth such a reservation unless deviations are requested by the sponsor and approved by the Chancellor or his/her designate consistent with the public interest. In the interest of fair treatment to the sponsor in consideration for the sponsor's investment and in the interest of discharging UNCP's obligation to the public in the application of its facilities and its employees' time and talent, special provisions may be negotiated by UNCP in such non-government sponsored contracts, upon request, provided that UNCP retains the right to use the invention for its own research, educational, and service purposes without payments of royalty fees, that UNCP requires the sponsor to use due diligence in the commercial use of the invention, and that UNCP retains the right freely to publish the results of its research after a reasonable period necessary to protect the right of the parties and to allow for the filing of a patent application.

## **7. Publication**

A major function of UNCP is the advancement and dissemination of knowledge. Any practice that unnecessarily restricts the publication of results of scientific work is to be avoided. However, it is recognized that the full development of useful inventions or discoveries may be dependent upon the securing of patent protection that will enable the commercial utilization of the discoveries or inventions. Accordingly, under certain circumstances it may be necessary to delay for a minimum period the publication of results of research. If a sponsor proposes to support a research effort that will involve a limited exclusive license to use of patents resulting from the

agreement with respect to publication shall include the following. First, the sponsor must agree that the results of the research may be published if desired by the investigators or research workers. Second, in order that patent applications are not jeopardized, OTT, the investigators, and research workers may agree that any proposed publication will be submitted to the sponsor with a notice of intent to submit for publication. If within a period of no more than 90 days from the date of such notice the sponsor fails to request a delay, the investigators, research workers, and OTT shall be free to proceed immediately with the publication. However, if the sponsor notifies the institution that a delay is desired, the submission of the manuscript to the publisher shall be withheld for the period requested, but in no event shall the total period of delay be longer than one year from the date of the notice of intent to submit for publication mentioned above. Such a period will permit the sponsor to have the necessary patent applications prepared and filed but will not unduly restrict the dissemination of scientific knowledge.

## **8. Avoidance of Conflicts**

8.1. Conflicts involving patentable inventions and discoveries may arise when UNCP personnel, including students, enter into personal consulting agreements with outside firms and organizations. The agreements that business firms wish to have executed by those who are to serve as their consultants frequently contain provisions as to the licensing or assignment of the consultant's inventions and patents. Unless such provisions are narrowly worded, they usually will apply to areas in which the individual's University work lies and thus come into conflict with the obligations owed by the individual to the University under this Patent Policy, either with respect to the rights of UNCP itself in an invention or with respect to the rights of a sponsor of research in the same field or subject matter. Prior to signing any consulting agreement that deals with patent rights, trade secrets, or the like, where any UNCP time, facilities, materials or other resources are involved, UNCP personnel and students must bring the proposed agreement to the attention of the OTT accordance with its Patent Policy and either obtain a waiver of UNCP

rights from the IPC or otherwise modify the consulting agreement to confirm with this Patent Policy, as is determined by UNCP in its discretion. The foregoing requirements are in addition to, and do not eliminate the necessity for, any approval which may be required by the UNCP policy on “External Professional Activity of Faculty and Other Professional Staff”.

- 8.2. The Staff Handbook covers SPA employees. It is available on the HR website at <http://www.uncp.edu/hr/policies/> and states “Dual Employment occurs when one State agency or University desires the services of an employee of another State agency on a part-time, consulting, or contractual basis. Generally, one cannot be additionally “employed” by another University department or by another State agency as a staff employee. Such Dual Employment is permitted only in certain circumstances and only with the advance approval by the two departments or agencies involved and the Director of Human Resources.”

## **9. Duty to Disclose Discoveries and Inventions**

All individuals whose discoveries and inventions are covered by this Patent Policy have a duty to disclose their discoveries and inventions promptly to the OTT in accordance with the Patent Policy adopted by UNCP. The duty to disclose arises as soon as the individual has reason to believe, based on his or her own knowledge, or upon information supplied by others, that the discovery or invention may be patentable. Certainty about patentability is not required before a disclosure is made. Individuals shall execute such declarations, assignments, or other documents as may be necessary in the course of invention evaluation, patent prosecution, or protection of patent rights, to insure that title in such inventions shall be held by UNCP, where this Patent Policy indicate the institution shall hold title, or by such other parties as may be appropriate under the circumstances.

## **10. Intellectual Property Committee**

The Chancellor of UNCP shall appoint an Intellectual Property Committee (IPC), consisting of no less than seven (7) members on a three (3) year staggered term. One of whom shall be designated by the Chancellor to serve as the chairperson.

Four of the members will be: the Executive Director of the OTT; Director of Business Services; Chair of the faculty senate; and the Provost (or his/her designate). The IPC will meet regularly and review the reports of its members. The inventor shall be allowed to examine materials submitted to the IPC in connection with his/her disclosure and may make a written and oral presentation to the IPC if the IPC finds that such a presentation would be useful. The IPC will advise on a disposition of the invention to secure the interests of the University, the inventor, the sponsor (if any) and the public. The IPC shall:

- 10.1. Recommend to the Chancellor the expenditure of the research royalty fund; and shall make such recommendations as are deemed appropriate to encourage disclosure and assure prompt and expeditious handling, evaluation, and prosecution of patent opportunities.
- 10.2. Review and recommend to the Chancellor (or his delegate) the procedures for the implementation of this Patent Policy;
- 10.3. Resolve questions of invention ownership that may arise between the institution and its faculty, staff, or students or among individuals;
- 10.4. Typically copyright is a matter of arrangement between the creator and his publishers and licensees. The IPC shall review and recommend to the Chancellor (or his delegate) the distribution of copyright royalties, if any. Different treatment may be accorded UNCP in case of specific contracts providing for an exception, in cases where UNCP or sponsor may employ personnel for the purpose of producing a specific work, where different treatment is deemed necessary to reflect the contribution of UNCP to the work, as in the case of software or audiovisual material, or where a sponsored agreement requires otherwise.
- 10.5. Review and recommend to the Chancellor service-marks and trademarks, which are the result of UNCP research and inventions. They are the property of UNCP. Without express authorization from the IPC no steps shall be taken for securing trademarks or service marks by usage or registration with respect to products resulting from or arising out of research or other activities carried out at UNCP or developed with the aid of its facilities or staff, or produced

through funds administered by UNCP. UNCP is authorized to register such marks as are deemed to be appropriate and to license the use of such marks, provided that the income from such licensing shall be used to support the research and educational programs of UNCP and not accrue to the personal benefit of UNCP personnel.

- 10.6. Review and recommend to the Chancellor the use of trade secret agreements to protect discoveries and inventions developed at UNCP. The IPC is also responsible for protecting the free dissemination of work produced by students, faculty, and/or staff.

## **11. Office of Technology Transfer**

The OTT has responsibility for managing activities instrumental to determining and fostering the marketability of an invention including obtaining legal and industry counsel, engaging marketing and focus research, contracting for the development of prototypes, and all else necessary to comprehensively and optimally market inventions under its sphere of control. When an inventor makes an invention, it is his/her responsibility to discuss the invention with his/her Department Head, and the disclosure of the invention must be sent to the OTT, which will administer the disclosure. Students will first discuss an invention with their faculty mentor, who will assist them in further discussion within the OTT. A case manager is available in the OTT to answer questions and to assist faculty, staff, and students in the preparation of disclosures. If an employee of UNCP makes an invention through collaboration with other researchers outside of UNCP, that employee will promptly disclose the invention to THE OTT in accordance with this Patent Policy. The inventor will inform the employee(s)' Department Head(s), Vice Chancellor, and/or the Dean of his/her College(s) about the disclosure. Upon receiving a disclosure, the Executive Director and/or case manager of the OTT will:

- 11.1. Submit the disclosure for review by a case manager, firm, or external agent and enter into confidentiality agreements as required;
- 11.2. Make inquiries of potential licensees that may have an interest in the invention, including the financial support of a patent application, where applicable;

- 11.3. Conduct a search of published and public databases to evaluate the novelty and utility of the invention;
- 11.4. Refer the disclosure to the IPC. The IPC members will be asked to review the disclosure from the point of view of whether or not, based on their knowledge, they believe the invention, would be most effectively made available for broad public use and dissemination by commercialization or under a cooperative agreement with a commercial or non-commercial partner.
- 11.5. Authorize the filing of patent applications based on the disclosure, as deemed necessary by the IPC, subject to the availability of funds. Potential funding sources include, but are not limited to UNCP's research royalty fund; a sponsor under the terms of a sponsored research agreement; or a potential licensee of the subject invention;
- 11.6. Report any such authorization to file patent applications at the next scheduled meeting of the IPC;
- 11.7. Notify the inventor in writing of the decision of the University concerning:
  - 11.7.1. costs and/or potential revenue of the invention,
  - 11.7.2. whether UNCP plans to file a patent application,
  - 11.7.3. whether UNCP will accept the invention for management.
- 11.8. Recommend where appropriate and upon written request of the inventor(s) and at the Chancellor's (or his/her designate) discretion, the invention may be released to the inventor(s) if the Chancellor (or his/her designate) decides that it will do none of the following:
  - 11.8.1. file a patent application for an invention in which it has rights,
  - 11.8.2. license the invention.
- 11.9. When the invention is released by UNCP to the inventor, then:
  - 11.9.1. release of ownership to the inventor will be subject to obtaining the permission of the sponsor of the research that resulted in the invention, if any. To the extent it is reasonably able, the OTT will inform the inventors within one hundred and twenty (120) days of receipt of the invention disclosure (or a mutually agreeable extended time period) regarding UNCP's decision as to disposition of the invention. Federal

Government regulations require that any invention arising out of federally sponsored research must be offered to the sponsoring agency before offering rights to the inventor(s).

- 11.9.2. the inventor(s) may not conduct any commercial research or development on that invention at UNCP or using UNCP resources. Commercial research or development includes, but is not limited to, research sponsored by a commercial entity, research obligated to a commercial entity, and/or research on behalf of a commercial entity. However, inventors may continue to use the released invention for non-commercial research, educational, or teaching purposes of UNCP. New invention(s) resulting from any such research, educational, or teaching uses of the released invention must be disclosed to UNCP in accordance with this Patent Policy. Potential conflicts of interest that may arise from an inventor's use of the released invention(s) must be promptly disclosed by the inventor(s) to the Executive Director of the OTT.
- 11.9.3. in those cases in which UNCP is managing an invention without obligation to any sponsors, the OTT will notify the inventors of any decision to cease its efforts to commercialize the invention, thus permitting the inventors to request the release of UNCP's rights in the invention. If no arrangement for commercial development of the invention has been made within three years from the date of the issuance of the patent, UNCP ordinarily will not continue to support the costs of any patent or patent application based on the invention. The OTT will inform the IPC of this decision, and unless the IPC recommends otherwise, will, before allowing any patent rights to lapse, offer rights in the invention to the inventor(s) in an agreement. Inventors may, prior to the three year post-issuance deadline, request in writing an assignment of the UNCP's rights in an invention on which the inventor is named and for which the UNCP has not made arrangements for commercial development. The IPC will promptly

either grant the request or advise the inventor of the University's plans for the development of the invention. The OTT, with the concurrence of the IPC, may elect to continue supporting the cost of developing an invention beyond the three years post-issuance deadline, subject to availability of funds, and provided the OTT and the IPC believe that such action may ultimately result in identifying a commercialization path for the invention.

## **12. Procedure**

The UNCP Patent Policy shall be reviewed by the IPC, Provost, and Faculty Senate and approved by the Chancellor (or his/her designate), and the Chancellor's Executive Staff, prior to approval by the UNCP Board of Trustees. As adopted by the Board of Trustees of UNCP, the implementation of this Patent Policy, takes into account the nature and scope of UNCP's research programs.

## **13. Exceptions**

Exceptions to the above Patent Policy are authorized if approved by the Chancellor or his/her designate following a favorable review and recommendation from the UNCP IPC. Before approving an exception, the Chancellor must determine that, on the basis of the evidence available, such exception is in the public interest and is consistent with the University's responsibilities to the public.

## **14. Definitions**

- 14.1. Intellectual property - Creations of the mind - creative works or ideas embodied in a form that can be shared or can enable others to recreate, emulate, or manufacture them. There are four ways to protect intellectual property - patents, trademarks, copyrights, or trade secrets
- 14.2. Patent - a property right granted by the Government of the United States of America to an inventor "to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention

into the United States” for a limited time in exchange for public disclosure of the invention when the patent is granted.

- 14.3. "University time" versus "Personal time." - The time of day or week when work was done is much less important than whether or not "exceptional" university resources were used. In the absence of exceptional resource use, then an invention or other form of intellectual property is generally believed to be owned in whole or part by the UNCP member. Exceptional resources are any resources not generally available to UNCP members as the inventor. **"Exceptional use of institutional resources"** means utilizing resources not routinely made available to UNCP employees in a given area. **Exceptional use** does not normally include routine use of University personnel, office space, laboratories, computer hardware and software, libraries, telephones, and information resources in a manner that (a) does not interfere with or delay use for University business purposes, and (b) does not result in substantial direct costs to the University. The following are some examples of situations that are presumed to be exceptional use:
- 14.3.1. waiver of fees normally required to use specialized University facilities (e.g., equipment, production facilities, service laboratories, special computing resources, studios) where those facilities are used in creation of the work;
  - 14.3.2. UNCP grants or gifts in support of the work's creation;
  - 14.3.3. reduction in levels of teaching, service or other University employment responsibilities (e.g., course load, student advising, division/department meetings, office hours, administrative tasks) granted solely for the purpose of facilitating creation of a specified work or works;
  - 14.3.4. use of University personnel, laboratory space, equipment, or supplies not routinely made available to other employees.

However to avoid and/or minimize any conflict in ownership, the inventor should follow the "Guide for Record-Keeping for Patents" in section 15 of this

Patent Policy.

## **15. Guidelines for Record-Keeping for Patents**

U. S. patent law places a premium on witnessed records when two or more parties claim the same invention. The date the idea occurred (the "conception") and the date it was put into practicable form ("reduced to practice") are vital. Equally important in the eyes of the U. S. Patent Office is the "diligence" shown by contending inventors. They must prove that they regularly and consistently pursued work on the invention, documenting their efforts on a day-to-day basis. The intent of U. S. patent law is to recognize the inventor(s) who first conceived the invention. The careful recording of ideas and laboratory data is generally a matter of routine for industrial researchers. Each entry is complete and up-to-date, signed and witnessed. This comprises a legal record of the day's work. Record-keeping is not traditionally so routine for the academic investigator, for he or she may work at odd hours or on weekends; may be in a laboratory, an office or at home; and often lacks easy accessibility to suitable witnesses. Still, the keeping of a witnessed laboratory notebook is critical. Additionally, such records can serve as valuable repositories of new ideas. As far as is reasonably practical, faculty, staff, and students are strongly advised to follow the "Guidelines for Record-Keeping".

- 15.1. Good practice is to use bound notebooks for records, making entries on a daily basis. This "diary" format provides among other things, a day-to-day chronology.
- 15.2. Use the notebook to record a conception (a complete description of an idea to accomplish a particular purpose or result) laboratory data, and drawings. Each entry should be headed with a title and continued on successive pages.
- 15.3. Make entries in ink and do not erase or use correction fluid to cover errors. Draw a line through text or drawings to be deleted, and enter the material in corrected form. Draw a line through blank spaces on the page.
- 15.4. Separate sheets and photographs pasted to notebook pages should be referred to in an entry. Material that cannot be incorporated in the notebook should be keyed to an entry.

15.5. Sign and date all entries at the time they are made, and have them witnessed.

A witness must be someone who has read the material and is capable of understanding it, yet has nothing to do with producing it. Secure additional witnesses when something important or highly unusual is discovered.

Remember that an inventor and his or her potential co-inventors cannot serve as their own witnesses.

15.6. Set aside a time for making notebook entries and faithfully observe it. Arrange to have two or more colleagues serve as witnesses on a consistent, frequent basis.

## **16. Applicable Forms**

16.1. UNCP INVENTION DISCLOSURE FORM (see Appendix A)

**APPENDIX A  
UNCP INVENTION DISCLOSURE FORM**

**CONFIDENTIAL** (UNCP Office of Technology Transfer Use Only)

UNCP File No. \_\_\_\_\_

Law Firm File No. \_\_\_\_\_

**RESPONSES ARE REQUIRED IN ALL FIELDS**

***This form must be signed by the Department Head or Manager and/or the College Dean/Associate Dean prior to submission to the OTT.***

**Inventor's Name (Primary Point of Contact):**

\_\_\_\_\_  
Title: \_\_\_\_\_ Citizenship: \_\_\_\_\_  
Campus Address: \_\_\_\_\_ Department: \_\_\_\_\_  
Telephone: \_\_\_\_\_  
Email: \_\_\_\_\_

Permanent Address: \_\_\_\_\_  
\_\_\_\_\_  
City: \_\_\_\_\_ State: \_\_\_\_\_ Telephone: \_\_\_\_\_  
Country: \_\_\_\_\_

**Inventor's Name:** \_\_\_\_\_ Citizenship: \_\_\_\_\_  
Title: \_\_\_\_\_ Department: \_\_\_\_\_  
Campus Address: \_\_\_\_\_ Telephone: \_\_\_\_\_  
Email: \_\_\_\_\_

Permanent Address: \_\_\_\_\_  
\_\_\_\_\_  
City: \_\_\_\_\_ State: \_\_\_\_\_ Telephone: \_\_\_\_\_  
Country: \_\_\_\_\_

**Inventor's Name:** \_\_\_\_\_ Citizenship: \_\_\_\_\_  
Title: \_\_\_\_\_ Department: \_\_\_\_\_  
Campus Address: \_\_\_\_\_ Telephone: \_\_\_\_\_  
Email: \_\_\_\_\_

Permanent Address: \_\_\_\_\_  
\_\_\_\_\_  
City: \_\_\_\_\_ State: \_\_\_\_\_ Telephone: \_\_\_\_\_  
Country: \_\_\_\_\_

1. Title of Invention: \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

2. Date Invention Conceived (Conception Date): \_\_\_\_\_

3. Has the Invention been reduced to practice?  Yes  No

4. Supporting Data Notebook No. \_\_\_\_\_  
Pages \_\_\_\_\_

5. Has the Invention been published:  
(Note: Publications may include posters, abstracts, funded grants, grant applications, manuscripts, theses, research reports to funding agencies, seminars, press releases, interviews, etc.)  
Orally:  Yes  No In writing  Yes  No  
If Yes, please explain below;  
a. When: \_\_\_\_\_  
b. Authors: \_\_\_\_\_  
c. Any changes in the Invention since public disclosure (please attach copies of any publications, if available): \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

6. Check all boxes that apply to the category of this invention:  
 New Process  New Product  New Composition of Matter  New Device  
 Improvement to an Existing Process/Product  New Use for an Existing Process/Product

7. **PLEASE DESCRIBE THE INVENTION IN DETAIL.** Attach additional pages as needed. Description must be complete and detailed to permit technical and/or patentability evaluation.  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

*(Insert additional sheets to elaborate or attach descriptive material. Mark all attached materials "CONFIDENTIAL")*

**THIS IS A DRAFT AND NOT AN APPROVED FINAL COPY**

8 Write a brief descriptive abstract of your Invention without making an enabling disclosure, or revealing confidential information. This will be used for marketing purposes. (This is not meant to substitute for the detailed description to be provided in #7.) \_\_\_\_\_

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9 Provide at least five (5) keywords that can be used in our internal database to track this technology by its field and/or applications. \_\_\_\_\_

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10 From the description in number 7, pick out and expand on novel and unusual features. How does the Invention differ from present technology? What problems does it solve or what advantages does it possess? \_\_\_\_\_

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11 If not indicated previously, what are possible uses for the Invention? In addition to immediate applications are there other uses that might be realized in the future? \_\_\_\_\_

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12 What are the disadvantages or limitations of the technology? Can they be overcome? How? \_\_\_\_\_

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13 Enclose sketches, drawings, photographs and other materials that help illustrate the description (Rough artwork, flow sheets, Polaroid photographs and penciled graphs are satisfactory as long as they tell a clear and understandable story.)

14 Is a publication or oral disclosure descriptive of the Invention planned within the next six months? (This includes dissertations and presentations to anybody outside of UNCP).

Yes  No

If yes, please give the date (estimate, if known) and attach copies of any existing manuscripts, preprints, abstracts, or poster material. \_\_\_\_\_

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15 Is there urgency in making a patent application?

Yes  No

If yes, please describe and estimate the likelihood that similar technology may be developed elsewhere. \_\_\_\_\_

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16 Have any students and/or other technicians been involved in this research?

Yes  No

If yes, should the individual(s) be included as a co-inventor? \_\_\_\_\_

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17 Has the Invention been tested experimentally?

Yes  No

18 Are experimental data or prototypes available?

Yes  No

19 Are there prior inventions or patents by the inventor(s) on this subject?

Yes  No

If yes, give the serial number(s) and the filing date(s). \_\_\_\_\_

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20 Are there inventions or patents by other researchers known to the inventor(s) on this subject?

Yes  No

If yes, please describe two (2) or three (3) closely related inventions, including information on relevant patents and publications, if available. \_\_\_\_\_

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21 What source(s) of funding was/were used to develop the Invention and was the Invention sponsored by industry or funded by State Federal appropriations? If so, attach a copy of the contract or agreement and fill in any applicable appropriate blanks below. One of the below MUST be completed. (This includes the source(s) of funds for the salary of each inventor.)

a. Complete Name of Government Agency: \_\_\_\_\_

i. Contract or Grant No. \_\_\_\_\_

b. Name of Industrial Company: \_\_\_\_\_

c. Name of Private Sponsor: \_\_\_\_\_

d. State or Federal Appropriation: \_\_\_\_\_

22 Please list all relevant UNCP Account Numbers: \_\_\_\_\_

23 Please list any companies that have been contacted or should be contacted about licensing and commercializing the invention:

a. Company Name: \_\_\_\_\_

b. Contact Information: \_\_\_\_\_

24 Please check all that apply:

- a. Contacted about the technology – only provided non-confidential information
- b. Disclosed information about this invention under Confidentiality Agreement
- c. Company was not contacted, but inventors feel that the company might be interested
- d. Disclosed confidential information to the company without signing a Confidentiality Agreement

25 Has the Invention been disclosed to industry representatives?

Yes  No

26 Has any commercial interest been shown in it?

27  Yes  No

If Yes, please name companies; listing specific individuals and their titles if you know them.

28 If known, list any manufacturers making comparable equipment or products.

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29 How much do you estimate your Invention will cost to make? \_\_\_\_\_

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30 Have any materials or confidential information belonging to another institution or company been used in the conception or development of the invention? (e.g. have materials been received from colleagues at UNCP or at another institution; have you received a request to sign a Material Transfer Agreement, etc.)

Yes  No

If Yes, please include the following:

Description of Material or Information: \_\_\_\_\_

Company or University providing the Material or Information: \_\_\_\_\_

31 If response to Question (30) was yes, has a Material Transfer Agreement/ Confidentiality Agreement (or License, Purchase or any other Agreement) been signed?

Yes  No

If Yes, please list all Agreements that apply

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## **Invention Disclosure Form – Final Checklist**

- 1 Have all potential inventors been listed on the first page(s) of the form? Please note that inventorship differs greatly from authorship. Inventorship is determined by U.S. Patent Law and may apply to anyone who contributed to the conception of the invention as described in the disclosure, including refinements or improvements that were essential to the success of the invention. Any employee (including technicians) or student (graduate and undergraduate) can be an inventor – inventorship is NOT limited to faculty or to EPA employees.
- 2 Have all of the inventors signed the disclosure in blue ink on the last page of the form?
- 3 Have the appropriate department head(s) and dean(s) also signed the disclosure in blue ink?
- 4 Has a funding source(s) been indicated? At least one funding source MUST be indicated. If nothing else, the source of funds for the inventor's salary should be listed. If the research was funded by a federal agency, even if the research is outside the scope of the relevant grant proposal, that federal funding MUST be indicated.
- 5 Have the relevant UNCP account numbers been provided for the funding source(s)?
- 6 Has the invention been described in sufficient detail to allow a technical review by the OTT and IPC?
- 7 Have there been public disclosures of this invention more than one year prior to the date the invention disclosure form was submitted?
- 8 Has every question on the invention disclosure form been answered? Please note that responses to all questions are required. If the answer is not known or is not applicable, please indicate that on the form.
- 9 Have all additional pages attached to the disclosure been marked "Confidential"?
- 10 Inventors should check "yes" if they've received materials from colleagues at this institution (especially if they are not listed as inventors on page 1 of the form) or from another institution which were used in the conception or reduction to practice of the invention. They should also check "yes" if they have received a request to fill out a material transfer agreement from any organization (university or company).

**SIGNATURE OF INVENTOR(S)**

Signed: \_\_\_\_\_ Date: \_\_\_\_\_

Signed: \_\_\_\_\_ Date: \_\_\_\_\_

Signed: \_\_\_\_\_ Date: \_\_\_\_\_

Signed: \_\_\_\_\_ Date: \_\_\_\_\_

Signed: \_\_\_\_\_ Date: \_\_\_\_\_

**Disclosed and Understood by:** (These signatures indicate that the witness has reviewed the invention disclosure and understood the technical and innovative nature of the technology. These signatures provide additional support for the date of development of the invention.)

Signed: \_\_\_\_\_ Date: \_\_\_\_\_  
Name: \_\_\_\_\_  
Title: \_\_\_\_\_  
Department: \_\_\_\_\_

Signed: \_\_\_\_\_ Date: \_\_\_\_\_  
Name: \_\_\_\_\_  
Title: \_\_\_\_\_  
Department: \_\_\_\_\_

**Department Authorization:**

Signed: *Department Head/Center Director* \_\_\_\_\_ Date: \_\_\_\_\_

Signed: *College Dean/Associate Dean for Research* \_\_\_\_\_ Date: \_\_\_\_\_

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**Disclosures must be submitted with original signatures; Photocopied signatures will**

**1-1.A.1(a) Please fill and submit this data sheet ONLY if you are submitting a**

**CONFIDENTIAL**

UNCP File No. \_\_\_\_\_

**UNCP**  
**Office of Technology Transfer**  
Pembroke, NC 28372-1510  
PHONE 910-775-4209     FAX  
[www.uncp.edu/tfce](http://www.uncp.edu/tfce)

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**INVENTOR DATA SHEET**

Dr./Ms./Mr.  
Inventor's Name: \_\_\_\_\_  
(First, Middle, Last)

UNCP Employee? yes / no

Title: \_\_\_\_\_ Email: \_\_\_\_\_

Department: \_\_\_\_\_

Business/  
Campus Address: \_\_\_\_\_ Phone: ( ) \_\_\_\_\_  
\_\_\_\_\_  
FAX: ( ) \_\_\_\_\_  
\_\_\_\_\_

Mailing/  
Home Address: \_\_\_\_\_ Phone: ( ) \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

Citizenship: \_\_\_\_\_

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

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*Please note: In order to comply with the North Carolina Identity Theft Protection Act we will no longer ask for your SSN. Thus, please help us keep our records current by informing us if your contact information changes. Ensuring that we have your current information will assist us in the event that we need to distribute royalties to you.*