

YESHIVA UNIVERSITY
PATENTS, LICENSING AND INTELLECTUAL PROPERTY POLICY
("PATENT POLICY")

A. General Policy

- i. The purpose of this Patent Policy is to delineate the rights of Inventors (as hereafter defined) and Yeshiva University (the "University" or "YU") with regard to Intellectual Property (as hereafter defined), and specify how proceeds generated by Intellectual Property will be distributed.
- ii. This Patent Policy applies to all Intellectual Property generated by faculty, staff, students and visiting faculty of YU.
- iii. Definitions:
 - a. "Intellectual Property" means the following as such may exist or be created in any jurisdiction worldwide:
 1. all inventions, discoveries, improvements, processes, methods, new uses, patents, tangible research materials, unique biological assets, compounds, formulations, composition of matter, applications for patents and statutory invention registrations, including, but not limited to, reissues, divisions, provisionals, non-provisionals, continuations, renewals, re-examinations, extensions and continuations-in-part of any of the foregoing;
 2. all trademarks, service marks, trade names, business names, corporate names, trade dress, look and feel, product and service names, logos, brand names, domain names, URLs, and other distinctive identification and indicia of source of origin, whether or not registered, including, but not limited to, all common law rights thereto, and all applications and registrations therefor, and all goodwill associated with any of the foregoing and/or the business connected with the use of and symbolized by the foregoing;
 3. all copyrights, author's rights, moral rights and copyrightable subject matter and all other works of authorship, whether or not published and whether or not registered, and all applications and registrations therefor;
 4. all designs, design registrations, design registration applications and integrated circuit topographies;
 5. all software, algorithms, biological specimens, microchips, circuits, devices, and chemical samples;
 6. all rights in databases and data collections (including, but not limited to, design databases, knowledge databases and customer databases);

7. all other proprietary information and intellectual property in all forms and media, and all goodwill associated therewith, and whether or not subject to patent, copyright, trademark, design or other intellectual property registration or classification, now known or hereafter recognized in any jurisdiction worldwide;
8. all records, memoranda, notes, schedules, plans, or other documentation and information that describe or support any of the foregoing;
9. all rights pertaining to the foregoing, including, but not limited to, those arising under international treaties and convention rights; and
10. all proceeds, income, royalties, damages and payments now and/or hereafter due and payable under and/or in respect of all of the foregoing (including, but not limited to, with respect to past, present or future infringement or violation thereof)

"Invention" means creation of Intellectual Property which did not exist previously.

"YU Resources" mean labs, offices, facilities and/or materials of YU; YU clerical and/or administrative support; financial or other support, regardless of origin, provided and/or administered through YU channels.

- iv. The University encourages and supports research and the publication and use of results. YU recognizes that research conducted by its faculty (including also visiting faculty), staff and/or students may lead to the creation of Inventions by inventor(s) (inventorship shall be determined in accordance with United States patent law, when applicable, or through procedures of the YU Committee on Patents) (each hereinafter referred to as "Inventor"), which should be patented and/or licensed for one or more of the following reasons:
 - a. To serve the public interest;
 - b. To comply with the requirements of sponsored research grants, fellowship awards and contracts for research;
 - c. To promote the development of useful drugs, processes and devices which would not be developed without patent protection;
 - d. To encourage invention and insure rewards for the Inventor as herein provided; and
 - e. To support facilities and the research and education programs of YU by means of a share of income derived from the commercial licensing of inventions and patents.
- v. This Patent Policy is intended to be consistent with these principles and purposes, and not to fetter scientific endeavor or inhibit pursuit of further related research.

Whenever used in this Patent Policy, the provisions relating to patents and patent royalties shall, whether specifically mentioned or not, also apply to the commercial licensing and the royalties obtained from it for Inventions which are not patented but which have commercial value or special technology or special art.

B. Disclosure of Invention to Yeshiva University

- i. All faculty (including also visiting faculty), staff, and students of YU are required to report to the Provost and/or the YU Committee on Patents all Inventions that: are made, originated, conceived, or reduced to practice by them during their appointment, employment and/or affiliation with YU and/or have otherwise resulted from research supported (directly or indirectly) entirely or partly by YU Resources as soon as possible after conception or first actual reduction to. Such reports, submitted using the Yeshiva University Invention Disclosure Form attached as an exhibit to this Patent Policy, shall be made descriptive enough for the Invention to be understood and evaluated for possible filing of a patent application and/or the development of a commercial licensing agreement.
- ii. In the case of research supported by any government agency or third-party sponsor, the Provost must be advised in advance of (and approve) any invention disclosure requirements of the granting or sponsoring agency.
- iii. It will be the responsibility of the Provost, with the advice of the YU Committee on Patents, to determine if YU is interested in pursuing a patent for any such Invention disclosure. Sections C. through J. below will detail the terms that will apply until YU declines to patent a YU-Owned Invention.

C. Ownership of Patents and Inventions

- i. YU shall own all rights, title and interests in and to YU Inventions resulting from research carried out or conducted by any of the following ("YU-Owned Inventions"):
 - a. YU faculty members, staff members and/or students and supported (directly or indirectly) entirely or partly by and/or through the use of any YU Resources;
 - b. research carried out or conducted by YU faculty members and/or research staff within their respective academic fields while employed by YU; and/or
 - c. research carried out or conducted by a student of YU in fulfillment of course requirements or other requirements for a degree, or in connection with a formal training program, including the preparation of a thesis or dissertation.
- ii. YU shall pay to the Inventor of a YU-Owned Invention a fixed proportion of the financial returns actually received by YU from the licensing or exploitation of such YU-Owned Invention in accordance with the provisions of Section F. below.

An Invention is considered to result from research if it was either conceived or first actually reduced to practice in the course of that research. With respect to an article or composition of matter, reduction to practice means construction (e.g., of a prototype) or formulation and testing sufficient to show that the article or matter is capable of

producing the invention's intended result. With respect to a method or process, reduction means to demonstrate the method.

- iii. Inventions made by YU faculty members, staff members and/or students in connection with government-sponsored research contracts, grants, fellowships or other such arrangements, shall be controlled by the terms of those arrangements. YU faculty or staff members accepting government-sponsored research shall execute such agreements as will enable YU to meet its obligations to the sponsoring agencies. All such arrangements and agreements require the prior written consent of the Provost, and shall otherwise be in compliance with University policies, including, but not limited to, policies on outside employment and conflicts of interest. (Note: Federal law generally grants the U.S. government a perpetual license in any invention conceived or first actually reduced to practice in performing a project supported in whole or part by federal funding.)
- iv. If Inventions result from grants from or contracts with non-government sources, such Inventions shall be subject to the terms of Section C. i. above, unless the terms of the grant or contract pertaining to the above research are in conflict with Section C. i., in which case the terms of the grant or contract shall govern. All such arrangements and agreements require the prior written consent of the Provost, and shall otherwise be in compliance with University policies, including, but not limited to, policies on outside employment and conflicts of interest.
- v. Copyrightable works that are made by YU faculty members or staff members outside the scope of their employment at YU and are not otherwise created using any YU Resources, such as scholarly works and books, shall be owned by the author thereof.
- vi. All Inventors, as well as other faculty (including also visiting faculty), students and staff, must hold all unpublished information regarding YU-Owned Inventions and other YU Intellectual Property in confidence and not disclose it to third parties without the prior written consent of the Provost (i.e., under a confidentiality agreement).

D. Management of Patents

YU (with the assistance of its Office of the General Counsel) shall have the responsibility for the management of patent applications and patents claiming YU-Owned Inventions and other YU Intellectual Property. YU has absolute and sole discretion to register, license and enforce its rights in and to any and all YU-Owned Inventions. All determinations and actions concerning the management of patent applications and patents claiming YU-Owned Invention(s) shall remain with YU.

E. Licenses

Licenses for commercial development of YU-Owned Inventions shall be sought by YU to ensure that useful inventions can be made available, under reasonable terms, in products or services beneficial to the public. In cases involving substantial developmental expenditures by a licensee, or for other special reasons, an exclusive license may be granted, subject to the terms of any applicable grant or contract. All such licensing agreements shall be negotiated by YU's Office of the General Counsel, and approved and executed by an appropriate officer of YU.

F. Distribution of Income

"Income" means all consideration (e.g., monetary, non-monetary and equity) actually received by YU in exchange for licensing of YU-Owned Inventions.

- i. If Income is received by YU in exchange for the licensing by YU of YU-Owned Invention to a third party, YU will pay and reward the Inventor within ninety (90) days of YU's actual receipt of such income in accordance with the provisions below:
 - a. YU will first deduct from such Income all direct assignable expenses incurred by YU in connection with the preparation, filing, prosecution and/or maintenance of any relevant patent applications and/or patents and/or the negotiation of the contract for the licensing of such YU-Owned Invention(s) (including, but not limited to, specialized attorney's fees). These expenses shall be determined in YU's sole but reasonable discretion. After deduction of direct assignable expenses, fifteen percent (15%) of the remaining Income will be allocated to the YU Committee on Patents (or similar office/department) to defray the operating costs of said committee (or similar office/department). The remaining Income ("Net Income") will be distributed in the following manner:
 1. One-third (1/3) of the Net Income will be allocated to the Inventor or their estate and/or heirs. All payments due to an Inventor under this Patent Policy will be transmitted via a separate payment outside of the payroll system. Fringe benefits will therefore not be applicable to such payments. These payments will be reported annually to the Inventor and to the Internal Revenue Service on Form 1099, or on such other forms as may be required periodically by the Internal Revenue Service. The Inventor (or their estate and/or heirs) shall be responsible for providing forwarding addresses to YU;
 2. One-third (1/3) of the Net Income will be allocated to a research account maintained by YU on behalf of any Inventor of such YU-Owned Invention with a primary appointment to YU for support of said Inventor's academic/research pursuits. Such allocated amount will be considered incremental funding for the Inventor. In the event that said Inventor leaves YU, the research account will revert to YU, and the status of such portion of the Net Income in the account and

any future portion of the Net Income will be determined by the Provost. The Inventor's research allocation as described above, and the indirect costs to be assessed thereon for each license, are as follows:

- (a) The first Thirty Thousand US Dollars (\$30,000) of Inventor's research allocation will be free of indirect costs.
- (b) The second Thirty Thousand US Dollars (\$30,000) of Inventor's research allocation will be subject to indirect costs at one-half the prevailing institutional rate.
- (c) Inventor's research allocation in excess of Sixty Thousand US Dollars (\$60,000) will be subject to indirect costs at the prevailing institutional rate.

- 3. The remaining one-third (1/3) of the Net Income will be allocated to the unrestricted funds of YU to be used by YU in the pursuit of its mission.
- ii. An exception to the method of Income distribution described above will be made in the case of Inventions resulting from sponsored research if the terms of the agreement between YU and the sponsor do not permit such a distribution. In that event, the terms of the agreement with the sponsor will govern. This exception will apply to sponsored research funded by governmental and/or non-governmental sources.
- iii. If there is more than one Inventor of YU-Owned Inventions, the Inventors shall meet and decide among themselves their respective shares of any Net Income to be distributed to the Inventors pursuant to Section F. i. above. The Inventors shall then inform the Provost and/or the YU Committee on Patents of their agreement in a written statement signed by all of the Inventors. In the case of a dispute among the Inventors regarding their respective shares, such dispute shall be resolved by the Provost. Mechanisms of dispute resolution may include, but are not limited to, mediation, arbitration or other services performed by the Provost and/or the YU Committee on Patents. Any recommendations or decisions made as a result of mediation, arbitration or services will be subject to review and approval by the Provost, and the Provost's decision shall be final. All expenses incurred by YU in connection with resolving the dispute will be deducted as an additional direct assignable expense prior to income distribution. No income shall be distributed to the Inventors until an agreement on the Inventors' respective shares is submitted to the Provost and/or the YU Committee on Patents or until any dispute between the Inventors regarding their respective shares is resolved.
- iv. Any equity that YU receives as consideration under a license agreement with respect to a YU-Owned Invention will be held and managed by YU. YU shall liquidate such equity by sale in the public market upon the first available liquidity event (unless otherwise determined by YU in its sole but reasonable discretion). Once such equity is liquidated, the proceeds will be distributed as cash according to the method described in Section F. i. above. It is generally not the intent of YU to hold equity for the purposes of maximizing

profits.

G. Publication/Disclosure

The right to publish or otherwise disclose the results of sponsored research where creation of Inventions may be involved shall be subject to the following conditions:

- i. YU shall not bar or prohibit publication or other disclosure of inventions on which patent applications have been filed.
- ii. As soon as it is possible to do so, an Inventor has the obligation to file an Invention Disclosure Form with YU. This form must be submitted prior to the submission of a paper for publication that will disclose the Invention(s), and prior to other disclosure of the Invention. In all events unless otherwise agreed by the Provost in consultation with the YU Committee on Patents, the Inventor shall disclose their Invention to YU a minimum of one hundred and eighty (180) days in advance of any printed or other disclosure so that an application for a patent may be prepared and filed prior to any such disclosure. In no event may the YU-Owned Invention be disclosed without the filing of a patent application, unless expressly approved in writing by the Provost in consultation with the YU Committee on Patents.
- iii. YU will, if requested or required by agreement, supply a sponsor with a copy of the proposed publication prior to publication.

H. YU Committee on Patents

The Provost will appoint a YU Committee on Patents and such other committees as are deemed appropriate to implement this Patent Policy. Among the responsibilities of the Committee(s) will be the following:

- i. To recommend to the Provost which Inventions should be processed in accordance with the applicable sections of this Patent Policy, including, but not limited to, Section J below. Recommendations shall be made by the Committee(s) within ninety (90) days after relevant Invention is brought to the Committee(s)' notice.
- ii. To determine, when necessary, whether an Invention is a YU-Owned Invention
- iii. To make general recommendations regarding proposals to patent YU-Owned Inventions as it relates to YU's mission.
- iv. To act in an advisory capacity to the Provost with regard to Inventions and/or patents assigned to YU or in which YU has a claim or interest.

- v. To assist the Provost in resolving disputes arising from patent and licensing matters, including, but not limited to, any disputes arising under Section F. above, in accordance with this Patent Policy.

I. Agreement with Yeshiva University

A form of agreement with YU shall be entered into by all YU faculty (including all visiting faculty), staff and students acknowledging that they have received and read a copy of this Patent Policy and agree to abide thereby. Such persons will agree further to disclose in writing promptly to YU any YU-Owned Inventions made by them and to assign to YU the entire right, title and interest in and thereto as required and defined in this Patent Policy.

Notwithstanding the foregoing, this Patent Policy shall nonetheless be binding on all such persons even if they do not execute such formal acknowledgement.

J. Where Yeshiva University Declines to Patent

- i. Upon disclosure of an Invention to YU, it will be the responsibility of the Provost, with the advice of the YU Committee on Patents, to determine if YU will decline to pursue a patent on such Invention. The Provost shall notify the Inventor in writing of this decision within one hundred and twenty (120) days of disclosure. If the Provost declines pursuit of a patent on a YU-Owned Invention, the option to pursue a patent with respect to a YU-Owned Invention reverts to the Inventor.
- ii. If at any time during the patent application process YU decides to discontinue pursuit of the patent claiming YU-Owned Invention, the Provost shall notify the Inventor in writing within thirty (30) days of this decision. The option to pursue a patent with respect to such YU-Owned Invention shall then revert to the Inventor and in such event all information held by YU that is pertinent to said patent application will be made available to the Inventor (subject to any applicable restrictions).
- iii. If YU decides to decline or discontinue pursuit of a patent on any YU-Owned Invention, YU shall nonetheless retain ownership of such YU-Owned Invention and any patent or application thereon. If the Inventor decides to pursue patent protection for such YU-Owned Invention at their own expense, the Inventor shall:

- a. Promptly notify YU in writing of their intent to pursue patent protection and file for patent protection within six (6) months;
- b. Assign ownership of the YU-Owned Invention to YU;
- c. Obligate patent counsel to copy YU on all communications with the United States Patent and Trademark Office or any foreign equivalents relating to such YU-Owned Invention; and
- d. Refer all third-party interest in said YU-Owned Invention directly to YU for licensing.

iv. If Income is derived by YU from a patent declined by YU, it will be distributed as follows:

After reimbursement to the Inventor and then YU of direct assignable expenses incurred, fifteen percent (15%) of the remaining Income will be allocated to the YU Committee on Patents (or similar office/department) to defray the operating costs of said committee (or similar office/department). The remaining Net Income will be distributed in the following manner:

- a. The first Fifteen Thousand US Dollars (\$15,000) of the Net Income will be allocated exclusively to the Inventor or their estate and/or heirs;
- b. Two-thirds (2/3) of the remaining Net Income will be allocated to the Inventor or their estate and/or heirs;
- c. The remaining one-third (1/3) of Net Income will be allocated to the unrestricted funds of YU to be used by YU in the pursuit of its mission..

K. Management of Licenses

Management of all licensing agreements for YU-Owned Inventions and/or other Intellectual Property owned by YU remains with YU.

Yeshiva University Invention Disclosure Form

Completed form should be sent via email to: **insert address here**

1. Title of Invention:

2. Contributors:

Inventor(s) Name(s)*	University Office Address	Email Address and Telephone Number	Home Address

Please list for each contributor a brief description of the contributions made, as well as citations to written documentation corroborating the date and time those contributions were made in the space below or an attachment. Please attach any supporting documentation to this form.

3. Brief Description of Invention:

Please provide the following in an attachment:

- (1) A short paragraph of 200 words or less in lay language describing the need this invention meets, using non-confidential language;
- (2) Any potential applications for the technology (in bullet-point form);
- (3) A brief technical summary of the invention including its function and purpose;
- (4) A technical description of the invention (including relevant figures, manuscripts, and publications) that would allow someone skilled in your field to replicate the invention.

4. Funding:

Did the U.S. Government provide funding to any inventor for research leading to this invention?

Yes _____ No _____

Please list below all outside agencies that provided funding to any inventor for research that led to this invention (including funding from U.S. government agencies):

Sponsor Name	Contract or Grant No.	Project ID	Dates of funding

5. Record of Invention:

On what date did you conceive of the finished invention? _____

Was this conception documented? Yes _____ No _____ If yes, please attach a copy of the documentation.

On what date, if any, did you reduce the invention to practice? _____

Is a prototype of the invention available? Yes _____ No _____

6. Public Disclosure:

Please list below any occasion where you have presented, or planned to present your invention:

By oral presentation at a seminar, meeting, or conference;

By publication in a thesis, poster, article, abstract, or seminar; or

By planned demonstration.

Presentation Type and Location	Date	Comments

7. Prior Art:

Please attach, to the best of your knowledge, any earlier patents or other prior art related to your invention. The legal standard for a patent to be granted includes whether an invention is not obvious “to a person having ordinary skill in the art” given the total body of public knowledge in the field.

8. Signatures:

Please check one of the following and have each contributor sign below.

- ☐ I (We) agree that this invention is a YU-Owned Invention and hereby assign all rights, title and interests in and to this invention to Yeshiva University. I (We) further agree to execute all documents and take any further action as requested by Yeshiva University to assign my (our) rights to in and to any patent application or other statutory form of intellectual property protection filed in connection with this disclosure, and to cooperate with Yeshiva University in securing protection of the disclosed invention.
- ☐ I (We) do not believe this is a YU-Owned Invention that is covered by the Yeshiva University Patents, Licensing and Intellectual Property Policy and therefore should not be assigned to Yeshiva University. I (We) hereby request Yeshiva University to make a determination of the proper ownership of this invention based on the information I (we) provided in the attachment to this Disclosure Form.

Name (Printed)	Signature	Date