

Boston College
Intellectual Property

Introduction

Boston College, as an institution of higher learning, has two primary academic aims: to share existing knowledge with its students and to engage in research and scholarly activities. The products of scholarly and research efforts often have social and commercial implications. These products may, therefore, be of benefit to the individuals involved, to the University, and to society. This policy governs the protection and administration of intellectual property developed in support of the University's mission.

Boston College recognizes that commercially valuable intellectual properties may arise in the course of research and other activities conducted by employees and students using University resources and facilities. The purpose of this policy is to define the conditions of ownership, legal protection, development, and licensing of intellectual properties conceived or first reduced to practice by any Boston College employee or student. Under this policy, intellectual properties can be managed so as to further the University's mission, enhance the value of such properties, and maximize benefits to the University, inventors, authors, and the public.

This policy applies to all persons employed by Boston College and any person using Boston College facilities under the supervision or sponsorship of University personnel, including, but not limited to, visiting and adjunct faculty, and under certain conditions specified herein, students. All exceptions to the policy must be negotiated in advance and agreed to in writing by the Vice Provost for Research (VPR) or his or her designee.

Definitions

For purposes of this policy, the following definitions apply:

Author is a person who creates a work protected by copyright.

Copyright is a form of protection the law provides to the authors of "original works of authorship" for their intellectual works that are "fixed in any tangible medium of expression," both published and unpublished. Examples of works that are protected by copyright include books, periodicals, software, musical or dramatic works, pictorial or other artistic works, and audiovisual works. Copyright arises upon the creation of the work and includes a bundle of rights: the right to reproduce the work; the right to distribute copies of it; the right to prepare derivative works based on the work; and the right to make public performances or displays of the work.

Database is a collection of independent works, data or other materials arranged in a systematic or methodical way and individually accessible by electronic or other means.

Equity is rights of ownership in an enterprise, including shares of stock or securities, stock options, warrants, or any other rights to purchase stock or securities.

Equity Pool is the total allotment of equity negotiated by the University as consideration for a license of the University's interest in an invention.

Executive Committee consists of the General Counsel, Vice Provost for Research, Provost, Financial Vice President & Treasurer and the Executive Vice President or their designees. The committee provides oversight to OTTL, including periodic review of the progress of intellectual property development at the University, including invention disclosures, patent applications, and licensing activity, and approves any changes to this policy.

Intellectual Property is a creation of the mind or intellect, the ownership of which is recognized and protected by law. It includes any patentable invention, tangible research property, works protected by copyright, trademarks, trade secrets, works of art, and inventions or creations that might normally be developed on a proprietary basis.

Invention is a new or useful process or discovery, art, method, technique, product, machine, device manufacture, software, composition of matter, or improvement thereof that is subject to protection by patent.

Invention Disclosure Forms are forms that report and describe a new Invention, signed by the Inventor(s).

Inventor is any individual associated with the University who makes an Invention.

Licensing Costs are defined as all the administrative, marketing, patent, and legal costs relating to the Intellectual Property licensed.

Net Equity Income is the proceeds realized by the University from the dividends or sale of equity received by the University in a licensing agreement, net of Licensing Costs.

OTTL is the University Office for Technology Transfer and Licensing, which manages the disclosure, management, and commercialization of intellectual property under this policy.

Patent is a grant issued by the United States or a foreign patent office that gives an inventor, or the entity to whom the inventor has assigned ownership rights, the right to exclude others from making, using, or selling the invention within the country within which the patent is issued.

Proceeds are all compensation of whatever kind received from the sale, license, or other transfer of intellectual property rights by the University to a third party. This includes, but is not limited to, percentage payments, up-front fees, milestone payments, shares of stock, and any other financial or in-kind consideration.

Software includes mathematical codes, programs, instructions, routines, and other functions that control the functioning and operation of a computer or data processing system. Software may be protected by patent, copyright, or trade secret.

Sponsored Project Agreement (SPA) is a contract between the University and a sponsoring organization that sets the terms and conditions for the conduct of a faculty research or training project. An SPA typically includes a description of the work to be performed and the terms of payment, and stipulates the ownership of intellectual property, publication rights, and other legal assurances.

Substantial Resources include substantial University financial, staff, or other support, including the use of University facilities and resources to a greater extent than the norm typically used for educational and research purposes by similarly situated individuals in the department and/or school in which the Inventor or Author holds his or her primary appointment. The University generally will not regard academic year salary, office space, ordinary library resources, usual secretarial and administrative staff resources, or usual computer equipment as constituting Substantial Resources, unless these resources are made available specifically to support the development of specific materials to be used for University purposes.

Tangible Research Property (TRP) is comprised of research results in their tangible physical form, and includes, but is not limited to, biological organisms, compositions of matter, instruments, machines or devices, and other property that can be physically distributed. Tangible Research Property may also have intellectual property rights associated with it, for example, compositions of matter which are patented.

Trademark is a word, name, symbol, or design (or any combination) adopted by an organization to identify its goods and services and distinguish them from the goods and services of others.

University Research Council (URC) consists of faculty members appointed by the Vice Provost for Research and provides advice to the Vice Provost for Research and Provost on issues that affect research at the University. The URC (or an appointed sub-committee of the URC), in addition to other responsibilities stated in this policy, advises the VPR regarding (a) the interpretation of the terms of this policy; and (b) recommending changes or exceptions.

Work-for-hire is any intellectual property created by an individual for the use and ownership by the University and any works protected by copyright that are developed by an employee within the scope of his or her employment, except as provided otherwise under this policy with respect to certain works of faculty.

Patentable Inventions

This policy section addresses the ownership of Inventions; the assignment of rights associated with such ownership; the disclosure of Inventions; and the licensing of commercial rights in Inventions. Inventors working on projects funded by SPAs should be aware that the ownership of rights in an Invention may be affected by the terms of the SPAs.

Ownership of Inventions

1. All rights in any Invention that results from activities related to an individual's employment responsibilities or conducted with support, in whole or in part, from University-administered funds, facilities, or personnel, including student employees, shall be assigned to and owned by the University.
2. All rights in an Invention that results from activities unrelated to an individual's employment responsibilities and that is developed without University funds, resources, or facilities are owned by the Inventor.
3. Ownership of rights in an Invention developed in the course of, or resulting from, work supported, in whole or in part, by a grant or contract with a governmental entity or a nonprofit or for-profit nongovernmental entity, is determined in accordance with the terms of the grant or contract, which shall normally provide that the rights shall be owned by the University. In the absence of such terms, the rights shall be assigned to and owned by the University.

Disclosure, Assignment, and Protection

1. All faculty members, graduate students, and others working on SPA's, including, but not limited to, visiting scientists, visiting scholars and undergraduate students as applicable, must sign the University's Intellectual Property Agreement (IPA; [EXHIBIT B](#)). Faculty must assure that others working under his or her supervision, including students paid by project funds, sign the IPA so as to avoid disputes over ownership and control of Intellectual Property arising from a research project.
2. All Inventors must promptly disclose to OTTL any discovery, Invention, possible Invention, or potentially useful Tangible Research Property (TRP) the Inventor has conceived or reduced to practice and has reason to believe might be useful, patentable, or otherwise protectable. The disclosure is to be made using the University's Invention Disclosure Forms ([EXHIBIT A](#)), signed by all of the Inventors, and submitted to OTTL.
3. To protect and preserve the intellectual property rights defined in this policy, and to comply with federal regulations, Inventors must execute assignments and other appropriate documents as may be requested by OTTL, including an IPA if an Inventor does not have an IPA on file with University, to perfect the University's ownership and rights to Inventions.
4. OTTL is responsible for reviewing all Invention Disclosure Forms, evaluating their patentability and potential commercial value, and endeavoring in good faith to provide an interim report to the Inventor within 60 days. OTTL is to seek such internal or external advice and assistance as may be needed to conduct an appropriate evaluation of each disclosure.
5. The Vice Provost for Research (VPR) is responsible for determining whether the University should seek patent protection for an Invention. Such determinations are based on an assessment of the respective Invention's commercial value and other relevant factors, and are reported to the Executive Committee on a periodic basis. When the failure to patent is based solely upon lack of funds, any Dean or Director may commit discretionary funds to patent an Invention, and, should it be licensed, may recover the costs upon receipt of proceeds. No Inventor of University-owned Intellectual Property can require the University to have an Invention patented. However, an Inventor may seek patent protection of such property if the

University has waived its ownership rights, pursuant to this policy, and it is able to obtain, on behalf of the Inventor, any waivers that may be required from funding sponsors.

6. The right of employees to publish the results of research remains inviolate, subject only to the terms of a grant or SPA funding the work. However, any public disclosure of an Invention, such as a presentation, publication, or abstract, prior to filing a patent application, limits patent rights and reduces an Invention's commercial value. Therefore, employees must disclose their Inventions to the University by submitting an Invention Disclosure Form to OTTL as soon as the employee believes an Invention has been created and prior to sending out manuscripts, abstracts or other public disclosures. Inventors should contact OTTL prior to submission of a research proposal if they believe an Invention is described in the research proposal and OTTL will work with the Inventor to determine if a patent application needs to be submitted in cases in which the research proposal may result in a public disclosure.

Licensing and Commercialization

1. License agreements that grant to commercial entities the rights to develop Inventions commercially are encouraged. OTTL is responsible for negotiating such agreements on behalf of the University in coordination with Inventors, and within parameters established by, or otherwise with the approval of, the Executive Committee. Authority to execute license agreements conforming to this policy is hereby delegated by the President to the Director of OTTL.
2. Whenever practicable, Inventors are advised and consulted on the progress of license negotiations, but in no event do they have a right to approve such agreements, including any right to approve payment or other terms of such agreements.
3. Upon the award of a patent or the successful execution of a license, OTTL is responsible for notifying the VPR and the Dean(s) or department Chair(s) of the school or department of the Inventor(s).

Copyright

This policy section addresses copyright ownership; the assignment of rights associated with copyright ownership; the disclosure of copyright; and the licensing of commercial rights in works protected by copyright. Boston College encourages the preparation and publication of works protected by copyright that result from teaching, research, and scholarly and artistic endeavors by members of the faculty, staff, and student body. The University affirms the right of faculty members to retain primary control over these works in most cases. Exceptions to this general rule includes works created under the terms of SPAs, works created through the use of Substantial Resources by the University, and works constituting "Works-for-hire" as outlined below in this policy.

Ownership of Copyright

1. In keeping with academic tradition, except to the extent required by the terms of any grant or SPA, and except as otherwise provided in paragraphs 2 through 6 below, the University does not claim copyright ownership in pedagogical, scholarly, or artistic works. These works include, but are not limited to, textbooks, refereed literature, and scholarly works created by students in the course of their education, such as dissertations, theses, papers, and journal articles. Accordingly, works that are created as part of a faculty member's independent research or scholarship that are developed without Substantial Resources are not owned by the University. Furthermore, the University claims no copyright ownership in general nonfiction, novels, poems, musical compositions, or other works of artistic imagination that are developed without Substantial Resources.
2. The University owns the copyright in all Works-for-hire and in certain works, including Software, Databases and any other electronic media, that are created for a nonacademic institutional purpose. These include all works that are created in the course of employment by non-faculty staff and students employed by the University.
3. The University owns the copyright in any works created or developed through the use of Substantial Resources. These include any works to which there have been simultaneous or sequential contributions over time by numerous faculty, staff, or students.

4. Websites and course materials give rise to special considerations under this policy, particularly as the media and means of transmission of these materials continues to evolve. In many cases, websites and course materials, particularly those that are created with the assistance of University staff, including the Office of Instructional Design and eTeaching Services, will be owned by the University by virtue of the use of Substantial Resources in their development. Most web sites involve the efforts of multiple individuals at the University, are created for an institutional purpose, are created with funds administered by the University, or are created under the name of the University or a department or other unit, implying the approval and endorsement of the University. The copyright in these websites will normally be held by the University and the University copyright notice must be included on the site. In many cases, the copyright in individual content on a website may be retained by a faculty member under the provisions of paragraph 1 of this policy, but faculty members are encouraged to consult with the Provost with respect to ownership in any website content prior to using the content for non-University purposes.

The University has a vital interest in how course materials, including recordings of course lectures, are disseminated. Even in those situations in which Substantial Resources are not used or when an individual faculty member or a department has developed a course or participated in its development, the University has a significant interest in protecting its right to determine the method and manner in which its educational programs and courses are offered to the public. Prior to making any course materials available to the general public or to a third party for the purpose of making the material available outside the University, the faculty member or Dean of the applicable school shall disclose the plans to the Provost for the Provost's review and approval.

5. The creation of works protected by copyright, including courses, multi-media presentations, Databases and Software for other institutions or organizations may place Authors in a conflict of interest with their responsibilities to the University. Therefore, prior to reaching any agreements concerning the creation of such works for other institutions or organizations, Authors are to discuss each potential arrangement with the Provost.
6. The VPR is responsible for making all determinations of copyright ownership under this policy, including determining what constitutes Substantial Resources in any given case. Authors are encouraged to consult with the VPR in advance of creating any work in which the copyright may belong to the University under the terms of this policy, other than works created through employment that are clearly Works-for-hire. Wherever possible, the VPR and the Author shall arrive at an agreement with respect to copyright ownership in advance of the creation of the work. In arriving at such an agreement and in situations in which no written agreement exists, the VPR shall consider three factors in determining copyright ownership: (a) the creative initiative and/or purpose for the work; (b) control over the content and final approval; and (c) any resources or compensation provided by the University. Whether copyright in a work is held by the University depends upon the circumstances of its creation and its purpose rather than the form of the work's expression. In some cases, the VPR may determine that it is appropriate or necessary to require an Author to assign his or her rights in a work to the University. In the event that the University enters into any agreement with a third party under which royalties or other payments are paid as compensation for rights granted in a work created by a faculty member, the revenue-sharing provisions of this policy shall apply. In the event that an Author disagrees with the VPR's decision with respect to copyright ownership under this policy, the matter will be referred to the Provost for final resolution.

Authorship and Permissions

1. Collaborators on a work are joint Authors, as that term is defined under U.S. copyright law. Because joint ownership may create complex management problems and unintended results, it is recommended that the parties enter into agreements with each other to allocate rights and duties, including the proportional distribution of anticipated proceeds, prior to beginning the work.
2. All works in which the copyright is owned by the University must bear prominently the legend "© <year> Trustees of Boston College. All rights reserved."
3. Authors are responsible for securing all required permissions or licenses from third party copyright owners before reproducing, distributing, making a derivative work, or displaying works of those third parties, unless an exception under copyright exists. Authors must be aware that works that are publicly available on the Internet or elsewhere are protected by copyright. Authors must be prepared to document such

permissions or licenses in the event questions arise. Whether a particular use constitutes "fair use" under U.S. copyright law can be difficult to ascertain. Assistance regarding questions of fair use and copyrights is provided by OTTL and the Office of the General Counsel.

4. The use of University trademarks or logos by any Author requires the permission of the University. See [Use of Boston College Indicia](#) for additional information.

Disclosure and Licensing of Works under Copyright

1. Certain works protected by copyright that are owned by the University under this policy may have commercial interest and be licensed to external parties by the University—in many cases these works include Software, Databases, websites, and other similar works. These works do not generally include Works-for-hire created by non-faculty employees in the course of their employment, unless the employee or the University wishes to commercialize the work or make it available to the public under a license. The process for disclosure and assessment of any work under copyright that is owned by the University and that may have commercial value or be suited for a license are the same as those described above with respect to Inventions.
2. In some cases, Authors who create works protected by copyright in which the Author retains ownership under this policy may wish to commercialize the work using the resources of the OTTL. In these cases, the Author should contact the OTTL to discuss how best to proceed. In cases in which the University elects to commercialize the work, the work will be treated as an Invention as described in the preceding paragraph.
3. Any faculty or staff who uses the services of the OTTL for disseminating a work under copyright shall sign an IPA and other agreements as deemed necessary, to avoid disputes over ownership and control of such works. All signed agreements must be delivered to OTTL before licensing and commercialization resources of the University can be applied.
4. OTTL is responsible for negotiating any agreements on behalf of the University in which works under Copyright are commercialized in close coordination with the Authors, and within parameters established by, or otherwise with the approval of, the Executive Committee. Authority to execute license agreements conforming to this policy is hereby delegated by the President to the Director of OTTL.
5. Whenever practicable, Authors are advised and consulted on the progress of license negotiations, and their comments are considered seriously and in good faith. However, in no event do Authors have a right to approve such agreements, including any right to approve payment or other terms of such agreements.

Software and Databases

1. Certain works, including Software and some Databases, may be protected by more than one form of intellectual property, including both patent and copyright, and as such, warrant special consideration under this policy. In the event that Software or a Database is created as part of the work under a grant or SPA, ownership of intellectual property rights in work will be determined by the grant or agreement. In such cases, the Software or Database will be treated as a patentable invention under this policy for the purposes of disclosure, assessment, and licensing, whether or not the University elects to protect the work by patent or license it commercially. In all other cases, ownership in the Software or Database and disclosure obligations with respect to these works will be determined in accordance with the copyright provisions of this policy.
2. Control and stewardship of data and information produced under an SPA will be governed by the University's current procedures with respect to sponsored project data. Any questions regarding these procedures should be directed to the Office for Research Integrity and Compliance and the Office of Sponsored Programs.

Tangible Research Property

1. Ownership of Tangible Research Property (TRP) normally resides with the University unless the TRP arises as a result of a grant or SPA, in which case the terms and conditions of the grant or SPA apply. Where the grant or SPA is silent, TRP is owned by the University.

2. All TRP which is potentially protected by patent or copyright shall be disclosed in accordance with the provisions of this policy which govern such disclosures. Any TRP which the Inventor believes may not be protected by patent or copyright shall be disclosed to the OTTL if: a) the TRP may have utility for commercial purposes; b) the Inventor wishes to provide the TRP to an individual or entity external to the University; or c) disclosure of the TRP is required under a grant or SPA.
3. Principal investigators and laboratory directors are primarily responsible for the custody, care, and control of TRP, including its storage, use, and distribution.
4. Principal investigators may wish to make TRP available for others' research use. Scientific exchanges should not be inhibited by potential commercial considerations. However, prior to any transfers of TRP external to the University, an appropriate license or material transfer agreement must be executed by the Director of OTTL. Any requests received from external sources wishing to obtain TRP or associated intellectual property rights must be referred to OTTL.

Special Considerations for Inventions Discovered Under Federal Projects

1. Research funded by the federal government carries with it legal requirements for disclosure. The federal government retains intellectual property to inventions created or reduced to practice under federal grants. Under federal regulations (37 CFR 401, et seq.), the University must report all such inventions to the funding agency and elect to file for a patent within a reasonable period of time. If the University elects not to file for a patent it must so inform the agency, which then has the right to file. Inventors must report all inventions on an Invention Disclosure Form, and provide a signed original form to OTTL for submission to the sponsoring agency.
2. Inventors whose inventive work is conducted under federal funding, regardless of amount, should be aware that the federal government retains a perpetual, nonexclusive license to all research results.

Distribution of Proceeds

Upon receipt of each royalty payment, license fee payment, lump-sum payment, or other payment of proceeds that results from the licensing or distribution of Intellectual Property owned by the University, the University shall first pay or reimburse itself with respect to all consulting, licensing, legal, marketing, and other direct invention-related expenses (which may include research funds and equipment) until all such costs are recovered. Following full direct cost recovery, the University shall thereafter retain 15% of each such payment to fund ongoing indirect costs, and shall distribute the remaining proceeds as follows:

Distribution of Proceeds After Full Direct Cost Recovery and 15% Ongoing Indirect Cost Recovery				
	Up to \$100,000	\$100,001 - \$499,999	\$500,000 - \$999,999	\$1,000,000 and Above
Inventor(s)/Authors(s)	50%	40%	35%	30%
Inventors'/Authors' Academic Unit	30%	35%	35%	40%
Provost	20%	25%	30%	30%

1. Proceeds following cost recovery are to be distributed according to the policy in effect at the time initial payments are received by the University from license and other agreements. The University reserves the right to determine the frequency of distribution.
2. The Inventors' share is normally shared equally among all Inventors unless they agree otherwise. Such agreements must be in writing via a Participation Agreement ([EXHIBIT C](#)), and a copy maintained on file with OTTL. Any distribution paid pursuant to this policy represents an employee benefit from the University to the recipient. Creators of Intellectual Property covered under this policy should understand that the receipt of distributions may have income tax ramifications; accordingly, it is highly recommended

that creators seek their own competent tax advice concerning the tax treatment of any income derived through the implementation of this policy.

3. An Inventor may waive his or her personal share in order that the University retain the proceeds to support further the Inventor's research and research within the Inventor's department. The appropriate administrator of the Inventor's academic unit is to maintain control of all such proceeds and resulting expenditure requests. Inventors/Authors are advised to consult with personal tax advisors regarding the tax ramifications of such a waiver.
4. An Inventor's rights to distribution of payments under this policy survive termination of his or her employment at Boston College.
5. In cases of large sums of cumulative proceeds (i.e., greater than \$1 million), academic unit administrators must arrange with the University for the dedication of their shares to create an endowment for support of their activities.
6. The academic unit administrator's and Provost's shares are used to support excellence in teaching and research, as appropriate, in such a way as to maximize the effect of such proceeds.
7. Notwithstanding the above, in some cases, the VPR may, at his or her discretion, propose to alter such distribution of proceeds if the alteration further advances the research mission of the University, including those cases in which individuals other than the named Inventors or Authors contributed to the invention or work. Any alteration must be approved by the Inventors and the Executive Committee.

Waiver of University Rights

Process for Review

Inventors and Authors shall receive written evaluations of their disclosures of intellectual property within 120 days of the date of formal submission to OTTL. Such period of time is provided to ensure that adequate review and consideration are given to patentability and commercial potential. The evaluation shall indicate whether the University plans to seek patent protection for, license, or otherwise commercialize the intellectual property. If the intellectual property in question is not yet developed to the point at which its commercial potential can be determined, evaluation of the disclosure may be deferred and the Inventors or Authors will be so informed. The disclosure will then be re-evaluated by OTTL once further development has been successfully undertaken. If, upon final review, it is determined that a disclosure will not be patented, licensed, or otherwise commercialized by the University, the Inventors or Authors may request, in writing, that the University waive ownership rights. The Director of OTTL shall consider such request and, with the approval of the VPR, may waive the University's ownership rights in favor of the Inventor or Author, subject to any sponsored program requirements. Ownership rights will not be waived by the University in cases in which one or more of the following conditions apply: (a) federal regulations that govern the Intellectual Property prohibit such release; (b) the terms of any SPA under which the disclosure arose prohibit such release; or (c) release of the Intellectual Property in question would create an undue liability or risk to the University or otherwise compromise the University's interests.

Royalties to University

In consideration of any University contribution of Substantial Resources to support the work in which the intellectual property is developed, Inventors and Authors are required, as a condition of the waiver, to grant back to the University fifteen percent (15%) of the royalties or any other revenues they receive as the result of any license or sale of said Intellectual Property. In addition, prior to retaining any such royalties or other revenues, Inventors and Authors must fully reimburse the University for any legal expenses, including patent costs, which the University incurred relating to the Intellectual Property.

Conditions to University's Waiver of Rights

All releases of the University's Intellectual Property incorporate the following terms and conditions whether or not this policy is referenced in any documents evidencing or documenting such releases:

1. The Inventor must report annually to OTTL any licenses or other commercialization agreements entered into with respect to the particular intellectual property for the purpose of disclosure of potential conflicts of interest, as well as the date of the first sale of a product or process that results from an Intellectual Property.
2. The University retains a perpetual, nonexclusive, nontransferable, worldwide, royalty-free license to exercise rights under the Intellectual Property for research or educational purposes.
3. The Inventor's licensees, sublicensees, and assignees must agree to defend, indemnify, and hold harmless the University, its trustees, officers, employees, and agents from all claims or demands made against them (and any related losses, expenses, or costs) arising out of the use of or conduct regarding the intellectual property.
4. The waiver creates no right of the Inventor and/or licensees to use, nor any interest whatever in, the University's technology, trade name, or trademarks, unless otherwise provided in the waiver. Any use by the Inventor or the Inventor's licensee(s) of the University name or trademarks may be made only with the express written permission of the Office of the General Counsel.
5. The Inventor's rights under the waiver are subject to any U.S. government purpose rights under 35 USC §202(c)(4) and any march-in rights under 35 USC §203.

Policy on Equity

Procedures Governing Equity Transactions

License in Consideration of Equity

The University's purpose in commercializing Intellectual Property is to promote the development of inventions and works to serve the public interest. If, after a diligent effort to identify prospective licensees, OTTL determines that it is appropriate and in keeping with the public interest to accept Equity as full or partial consideration for a license, it may negotiate such a license on behalf of the University, following approval by the Executive Committee. As with any license, OTTL is to be satisfied that the licensee can demonstrate management and technical capability and that it has the financial resources necessary to meet its developmental objectives and its obligations to the University. OTTL may accept Equity in the licensee on behalf of the University in lieu of or in combination with royalties, license fees, or other fees, provided that the Equity together with any other consideration represents a fair value for the technology.

Conflicts of Interest in License Agreements that Involve Equity

License agreements that involve Equity must be structured to protect the University from liability and to avoid conflicts of interest. The Inventor/Author is to disclose to the OTTL any existing or proposed agreements between the Inventor/Author and the prospective licensee, or any other agreements with other entities that have potential for conflicts of interest. OTTL is to inform, in writing, the Executive Vice President, the University's Conflict of Interest Committee, and the Inventor/Author of the proposed terms of the agreement and any potential conflicts of interest. If it is determined that a conflict of interest exists, the University may impose limitations on the proposed license agreement, any associated sponsored research agreement, any consulting agreement between the Inventor/Author and the licensee, any other related agreement.

Board Participation and Fiduciary Roles

The University is to exercise due care in evaluating whether to accept a position on the board of directors of the licensee, but may more routinely accept and exercise observer rights on such boards. The decision to accept a position on a licensee's board of directors must have the approval of the Executive Committee. Participation of the Inventor/Author in the business of the licensee shall be governed by the University's Conflict of Interest Policy pertaining to Sponsored Projects, and/or any other applicable conflict of interest policy of the University.

Disclosure of Equity

The University will require the prospective licensee to disclose all Equity offered to the University, its employees, and other institutions or individuals in consideration for the license agreement. In addition, the prospective licensee will be required to disclose, in writing, to OTTL the specific terms and conditions associated with such Equity, and the anticipated capital structure of the venture. Furthermore, the prospective licensee and the Inventor/Author must

disclose to OTTL, in writing, any Equity to be issued to the Inventor/Author for his or her role as founder, consultant, or otherwise.

Direct Personal Ownership of Equity

The University will require generally that the Equity provided to the Inventor/Author from the Equity Pool be issued directly to the Inventor/Author, with the approval of the Executive Committee, at the time the Equity is issued. The Inventor/Author share of the Equity Pool is 30% provided, however, that if the Inventor/Author is receiving Equity from the licensee in connection with being a Founder, consultant, or other arrangement, he or she shall not be entitled to a share of the Equity Pool. The Inventor/Author is responsible for all financial, tax, and legal consequences related to the Equity he or she receives and for retaining his or her own business advisors, legal counsel, and tax counsel. An Inventor/Author receiving Equity from the Equity Pool or from the licensee shall not be entitled to any share of the University's Net Equity Income.

Management of Equity

The Treasurer of the University shall manage the Equity and determine, at his or her discretion, if equity shall be sold and, if sold, when such Equity shall be sold. The Treasurer is under no obligation to sell the Equity. If Equity is sold by the University, the proceeds of the sale are to be transferred to the University. Costs associated with the sale of Equity shall be deducted from the proceeds, and the balance of the Net Equity Income shall be distributed between the Academic Unit and Provost as determined by the Executive Committee to advance research at the University in accordance with the requirements of the Bayh-Dole Act. In cases of large sums of cumulative proceeds (i.e., greater than \$1 million), academic unit administrators must arrange with the University for the dedication of their shares to create an endowment for support of their activities.

Approved: William P. Leahy, S.J.

Date: January 28, 2011

Exhibit A – Invention Disclosure Form (i. Inventions and ii. Software)

Exhibit B – Intellectual Property Agreement

Exhibit C – Participation Agreement

Exhibit A

Invention Disclosure Form

General Information

An invention is any new or useful process or discovery, art, method, technique, product, machine, device, manufacture, software, composition of matter, or improvement thereof that is subject to protection by patent. An invention is a new, useful process, machine, improvement, etc., that did not exist previously and that is recognized as the product of some unique intuition or genius, as distinguished from ordinary mechanical skill or craftsmanship. It may cover things such as new or improved devices, circuits, systems, chemical compounds, drugs, etc. To be patentable, the invention must not be obvious to a worker with average skills in that particular technology. In addition, it must not have been used by others in this country, or patented or described in a printed publication anywhere, prior to the date of conception.

Instructions

The purposes of this Invention Disclosure Form are to record what was invented and the circumstances under which the invention was made. It provides the basis for a determination of patentability and the data for drafting a patent application. In addition, it provides the Office of Technology Transfer and Licensing (OTTL) with initial information to conduct an evaluation on the market potential of the invention. Based upon the information you provide on this form, OTTL will review your invention and provide advice and assistance regarding legal protection for your invention and in determining avenues for licensing or otherwise bringing the invention into public use. It is a legally important document that you should read carefully before completing.

Complete a Technology Disclosure Form when something new and useful has been conceived or developed, or when unusual, unexpected or unobvious research results have been achieved and can be used.

Please answer all questions and complete all sections as thoroughly as possible. Incomplete or unsigned forms will be returned to the inventors and will not be processed by OTTL until a completed form is returned.

When completed submit to:

Jason Wen
Director
Office for Technology Transfer and Licensing
Waul House, 2nd Floor
Telephone: 617-552-1682
Fax: 617-552-2970
Email: jason.wen@bc.edu

1. Title of invention:

Use a brief title, sufficiently descriptive to aid in identifying the invention. It should be brief but technically accurate and descriptive - 10 words or less. This may be the first thing a potential licensee will look at. It should therefore describe some key feature, improvement or key word that will catch people's attention.

2. Please list all individuals you believe to be inventor(s) -- list the lead inventor first:

a. BC Inventor Information:

Name	Position	Subdivision	Lab Address	Phone/Fax/E-Mail

b. Non-BC Inventor Information (e.g. other universities):

Name	Institution	Position	Department	Phone/E-Mail

3. **PARTICIPATION AGREEMENT** – Under BC policy, all inventors will share in royalty distributions equally unless inventors sign a Participation Agreement. If you wish to complete a Participation Agreement check here

(If box is checked, please download the Participation Agreement form _____, COMPLETE the form, with signatures from all inventors, and SEND to Waul House, 2nd floor.

4. **Funding Sources.** Indicate all sources of funding for the invention, including funding received from government agencies, nonprofit organizations or commercial entities. If the invention was created under a research project receiving funding from a government agency, nonprofit entity or a commercial party, the University may have obligations to report the invention or provide certain rights to the sponsor. Please carefully consider all sources of funds used in the research that led to this invention and provide the requested information below.

a. I confirm that no grant funds were used . Signed: _____

b. **Federal Support.** Check all that apply and provide details below:

NIH NSF DoD DoE Other None

Agency	Contract/Grant No(s).	Period of Funding	Principal Investigator

c. **Industry Support.** Check all that apply and provide details below:

Industry Sponsored Research SBIR/STTR Gift Other None

Agency	Contract/Grant No(s).	Period of Funding	Principal Investigator

<p>If so, please give the name(s) of these sources and describe the nature of the item(s):</p> <p>Is there an agreement in place covering the provision of the item(s) to you? If so, please describe.</p>	
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8. External Disclosure Information:

	x	Check	Please Provide Dates, Circumstances, Location, etc.
Has the invention been described, in whole or in part, in a printed or online publication?	<input type="checkbox"/>	Yes	
	<input type="checkbox"/>	No	
Has a manuscript describing the invention, in whole or in part, been submitted for publication? If so, when?	<input type="checkbox"/>	Yes	
	<input type="checkbox"/>	No	
If a manuscript has been submitted, has it been accepted for publication? If so, provide the name of journal and anticipated date of publication in print or online.	<input type="checkbox"/>	Yes	
	<input type="checkbox"/>	No	
Has the invention been described in any application for external funding? If so, provide the name of the external organization and the date of application.	<input type="checkbox"/>	Yes	
	<input type="checkbox"/>	No	
Has the invention been disclosed in a public setting such as a poster session, conference, or seminar? If so, when? If not, are any such disclosures scheduled to occur?	<input type="checkbox"/>	Yes	
	<input type="checkbox"/>	No	
Has the invention been disclosed in a "private" setting, such as a conversation with a company or with colleagues at another institution? If so, please describe.	<input type="checkbox"/>	Yes	
	<input type="checkbox"/>	No	

9. Written Description of Invention. Please provide a detailed written description of the invention. This may be in the form of a draft manuscript. **However, in addition to the manuscript and/or written description, please provide the following information:**

- a. **Brief summary of the invention:** This should be a short, relatively non-technical description of the invention. It should clearly summarize the purpose of the invention, possible applications and commercial products developed using the invention or containing the invention, the commercial/industrial problem that the invention solves and its advantages over current technologies (i.e. how it is better, faster, cheaper, etc.). This should be no longer than two paragraphs.
 - b. **Background:** Briefly summarize the state of the art and current problems in the field that led you to develop this invention. Think of this as the introduction to a paper or the background and significance section of a grant.
 - c. **Technical description of the invention.** This description should be detailed enough to make it possible for someone to recreate or perform what is described in the invention. You can think of this as a protocol that someone would follow. Pictures and flow charts are also very helpful to clarify the procedure/processes and can help to strengthen a point. (The draft of a manuscript may suffice here; electronic versions are helpful):
 - d. **Novelty/Non-obviousness.** In order to obtain a patent, it is necessary to prove that the invention is truly unique and would not be evident to a colleague. Describe the key elements that distinguish your invention from existing technologies used to address the same issue or problem.
 - e. **Advantages:** Encouraging companies to invest in the commercial development of your invention will require that we describe for them its advantages over alternative products, processes or services. Describe all of the advantages you can think of (i.e. what makes it faster, better, cheaper) and any key features you can think of that might make your technology more marketable. Feel free to be speculative; all of the claims in this section do not necessarily have to be backed up by data at this time.
 - f. **Possible Variations:** Describe any possible variations you can think of that can be used to broaden the claims in the patent. The broader the claims the stronger the patent and the less likely it is that a competitor can engineer around your patent. This should include any variations in the types of chemistry, sequences, mutations, materials, manufacturing methods alternative steps or approaches that can be used to create or enable the invention. The more examples, the better.
 - g. **Products and Services:** List below as many actual or hypothetical products or services as you can think of that might result or benefit from your invention. Be adventurous; try to think of broader and narrower applications for the invention than those that immediately come to mind, as well as applications that are outside your own field.
- 10. Future Plans.** Are you planning to continue your research on this invention, or in closely related areas? If so, what are the next steps you envision? If it has not yet been reduced to practice, do you anticipate doing so in the foreseeable future?
- 11. Licensing Leads.** Are you aware of any companies or academic research groups conducting similar research? Are there any companies that you believe could take an interest in licensing this invention? Do you have any contacts in industry (former students, colleagues, etc) that you think would be interested to learn of the invention? If so, please identify these.

12. Related Research. Please list any pertinent publications (by you or by other researchers) which are related to the invention or to this area of research.

13. Inventor's signatures:

By signing, you agree that:

All information provided herein is true and complete to the best of my knowledge. I hereby assign all right, title and interest to this invention to Boston College and agree to execute all documents as requested, assigning to Boston College my right in any patent application filed on this invention. I further agree to be bound by the Boston College Intellectual Property policy, and to cooperate with the Boston College Office of Technology Transfer and Licensing in the protection of this invention. Boston College will share any royalty income derived from the invention with the inventors(s) according to its standard policies. Failure to submit to the Office of Technology Transfer and Licensing an update to this form to show changes to your address, phone number, email address and/or employment/enrollment status may lead to the forfeiture of royalty income.

<u>Print or Type Name:</u>	<u>Print or Type Name:</u>
<u>Signature and Date:</u>	<u>Signature and Date:</u>
<u>Home Address:</u>	<u>Home Address:</u>
Country of Citizenship:	Country of Citizenship:
<u>Print or Type Name:</u>	<u>Print or Type Name:</u>
<u>Signature and Date:</u>	<u>Signature and Date:</u>
<u>Home Address:</u>	<u>Home Address:</u>
Country of Citizenship:	Country of Citizenship:
<u>Print or Type Name:</u>	<u>Print or Type Name:</u>
<u>Signature and Date:</u>	<u>Signature and Date:</u>
<u>Home Address:</u>	<u>Home Address:</u>
Country of Citizenship:	Country of Citizenship:

Technology disclosed to and understood by:

Signature of Non-Inventor Witness:	
Date:	
Name of Witness:	
Title of Witness:	

Exhibit B

Intellectual Property Agreement

SUMMARY: This document sets forth the signatory's agreement to Boston College's intellectual property terms. They apply to all intellectual property that is created in the course of University activities, including sponsored projects.

Introduction

Boston College has adopted an Intellectual Property Policy. That Policy, as amended from time to time, applies to all members of the University, including anyone who participates in externally sponsored programs. In addition, Federal policy requires the University to obtain from any staff member who is paid, in part, by a Federal grant, a written agreement that outlines the staff member's obligations for reporting and assigning inventions. In order to achieve consistency in applying the University's policies, the University will accept and execute sponsored agreements only if the Principal Investigator and other relevant employees and students have signed this Agreement on Intellectual Property. It is the practice of the University to have individuals sign this Agreement only once and to keep these Agreements on file in the Office for Technology Transfer and Licensing (OTTL).

Agreement

1. I have read and I understand and agree to be bound by the terms of the University's "Intellectual Property Policy," as well as by the terms of any revisions or amendments adopted by the University.
2. I agree to report promptly to OTTL any invention or discovery conceived or first reduced to practice as part of or related to my University activities. By signing this Agreement, I hereby assign and will assign to the University all right, title, and interest (including any intellectual property rights) in and to any such invention or discovery, including those that are conceived or reduced to practice in the course of a sponsored project.
3. I understand that the University accepts obligations under the terms of sponsored agreements, and that these obligations are binding on any individual participating in externally sponsored programs. Therefore, if I am associated with such a program, I understand that it is my responsibility to ascertain the terms of such agreements. I agree to do so and abide by all applicable terms of such agreements.
4. I also understand that there may be instances in which University policy or the University's obligations to external sponsors may preclude my being able to retain copyright and I hereby assign and will assign all rights to the University or its designee in such cases. I further understand that, in its agreements with external sponsors, the University seeks to retain maximum publication rights for its members and itself.
5. I will execute all papers and otherwise provide cooperation and assistance to the University, promptly upon its request and at its expense, during and after my affiliation with the University, to enable the University to obtain, maintain, or enforce its patents, copyrights, or other intellectual property.
6. In furtherance of the University's rights as provided above and at its reasonable request, I will provide the University with copies of all the written records relating to the intellectual property assigned under this Agreement.
7. I am now under no obligation to any person, organization, or corporation with respect to any rights in inventions, discoveries, or copyrightable materials that is, or could be reasonably construed to be, in conflict with this Agreement or my obligations to the University. I will not enter into any agreements or incur any obligations that conflict with my obligations under this Agreement.
8. I recognize that this Agreement is part of the terms of my employment or appointment at the University and that my obligations under this Agreement in regard to my activities at the University shall continue after termination of my employment or appointment.

9. This Agreement shall be binding on myself, my estate, heirs, and assigns.

Signature: _____

Print Name: _____

Date: _____

Exhibit C

Participation Agreement Regarding Contribution to Invention

This Agreement ("Agreement") is made by and between _____ residing at _____, _____; residing at _____, _____; residing at _____, _____; (each of whom hereinafter is referred to individually as an "Inventor" and collectively as "Inventors"), assignors to Trustees of Boston College of Invention Disclosure Case Number _____, entitled "_____" disclosed to the Office of Technology Transfer and Licensing on _____ (hereinafter the "Invention").

WITNESSETH

WHEREAS, Inventors are ordinarily entitled to receive a percentage of Proceeds received by Trustees of Boston College from licensing intellectual property under Boston College's existing Intellectual Property Policy; and

WHEREAS, Inventors wish to record with Trustees of Boston College the varying contributions made by the Inventors with respect to the Invention;

NOW, THEREFORE, in consideration of the foregoing, the Inventors agree as follows:

- 1. The elements of the Invention that were contributed by each inventor were as follows:

<u>Inventor</u>	<u>Intellectual Contribution to the Invention</u>
_____:	_____
_____:	_____
_____:	_____
_____:	_____
_____:	_____

- 2. In light of these respective technical contributions, the Inventors agree that the appropriate participation of the Inventors in Proceeds is as follows:

_____ shall receive ____% of the Proceeds allotted to Inventors;
_____ shall receive ____% of the Proceeds allotted to Inventors;
_____ shall receive ____% of the Proceeds allotted to Inventors;
_____ shall receive ____% of the Proceeds allotted to Inventors;
_____ shall receive ____% of the Proceeds allotted to Inventors.

Note that the entire percentage in 2 above must equal 100%.

- 3. The Inventors understand and accept that a license to the Invention may include one or more additional inventions not yet made which may expand on the Invention ("New Inventions"), that such New Inventions may not be made by all of the Inventors and/or may include additional inventors, that Boston College, in

consultation with the licensee will allocate a share of Proceeds to the New Inventions and that the relative contributions to the New Invention may be different than those specified in Section 2;

4. The Inventors agree that at the time a License Agreement covering the Invention is signed, this Agreement and any corresponding Participation Agreements for New Inventions may be incorporated by reference into a Royalty Sharing Agreement which distributes Proceeds from said license.
5. This Agreement shall be binding on and inure to the benefit of each of the parties hereto, their heirs, assigns and successors and may not be amended, waived or discharged except by a writing signed by all the parties, including the Trustees of Boston College.

IN WITNESS WHEREOF, the parties hereto have hereunder set their hands and seals and duly executed this Agreement, this ____ day of _____, 20__.

Inventors:

Signed: _____

Signed: _____

Signed: _____

Signed: _____

Signed: _____

Received on behalf of Trustees of Boston College

Signed: _____

Name: Jason Wen, Ph.D., MBA, CLP, RTTP

Title: Director, Office of Technology Transfer and Licensing