

## **INTELLECTUAL PROPERTY POLICY**

### **Introduction**

The Rockefeller University (“*University*”) recognizes that inventions may be made and copyrightable works may be created in the course of research supported by facilities, equipment, or funds of, or administered by, the University. The University desires that such inventions and works be brought into use for the public benefit at the earliest possible time. The University recognizes that this objective may be best accomplished through the patenting of such inventions and the licensing of such inventions and works consistent with the public interest. The University also desires to foster the creation and publication of scholarly works by authors at the University. This policy seeks to reconcile these interests on behalf of the public, the University and the inventors and authors.

### **Effect and Incorporation by Reference**

This Intellectual Property Policy, as it may be amended from time to time (this “*Policy*”), supersedes prior versions of the Policy, including the Patent Policy of January 1, 1994 and the Copyright Policy of January 18, 1984 (collectively, the “*Prior Policies*”) and shall be deemed to be incorporated by reference in existing agreements referencing these Prior Policies, except as noted below. In the event there are inconsistencies between this Policy and existing agreements referencing these Prior Policies or this Policy, the terms of this Policy shall control.

### **Policy**

1. Ownership of Inventions. All inventions, discoveries, and improvements, whether patentable or not, that are conceived, reduced to practice, or generated by employees of the University or by others, using the facilities, equipment, or funds of, or administered by, the University (each, an “*Invention*”) are hereby assigned by the Inventors to, and are the sole property of, the University. Inventions, discoveries, and improvements include, without limitation, data, tangible materials, and know how. The term “*Inventor*” under this Policy means an individual who is or could reasonably be determined to be an inventor under applicable Federal patent law of an Invention that is claimed or described in a patent or patent application and/or an individual who has substantially contributed to the conception, design, or development of an Invention that is not claimed in a patent or patent application.

2. Ownership of Works. The University acknowledges that copyrightable works that are submitted and accepted for scholarly publication, such as a journal article or a textbook (each, a “*Scholarly Work*”), will be owned by the Author. The University further acknowledges that copyrightable works that are created outside of the scope of employment or engagement by the University and without using the facilities, equipment, or funds of, or administered by, the University, such as a novel or a painting (each, an “*Individual Work*”), will be owned by the Author. All copyrightable works that (a) are neither Scholarly Works nor Individual Works and (b) are created by employees of the University or others using the facilities, equipment, or funds of, or administered by, the University (each, a “*Commercial Work*”) are hereby assigned by the Authors to, and are the sole property of, the University. Where applicable, Commercial Works are treated as works for hire under Federal copyright law. Examples of Commercial Works include: the text of an invention disclosure written by an Author to be used in a patent application, courseware, databases, and the source code and documentation for a new computer software program created by an Author. The term “*Author*” under this Policy means an individual determined to be an author of a Scholarly Work, Individual Work, or Commercial Work under applicable Federal copyright law.

3. Exceptions. The University reserves a royalty-free, non-exclusive right for itself and other non-

profit institutions to use all Inventions and Commercial Works for academic and research purposes. With respect to Inventions or Commercial Works, the University may choose to modify the disposition of its ownership under this Policy. With respect to joint invention or authorship with entities or individuals not covered by this Policy, the University will seek to resolve any ownership questions by contract in a timely manner. With respect to Scholarly Works, the Author, when entering into an agreement with a third party regarding publication of such Scholarly Work, is encouraged to preserve for the University and the Author the right to use such Scholarly Work to fulfill the mission of the University, including for educational and research purposes.

4. Disclosure Process. At the commencement of his or her employment or engagement, each employee or other person who uses the facilities, equipment, or funds of, or administered by, the University is required to sign an Agreement Concerning Intellectual Property (Appendix A, as it may be amended from time to time) and to be bound by this Policy. The absence of a signed Agreement will not relieve any individual who is subject to this Policy from the obligations imposed by it. An Inventor or Author must promptly disclose to the University's Office of Technology Transfer ("OTT") each Invention or Commercial Work conceived or made using funds from an entity that requires disclosure of any such Invention or Commercial Work. Additionally, an Inventor or Author must disclose an Invention or Commercial Work for which he or she wishes to seek commercialization. An Inventor or Author will cooperate with OTT at all times in the implementation of this Policy (including executing assignments and other documents as requested by OTT) in connection with each Invention or Commercial Work, which includes applying for, obtaining, maintaining, and enforcing patents or copyrights anywhere in the world; licensing or other transactions; and cooperating in any litigation, other proceedings, or any dispute resolution process, such as mediation, arbitration, etc. Such cooperation is a condition to receiving a share of the Net Proceeds.

5. Role of OTT. OTT will be the primary office at the University responsible for managing this Policy. OTT will, for example:

- a. determine whether or not to seek patent or copyright protection for an Invention or Commercial Work and implement the selected strategy;
- b. determine whether or not releasing an Invention to the Inventor or Commercial Work to the Author is in the best interests of the University;
- c. market Inventions and Commercial Works to potential licensees;
- d. structure, close, and administer option, license, industry sponsored research transactions, or other transaction concerning an Inventor's or Author's Invention or Commercial Work;
- e. direct the distribution of cash proceeds from option and license transactions consistent with the terms of Paragraph 6 of this Policy; and
- f. develop and administer procedures that are consistent with this Policy.

6. Allocation of Cash Proceeds.

- a. The Author will retain any cash proceeds from Scholarly Works and/or Individual Works.
- b. The use of proceeds from sponsored research transactions for Inventions and Commercial Works will be governed by applicable contracts, this Policy, and any other applicable University policy.
- c. Cash proceeds (including proceeds from the liquidation of Equity as described in Paragraph 8 below) arising from an Invention or Commercial Work will be divided as follows: (i) first, the University will recover all patenting, licensing, transactional, other fees and costs under Paragraph 6(e), and other fees and costs (including without limitation fees and costs of litigation, arbitration, mediation, or other proceedings; third party revenue sharing obligations, as applicable, etc.) relating to the Invention or Commercial Work; and (ii) second, the remaining cash proceeds ("*Net Proceeds*") will be divided (a) thirty-three and one-third percent (33-1/3%) to the Inventors of the Invention or the Authors of the Commercial Work, as a group under a share allocation agreement under Paragraph 6(d) or a share allocation determination under Paragraph 6(e), ("*Inventor or Author Share*") and (b) sixty-six and two-thirds percent (66- 2/3%) to the University. For the avoidance of doubt, any stock or other securities received by the University as the result of the University's investment in a company (and not in exchange for option or

license rights) are not subject to this Policy.

d. If there is more than one Inventor of an Invention or Author of a Commercial Work, then the Inventor or Author Shares will be divided as unanimously agreed among such Inventors or Authors according to a written share allocation agreement, a copy of which will be provided to OTT as soon as possible. Inventors or Authors may agree in a written share allocation agreement to designate a portion of the Inventor or Author Share to other individuals who have made significant intellectual contributions that do not rise to the level of inventorship or authorship; and such individual is included by reference as an Inventor or Author for the purpose of addressing distribution of the Inventor or Author Share only.

e. The University has no obligation to resolve disagreements as to share allocation among Inventors or Authors and shall hold such funds, without interest, until a share allocation agreement or share allocation determination is made. In the event of an impasse the Inventors or Authors may, at their sole expense, engage in an external dispute resolution process, such as mediation or binding arbitration. An arbitrator's written decision will include a share allocation determination that indicates the individual shares for each Inventor or Author and the allocation of dispute resolution fees and costs to be borne by each of them, and such decision shall be final and binding on all Inventors and Authors, and not subject to any right of appeal. All fees and costs of any external dispute resolution will be borne by the Inventors or Authors. To the extent the University incurs any fees and costs (other than internal costs) in connection with a share allocation determination, such fees and costs will be recovered by the University under Paragraph 6(c)(i).

7. Distribution of Inventor or Author Share. The Inventor or Author Share of licensing transactions for Inventions and Commercial Works will be distributed by the University in its ordinary course of business to Inventors or Authors according to the applicable share allocation agreement or share allocation determination. No interest will be paid on such Inventor or Author Share. The University will use reasonable efforts to distribute any Inventor or Author Share (or portion thereof) due to an Inventor or Author who is no longer associated with the University, subject to the University having current contact information from such Inventor or Author or his or her estate, which are solely responsible for updating such information. In the event of the death of an Inventor or Author, any such Inventor or Author Share due to the Inventor or Author will be distributed to his or her estate in accordance with this Policy and applicable law. Payment of such Inventor or Author Share to an Inventor or Author will be reported by the University as payment of "other income" or "royalties" and not as "salary". The Inventor or Author will be solely responsible for any tax consequences resulting from such distribution and are encouraged to consult his or her tax advisor to determine his or her tax consequences.

8. Option or License Transactions Resulting in Equity Issuance to University. If the University receives any equity or other class of securities of an optionee or licensee ("*Equity*") as consideration in an option or license transaction for Inventions or Commercial Works, then the Equity will be held by the University and managed by the Investments Office or its designee, applying relevant policies or practices. The University will, in its sole discretion, determine the timing of liquidation of such Equity. No Inventor or Author will have any right to vote or direct the disposition of such Equity. The University does not act as a fiduciary for any Inventor or Author concerning such Equity including its liquidation and has no obligation or duty to an Inventor or Author regarding the value realized from the liquidation of such Equity, or regarding any personal tax consequences for an Inventor or Author who receives a distribution of his or her portion of the Inventor or Author Share of Net Proceeds from the disposition of such Equity. After the Equity is liquidated, the proceeds will be treated as cash proceeds and distributed under the terms of this Policy.

9. Inventor or Author Compensation. All Inventors and Authors are required to submit to OTT existing and proposed agreements, including proposed amendments to existing agreements, with (a) any entity that is or becomes involved with the University in an option transaction, license transaction, or other transaction concerning the Inventor's or Author's Invention or Commercial Work, and (b) any other entity or person through which the Inventor or Author may directly or indirectly derive a benefit arising out of such transaction. Should any Inventor or Author receive or have a right to receive Equity and/or other compensation directly or indirectly (other than an Inventor or Author Share (or portion thereof)) from such an entity, the University reserves the right to modify such individual's Inventor or Author Share (or portion

thereof). In such case, OTT will disclose such individual's agreement or arrangement with the entity and any other information that OTT deems, in its discretion, to be relevant for consideration by the Technology Transfer Committee of the University's Board of Trustees. This Committee will then recommend to the University President, any proposed adjustment of the University's and the individual's Inventor or Author Share of Net Proceeds based on the particular circumstances of the situation. The President, in his or her sole discretion, will make a decision, which will be final and supersede any inconsistent provisions set forth in this Policy.

**Effective Date**

This Policy became effective on June 4, 2003 upon approval by the Board of Trustees of the University, was amended on October 7, 2005, March 15, 2010, November 17, 2010, February 21, 2018, and March 12, 2025.

## **APPENDIX A**

### **AGREEMENT CONCERNING INTELLECTUAL PROPERTY**

In consideration of my employment or engagement by The Rockefeller University (the “*University*”) and/or my use of the facilities, equipment, or funds of, or administered by, the University, I make this agreement with the University:

1. I hereby agree:

- (a) to be bound by the University’s Intellectual Property Policy, as it may be amended from time to time (the “*Policy*”);
- (b) to make prompt and full written disclosures in accordance with the Policy, including disclosure of each Invention and/or Commercial Work (as those terms are defined in the Policy) and of every existing and proposed agreement that I have with an entity that is or becomes involved with the University in an option or license transaction concerning such Invention or Commercial Work;
- (c) to assign and do hereby assign to the University all of my right, title, and interest in, to, and under the Inventions and/or Commercial Works of which I am an Inventor or Author; and
- (d) that all right, title, and interest in, and to, the Inventions and/or Commercial Works discovered or created by me are the property of the University under the terms of the Policy.

2. At the request of the University at any time and in accordance with the Policy, I will execute, without charge, all documents relating to the Inventions and/or Commercial Works, including those reflecting the assignment herein and assist the University in applying for, obtaining, maintaining, and enforcing associated patent and copyright applications, patents, and copyrights anywhere in the world.

3. At the request of the University, I agree to assist the University, without charge (except for reasonable compensation for extraordinary work if I am no longer employed or engaged by the University) in the following:

- (a) Preparation, filing, prosecution of applications, and maintaining patents or copyrights anywhere relating to any Invention or Commercial Work;
- (b) Licensing or other transactions relating to any Invention or Commercial Work; and
- (c) Any litigation, other proceedings (in courts, patent offices, copyright offices, or elsewhere), or any dispute resolution process, including mediation, arbitration, or negotiation, relating to any Invention or Commercial Work.

4. This Agreement will inure to the benefit of the University and its nominees and their respective legal representatives, successors, and assigns. This Agreement will be binding now and in the future on me and my heirs, legal representatives, executors, administrators, and assigns. Except with the prior, written consent of an authorized official of the University, no attempt by me to assign or transfer any rights in Inventions or Commercial Works will relieve me of any of my obligations under this Agreement or the Policy.

5. This Agreement, together with the Policy, supersedes any prior agreements or understandings I may have signed or to which I may be bound with respect to the subject matter of this Agreement. I represent and warrant that I have not entered into any agreement, understanding, or obligation with any person, organization, or entity that is in conflict with my obligations under this Agreement or the Policy.

Signature: \_\_\_\_\_

Dated: \_\_\_\_\_, 20\_\_

Printed Name: \_\_\_\_\_