



Title: Inventions, Patents, and Licensing Policy
Effective Date: July 31, 2023
Issuing Authority: Provost
Policy Contact: Senior Vice Provost for Research
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Purpose

Mercer University is dedicated to teaching, research, and the expansion of knowledge. Although the University does not undertake research or developmental work principally for the purpose of developing patents and commercial applications, patentable inventions sometimes result from the research activities carried out wholly or in part with University funds and facilities. It is the policy of the University to assure the utilization of such inventions for the common good and, where appropriate, to pursue patents and licenses to encourage their development and marketing.

Scope

This policy applies to all employees and students at Mercer University.

Exclusions

None

Policy Statement

Mercer University has established the following policies and procedures with respect to inventions, patents, and licensing to:

1. promote the University's academic policy of encouraging research and scholarship;
2. serve the public interest by providing an organizational structure and procedures through which inventions that arise in the course of University research may be made available to the public through established channels of commerce;
3. encourage, assist, and provide tangible rewards to members of the University community who make inventions processed under this policy;
4. establish principles and uniform procedures for determining the rights and obligations of the University, inventors, and research sponsors;
5. enable the University to retain title to inventions resulting from federally-sponsored

research; and

6. produce funds for further investigation and research and for the overall needs of the University.

A. Ownership of Inventions

1. Inventions arising from research financed by the United States Government are controlled by the terms of the applicable grant or contract. Where the University is permitted to retain title to such inventions and chooses to do so, University patent policies will control.
2. Inventions arising from research or other work sponsored by non-governmental entities are controlled by the terms of the sponsored agreement, if applicable, and if not, by University patent policies.
3. Inventions arising from research or other work conducted by University employees or students on their own time and without significant use of University funds or facilities shall be considered the sole property of the inventor and may be commercialized by the inventor at his or her own expense. However, by mutual agreement, such inventions may be managed by the University under the terms of this policy. The University will not construe the payment of salary from unrestricted funds or the provision of office or library facilities as constituting significant use of university funds or facilities.
4. Inventions resulting from research or other work conducted by University employees or students on University time or with significant use of University funds or facilities shall be considered the property of the University. Any income received by the University as a result of licensing or otherwise commercializing these inventions shall be shared with the inventor as provided below. If the University does not wish to undertake patenting and commercialization of such an invention, and if there are no restrictions by any outside sponsor, the University may release its proprietary interest to the inventor.
5. Any use of Mercer University's name in connection with the commercialization of an invention by an individual shall be approved in advance by the University.

B. Division of Income

1. Any income resulting from inventions managed by the University under this policy shall be shared as follows:
 - a. First \$10,000 of Net Income received:
 - 75% to the inventor
 - 15% to the inventor's college or school
 - 10% to the University

- b. Net income received above \$10,000:
 - 50% to the inventor
 - 25% to the inventor's college or school
 - 25% to the University
2. "Net Income" is defined as gross royalties and/or other receipts minus the costs incurred by the University for the patent application, interferences, development, licensing, and patent enforcement.
3. Co-inventors share the inventor's portion in proportions agreeable to themselves.
4. The college or school share shall be administered by the Dean to support research programs in the inventor's department or division.
5. Fifty percent (50%) of the University's share, after defrayment of patent-related costs not otherwise covered, shall be used to support or offset the costs of research in the inventor's college or school with the advice and counsel of the Dean.

C. Disclosure

1. Inventions arising in the course of sponsored projects should be disclosed promptly to the Office of the Senior Vice Provost for Research with simultaneous disclosure to the principal investigator or project supervisor where applicable. The circumstances of the invention will be reviewed with those involved, and the inventor will be notified in writing of the proposed disposition.
2. Inventions falling within Section D of Article I above, or about which there is a doubt as to ownership, or which the inventor wishes to have managed by the University, should be promptly disclosed to the Senior Vice Provost for Research in the Office of the Provost. Within six weeks of the receipt of the disclosure, the Inventor will be notified in writing of the determination of ownership (if in doubt) and the proposed disposition.

D. Invention Management

1. For all inventions managed by the University under this policy, the University will at no expense to the inventor make reasonable efforts to evaluate the interest of others in commercializing the invention, seek licenses and options for licenses, have applications for patents filed and prosecuted, and otherwise manage the inventions or arrange for their management by recognized patent management organizations.
2. The University will normally evaluate potential commercial use of an invention prior to the filing of a patent application. Options to license and other contractual arrangements

appropriate in the circumstances will normally be sought as early as possible as a validation of potential commercial use. If the University determines that neither commercial possibilities nor the potential contribution to the public good warrants proceeding further, the invention will be returned to the inventor and shall belong to the inventor unless such action is precluded by prior agreement with sponsors.

3. In licensing, sale, or other disposition of rights to inventions, the University will seek to guard against repressive practices. Royalty rates shall be reasonable and consistent with the goal of effectively transferring technology in the public interest. Where feasible, the University will grant non-exclusive, reasonable royalty-bearing licenses to all qualified licensees. The University recognizes, however, that non-exclusive licensing may not always be effective in bringing the invention to the commercial market in a satisfactory manner, and thus may grant an exclusive license if it determines that such is required in the public interest to encourage the marketing and eventual public use of the invention. In all cases, the University shall reserve to itself a non-exclusive, royalty-free license to make or have made and to use the invention within Mercer University for its own purposes.
4. In those cases where the University has obtained a patent without obligation to sponsors, if no arrangement has been made for commercial development within a reasonable period from the date of issuance of the patent, ownership of the patent will revert to the inventor upon request.

E. Publication

Inventors should be aware that a publication disclosing the invention prior to the filing of a U.S. patent application is a bar to the grant of certain foreign patents and can bar the grant of a U.S. patent if the publication occurred a year prior to the filing date. Accordingly, the University may request a temporary delay in a publication that discloses an invention to permit a U.S. patent application to be filed but in no event longer than three months.

F. Disputes

Any disagreement between an inventor and the Senior Vice Provost for Research in the Office of the Provost concerning rights in an invention shall be resolved by the President, who may appoint an ad hoc committee to make findings of fact and recommendations to him.

G. Revision or Termination

This policy may be changed or discontinued at any time by action of the Board of Trustees. Any such change or discontinuance shall not affect rights accrued prior to the date of such action.

H. Patent Agreements

This policy, as amended from time to time, shall be deemed to be a condition of initial or continuing employment of every University employee and a condition of enrollment and attendance of every student who works on any research project under University control. All such employees and students will be expected, upon request, to sign agreements incorporating

the terms of this policy. Failure to sign such agreements, however, shall not affect the applicability of the policy nor relieve any employee or student from the obligations imposed.