



**THE GEORGE  
WASHINGTON  
UNIVERSITY**  
WASHINGTON, DC

**Responsible University Official:**  
Associate VP for Health Research,  
Compliance, and Technology Transfer  
**Responsible Office:** Health Research,  
Compliance and Technology Transfer  
**Last Revised Date:** April 30, 2005

## **PATENTS AND SCHOLARLY WORK**

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### **Policy Statement**

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The university seeks to serve the needs of society in the course of pursuing the traditional principles of education and research, as well as patient care. It has dedicated itself and all its resources to the pursuit and dissemination of knowledge. It does not pursue knowledge for primarily commercial purposes. However, the university recognizes that the interest of the inventor(s) and that of the university are better served when inventions and discoveries made by university faculty, staff, or students are developed to the point of practical application. The university's Policy on Patents and Scholarly Works is intended to facilitate that objective.

The university's Policy on Patents and Scholarly Works applies to all faculty, staff, and students of the university. While it imposes certain obligations on faculty, staff, and students who conduct research, the purpose of this document is to adopt an inventor-friendly process in dealing with patents and scholarly works.

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### **Reason for Policy**

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The university's purposes of pursuing and disseminating knowledge are sometimes served by seeking patent protection for inventions and discoveries made in the course of work by university faculty, staff, and students. Patents confer certain exclusive rights to inventions and discoveries while simultaneously making those inventions and discoveries known to the public. Many inventions and discoveries are of more beneficial use when protected by the exclusive rights granted in a patent. Consistent with the public interest, the university will take steps to promote the development and use of its faculty's, staff's, and students' inventions and discoveries. When the university receives royalties from patents, it will use those royalties in support of its mission of education and research and to provide appropriate incentives for inventorship.

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## Who is Governed by this Policy

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Faculty, staff and students

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## Policy

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### University Organization

#### A. Office of Health Research, Compliance, and Technology Transfer

The Associate Vice President for Health Research, Compliance and Technology Transfer and the Assistant Vice President for Health Research, Compliance and Technology Transfer, in collaboration with the Associate Vice President for Research and Graduate Studies and the Assistant Vice President for Research Services, are the university officials responsible for patent matters, including negotiation of agreements with sponsors of research and with licensees of university owned patents. These officials administer the Policy on Patents and Scholarly Works and ensure compliance with agreements with sponsors, and coordinate on such activities for joint endeavors that involve both components, i.e., non-medical and medical.

The Office of Health Research, Compliance, and Technology Transfer is available to advise faculty, staff, and students on patent questions, particularly as they relate to specific disclosures.

B. Patent and Scholarly Works Review Panel: Policy and Procedure with regard to Patents and Scholarly Works.

Responsibility for establishing policy and procedures to implement the Policy on Patents and Scholarly Works resides with the Associate Vice President for Health Research, Compliance, and Technology Transfer. The Advisory Council on Research, chaired by the Associate Vice President for Research and Graduate Studies, serves as the consultative body on these matters and must approve policy changes. A subcommittee of the Advisory Council on Research will be appointed for each calendar year by the Associate Vice President for Health Research, Compliance, and Technology Transfer in consultation with the Associate Vice President for Research and Graduate Studies. This subcommittee will be called the Patent and Scholarly Works Review Panel. The Panel, chaired by the Associate Vice President for Health Research, Compliance, and Technology Transfer, shall have membership composed of one representative from each School of the university along with the Associate Vice President for Research and Graduate Studies, the Assistant Vice President for Research Services and the Assistant Vice President for Health Research, Compliance, and Technology Transfer. In addition, one of the two members of the Advisory Council on Research from the Senate Committee on Research and one member from the Medical Center Committee on Research shall be appointed to the Panel. When necessary, for consultative purposes and to obtain expert advice, the Panel may convene an ad hoc subpanel, composed of members internal or external to the university who are not members of the Panel.

### **Relations with Sponsors of Research**

Through the Offices of Research Service, the university enters into agreements with third parties to sponsor research conducted by university faculty, staff, and students. Such agreements for sponsored research may contain provisions allocating the parties' rights in any Inventions or Discoveries made under the agreement. The university will not enter into such an agreement if its provisions differ in any way from university policy unless the deviating provisions are deemed acceptable in writing by the faculty member or staff member who will be the principal investigator for the project.

Sponsored research agreements impose many requirements, not just ones related to patents, and university faculty, staff, and students should familiarize themselves with any of these requirements that relate to their work. Before work begins on a project covered by a sponsored research agreement, the principal investigator must advise his/her colleagues working on the project of their rights and duties under the

agreement. Usually, this is best done by providing each individual involved with copies of the applicable sections of the document.

Sponsored research agreements are entered into only after it is determined that they meet certain basic criteria. It is expected that the following criteria will be applied unless there is documented reason for an exception that is approved by the Associate Vice President for Research and Graduate Studies (non-medical) or the Associate Vice President for Health Research, Compliance, and Technology Transfer:

1. The sponsored research is consistent with and supportive of the university's purposes of education and research, as well as patient care, and the university's overriding aim of pursuing and disseminating new knowledge.
2. The sponsored research does not involve the commitment of so many personnel or other resources that it creates an inappropriate balance of activities within the relevant university school, department, or laboratory. These determinations are to be made by the appropriate signatories, e.g., Department Chair, Dean, Associate Vice President for Research and Graduate Studies, Vice President for Academic Affairs, Associate Vice President for Health Research, Compliance, and Technology Transfer, or Vice President for Health Affairs, on the standard routing sheets for approval of sponsored research proposal within the university.
3. Faculty, staff, and students are permitted to publish the results of their research in a timely manner. The university normally will agree to maintain confidentiality of confidential information provided by the sponsor and to withhold publication for up to 60 days after disclosure to the sponsor in order to accommodate the filing of a domestic or foreign patent application covering the subject matter of the publication.

#### A. The U.S. Government

Many university faculty, staff, and students receive financial support for their research from the U.S. Government. The ownership of Inventions, Discoveries, Technologies, or Innovations made by university faculty, staff, or students with Government financial support is determined by Federal law, including the Bayh-Dole Act (35 U.S.C. §§ 200-212) and the regulations at 37 C.F.R. Pt. 401.

The university has a duty promptly to disclose to the Government all Inventions, Discoveries, Technologies, or Innovations made in the performance of a Government funding agreement, where a funding agreement means prime awards from the Federal government and Federal pass-throughs,

i.e., subcontracts at all tiers. Accordingly, as provided in Section V of the Policy on Patents and Scholarly Works, faculty, staff, and students associated with Government-sponsored projects promptly shall notify the Office of Research Services and the Office of Health Research, Compliance, and Technology Transfer whenever any Invention, Discovery, Technology, or Innovation is conceived or actually reduced to practice in the course of the project. When permitted, if the university decides to seek patent protection for such an Invention, Discovery, Technology, or Innovation in accordance with this policy, the university will elect to retain title to the Invention, Discovery, Technology, or Innovation and make efforts to achieve practical application of the Invention, Discovery, Technology, or Innovation.

#### B. Sponsors Other than the U.S. Government

University faculty, staff, and students also conduct research sponsored by corporations, non-profit organizations, and others. Such agreements for research sponsorship are entered into through the same procedures used for U.S. Government projects, i.e., through the Office of Sponsored Research (non-medical) or through the Medical Center Office of Research. The university normally will not enter into such a sponsored agreement unless:

1. It is explicitly stated what the rights of the sponsors and of the university will be in Inventions, Discoveries, Technologies, or Innovations that result from the sponsored work. It is expected that the university will retain title to all such Inventions, Discoveries, Technologies, and Innovations, and to any resulting patents. The university normally will grant the sponsor an option to obtain an exclusive or nonexclusive license to such Inventions, Discoveries, Technologies, Innovations, and patents, in exchange for appropriate consideration which may include the payment of patent expenses and royalties, provided that the university is entitled to practice the patent and to permit other nonprofit organizations to practice the patent for *research* purposes.
2. The sponsor agrees that its rights in any Inventions, Discoveries, Technologies, or Innovations are subject to any rights the U.S. Government might have by virtue of its sponsorship of related research.

#### **Disclosure of Inventions to the University**

In order to provide maximum benefit to the university community and to assure the university's compliance with obligations to sponsors of research, all faculty, staff, and students have the responsibility for promptly disclosing fully and openly to the Associate Vice President for Health Research, Compliance, and Technology Transfer all Inventions, Discoveries, Technologies, and Innovations as required by research

agreements or where there is prospect for commercialization in which the university has an interest. Principal Investigators of research projects, as well as department chairs and deans, have a responsibility to insure that all such Inventions, Discoveries, Technologies, and Innovations of which they become aware are disclosed to the appropriate individual named above.

The university will make no claim to Inventions, Discoveries, Technologies, and Innovations unrelated to the individual's scope of duties with the university. Inventions, Discoveries, Technologies, and Innovations made by university faculty, staff, or students which occur under the scope of their duties with the university, i.e., the area or areas of expertise in which an individual is considered qualified to teach or do research by his/her Department, and includes the application of this expertise in any field within or outside the individual's discipline, and accomplished on university time, or with direct university funding, or the use of university facilities, are subject to this Policy on Patents and Scholarly Works. Faculty, staff, and students have the responsibility to disclose all Inventions, Discoveries, Technologies, and Innovations, as required by research agreements or where there is prospect for commercialization in which the university has an interest, that are made within the scope of their duties to the Associate Vice President for Health Research, Compliance, and Technology Transfer. When required, the Patent and Scholarly Works Review Panel shall assist the Associate Vice President for Health Research, Compliance, and Technology Transfer in determining whether the disclosure falls within the individual's scope of duties.

Failure to disclose an Invention, Discovery, Technology, or Innovation may result in the forfeiture of the individual's rights under this policy. Such cases will be reviewed by the Patent and Scholarly Works Review Panel, and additional sanctions consistent with other faculty, staff, or student policies may be recommended to the Associate Vice President for Health Research, Compliance, and Technology Transfer of the Associate Vice President for Research and Graduate Studies.

### **Evaluation of Inventions**

After preliminary evaluation of a disclosure by the Associate Vice President for Health Research, Compliance, and Technology Transfer, and determination that the subject matter is in fact an Invention, Discovery, Technology, or Innovation subject to this Policy on Patents and Scholarly Works, the university must initiate one of the following actions within 30 days:

- A. Submit the Invention, Discovery, Technology, or Innovation to an external technology transfer agent for evaluation and possible commercialization.
- B. Bring the disclosure before the Patent and Scholarly Works Review Panel for further evaluation as to a recommendation for a possible patent application, both domestic and/or foreign, being undertaken by the university.

- C. If rights in the Invention, Discovery, Technology, or Innovation are subject to the terms of an agreement with a sponsor, comply with the terms of the agreement.
- D. Assign title to the Invention, Discovery, Technology, or Innovation to the faculty member, staff member, or student.

## **Rights in Inventions, Discoveries, Technologies, and Innovations**

### A. Scholarly Works

All rights in scholarly books, articles and other publications, artistic creations, literary manuscripts, visual and auditory creations, and musical works, irrespective of their medium of storage or presentation, are granted to the faculty, librarians, staff, and students who are the authors, except for "Works Made for Hire" and works made with "Substantial Use" of university resources (as such terms are defined in the university's Copyright Policy). The former items are meant to include computer programs, computer software, and databases that are accessory to or part of a scholarly text. Computer programs that are written for the primary purpose of educational learning and testing are excluded from classification as Inventions, Discoveries, Technologies, and Innovations. [See also The George Washington University [Copyright Policy](#).]

### B. Inventions, Discoveries, Technologies, and Innovations

Once the university has evaluated an Invention, Discovery, Technology, or Innovation, in order to carry out a decision made in accordance with Section VI of the Policy on Patents and Scholarly Works, the university may require the faculty member, staff member, or student to assign to the university or to a third party all rights, title, and interest in the Invention, Discovery, Technology, or Innovation.

Faculty, staff, and students are required to execute all contracts, assignments, waivers, patent applications, and other documents necessary to carry out the provisions of this policy in a timely manner.

If the university permits a faculty member, staff member, or student to retain title to an Invention, Discovery, Technology, or Innovation, the university shall receive a nonexclusive, irrevocable, paid-up license to practice the Invention, Discovery, Technology, or Innovation, or to have it practiced for the university's own non-income producing purposes, and to permit other nonprofit organizations to practice the Invention, Discovery, Technology, or Innovation for research purposes.

### C. Employee Inventions

The Policy on Patents and Scholarly Works does not apply to Inventions, Discoveries, Technologies, or Innovations that are created as a specific requirement of university employment or as an assigned university duty outside sponsored projects or related activities. All rights in these works are owned by the university with no right or interest vesting in the inventor.

#### **Patenting of Inventions, Discoveries, Technologies, and Innovations**

If the university determines to seek patent protection for an Invention, Discovery, Technology, or Innovation in one or more countries, the faculty members, staff members, or students making the Invention, Discovery, Technology, or Innovation shall assist the university in preparing and prosecuting patent applications. The university will give due regard to its faculty, staff, and student inventors in making decisions with respect to patents on their inventions and keep its faculty, staff, and student inventors informed of the decisions the university makes. The university will provide appropriate support as necessary.

If the university decides to abandon a patent application, it first shall offer to assign the Invention, Discovery, Technology, or Innovation back to the faculty, staff, or student inventor, subject to the provisions of Section VII of the Policy on Patents and Scholarly Works and to any rights of the sponsor of the research leading to the Invention, Discovery, Technology, or Innovation.

#### **Distribution of Royalties**

When an Invention, Discovery, Technology, or Innovation is submitted to an external technology transfer agent, the university shall distribute to the inventor (or the inventors collectively) any proceeds received in connection with that entity accepting the Invention, Discovery, Technology, or Innovation for filing of patent applications.

When income is received by the university either from an external technology transfer agent, through commercialization of an assigned Invention, Discovery, Technology, or Innovation or from a university-owned Invention, Discovery, Technology, or Innovation, all expenses directly attributable to patenting, marketing, licensing, protecting, or administering the Invention, Discovery, Technology, or Innovation shall first be deducted from such income. The income remaining after these deductions constitutes "net income." Net income shall be allocated as follows:

<b>Net Income Distribution</b>				
	<b>Inventor(s)</b>	<b>Inventor's Department</b>	<b>Inventor's School</b>	<b>Research Office*</b>
<b>First \$100,000/yr.</b>	50%	20%	10%	20%
<b>Above \$100,000/yr.</b>	40%	20%	15%	25%

*\*Associate Vice President for Research and Graduate Studies (non-medical) or Associate Vice President for Health Research, Compliance, and Technology Transfer -- to be used for the purpose of promoting research in the university.*

When the Invention, Discovery, Technology, or Innovation is the result of the joint efforts of two or more university faculty, staff, or students, they shall use good faith efforts to agree upon the allocation between them of the royalties that would be payable to a single inventor pursuant to this Policy on Patents and Scholarly Works. In the event that an agreement cannot be reached between the inventors, the Associate Vice President for Research and Graduate Studies (non-medical) or the Associate Vice President for Health Research, Compliance, and Technology Transfer (Medical Center) shall determine an equitable distribution of the royalties, based on a recommendation formulated by the Patent and Scholarly Works Review Panel.

### **Invention Rights under Consulting Agreements**

Members of the faculty and staff may agree to assign to third parties for whom they consult the rights in Inventions, Discoveries, Technologies, or Innovations made in the performance of consulting services, provided that such an agreement is consistent with previous obligations under an agreement for sponsored research, the rights of the university as described in this Policy on Patents and Scholarly Works, or any other rights or obligations described herein. Prior to entering into any such agreements, members of the faculty shall notify in writing the Associate Vice President for Health Research, Compliance, and Technology Transfer for review and approval of the provisions concerning the assignment of inventions and also of provisions concerning inventions assigned to third parties pursuant to such agreements.

Absent such an agreement, rights in inventions made in the performance of consulting services will belong to the faculty member, unless an invention made in the performance of consulting services also constitutes an Invention, Discovery, Technology, or Innovation subject to this patent policy. Should guidance be required in this determination, the Associate Vice President for Health Research, Compliance, and Technology Transfer shall be the deciding official in consultation with and review

by the Patent and Scholarly Works Review Panel and/or outside experts in intellectual property management.

### **Other Inventions**

Faculty, staff, and students may assign Inventions, Discoveries, Technologies, or Innovations made on their own time, with their own facilities and materials, and unrelated to their scope of duties, to the university for administration on behalf of the university. If a faculty member, staff member, or student does so, the university will evaluate the invention pursuant to Section VI of the Policy on Patents and Scholarly Works and then take whatever steps the university deems appropriate. There can be no assurance that the university will seek patent protection for an Invention, Discovery, Technology, or Innovation so assigned. In the event the university does seek patent protection, the sharing of costs and revenues shall be established on an ad hoc basis in negotiation between the inventor and the university prior to seeking the patent. Such cases shall be guided by recommendations from the Patent and Scholarly Works Review Panel to the Associate Vice President for Research and Graduate Studies (non-medical) or the Associate Vice President for Health Research, Compliance, and Technology Transfer (Medical Center).

Persons who are not faculty, staff, or students of the university may approach the university with Inventions, Discoveries, Technologies, or Innovations needing further development before their advantages can be fully realized. Where such inventions fit into the research program of the university and where university personnel, with administrative approval, choose to pursue such further development, they may be assigned to the university pursuant to an agreement to be negotiated between the university and the inventor.

### **Supplemental Patent Agreements**

All faculty, staff, and students who may be expected to conduct research of any kind are bound by the terms of this Policy on Patents and Scholarly Works and should familiarize themselves with its content. Those faculty, staff, and students who conduct sponsored research of any kind shall be required, as a condition of employment or association with the university, to acknowledge that they are bound by the terms of this Policy on Patents and Scholarly Works by signing a university supplemental patent agreement in a form determined by the university's Associate Vice President for Health Research, Compliance, and Technology Transfer.

Any individual with emeritus faculty standing is considered to be subject to the conditions of this patent policy as long as that individual is actively associated with the university through a sponsored research project or is extensively using university facilities. Emeritus faculty, working on their own or with limited resources from the university, will not be subject to this policy unless they so choose to be covered.

Should there be question as to the amount of resources being used, a determination shall be made by the Associate Vice President for Research and Graduate Studies or the Associate Vice President for Health Research, Compliance, and Technology Transfer after consultation with and review by the Patent and Scholarly Works Review Panel.

Any individual, whose Invention, Discovery, Technology, or Invention is granted a patent through GW, and who subsequently leaves the university, is still subject to the conditions of this Policy on Patents and Scholarly Works with respect to said patent.

### **Disputes**

Disputes on patent matters, including the interpretation of this Policy on Patents and Scholarly Works, shall be referred to the Patent and Scholarly Works Review Panel for review and recommendation. Based on the Panel's recommendation, the Associate Vice President for Research and Graduate Studies (non-medical) or the Associate Vice President for Health Research, Compliance, and Technology Transfer (Medical Center) shall make a ruling on the dispute. Any appeal of a ruling by either official will be heard by the Vice President for Academic Affairs, who will make a recommendation to the President for his final ruling.

### **Periodic Review**

At least once every four years, the Patent and Scholarly Works Review Panel shall review the provisions of this policy and propose to the Advisory Council on Research changes that will maintain a Policy on Patents and Scholarly Works that serves the best interests of the university, faculty, staff, and students.

### **Changes**

The university administration and the Faculty Senate shall review this policy at least once every four years and following such review, shall jointly determine whether modifications to the policy are necessary or desirable to best serve the interests of the university and its Faculty and Librarians, Staff, and Students. Proposed amendments that result from such review and joint determination shall be presented by The Vice President for Academic Affairs to the Board of Trustees for final approval.

### **Implementation**

The Office of the Associate Vice President for Health Research, Compliance, and Technology Transfer is responsible for the implementation of this Policy on Patents and Scholarly Works. It is expected that this Office will undertake to promote the development and use of inventions and discoveries by holding periodic information sessions for faculty and staff on the patent process. In addition to these sessions, it

is expected that materials will be distributed university-wide that keep the faculty fully informed as to the number of patents sought and obtained along with other technology transfer successes. Generally, the Office of the Associate Vice President for Health Research, Compliance, and Technology Transfer is responsible for creating a proactively supportive environment for faculty interested in the invention and discovery process.

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## Definitions

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**Faculty:** means all those individuals receiving a letter of faculty or librarian appointment from the Vice President for Academic Affairs, with associated compensation from the university, whether of full-time, research, continuing part-time where on-campus research activity is involved, visiting, or other status.

**Staff:** means all those individuals receiving letters of appointment to either graded or ungraded positions, whether full-time, regular part-time, visiting, or other status, and receiving compensation from the university.

**Students:** means all those individuals associated with the university who are in active student status as defined by formal registration, whether full-time or part-time; whether or not holding a fellowship, a teaching assistantship, a research assistantship, or equivalent award, and whether or not receiving salary, wages, or a stipend. This term also applies to those individuals who have petitioned for and received a leave of absence for a specific period of time.

**Inventions, Discoveries, Technologies, and Innovations:** are terms that are meant to cover tangible or intangible inventions, including any process, machine, manufacture, composition of matter, or improvement thereof, which is or may be patentable, whether or not reduced to practice. These terms also are meant to cover tangible research and development results whether or not patentable. Such results include, for example, computer programs, circuit designs of all types, data bases, technical and design drawings, biogenic materials, novel varieties of plants, chemically synthesized molecular systems, and other creations. Such tangible results may also be subject to the university Copyright Policy, and to the extent of any overlap, the intent is to treat such items first under the Patent Policy, and then if not patentable to treat them under the Copyright Policy.

These terms apply to the faculty, staff, and students of The George Washington University in the performance of their scope of duties for the university or for a sponsored research project accomplished on university time, or with direct university funding, or the use of university facilities. The scope of duties includes the area or areas of expertise in which an individual is considered qualified to teach or do

research by his/her Department, and includes the application of this expertise in any field within or outside the individual's discipline.

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## Related Information

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[Copyright Policy](#)

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## Contacts

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Contact	Telephone	Email
Health Research Compliance & Technology Transfer	202-994-2995	
Research Services	202-994-7315	

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## Document History

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- **Last Reviewed Date:** July 2, 2018
  - **Last Revised Date:** April 30, 2005
  - **Policy Origination Date:** April 13, 1996
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## Who Approved This Policy

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Beth Nolan, Senior Vice President and General Counsel

Board of Trustees

Faculty Senate

*This policy, as well as all [university policies](#), are located on the [Office of Compliance's](#) home page.*