University Of Washington
Special Committee on Intellectual Property and Commercialization
3:30 p.m. – 5:00 p.m., November 27, 2012
36 Gerberding Hall

Agenda:
1. Call to Order
2. Introductions
3. Overview of SCIPC Charge
4. Establish a Meeting Schedule and Catalyst Go Post
5. Review the revised Request for Approval of Outside Professional Work for Compensation form
6. Adjourn

1. Call to Order
The meeting was called to order by Chair Susan Astley at 3:33 p.m.

2. Introductions
This is the first meeting of the newly formed SCIPC. Brief introductions were given for the SCIPC members.

3. Overview of SCIPC Charge
The Special Committee on Intellectual Property and Commercialization (SCIPC) is charged to review all University of Washington policies and practices related to faculty Intellectual Property, including its management and commercialization. Astley emphasized the importance of providing faculty input and promoting understanding of such policies. Multiple subjects have been proposed for the Council to consider.

4. Establish a Meeting Schedule and Catalyst Go Post
The scheduling will be done via email.

In February 2012, the faculty senate expressed concern about new IP language that had been inserted into the Oct 2011 version of the Request for Approval of Outside Professional Work for Compensation form. This new present assignment language “hereby assign” was inserted into the form by a group consisting of the C4C, the Office of Research, and the UW Attorney General’s office. The faculty senate felt the present assignment language was inconsistent with current UW IP policy (EO 36). In response to faculty concern, Provost Cauce created a Work Group in September 2012 to revise the Oct 2011 Compensation form. The Work Group proposed revisions to the form in Nov 2012 and presented the revised Outside Work form to IPMAC and SCIPC for review. Both Professor Breidenthal and Fred Holt, Director of Strategic Initiatives at the UW C4C were part of this Work Group, and thus were asked to attend this SCIPC meeting.
In preparation for SCIPC’s review of the Nov 2012 *Outside Work* form, Chair Susan Astley sent SCIPC members pertinent documents to review on November 27, 2012 (see Attachment 1).

The Work Group proposed two options for assignment language in the proposed Nov 2012 *Outside Work* form: 1) Narrow Assignment: focused on any invention that may be developed within the scope of this outside work; 2) Broad Assignment: present assignment language that would apply to all inventions, not just those developed as a consequence of this outside work.

SCIPC considered three options regarding assignment language in the *Outside Work* form:

1. No assignment language
2. Narrow assignment
3. Broad assignment

After considerable discussion, SCIPC felt the most appropriate option was to include no assignment language in the *Outside Work* form. SCIPC members agreed to summarize this recommendation by next week and submit to Jack Johnson through the Chair of the Faculty Senate.

6. Adjourn
The meeting was adjourned by Chair Astley at 5:04 p.m.

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

Absent: President’s Designee: TB

Attachment 1
November 17, 2012

Dear SCIPC members,

Welcome to the Special Committee on Intellectual Property and Commercialization.

We have an important first task before us with a December deadline, thus the need to get ourselves up and running as soon as possible.

Our first task will be to review the 11/11/12 draft of the Request for Approval of Outside Professional Work for Compensation form.

Below are documents you will need to review in preparation for our first meeting. These documents include the following Exhibits:

1. A brief history of why this form has been revised.
2. The charge letter from Ana Mari establishing a work group to revise the form.
3. Two versions of the Request for Approval of Outside Professional Work for Compensation form:
   a. The current form (Rev October 2011)
   b. The revised form (Draft 11-11-12)
   c. The Nov 13th email from Jack Johnson to the Senate Leadership presenting the revised form to us for our review/comment.
4. UW Executive Order No. 57 Outside Professional Work Policy.
5. UW Executive Order No. 36. Patent, Invention, and Copyright Policy
Exhibit 1: Brief history of why this form has been revised.

An excerpt from my November SCPB report to the Senate:

**Intellectual Property (IP):** As we move into the 21st century, intellectual property takes on a whole new meaning, as every aspect of our lives and careers move online. The playing field is rapidly changing and policies are needed to address these changes. In February 2012, Professor Storti brought to the Senate’s attention the need to review new language regarding assignment of IP recently inserted in the “Request for Approval of Outside Professional Work for Compensation” form. This discussion led to the discovery that the Intellectual Property Management Advisory Committee (IPMAC), established 15 years ago through EO 36, held its last meeting in March 2010. As of April 2012, IPMAC has been reinstated by the President. The committee is charged with reviewing the policy set forth in EO 36 and recommending such changes to the President as deemed desirable. The committee will also advise the President on broader IP issues that arise in the promotion and protection of research. IPMAC will have a very full agenda over the ensuing years and I recommended IPMAC present annually to the Faculty Senate. In September 2012, Ana Mari established a work group to revise the “Request for Approval of Outside Professional Work for Compensation” form. Professor Breidenthal is a member of the work group. The workgroup revised the Compensation Form and submitted it to the Senate Leadership on 11/14/12 for their review. I have placed this topic on the Nov 26 SCPB agenda. It will also be the first item of business for the newly established Special Committee on IP and Commercialization (SCIPC), approved by the SEC on November 5, 2012. SCIPC is charged to review all University of Washington policies and practices related to faculty Intellectual Property, including its management and commercialization. These policies are broadly outlined in EO 36 and APS 59.4, and managed in part through the Center for Commercialization (C4C). Any proposed changes to such policies/practices shall be brought to this Special Committee as a part of shared governance. This special committee shall report to the Senate Executive Committee. The committee will consist of five or more faculty members (voting) and a presidential designee (nonvoting). One of the faculty members will be the Chair of the Faculty Council on Research. Members will normally serve a three year term but the initial terms will be staggered. Members include: Susan Astley, School of Public Health; Kate O’Neill, School of Law; Matthew Sparke, A&S; Duane Storti, College of Engineering; Tueng Shen, School of Medicine; and Gerald Miller, Physics and Chair of the Faculty Council on Research. I will serve as chair of SCIPC.
September 17, 2012

Prof. Ed Lazowska, Computer Science Engineering  
Prof. Judith Howard, Arts & Sciences  
Jeff Cheek, Office of Research  
Lauren Exnicios, School of Medicine  
Shelley Kostrinsky, Academic HR  
Fred Holt, Center for Commercialization  
Jack Johnson, Office of the President

Dear Colleagues:

I am writing to ask you to serve as a member of a work group to help revise the form used by faculty and other academic personnel to request approval of outside professional work for compensation. Last year, part of the form was modified to address a Supreme Court decision -- it was during this process that a variety of concerns regarding the form were highlighted. I believe it is now worthwhile to determine whether further refinements to the form might make it clearer and more helpful.

As you may be aware, the Center for Commercialization has spent the last several months gathering perspectives regarding a series of potential policy reform efforts around commercialization, industry engagement, and outside work. During this effort, the policies and approval processes related to outside work have emerged as top priority for many. However, rather than waiting for these bigger fixes to take shape, I would like to move forward with this first step of making useful improvements to the outside work approval form. This focused task may also help identify policy areas that need attention.

Jack Johnson, of the President’s Office, has agreed to help schedule an initial meeting of the work group and facilitate moving ahead with this task. We will also be seeking the assignment of a lawyer from the Attorney General’s Office. My hope is that your work can be completed during autumn quarter.

Thank you in advance for your help with this project.

Sincerely,

[Signature]

Ana Mari Cauce  
Provost

cc:  Linden Rhoads  
Tom Baillie  
Gary Ikeda
REQUEST for APPROVAL of OUTSIDE PROFESSIONAL WORK for COMPENSATION

POLICY OVERVIEW:

Pursuant to University Policy on Outside Professional Work (Executive Order 57), faculty members, librarians, and all other academic personnel must complete this form to obtain approval prior to engaging in outside activities for compensation. A person is deemed to engage in an activity for compensation if the person has any economic interest in the activity, or has waived or assigned that economic interest. Such interests include, but are not limited to, the following: (1) monetary payments, such as consulting fees, salaries, wages, loans, royalties, and retainers, or the right to receive monetary payments; (2) any equity interest, such as any interest in the profits or ownership of any entity, and any right to acquire such an interest, including an option, warrant, or other convertible security; and (3) any intellectual property interest, that is, any interest in an invention, patent, copyright, trademark, trade secret, know-how, or other intellectual property right. A person is deemed to have an equity interest or an intellectual property interest if the person either will receive the interest in exchange for engaging in the activity, or owns the interest prior to the activity and the value of the interest could be affected by the activity. For additional policy information, see http://www.washington.edu/admin/acadpers/faculty/outside_profwork.html.

Information regarding the “number of days” for the purpose of Outside Professional Work for Compensation

UW policy limits outside professional work to 1 day per 7 day week; evenings and weekends count; partial days or hours can be accumulated for the completion of a project (e.g. study, report, expert witness, commissioned work of art) with each 8 hours counting as a day; full days or partial days where a continuous relationship exists with the organization (e.g. 4 hours weekly advisory meeting, monthly evening board meeting, or regular weekend assignment) counts as a day; travel time associated solely with the proposed work counts toward days requested. Therefore, for example, a full-time 9-month faculty member may not exceed 39 days of outside work for the period from September 16 to June 15.

Executive Order 57—Exclusions from the Policy Governing Outside Professional Work

Members of the University faculty, librarians, and academic professional community are encouraged to participate in the work of nonprofit professional associations and societies, to contribute their expertise to scholarly, editorial, and advisory bodies including governmental bodies related to their academic work, and to serve on public commissions or boards of philanthropic organizations. These involvements are most appropriately characterized as University and community service and are complementary to University responsibilities. Such activities are not considered outside consulting and prior approval is not required. Such activities should be reported annually online. Faculty members, librarians, or other academic personnel are also encouraged to accept invitations by nonprofit organizations, colleges and universities, and governmental agencies for purposes of presenting guest lectures, delivering papers, serving on review panels, and participating in accreditation activities. In such instances it is not uncommon for a member of the University community to receive some form of honoraria for such activities (see Section 7). Such activities are not subject to limitations on outside consulting work and do not require prior approval, provided, if they involve time away from the University, approval for travel away from the University should be sought from the appropriate supervisor. Such activities should be reported annually online. This exclusion does not apply to teaching credit courses or participating in continuing education activities not under the aegis of the University of Washington.

INSTRUCTIONS TO APPLICANTS: A separate form must be completed for each organization and each type of work to be performed for each academic year. A form must be submitted for approval on an annual basis, or immediately upon any change to information in a previously approved request. Keep one copy of the completed application for your records and give the original application to your Department Chair or Program Director.

Applicant Section:

- If you do not know your EID you can find it by logging into Employee Self-Service with your UWNetID at https://www.washington.edu/admin/payroll/ess/ess.cgi.
- This request form will be returned to you via campus mail once approved.
- Individuals with visas should consult with the International Scholars Office.

15 Enter date range between which all activities will be performed; if the period of activities spans more than one academic year (i.e. activity begins on or before 6/30 and ends on or after 7/1), you must complete a separate form for each academic year.

16 Enter the number of days that will be spent on the activity; use whole numbers only, with a minimum of one day (see above for more information regarding how days are counted).

17 Provide a brief abstract of the activities that will be performed. Use item 28b if additional space is needed.
18a-27a Carefully read the questions and answer either “Yes” or “No”. If you answered “Yes” to any question, you must provide answers to 18b-27b as appropriate.
29 Read the language acknowledging compliance with UW policy, print your name, sign and date the form.

**INSTRUCTIONS TO DEPARTMENT CHAIRS AND PROGRAM DIRECTORS:**
Evaluate the request and indicate your recommendation. Print your name, sign and date the form; forward to your Dean’s/Chancellor’s/Vice Provost’s Office for approval.

**INSTRUCTIONS TO DEANS, CHANCELLORS AND VICE PROVOSTS:**
Evaluate the request and indicate your recommendation. Print your name, sign and date the form; forward to the Office of the Provost, UW Mailbox 351270, for review.
REQUEST for APPROVAL of OUTSIDE PROFESSIONAL WORK for COMPENSATION
TO BE COMPLETED BY THE APPLICANT:

(1) Last Name

(2) First Name

(3) Middle Initial

(4) Employee ID (not SSN)

(5) Campus Box #

(6) Are you here on a visa?

No □ Yes □ Visa Type:

(7) Job Title

(8) Department/Program (if applicable)

(9) College/School/Campus

(10) FTE (if part time, indicate percentage)

□ Full Time or □ Part Time %

(11) Service Period

□ 9 months or □ 12 months

(12) Name of Organization for whom work will be performed

(13) Type of Organization (select one)

□ Private: For-Profit □ Private: Not-For-Profit □ Public: Federal □ Public: State □ Public: Local

(14) Category of Activity (check all that apply)

□ Professional/Private Practice □ Performing Arts □ Consultant □ Speaker □ Board Member □ Editor □ Expert Witness

□ Professional/Continuing Education □ Scientific/Technical/Expert Advisor □ Reviewer □ Other:

(15) Period of Work (date range must fall within one academic year, 7/1-6/30)

(16) Number of Days Requested for Activity

From (mm/dd/yyyy):

To (mm/dd/yyyy):

(17) Provide a brief abstract of the activities to be performed

(18-27) Answer “Yes” or “No” for each question. If you answered “Yes” to any question, you must provide additional documentation below

(18a) □ Yes □ No Do you, your spouse or significant other, or your children have an ownership or deeper involvement with the organization for which the work is to be performed?

(19a) □ Yes □ No Do you, your spouse or significant other, or your children hold a management position with the organization for which the work is to be performed?

(20a) □ Yes □ No Do you, your spouse or significant other, or your children participate in the ongoing day-to-day operations of the organization?

(21a) □ Yes □ No Do you, your spouse or significant other, or your children have a continuing advisory role with the organization?

(22a) □ Yes □ No Will this activity result in the transfer or use of technology, information or other intellectual property developed at the University of Washington that is not publicly available?

(23a) □ Yes □ No Will this activity result in the transfer or use of discoveries, software, databases, inventions or other intellectual property not yet disclosed to the University of Washington?

(24a) □ Yes □ No Will this activity result in the transfer or use of intellectual property obligated or licensed to another entity?

(25a) □ Yes □ No Will you receive, or do you anticipate receiving, research funding from the organization?

(26a) □ Yes □ No Will this activity require that you conduct original research?

(27a) □ Yes □ No Will University of Washington employees or students be involved?

(18b) Do you, your spouse or significant other, or your children have an ownership or deeper involvement with the organization for which the work is to be performed? If YES, please describe the relationship, including the percentage of the organization owned and its approximate value.

(19b) Do you, your spouse or significant other, or your children hold a management position with the organization for which the work is to be performed? If YES, please describe the position.
(20b) Do you, your spouse or significant other, or your children participate in the ongoing day-to-day operations of the organization? If YES, please describe this participation.

(21b) Do you, your spouse or significant other, or your children have a continuing advisory role with the organization? If YES, please describe this role.

(22b) Will this activity result in the transfer or use of technology, information or other intellectual property developed at the University of Washington that is not publicly available? If YES, please explain.

(23b) Will this activity result in the transfer or use of discoveries, software, databases, inventions or other intellectual property not yet disclosed to the University of Washington? If YES, please explain.

(24b) Will this activity result in the transfer or use of intellectual property obligated or licensed to another entity? If YES, please explain.

(25b) Will you receive, or do you anticipate receiving, research funding from the organization? If YES, please explain.

(26b) Will this activity require that you conduct original research? If YES, please explain.

(27b) Will University of Washington employees or students be involved? If YES, please explain.

(28b) Additional information or details regarding items 17-27 above.

The Statements above are truthful to the best of my knowledge. With this request for outside work, I acknowledge that I am bound by and I agree to comply with the University Patent, Invention, and Copyright Policy (Executive Order 36) (“Policy”), as it may be amended from time to time. In accordance with this Policy, I will disclose all inventions and discoveries I create to the UW Center for Commercialization, including any that I create in connection with any outside work. I agree to assign and I hereby assign to the University all my rights in any intellectual property to which the University has a right of assignment under the Policy, provided I created such intellectual property in the course of my University activities or responsibilities or with more than incidental use of University resources.

(29) Date ___________________________ Applicant (print) ___________________________ Signature ___________________________

TO BE COMPLETED BY THE DEPARTMENT CHAIR/PROGRAM DIRECTOR:

(30) Evaluation of Request by Department Chair/Program Director

[ ] Recommended [ ] Not Recommended [ ] Excluded from Policy (Sec. 5), Approval Not Required

Office of the Provost (Rev. October 2011); supersedes all previous versions
TO BE COMPLETED BY THE DEAN/CHANCELLOR/VICE PROVOST:

(32) Evaluation of Request by Dean/Chancellor/Vice Provost

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<th>Excluded from Policy (Sec. 5), Approval Not Required</th>
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(33) Date

Dean/Chancellor/Vice Provost (print)  Signature

TO BE COMPLETED BY THE OFFICE OF THE PROVOST:

(34) Evaluation of Request by the Office of the Provost

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(36) Evaluation of Request by the Provost

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<th>Recommended</th>
<th>Not Recommended</th>
<th>Excluded from Policy (Sec. 5), Approval Not Required</th>
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Requirements upon which Approval is Conditional if any:

(37) Date

Office of the Provost (print)  Signature
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.

____________________________________
Chair/Director Signature Date

____________________________________
Dean/Vice Provost Signature Date
Provost Approval (where needed)

I □ approve □ do not approve this request.

____________________________________
From: Jack G. Johnson [mailto:jackj@uw.edu]
Sent: Tuesday, November 13, 2012 8:10 AM
To: Susan J. Astley
Cc: James N. Gregory; John M. Lee; Nancy L. Bradshaw; Ana M. CAUCE; Douglas J. Wadden
Subject: RE: Work Group on Outside Work Form

Susan, Jim, and Jack:

After three constructive sessions, the work group has put together the attached draft of a revised Request for Approval of Outside Professional Work for Compensation form. We are now hoping to get suggestions from others who may be interested before we make a final recommendation to Ana Mari.

Our two-page draft version of the form is intended to be clearer and easier to complete, with fewer boxes to check and blanks to fill in. It also focuses on conveying important information to the applicant and tracking written policy as closely as possible. Despite these improvements, we are pretty sure the form is not yet perfect, so suggestions will be welcomed.

Regarding the assignment of intellectual property, we have identified two alternatives that IPMAC and the Provost might consider:

- a broad assignment, substantially like the provision put in the form last year (although tailored to “inventions” rather than “intellectual property”) and
- a narrower assignment, that would be scoped to relate in some way to the outside work or the outside company.

IPMAC and the AG’s Office will need to be consulted on the legal and policy dimensions of these alternatives or others.

Please pass this draft on to whomever you think best. Comments should be sent directly to me, preferably by mid-December so that we can be prepared to move ahead after the new year.

-Jack