



## Ohio Administrative Code Rule 3349-20-50 Intellectual property.

Effective: September 23, 2024

---

### (A) Purpose

Under Ohio law, all discoveries or inventions resulting from research or investigations conducted in any Ohio public college or university are the sole property of the university. The purpose of this rule is to establish a framework for university intellectual property protection and development that will transfer the benefits of its innovations to society, and at the same time, obtain appropriate financial gains for the university and its inventors as appropriate.

### (B) Scope

(1) This rule applies to all discoveries, innovations, or inventions, made by any university employee if such discovery, invention, or innovation was:

(a) The result of research by, or under the direction of, any university employee, the cost of which was paid for, in whole or in part, with funds from, under the control of, or administered by, the university. This includes all grant funds under the control of a university employee regardless of the source; or

(b) The discovery, innovation, or invention resulted from efforts that utilized more than a de minimus amount of university facilities or resources.

(2) Inventions not involving any university funds, equipment, facilities, or personnel (or a de minimus amount) are the property of the inventor, so long as the discovery, innovation, or invention is not in a substantive area of research in which the inventor is customarily engaged on behalf of the university.

(3) In general, students at the university are entitled to own any invention made in their student capacity; and will not be required to assign their ownership to the university. Students who receive



compensation from the university for work performed for the university, however, are considered employees under this rule and must assign their ownership interest to the university. Students are not obligated to participate in projects or activities that require the students to license or assign their intellectual property to the university.

(4) Absent other facts or as otherwise agreed to in writing, if a student takes any course for credit and develops an invention as part of a class project using no greater university resources than those generally available to all other students within the class, the intellectual property associated with that invention belongs to the student.

(5) The university will only protect intellectual property that has been assigned to it. Prior to investing in any property protection, the university will investigate the intellectual property landscape to identify any prior art or encumbrances related to the technology, evaluates technical merit, competition, market need, stage of development, and potential licensees. Students requesting that the university protect their intellectual property must execute an assignment agreement that will set forth the rights and responsibilities of the student and the university.

#### (C) Definitions

(1) "Confidential information" refers to all proprietary or confidential information of the university, the affiliated entities of the university, research sponsors, foundations, governmental agencies, or others, whether provided or made available verbally, in writing, electronically, by observation or through any other means, as well as all information generated during the review of such information or concerning the existence, scope or terms of any past, present or potential future research project, study, collaboration, grant, contract or other agreement. Confidential information includes, by way of example, but without limitation, the following: all business, financial, or scientific information; contractual arrangements and methods of operating; lab notes, graphic materials, work papers; patent applications and trade secrets; research protocols or other information; biological materials; reagents; software or documentation; prototypes; mask works; information pertaining to any directors, officers, medical staff members, employees, consultants, representatives, or agents of university affiliates or relating to actual or potential sponsor, patient, supplier, customer, or licensee identities, accounting and patient records; and any other information or materials not specifically mentioned in this rule that is designated as confidential, that affiliated entities have an obligation to keep



confidential; that the university designates as confidential or designate as requiring permission to release; or that would constitute a trade secret under applicable law.

(2) "Composition of matter" generally, refers to chemical compositions and can include mixtures of ingredients as well as new chemical compounds per se.

(3) "Copyright" refers to the protection that is accorded to original works of authorship fixed in tangible media of expression. Copyright protects the owner of the work if others copy, present, or display the work without the permission of the owner.

(a) "Works of authorship" include but are not limited to scholarly articles, literary, musical, dramatic, audiovisual, architectural, pictorial, graphic, and sculptural works, and video and sound recordings.

(b) "Tangible media of expression" include physical, digital, and other formats now known or later developed from which copyrightable works may be stored, reproduced, perceived, or otherwise communicated, either directly or with the aid of a machine or device.

(c) Copyright may be used to protect software source codes from being copied or infringed.

(4) "Direct and significant amount of university resources" refers to a requested and approved allocation of resources not routinely available to members of an employee's unit. University resources include, but are not limited to, staff time, equipment, college, departmental and grant funds, computer usage, and release time from assigned duties. Clarification of whether an allocation is "direct and significant" should be sought by the employee at the time of the request for allocation.

(5) "Disclosure" refers to printed publication, or in public use, or sale, or otherwise made available to the public. An invention disclosure to the university is a confidential reporting of an invention or discovery in sufficient detail to communicate an understanding of the invention or discovery to the university personnel responsible for evaluating and protecting the discovery, innovation or invention.

(6) "Discovery" refers to the process of finding out about some substance, mechanical device, improvement, or application not previously known. It is something less than invention and may be the result of industry, application, or be merely fortuitous.



(7) "Employee," for the purposes of this rule, refers to faculty, staff, and volunteers of the university regardless of any compensation paid or the amount of hours worked. This includes any visiting scholars/researchers who are working or studying within the university and students who are paid for rendering services.

(8) "Intellectual property (IP)" refers to any and all rights resulting from endeavors of the mind including those that protect the application and/or expression of ideas, inventions, creations, works, developments, improvements products, processes, procedures, techniques, devices, software, designs, materials and compositions of matter, as well as the embodiments of all such rights, whether in tangible or intangible form, including but not limited to, those items specifically referred to in the definition of confidential information. Intellectual property rights may be protected under federal law under patents, trademarks, service marks, copyrights, and trade secrets.

(9) "Innovation" refers to a new model, idea, or product. A useful application of new inventions or discoveries.

(10) "Invention" refers to, but is not limited to, products, methods, or uses, even if not patentable.

(11) "Inventor" refers to one who, alone or with others, first invents a new and useful process, machine, composition of matter, or other patentable subject matter. An Inventor conceived of, not just contributed to the reduction-to-practice, of at least one claim to a patent.

(12) "Manufactured" refers to all manufactured articles.

(13) "Net income" refers to gross income from royalties or other payments, such as option payments received by university, minus any fees or costs directly attributable to the invention being licensed. Examples of such direct fees are patent filing fees, fees for patent searches, legal advice, consulting fees, fees arising out of litigation, necessary travel, marketing costs, and maintenance fees. Indirect university overhead and other costs normally associated with the operation of the university shall not be deducted from gross royalties or otherwise allocated to costs or fees associated with the invention.

(14) "Patent" refers to the grant of a property right to the inventor issued by the united states patent



and trademark office. Generally, the term of a new patent is twenty years (fifteen years for design patents) from the date on which the application for the patent was filed in the United States, subject to the payment of maintenance fees. U.S. patent grants are effective only within the United States, U.S. territories, and U.S. possessions. The right conferred by the patent is the right to exclude others from making, using, or selling the invention (as defined in the patent claims).

(15) "Publication" refers to a published article or abstract in a technical journal, bulletin, newspaper, textbook, or any other tangible medium which gives sufficient information about the discovery or invention to permit one skilled in the art to practice the invention.

(16) "Software" refers to computer instructions, data, and accompanying documentation. To be patent-eligible, software must perform features that are novel and proprietary. Computing code itself isn't patentable; the patent application must be directed to the process of execution of the software code on a computer. This is commonly referred to as a "software-implemented invention."

(17) "Trade secret" refers to information, including a formula, pattern, compilation, program, device, method, technique, or process that derives independent economic value, actual or potential, from not being generally known to the public or to other persons who can obtain economic value from its disclosure or use, and is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.

(18) "Unobvious" refers to a characteristic that is not obvious to a person having ordinary skill in the art to which said subject matter pertains.

(19) "Work made for hire" refers to a specific type of relationship in which ownership of the work belongs to a third party, not the creator of the work. Under this rule, there are two situations in which a work made for hire is produced; when the work is created by an employee as part of the employee's duties and when work is undertaken or created because of an express written agreement, such as a grant or sponsored research agreement, to the university. When a work is produced under these conditions, the university or the party sponsoring the work is considered the owner. A faculty member's general obligation to produce scholarly works does not constitute a specific responsibility as set forth in this definition.



(D) Body of the rule

(1) General considerations

(a) The university education and research missions are preeminent over that of the transfer and commercialization of research results.

(b) The university is committed to active engagement and support of innovation, technology development, and entrepreneurial activities through the efficient and effective deployment of its resources for the betterment of society and the generation of unrestricted revenue to support its mission.

(c) University resources may be used for non-university purposes so long as they are appropriately serving the public interest. Any such use must conform to university rule and be set forth in appropriate agreements between the parties.

(d) The university will respect the intellectual property of its partners and collaborators.

(e) When the university owns intellectual property under this rule, the inventor or creator may play an active role in the entire licensing process unless such participation is inconsistent with conflict-of-interest regulations or university rules.

(2) Patents

(a) Under this rule and in accordance with section 3345.14 of the Revised Code, all rights to and interests in patents that result from research or investigation conducted in any experiment station, bureau, laboratory, research facility, or other facility of the university, or by employees acting within the scope of their employment or with funding, equipment, or infrastructure provided by or through the university, shall be the sole property of the university.

(b) No person, firm, association, corporation, or governmental agency which uses the facilities of the university in connection with such research or investigation and no employee of the university participating in or making such discoveries or inventions shall have any rights to or interests in such



discoveries or inventions, including income therefrom, except as may, by determination of the university's board of trustees, be assigned, licensed, transferred, or paid to such persons or entities in accordance with the terms of this rule.

(c) The board has delegated to the president of the university, unless the president is an inventor of the invention, the authority on behalf of the board of trustees, to retain, assign, license, transfer, sell, or otherwise dispose of, in whole or in part and upon such terms as the board of trustees has set forth in this rule, or may otherwise direct from time to time. Such dispositions may be to any individual, firm, association, corporation, or governmental agency, or to any employee, as the president or in the case where the president is an inventor, the board of trustees may direct. All income or proceeds derived or retained from such dispositions shall be applied to the general or special use of the university as determined by the board of trustees.

(d) The university has established these rules within the scope of academic freedom, consistent with its goal to provide incentives and institutional support to those employees whose research and scholarly activities lead to discoveries, innovations, or inventions, or that might be patented for societal use and to provide for equitable distribution of income resulting from discoveries, innovations, and inventions between the university and the inventor.

### (3) Publications

It is well understood that publication of research results is an essential part of the activity of a university researcher. While this rule recognizes this need, the timing of the publication of research results can be of critical importance when considering patent activity. Failure to take timely steps to patent can result in a possible reduction in, or the entire loss of, adequate patent protection in the United States or abroad.

The safest course is to file a United States patent application before any public use, publication, disclosure or sale of the invention occurs. There is a period of one year from the date of publication to file an application for a United States patent; however, in most foreign countries, the publication itself bars valid patent protection with no grace period.

(4) Government grants under the Bayh-Dole Act or Patent and Trademark Law Amendments Act,



Pub. L. 96-517, (1980).

The university generally can obtain title to inventions and patents arising under United States government contracts/grants, subject to certain rights reserved by the government, if invention reporting requirements and formalities are followed.

(5) Technology commercialization activity

Inventions disclosed to the university will be evaluated to determine scientific and technical merit, the likelihood of patentability or other protection, the potential for societal benefit, market potential, barriers to market, and other criteria concerning commercialization potential.

(6) Rights and obligations of the parties

(a) In accordance with section 3345.14 of the Revised Code, unless otherwise modified by contract, all rights, title and interest in discoveries or inventions made by employees, as defined herein, shall be the sole property of the university. Rights to inventions arising during government sponsored research must be assigned to the to protect the government's interest against competing claims. Inventions arising from privately sponsored research must be assigned to the university unless otherwise agreed to in writing at the time the research commences. The university is required to report federally sponsored research discoveries to the federal government.

(b) Inventor rights and obligations

(i) Confidential disclosure of the invention to the general counsel must precede an inventor's public disclosure, publication of information concerning a discovery, innovation, or invention. Once a discovery, innovation, or invention is reduced to practice, an invention disclosure form shall be promptly submitted by the inventor to the general counsel. The invention disclosure form is available through the office of general counsel and on the university website.

(ii) The university requires that researchers maintain adequate laboratory notebooks documenting critical information about the discovery or invention. Notebooks and other materials pertaining to research activities leading to a patent application are the property of university and will remain at





university even after termination of employment.

(iii) The inventor shall assign title to the invention, discovery, or innovation to university.

(iv) The inventor shall cooperate in the following:

(A) Executing applications and legal documents;

(B) Any litigation arising out of the patent application; and

(C) Reasonable marketing efforts related to the discovery or invention.

(v) The inventor has a right to receive a share of any royalties or licensing fees received for the discovery, invention, or innovation according to the schedule contained in paragraph (D)(10) of this rule.

(vi) If the general counsel and the vice president for research recommend that university surrender all rights in the discovery or invention, and the president agrees that this recommendation is in the best interests of the university, the president will have the authority to surrender the rights of the university with respect to the discovery, invention, or innovation unless the president is an inventor, in which case, the board must approve the surrender. After surrender, the inventor shall have the option to pursue a patent application in the inventor's own name at the inventor's expense, in which case, any royalties or licensing fees received would be the sole property of the inventor; however, the inventor will reimburse the university for its out of pocket expenses, if any, and grant to university a royalty-free, irrevocable, perpetual, non-exclusive license to make and use the invention for its own research and educational purposes.

(vii) The inventor has a right to timely publication of his or her findings as required by the principles of academic freedom, subject to the university's right to protect its interest in the intellectual property.

(7) The university's rights and obligations



- (a) The university has the sole right to license, sell, assign, or otherwise dispose of the rights to discoveries, innovations, or inventions that are owned by or have been assigned to university.
  
- (b) The university shall timely determine whether it chooses to retain or assign title, submit to an external source for evaluation of patentability, file a patent application, or surrender title to the inventor.
  
- (c) Should the university choose to file a patent application, it shall file, in a timely manner, any documentation necessary to prosecute a patent and shall pay all filing fees, maintenance fees, attorney fees, and other costs related to prosecuting and maintaining the patent. These costs will be recovered by the university before any payments are made in accordance with this rule.

(8) Administration

The general counsel and the vice president for research shall have overall responsibility for administration of the university's patent program, including assuring valuable property rights are not lost. Specific responsibilities shall be to:

- (a) Function as points of contact and resources with regard to this rule and procedure;
  
- (b) Receive reports of all discoveries or inventions that are subject to this rule;
  
- (c) Conduct or cause to be conducted due diligence studies to determine patentability, market potential, barriers to market, and other criteria deemed necessary to determine commercial potential;
  
- (d) Act upon the due diligence conducted to promote the interests of the university and to the extent appropriate to the university inventors.

(9) The general counsel and the vice president for research may utilize university funds to engage appropriate consultants and legal and business professionals to evaluate all discoveries and inventions disclosed to university for potential patentability and commercialization. These reports will be sent directly to the general counsel and will be protected from disclosure under attorney-client work product.



(10) Income, including royalties and other payments

(a) For all inventions for which the university receives royalties or other payments, the net income will normally be distributed as follows:

(i) Fifty per cent to the inventor(s);

(ii) Ten per cent to the inventor's department(s);

(iii) Twenty per cent to the university research office; and

(iv) Twenty per cent to the technology transfer office.

(b) All monies received by the departments, the university research office, or university technology transfer office are considered university funds and will be administered in accordance with established accounting policies and procedures.

(c) If multiple inventors are involved, the royalties as specified in this rule shall be distributed equally among the parties set forth in paragraph (D)(10)(a) of this rule unless a written proposal for an alternate distribution is jointly presented by the inventors and approved by the general counsel and the vice president for research.

(d) The inventor shall not receive the specified share of royalties when the inventor is no longer affiliated with the university unless otherwise agreed to, in writing, by the university and the inventor at the time the inventor leaves the university it is the responsibility of the inventor to notify the general counsel in writing of the inventor's address. In the event of the inventor's death, royalties due and payable under this rule will be paid to the inventor's estate for the remainder of the royalty period if the person responsible for the administration of the estate provides written authority and instructions from a court of competent jurisdiction concerning the payments. The inventor's department(s) shall continue to receive the royalties specified in this rule as long as the inventor is affiliated with said department. Should the inventor leave the department or the university, all departmental royalties shall become the sole property of university and will be shared equally by the



university research office and technology transfer office, unless otherwise agreed to in writing.

(11) Research agreements between collaborators and industry involving patent rights

It is not uncommon for university employees to receive awards to conduct research funded by private industry. It is also not uncommon for employees to conduct research in cooperation with colleagues at other institutions. The university recognizes that to continue these relationships, it must be willing to consider a variety of contractual terms and conditions. To protect traditional academic freedom, assist employees in evaluating proposals, and protect university's interest in discoveries, innovations, or inventions, the following policies shall apply to these external relationships:

(a) All written agreements with private industry or with other institutions utilizing university resources to conduct research must first be reviewed by the general counsel and the vice president for research. The general counsel and the vice president for research will only approve those agreements which assure that the rights of the university are appropriately protected.

(b) In dealing with inventions that are conceived or developed during research sponsored by a third party and/or pursuant to an agreement with another institution, the university will abide by the terms of the agreement with that third party. Where an option exists, the university will seek agreements and contracts, or waivers thereof, that will allow patent rights to remain with university.

(c) University will not waive the right to publish results of research. University will only agree to delay publication for reasonable periods of time so appropriate action can be taken to protect patentable discoveries or inventions. In agreeing to delay publication for a reasonable period, university will not agree to delays that effectively inhibit a student's timely completion of a course or degree or impair a faculty member's application for promotion or tenure.

(d) Title to all documents, records, biological materials, software, databases, notebooks, and other repositories of information from research shall be held by university unless otherwise provided for in a written agreement with the private research sponsor. Those materials must remain at university should the inventor's employment at university be terminated for any reason unless specifically authorized by the university.



(e) The university will agree that confidential information remains the property of private industry and will agree to protect the trade secrets of third-party research sponsors. Written agreements with the third party must clearly define what information is proprietary in nature. Trade secrets will be kept confidential and will not be subject to disclosure under the provisions of section 149.43 of the Revised Code. If a request for such information is received, the university will notify the owner of the confidential information of the request and mutually agree to the appropriate response.

(12) Visiting scholars and researchers

(a) For the purposes of this rule, visiting scholars and researchers will be treated as employees (as defined in this rule) and are required to adhere to the provisions of the visiting scholar/researcher agreement, which is available through the office of general counsel.

(b) The faculty member hosting the visiting scholar/researcher is responsible for, and expected to, ensure the following:

(i) The visiting scholar/researcher agreement has been properly executed with the office of general counsel;

(ii) That a copy of this rule has been provided to the visiting scholar/researcher; and

(iii) That all departments have been properly notified of visiting scholar/researcher's presence at the university.

(13) Copyright

(a) For the purposes of copyright, the university seeks the following:

(i) To maximize academic freedom and creative expression for the public good;

(ii) To preserve traditional academic practices and privileges with respect to the publication of scholarly works;



(iii) To apply uniform principles and procedures that provide allocation of income resulting from commercial publication;

(iv) To apply funds accruing to university from copyrighted materials to advance and encourage scholarly endeavor;

(v) To disavow any claims by university in an individual's copyrightable work simply because of the individual's membership in the university community; and

(vi) To protect university's assets and preserve its reputation of excellence.

(b) Copyright ownership

(i) The university encourages scholarly and creative activity by faculty, students, and staff. These activities include the production of works resulting from academic research or scholarly study. Authors of copyrightable works may register the copyrights and publish the works as their own except for works made for hire, those where a direct and significant amount of university resources have been used in the creation of the work, or any other work covered by an agreement to the contrary.

(ii) Personal copyrights

Works by a university employee that are not works for hire, do not use a direct and significant amount of university resources, and are not subject to a grant or sponsorship agreement to the contrary are the property of the employee.

In the case of a dispute concerning copyright ownership the general counsel will review information concerning the work with the employee's department chair or supervisor, and in consultation with the vice president for research, make a recommendation to the president. The president's decision will be final.

The university will retain title to all copyrighted software developed by, or substantially with, university resources unless prior written waiver of university rights is issued.



(iii) The following notice is to appear on all university-owned material:

Copyright © (year) Northeast Ohio medical university

Rootstown, Ohio. All rights reserved.

The date in the notice should be the year in which the work was first fixed in any tangible mode of expression.

(iv) The general rule of the university is to register only those of its works that have the potential for royalty return. University copyright ownership may be relinquished only upon the authorization of the vice president for research and the general counsel, who are authorized by the board to surrender such rights if they believe it is in the best interest of the university to do so. If such rights are relinquished, the university will retain a non-exclusive, royalty-free license to use these works.

(v) Sponsored works

The disposition of copyrights of works created with support from an outside sponsor shall be governed by an agreement.

(c) Rule administration

The general counsel with the vice president for research will:

(i) Determine, promote and protect the rights of the university in any copyrightable works created or to be created with university resources;

(ii) Develop and approve agreements for the use of university resources in the creation of copyrightable works;

(iii) Distribute royalties to the author or others as set forth in pertinent agreements.