

# New York University

## UNIVERSITY POLICIES

<b>Title:</b>	Statement of Policy on Intellectual Property
<b>Effective Date:</b>	July 1, 2012
<b>Supersedes:</b>	<ul style="list-style-type: none"><li>- Statement of Policy on Patents, as approved on November 26, 1956 and amended through December 12, 1983</li><li>- Statement of Policy on Copyrights, as approved on January 24, 1972</li><li>- Statement of Policy on Computer Software Copyrights, as approved on June 5, 1989</li><li>- Policy on Tangible Research Property, effective date March 1, 2010</li></ul>
<b>Related Policies:</b>	<ul style="list-style-type: none"><li>- Policy on Academic Conflict of Interest and Conflict of Commitment</li><li>- Policy on Retention of and Access to Research Data</li><li>- Guidelines for Sponsored Research</li><li>- Statement of Policy on Photocopying Copyrighted Materials</li></ul>
<b>Issuing Authority:</b>	University Provost
<b>Responsible Officer:</b>	Senior Vice Provost for Research

### **Purpose of this Policy**

This Statement of Policy on Intellectual Policy comprises a Patent Policy, a Copyright Policy and a Tangible Research Property Policy. The Patent Policy guides the University Community in disclosing and managing inventions made at or under the auspices of NYU in a manner consistent with NYU's commitment to the public good, including: promoting research and scholarship, and facilitating the development, dissemination and commercialization of its inventions. The Copyright Policy identifies the situations in which copyrightable works may be created at or under the auspices of NYU, defines ownership and license rights for such works, and expresses NYU's commitment to disseminate and commercialize its copyrightable works consistent with the public good. The Tangible Research Property Policy addresses the ownership, distribution and commercialization of tangible items produced in the course of NYU's research, clinical or other activities, consistent with the public good.

### **Who Needs to Know This Policy**

This policy applies to all members of the "University Community." As used in this policy, "University Community" means: NYU faculty, including visiting faculty; researchers, including persons participating in research at or under the auspices of NYU; employees; professional staff, including medical, dental and nursing staff; volunteers; fellows, trainees and post-doctoral appointees; students; and any other persons involved in the creation of Inventions, Copyrightable Works and/or Tangible Research Property at or under the auspices of NYU, including consultants, vendors and contractors, irrespective of the source of funding for the creation.

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**PREAMBLE**

The mission of New York University (“NYU” or the “University”) includes the provision and promotion of education and research and the provision of patient and other clinical services. This mission is supported by well-established academic values and practices, including, among others: academic freedom; promotion of excellence and innovation in teaching and research; support of the ability of faculty and research staff to publish, share information, collaborate in research activities,

innovate and develop technologies that benefit the public; and support of students in full participation in these and other educational activities.

This Statement of Policy on Intellectual Property includes a **Patent Policy**, a **Copyright Policy**, and a **Tangible Research Property Policy**. It replaces the University's Statement of Policy on Patents, as approved on November 26, 1956 and amended through December 12, 1983; the Statement of Policy on Copyrights, as approved on January 24, 1972; the Statement of Policy on Computer Software Copyrights, as approved on June 5, 1989; and the Policy on Tangible Research Property, effective March 1, 2010. This Statement of Policy is subject to change at any time and from time to time, with the approval of the Board of Trustees of the University.

In certain cases, Inventions may be closely associated with non-patentable Copyrightable Works and/or Tangible Research Property and/or Research Data. Unless otherwise determined by the Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing), the Patent Policy applies to non-patentable Copyrightable Works and/or Tangible Research Property and/or Research Data closely associated with an Invention.

This Statement of Policy on Intellectual Property should be considered together with other pertinent NYU policies, including the NYU Policy on Academic Conflict of Interest and Conflict of Commitment, the NYU Policy on Retention of and Access to Research Data, the Guidelines for Sponsored Research, and the Statement of Policy on Photocopying Copyrighted Materials, which are available at [www.nyu.edu/about/policies-guidelines-compliance.html](http://www.nyu.edu/about/policies-guidelines-compliance.html).

This policy applies, among other things, to all research and other sponsored projects conducted by or under the auspices of NYU, whether funded by a US sponsoring agency, NYU or another funding source. It is the policy of NYU to comply with requirements imposed by a US sponsoring agency and by US law, including but not limited to the Bayh-Dole Act, and with requirements to which NYU has duly entered into or agreed to in connection with other funding sources and collaborators. This policy is believed to be in compliance with applicable US sponsoring agency requirements and US law. To the extent there is any issue about whether this policy wholly complies with applicable US sponsoring agency requirements and US law or with requirements to which NYU has agreed in connection with other funding sources and collaborators, it is to be interpreted to assure compliance. Additionally, research must be conducted in accordance with NYU policies, including this policy and the policies of a relevant School. Each member of the University Community is responsible for assuring his or her compliance with the requirements applicable to such person's specific research and other sponsored projects.

Certain defined terms used throughout this Statement of Policy on Intellectual Property are set forth in Appendix A.

The electronic version of this policy will, from time to time, be accompanied by "Frequently Asked Questions," which provide further guidance regarding a variety of practical situations.

## **PATENT POLICY**

### **I. PREAMBLE**

NYU is dedicated to teaching, scholarship, research, the provision of patient and other clinical services and the expansion of knowledge. While NYU encourages these activities for their intrinsic value, it recognizes that Inventions may result from various activities conducted wholly or in part at or under the auspices of NYU. This policy expresses NYU's commitment to promote the use of Inventions for the public good, including: promoting research and scholarship, and facilitating the development, dissemination and, where appropriate, commercialization of Inventions.

This policy defines ownership rights relating to Inventions and ensures that the proceeds from any commercialization are distributed in a manner approved by NYU's Board of Trustees and consistent with the mission of NYU.

This policy also guides members of the University Community in complying with NYU's legal and contractual obligations, including under the Bayh-Dole Act.

For all Inventions that are subject to NYU ownership under this policy, it is within NYU's sole discretion to determine whether to seek patent protection and to pursue commercialization of such Inventions. NYU's Office of Industrial Liaison (the "OIL") is responsible for managing on behalf of NYU all activities relating to the protection and commercialization of intellectual property.

### **II. SCOPE AND ACCEPTABILITY**

This policy applies to all Inventions (including any closely associated Copyrightable Works and/or Tangible Research Property and/or Research Data) conceived, reduced to practice or developed, in whole or in part, by members of the University Community. "Invention" refers to any novel idea, discovery, invention, know-how, show-how, or process, whether or not patentable, together with any associated or supporting technology necessary or useful for the protection, development or application of the idea, discovery, invention, know-how, show-how, or process, and also includes all patents and patent rights derived from that Invention, and all non-patentable Copyrightable Works, Tangible Research Property and Research Data that are closely associated with the Invention. "Closely associated with" includes useful in practicing the patent, in effectively prosecuting the patent application or in maximizing the licensing potential or other commercialization of the Invention.

### **III. OWNERSHIP OF INVENTIONS**

#### **A. General Rule**

(1) NYU Ownership. Except as otherwise provided in this Section III, Inventions that are conceived, reduced to practice or developed by members of the University Community are owned by NYU if conceived, reduced to practice or developed, in whole or part: (1) in the scope of NYU employment or other duties at or for NYU; or (2) in connection with training, research or clinical activities at or under the auspices of NYU; or (3) with Substantial Use of University Resources; or (4) the Invention is subject to the rights of research sponsors or other third parties under

agreements duly entered into or agreed to by NYU; In such cases, it is presumed that NYU owns every Invention made by a member of the University Community.

(2) Non-NYU Owned Inventions. Where a member of the University Community provides to the OIL clear and convincing evidence that an Invention was conceived, reduced to practice and developed entirely outside of the scope of the person's NYU employment, duties, training, research and/or clinical activities at, for or under the auspices of NYU, on the person's own time and without the Substantial Use of University Resources, NYU will not assert ownership rights to such an Invention unless the Invention is subject to the rights of research sponsors or other third parties under agreements duly entered into or agreed to by NYU (see Section III.B. of this policy). In such instances, the Invention may be owned directly by the member of the University Community or may be assigned freely by the Inventor (for example, to an entity with whom the member is consulting, in accordance with Section IV. of this policy regarding Outside Consulting Activities).

(3) Scope of NYU Employment. Inventions conceived, reduced to practice or developed, in whole or part, by full-time academic members of the University Community are deemed made in the scope of NYU employment or other duties at or for NYU and owned by NYU under this Section III.A. if such Inventions are within the broad academic field or area of teaching, scholarship, research or clinical activities in which such academic member of the University Community is engaged. However, there are exceptions for Inventions conceived, reduced to practice and developed by NYU faculty solely during an unpaid leave as set forth in Section III.C. of this policy, for Inventions conceived, reduced to practice and developed by students as part of their uncompensated class work as set forth in Section III.E. of this policy, for Inventions conceived, reduced to practice and developed during outside consulting as set forth in Section IV of this policy, and for Inventions which NYU agrees in writing to release to a member of the University Community pursuant to Section VI.E of this policy. Where a member of the University Community has a question about whether an activity that might give rise to an Invention is within the scope of employment, he or she may seek a determination from the School Dean, who will consult with the OIL, where necessary before providing guidance.

#### B. Contractual Obligations to Sponsors and Others

Notwithstanding anything to the contrary in this policy, all rights of NYU and of members of the University Community under this policy are subject to the rights of research sponsors or other third parties under agreements duly entered into or agreed to by NYU. In addition, nothing in this policy is intended to limit the express contractual or legal rights of NYU (e.g., NYU owns an Invention conceived, reduced to practice and developed solely by an NYU student as part of uncompensated class work if the student has agreed in writing that NYU owns it).

#### C. University Faculty on Leave and/or Visiting Other Institutions

In general, Inventions conceived, reduced to practice or developed by NYU faculty during a paid leave (whether at NYU or elsewhere, including another institution or a company) are owned by NYU.

NYU will not claim ownership of Inventions conceived, reduced to practice and developed by NYU faculty solely during an unpaid leave unless: (1) Substantial Use of University Resources was involved in the conception, reduction to practice and/or development of the Invention; (2) the

activity of the NYU faculty in conceiving the Invention, reducing it to practice or developing the Invention violated NYU's conflict of interest policies; or (3) the Invention is subject to the rights of research sponsors or other third parties under agreements duly entered into or agreed to by NYU.

If an Invention was conceived during an unpaid leave and reduced to practice and/or developed after the faculty member's return to NYU (after the unpaid leave ended), the Invention is wholly owned by NYU, unless another institution has legitimate ownership rights, in which case the Invention is jointly owned by NYU and the other institution. Similarly, if an Invention was conceived or developed before the unpaid leave began and was reduced to practice while the faculty member was on leave, the Invention is wholly owned by NYU, unless another institution has legitimate ownership rights, in which case the Invention is jointly owned by NYU and the other institution.

In cases in which there are potential conflicts between NYU's policies and those of an institution at which a faculty member will be or has been on leave and/or visiting, such conflicts will be resolved through good faith negotiations between NYU and such institution, preferably before the leave or visit begins. All such negotiations will be conducted on behalf of NYU by the OIL, normally in consultation with the faculty member.

#### D. Visitors from Other Institutions (Non-Employees)

In general, Inventions conceived, reduced to practice or developed by visitors from other institutions (home institutions), including visiting faculty and scholars, while participating in research, clinical or other activities at or under the auspices of NYU are wholly owned by NYU. Such visitors often are subject to intellectual property policies of their home institutions. Accordingly, where it is anticipated that there is a reasonable possibility that a visitor will conceive, reduce to practice or develop an Invention while working at or under the auspices of NYU, Schools and units are encouraged to contact the OIL so it can determine whether an agreement with the visitor's home institution is advisable prior to the start of the visit. Any conflicts between NYU and the home institution of a visitor will be resolved through good faith negotiations between the OIL and such home institution.

#### E. Graduate and Undergraduate Students

The principles described below apply to students enrolled at NYU and non-enrolled students who are visiting NYU.

(1) Class Work. In general, NYU will not claim ownership of Inventions conceived, reduced to practice and developed by students as part of their uncompensated class work. For purposes of this policy, student compensation excludes financial aid without a work requirement

(2) Other. When a student, solely or jointly, conceives, reduces to practice, or develops an Invention in the course of (a) sponsored research (e.g., under a graduate or research fellowship or assistantship), including research for the student's thesis or dissertation, (b) any research or other activity involving Substantial Use of University Resources, (c) participation as a team member in a University project involving other members of the University Community (unless all participating members of the University Community are students acting in the capacity of students) or (d) employment or other compensated duties at NYU, the Inventions are the property of NYU and the

student shares in the proceeds, if any, as an Inventor, in accordance with Section V.B. of this policy. By way of example, a student is not considered to be acting as a student for purposes of this policy if the student conceives an Invention, reduces it to practice or develops it as an employee of NYU, even if employment related to the student's intellectual discipline is a condition of the student's academic program at NYU.

#### F. Contractors/Vendors/Consultants Hired by the University

Inventions conceived, reduced to practice or developed as a result of a contractor/vendor/consultant's work for NYU are the property of NYU, unless other arrangements have been explicitly agreed to in a writing duly entered into in advance by NYU. Contractors/vendors/consultants should be hired only pursuant to a prior written agreement in a form approved by NYU's Office of General Counsel; however, failure to do so will not diminish NYU's rights under this policy.

#### G. Research Data

NYU's ownership of and rights to all Research Data closely associated with an Invention owned by or assignable to NYU is governed by this policy.

#### H. Publication of Research Results

NYU's ownership of Inventions is not intended to prevent the presentation and publication of research results. Subject to the obligation to disclose Inventions to the OIL as set forth in Section VIII of this policy and subject to any obligations to third parties, faculty and the relevant members of the University Community retain their traditional role in selecting and preparing for publication the results of research conducted by them or under their supervision. NYU reserves the right to delay presentation or publication for a reasonable period of time if such delay is necessary or useful to protect NYU's intellectual property rights or to meet legal or contractual obligations, but any review or delay periods will not exceed a total of 90 days unless authorized by the Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing).

#### I. Assignment

Each member of the University Community is deemed to have made an assignment to NYU, effective as of the date such person first became a member of the University Community, of any right, title and/or interest in any Invention, to the extent such right, title and/or interest is owned by NYU as set forth in this policy. Such persons continue to have the obligations set forth in this policy, including under Section VIII of this policy.

### **IV. OUTSIDE CONSULTING ACTIVITIES**

A. Faculty, research staff and others subject to this policy who engage in outside consulting activities must do so in compliance with all NYU policies, including, but not limited to, this policy, NYU's conflict of interest policies (see, e.g., "NYU Policy on Academic Conflict of Interest and Conflict of Commitment") and policies of the relevant School or unit. Faculty, research staff and others subject to this policy who engage in outside consulting activities also should consider any guidelines provided by the Office of General Counsel for consulting agreements.

B. NYU will make no claim to an Invention made by a faculty member or research staff member in the course of a consulting engagement that is consistent with the terms of this Section IV if: (1) the Invention results from work on a problem or topic (a) proposed by the company for which the faculty member or research staff member is consulting and (b) on which the faculty member or research staff member has not engaged in research, and does not have plans to engage in research, at or under the auspices of NYU; (2) the Invention is conceived, reduced to practice and developed without the Substantial Use of University Resources; (3) the Invention is not conceived, reduced to practice or developed in the person's NYU employment, duties, training, research and/or clinical activities at, for or under the auspices of NYU; (4) the consulting agreement is approved in advance in writing where advance approval may be required pursuant to any specific School and/or unit policies; and (5) the consulting activity is not for a company that (a) has licensed such person's Inventions, Copyrightable Works or Tangible Research Property from NYU or (b) is sponsoring research in which such person participates. NYU also will make no claim to an Invention made by a faculty member or research staff member in the course of a consulting engagement if NYU, through the School Dean and the OIL, has received, reviewed and approved in advance in writing the consulting engagement and consulting agreement (including the problem, topic and/or statement of work) and the Invention is made consistent with such advance approval. In all other situations, NYU is the owner of the Invention, subject to any written agreements to the contrary duly entered into or agreed to by NYU.

C. Even where an Invention resulting from outside consulting activities is not owned by NYU, each Inventor is responsible for assuring that all such Inventions are properly disclosed to the OIL where required under Section VIII.B. of this policy.

## **V. COMMERCIALIZATION OF INVENTIONS**

A. NYU is committed to facilitating the development, dissemination and, where appropriate, commercialization of Inventions for the greatest public benefit. Accordingly, when NYU owns the rights to an Invention, NYU has the sole right, either directly or through others, to commercialize such Invention or otherwise make it available for public use. Such efforts may include, but are not limited to, licensing to an existing company or the establishment of a new company or venture, in each case as determined by NYU. In all cases, decisions regarding Inventions owned by NYU are made at the sole discretion of NYU, and NYU has no liability to any Inventor, other person with rights under this policy or third party for such decisions.

B. When NYU owns the rights to an Invention, each Inventor has the right to share in the Net Proceeds received by NYU from commercializing the Invention except as otherwise provided in this policy. Specifically, Net Proceeds ordinarily are distributed as follows:

(1) Fifteen percent (15%) of the Net Proceeds for the general support of the OIL and to cover any other expenses associated with the commercialization of NYU's Inventions. In cases where the funds so designated exceed the budget of the OIL, the remainder are allocated to the NYU share as per Paragraph 2.b below; and

(2) The remaining Net Proceeds (85%) are distributed as follows:



- (a) Inventor share: one-half (or 42.5% of Net Proceeds) to the Inventor or Inventors (including Inventors outside of NYU).
- (b) One-half (or 42.5% of Net Proceeds) to be used by NYU for research, scholarship, educational and clinical activities (or as otherwise required by law, regulation or contract) in the following manner:
  - (i) Two-thirds to the School (or other NYU unit if the Inventor is not affiliated with a School) in which the Invention was made. Each School or other unit receiving royalty proceeds must develop and disseminate a policy for the use of such proceeds that is in accordance with the overall aims outlined in Section V.D. of this policy.
  - (ii) One-third to NYU. In recent years, for Inventions made in the School of Medicine, NYU's practice has been to contribute a large portion of its one-third share to the School of Medicine in light of financial circumstances.

If NYU pursues or defends litigation to enforce rights, then the proceeds of any judgment or settlement received by NYU from such litigation ordinarily will be included in Gross Proceeds, on a net basis, with the associated litigation expenses paid by NYU deducted as out-of-pocket expenses. If NYU becomes involved in litigation regarding the Invention, or closely associated Copyrightable Works, Tangible Research Property or Research Data, the distribution described above may be modified by the Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing), in his/her sole discretion, to reflect the greater economic risk being incurred by NYU in pursuing such litigation.

Except as provided below, Inventors who are employees of NYU are entitled to share in the Net Proceeds from commercialization of an Invention as outlined in this Section V.B. The following Inventors are not entitled to share in the Net Proceeds from commercialization of the Invention (i.e., they are not included within this Section V.B.): (i) contractors/vendors/consultants of NYU and (ii) employees of NYU, other than faculty or research staff, unless NYU agrees to their inclusion in writing signed by the Provost or The Executive Vice President or the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing, as applicable. In any individual employee case, the supervisor of such an employee or the relevant project leader may make a recommendation (will make a recommendation if requested by the employee) as to the appropriateness of such employee sharing in the proceeds of commercialization and the Provost, The Executive Vice President or the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing (or his/her designee), as applicable, will determine if and the extent to which the employee is included. The decision of the Provost or The Executive Vice President or the Executive Vice President for Health (or his/her designee) is final. For Inventors who are not entitled to share in the Net Proceeds under this policy, the portion of proceeds attributable to said Inventor(s) under Section III.E. of this policy will be distributed in full to NYU and NYU shall be entitled to exercise all other rights given to joint Inventors under this policy.

Individuals sharing proceeds under this policy are responsible for understanding the personal tax and legal consequences to them of such entitlements pursuant to this policy.

C. Equity received by NYU from a company or other entity as a part of the consideration of a license or other disposition of an Invention will be allocated by calculating the appropriate number of shares, using the same percentages outlined in Section V.B. of this policy. Unless otherwise required by contractual arrangements, a management plan pursuant to an NYU conflict of interest policy, or applicable law, NYU normally will hold the shares until there is a public market for those shares or other liquidity event, and NYU will thereafter make appropriate distribution following NYU's or its agent's liquidation of the shares. Notwithstanding the foregoing, NYU may, in its sole discretion, (1) elect to hold the shares after there is a public market or other liquidity event or (2) elect to distribute equity at or any time after it is received by NYU or (3) require that the Inventor receive such equity directly from the company or other entity. NYU is not responsible, and has no liability, for any fluctuation or dilution in the value of the shares, for any tax consequences to the person receiving a distribution or for any other matters relating to NYU's administration of such shares or interests pursuant to this policy.

In the event that NYU elects to invest cash in a company or other entity to which NYU has licensed rights hereunder, and NYU receives equity for such investment, such investment will not be considered (1) an out-of-pocket expense of NYU for which reimbursement would be made under Section V.B. of this policy or (2) Gross Proceeds from the licensing or other grant of rights for purposes of Section V.B. of this policy. NYU will retain all proceeds and bear all losses from such equity investment.

To the extent that cash payments made to NYU under any licensing arrangement do not fully cover the out-of-pocket expenses of NYU under Section V.B. of this policy, NYU will be reimbursed for such expenses by an allocation of equity from that licensing arrangement prior to any distribution of equity pursuant to this Section V.C. Monies received by NYU pursuant to a license or other disposition of an Invention may be required to be escrowed by NYU to cover a contingent liability under the license or disposition agreement. Ordinarily, no disbursements will be made under this policy until the monies are released from such escrow.

Individuals with rights to equity interests under this policy are responsible for the personal tax and legal consequences to them of owning and/or having rights to such equity, whether directly or beneficially, pursuant to this policy.

D. NYU and School (or other unit) shares of proceeds will be used to further the research, scholarship, educational and clinical activities of NYU (or as otherwise required by law, regulation or contract).

E. If more than one Inventor is to share in the Inventor share provided in Section V.B. of this policy, the Inventors should decide among themselves their respective shares and provide the OIL with a written agreement signed by all Inventors. Such written agreement among the Inventors must be provided promptly to the OIL upon a written request from the OIL for such an agreement and will be irrevocable unless it is modified in writing by all Inventors. In the absence of such a written agreement, NYU will determine the distribution of shares to Inventors, which may in NYU's sole discretion vary based on individual patents or patent applications, contributions to and commercial relevance of the Inventions or other factors, and such determination will be binding on all Inventors. NYU has the right at any time, in its sole discretion, to reapportion distributions among the Inventors to reflect the commercial relevance of an Invention or the particular rights contained within an Invention. NYU will support such decisions with a written rationale, and any

apportionment or reapportionment will be subject to the appeal rights set forth in Section VIII.D. of this policy. If the Inventors represent more than one School or other NYU unit, the distribution of the School or unit share will follow the allocation of the Inventor share set forth in the agreement among the Inventors or NYU determination, as applicable, unless otherwise agreed.

F. Where non-patentable Copyrightable Works, Tangible Research Property and/or Research Data are included within an Invention because they are closely associated with the Invention, the persons creating or contributing to the Copyrightable Works, Tangible Research Property and/or Research Data are not Inventors entitled to share in the Inventor's share pursuant to Section VII.B. of this policy. In the case of non-patentable Copyrightable Works and Tangible Research Property, the creators and/or contributors may receive an economic benefit if the Copyrightable Works and/or Tangible Research Property is licensed or otherwise commercialized as part of an Invention. In such case, the OIL will determine the percentage, if any, of any ultimate Net Proceeds that are expected to be attributable to the Copyrightable Works and/or Tangible Research Property and such percentage will be payable to the creators and/or contributors pursuant to the Copyright Policy and Tangible Research Property Policy, as applicable; and such allocation will reduce the Net Proceeds available for distribution under this policy. Creators or contributors of Research Data are not entitled to any economic benefit from such commercialization. For example, if non-patentable software and Tangible Research Property are closely associated with a patentable Invention and the Invention, including the software and Tangible Research Property, are licensed to a third party, and the OIL determines that ten percent of any proceeds are attributable to the software and zero percent of any proceeds are attributable to the Tangible Research Property, then 90 percent of the Net Proceeds are distributable pursuant to Section V.B. of this policy and 10 percent of the Net Proceeds are distributable pursuant to Section XIII.B. of the Copyright Policy.

G. Whenever NYU licenses rights to an Invention, NYU will seek to reserve the right for NYU to use the Invention for any purpose consistent with NYU's mission, including research, clinical and educational purposes, except in rare cases approved by the Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing), and NYU may reserve the right to grant similar rights to other nonprofit research institutions.

## **VI. TRANSFERRING OR RELEASING OWNERSHIP OF INVENTION TO THE INVENTOR**

A. If NYU determines it will not pursue patenting and/or commercialization of an Invention subject to NYU ownership under this policy, NYU will consider a written request by the Inventor to transfer ownership in the Invention to the Inventor as provided herein, subject to the terms (including required approvals from government or other sponsors) of any applicable grants, contracts or agreements duly entered into with governmental, corporate, nonprofit or other sponsors or third parties (including but not limited to any "march-in" rights held by the US Government under the Bayh-Dole Act). Transfer of ownership to the Inventor generally will be subject to an irrevocable non-exclusive world-wide royalty-free license to NYU to use the Invention for education, research (including sponsored research), clinical and other legitimate NYU purposes and may be subject to a reservation to NYU of the right to grant similar licenses to other nonprofit institutions and government organizations. In those instances in which there are multiple Inventors, all Inventors must be in agreement and be party to such a request, although all Inventors need not be seeking ownership or equal rights. If NYU (1) has not begun the process of filing a patent application or otherwise begun marketing and/or commercialization efforts within 120 days after a

completed Invention Disclosure has been submitted to the OIL on the Invention or (2) has notified the Inventor(s) that it will abandon the Invention and/or its patent application(s) and/or patent(s) and/or marketing and/or commercialization, an Inventor may make such a request. In the event that the 120-day waiting period would result in a loss of patent rights, an Inventor may make such request at any time, and must in such case include an explanation for the timing of the request in the request. In all cases, decisions regarding transfer of ownership in Inventions are at the sole discretion of NYU, and NYU has no liability to any Inventor, other person with rights under this policy or third party in connection with such decisions.

B. If, after the transfer of ownership to the Inventor pursuant to a request made under Section VI.A. of this policy, the Inventor receives proceeds from commercializing the Invention, NYU may require reimbursement from the Inventor for any out-of-pocket expenses incurred by NYU in connection with the Invention, including legal, commercialization and marketing expenses.

C. The transfer of ownership of an Invention to the Inventor does not affect NYU's rights or the Inventor's obligations pursuant to this policy with respect to other Inventions. For example, if the Inventor invents an improvement to the transferred Invention for which a continuation-in-part patent application could be filed, the Inventor must fully disclose such improvement as a new Invention to NYU, which may claim ownership of such new Invention.

D. Often when NYU seeks patent protection for an Invention, it seeks it only in the US and certain other countries. If the Inventor wishes to file patent applications in a country other than the US in which NYU has chosen not to file, the Inventor may request permission to do so at his/her own expense. In the case of multiple Inventors, all Inventors must agree and be party to the request, although all Inventors need not agree to participate in the expense of such filings. NYU, in its sole discretion, will decide if permission is granted. Because the existence of patent rights that are not owned by NYU in particular countries could block a licensee of the patents that NYU has pursued from commercializing the Invention in such countries, and could therefore impede NYU's ability to most effectively license the patents that it has pursued, NYU will retain ownership of all patent applications filed and all patents issued (US and non-US) for the Invention. If NYU receives separate revenues that are or can be directly attributed specifically to such patent applications and patents for which the Inventor has solely paid expenses, the Inventor's share of Net Proceeds from such revenue will be increased from 42.5% to 63.75%, and the School (or unit) and NYU shares will be reduced pro rata in order to recognize both the expenses incurred by NYU in the preparation of the US application that will serve as the basis for the non-US applications and the expenses incurred by the Inventor on the non-US applications. Where no such separate revenue may be identified, and NYU licenses its rights as a part of an overall portfolio, NYU will, in its sole discretion, determine if the filings by the Inventor increased the Net Proceeds and, if so, determine an equitable sharing to reflect Inventor's additional contributions. The Inventor also may request reimbursement of out-of-pocket patent expenses he/she incurred in filing such non-US patent applications and in obtaining and maintaining resulting patents from Gross Proceeds attributed specifically to such non-US patent applications and patents. In those instances, the Inventor must provide NYU with copies of all documents relating to such non-US filings, including, but not limited to, all documents sent from and submitted to any non-US patent office and documents showing the costs of obtaining such protection.

E. If an Inventor of an Invention subject to this policy believes an Invention should not be subject to NYU's ownership rights under this policy because (1) the Invention can be shown by

clear and convincing evidence to be outside of NYU's ownership rights in accordance with Section III.A(2) of this policy, (2) the Invention was made solely during an unpaid leave as set forth in Section III.C. of this policy, (3) the Invention was made by student(s) as part of uncompensated class work as set forth in Section III.E. of this policy, (4) the Invention was made in outside consulting and is consistent with the requirements set forth in Section IV.B. of this policy, or (5) otherwise, the Inventor may request through the OIL a determination as to whether NYU will assert ownership rights to the Invention under this policy. In the case of multiple Inventors, all Inventors should agree and be party to the request. In connection with the request, the Inventor(s) must provide the OIL with a summary of the circumstances leading to the conception, reduction to practice and development of the Invention. The Provost, The Executive Vice President or the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing, as applicable, in consultation with the OIL and the School Dean(s), will make a determination in writing on whether to assert ownership rights in such Invention or to release such Invention to the Inventor(s). It is expected that the written determination will be provided to the Inventor(s) within thirty (30) days of date of the OIL receives sufficient information regarding the Invention for NYU to make such a determination. In all cases, decisions regarding releasing of ownership in Inventions are at the sole discretion of NYU, and NYU has no liability to any Inventor, other person with rights under this policy or third party in connection with such decisions.

## **VII. MAKING NYU-OWNED INVENTIONS AVAILABLE FOR PUBLIC USE**

NYU, in its sole discretion, normally after consultation with the Inventor(s), may make Inventions available for public use on a royalty-free license or other means on such terms as it finds appropriate where it believes that the advantages of making such Inventions available for public use outweigh alternative commercialization strategies and there are no legal or contractual obligations that prohibit the public use. The Inventor of an Invention owned by NYU may request that NYU make such Invention available for public use on a royalty-free license or other means. Such request should be transmitted to the OIL in writing. In the case of multiple Inventors, all Inventors should agree and be party to the request. The Provost, The Executive Vice President or the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing, as applicable, will make a determination with respect to the request (see Section VIII.F. of this policy).

## **VIII. ADMINISTRATION OF POLICY**

### **A. University Administration**

This policy will be administered by the Provost and The Executive Vice President, except in the Schools of Medicine, Dentistry and Nursing, where the policy will be administered by the Executive Vice President for Health. The Provost, The Executive Vice President or the Executive Vice President for Health may obtain advice from the Intellectual Property Advisory Committee and the Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing) will consult with the School Deans, as appropriate. Further information about the Intellectual Property Advisory Committee and administration of this policy is contained in Appendix B.

## B. Disclosure of Inventions

(1) Inventors must, at the earliest opportunity practicable, complete an Invention Disclosure Form, which is available on the OIL's Web site at <http://www.nyu.edu/oil>, with respect to any Invention that might be subject to NYU ownership under the terms of this policy. Ordinarily, because international patent rights will be lost if information describing an Invention has been published prior to filing of a patent application, notice and disclosure of an Invention should be made to NYU through its OIL at least three months prior to any public disclosure (including but not limited to publication or presentation, such as at poster sessions or academic conferences); but, in any event prior to any public disclosure (written or oral), public display, use of, or offer to sell or convey the Invention. If an Inventor believes that early disclosure of an invention may impede research or collaboration, or otherwise is inadvisable, he or she should discuss the circumstances with the OIL, which will assist in developing a reasonable time schedule for disclosure. It is the obligation of each Inventor to ensure that the completed Disclosure Form provides full disclosure to NYU, including that NYU is: (a) fully informed of the scope, extent and usefulness of the Invention; (b) able to make a proper determination of Inventorship and ownership; (c) able to fulfill reporting obligations to governmental and other research sponsors; and (d) able to timely file patent applications. An Inventor's obligation to disclose as set forth herein continues after the Inventor ceases to be a member of the University Community with respect to Inventions covered under this policy.

(2) If there is any possibility that NYU has ownership rights in an Invention, the Inventor must disclose the Invention to NYU as set forth in this policy even if an Inventor believes that NYU has no ownership rights to the Invention. Inventors are encouraged to disclose all Inventions to NYU, under confidentiality where appropriate, that are conceived, reduced to practice or developed in whole or in part while the Inventor is a member of the University Community even if NYU clearly has no ownership rights to the Invention.

(3) Upon disclosure of an Invention, NYU will determine whether or not ownership vests in NYU pursuant to this policy.

## C. Inventor Cooperation with NYU Ownership Rights

If NYU maintains ownership rights to the Invention pursuant to this policy, NYU has the right, either directly or through others, to evaluate the Invention, to seek patent or other protection of the Invention, and to undertake commercialization and/or otherwise introduce the Invention into public use. Each Inventor is required to cooperate as reasonably requested by NYU, and in every necessary way, but at no out-of-pocket expense to the Inventor, with NYU's efforts, including, without limitation, executing confirmatory assignments or agreements documenting NYU's ownership, executing documents necessary or useful for prosecuting or enforcing patents and patent applications in the US or in any other jurisdiction or with respect to the commercialization the Invention or its introduction into public use, and providing reasonable advisement regarding the Invention to companies who have acquired rights to the Invention pursuant to this policy. An Inventor's obligation to cooperate as set forth herein continues after the Inventor ceases to be a member of the University Community with respect to Inventions covered under this policy.

## D. Agreement to Policy

This policy is binding on NYU and on all members of the University Community. All members of the University Community are advised of NYU's policies and procedures relating to intellectual property through publication on NYU's website at [www.nyu.edu](http://www.nyu.edu). To the extent NYU requires formal confirmation of patent assignment or other agreements to implement this policy, the absence of such executed agreements does not in any way invalidate, in whole or in part, the applicability of this policy or diminish NYU's rights under this policy. Nothing in this policy constitutes a waiver by NYU of any rights that NYU may have under any other NYU policy, by contract or pursuant to any applicable law.

#### E. Intellectual Property Agreement

Each member of the University Community must sign and submit an Intellectual Property Agreement (see Appendix C) when first submitting an external grant application, when first engaging in sponsored programs, or in certain Schools on accepting an appointment to NYU; and must sign and submit an Intellectual Property Agreement at any time upon request of the Provost, The Executive Vice President or the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing. All program directors or principal investigators of sponsored programs are responsible for securing signatures to the Intellectual Property Agreement from all research personnel, including students, working on a project at the time of their appointment to the project and for the timely submission of the fully-executed Agreement as set forth on the Intellectual Property Agreement. Notwithstanding the above, the failure of NYU to obtain a signed Intellectual Property Assignment does not in any way diminish NYU's rights under this policy.

#### F. Disputes

Disputes involving intellectual property rights or this policy will be reviewed and resolved by the Provost and/or The Executive Vice President or by the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing, as applicable, unless a decision is deemed final pursuant to this policy. The Provost, The Executive Vice President and/or the Executive Vice President for Health may within their sole discretion refer the matter to the Intellectual Property Advisory Committee or another designee to adjudicate the matter or to make a formal recommendation to the Provost and/or The Executive Vice President or to the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing, as applicable. Adjudications made hereunder by the Intellectual Property Advisory Committee or another designee of the Provost, The Executive Vice President and/or the Executive Vice President for Health may be appealed, within thirty days of the date of the decision, to the Provost and/or The Executive Vice President or to the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing, who will review the matter and make a final decision on behalf of NYU. If the Provost and/or The Executive Vice President or the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing are not able to review the matter and make a final decision on behalf of NYU, for example due to conflict or unavailability, the appeal will go instead to the President or the President's designee, who will review the matter and make a final decision on behalf of NYU. The persons involved in the dispute should present a written summary of the matter with relevant written evidence and may ask to present witnesses, which may be permitted in the discretion of the recommending or adjudicating person or persons or committee. The recommending or adjudicating person or persons or committee may consult with the Intellectual Property Advisory Committee, the relevant School Dean, other officers and personnel of NYU, and/or any experts or witnesses as they may deem appropriate.

#### G. Advisory Committee

The Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing) may from time to time appoint an Intellectual Property Advisory Committee with broad or specific responsibilities relating to all intellectual property matters (which may include, without limitation, Inventions, patents, Copyrightable Works, copyrights, software, Tangible Research Property and Research Data). The Intellectual Property Advisory Committee's role is to advise the OIL, the Provost, and/or the Senior Vice Provost for Research, except in the Schools of Medicine, Dentistry and Nursing, where the Committee's role is advisory to the School Dean and the Executive Vice President for Health.

#### H. Administration by Schools and Units

(1) The School Deans will work closely with the Provost and the Intellectual Property Advisory Committee to ensure that the perspectives, practices and values of each School are taken into consideration in the decision-making process under this policy.

(2) Each School of NYU retains the right to supplement this policy as necessary or desired by such School, including requiring formal patent assignment or agreements of its employees or others subject to this policy or such School's policies. The Provost may permit academic units other than Schools, The Executive Vice President may permit non-academic units and the Executive Vice President for Health in the case of the School of Medicine, Dentistry and Nursing may permit any of their academic and non-academic units to supplement this policy as necessary or desired by such unit, including requiring formal patent assignment or agreements of its employees or others subject to this policy or such unit's policies. The decision of any School or unit not to secure formal intellectual property agreements from any person does not diminish NYU's rights under this policy. Any supplement must be: (a) consistent with the terms of this policy (or an exception approved in accordance with the Policy on Policies); (b) in writing; (c) approved by the School Dean of a relevant School in the case of a School; and (d) submitted to the Provost for review and approval in the case of a School or academic unit, to The Executive Vice President in the case of a non-academic unit and to the Executive Vice President for Health in the case of the School of Medicine, Dentistry and Nursing and any of their academic and non-academic units. A supplement may contain dispute resolution procedures that operate within a School, provided that such procedures are not inconsistent with this policy and provide for resolution pursuant to Section VIII.E. of this policy in the event that such dispute cannot be resolved within the School.

#### I. Governing Law

This policy is governed by and construed in accordance with the laws of the US and the State of New York, including US laws of inventorship; provided however, that where the only persons who may be Inventors are non-US nationals and all of the work giving rise to the Invention was performed outside of the United States, NYU may, in its sole discretion, apply a relevant international law to questions of law governing intellectual property, including questions of inventorship.



## **COPYRIGHT POLICY**

### **IX. PREAMBLE**

NYU is dedicated to teaching, scholarship, research, the provision of patient and other clinical services and the expansion of knowledge. While NYU encourages these activities for their intrinsic value, it recognizes that Copyrightable Works may result from various activities conducted wholly or in part at or under the auspices of NYU. This policy expresses NYU's commitment to promote the use of Copyrightable Works for the public good, including: promoting research and scholarship, and facilitating the development, dissemination and, where appropriate, commercialization of Copyrightable Works.

This policy defines ownership and license rights relating to Copyrightable Works and ensures that the proceeds from any commercialization are distributed in a manner approved by NYU's Board of Trustees and consistent with the mission of NYU.

This policy also guides members of the University Community in complying with NYU's legal and contractual obligations.

For all Copyrightable Works that are subject to NYU ownership under this policy, it is within NYU's sole discretion to determine whether to seek additional copyright protection and to pursue commercialization of such Copyrightable Works. NYU's Office of Industrial Liaison (the "OIL") is responsible for managing on behalf of NYU all activities relating to the protection and commercialization of intellectual property.

US and other international copyright rights arise upon creation of any original work of authorship that is reduced to, or "fixed" in, tangible form. Ownership of copyright provides the owner with the exclusive rights to reproduce, make derivative works, distribute, copy, license, perform and/or publicly display the Copyrightable Works. Under US copyright law, Copyrightable Works created by employees in the scope of employment are owned by their employers. Such works are commonly referred to as "works for hire." However, universities, including NYU, have historically declined to assert their ownership rights to Traditional Works of Scholarship created by faculty.

This policy reaffirms NYU's commitment to embrace the general concept of scholarly works, and broadly applies it to include not only traditional print media, but also where content historically associated with scholarly works is in digital form. This policy balances the recognition of Traditional Works of Scholarship against NYU's need to preserve its rights to effectively deliver academic content throughout and beyond its global network of campuses and facilities, including through digital means. This remains a fluid area of both law and technology, particularly in the delivery and dissemination of academic and research content.

### **X. SCOPE AND ACCEPTABILITY**

A. This policy applies to all Copyrightable Works created in whole or in part by members of the University Community. "Copyrightable Work" refers to any original work of authorship that is reduced to tangible form (including web pages and digital works), and includes literary works, computer software, data sets, musical works, dramatic works, pantomimes and choreographic works,

artistic works (pictorial, graphic, and sculptural), and audiovisual works including motion pictures, sound recordings, and architectural works, all including in existing formats and those later created, and also includes all US and international copyright rights, and all similar rights, such as moral rights, derived from the Copyrightable Work.

B. This Copyright Policy does not address the use of Copyrightable Works owned by third parties. In the course of educational and research activities at NYU, members of the University Community may use materials subject to third party copyright protections. All such uses must comply with applicable legal and contractual obligations and NYU policies, including NYU's Copyright and Fair Use Policy.

## **XI. OWNERSHIP AND USE OF COPYRIGHTABLE WORKS**

### A. General Rule

(1) NYU Ownership. Except as otherwise provided in this Section XI (including the Academic Protections set forth in Section XI.B.) of this policy, Copyrightable Works that are authored or created by members of the University Community are owned by NYU if authored or created, in whole or part: (1) in the scope of NYU employment or other duties at or for NYU; or (2) in connection with training, research or clinical activities at or under the auspices of NYU; or (3) with Substantial Use of University Resources; or (4) in connection with the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU; or (5) the Copyrightable Work is subject to the rights of research sponsors or other third parties under agreements duly entered into or agreed to by NYU. In such cases, it is presumed that NYU owns every Copyrightable Work made by a member of the University Community.

(2) Non-NYU Owned Copyrightable Works. Where a member of the University Community provides to the OIL clear and convincing evidence that a Copyrightable Work was authored and created entirely outside of the scope of the person's NYU employment, duties, training and research at, for or under the auspices of NYU, on the person's own time and without the Substantial Use of University Resources, and not in connection with the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU, NYU will not assert ownership rights to such a Copyrightable Work unless the Copyrightable Work is subject to the rights of research sponsors or other third parties under agreements duly entered into or agreed to by NYU (see Section XI.D. of this policy). In such instances, the Copyrightable Work may be owned directly by the member of the University Community or may be assigned freely by the Creator (for example, to an entity with whom the member is consulting, in accordance with Section XII of this policy regarding Outside Consulting Activities).

(3) Scope of NYU Employment. Copyrightable Works created in whole or part, by full-time academic members of the University Community are deemed made in the scope of NYU employment or other duties at or for NYU and owned by NYU under this Section XI.A. if such Copyrightable Works are within the broad academic field or area of teaching, scholarship, research or clinical activities in which such academic member of the University Community is engaged. However, there are exceptions for Copyrightable Works created by NYU faculty solely during an unpaid leave as set forth in Section XI.E. of this policy, for Copyrightable Works created by students as part of their uncompensated class work as set forth in Section XI.G. of this policy, for Copyrightable Works created during outside consulting as set forth in Section XII of this policy, and

for Copyrightable Works which NYU agrees in writing to release to a member of the University Community pursuant to Section XIV.C of this policy. Where a member of the University Community has a question about whether an activity that might give rise to a Copyrightable Work is within the scope of employment, he or she may seek a determination from the School Dean, who will consult with the OIL, where necessary before providing guidance.

## B. Academic Protections

NYU will not assert ownership of Traditional Works of Scholarship, Lectures and Instructional Media authored, created or given by faculty, research scientists, post-doctoral appointees and/or fellows as set forth in this Section XI.B. (“Academic Protections”), except to the extent that NYU has ownership rights pursuant to Section XI.C. of this policy.

(1) Traditional Works of Scholarship. NYU will not assert ownership of Traditional Works of Scholarship authored or created by faculty, research scientists, post-doctoral appointees and/or fellows. However, where such works are owned by the Creator, they become subject to certain NYU non-exclusive license rights, as defined in Section XI.B(3)(b) of this policy, if used as Instructional Media. In the case of other Traditional Works of Scholarship, when the owner enters an agreement with third parties regarding publication of those works, the owner is encouraged to preserve for NYU and the Creator the right to use such works to fulfill the mission of NYU, including for educational and research purposes.

(2) Lectures. NYU will not assert ownership of lectures given by faculty, research scientists, post-doctoral appointees, and/or fellows. Oral lectures are not protected by US copyright law (or most international copyright statutes) unless they are “fixed” in a tangible medium of expression (such as a digital recording or a transcription). Nonetheless, such lecturers may have certain “common law,” state and/or international copyright rights in their oral lectures, and also may have related international “moral rights,” or “droit morale” under various international laws and treaties. In addition, such lecturers ordinarily own the rights to their lecture notes, and other similar Instructional Media, as provided in Section XI.B(3)(a) of this policy; provided, however, that these ownership rights are subject to certain NYU non-exclusive license rights, as set forth in Section XI.B(3)(b) of this policy. The rights of students to create and use audio/video recording and transmission of classroom lectures and discussions by students is subject to the rights held by the Creators of such lectures and discussions and may be subject to other policies of NYU and the School and to applicable laws and regulations protecting other students. As a general matter, recordings and transmissions may not be made without the permission of all Creators.

(3) Instructional Media.

(a) NYU will not assert ownership of Instructional Media created by faculty, research scientists, post-doctoral appointees and/or fellows; provided, however, that these ownership rights are subject to certain NYU non-exclusive license rights, as set forth in Section XI.B(3)(b) of this policy, and that NYU will assert ownership of any Instructional Media that is created by members of the University Community as team members in an NYU project involving other members of the University Community and Substantial Use of University Resources are used in the creation of the Instructional Media.

(b) With regard to Instructional Media owned by the Creator under this Section, NYU reserves, and effective upon the date the Creator becomes a member of the University Community, the Creator grants to NYU, a non-exclusive, perpetual, world-wide, royalty free license (with the right to sublicense) to use such Instructional Media in any form or media for any purpose consistent with the mission of NYU, including educational and research purposes and for publicizing NYU or any program or department of NYU, and including the right to make derivative works for such purposes. A Creator's refusal or failure to sign a document confirming this grant of limited license rights will not invalidate NYU's rights under this Section XI.B(3)(b) of this policy. Where the Creator is identified, or may be reasonably identifiable within the Instructional Media, NYU will not edit or use any such Instructional Media in a manner that materially misrepresents the intent of the Creator in authoring or creating the Copyrightable Work. For instance, if a recorded lecture includes scientific information that is no longer accurate, NYU will not use a recording of any such portions of the lecture for instructional purposes without an appropriate explanation. As another example, where a Creator's name is indicated within the Copyrightable Work, NYU will not edit portions of any such course or program in a manner that changes the manner in which the content would be reasonably understood.

### C. Other Copyrightable Works Owned by NYU

In addition to the Copyrightable Works owned by NYU pursuant to Section XI.A. of this policy, the following categories of Copyrightable Works are owned by NYU.

(1) Works for Hire. NYU owns Copyrightable Works created by an employee, contractor, vendor or consultant in the scope of employment or engagement (including the performance of research); provided, however, that Copyrightable Works subject to the Academic Protections set forth in Section XI.B. of this policy are works for hire owned by NYU only if (i) the owner has entered into a written agreement transferring rights to NYU or (ii) if the author's work is as a team member in an NYU project involving other members of the University Community and Substantial Use of University Resources are used in the creation of the Copyrightable Work.

(2) NYU Commissioned Works. NYU owns Copyrightable Works created by Members of the University Community that are created at the direction of, or commissioned by, NYU; provided, however, that Copyrightable Works subject to the Academic Protections set forth in Section XI.B. of this policy are owned by NYU under this Section only (i) if the owner has entered into a written agreement transferring rights to NYU or (ii) if the author's work is as a team member in an NYU project involving other members of the University Community and Substantial Use of University Resources are used in the creation of the Copyrightable Work. This subsection includes works created for administrative use, instructional use, computer software authored for University purposes or projects, and works created institutionally that are developed and/or refined over time by a series of individuals, where authorship is joint and cannot be attributed to any one person.

(3) Copyrightable Works Related to Patents. NYU owns Copyrightable Works created by Members of the University Community that are closely associated with an Invention owned by NYU under the Patent Policy, even if otherwise subject to Academic Protections set forth in Section XI.B. of this policy. For instance, any non-patentable Copyrightable Works that are useful in practicing such an Invention, or in effectively prosecuting a patent application covering such an Invention, or in maximizing the licensing potential of such an Invention, are owned by NYU.

(4) NYU Created Reproductions. NYU owns any material, in any form of media (including audio, or video, analogue or digital), that is a recording or reproduction of an NYU course or program.

(5) Clinical Records. NYU owns all Copyrightable Works, including but not limited to photographs, digital images, data, and graphs and other records, authored or created, in whole or part, in connection with the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU (“Clinical Records”), including but not limited to nursing, dental, medical, and psychological Clinical Records. Under no circumstances will NYU’s ownership and/or commercialization under this policy of Copyrightable Works obtained in connection with the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU directly or indirectly affect NYU’s responsibilities to ensure a high quality of patient care and patient safety. NYU’s ownership of Copyrightable Works arising from clinical or research activity and includes personal health information will be used at all times in a manner consistent with all applicable consents and authorizations granted by such subjects and will comply with all applicable laws and regulations.

#### D. Contractual Obligations to Sponsors and Others

Notwithstanding anything to the contrary in this policy, all rights of NYU and of members of the University Community under this policy are subject to the rights of research sponsors or other third parties under agreements duly entered into or agreed to by NYU. In addition, nothing in this policy is intended to limit the express contractual or legal rights of NYU (e.g., NYU owns a Copyrightable Work subject to Academic Protections set forth in Section XI.B. of this policy if a faculty member has agreed in writing that NYU owns it).

#### E. University Faculty on Leave and/or Visiting Other Institutions

In general, Copyrightable Works, other than those subject to the Academic Protections set forth in Section XI.B. of this policy, which are authored or created by NYU faculty during a paid leave (whether at NYU or elsewhere, including another institution or a company) are owned by NYU.

NYU will not claim ownership of Copyrightable Works authored or created by NYU faculty solely during an unpaid leave unless: (1) Substantial Use of University Resources was involved, and the Copyrightable Work is not covered by the Academic Protections set forth in Section XI.B. of this policy; (2) the Copyrightable Work was authored or created, in whole or part, in connection with the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU; (3) the Copyrightable Work is patentable or closely associated with an Invention owned by NYU pursuant to its Patent Policy (in which case the Patent Policy applies); (4) the activity of the NYU faculty in authoring or creating the Copyrightable Work violated NYU’s conflict of interest policies; or (5) the Copyrightable Work is subject to the rights of research sponsors or other third parties under agreements duly entered into or agreed to by NYU.

In cases in which there are potential conflicts between NYU’s policies and those of an institution at which a faculty member will be or has been on leave and/or visiting, such conflicts will be resolved through good faith negotiations between NYU and such institution, preferably before the leave or visit begins. All such negotiations will be conducted on behalf of NYU by the OIL, normally in consultation with the faculty member.

#### F. Visitors from Other Institutions (Non-Employees)

In general, Copyrightable Works, other than those subject to the Academic Protections set forth in Section XI.B. of this policy, authored or created by visitors from other institutions (home institutions), including visiting faculty and scholars, while participating in research, clinical or other activities at or under the auspices of NYU are wholly owned by NYU. Such visitors often are subject to intellectual property policies of their home institutions. Accordingly, where it is anticipated that there is a reasonable possibility that a visitor will author or create Copyrightable Works while working at or under the auspices of NYU (including authoring computer code or software), Schools and units are encouraged to contact the OIL so it can determine whether an agreement with the visitor's home institution is advisable prior to the start of the visit. Any conflicts between NYU and the home institution of a visitor will be resolved through good faith negotiations between the OIL and such home institution.

#### G. Graduate and Undergraduate Students

The principles described below apply to students enrolled at NYU and non-enrolled students who are visiting NYU. Schools may implement policies that supplement this policy that are specific to the nature of copyright activities in that School.

(1) Classwork. In general, NYU will not claim ownership of any Copyrightable Works created by students as part of their uncompensated class work. This may include, for example, works of art or music or theses. For purposes of this policy, student compensation excludes financial aid without a work requirement.

Except as otherwise stated in this policy, or in the supplemental policies of a School, Copyrightable Works created by more than one student involved in a common project whose components are not severable will be considered to be created and jointly owned by all such students, unless otherwise agreed in writing by each person. Where the components of a Copyrightable Work are severable, the separate portions will be owned by the student(s) who create or author each separate portion. For instance, each of the musical score, script and set designs for a film may be separately owned.

(2) Other. When a student, solely or jointly, authors or creates a Copyrightable Work, in whole or in part, in the course of (a) sponsored research (e.g., under a graduate or research fellowship or assistantship), including research for the student's thesis or dissertation, (b) the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU (including but not limited to photographs, digital images, data, graphs, and copyright rights in medical, nursing, dental, and psychological patient records), (c) any research or other activity involving Substantial Use of University Resources, (d) participation as a team member in a University project involving other members of the University Community (unless all participating members of the University Community are students acting in the capacity of students) or (e) employment or other compensated duties at NYU, the Copyrightable Works, or the portions thereof authored by the student, are the property of NYU and the student shares in the proceeds, if any, as a Creator, in accordance with Section XIII of this policy. By way of example, a student is not considered to be acting as a student for purposes of this policy if the student authors or creates a Copyrightable Work as an employee of NYU, even if employment related to the student's intellectual discipline is a condition of the student's academic program at NYU.

(3) Limited NYU License. In addition to any other NYU rights, NYU reserves, and effective upon the date the Creator becomes a member of the University Community, the Creator grants to NYU, a non-exclusive, perpetual, world-wide, royalty-free license (with the right to sublicense) to use such Copyrightable Work in any form or media for any purpose consistent with the mission of NYU, including educational and research purposes and for publicizing NYU or any program or department of NYU, and including the right to make derivative works for such purpose. A student's refusal or failure to sign a document confirming this grant of limited license rights will not invalidate NYU's rights under this Section XI.D(3) of this policy. NYU's use of all such Copyrightable Works will comply at all times with applicable laws and regulations protecting students, including NYU's obligations under the Family Educational Rights and Privacy Act (FERPA).

(4) Participation in Faculty Traditional Works of Scholarship. Where a student participates in the creation of a Traditional Work of Scholarship under the direction of a faculty member, the faculty member is advised to obtain the student's written agreement, prior to the commencement of such student's participation, to allocate the copyright arising with respect to such Traditional Work of Scholarship between them on such basis as the student and the faculty member may agree. Under no circumstances may an assignment operate to transfer copyright to all or any portion of a student's thesis or dissertation to a faculty member, or otherwise transfer ownership to a faculty member of work produced by a student in the course of the faculty member's teaching or academic advising activities involving such student. In the absence of an agreement to the contrary, a student does not hold any license or other right to use any portion of such Traditional Work of Scholarship, other than the portion authored by the student.

(5) Participation by Students in the Creation of Software and Other Copyrightable Works. Where one or more students participate in the creation of software and other Copyrightable Works under the direction of a faculty member who has initiated and is conducting research under the auspices of NYU involving the authorship or creation of such Copyrightable Works, and where such student involvement is limited to making discrete contributions to the Copyrightable Work, and the involvement of the student(s) does not rise to the level of a joint research project between such faculty member and the student(s), the faculty member is encouraged to obtain a written agreement with the student confirming the ownership of copyright rights to the Copyrightable Work. The OIL is available to assist faculty in ensuring that each party's rights, including NYU's rights, are appropriately identified. In the absence of an agreement to the contrary, a student does not hold any license or other right to use any portion of such software or other Copyrightable Work, other than the portion authored by the student.

#### H. Contractors/Vendors/Consultants Hired by the University

Copyrightable Works authored or created as a result of a contractor/vendor/consultant's work for NYU are the property of NYU, unless other arrangements have been explicitly agreed to in a writing duly entered into in advance by NYU. Contractors/vendors/consultants should be hired only pursuant to a prior written agreement in a form approved by NYU's Office of General Counsel; however, failure to do so will not diminish NYU's rights under this policy.

#### I. Research Data

NYU's ownership of and rights to all Research Data closely associated with a Copyrightable Work owned by or assignable to NYU is governed by this policy, unless it is governed by the Patent Policy.

#### J. Publication of Research Results

NYU's ownership of Copyrightable Works is not intended to prevent the presentation and publication of research results. Subject to the obligation to disclose Copyrightable Works to the OIL as set forth in Section XIII of this policy and subject to any obligations to third parties, faculty and the relevant members of the University Community retain their traditional role in selecting and preparing for publication the results of research conducted by them or under their supervision.

#### K. Assignment

Each member of the University Community is deemed to have made an assignment to NYU, effective as of the date such person first became a member of the University Community, of any right, title and/or interest in any Copyrightable Work, to the extent such right, title and/or interest is owned by NYU as set forth in this policy. Such persons continue to have the obligations set forth in this policy, including under Section XI of this policy.

### **XII. OUTSIDE CONSULTING ACTIVITIES**

A. Faculty, research staff and others subject to this policy who engage in outside consulting activities must do so in compliance with all NYU policies, including, but not limited to, this policy, NYU's conflict of interest policies (see, e.g., "NYU Policy on Academic Conflict of Interest and Conflict of Commitment") and policies of the relevant School or unit. Faculty, research staff and others subject to this policy who engage in outside consulting activities also should consider any guidelines provided by the Office of General Counsel for consulting agreements.

B. NYU will make no claim to Copyrightable Works, authored or created by a faculty member or research staff member in the course of a consulting engagement that is consistent with the terms of this Section XII if: (1) the Copyrightable Work results from work on a problem or topic (a) proposed by the company for which the faculty member or research staff member is consulting and (b) on which the faculty member or research staff member has not engaged in research, and does not have plans to engage in research, at or under the auspices of NYU; (2) the Copyrightable Work is authored and/or created without the Substantial Use of University Resources; (3) the Copyrightable Work is not authored or created in connection with the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU or made in the person's NYU employment, duties, training, research and/or clinical activities at, for or under the auspices of NYU; (4) the consulting agreement is approved in advance in writing where advanced approval may be required pursuant to applicable NYU, School and/or unit policies; (5) the Copyrightable Work is not Instructional Media; and (6) the consulting activity is not for a company that (a) has licensed such person's Inventions, Copyrightable Works or Tangible Research Property from NYU or (b) is sponsoring research in which such person participates. NYU also will make no claim to a Copyrightable Work made by a faculty member or research staff member in the course of a consulting engagement if NYU, through the School Dean and the OIL, has received, reviewed and approved in advance in writing the consulting engagement and consulting agreement (including the problem, topic and/or statement of work) and the Copyrightable Work is made consistent with such



advance approval. In all other situations, NYU is the owner of the Copyrightable Works, subject to any written agreements to the contrary duly entered into or agreed to by NYU.

C. Even where a Copyrightable Work resulting from outside consulting activities is not owned by NYU, and not subject to University license rights under this policy, each Creator is responsible for assuring that all such Copyrightable Works are properly disclosed to the OIL as described in Section XVI. B. of this policy.

### **XIII. COMMERCIALIZATION OF COPYRIGHTABLE WORKS**

A. NYU is committed to facilitating the development, dissemination and, where appropriate, commercialization of Copyrightable Works for the greatest public benefit. Accordingly, when NYU owns Copyrightable Works and the copyrights in such Copyrightable Works under this policy, NYU has the sole right, either directly or through others, to commercialize such Copyrightable Works or otherwise make them available for public use. Such efforts may include, but are not limited to, licensing to an existing company or the establishment of a new company or venture, in each case as determined by NYU. In all cases, decisions regarding Copyrightable Works owned by NYU are made at the sole discretion of NYU, and NYU has no liability to any Creator, other person with rights under this policy or third party for such decisions.

B. When NYU owns the rights in a Copyrightable Work, each Creator, including in the case of Instructional Media the faculty member(s) represented within such media, has the right to share in the Net Proceeds received by NYU from commercializing the Copyrightable Work except as otherwise provided in this policy. Specifically, Net Proceeds ordinarily are distributed as follows:

(1) Fifteen percent (15%) of the Net Proceeds for the general support of the OIL and to cover any other expenses associated with the commercialization of NYU's Copyrightable Works. In cases where the funds so designated exceed the budget of the OIL, the remainder are allocated to the NYU share as per Paragraph 2.b below; and

(2) The remaining Net Proceeds (85%) are distributed as follows:

(a) Creator share: one-half (or 42.5% of Net Proceeds) to the Creator or Creators (including Creators outside of NYU).

(b) One-half (or 42.5% of Net Proceeds) to be used by NYU for research, scholarship, educational and clinical activities (or as otherwise required by law, regulation or contract) in the following manner:

(i) Two-thirds to the School (or other NYU unit if the Creator is not affiliated with a School) in which the Copyrightable Work was authored or created. Each School or other unit receiving royalty proceeds must develop and disseminate a policy for the use of such proceeds that is in accordance with the overall aims outlined in Section XIII. D. of this policy.

(ii) One-third to NYU. In recent years, for Copyrightable Works made in the School of Medicine, NYU's practice has been to contribute a large portion of

its one-third share to the School of Medicine in light of financial circumstances.

If NYU pursues or defends litigation to enforce rights, then the proceeds of any judgment or settlement received by NYU from such litigation ordinarily will be included in Gross Proceeds, on a net basis, with the associated litigation expenses paid by NYU deducted as out-of-pocket expenses. If NYU becomes involved in litigation regarding the Copyrightable Work or closely associated Research Data, the distribution described above may be modified by the Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing), in his/her sole discretion, to reflect the greater economic risk being incurred by NYU in pursuing such litigation.

Except as provided below, Creators who are employees of NYU are entitled to share in the Net Proceeds from commercialization of a Copyrightable Work as outlined in this Section XIII.B. The following Creators are not entitled to share in the Net Proceeds from commercialization of the Copyrightable Works (i.e., they are not included in this Section XIII.B.): (a) contractors/vendors/consultants of NYU, (b) authors of works for hire under this policy, (c) authors of commissioned works under this policy, (d) authors of Copyrightable Works created, in whole or part, in connection with the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU, and (e) employees of NYU, other than faculty or research staff, unless, in the case of employees, NYU agrees to their inclusion in writing signed by the Provost or The Executive Vice President, as applicable (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing). In any individual employee case, the supervisor of such an employee or the relevant project leader may make a recommendation (will make a recommendation if requested by the employee) as to the appropriateness of such employee sharing in the proceeds of commercialization, and the Provost or The Executive Vice President (or his/her designee) (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing) will determine if and the extent to which the employee is included. The decision of the Provost or The Executive Vice President (or his/her designee) (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing) is final. For Creators who are not entitled to share in the Net Proceeds under this policy, the portion of proceeds attributable to said Inventor(s) under Section XIII.E. of this policy will be distributed in full to NYU and NYU shall be entitled to exercise all other rights given to such joint Creators under this policy.

Individuals sharing proceeds under this policy are responsible for understanding the personal tax and legal consequences to them of such entitlements pursuant to this policy.

C. Equity received by NYU from a company or other entity as a part of the consideration of a license or other disposition of a Copyrightable Work will be allocated by calculating the appropriate number of shares, using the same percentages outlined in Section V.B. of this policy. Unless otherwise required by contractual arrangements, a management plan pursuant to an NYU conflict of interest policy, or applicable law, NYU normally will hold the shares until there is a public market for those shares or other liquidity event, and NYU will thereafter make appropriate distribution following NYU's or its agent's liquidation of the shares. Notwithstanding the foregoing, NYU may, in its sole discretion, (1) elect to hold the shares after there is a public market or other liquidity event or (2) elect to distribute equity at or any time after it is received by NYU or (3) require that the Creator receive such equity directly from the company or other entity. NYU is not responsible, and has no liability, for any fluctuation or dilution in the value of the shares, for any tax consequences to

the person receiving a distribution or for any other matters relating to NYU's administration of such shares or interests pursuant to this policy.

In the event that NYU elects to invest cash in a company or other entity to which NYU has licensed rights hereunder, and NYU receives equity for such investment, such investment will not be considered (1) an out-of-pocket expense of NYU for which reimbursement would be made under Section XIII.B. of this policy or (2) Gross Proceeds from the licensing or other grant of rights for purposes of Section XIII.B. of this policy. NYU will retain all proceeds and bear all losses from such equity investment.

To the extent that cash payments made to NYU under any licensing arrangement do not fully cover the out-of-pocket expenses of NYU under Section XIII.B, NYU will be reimbursed for such expenses by an allocation of equity from that licensing arrangement prior to any distribution of equity pursuant to this Section XIII.C. Monies received by NYU pursuant to a license or other disposition of a Copyrightable Work may be required to be escrowed by NYU to cover a contingent liability under the license or disposition agreement. Ordinarily, no disbursements will be made under this policy until the monies are released from such escrow.

Individuals with rights to equity interests under this policy are responsible for the personal tax and legal consequences to them of owning and/or having rights to such equity, whether directly or beneficially, pursuant to this policy.

D. NYU and School (or other unit) shares of proceeds will be used to further the research, scholarship, educational and clinical activities of NYU (or as otherwise required by law, regulation or contract).

E. If more than one Creator is to share in the Creator share, the Creators should decide among themselves their respective shares and provide the OIL with a written agreement signed by all Creators. Such written agreement among the Creators must be provided promptly to the OIL upon a written request from the OIL for such an agreement and will be irrevocable unless it is modified in writing by all Creators. In the absence of such a written agreement, NYU will determine the distribution of shares to Creators, which may in NYU's sole discretion vary based on contributions to and commercial relevance of the Copyrightable Work or Works, or other factors, and such determination will be binding on all Creators. NYU has the right at any time, in its sole discretion, to reapportion distributions among the Creators to reflect the commercial relevance of a Copyrightable Work. NYU will support such decisions with a written rationale, and any apportionment or reapportionment will be subject to the appeal rights set forth in Section XVIII.D. of this policy. If the Creators represent more than one School or other NYU unit, the distribution of the School or unit share will follow the allocation of the Creator share set forth in the agreement among the Creators or NYU determination, as applicable, unless otherwise agreed.

F. Where non-patentable Copyrightable Works are included within an Invention because they are closely associated with the Invention, the Creators may or may not be entitled to an economic benefit as set forth in Section V.F of the Patent Policy.

G. Whenever NYU licenses rights to a Copyrightable Work, NYU will seek to reserve the right for NYU to use the Copyrightable Work for any purpose consistent with NYU's mission, including research, clinical and educational purposes, except in rare cases approved by the Provost (the

Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing), and NYU may reserve the right to grant similar rights to other nonprofit research institutions.

#### **XIV. TRANSFERRING OR RELEASING OWNERSHIP OF COPYRIGHTABLE WORK TO THE CREATOR**

A. If NYU determines it will not pursue commercialization of Copyrightable Works subject to NYU ownership under this policy, NYU will consider a written request by the Creator to transfer ownership in the Copyrightable Work to the Creator as provided herein, subject to the terms (including required approvals from government or other sponsors) of any applicable grants, contracts or agreements duly entered into with governmental, corporate, nonprofit or other sponsors or third parties (including but not limited to any rights held by the US Government). Transfer of ownership to the Creator generally will be subject to an irrevocable, non-exclusive, world-wide, royalty-free license to NYU to use the Copyrightable Work for education, research (including sponsored research), clinical and other legitimate NYU purposes and may be subject to a reservation to NYU of the right to grant similar licenses to other nonprofit institutions and governmental organizations. In those instances in which there are multiple Creators, all Creators must be in agreement and be party to such a request, although all Creators need not be seeking ownership or equal rights. In all cases, decisions regarding transfer of ownership in Copyrightable Works owned by NYU are at the sole discretion of NYU, and NYU has no liability to any Creator, other person with rights under this policy or third party in connection with such decisions.

B. If, after the transfer of ownership to the Creator pursuant to a request made under Section XIV.A. of this policy, the Creator receives proceeds from commercializing the Copyrightable Work, NYU may require reimbursement from the Creator for any out-of-pocket expenses incurred by NYU in connection with the Copyrightable Work, including legal, commercialization and marketing expenses.

C. If a Creator of a Copyrightable Work subject to this policy believes the Copyrightable Work should not be subject to NYU's ownership rights under this policy because (1) the Copyrightable Work can be shown by clear and convincing evidence to be outside of NYU's ownership rights in accordance with Section XI.A. of this policy, (2) the Copyrightable Work is subject to Academic Protections under Section XI.B. of this policy, (3) the Copyrightable Work was made solely during an unpaid leave as set forth in Section XI.E. of this policy, (3) the Copyrightable Work was made by student(s) as part of uncompensated class work as set forth in Section XI.G. of this policy, (4) the Copyrightable Work was made in outside consulting and is consistent with the requirements set forth in Section XII.B. of this policy, or (5) otherwise, the Creator may request through the OIL a determination as to whether NYU will assert ownership rights to the Copyrightable Work under this policy. In the case of multiple Creators, all Creators should agree and be party to the request. In connection with the request, the Creator(s) must provide the OIL with a summary of the circumstances leading to the creation of the Copyrightable Work. The Provost or The Executive Vice President (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing), in consultation with the OIL and the School Dean(s), will make a determination in writing on whether to assert ownership rights in such Copyrightable Work or to release such Copyrightable Work to the Creator(s). It is expected that the written determination will be provided to the Creator(s) within thirty (30) days of date of the OIL receives sufficient information regarding the Copyrightable Work for NYU to make such a determination. In all cases, decisions regarding releasing of ownership in Copyrightable Works are at the sole discretion of

NYU, and NYU has no liability to any Creator, other person with rights under this policy or third party in connection with such decisions.

D. The transfer of ownership of a Copyrightable Work to the Creator does not affect NYU's rights or the Creator's obligations pursuant to this policy with respect to other Copyrightable Works.

#### **XV. MAKING NYU OWNED COPYRIGHTABLE WORKS AVAILABLE FOR PUBLIC USE, INCLUDING THROUGH OPEN SOURCE LICENSING**

A. NYU, in its sole discretion, normally after consultation with the Creator(s), may make Copyrightable Works available for public use on a royalty-free license or other means on such terms as it finds appropriate where it believes that the advantages of making such Copyrightable Works available for public use outweigh alternative commercialization strategies and there are no legal or contractual obligations that prohibit the public use. The Creator of Copyrightable Works owned by NYU may request that NYU make such works available for public use on a royalty-free license or other means. Such request should be transmitted to the OIL in writing. In the case of multiple Creators, all Creators should agree and be party to the request. The Provost or The Executive Vice President, as applicable, (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing) will make a determination with respect to the request (see Section VIII.F. of this policy).

B. Under appropriate circumstances, and pursuant to Section XV.A. of this policy, NYU may elect to make Copyrightable Works available to the public via open source licensing or, publication of materials via open-access licenses, or through other public use bases. In each case, the decision to make materials widely available should include a number of considerations including, without limitation: who has ownership or other rights to the Copyrightable Work under this policy; whether the objectives in distributing the Copyrightable Work would be better achieved by commercialization of such materials; and whether open access should be limited to the nonprofit and/or educational fields. Open Source licensing should be undertaken in consultation with the OIL and the University's Office of General Counsel to ensure that the licensing approach adequately protects NYU and the Creator(s) from liability and other risks.

C. Open source and open access licensing also may be covered by separate policies and procedures of NYU in effect from time to time. Such policies and procedures may cover issues such as permitted use of NYU resources (including computer resources and bandwidth) and require consultation with the Provost or The Executive Vice President, as applicable, (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing) and NYU's Offices of Information Technology Services and Office of General Counsel to determine the implications of open-access licensing using NYU resources.

D. In the event that NYU owns Copyrightable Works under Section XI, open access licensing may be conducted only following disclosure to NYU under Section XVI.B. of this policy and a request that such material be made available on an open-access basis. NYU will make a determination as to such request weighing the factors outlined in Section XV.A. of this policy and taking into consideration the views of the relevant faculty and School Dean and the Office of Industrial Liaison. In all cases, decisions regarding Copyrightable Works owned or licensed by NYU are at the sole discretion of NYU.

## **XVI. ADMINISTRATION OF POLICY**

### A. University Administration

This policy will be administered by the Provost and The Executive Vice President, except in the Schools of Medicine, Dentistry and Nursing, where the policy will be administered by the Executive Vice President for Health. The Provost, The Executive Vice President or the Executive Vice President for Health may obtain advice from the Intellectual Property Advisory Committee and the Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing) will consult with the School Deans, as appropriate. Further information about the Intellectual Property Advisory Committee and administration of this policy is contained in Appendix B.

### B. Disclosure of Copyrightable Works

(1) Creators must, at the earliest opportunity practicable, promptly notify and fully disclose to NYU any Copyrightable Work that might be subject to NYU ownership under the terms of this policy if: (a) the Creators wish to transfer the Copyrightable Work outside of the University; (b) in Creators' reasonable judgment the Copyrightable Work has commercial potential; or (c) the Copyrightable Work is subject to contractual rights or obligations (e.g., funding agreements).

(2) If there is any possibility that NYU has ownership rights in a Copyrightable Work, the Creator must disclose the Copyrightable Work to NYU as set forth in this policy even if a Creator believes that NYU has no ownership rights to the Copyrightable Work.

(3) Upon disclosure of a Copyrightable Work, NYU will determine whether or not ownership vests in NYU.

### C. Creator Cooperation with NYU Ownership Rights

If NYU maintains ownership rights to the Copyrightable Works pursuant to this policy, NYU has the right, either directly or through others, to evaluate the Copyrightable Work, to seek patent or other protection of the Copyrightable Work, and to undertake commercialization and/or otherwise introduce the Copyrightable Work into public use. Each Creator is required to cooperate as reasonably requested by NYU, and in every necessary way, but at no out-of-pocket expense to the Creator, with NYU's efforts, including, without limitation, executing confirmatory assignments or agreements documenting NYU's ownership, and executing documents necessary or useful for filing copyrights in the US or in any other jurisdiction or with respect to the commercialization of the Copyrightable Work. A Creator's obligation to cooperate as set forth herein continues after the Creator ceases to be a member of the University Community with respect to Copyrightable Works covered under this policy.

### D. Agreement to Policy

This policy is binding on NYU and on all members of the University Community. All members of the University Community are advised of NYU's policies and procedures relating to intellectual property through publication on NYU's website at [www.nyu.edu](http://www.nyu.edu). To the extent NYU requires

formal confirmation of copyright assignment or other agreements to implement this policy, the absence of such executed agreements does not in any way invalidate, in whole or in part, the applicability of this policy or diminish NYU's rights under this policy. Nothing in this policy constitutes a waiver by NYU of any rights that NYU may have under any other NYU policy, by contract or pursuant to any applicable law.

#### E. Intellectual Property Agreement

Each member of the University Community must sign and submit an Intellectual Property Agreement (see Appendix C) when first submitting an external grant application, when first engaging in sponsored programs, or in certain Schools on accepting an appointment to NYU; and must sign and submit an Intellectual Property Agreement at any time upon request of the Provost or The Executive Vice President (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing). All program directors or principal investigators of sponsored programs are responsible for securing signatures to the Intellectual Property Agreement from all research personnel, including students, working on a project at the time of their appointment to the project and for the timely submission of the fully-executed Agreement as set forth on the Intellectual Property Agreement. Notwithstanding the above, the failure of NYU to obtain a signed Intellectual Property Assignment does not in any way diminish NYU's rights under this policy.

#### F. Disputes

Disputes involving intellectual property rights or this policy will be reviewed and resolved by the Provost and/or The Executive Vice President or by the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing, as applicable, unless a decision is deemed final pursuant to this policy. The Provost, The Executive Vice President and/or the Executive Vice President for Health may within their sole discretion refer the matter to the Intellectual Property Advisory Committee or another designee to adjudicate the matter or to make a formal recommendation to the Provost and/or The Executive Vice President or to the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing, as applicable. Adjudications made hereunder by the Intellectual Property Advisory Committee or another designee of the Provost, The Executive Vice President and/or the Executive Vice President for Health may be appealed, within thirty days of the date of the decision, to the Provost and/or The Executive Vice President or to the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing, who will review the matter and make a final decision on behalf of NYU. If the Provost and/or The Executive Vice President or the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing are not able to review the matter and make a final decision on behalf of NYU, for example due to conflict or unavailability, the appeal will go instead to the President or the President's designee, who will review the matter and make a final decision on behalf of NYU. The persons involved in the dispute should present a written summary of the matter with relevant written evidence and may ask to present witnesses, which may be permitted in the discretion of the recommending or adjudicating person or persons or committee. The recommending or adjudicating person or persons or committee may consult with the Intellectual Property Advisory Committee, the relevant School Dean, other officers and personnel of NYU, and/or any experts or witnesses as they may deem appropriate.

#### G. Advisory Committee

The Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing) may from time to time appoint an Intellectual Property Advisory Committee with broad or specific responsibilities relating to all intellectual property matters (which may include, without limitation, Inventions, patents, Copyrightable Works, copyrights, software, Tangible Research Property and Research Data). The Intellectual Property Advisory Committee's role is to advise the OIL, the Provost, and/or the Senior Vice Provost for Research, except in the Schools of Medicine, Dentistry and Nursing, where the Committee's role is advisory to the School Dean and the Executive Vice President for Health.

#### H. Administration by Schools and Units

(1) The School Deans will work closely with the Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing) and the Intellectual Property Advisory Committee to ensure that the perspectives, practices and values of each School are taken into consideration in the decision-making process under this policy.

(2) Each School of NYU retains the right to supplement this policy as necessary or desired by such School, including requiring formal copyright assignment or agreements of its employees or others subject to this policy or such School's policies. The Provost may permit academic units other than Schools, The Executive Vice President may permit non-academic units and the Executive Vice President for Health in the case of the School of Medicine, Dentistry and Nursing may permit any of their academic and non-academic units to supplement this policy as necessary or desired by such unit, including requiring formal copyright assignment or agreements of its employees or others subject to this policy or such unit's policies. The decision of any School or unit not to secure formal intellectual property agreements from any person does not diminish NYU's rights under this policy. Any supplement must be: (a) consistent with the terms of this policy (or an exception approved in accordance with the Policy on Policies); (b) in writing; (c) approved by the School Dean of a relevant School in the case of a School; and (d) submitted to the Provost for review and approval in the case of a School or academic unit, to The Executive Vice President in the case of a non-academic unit and to the Executive Vice President for Health in the case of the School of Medicine, Dentistry and Nursing and any of their academic and non-academic units. A supplement may contain dispute resolution procedures that operate within a School, provided that such procedures are not inconsistent with this policy and provide for resolution pursuant to Section XVI.E. of this policy in the event that such dispute cannot be resolved within the School.

#### I. Governing Law

This policy is governed by and construed in accordance with the laws of the US and the State of New York, including US Copyright laws, provided, however, that where the only persons who may be Creators are non-US nationals and all of the work giving rise to the Copyrightable Works was performed outside of the United States, NYU may, in its sole discretion, apply a relevant international law to questions of law governing intellectual property, including questions of authorship.



## **TANGIBLE RESEARCH PROPERTY POLICY**

### **XVII. PREAMBLE**

NYU is dedicated to teaching, scholarship, research, the provision of patient and other clinical services, and the expansion of knowledge. While NYU encourages these activities for their intrinsic value, it recognizes that Tangible Research Property may result from various activities conducted wholly or in part at or under the auspices of NYU.

This policy defines ownership rights relating to TRP and ensures that the proceeds from any commercialization are distributed in a manner approved by NYU's Board of Trustees and consistent with the mission of NYU. It also protects NYU's property rights by addressing responsibility, control and distribution of TRP. The policy aids the traditional open distribution and exchange of TRP for research purposes, preserves the potential commercial value of TRP, assists the further development of TRP for public use, and protects NYU and its employees from potential liability from the use of NYU's TRP by others.

This policy also guides members of the University Community in complying with NYU's legal and contractual obligations.

For all TRP that are subject to NYU ownership under this policy, it is within NYU's sole discretion to determine whether and on what terms TRP should be distributed, and whether TRP should be protected and/or commercialized. NYU's Office of Industrial Liaison (the "OIL") is responsible for managing all activities relating to the protection and commercialization of TRP.

### **XVIII. SCOPE AND ACCEPTABILITY**

This policy applies to all TRP made in whole or in part by members of the University Community, except for TRP that is closely associated with an Invention covered under Section V.F of the Patent Policy. The term "Tangible Research Property" or "TRP" refers to tangible (or corporeal) items produced in the course of research, clinical or other activities at or under the auspices of NYU, or otherwise made with Significant Use of University Resources, and also includes all registrations, filings, depository rights and indicia covering the TRP. TRP includes, but is not limited to, such items as: biological materials, engineering drawings, integrated circuit chips, physical embodiments of computer software and computer databases, algorithms and databases (e.g., computer disks and firmware), prototype devices, circuit diagrams, and equipment, as is intended to include items that are in existence or that may arise in the future.

### **XIX. OWNERSHIP OF TRP**

#### **A. General Rule**

(1) NYU Ownership. Except as otherwise provided in this Section XIX, TRP that are made by members of the University Community are owned by NYU if made, in whole or part: (1) in the scope of NYU employment or other duties at or for NYU; or (2) in connection with training, research or clinical activities at or under the auspices of NYU; or (3) with Substantial Use of University Resources; or (4) in connection with the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU (including but not limited to

photographs, digital images, data, graphs, samples, specimens and other tangible items and medical, nursing, dental, and psychological patient records); or (5) the TRP is subject to the rights of research sponsors or other third parties under agreements duly entered into or agreed to by NYU. In such cases, it is presumed that NYU owns all TRP made by a member of the University Community.

(2) Non-NYU Owned TRP. Where a member of the University Community provides to the OIL clear and convincing evidence that the TRP was made entirely outside of the scope of the person's NYU employment, duties, training and research at, for or under the auspices of NYU, on the person's own time and without the Substantial Use of University Resources and not in connection with the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU, NYU will not assert ownership rights to such TRP unless the TRP is subject to the rights of research sponsors or other third parties under agreements duly entered into or agreed to by NYU (see Section XIX.B. of this policy). In such instances, the TRP may be owned directly by the TRP Creator or may be assigned freely by the TRP Creator (for example, to an entity with whom the member is consulting, in accordance with Section XX of this policy regarding Outside Consulting Activities).

(3) Scope of NYU Employment. TRP created in whole or part, by full-time academic members of the University Community are deemed made in the scope of NYU employment or other duties at or for NYU and owned by NYU under this Section XIX.A. if such TRP are within the broad academic field or area of teaching, scholarship, research or clinical activities in which such academic member of the University Community is engaged. However, there are exceptions for TRP created by NYU faculty solely during an unpaid leave as set forth in Section XIX.C. of this policy, for TRP created by students as part of their uncompensated class work as set forth in Section XIX.D. of this policy, for TRP created during outside consulting as set forth in Section XX of this policy, and for TRP which NYU agrees in writing to release to a member of the University Community pursuant to Section XXII.D of this policy. Where a member of the University Community has a question about whether an activity that might give rise to TRP is within the scope of employment, he or she may seek a determination from the School Dean, who will consult with the OIL, where necessary before providing guidance

#### B. Contractual Obligations to Sponsors and Others

Notwithstanding anything to the contrary in this policy, all rights of NYU and of members of the University Community under this policy are subject to the rights of research sponsors or other third parties under agreements duly entered into or agreed to by NYU. In addition, nothing in this policy is intended to limit the express contractual or legal rights of NYU (e.g., NYU owns TRP if the member of the University Community who made it agrees in writing that NYU owns it even where not otherwise owned by NYU pursuant to this policy).

#### C. University Faculty on Leave and/or Visiting Other Institutions

In general, TRP made by NYU faculty during a paid leave (whether at NYU or elsewhere, including another institution or a company) are owned by NYU.

NYU will not claim ownership of TRP made by NYU faculty solely during an unpaid leave unless (1) Substantial Use of University Resources was involved; (2) the TRP was made in connection with

the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU; (3) the TRP are patentable or is closely associated with an Invention or Copyrightable Work owned by NYU (in which case the Patent Policy applies); (4) the activity of the NYU faculty in making the TRP violated NYU's conflict of interest policies; or (5) the TRP is subject to the rights of research sponsors or other third parties under agreements duly entered into or agreed to by NYU.

In cases in which there are potential conflicts between NYU's policies and those of an institution at which a faculty member will be or has been on leave and/or visiting, such conflicts will be resolved through good faith negotiations between NYU and such institution, preferably before the leave or visit begins. All such negotiations will be conducted on behalf of NYU by the OIL, normally in consultation with the faculty member.

#### D. Visitors from Other Institutions (Non-Employees)

In general, TRP made by visitors from other institutions (home institutions), including visiting faculty and scholars, while participating in research, clinical or other activities at or under the auspices of NYU are wholly owned by NYU. Such visitors often are subject to the policies of their home institutions. Accordingly, where it is anticipated that there is a reasonable possibility that a visitor will make TRP while working at or under the auspices of NYU, Schools and units are encouraged to contact the OIL so it can determine whether an agreement with the visitor's home institution is advisable prior to the start of the visit. Any conflicts between NYU and the home institution of a visitor will be resolved through good faith negotiations between the OIL and such home institution.

#### E. Graduate and Undergraduate Students

The principles described below apply to students enrolled at NYU and non-enrolled students who are visiting NYU.

(1) Class Work. In general, NYU will not claim ownership of TRP made by students as part of their uncompensated class work. For purposes of this policy, student compensation excludes financial aid without a work requirement.

(2) Other. When a student, solely or jointly, makes TRP in the course of (a) sponsored research (e.g., under a graduate or research fellowship or assistantship), including research for the student's thesis or dissertation, (b) the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU (including but not limited to photographs, digital images, data, graphs, samples, specimens and other tangible items and medical, nursing, dental, and psychological patient records), (c) any research involving Substantial Use of University Resources, (d) participation as a team member in a University project involving other members of the University Community (unless all participating members of the University Community are students acting in the capacity of students) or (e) employment or other compensated duties at NYU, the TRP are the property of NYU and the student shares in the proceeds, if any, as a TRP Creator, in accordance with Section XXI.E. of this policy. By way of example, a student is not considered to be acting as a student for purposes of this policy if the student makes TRP as an employee of NYU, even if employment related to the student's intellectual discipline is a condition of the student's academic program at NYU.

F. Contractors/Vendors/Consultants Hired by the University.

TRP made as a result of a contractor/vendor/consultant's work for NYU are the property of NYU, unless other arrangements have been explicitly agreed to in a writing duly entered into in advance by NYU. Contractors/vendors/consultants should be hired only pursuant to a prior written agreement in a form approved by NYU's Office of General Counsel; however, failure to do so will not diminish NYU's rights under this policy.

G. Research Data.

NYU's ownership of and rights to all Research Data closely associated with TRP owned by or assignable to NYU is governed by this policy, unless the Research Data is governed by the Patent Policy.

H. TRP Involving Clinical Services.

NYU owns all TRP made in whole or part, in connection with the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU. Under no circumstances will NYU's ownership and/or commercialization under this policy of TRP obtained in connection with the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU directly or indirectly affect NYU's responsibilities to ensure a high quality of patient care and patient safety. NYU's ownership of TRP obtained from subjects in human subjects research, and its rights and obligations regarding such TRP under this policy, will at all times be consistent with all applicable consents and authorizations granted by such subjects and will comply with all applicable laws and regulations.

I. Publication of Research Results.

NYU's ownership of TRP is not intended to prevent the presentation and publication of research results. Subject to the obligation to disclose TRP to the OIL as set forth in Section XXV.B. of this policy and subject to any obligations to third parties, faculty and the relevant members of the University Community retain their traditional role in selecting and preparing for publication the results of research conducted by them or under their supervision.

J. Assignment.

Each member of the University Community is deemed to have made an assignment to NYU, effective as of the date such person first became a member of the University Community, of any right, title and/or interest in any TRP, to the extent such right, title and/or interest is owned by NYU as set forth in this policy. Such persons continue to have the obligations set forth in this policy, including under Section XXV of this policy.

## **XX. OUTSIDE CONSULTING ACTIVITIES**

A. Faculty, research staff and others subject to this policy who engage in outside consulting activities must do so in compliance with all NYU policies, including, but not limited to, this policy, NYU's conflict of interest policies (see, e.g., "NYU Policy on Academic Conflict of Interest and

Conflict of Commitment”) and policies of the relevant School or unit. Faculty, research staff and others subject to this policy who engage in outside consulting activities also should consider any guidelines provided by the Office of General Counsel for consulting agreements.

B. NYU will make no claim to any TRP made by a faculty member or research staff member in the course of a consulting engagement that is consistent with the terms of this Section XX if: (1) the TRP results from work on a problem or topic (a) proposed by the company for which the faculty member or research staff member is consulting and (b) on which the faculty member or research staff member has not engaged in research, and does not have plans to engage in research, at or under the auspices of NYU; (2) the TRP are made without the Substantial Use of University Resources; (3) the TRP are not made in connection with the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU or made in the person’s NYU employment, duties, training, research and/or clinical activities at, for or under the auspices of NYU; (4) the consulting agreement is approved in advance in writing where advanced approval may be required pursuant to any applicable NYU, School and/or unit policies; and (5) the consulting activity is not for a company that (a) has licensed such person’s Inventions, Copyrightable Works or Tangible Research Property from NYU or (b) is sponsoring research in which such person participates. NYU also will make no claim to a Copyrightable Work made by a faculty member of research staff member in the course of a consulting engagement if NYU, through the School Dean and the OIL, has received, reviewed and approved in advance in writing the consulting engagement and consulting agreement (including the problem, topic and/or statement of work) and the Copyrightable Work is made consistent with such advance approval. In all other situations, NYU is the owner of the TRP, subject to any written agreements to the contrary duly entered into or agreed to by NYU.

C. Even where TRP resulting from outside consulting activities is not owned by NYU, each TRP Creator is responsible for assuring that all such TRP are properly disclosed to the OIL as described in Section XXV.B. of this policy.

## **XXI. COMMERCIALIZATION OF TRP**

A. NYU is committed to facilitating the development, dissemination and, where appropriate, commercialization of TRPs for the greatest public benefit. Accordingly, when NYU owns the rights to TRP, NYU has the sole right, either directly or through others, to commercialize such TRP or otherwise make it available for public use. Such efforts may include, but are not limited to, licensing to an existing company, or the establishment of a new company or venture, in each case as determined by NYU. In all cases, decisions regarding TRP owned by NYU are made at the sole discretion of NYU, and NYU has no liability to any TRP Creator, other person with rights under this policy or third party for such decisions.

B. Because TRP potentially may have both scientific value to other researchers and commercial value, TRP owned by NYU may be made broadly available for others’ non-commercial scientific use by means that do not diminish its value or inhibit its commercial development or public use, or the potential commercial viability of Inventions, Copyrightable Works, and/or Research Data that are closely associated with the TRP. Normally in consultation with the TRP Creator, NYU will develop a strategy for commercializing the TRP that takes into account any parallel need to distribute the TRP, including within the scientific community, and including under Section XXIII of this policy.

C. Although valid reasons may exist for the temporary delay of TRP distribution outside the laboratory for others' scientific use (e.g., safety factors or the need to more fully characterize the TRP prior to distribution, etc.), scientific exchanges should not ordinarily be inhibited due to potential commercial considerations.

D. When NYU commercializes TRP, the TRP Creator may seek the recovery of the costs of the raw materials and handling from any commercialization or distribution of TRP not borne by NYU (including through external funding) prior to the calculation of Net Proceeds as provided below. NYU will, in its sole discretion, determine the nature and extent of any such recovery.

E. When NYU owns the rights to TRP, each TRP Creator has the right to share in the Net Proceeds received by NYU from commercializing the TRP except as otherwise provided in this policy. Specifically, Net Proceeds ordinarily are distributed as follows:

(1) Fifteen percent (15%) of the Net Proceeds for the general support of the OIL and to cover any other expenses associated with the commercialization of NYU's TRPs. In cases where the funds so designated exceed the budget of the OIL, the remainder are allocated to the NYU share as per Paragraph 2.b below; and

(2) The remaining Net Proceeds (85%) are distributed as follows:

(a) TRP Creator share: one-half (or 42.5% of Net Proceeds) to the TRP Creator or TRP Creators (including TRP Creators outside of NYU).

(b) One-half (or 42.5% of Net Proceeds) to be used by NYU for research, scholarship, educational and clinical activities (or as otherwise required by law, regulation or contract) in the following manner:

(i) Two-thirds to the School (or other NYU unit if the TRP Creator is not affiliated with a School) in which the TRP was made. Each School or other unit receiving royalty proceeds must develop and disseminate a policy for the use of such proceeds that is in accordance with the overall aims outlined in Section XXI.D. of this policy.

(ii) One-third to NYU. In recent years, for TRPs made in the School of Medicine, NYU's practice has been to contribute a large portion of its one-third share to the School of Medicine in light of financial circumstances.

If NYU pursues or defends litigation to enforce rights, then the proceeds of any judgment or settlement received by NYU from such litigation ordinarily will be included in Gross Proceeds, on a net basis, with the associated litigation expenses paid by NYU deducted as out-of-pocket expenses. If NYU becomes involved in litigation regarding the TRP, or closely associated Invention, Copyrightable Works, or Research Data, the distribution described above may be modified by the Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing), in his/her sole discretion, to reflect the greater economic risk being incurred by NYU in pursuing such litigation.

Except as provided below, TRP Creators who are employees of NYU are entitled to share in the Net Proceeds from commercialization of TRP as outlined in this Section XXI.B. TRP Creators (a) who are employees of NYU, other than faculty or research staff, (b) who are contractors/vendors/consultants of NYU or (c) whose sole contribution to TRP in the form of unadulterated human specimens is the design, development, or maintenance of the biorepository, or the provision of specimens to the biorepository from clinical activities or human subjects research, are not entitled to share in the Net Proceeds from commercialization of the TRP (i.e., they are not included within this Section XXIV.E.) unless, in the case of employees, NYU agrees to their inclusion in a writing signed by the Provost or The Executive Vice President, as applicable (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing). In any individual employee case, the supervisor of such an employee or the relevant project leader may make a recommendation (will make a recommendation if requested by the employee) as to the appropriateness of such employee sharing in the proceeds of commercialization and the Provost or The Executive Vice President (or his/her designee) (the Executive Vice President for Health (or his/her designee) in the case of the Schools of Medicine, Dentistry and Nursing) will determine if and the extent to which the employee is included. The decision of the Provost or The Executive Vice President (or his/her designee) (the Executive Vice President for Health (or his or her designee) in the case of the Schools of Medicine, Dentistry and Nursing) is final. For TRP Creators who are not entitled to share in the Net Proceeds under this policy, the portion of proceeds attributable to said Inventor(s) under Section XXI.E. of this policy will be distributed in full to NYU and NYU shall be entitled to exercise all other rights given to such joint TRP Creators in this policy.

Individuals sharing proceeds under this policy are responsible for understanding the personal tax and legal consequences to them of such entitlements pursuant to this policy.

F. Equity received by NYU from a company or other entity as a part of the consideration of a license or other disposition of TRP will be allocated by calculating the appropriate number of shares, using the same percentages outlined in Section XXIV.B. of this policy. Unless otherwise required by contractual arrangements, a management plan pursuant to an NYU conflict of interest policy, or applicable law, NYU normally will hold the shares until there is a public market for those shares or other liquidity event, and NYU will thereafter make appropriate distribution following NYU's or its agent's liquidation of the shares. Notwithstanding the foregoing, NYU may, in its sole discretion, (1) elect to hold the shares after there is a public market or other liquidity event or (2) elect to distribute equity at or any time after it is received by NYU or (3) require that the TRP Creator receive such equity directly from the company or other entity. NYU is not responsible, and has no liability, for any fluctuation or dilution in the value of the shares, for any tax consequences to the person receiving a distribution or for any other matters relating to NYU's administration of such shares or interests pursuant to this policy.

In the event that NYU elects to invest cash in a company or other entity to which NYU has licensed rights hereunder, and NYU receives equity for such investment, such investment will not be considered (1) an out-of-pocket expense of NYU for which reimbursement would be made under Section XXIV.B. of this policy or (2) Gross Proceeds from the licensing or other grant of rights for purposes of Section XXIV.B. of this policy. NYU will retain all proceeds and bear all losses from such equity investment.

To the extent that cash payments made to NYU under any licensing arrangement do not fully cover the out-of-pocket expenses of NYU under Section XXIV.B, NYU will be reimbursed for such

expenses by an allocation of equity from that licensing arrangement prior to any distribution of equity pursuant to Section XXIV.F.. Monies received by NYU pursuant to a license or other disposition of TRP may be required to be escrowed by NYU to cover a contingent liability under the license or disposition agreement. Ordinarily, no disbursements will be made under this policy until the monies are released from such escrow.

Individuals with rights to equity interests under this policy are responsible for the personal tax and legal consequences to them of owning and/or having rights to such equity, whether directly or beneficially, pursuant to this policy.

G. NYU and School (or other unit) shares of proceeds will be used to further the research, scholarship, educational and clinical activities of NYU (or as otherwise required by law, regulation or contract).

H. If more than one TRP Creator is to share in the TRP Creator share, the TRP Creators should decide among themselves their respective shares and provide the OIL with a written agreement signed by all TRP Creators. Such written agreement among the TRP Creators must be provided promptly to the OIL upon a written request from the OIL for such an agreement and will be irrevocable unless it is modified in writing by all TRP Creators. In the absence of such a written agreement, NYU will determine the distribution of shares to TRP Creators, which may in NYU's sole discretion vary based on each TRP Creator's contributions to and commercial relevance of the TRPs or other factors, and such determination will be binding on all TRP Creators. NYU has the right at any time, in its sole discretion, to reapportion distributions among the TRP Creators to reflect the commercial relevance of TRP. NYU will support such decisions with a written rationale, and any apportionment or reapportionment will be subject to the appeal rights set forth in Section XXV.H. of this policy. If the TRP Creators represent more than one School or other NYU unit, the distribution of the School or unit share will follow the allocation of the TRP Creator share set forth in the agreement among the TRP Creators or NYU determination, as applicable, unless otherwise agreed.

I. Where non-patentable TRP are included within an Invention because they are closely associated with the Invention, the TRP Creators may or may not be entitled to an economic benefit as set forth in Section V.F. of the Patent Policy.

J. Whenever NYU licenses rights to a TRP, NYU will seek to reserve the right for NYU to use the TRP for any purpose consistent with NYU's mission, including research, clinical and educational purposes, except in rare cases approved by the Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing), and NYU may reserve the right to grant similar rights to other nonprofit research institutions.

## **XXII. TRANSFERRING OR RELEASING OWNERSHIP OF TRP TO THE TRP CREATOR**

A. If NYU determines that it will not pursue commercialization of TRP that are subject to NYU ownership under this policy, and NYU further determines that it wishes to destroy or discard the TRP, NYU will consider a written request by the TRP Creator to transfer ownership and/or possession of the TRP to the TRP Creator as provided herein, subject to the terms (including required approvals from government or other sponsors) of any applicable grants, contracts, or



agreements duly entered into with governmental, corporate, nonprofit or other third parties (including but not limited to any rights held by the US Government). Transfer of ownership and/or possession to the TRP Creator generally will be subject to an irrevocable non-exclusive world-wide royalty-free license to NYU to use the TRP for education, research (including sponsored research), clinical and other legitimate NYU purposes and may be subject to a reservation to NYU of the right to grant similar licenses to other nonprofit institutions and government organizations. In those instances in which there are multiple TRP Creators, all TRP Creators must be in agreement and be party to such a request, although all TRP Creators need not be seeking ownership or equal rights. In all cases, decisions regarding transfer of ownership or possession in TRP are at the sole discretion of NYU, and NYU has no liability to any TRP Creator, other person with rights under this policy or third party in connection with such decisions.

B. If, after the transfer of ownership to the TRP Creator pursuant to a request made under Section XXII.A. of this policy, the TRP Creator receives proceeds from commercializing the TRP, NYU may require reimbursement from the TRP Creator for any out-of-pocket expenses incurred by NYU in connection with the TRP, including legal, commercialization and marketing expenses.

C. The transfer of ownership of a TRP to the TRP Creator does not affect NYU's rights or the TRP Creator's obligations pursuant to this policy with respect to other TRPs.

D. If a TRP Creator of TRP subject to this policy believes the TRP should not be subject to NYU's ownership rights under this policy because (1) the TRP can be shown by clear and convincing evidence to be outside of NYU's ownership rights in accordance with Section XIX.A(2) of this policy, (2) the TRP was made solely during an unpaid leave as set forth in Section XIX.C. of this policy, (3) the TRP was made by student(s) as part of uncompensated class work as set forth in Section XIX.E. of this policy, (4) the TRP was made in outside consulting and is consistent with the requirements set forth in Section XX.B. of this policy, or (5) otherwise, the TRP Creator may request through the OIL a determination as to whether NYU will assert ownership rights to the TRP under this policy. In the case of multiple TRP Creators, all TRP Creators should agree and be party to the request. In connection with the request, the TRP Creator(s) must provide the OIL with a summary of the circumstances leading to the creation of the TRP. The Provost or The Executive Vice President (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing), in consultation with the OIL and the School Dean(s), will make a determination in writing on whether to assert ownership rights in such TRP or to release such TRP to the TRP Creator(s). It is expected that the written determination will be provided to the TRP Creator(s) within thirty (30) days of date of the OIL receives sufficient information regarding the TRP for NYU to make such a determination. In all cases, decisions regarding releasing of ownership in TRP are at the sole discretion of NYU, and NYU has no liability to any TRP Creator, other person with rights under this policy or third party in connection with such decisions.

### **XXIII. MAKING NYU-OWNED TRP AVAILABLE FOR PUBLIC USE OR NON-COMMERCIAL PURPOSES**

A NYU, in its sole discretion, normally after consultation with the TRP Creator, may make TRP available for public use on royalty-free license terms as it finds appropriate where it believes that the advantages of making such TRP available for public use outweigh alternative commercialization strategies and there are no legal or contractual obligations that prohibit the public

use. NYU also may include terms for any sharing, such as those outlined in the Uniform Biological Material Transfer Agreement (UBMTA,) pursuant to agreements approved by the OIL. NYU maintains the right to access TRP and associated Research Data, regardless of the location of the TRP Creator(s), to assure its rights under this policy. If NYU believes it appropriate (e.g., for safe-keeping of the TRP), NYU may take physical custody of any TRP. The TRP Creator of TRP owned by NYU may request that NYU make such TRP available for public use on a royalty-free basis or other means. Such request should be transmitted to the OIL in writing. In the case of multiple TRP Creators, all TRP Creators should agree and be party to the request. The Provost or The Executive Vice President, as applicable, (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing) will make a determination with respect to the request (see Section XXVIII.F. of this policy). All public use of TRP hereunder will be consistent with NYU's Policy on Retention of and Access to Research Data.

#### B. Biological TRP

Any distribution of biological TRP (other than distributions for purposes of patient care) should be accompanied by a Material Transfer Agreement provided by and signed by the OIL, regardless of whether the TRP are distributed for non-commercial or commercial research purposes. Some transfers of biological TRP, such as infectious agents or recombinant DNA, also may require compliance with customs, safety and other regulations. For information about regulations regarding such transfers, contact the Office of Environmental Health and Safety.

#### C. TRP containing Software or Copyrightable Works

If a TRP Creator wishes to transfer TRP that contains software and/or computer code that is considered a Copyrightable Work that is required to be disclosed pursuant to paragraph XVI.B of the Copyright Policy, such transfers should be approved by the OIL to ensure that the transfer does not diminish or impair the Copyrightable Works contained within the TRP.

### **XXIV. TRANSFER IN THE EVENT A PRINCIPAL INVESTIGATOR LEAVES NYU**

If a principal investigator leaves NYU, and a project is authorized by NYU to be moved to another institution, original or copies of TRP and closely associated Research Data, as appropriate, may be transferred with the approval of the Senior Vice Provost for Research (or a designee) (the Executive Vice President for Health (or a designee) in the case of the Schools of Medicine, Dentistry and Nursing), and with a written Material Transfer Agreement from the principal investigator's new institution, and approved by the OIL, that guarantees: (A) its acceptance of custodial responsibilities for the TRP and Research Data, and (B) NYU's access to the TRP and Research Data, should that become necessary.

NYU may refuse to permit the transfer of original TRP and closely associated Research Data, and may impose conditions beyond those stipulated in this policy on such transfer, or may ask the PI to leave copies and/or portions of the TRP and closely associated Research Data with NYU. In addition, other NYU investigators associated with a collaborative research project may make copies of TRP and closely associated Research Data, where feasible, prior to a permitted transfer by the principal investigator, unless restricted by an agreement duly entered into with governmental, corporate, nonprofit or other third parties.

Departing TRP Creator(s) have an obligation to hold TRP owned by NYU under this policy and any closely associated Research Data in trust for NYU and must return the TRP and closely associated Research Data to NYU if requested. In addition, during the required retention period, such TRP and closely associated Research Data must be available to external sponsors, designated governmental officials, and other NYU investigators associated with the collaborative research project, as appropriate.

Principal investigators and other TRP Creators should note that many legal and contractual agreements require the sponsor's consent before TRP and closely associated Research Data are transferred or removed from NYU. Before transferring the original TRP and closely associated Research Data, the principal investigator is responsible for ensuring that any special conditions stated in the grant, contract, or agreement are met.

This Section XXVII applies for all TRP transferred with a departing principal investigator, including TRP in which NYU has transferred ownership to the principal investigator as outlined in Section XXII of this policy. All transfers of TRP hereunder will be consistent with NYU's Policy on Retention of and Access to Research Data.

## **XXV. ADMINISTRATION OF POLICY**

### **A. University Administration**

This policy will be administered by the Provost and The Executive Vice President, except in the Schools of Medicine, Dentistry and Nursing, where the policy will be administered by the Executive Vice President for Health. The Provost, The Executive Vice President and the Executive Vice President for Health may obtain advice from the Intellectual Property Advisory Committee and the Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing) will consult with the School Deans, as appropriate. Further information about the Intellectual Property Advisory Committee and administration of this policy is contained in Appendix B.

### **B. Disclosure of TRPs**

(1) TRP Creators must, at the earliest opportunity practicable, promptly notify and fully disclose to NYU any TRP if: (a) the TRP Creators wish to transfer the TRP outside of the University; (b) in TRP Creators' reasonable judgment the TRP has commercial potential, or (c) the TRP are subject to contractual rights or obligations (e.g., funding agreements). A TRP Creator's obligation to disclose as set forth herein continues after the TRP Creator ceases to be a member of the University Community with respect to TRP covered under this policy.

(2) If there is any possibility that NYU has ownership rights in TRP, the TRP Creator must disclose the TRP to NYU as set forth in this policy, even if a TRP Creator believes that NYU has no ownership rights to the TRP. TRP Creators are encouraged to disclose all TRP to NYU that are made in whole or in part while the TRP Creator is a member of the University Community even if NYU clearly has no ownership rights to the TRP.

(3) Upon disclosure of TRP, NYU will determine whether or not ownership vests in NYU.

### C. Cooperation of TRP Creator with NYU Ownership Rights

If NYU maintains ownership rights to the TRP pursuant to this policy, NYU has the right, either directly or through others, to evaluate the TRP, to seek patent or other protection of the TRP, and to undertake commercialization and/or otherwise introduce the TRP into public use. Each TRP Creator is required to cooperate as reasonably requested by NYU, and in every necessary way, but at no out-of-pocket expense to the TRP Creator, with NYU's efforts, including, without limitation, executing confirmatory assignments documenting NYU's ownership, and executing documents necessary or useful for prosecuting or enforcing patents and patent applications in the US or in any other jurisdiction or with respect to the commercialization the TRP or its introduction into public use. A TRP Creator's obligation to cooperate as set forth herein continues after the TRP Creator ceases to be a member of the University Community with respect to TRPs covered under this policy.

### D. Responsibilities of TRP Creator

As set forth below, the TRP Creator (and where applicable, the principal investigator, or laboratory director or department chair, if the TRP are not developed as part of a project headed by a principal investigator) is responsible for the proper identification, custody, storage and use of TRP, and for monitoring and documenting as necessary IRB and regulatory compliance related to the TRP, all as subject to this policy, other NYU policies, and the terms of any applicable grants, contracts, or agreements duly entered into with governmental, corporate, nonprofit or other third parties (including but not limited to any rights held by the US Government and government or sponsor approvals).

(1) TRP Identification. The TRP Creator is responsible for assuring that each item of TRP has an orderly and unambiguous identification code and/or name sufficient to distinguish it from other similar items developed by the TRP Creator. Where applicable (e. g., embodiments of computer software), NYU's name and other relevant information should be affixed to each item to provide notice of NYU's ownership interests in the item. Such notice should be sufficient to meet NYU's contractual obligations and administrative needs, including notice of copyright, trademark and government rights. Information regarding identification, marks, and legends required under sponsored agreements can be obtained from the applicable sponsored programs office.

(2) Custody and Storage of TRP. The TRP Creator is responsible for establishing conditions for the storage and custody of TRP sufficient to protect the integrity and potential value of the TRP for research and commercial purposes. The TRP Creator is responsible for establishing and maintaining procedures for the protection of TRP in the event of a natural disaster or other emergency, and for the security of TRP in such event. The TRP Creator is also responsible for assuring that where TRP must be combined with or modified by the tangible materials of a third party (such as a material received from a third party under a material transfer agreement such interaction does not impair or diminish NYU's rights in the TRP, except with the approval of the OIL.

(3) Use and Distribution. Although sharing TRP with other research laboratories is customary and expected in many instances, such "sharing" or distributions of biological and chemical TRP should only be done through a formal Material Transfer Agreement approved by the OIL, as set forth in detail under Section XXI of this policy. All such agreements must be consistent with any

applicable customs and export laws and regulations. Only a representative of the OIL or the Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing) may execute a formal agreement for the sharing or distribution of TRP.

#### E. Agreement to Policy

This policy is binding on NYU and on all members of the University Community. All members of the University Community are advised of NYU's policies and procedures relating to intellectual property through publication on NYU's website at [www.nyu.edu](http://www.nyu.edu). To the extent NYU requires formal confirmation of assignments or other agreements to implement this policy, the absence of such executed agreements does not in any way invalidate, in whole or in part, the applicability of the policy or diminish NYU's rights under this policy. Nothing in this policy constitutes a waiver by NYU of any rights that NYU may have under any other NYU policy, by contract or pursuant to any applicable law.

#### F. Intellectual Property Agreement

Each member of the University Community must sign and submit an Intellectual Property Agreement (see Appendix C) when first submitting an external grant application, when first engaging in sponsored programs, or in certain Schools on accepting an appointment to NYU; and must sign and submit an Intellectual Property Agreement at any time upon request of the Provost or The Executive Vice President (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing). All program directors or principal investigators of sponsored programs are responsible for securing signatures to the Intellectual Property Agreement from all research personnel, including students, working on a project at the time of their appointment to the project and for the timely submission of the fully-executed Agreement as set forth on the Intellectual Property Agreement. Notwithstanding the above, the failure of NYU to obtain a signed Intellectual Property Assignment does not in any way diminish NYU's rights under this policy.

#### G. Disputes

Disputes involving intellectual property rights or this policy will be reviewed and resolved by the Provost and/or The Executive Vice President or by the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing, as applicable, unless a decision is deemed final pursuant to this policy. The Provost, The Executive Vice President and/or the Executive Vice President for Health may within their sole discretion refer the matter to the Intellectual Property Advisory Committee or another designee to adjudicate the matter or to make a formal recommendation to the Provost and/or The Executive Vice President or to the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing, as applicable. Adjudications made hereunder by the Intellectual Property Advisory Committee or another designee of the Provost, The Executive Vice President and/or the Executive Vice President for Health may be appealed, within thirty days of the date of the decision, to the Provost and/or The Executive Vice President or to the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing, who will review the matter and make a final decision on behalf of NYU. If the Provost and/or The Executive Vice President or the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing are not able to review the matter and make a final decision on behalf of NYU, for example due to conflict or unavailability, the appeal will go instead to the President or the President's designee, who will review the matter and make a final

decision on behalf of NYU. The persons involved in the dispute should present a written summary of the matter with relevant written evidence and may ask to present witnesses, which may be permitted in the discretion of the recommending or adjudicating person or persons or committee. The recommending or adjudicating person or persons or committee may consult with the Intellectual Property Advisory Committee, the relevant School Dean, other officers and personnel of NYU, and/or any experts or witnesses as they may deem appropriate.

#### H. Advisory Committee

The Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing) may from time to time appoint an Intellectual Property Advisory Committee with broad or specific responsibilities relating to all intellectual property matters (which may include, without limitation, Inventions, patents, Copyrightable Works, copyrights, software, Tangible Research Property and Research Data). The Intellectual Property Advisory Committee's role is to advise the OIL, the Provost, and/or the Senior Vice Provost for Research, except in the Schools of Medicine, Dentistry and Nursing, where the Committee's role is advisory to the School Dean and the Executive Vice President for Health (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing).

#### I. Administration by Schools and Units

(1) The School Deans will work closely with the Provost (the Executive Vice President for Health in the case of the Schools of Medicine, Dentistry and Nursing) and the Intellectual Property Advisory Committee to ensure that the perspectives, practices and values of each School are taken into consideration in the decision-making process under this policy.

(2) Each School of NYU retains the right to supplement this policy as necessary or desired by such School, including requiring formal assignments or agreements of its employees or others subject to this policy or such School's policies. The Provost may permit academic units other than Schools, The Executive Vice President may permit non-academic units and the Executive Vice President for Health in the case of the School of Medicine, Dentistry and Nursing may permit any of their academic and non-academic units to supplement this policy as necessary or desired by such unit, including requiring formal assignments or agreements of its employees or others subject to this policy or such unit's policies. The decision of any School or unit not to secure formal intellectual property agreements from any person does not diminish NYU's rights under this policy. Any supplement must be: (a) consistent with the terms of this policy (or an exception approved in accordance with the Policy on Policies); (b) in writing; (c) approved by the School Dean in the case of a School; and (d) submitted to the Provost for review and approval in the case of a School or academic unit, to The Executive Vice President in the case of a non-academic unit and to the Executive Vice President for Health in the case of the School of Medicine, Dentistry and Nursing and any of their academic and non-academic units. A supplement may contain dispute resolution procedures that operate within a School, provided that such procedures are not inconsistent with this policy and provide for resolution pursuant to Section XXVIII.D. of this policy in the event that such dispute cannot be resolved within the School.

#### J. Governing Law

This policy is governed by and construed in accordance with the laws of the US and the State of New York; provided however, that where the only persons who may be TRP Creators are non-US nationals and all of the work giving rise to the TRP was performed outside of the United States, NYU may, in its sole discretion, apply a relevant international law to questions under this policy.

## APPENDIX A TO STATEMENT OF POLICY ON INTELLECTUAL PROPERTY

### DEFINITIONS

This Appendix defines certain terms used in this Statement of Policy on Intellectual Property. Except where the context requires otherwise, whenever used the singular includes the plural, the plural includes the singular, and the use of any gender is applicable to all genders.

“Copyrightable Work” means any original work of authorship that is reduced to tangible form (including web pages and digital works), and includes literary works, computer software, data sets, musical works, dramatic works, pantomimes and choreographic works, artistic works (pictorial, graphic, and sculptural), and audiovisual works including motion pictures, sound recordings, and architectural works, all including in existing formats and those later created. For purposes of this Statement of Policy on Intellectual Property, a Copyrightable Work also includes all US and international copyright rights, and all similar rights, such as moral rights, derived from the Copyrightable Work.

“Creator” means a member of the University Community who has solely or jointly authored or created a Copyrightable Work.

“The Executive Vice President” means The Executive Vice President or his/her designee.

“Executive Vice President for Health” means the Executive Vice President for Health or his/her designee.

“Gross Proceeds” means proceeds received by NYU (on a cash, as opposed to an accrual, basis) from licensing or otherwise granting rights in an Invention, Copyrightable Work, or Tangible Research Property to third parties, including license fees, royalties on sales or other usage, and milestone payments, but excluding research funding and other internally generated monies, including but not limited to tuition. Gross Proceeds also includes amounts recovered (on a cash, as opposed to an accrual, basis) by NYU from suits or dispute resolution with licensees and/or infringing third parties, less the attorney’s fees, court and dispute resolutions fees and other direct costs of such suits.

“Instructional Media”, means: (i) a Copyrightable Works used or created as content for courses, instruction and/or programs delivered at or under the auspices of NYU using any form of media, including print, in-person delivery, over the World Wide Web or using other forms of electronic media, video including videotaping, audio including audiotaping, television broadcast, or radio broadcast, as well as forms of transcription or media in existence or that may arise in the future. By way of illustration, Instructional Media includes, but is not limited to, the course title and course syllabus, course reading lists, lecture notes, course materials, handouts, problems and examples, presentation materials (such as content made available to students through Sakai, Blackboard, Powerpoint, and similar programs, platforms and/or technologies), and course tests and examinations. Instructional Media excludes Traditional Works of Scholarship.

"Invention" means any novel idea, discovery, invention, know-how, show-how, or process, whether or not patentable, together with any associated or supporting technology necessary or



useful for the protection, development or application of the idea, discovery, invention, know-how, show-how, or process. For purposes of this Statement of Policy on Intellectual Property, an Invention also includes all patents and patent rights derived from that Invention, and all non-patentable Copyrightable Works, Tangible Research Property and Research Data that are closely associated with the Invention. "Closely associated with" includes useful in practicing the patent, in effectively prosecuting the patent application or in maximizing the licensing potential or other commercialization of the Invention.

"Inventor" means a person who individually or jointly with others makes an Invention; and in the case of a patent, who meets the criteria for Inventorship under US patent laws and regulations, regardless of the place an Invention is conceived, reduced to practice or developed. Creating or contributing to non-patentable Copyrightable Works, Tangible Research Property or Research Data that are closely associated with an Invention does not cause the creator or contributor to be an Inventor.

"Net Proceeds" means Gross Proceeds minus all out-of-pocket expenses incurred by NYU that are associated with the particular Invention, Copyrightable Work, Tangible Research Property or Research Data. Out-of-pocket expenses includes, but is not limited to, such items as: patent or copyrighting expenses, legal expenses associated with negotiating an agreement or defending or prosecuting a claim or potential claim with respect to an Invention, Copyrightable Work, Inventor, Creator, or licensee, travel expenses, payments due to other parties with rights in the Invention, Copyrightable Work, Tangible Research Property or Research Data, or any reasonable expenses incurred in pursuing NYU's rights.

"NYU" includes the schools, colleges, institutes, and other administrative units of NYU, NYU's Global Network University sites, and all University Affiliates, as each term is defined in NYU's Policy on Policies.

"Research Data" means any recorded, retrievable information useful for the reconstruction and evaluation of reported results created in connection with the design, conduct or reporting of research performed at or under the auspices of NYU and the events and processes leading to those results, regardless of the form or the media on which they may be recorded. Research Data include both intangible data (statistics, finding, conclusions, etc.) and tangible data (notebooks, printouts, etc.), but not Tangible Research Property.

"School" means each NYU school, college or institute that functions similarly to a school or college (such as IFA, ISAW, Courant and CUSP), each NYU comprehensive campus (such as New York, Abu Dhabi and Shanghai) and also may include for purposes of this policy other global sites as designated by the Provost

"School Dean" means the dean, or his or her designee, of each NYU school and college, the director or each NYU institute that functions similarly to a school or college (such as IFA, ISAW, Courant and CUSP) and the Vice Chancellor of each NYU comprehensive campus (such as New York and Abu Dhabi). In the case of other NYU global sites that have Inventors, Creators and/or TRP Creators, the Provost may designate someone to fulfill some or all of the duties of a School Dean as described herein with respect to such global sites.

“Substantial Use of University Resources” means more than incidental use of NYU resources. The following are examples of Substantial Use of University Resources (in the absence of advance written approval of NYU that explicitly states they will not be deemed to be considered Substantial Use of University Resources): use of NYU funding or of grants administered by NYU; use of NYU employees, physicians, consultants, vendors, contractors, students, post-doctoral scholars or fellows; use of NYU intellectual property; use of NYU laboratories or other facilities; or use of NYU research, clinical or other equipment. Use of NYU libraries on a basis similar to scholars who have no association with NYU is not considered Substantial Use of University Resources.

“Tangible Research Property” (or “TRP”) means tangible (or corporeal) items produced in the course of research, clinical or other activities at or under the auspices of NYU, or otherwise made with Significant Use of University Resources. TRP includes, but is not limited to, such items as: biological materials, engineering drawings, integrated circuit chips, physical embodiments of computer software and computer databases, algorithms and databases (e.g., computer disks and firmware), prototype devices, circuit diagrams, and equipment, as is intended to include items that are in existence or that may arise in the future. TRP are separate and distinct from Inventions, patents, Copyrightable Works, copyright or Research Data. Individual items of TRP may be associated with copyrights or patents. For purposes of this Statement of Policy on Intellectual Property, Tangible Research Property also includes all registrations, filings, depository rights and indicia covering the TRP. By way of illustration only, this includes but is not limited to: ATCC data and rights, mask work rights, and Plant Variety Protection Certificates.

“TRP Creator” means a member of the University Community who has solely or jointly made Tangible Research Property. TRP Creators must make a significant intellectual contribution to TRP. Merely the provision of specimens or samples to a repository or library does not qualify a person as a TRP Creator.

“Traditional Works of Scholarship” means the following when created by faculty, research scientists, post-doctoral appointees, and/or fellows: traditional textbooks in print or digital format, journal articles, research bulletins, monographs and other scholarly publications, non-commissioned creative works of art, including music, lyrics, photographs, poetry, choreography, works of fiction, plays, architectural works, sculpture, pictorial and graphic works, motion pictures, and sound recordings, which in each case are created: (1) as part of the regular scholarly activities of a Creator covered by this Statement of Policy on Intellectual Property; and (2) upon the initiative of the Creator (as opposed to a research sponsor or NYU).

“University Community” means all NYU faculty, including visiting faculty; researchers, including persons participating in research at or under the auspices of NYU; employees; contractors; volunteers; fellows, trainees and post-doctoral appointees; students; and any other persons involved in the creation of Copyrightable Works at or under the auspices of NYU, and applies to all research projects on which those individuals work, regardless of whether the project is funded and if so, by what entity.

**APPENDIX B**  
**TO STATEMENT OF POLICY ON INTELLECTUAL PROPERTY**

**NYU INTELLECTUAL PROPERTY AGREEMENT (“AGREEMENT”)**

I have read and understand New York University’s (“NYU’s”) Statement of Policy on Intellectual Property, including NYU’s Patent Policy, Copyright Policy and Tangible Research Property Policy (the “Statement of Policy on Intellectual Policy” or “Statement”). I understand that in consideration of my being a member of the University Community<sup>1</sup>, as defined in that Statement, and in consideration of my rights under that Statement that I am bound by all the provisions of the Statement of Policy on Intellectual Property.

I understand that NYU has the right to ask me to confirm in writing that I am bound by all the provisions of the Statement of Policy on Intellectual Property. I hereby:

- A. acknowledge and confirm that I have assigned to NYU all of my right, title and interest in and to: any Invention (including any Copyrightable Works, Tangible Research Property and/or Research Data closely associated with the Invention or necessary or useful for the Invention’s protection, development or application thereto), including all right, title and interest in and to any copyrights, patent applications, patents or inventors certificates for such Inventions, any Copyrightable Work, and any Tangible Research Property I create, conceive and/or reduce to practice, that is subject to NYU ownership under the terms of the Statement of Policy on Intellectual Property and/or grants or agreements under which research or other activities I participate in is funded or otherwise supported;
- B. agree to cooperate as reasonably requested by NYU, and in every necessary way, but at no out-of-pocket expense to me, with NYU’s efforts to evaluate an Invention, Copyrightable Work and/or Tangible Research Property, to seek patent, copyright or other protection for it, and to undertake commercialization and/or otherwise introduce it into public use, including, without limitation, executing confirmatory assignments or agreements documenting NYU’s ownership as contemplated by this Agreement and the Statement of Policy on Intellectual Property, executing documents necessary or useful for prosecuting or enforcing patents, patent applications or copyrights in the US or in any other jurisdiction or with respect to the commercialization of the Invention, Copyrightable Work and/or Tangible Research Property or its introduction into public use, meeting and cooperating with NYU and its attorneys and agents regarding the prosecution and enforcement of patents or patent applications, and providing reasonable advisement regarding it to companies who have acquired rights to it pursuant to this Statement of Intellectual Property.

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<sup>1</sup> “University Community” means all NYU faculty, including visiting faculty; researchers, including persons participating in research at or under the auspices of NYU; employees; contractors; volunteers; fellows, trainees and post-doctoral appointees; students; and any other persons involved in the creation of Copyrightable Works at or under the auspices of NYU, and applies to all research and other projects on which those individuals work, regardless of whether the project is funded and if so, by what entity.

- C. agree to disclose fully to NYU's Office of Industrial Liaison, promptly after discovery, conception, reduction to practice, and/or creation, any Invention I conceive and reduce to practice and any Copyrightable Work I create that may be subject to NYU ownership under the terms of the Statement of Policy on Intellectual Property and/or the agreements under which research or other activities I participate in is funded or otherwise supported, even if I believe at that time that NYU has no ownership rights to the Invention or Copyrightable Work. For Invention disclosures, I agree to make the disclosure to NYU's Office of Industrial Liaison prior to any public disclosure of the Invention and I agree to ensure that the disclosures are sufficient to ensure that NYU is: (a) fully informed of the scope, extent and usefulness of the Invention; (b) able to make a proper determination of Inventorship and ownership; (c) able to fulfill reporting obligations to governmental and other research or other sponsors; and (d) able to timely file patent applications. An Inventor's or Creator's obligation to disclose as set forth herein continues after the Inventor or Creator ceases to be a member of the University Community with respect to Inventions or Copyrightable Works covered under the Statement of Policy on Intellectual Property.
- D. agree to disclose fully to NYU's Office of Industrial Liaison, at the earliest opportunity practicable, any Tangible Research Property ("TRP") I create that may be subject to NYU ownership under the terms of the Statement of Policy on Intellectual Property and/or the agreements under which research or other activities I participate in is funded or otherwise supported, even if I believe at that time that NYU has no ownership rights to the TRP, when (a) I wish to transfer the TRP outside of NYU; (b) I believe, in my reasonable judgment, that the TRP has commercial potential, or (c) the TRP is subject to contractual rights or obligations (e.g., funding agreements).
- E. certify that I do not have any consulting or other agreements with any third person or organization pursuant to which I grant rights that are in conflict with this Agreement or with my obligations under the Statement of Policy on Intellectual Property, and warrant that I will not knowingly enter into any such agreement.

If I am a director or principal investigator of a sponsored project, I agree to secure signatures to an NYU Intellectual Property Agreement in the form of this Agreement from all members of the University Community working on the project at the time of their appointment and file the signatures with NYU's Office of Sponsored Programs.

[I agree my responsibilities hereunder continue after termination of my employment or association with NYU.](#)

[I agree that this agreement is governed by and construed in accordance with the laws of the United States of America and the State of New York.](#)

NAME: \_\_\_\_\_

SIGNED: \_\_\_\_\_

DATE: \_\_\_\_\_

WITNESS NAME: \_\_\_\_\_