1. **Call to Order**
The meeting was called to order by Chair Susan Astley at 3:31 p.m.

2. **Review of SCIPC November 27, 2012 Meeting Minutes**
Approval of minutes from the SCIPC November 27\textsuperscript{th} meeting were deferred.

3. **Update on the status of the Nov 2012 proposed changes to the Request for Approval of Outside Professional Work for Compensation form**
Astley informed that SCIPC has a website\textsuperscript{1} and a Go-Post site\textsuperscript{2} live now, where documents will be posted.

In preparation for today’s SCIPC meeting, Chair Astley sent pertinent documents to SCIPC members for their review (see Attachments 1-3).

During the last meeting, SCIPC reviewed the Nov 2012 draft of the Outside Work form revised by C4C and IPMAC. The Nov 2012 draft offered two options for IP assignment language: 1) broad assignment, or 2) narrow assignment. SCIPC came to the conclusion that the IP language should be removed altogether from the form and forwarded that recommendation to Jack Johnson, Chief of Staff for the President, on Dec 10, 2013 (Attachment 1). Upon review of SCIPC’s recommendations, IPMAC chose to remove the IP language from the Outside Work form (Jan 2013 draft) (Attachment 2) and proposed the creation of a separate IP Agreement (Jan 2013 draft) (Attachment 3), adapting the Stanford approach. The proposal to create a separate IP Agreement form was initiated by C4C as outlined in an email from C4C to IPMAC on Jan 15, 2013 (Attachment 3). C4C also proposed revisions to EO36 and the Innovation Assignment form (Attachment 3). These revisions were shared with SCIPC just prior to today’s meeting for our review.

\textsuperscript{1} Found here: http://www.washington.edu/faculty/committees/fcipc/
\textsuperscript{2} Found here: https://catalyst.uw.edu/gopost/board/ senate/31766/
SCIPC members reviewed the Jan 2013 draft of the *Outside Work* form with the IP language removed. There was general consensus that the form was greatly improved over the Oct 2011 version that is currently in use. The Jan 2013 draft had been provided to department Chairs and Deans, who had given positive responses.

Discussion then turned to the new proposed IP Agreement form and revisions to EO 36 (Attachment 3). The primary thrust of these revisions was the incorporation of present assignment language “I hereby assign”. All faculty members would be required to sign the IP Agreement form, not just those submitting the *Outside Work* form. Faculty members would be required to sign the form now or at the time of hire. Their signature on the form would transfer their right, title, and interest in all future inventions to the University. This new present assignment language is in contrast to current IP policy which uses a promise to assign approach at the time of invention. Committee members expressed concern for the proposed IP Agreement and revisions to EO 36. The urgency for adjusting policy was debated, between the need to protect the University and faculty, and the need to “answer all questions” prior to executing new policy. Committee members questioned the proposed definitions for inventions, scholarly work, and works made for hire. Concerns were raised that a Stanford-type model of intellectual property assignment may not be relevant to the legal environment in the state of Washington, as a bill in the State Senate proposes halting state universities from requiring intellectual property ownership for faculty inventions.³

At the close of this meeting, committee members agreed that further discussion of all issues raised in Attachment 3 require further discussion. This conversation will be resumed at our next meeting scheduled in Feb 2013.

4. Adjourn
The meeting was adjourned by Chair Astley at 5:07 p.m.

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Minutes by Jay Freistadt, Faculty Council Support Analyst. jayf@u.washington.edu

Present: Faculty: Astley (Chair), O’Neill, Sparke, Storti, Olavarria
President’s Designee: Johnson
Ex-Officio Reps: Miller
Guests: Fred Holt, Bob Breidenthal

Absent: Faculty: Shen

Attachment 1: SCIPC/Senate Chair Dec 2012 response to the Nov 2012 revisions to the *Outside Work* form
Attachment 2: January 2013 draft of the *Outside Work* form from IPMAC (with IP language removed)
Attachment 3: Email from IPMAC-C4C (01/15/13) regarding proposed changes to invention reporting and assignment (Proposed IP Agreement form and revisions to EO 36).

December 10, 2012

Jack Johnson, Chief of Staff
Office of the President
University of Washington - 351230

Dear Mr. Johnson:

Please find attached the Faculty Senate’s response to your request to review and provide input on the November 12, 2012, draft of proposed changes to the Request for Approval of Outside Professional Work for Compensation. I’d be happy to discuss the committee’s recommendations with you.

Thank you.

Sincerely,

James Gregory
Professor, History
Chair, Faculty Senate

Attachment

cc: Susan Astley, Chair, SCIPC
    Marcia Killien, Secretary of the Faculty
December 1, 2012

Dear Jack Johnson:

Thank you for the opportunity to review the November 2012 draft of the revised “Request for Approval of Outside Professional Work for Compensation” form. The newly established SCIPC held its first meeting on November 27th. The focus of the meeting was the review of this form.

The group as a whole felt the revised form was an improvement over the current (Rev. Oct 2011) form. We felt the work group succeeded in creating a form that was clearer, more informative, more focused, and easier to complete.

Our discussion of the form centered primarily on Section D. Intellectual Property.

We felt the three bulleted paragraphs in Section D were clear.

Regarding the assignment of intellectual property, we considered three alternatives:
1. No assignment (consistent with the Compensation Form prior to the Oct 2011 revision)
2. Narrow assignment (as conceptually described in the Nov 2012 draft)
3. Broad assignment (as conceptually described in the Nov 2012 draft)

After considerable deliberation, SCIPC unanimously concluded that assignment language should not be included in the Request for Approval of Outside Professional Work for Compensation form. Assignment of an invention prior to its invention cannot take into consideration the unique and complex issues that may be inherent in an invention. For example, what if this outside work activity is to be conducted by a group of faculty from different departments/schools? Who is the inventor? Who has the authority to assign rights? How can these questions be answered if the invention has not yet been invented?

The committee felt a more appropriate approach for dealing with assignment of inventions at this very early stage in an outside work effort is the approach conveyed in the Notice paragraph on page 2 and copied below.

NOTICE: You should carefully review any agreements with the outside organization to be certain you make no promises that are inconsistent with this assignment or your other UW obligations. Your agreement with the outside organization should contain the provision “To the extent the consulting agreement is inconsistent with any of the UW employee's obligations to the UW, the employee's obligations to the UW shall prevail.”

If the statement “To the extent the consulting agreement is inconsistent with any of the UW employee's obligations to the UW, the employee's obligations to the UW shall prevail.” is not sufficient to legally protect/prevent a faculty member from entering into an agreement
inconsistent with the faculty member’s obligations to the UW, then we suggest this language be further refined to ensure such protection.

It is imperative faculty are in compliance with Administrative Policy Statement 59.4 (Technology Transfer) and EO57 (Outside Professional Work Policy) when engaged in outside professional work. We feel the best way to ensure this is to derive language that legally通知s the outside organization that the faculty member cannot engage in an agreement that is inconsistent with the UW employee’s obligations. This notice should be shared with the outside organization prior to the signing of any contracts or agreements with the faculty member. And any signed contract/agreement that fails to honor this prior notification would be considered legally not binding.

Once again, thank you for the opportunity to review this draft and provide comment. Please do not hesitate to contact us if you have any questions regarding our comments.

Sincerely,

Susan Astley Ph.D. Chair SCIPC
Professor of Epidemiology and Pediatrics

Enclosure

cc: Secretary of the Faculty
REQUEST FOR APPROVAL OF OUTSIDE PROFESSIONAL WORK FOR COMPENSATION

The UW’s Outside Professional Work Policy requires faculty members, librarians, and all other academic personnel to obtain University approval before engaging in outside professional activities for any type of compensation. Purely voluntary work for which no financial payment, property rights, or other tangible benefit of any sort will be received does not require approval. Approval of each outside work activity for compensation must be obtained each academic year before you engage in the requested activity.

NOTICE: Your compliance with the Outside Professional Work Policy provides you significant protection from potential complaints under the Washington State Ethics Act, RCW 42.52.

Submitting the Request

1. Fill in the blanks below and print and sign the request form.
2. Send the request to your department chair or program director for review and recommendation.
3. The department chair or program director will evaluate the request, make a recommendation, and submit the request and recommendation to the appropriate dean, chancellor, or vice provost, for further action. Under some circumstances, review by the Provost’s Office may also be necessary.

A. Applicant Information

Name ______________________________________ Employee ID No. _______________
Campus Box _______________ College/School/Department _______________________
Job Title ______________________ % FTE _______ Service Period (e.g., 9 or 12 months) _______
Are you here on a work visa?  no □ yes □ (type ________________)
Have you read the Outside Professional Work Policy within the past year?  yes □ no □
If not, please do so before continuing, since failure to comply with the Policy puts you at individual risk. The Policy contains specific exemptions, conditions, and limitations.

B. Information About the Outside Organization

Name of Organization ______________________________________________________
Type of Organization (e.g., For-Profit, Not-For-Profit; Public (Federal, State, Regional, or Local agency)) _______

• Do you or a member of your immediate family (including any significant other) have ownership, management, day-to-day participation, or other significant or continuous involvement with the outside organization that is deeper than a usual consulting relationship? yes □ no □
If so, please describe the involvement __________________________________________________________
__________________________________________________________________________________________

C. Information about the Outside Work

Brief description of the activities to be performed

Period of Work during the Academic Year (July 1 – June 30) __________________
Number of Days Requested for Activity ________________

• Will other UW employees or students be involved in this work? yes □ no □
• Are you receiving or do you anticipate receiving any UW research funding from the organization? yes □ no □

If the answer to either question in this Section C is “yes,” please explain here, including any eGC1 numbers for any existing research funding:
D. Intellectual Property (Please refer to Administrative Policy Statement 59.4.7)

- Is there any possibility that this work will result in the transfer or use of information that is not publicly-available or any technology or invention or software of commercial value developed at the UW that is not in the public domain? yes □ no □
  If the answer is “yes,” please describe the non-public information, technology, or invention, or software:

- Is there any possibility that you will make more than de minimis use of any UW equipment, supplies, facilities, or non-public information while performing this outside work? yes □ no □
  If the answer is “yes,” please describe the equipment, supplies, facilities, or non-public information:

- In this outside work, will you be participating in activities that are likely to result in inventions, novel technologies, or software of commercial value? yes □ no □

  VERSION 1: NARROW ASSIGNMENT [Conceptually described below]
  [This version would provide that if the answer to any question in this Section D is “yes,” the applicant would please initial a paragraph that assigned to the UW all the applicant’s rights to any inventions developed as a consequence of, or in any way related to this outside work, the rights to which the UW would be entitled under the UW Patent, Invention, and Copyright Policy]
  OR
  VERSION 2: BROAD ASSIGNMENT [Conceptually described below]
  [This version would provide that if the answer to any question in this Section D is “yes,” the applicant would please initial a paragraph that assigned to the UW all the applicant’s rights to any inventions to which the UW would be entitled under the UW Patent, Invention, and Copyright Policy.]

NOTICE: You should carefully review any agreements with the outside organization to be certain you make no promises that are inconsistent with this assignment or your other UW obligations. Your agreement with the outside organization should contain the provision “To the extent the consulting agreement is inconsistent with any of the UW employee's obligations to the UW, the employee's obligations to the UW shall prevail.”

Applicant’s Signature

In submitting this request, I certify that the Statements above are truthful to the best of my knowledge.

____________________________________
Signature       Date

Chair/Director and Dean/Vice Provost Approval

I am confident on the basis of the information provided that the proposed outside work:

- Is not within, or a duplication of, the UW duties of the Applicant or under the Applicant’s supervision;
- Does not fall within the scope of the Applicant’s grant or contract funding at the UW;
- Will not interfere with the Applicant’s primary obligations to the UW;
- If it involves consulting with another state entity, RCW 42.12.120 has been followed;
- If applicable, a conflict management plan has been prepared and implemented; and
- If applicable, a deeper involvement review has been completed pursuant to Executive Order 57, Section 6.C.

I □ approve □ do not approve this request.       I □ approve □ do not approve this request.
I □ approve □ do not approve this request.
REQUEST FOR APPROVAL OF OUTSIDE PROFESSIONAL WORK FOR COMPENSATION

The UW's Outside Professional Work Policy requires faculty members, librarians, and all other academic personnel to obtain University approval before engaging in outside professional activities for any type of compensation. Purely voluntary work for which no financial payment, property rights, or other tangible benefit of any sort will be received does not require approval. Approval of each outside work activity for compensation must be obtained each academic year before you engage in the requested activity.

NOTICE: Your compliance with the Outside Professional Work Policy provides you significant protection from potential complaints under the Washington State Ethics Act, RCW 42.52.

Submitting the Request

1. Fill in the blanks below and print and sign the request form.

2. Send the request to your department chair or program director for review and recommendation.

3. The department chair or program director will evaluate the request, make a recommendation, and submit the request and recommendation to the appropriate dean, chancellor, or vice provost, for further action. Under some circumstances, review by the Provost’s Office may also be necessary.

A. Applicant Information

Name ___________________________________ Employee ID No. __________________________

Campus Box ________________ College/School/Department _____________________________

Job Title ________________________ % FTE _______ Service Period (e.g., 9 or 12 months) ______

Are you here on a work visa? no □ yes □ (type __________________________)

Have you read the Outside Professional Work Policy within the past year? yes □ no □

If not, please do so before continuing, since failure to comply with the Policy puts you at individual risk. The Policy contains specific exemptions, conditions, and limitations.

B. Information About the Outside Organization

Name of Organization ________________________________________________________________

Type of Organization (e.g., For-Profit, Not-For-Profit, Public (Federal, State, Regional, or Local agency)) _______________________

- Do you or a member of your immediate family (including any significant other) have a Significant Financial Interest with the outside organization (as defined by UW Policy, GIM 10), or plan to engage in management, day-to-day participation, or other significant or continuous involvement with the outside organization that is deeper than a usual consulting relationship? yes □ no □

If so, please describe the involvement ________________________________________________

C. Information about the Outside Work

Brief description of the activities to be performed __________________________________________

______________________________

Period of Work during the Academic Year (July 1 - June 30) __________________________

Number of Days Requested for Activity ______________________

- Will other UW employees or students be involved in this work? yes □ no □

- Are you receiving or do you anticipate receiving any UW research funding from the organization? yes □ no □

If the answer to either question in this Section C is “yes,” please explain here, including any eGCI numbers for any existing research funding: __________________________________________
D. UW Resources and Proprietary Information (Please refer to Administrative Policy Statement 59.4.7)

- Is there a reasonable possibility that this work will result in the transfer or use of information, technology, or inventions, or software of commercial value developed at the UW that is neither publicly-available nor in the public domain? yes □ no □
  If the answer is "yes," please describe the non-public information, technology, or invention, or software:

- Is there a reasonable possibility that you will make more than de minimis use of any UW equipment, supplies, facilities, or non-public information while performing this outside work? yes □ no □
  If the answer is "yes," please describe the equipment, supplies, facilities, or non-public information:

- In this outside work, will you be participating in activities that are likely to result in inventions, novel technologies, or software of commercial value? yes □ no □
  If the answer is "yes," please describe the activities:

NOTICE: You should carefully review any agreements with the outside organization to be certain you make no promises that are inconsistent with your obligations to the UW. Any agreement you make with the outside organization should contain a provision stating, in essence, that, "To the extent the consulting agreement is inconsistent with any of the UW employee's obligations to the UW, the employee's obligations to the UW shall prevail."

Applicant's Signature

In submitting this request, I certify that the Statements above are truthful to the best of my knowledge.

________________________________________  ________________________
Signature                                      Date

Chair/Director and Dean/Vice Provost Approval

I am confident on the basis of the information provided that the proposed outside work:

- Is not within, or a duplication of, the UW duties of the Applicant or under the Applicant's supervision;
- Does not fall within the scope of the Applicant's grant or contract funding at the UW;
- Will not interfere with the Applicant's primary obligations to the UW;
- If it involves consulting with another state entity, RCW 42.12.120 has been followed;
- If applicable, a conflict management plan has been prepared and implemented; and
- If applicable, a deeper involvement review has been completed pursuant to Executive Order 57, Section 6.C.

I □ approve □ do not approve this request.  I □ approve □ do not approve this request.

Chair/Director Signature  Date

Dean/Vice Provost Signature  Date

Provost Approval (where needed)

I □ approve □ do not approve this request.
Hi Susan, Jack,

Keeping you in the loop on the ongoing policy work -

Fred.

Fred B. Holt
Strategic Initiatives - fbholt@uw.edu
UW Center for Commercialization

Begin forwarded message:

From: Linden Rhoads <lrhoads@u.washington.edu>
Date: January 15, 2013 10:51:18 AM PST
To: "Robert W. Gomulkiewicz" <bobgom@u.washington.edu>, ...
Subject: IPMAC - C4C drafts

Dear IPMAC members:

Following up on the IPMAC meeting on December 14th, we have been drafting the documents to reflect the agreed upon changes regarding the reporting and assignment of inventions. With the January IPMAC meeting scheduled for Friday January 25th, we wanted to get these documents out to you for your review.

There are four attachments for your review:
* a revised EO36, with changes primarily to the Patent & Invention Policy. We have only made a few related changes in the Copyright Policy at this time.

* a draft of an IP Agreement, adapting the Stanford approach to our circumstances.

* a revision of the Innovation Assignment form we use as part of our ROI process.

* a 1-page memo about the RCWs covering the reporting and scope of required assignment of inventions, by employees to employers in Washington.

As you review these documents, here are a few topics and issues for you to consider:

1. Can we please update the name of the office? The official title in policy remains "the Office of Intellectual Property and Technology Transfer" (OIPPT), but this is seldom used in practice. This change would require small changes in a handful of other sections of UW policy, where our office is
2. What limitations should we have on putting inventions in the public domain? Consider 3 situations:

Situation A: Four researchers jointly invent a technology. Three want to manage the technology, one wants to put it in the public domain. What outcome should policy support?

Situation B: Four researchers jointly invent a technology. One wants to manage the technology, and three want to put it in the public domain. What outcome should policy support?

Situation C: A researcher has been working with C4C on commercializing an invention. UW C4C has invested in patent filings, business development, an EIR, etc, to advance this commercialization project. How does C4C execute an agreement with the inventors, suspending their right to put the invention in the public domain until the commercialization project is concluded?

3. “Commercial software” falls under the patent & invention policy. We have proposed an updated definition and would like your thoughts on this.

We look forward to reviewing this material with you on the 25th.

Linden

Linden Rhoads
Vice Provost — Commercialization

Center for Commercialization
University of Washington
Direct line 206.543.0905
Assistant Myrna Duarte — myrnad@uw.edu
lrhoads@uw.edu
www.uwc4c.com
Patent, Invention, and Copyright Policy

1. Patent and Invention Policy

A. This policy covers both patented and nonpatented innovations, including computer software with commercial value, and is applicable to all faculty, staff, and students. The policy is intended to show the University’s positive attitude toward transfer of results of its research to the private sector.

B. The purpose of university research is to seek new knowledge for the general benefit. Although university research is not directed intentionally toward inventions, commercially valuable inventions do often result, and it is generally in the best interests of the University and the public that patents be obtained and/or licenses granted as described in this policy. Inventions shall be promptly reported to the University’s Office of Intellectual Property and Technology Transfer, and all concerned shall cooperate to assure prompt initiation of appropriate technology transfer actions. A university researcher is free to place his or her inventions in the public domain as long as in so doing the researcher has consent from any co-inventors and neither the researcher nor the University violates the terms of any agreements, including agreements within the University.

The term "invention" means any invention innovation or discovery which is or may be patentable or otherwise protectable as to ownership. An invention may be a process, machine, manufacture, composition of matter or design, or any new or useful improvement thereof. An invention is deemed to be "made" when it is conceived or first actually reduced to practice.

C. The University requires assignment for inventions it determines were developed:

(a) in the course of the employee’s University obligations and
activities, or reasonably anticipated to be developed as part of the employee’s University obligations and activities; or
(b) as a result of or in the course of making use of nonpublic University information or more than de minimis use of University equipment, supplies, or facilities, unless excluded by prior written contract for the lease or appropriate use of University equipment and facilities.

University employees shall disclose report all such inventions and discoveries to the University’s Office of Intellectual Property and Technology Transfer and shall execute documents of assignment and do everything reasonably required to assist the University in obtaining, protecting, and maintaining its patent or other proprietary rights. As a condition of employment, and even if a specific patent agreement is not signed, University employees hereby assign and agree to assign all inventions in which the University has an interest to the University. Employees shall execute documents of assignment and do everything reasonably required to assist the University assignee(s) in obtaining, protecting, and maintaining its patent or other proprietary rights.

Students who are also employees, students working on a sponsored project, and students who have used University resources (other than for lecture-based coursework) shall also report all inventions and discoveries to the University’s Office of Intellectual Property and Technology Transfer will be treated as employees under this policy. Such students and hereby assign and agree to shall assign all such inventions and discoveries in the same manner as University employees.

Under Washington State law RCW 49.44.140-150, employees have certain rights with respect to assignment of inventions.

Inventions in which the University has an interest but which do not meet University criteria for patenting shall be managed in accordance with policies and procedures determined by the University Office of Intellectual Property and Technology Transfer. If and to the extent permitted by state law and other University policies, those procedures may include:

1) A mechanism by which the inventor(s) may personally pay patenting costs;

2) The formation of a commercial enterprise to pursue commercialization; and, under very rare circumstances,
3) The transfer, for appropriate consideration, of the patent rights to the inventor(s).

These procedures shall be implemented at the discretion of the Vice Provost for Intellectual Property and Technology Transfer.

Although all inventions and discoveries must be reported to the Office of Intellectual Property and Technology Transfer, there are instances when the University may choose not to assert ownership. The University will not require assignment of interests for any invention for which no equipment, supplies, facilities, or trade secret information of the University was used and which was developed entirely on the employee's own time, unless:

1) The inventions relate:
   a) Directly to the business of the University, or
   b) The University's actual or demonstrably anticipated research or development, or

2) The invention results from any work performed by the employee for the University.

D. Research funded wholly or in part by an outside sponsor is subject to this policy as modified by the provisions of the agreement covering such work. Employees engaged in sponsored research are bound by the provisions of the agreement between the University and the sponsor. Title to any inventions conceived or first reduced to practice in the course of research supported by federal agencies, industry, or other sponsors shall generally vest in the University. In rare cases, an industrial sponsor may possess a dominant patent position in a certain technology area so that any patent the University might seek would be of little or no value. For this or other reasons, an exception to the University's Office of Intellectual Property and Technology Transfer when to do so will honor the general principles of this policy, protect the equities involved, and satisfy the requirements of the parties.

E. Industry supported research is valued by the University when it embraces a proper balance between the University's educational mission and industry's quest for the development of commercial products, processes, and services. Interaction with industry may take any of several forms, including grants, contracts, consortia agreements, and affiliate programs.
Industry sponsors may be assured of at least a non-exclusive license to inventions conceived or developed with their support. Where the sponsor uses the invention entirely within its own operations, the license may be royalty-free. Where the sponsor, or a third party, manufactures and sells products, services, or processes based on the invention, reasonable royalty payments to the University, or its assignee, are required. If necessary for the effective development and marketing of a University invention, an exclusive license may be granted, usually for a limited time period. Where an invention is not identifiable in advance, the University may grant the sponsor an option to an exclusive license if the sponsor agrees to finance the cost of the University’s patent application and observe certain diligence requirements that will assure promptly bringing the invention into public use. The patent financing may be treated as an offset against royalties payable when the invention is marketed.

F. The University retains the right to file patents itself or to use other patent management firms. The University has agreements with the Washington Research Foundation, Research Corporation Technologies of Tucson, Arizona and Battelle Development Corporation in Columbus, Ohio as patent and license agents.

G. Both the University and the inventor are entitled to a share of income from licensed inventions; the University on the basis of salary and facilities support for the inventor and the cost of patent or license administration; and the inventor on the basis of creative activity, documenting the invention, and assisting as necessary with commercialization. Thus, the University allocates a share of income to the inventor. The remainder is dedicated to further research by allocating shares to the college/department (or other unit) in which the invention was conceived or first reduced to practice and to the Office of the Provost.

H. The University may take an equity position in a company whether or not license fees or royalties are paid to the University as part of a negotiated agreement. A typical circumstance under which the University might receive equity would be as part of an agreement licensing University-developed technology to a start-up or developing business venture. Another example might occur when an employee of the University utilizes the expertise and/or technology he or she has developed in the course of University employment and assists a business venture in the commercialization of an idea. (A business venture includes corporations, partnerships, or other commercial enterprises.) Such a commercial association with the University and its employees adds both value and credibility to the new business venture. To assure a balance of interests
for the business venture as well as for the University, the University will generally require that it receive an equity position in such circumstances.

The University's equity interests are managed and disposed of in accordance with guidelines established by the Treasury Office in consultation with the Office of the Provost and the policies and procedures stated in the *Administrative Policy Statements, Board of Regents Governance, Employment and Administrative Policies, Faculty Code and Governance, Presidential Orders, and Student Governance and Policies*. University employees may be eligible to receive a portion of the University's equity interest in accordance with the policies and procedures described in the University's *Administrative Policy Statements* and as allowed under state law and University conflict of interest policies. When such equities are liquidated, the net proceeds, after recovery of all University costs and after any distributions to eligible recipients, accrue to appropriate University accounts and are administered by the Provost to promote research and technology transfer across the entire University. If the proceeds from the disposition of a particular equity interest are unusually large, the Provost shall confer with the University Budget Committee, the Research Advisory Board, or other appropriate faculty bodies, on alternative uses for amounts in excess of a base figure (set at $3 million in 2000 dollars).

There may be situations in which both the University and its employees separately own equity interests in a business venture. In such circumstances, the employee's equity interest is considered to be independent of the University's equity interest and is not held, managed, disposed of, or distributed by the University. An example would be a case in which the University receives an equity interest in a business venture as a result of licensing certain intellectual property developed by one of its employees and in which the same employee also owns a equity interest as a result of being a founder of the business venture receiving the license. In this example, the employee's equity interest is not held or managed by the University, but rather by the employee, and the employee's status as a founder having an ownership stake in the business venture renders the employee ineligible to receive a distribution of a portion of the University-owned equity.

I. As a public institution, the University should undertake sponsored research only when the results can be published. Publication may be deferred for a reasonable time during which the University and the sponsor review the feasibility of patent coverage or other protection on an invention described in the publication. Likewise, graduate student theses or dissertations containing invention details may be withheld from
the Library shelves for a limited period while this evaluation process is conducted. Some research agreements may involve University access to a sponsor’s proprietary data subject to a clause defining the conditions under which such data will be identified, accepted, and used. Students should be able to participate in such research in a meaningful way without access to proprietary data. When publication of the research involving proprietary data is contemplated, the University may agree to provide the sponsor with advance copy prior to submission for publication to allow the sponsor an opportunity to identify any inadvertent disclosure of proprietary data.

J. Employee consulting with commercial enterprises can be of significant benefit to the University, the employee, the commercial entity, and the general public. However, such involvements include the potential for conflicts of interest, for the inhibition of the free exchange of information, and for interference with the employee’s primary allegiance to the University. University employees should be guided in these arrangements by the policy stated in Executive Orders No. 32, No. 35, No. 43, and No. 57. Invention clauses in consulting agreements must be consistent with the policy of the University and with University commitments under sponsored research agreements. Questions concerning potential conflicts should be referred to the University's Office of the Provost and the Office of Research.

K. Conflicts of interest are of prime concern when a faculty member is involved in "deeper than consulting" arrangements with business ventures. Although the faculty member may hold an equity interest or a management position in a business venture, he or she must do so consistent with the principles and procedures of Executive Order No. 57, Section 6, "Involvement with Commercial Enterprise, Deeper than Consulting." In situations where the employee is a board member, manager, or receives shares of stock, the option to purchase stock, or other equity interest in return for the use of his or her services and/or inventions in a business venture, approval by the Office of the Provost (after review by the dean and the chair) is required. The primary focus of the review by the Office of the Provost will be to ensure that potential conflicts of interest and exposure to liability are properly managed. For example, the interests of the graduate students involved in such cases must be protected, there must be no direct managerial involvement of the faculty member in the business venture, there must be an arms-length relationship, an expressed distinction between the faculty member's responsibilities to the business venture and the faculty member’s academic responsibilities, and mechanisms must be in place to ensure that the research program of the faculty member is not distorted by his or
2. **Copyright Policy**

   **A. Background**

   The University encourages the publication of scholarly works as an inherent part of its educational mission. In this connection, the University acknowledges the right of faculty, staff, and students to prepare and publish, through individual initiative, articles, pamphlets, and books that are copyrighted by the authors or their publishers and that may generate royalty income for the authors.

   The variety and number of copyrightable materials that may be created in the university community have increased significantly in recent years as have the author-university-sponsor relationships under which such materials are produced. Therefore, the following statement of University policy on ownership and use of copyrightable materials is provided to clarify the respective rights of individuals and the University in this increasingly important area. The policy will be administered by the University's Office of Intellectual Property and Technology Transfer.

   **B. General Statement of University Policy on Ownership and Use of Copyrightable Materials**

   For the purposes of this policy, “scholarly work” means an employee’s original contributions, created independently and at the employee’s initiative, to course notes, syllabi, writings, books, journal articles, web pages, artistic creations, performances, video or audio recordings, and media, within the field of the employee’s academic research, exclusive of inventions. Scholarly work includes the discovery of new knowledge and original insights that expand human understanding; the application of existing knowledge in one discipline with that of others; the finding of new and better means for describing, understanding, and presenting what is already known; or the creative work that includes artistic performance, expression, or creation.

   University faculty, staff, and students retain all rights in copyrightable materials they create, including scholarly works, subject to the following exceptions and conditions:

   **1) Grant and Contract Limitations**

   Conditions regarding rights in data or restrictions on copyright privileges contained in sponsored grants, contracts, or other awards are binding
on the University and on faculty, staff, or student authors. Copyright works, with the exception of routine progress reports, prepared as required elements of such sponsored grants, contracts, or other awards shall be reported to the Office of Intellectual Property and Technology Transfer for review prior to any external dissemination of the work. If necessary to fulfill grant and contract limitations, authors shall execute an appropriate written assignment of copyrights to the University.

2) University-Owned Materials

Materials shall be "University-owned" within the meaning of this policy statement if the work is a "work for hire" under copyright law or the author was commissioned in writing by the University (or one of its colleges, schools, departments, or other divisions) to develop the materials as a part of the author's regularly compensated duties, as for example, released time arrangements in the case of faculty members. As to a faculty member, "commissioned in writing" specifically does not refer to his or her general obligation to produce scholarly works.

3) University-Sponsored Materials

Materials shall be "University-sponsored materials" within the meaning of this policy statement if the author developed the materials in the course of performance of his or her normal duties and utilized University staff, resources, or funding to develop the work. As to a faculty member, "normal duties" does not include his or her usual scholarly activity unless it involves extensive uncompensated use of University resources.

4) Written Agreements

It is desirable to reach agreement in writing as to the rights of the University and of participants before work begins whenever:

a) A question exists as to whether the materials will be University-owned or University-sponsored, or

b) Copyrightable materials are likely to result from the joint efforts of persons in academic departments and University service departments.

As to jointly-developed materials, determination of rights in written form shall be accomplished no later than prior to sale of the materials in question. Questions concerning the interpretation and administration of
this policy shall be resolved in accordance with Section 3.

5) Proportional Ownership

In case of materials developed in substantial part under commission and in substantial part through other means, the materials shall be regarded as "University-owned" in an appropriate proportion. In the case of materials developed in substantial part during the course of normal duties and with use of University staff, resources, or funding the materials shall be regarded as "University-sponsored" in an appropriate proportion.

6) Royalty-Free Privileges to University

The University retains a right to royalty-free use of any copyrightable materials developed by University employees (other than books and materials available from a publisher through normal distribution channels) when the development of such materials was advanced through the use of University facilities, supplies, equipment, or staff services. This right exists even though the materials do not constitute University-owned or University-sponsored materials as defined above (e.g., where use of facilities by a faculty member was not extensive).

7) Student Writings

Students employed by the University in any capacity are covered by the terms of this policy. In addition, where a student receives financial aid or remuneration under a sponsored research, training, or fellowship program, his or her rights in copyrightable materials are limited by the terms of the University agreement with the sponsoring agency. The University has no ownership rights in copyrightable materials developed by students who are not employees of the University or in materials unrelated to their employment.

C. Types of Materials

The types of materials to which this policy is intended to apply include:

1) Video and audio recordings, tapes, and cassettes.

2) Film, film strips, and other visual aids.

3) Books, texts, study guides, and similar published materials.
4) Computer programs and software when copyright rather than patent or trade secret protection is relied upon as the primary source of legal protection. (When the primary commercial value of a computer program lies in may be enhanced by its transfer in limited quantities under a license agreement arrangements of confidentiality that controls use and/or distribution, it shall be treated as unpatented technology and be subject to the University Patent and Invention Policy.)

5) Musical or dramatic compositions.

6) Internet-based productions and multimedia products.

7) Other copyrightable materials.

D. Rights Involved in Use of University-Owned or University-Sponsored Materials

1) Two categories of use are differentiated for purposes of this policy: internal use and external use. Internal use refers to use by any unit of the University for instruction, research, or other educational purposes. External use refers to use by other educational institutions, government and other nonprofit institutions, and use resulting from lease or other contractual arrangements for commercial distribution of the materials.

2) Use of University-owned or University-sponsored materials under this policy shall be subject to the following conditions:

   a) Internal Use

      i) Each instance of use of such materials within the University requires the approval of the author and the department or college unless advance approval is waived through a prior written understanding or the author’s consent is implicit in the terms of the grant or contract supporting the work. Internal uses of such materials will not involve a transfer of funds between departments unless the lending department incurs incremental costs in order to make the materials available.

      ii) As long as the author or producer of such materials remains an employee of the University, the author may:

          • Request reasonable revisions of the materials prior to any instance of internal use, or

          • Ask that the materials be withdrawn from internal use if
revisions are not feasible. In cases where the University has invested significant funds in the production of the materials and the author/producer is unable to agree with the department head on appropriate revision or withdrawal of materials, the question will be referred to the dean of the school or college for mediation.

iii) If the author or producer terminates employment with the University, then the University retains the right to continue internal use of the material unless the author/producer and the University agree in writing on special conditions for subsequent internal use of the materials and the procedures for their revision.

b) **External Use**

Licensing or sale of University-owned or University-sponsored materials for external use shall be preceded by a written agreement between the University and the author or producer specifying the conditions of use, and including provisions concerning the right of the author or producer to revise the materials periodically, or to withdraw them from use—subject to existing agreements—in the event revisions are not feasible.

### E. Division of Royalties

1) **General Policy on Royalties**

As to University-owned materials, all royalties and income should inure to the University and its schools, colleges, and departments as such materials are prepared in exchange for agreed compensation. As to University-sponsored materials, a sharing of royalties and income is appropriate because of the author's provision of creative efforts on the one hand and the University's provision of salary, facilities, administrative support, and other resources.

2) **Royalties on Sales to Outside Users**

Where University-owned or University-sponsored materials are to be sold or rented to outside users, the following guidelines pertaining to financial arrangements should be observed (subject to any limitations specified by granting agencies):

a) All incremental expenses related to the distribution of copies will
be recovered from each sale or rental. Original costs for production of the materials shall be recovered only if and as agreed to in writing prior to preparation of the materials by the author and the academic departments and/or other University units which incur those costs.

b) In the case of University-owned materials, royalty and other income from sale or use of the materials (after recovery of costs as specified in Subsection 2.E.1 above) shall be divided one-half to the University and one-half to the school/college/department of the author or authors. The University share shall be used to promote research across the whole University and shall normally be administered by the Office of Research. The school/college/department share shall be allocated to the dean of the college or school, and may be used for research, education, and communications. At least 75% of this share should normally go to the author’s department for use there according to departmental and college goals. The dean should have discretion in distributing the remaining 25% to promote activities according to the nature and needs of the college or school in question.

c) In the case of University-sponsored materials, royalty and other income from the sale or use of materials (after recovery of costs as specified in Subsection 2.E.2.a above) shall be divided according to the Administrative Policy Statement 59.4, "Technology Transfer." In any given case covered by this subsection, the author may dedicate all or any portion of his or her allocation to the school/college/department, the Office of Research, or other administrative unit, subject to the provisions of Administrative Policy Statement 59.4).

d) In certain instances it may be advantageous to market University-owned or University-sponsored materials through outside commercial sources or the University Press. Net royalty income from such sources shall be divided as specified in Subsections 2.E.2.b and 2.E.2.c.

e) Royalty and other income from updating and revision of University-sponsored materials shall be treated as income and royalty from such University-sponsored materials, unless otherwise agreed to in writing by the author/producer and the University before preparation of the original materials. The net income from such upkeep or revision shall be separately computed on an annual basis for the purpose of applying the distributions referenced in
F. Protection and Liability

1) Protection

The Office of Intellectual Property and Technology Transfer shall investigate allegations of unauthorized use or copyright infringement of University-owned and University-sponsored materials and shall recommend appropriate action. If such action is started by the University, all costs of such action shall be borne by the University. All proceeds in excess of such costs shall be shared as provided in Subsection F (subject to sponsoring agency limitations if a grant or contract is involved).

2) Liability

When there are allegations of violation of personal or property rights by the University, or by the author or producer of University-owned or University-sponsored materials copyrighted by the University, the University shall assume responsibility for the defense of any action and the satisfaction of any judgment rendered against the University or the author or producer.

3. Interpretation and Administration of Policy

A. The President has designated the Vice Provost for Intellectual Property and Technology Transfer as the officer of the University to administer, apply, and interpret the provisions of this policy. The Vice Provost shall have the authority to determine whether the facts of a given case merit special consideration.

B. Committee

The President of the University will appoint an Intellectual Property Management Advisory Committee to review periodically the policy set forth in this statement and recommend such changes to the President as the Committee deems desirable. The Committee will also advise on broader intellectual property issues that arise in the promotion and protection of research. The Committee will report to the Vice Provost for Intellectual Property and Technology Transfer and consist of no fewer than five members, a majority of whom shall be chosen from the faculty.

C. Distribution of Statement
When this statement becomes effective as University policy, the President’s office shall see that all departments and administrative offices of the University are properly informed. Thereafter, the Vice Provost for Intellectual Property and Technology Transfer shall remind deans and department heads periodically of the existence of the policy, inform them about any significant interpretations of the policy, and invite comments or questions regarding it.

D. **Duties of Vice Provost for Intellectual Property and Technology Transfer**

The Vice Provost for Intellectual Property and Technology Transfer shall manage the Office of Intellectual Property and Technology Transfer, which will represent the University in negotiating agreements with inventors, authors or producers, or licensees pursuant to this policy. She or he may consult also with department heads and the heads of production units involved in a specific technology transfer transaction, and she or he shall sign or recommend all agreements for signing consistent with delegated authority. Where copyright coverage should be obtained on University-sponsored or University-owned materials, the Office of Intellectual Property and Technology Transfer will facilitate the copyright application. The faculty or staff member who is the author of University-owned or University-sponsored materials shall execute a written transfer of copyright to the University when necessary or appropriate.

E. **Inquiries on Status of Materials**

Any faculty or staff member who has a question as to whether or not particular materials will be considered University-owned or University-sponsored should initiate an inquiry to the Office of Intellectual Property and Technology Transfer as to their status. This inquiry, with all relevant facts, should be forwarded via the author’s department head. Thereafter, the Vice Provost for Intellectual Property and Technology Transfer shall advise the author or producer as promptly as possible as to whether or not it appears that the materials should be regarded as University-owned or University-sponsored within the meaning of this policy. The Vice Provost for Intellectual Property and Technology Transfer’s decision in such cases will be considered as an advisory opinion subject to final clarification when the work is completed. At that time, the faculty or staff member should either:

1) Indicate concurrence in the original decision, or

2) Request that the question of rights be submitted for decision to the Vice Provost for Intellectual Property and Technology Transfer.
In the latter case, the decision of the Vice Provost will be final unless the faculty or staff member requests arbitration of the question.

F. Arbitration

In the event of any differences between faculty or staff members, on the one hand, and the Vice Provost for Intellectual Property and Technology Transfer, on the other hand, and when the questions cannot be reconciled by direct negotiation, the matter shall be submitted for binding arbitration either to a single arbitrator agreed on by all parties or to a special three-person panel consisting of one person representing the faculty or staff member, one person representing the University, and a third person designated by the first two. Knowledgeable members of the University community will normally be chosen for such panels in order to expedite a decision and minimize cost. In the event costs are incurred, they shall be divided equally between the faculty/staff member and the University. Decisions of the panel will be binding on both parties. The panel shall have full access to any pertinent records over which the faculty/staff member or the University has jurisdiction.

BR, March 1969; Executive Order No. 36 of the President: June 1, 1972; October 3, 1977; September 26, 1983; September 21, 1992; May 2, 2000, December 20, 2000; October 27, 2003.
This agreement is to be completed by University of Washington employees, faculty, staff, postdoctoral fellows, and resident interns; and by University of Washington students who are working on sponsored research projects, who are employed by the University, or who are making use of the University’s core research facilities.

**Invention and Copyright Agreement for Personnel at the University of Washington**

I understand that, consistent with applicable laws and regulations, the University of Washington (“University”) is governed in the handling of intellectual property by its official Patent, Invention, and Copyright Policy and its Administrative Policy Statement on Technology Transfer, and I agree to abide by the terms and conditions of those policies, as they may be amended from time to time.

Pursuant to those policies, and in consideration of my employment by the University, the receipt of remuneration from the University, participation in projects administered by the University, access to or use of facilities or resources provided by the University and/or other valuable consideration, I hereby agree as follows:

1. **Inventions.** I will disclose to the University all inventions conceived or first reduced to practice in whole or in part in the course of my University responsibilities or with more than incidental use of University resources. I hereby assign to the University all my right, title and interest in such inventions and shall execute and deliver all documents and do everything reasonably required to assist the University in obtaining, protecting, and maintaining patent or other proprietary rights.

   I am free to place such inventions in the public domain as long as in so doing I have the consent of any co-inventors, and neither I nor the University violates the terms of any agreements, including agreements within the University.

   For this agreement, “inventions” means patentable innovations and discoveries, and software of commercial value. Employees have certain rights with respect to assignment of inventions under Washington state law RCW 49.44.140-150.

2. **Scholarly work.** The University and I hereby affirm that as between the University and myself, I retain all copyrights in my scholarly work, that my scholarly work is excluded from any work-made-for-hire at the University.

   For this agreement, “scholarly work” means my original contributions within the field of my academic research, created independently and at my own initiative, exclusive of inventions and of the works identified as works-made-for-hire below. For the definition of “scholarly work”, refer to the policy.

3. **Works Made For Hire.** I hereby assign or confirm in writing to the University all my right, title and interest, including associated copyright, in
and to copyrightable materials in the inventions or copyrightable works created in my service as an employee of the University. Such “works made for hire” include:

a. Works produced for the administration or operation of the University, which may be expressed as including memos, whitepapers, web pages, software, databases, presentations, photographs, designs, and videos;

b. Works supported by a direct allocation of funds or release time through the University for the pursuit of a specific project;

c. Works commissioned by the University;

d. Works identified as deliverables or otherwise obligated under contract otherwise subject to contractual obligations through the University.

This assignment does not include scholarly materials, as addressed above.

4. I am now under no consulting or other obligations to any third person, organization or corporation within respect to rights in inventions or copyrightable materials that are, or could be reasonably construed to be, in conflict with this agreement. NOTE: If you unable to make this affirmation, please contact the UW Office of Research.

5. I will not enter into any agreement creating copyright or patent obligations in conflict with this agreement.

6. This agreement is effective on the later of January 1, 2012 or my date of hire, enrollment, or participation in projects administered by the University, and is binding on me, my estate, heirs and assigns.

Name: ________________________________

Signed: ___________________________ Date: __________________________

The signer should make a copy of this agreement for his or her own records, and hereby waives any objection to the University’s use of an electronic version of this agreement as a substitute for the original for any legally recognized purpose.

1 Proposed definition of scholarly work, to be included in EO 36: “scholarly work” means my original contributions within the field of my academic research, created independently and at my own initiative, exclusive of inventions. Scholarly works may be expressed as to course notes, syllabi, writings, books, journal articles, web pages, artistic creations, performances, video or audio recordings, and media, within the field of my academic research, exclusive of inventions. Scholarly work includes the discovery of new knowledge and original insights that expand human understanding; the application of existing knowledge in one discipline with that of others; the finding of new and better means for describing, understanding, and presenting what is already known; or the
creative work that includes artistic performance, expression, or creation. [Refer to the AAUP Statement on Copyright (1999) and BYU policy.]

Proposed definition of scholarly work, to be included in E0 36: “scholarly work” means my original contributions within the field of my academic research, created independently and at my own initiative, exclusive of inventions. Scholarly works may be expressed as to course notes, syllabi, writings, books, journal articles, web pages, artistic creations, performances, video or audio recordings, and media, within the field of my academic research, exclusive of inventions. Scholarly work includes the discovery of new knowledge and original insights that expand human understanding; the application of existing knowledge in one discipline with that of others; the finding of new and better means for describing, understanding, and presenting what is already known; or the creative work that includes artistic performance, expression, or creation. [Refer to the AAUP Statement on Copyright (1999) and BYU policy.]
INNOVATION ASSIGNMENT / CONFIRMATION OF ASSIGNMENT

All Contributors affiliated with the University of Washington ("UW") at the time of their contribution to the innovation described in this ROI (the "Innovation") must read the information herein and sign below. The nature of the Innovation may be patentable subject matter (e.g. a material, method, or device), copyrightable subject matter (e.g. software, digital media, and other works), trademark, or a combination thereof.

Please note: HHMI investigators and VA-affiliated faculty should contact the ROI Coordinator at the UW Center for Commercialization for the appropriate assignment procedures. Contributors who have no affiliation with the University of Washington should not sign this ROI, but should include their personal contact information and employment affiliation.

Consistent with applicable laws and regulations, the University of Washington is governed by its official policies titled Executive Order 36 and Administrative Policy Statement 59.4 ("UW Policy") in the handling of intellectual property matters, including management of commercialization and distribution of any derived revenue. Subject to UW Policy, Contributors confirm UW rights in this Innovation by signing below.

In some instances, the nature of the Innovation may include rights not typically subject to UW Policy and by signing below, Contributors As a condition of employment or other involvement in research and/or related activities using UW facilities and resources, Contributors agree to abide by the terms and conditions of the UW Policy, as may be amended from time to time.

As such, Contributors hereby assign to UW the entire right to, title to, and interest in the Innovation, excluding any rights to scholarly works as provided under the UW Policy.

Contributors confirm and agree that such assignment (whether under UW Policy or as agreed upon in this ROI) includes the assignment of and the agreement to assign any future additions or improvements of the Innovation to the UW as provided for under UW Policy.

Contributors agree to provide reasonable assistance to the UW Center for Commercialization in the evaluation and commercialization of the Innovation, during and subsequent to UW affiliation, all without charge to UW but at no expense to Contributors. Contributors will not enter into any agreement in the future creating intellectual property obligations that conflict with this agreement without prior written consent from UW.

By signing below, Contributors indicate acceptance thereof and will and hereby do assign all intellectual property rights, including any future additions or improvements, to the Innovation to the University of Washington as provided for under the UW Policy.
Washington State requirements for reporting IP

Following up on the 14 December meeting of IPMAC, we offer this brief summary of the two parts of the state law that limits the scope of employers’ claims on inventions and that requires employees to disclose inventions to their employers. As you will see, the current UW policy closely follows state law, both in its disclosure requirements and in its scope of expected IP assignments. It is important to be familiar with the state laws as we propose narrowing our disclosure requirements and the conditions around invention for which UW policy will seek assignment.

The first part is a state law to prevent over-reaching IP policies by employers in the State of Washington:

(1) A provision in an employment agreement which provides that an employee shall assign or offer to assign any of the employee’s rights in an invention to the employer does not apply to an invention for which no equipment, supplies, facilities, or trade secret information of the employer was used and which was developed entirely on the employee’s own time, unless (a) the invention relates (i) directly to the business of the employer, or (ii) to the employer’s actual or demonstrably anticipated research or development, or (b) the invention results from any work performed by the employee for the employer. Any provision which purports to apply to such an invention is to that extent against the public policy of this state and is to that extent void and unenforceable.

RCW 49.44.140

One challenge that we have already identified with simply copying these guidelines into UW policy is that the “business of the UW” is very broad, and we have suggested narrowing the scope of the UW requirement to an employee’s duties.

The second part requires employees to cooperate in determining fair ownership of IP by disclosing all inventions:

Even though the employee meets the burden of proving the conditions specified in RCW 49.44.140, the employee shall, at the time of employment or thereafter, disclose all inventions being developed by the employee, for the purpose of determining employer or employee rights. The employer or the employee may disclose such inventions to the department of employment security, and the department shall maintain a record of such disclosures for a minimum period of five years.

RCW 49.44.150

As we consider limiting the reporting/disclosure requirements in UW policy, we are choosing not to use UW policy to enforce an employee’s legal obligation arising from Washington State law (currently EO 36 enforces the statute, and we believe that this approach is too strong). The reporting requirement in state law is an obligation of the employees not of the employer. Further, the purpose of the required disclosure is to determine employer or employee rights, so if we have decided that UW will not claim ownership for certain classes of IP (e.g. those developed in approved consulting relationships, outside of UW research projects), then we believe that UW policy can be silent on this obligation.