

Background Material on FSH 5400

Excerpt from the Minutes of the May 8, 2002 General Faculty Meeting

It was **moved and seconded to return Item M (FSH 5400, Employment Agreement Concerning Patents and Copyrights) to the 2002-2003 Faculty Council for further consideration.** The discussion that followed pointed out faculty concerns about: (1) the agreement statement that had a distinctive *institutional* rather than *individual* perspective; (2) the difficulty in interpreting the terms in the agreement; (3) the need to create an agreement that would benefit all parties; (4) the need for a better understanding of an individual faculty member's rights; (5) the need to create research incentives; and (6) the need to protect everyone's rights, not just the rights of the university.

Professor Smelser pointed out that the *Intellectual Property Committee* had reviewed the new policy language and found it to be consistent with the way business is now being conducted at the U of Idaho. Most of the language is, in fact, the original language and the new material in the policy is for protection and disclosure purposes concerning sponsored research projects. The policy is consistent with contractual law.

It was noted that the SBOE/Regents had appointed a task force to re-write this policy 18 months ago, but the task force draft did not meet with the approval of the SBOE/Regents. This caused them to initiate an external review of intellectual property policy. That report was presented in March, but the SBOE/Regents has not yet made a final decision on the policy. There is the feeling that, at some levels, people believe that everything created by faculty members belongs to the state of Idaho.

Several faculty members pointed out that the proposed policy represents a clarification of current university policy and is an attempt to put the policy in line with contractual agreements that are currently being entered into by the university. The provost indicated that the SBOE/Regents has already affirmed the proposed policy language. On the other hand, others noted that since the board has not yet approved a formal policy, that sending the policy back to the Faculty Council would make sure that there was a "fresh start" in crafting a good policy to present to the SBOE/Regents. After a voice vote that was too close to call, a show of hands showed that the motion to return was **adopted** by majority vote.

Excerpt from the Minutes of the April 22, 2003 Faculty Council Meeting

FC-03-051, Temporary Wording for *Faculty-Staff Handbook* Section 5400, Employment Agreement Concerning Patents and Copyrights. Professor Jeff Harkins [who had convinced the faculty to send this item back to the council at the May 2002 General Faculty meeting] and Gene Merrell, Assistant Vice President and Chief Technology Transfer Officer for the Research Office, provided background information on the proposal.

The council was provided with the relevant section of the minutes from the May 2002 General Faculty meeting and the suggested temporary revision of the handbook section. It was pointed out by Harkins and Merrell that the temporary wording would allow agreements to be signed and rights protected until a final policy statement was completed. That final policy statement would also need to be in agreement with SBOE/Regents policy on this matter, which also has not yet been finalized.

It was further requested that an ad hoc committee be formed made up of representatives of the Faculty Council (McGuire and Pikowsky), Harkins, Merrell, and several faculty members well acquainted with patents and copyrights. That committee would return a final policy statement to the council in the fall for discussion and vote. Furthermore, the temporary wording would be clearly labeled as such, noting that it would be replaced within one year.

It was **moved and seconded** (Wagner, Lillard) that the council **approve the temporary wording for Section 5400 and its accompanying letter of agreement for immediate inclusion in the *Faculty-Staff Handbook*; that the temporary nature of the wording be made clear in the preamble to that section; and that the council chair be authorized to form an ad hoc committee to complete the final wording of FSH Section 5400 for submission to the council in the Fall of 2003.** The motion was **adopted** by unanimous voice vote.

FSH 5400
Patent and Copyright Agreement for University of Idaho Employees

PREAMBLE: UI uses the following form of employment agreement concerning patents and copyrights. This section was added to the Handbook in June of 1988 and revised in July of 1992 and given a temporary revision in April 2003.

SPECIAL NOTICE: The April 2003 revision is only temporary and allows the patent and copyright practices to continue under revised guidelines until the final language is drafted by an ad hoc committee that was formed in April 2003. If that revision has not been approved by the faculty by May 2004 this policy will revert back to its 1992 revision.

For further information, contact the Technology Transfer Office (208-885-4630 or the Office of the Faculty Secretary (208-885-6151).

As an employee of the University of Idaho (University), I acknowledge that I am subject to the policies and rules of the Regents of the University of Idaho (Regents) published at the Idaho State Board of Education's website <http://www.sde.state.id.us/osbe/policy.htm> and to the policies and procedures of the University as published in the University Faculty-Staff Handbook, the University Administrative Procedures Manual and on the University's web site.

Pursuant to those policies, I hereby agree to the following:

1. With regard to inventions:
 - a. I will disclose to the University all potentially patentable inventions conceived or first reduced to practice in whole or in part in the course of my University responsibilities. If in doubt about the patentability of an invention, I will confer with the University's research office.
 - b. I also will disclose all potentially patentable inventions conceived or first reduced to practice in whole or in part through the use of University resources when that use is more than incidental (FSH 5300). Again, if in doubt as to what is incidental use I will confer with the University's research office.
 - c. I further agree to collaborate with the University in the assignment, as required by the policies of the Regents and the University, of all my right, title and interest in such patentable inventions.
 - d. I also will provide completed documents and fully participate in actions that allow the University to promptly complete such assignment.
2. I acknowledge that Regents University policy states that all rights in copyright shall remain with me as the creator unless the work:
 - a. is a work-for-hire (and copyright therefore vests in the University under copyright law),
 - b. is supported by a direct allocation of funds through the University for the pursuit of a specific project,
 - c. is commissioned by the University, or
 - d. is otherwise subject to contractual obligations.

I will collaborate with the University of Idaho to promptly assign or confirm in writing all my right, title and interest, including associated copyright, in and to copyrightable materials falling under a) through d) above.

3. I agree to obtain from all students wishing to participate in my University research programs, and who are not employees of the University, a signed copy of the "Memorandum of Understanding Regarding Research Participation and the University Patent Rights and Copyright" available from the Technology Transfer Office. I will provide the Technology Transfer Office with a copy of the signed MOU.
4. I certify that I am under no consulting or other obligation to any third person, organization or corporation that is, or could be reasonably construed to be, in conflict with this agreement with respect to rights to inventions or copyrightable materials.
5. I will not enter into any agreement creating copyright or patent obligations in conflict with this agreement.

Signature

Title

Printed Name

Date

**Memorandum Of Understanding Regarding Research Participation And
University Patent Rights And Copyrights**

PREAMBLE: UI uses the following form of agreement concerning patents and copyrights with non-employee students and visitors participating in university research activities. This allows the non-employee student to participate in the university's patent/copyright income distribution program (FSH 5300) while protecting the interests of the faculty, staff, student, and university. This section was added to the Handbook in May 2003. For further information, contact the Research Office (208-885-6651).

This memorandum of understanding is entered into by _____, a student at University of Idaho ("participant"), _____, a professor/researcher at University of Idaho ("faculty"), and the Regents of the University of Idaho ("university").

The participant is involved in research activities or enrolled in _____, which may involve working on research or design projects. These activities or projects may or may not result in the development of patentable subject matter and/or copyrightable work products in which the university and/or a sponsor may have a proprietary interest.

Therefore, it is important that the participant, faculty, and the university have a full understanding of the participant's rights and obligations regarding these proprietary interests, copyright, and patent rights. This memorandum sets forth the understanding of the parties.

1. The participant acknowledges receipt of copies of the relevant patent/copyright policies of the Regents of the University of Idaho and the University of Idaho.
2. The participant agrees to promptly disclose any discoveries he/she makes that may be patentable/copyrightable to the Technology Transfer Office.
3. The participant has the right to submit any thesis, dissertation, or other academic product based upon or resulting from his/her work as part of the fulfillment of the requirements for obtaining an undergraduate, master's, or doctoral degree from the university or collaboration with the university.
4. In exchange for the opportunity to participate in these projects and the right to receive royalties, the participant agrees to assign his/her right, title, and interest in any research or other project outcome, including copyright or patent rights, derived from the participant's work in this class or research activities to the university. This assignment vests rights in the university as provided for in the university's copyright and patent policies attached hereto and is subject to the participant's right to share in royalties in the same manner as employees of the university.

Participant _____ Date _____

Supervising Faculty _____ Date _____