This document provides answers to frequently asked questions as well as examples for students, faculty, and staff regarding managing and protecting intellectual property at the University of North Dakota. The examples below have caveats and are not meant as a replacement for appropriate legal counsel. Please contact Michael Moore at the Office of IP Commercialization and Economic Development (IPCED) for feedback, comments, questions, and additional information at 701-777-6709, or by e-mail, <michael.f.moore@research.und.edu>.

General Questions and Definitions:

Q1: What is the difference between inventorship and ownership?

A: Ownership means having the legal right to protect and license IP while inventorship recognizes the actual contribution to the conception and/or reduction to practice of an invention. At UND, inventorship carries rights regardless of ownership.

Example: Jack Smith and Diane Johnson, employees at UND, invent something at work. UND typically will own that invention and see that it is protected and licensed. Royalties will be shared with Jack and Diane. See more examples below.

Q2: How do I know whether my invention could have potential commercial value?

A: Contact the Office of IP Commercialization and Economic Development (IPCED). Please call 701-777-6709 or send an e-mail to <michael.f.moore@research.und.edu>.

Q3: As it relates to patents, what constitutes a “public disclosure”?

A: Any description in any form or format that publicly discloses the embodiments of your invention is a “public disclosure” that could compromise patentability.

Q4: Where can I go on campus to get help with questions on Intellectual Property?

A: IPCED is available to meet with you, answer any questions you may have, and help ensure that the rights in your invention are appropriately managed. Please call 701-777-6709 or send an e-mail to <michael.f.moore@research.und.edu>.

The following pages contain examples that pertain to students, faculty, graduate assistants, and staff.

Endorsed by the UND Univ. Senate’s Intellectual Property Committee on 10 Apr 2015
Page 1 of 4
Student Examples

E1: I invent the next Facebook® in my dorm on my own time. Who owns it?

A: More than likely, you. UND students own intellectual property they develop while at UND, unless one of following two scenarios apply:

- The IP arose under University-administered funding, federal funding, or under a contract that obligates UND or another party to own the IP; or
- The IP arose in the course and scope of your employment at UND.

(Please remember UND in your philanthropy plan. 🎉)

E2: This question is about our Senior Design (class) Project in Electrical Engineering. This project was started by other students several years ago. As a team, we think we have invented improvements this year. Who owns these?

A: You and your teammates would own these inventions. If students in previous years contributed to the latest inventions, it is possible that those students are co-owners as well. Similarly, if a faculty member also made an inventive contribution, then UND would be an additional owner. In any event, UND would be entitled to a non-commercial, royalty-free license to use the your inventions in order to permit future students to continue work on the project.

E3: I invent a new and improved device charger in my apartment. I talk to an Electrical Engineering Professor and a Marketing Professor for guidance. Who owns it?

A: This can be complicated. General scientific knowledge, advice, and tips typically will not constitute inventorship, but suggested improvements and fixes may. If either professor has made an inventive contribution, then UND and you are co-owners. However, if neither faculty member is an inventor, then you fully own the invention. Contact IPCED for help.

E4: I’m an undergraduate student in an Advanced Organic Chemistry class, which gives us access to a chemistry lab 24/7. I paid a lab fee for the course and the lab is free to use by all UND students. Since the lab is open at night, I come back to work on my next-best non-stick pan coating invention. Who owns it?

A: Most likely you will be the sole owner of the invention. You are, however, obligated to follow the instructions of faculty and staff concerning access to equipment and facilities, and proper safety regulations must be observed at all times. If you have questions or concerns about the availability or utilization of specific University resources, equipment, supplies, reagents, etc. for working on an invention that goes beyond the scope of your course assignments, please first contact IPCED and/or a responsible faculty member.

E5: I was hired by UND to test a professor’s invention. Am I considered an inventor?

A: As a general matter, if you merely followed the professor’s instructions, and did not yourself make material alterations or suggestions and did not solve a particular problem, you are probably not an inventor.
Faculty and Graduate Assistant Examples

E6: I started working on an invention at UND and then went to another institution where I continued to develop the IP. Who owns it?

A: It is likely that both UND and your new institution will jointly own the invention. If so, the two institutions will work together to reach an agreement to benefit all parties.

E7: I am a GTA (or faculty) who wants to use course materials that I develop while employed at UND at another university. Who owns those materials? Can I use those materials once I have left?

A: In most instances, you own the copyright in your work and you are free to use those materials once you leave UND. By policy, UND has "limited use rights" meaning that the material can continue to be used non-commercially (e.g., in future course offerings).

E8: I am a department head/chair and want to have an employee create materials for an online class, in exchange for a summer salary, that will be owned by the university. What do I do?

A: Copyright in works created by employees at the specific direction of UND is owned by UND. Such a direction should preferably be in writing and identify with specificity the nature and expectations for the desired work product. This can be incorporated into the employee’s contract.

E9: I invented something related to my work, but didn’t tell IPCED. Who owns it?

A: Timely disclosures of inventions are required by UND policy. UND likely owns the invention regardless of whether you, the inventor, disclose the creation. IPCED will perform a fact-specific investigation to determine ownership.

E10: I am a GRA. In conjunction with my professor, we develop a new screening method for detecting cancer. We believe this technique is marketable, however, we would also like to publish/present the research.

A: The safest path to protect your rights as the inventor and UND’s rights as the owner is to have the university submit a patent application before a public disclosure.

E11: A journal asked my professor and I to sign a copyright release form in order to publish our research article. We do not receive any royalties. Who owns the article?

A: You own the copyright in your scholarly works. Signing over copyright to the journal allows them to distribute the materials, however, typically the journal allows you to retain rights to continue using the work.

E12: I work on mechanical equipment in my garage on weekends. Who owns it?

A: If you are in the Dept. of English, you likely own it outright. If you are in Mechanical Engineering, institutional ownership of the IP may be more likely. If you are not bound by funding agreements that affect your IP rights and if the invention is made outside the scope of your employment and without the use of institutional resources, then the invention likely belongs to you. Contact IPCED to discuss ownership.
Staff Examples

E13: I work on inventions on my time off. Who owns my inventions?

A: You may, depending upon the nature of the invention and its relationship to your employment at UND.

E14: I am a Building technician who has come up with a new and improved piece of cleaning equipment that will make my job easier. Who owns it?

A: Since you are improving a tool that you already use in your day-to-day job, then UND is likely the owner.

E15: I am a mechanic at Facilities. I invented a snowplow controller during work hours that I think will allow better maneuvering of our plows around cars, but I didn’t tell UND. Some of the development occurred at home, on my own time. Who owns it?

A: This invention will likely be owned by UND, even though some of the development occurred after hours. Timely disclosures of inventions are required by UND policy, and are necessary to protect your rights as an inventor.

E16: I am a Dining Services employee at UND. I invent a snowplow controller in my garage at night and on weekends. Who owns it?

A: You do, since the invention was created and developed on your free time and is unrelated to your job.

E17: I am a Dining Services employee. I invent a new type of collapsible bleacher that could be used at the Ralph Engelstad Arena. I thought of this invention while working concessions at the Ralph (my side job) but I developed the invention at home. Who owns it?

A: UND does not, but you may. You need to check with the Ralph Engelstad Arena (your employer) as the invention was conceived while working for them.

E18: I invent a new ice cream machine with a fellow employee at Dining Services. We want to pitch and sell our idea to Tastee Freeze at an upcoming industry trade show. What should we do?

A: UND welcomes active participation of inventors in the marketing of their UND-owned inventions. You should first disclose the invention to IPCED and then work with IPCED to map out a commercialization strategy to move this IP into the commercial space.

This concludes the frequently asked questions and examples regarding management and protection of IP at UND. The examples above have caveats and are not meant as a replacement for appropriate legal counsel. Please contact Michael Moore at the Office of IP Commercialization and Economic Development (IPCED) for feedback, comments, questions, and additional information at 701-777-6709, or by e-mail, <michael.f.moore@research.und.edu>.

Endorsed by the UND Univ. Senate’s Intellectual Property Committee on 10 Apr 2015