Agenda:

1. Call to Order
2. Introductions
3. Approval of the Minutes from February 25, 2014
4. IPMAC’s Draft Outside Work Form
5. SCIPC and the Faculty Council on Research
6. Adjourn

1. Call to Order

Chair Astley called the meeting to order at 3:30 p.m.

2. Introductions

Members introduced themselves to the committee.

3. Approve the Minutes from February 25, 2014

The minutes from February 25, 2014 were approved as written.

4. IPMAC’s Draft Outside Work Form

Members reviewed IPMAC’s April 15, 2014 draft of the Outside Work Form 1460 (attached). The April version reflected IPMAC’s response to SCIPC’s review of the Feb 2014 draft. Astley informed SCIPC that a goal for today’s meeting was to hold a vote to adopt the April 2014 version of Form 1460. If adopted, it would replace the May 2013 version of Form 1460 currently in use at the UW.

The key changes between the May 2013 and April 2014 versions include:

- The Form is simplified and more informative.
- The present assignment language is narrowed in scope.
  May 2013 language: “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”.
  April 2014 language: “The Applicant hereby assigns to the UW all rights, title, and interest in every Patentable Invention conceived or actually reduced to practice in the course of my UW employment. For purposes of this Agreement, the term “Patentable Invention” means only those Inventions that are patentable, i.e., meet the criteria for patentability under U.S. patent laws.”
- The faculty member is informed their signature on the Patent Assignment Agreement form does not prevent them from placing their inventions in the public domain.
In the event that a faculty member signed the Outside Work Form Patent Assignment Agreement, and the request for Outside Work was not approved, the IP agreement signed by the faculty member would be null and void.

Although SCIPC members felt the April 2014 version of Form 1460 was an improvement over the current May 2013 version of Form 1460, members continued to express concern about the inclusion of present assignment language in the April 2014 version. Members expressed concern that present assignment infringes on academic freedom and management/development of academic work.

SCIPC members discussed the role of the Bayh-Dole Act and how it influences the relationship between federal funding agencies, UW, and individual faculty members. Sean O’Connor (Chair of IPMAC) explained the impact of Stanford v. Roche on faculty IP and the need for “present assignment” language in the Outside Work Form. Astley commented that present assignment is not mandated by federal or State law and is an approach that seems unnecessarily heavy-handed. All agreed that present assignment effectively ensures that the rights to invention made at the UW are protected from being transferred to outside parties. But that said, Astley continued to query as to whether there were legal alternatives to the present assignment language that were less heavy-handed. O’Neill responded to Astley’s query with four suggested legal alternatives to the present assignment language (attached). These were distributed to members during the meeting.

In place of the current April 2014 present assignment language:

2. Inventions. The Applicant hereby assigns to the UW all rights, title, and interest in every Patentable Invention conceived or actually reduced to practice in the course of my UW employment.

The following 4 alternatives were suggested:

1. Suggestion #1: 2. Inventions. The Applicant hereby grants to the UW the non-exclusive rights and interests to develop, actually reduce to practice, further assign or patent my rights and interests in every Patentable Invention conceived or actually reduced to practice in the course of my UW employment.

2. Suggestion #2: 2. Inventions. The Applicant hereby grants to the UW an undivided joint rights, title, and interest in my rights, title, and interest in every Patentable Invention conceived or actually reduced to practice in the course of my UW employment.

3. Suggestion #3: 2. Inventions. The Applicant hereby assigns to the UW all rights, title, and interest in every Patentable Invention conceived or actually reduced to practice in the course of my UW employment. Upon completion in a manner consistent with the representations I made in obtaining the Approval of Outside Professional Work and in making this Agreement, and upon and in consideration of my submission to the Office of Research of a signed attestation from a duly authorized officer of the entity who provided the compensation for the Outside Professional Work that that entity has not acquired and will not assert any right, title, or interest in any Patentable Invention conceived or actually reduced to practice in the course of my UW employment, the UW shall assign me all rights, title, and interest in every such Patentable Invention conceived or actually reduced to practice in the course of my UW employment, unless I waive my right so such assignment.

4. Suggestion #4: If the answer to either question 1 or 2 is “yes,” you must either:
   a. Submit a signed copy of Attachment A, Patent Assignment Agreement, or
   b. Submit a signed and duty authorized written contract between the outside employer and the UW in which the outside employer provides that in consideration of the UW’s approval of your outside work, it has not and will not obtain, attempt to obtain, or assert any right, title, or interest in any Patentable Invention, conceived or actually reduced to practice in the course of my UW employment.
Time permitted only brief discussion of Suggestions #1 and #4. Potential merits and limitations of each were addressed. Sean O’Connor (Chair of IPMAC) expressed concern that if SCIPC proposed new language for the April 2014 version of Form 1460 at this late date, it would not be possible to obtain review/approval from all necessary partners (IPMAC, C4C, AG’s office) before the end of this academic year. This would postpone replacement of the current May 2013 Form 1460 until well into next Fall. Another option would be for SCIPC to approve the April 15, 2014 draft of Form 1460 as an “interim” draft to replace the current May 2013 Form 1460, and discuss O’Neill’s alternative suggestions in the next round of discussions in the Fall. SCIPC felt it was in the faculty’s best interest to replace the current May 2013 Form with the revised April 2014 Form ASAP to take advantage of improvements captured in the April 2014 Form. SCIPC members expressed the importance of referring to the April 2014 version as an “interim” version. The issue of replacing the present assignment language in Form 1460 with alternate language is still on the table and will be addressed first thing next Fall.

ACTION: Gerald Miller moved to accept the April 15, 2014 version of the Form 1460 as an interim document for the outside work agreement. The motion was seconded.

A comment was raised that there are still opportunities to redraft documents and work on key principles surrounding IP ownership.

Gerald Miller called the question. The motion received unanimous approval.

5. SCIPC and the Faculty Council on Research

O’Neill reported that from conversations with faculty leadership there is an interest to position SCIPC as a permanent subcommittee under the Faculty Council on Research. O’Neill explained that the interest comes from the complexity of future IP discussions, the need for cross-campus representation, the ability to make SCIPC a permanent committee under the Faculty Senate structure, and raising SCIPC’s status throughout the university. Astley expressed concern that IP issues impact all faculty members, not just those engaged in research (especially as it related to web-based content and online courses), thus placing SCIPC under the FCR did not seem altogether appropriate. The current and past chairs of FCR (Miller and Rubel) also expressed concern that FCR would not have sufficient time to oversee SCIPC. As the UW and IPMAC embark on a major review and overhaul of UW IP policy, the role of SCIPC will become increasingly important. Astley suggested an alternative to positioning SCIPC under FCR would be to establish SCIPC as a new Faculty Council.

6. Adjourn

The meeting was adjourned by Chair Astley at 5:15 p.m.

Minutes by Grayson Court, Faculty Council Support Analyst, gcourt@uw.edu

Present: Faculty: Astley (Chair), Jacoby, O’Neill, Rubel, Shen  
President’s Designee: Holt  
Ex-Officio: Miller, Gerrad  
Invited Guest: Sean O’Connor (Chair of IPMAC), Mike Hatch

Absent: Faculty: Storti, Teredesai
Ex-Officio: McNerney

Attachment:

Outside Work Form (DRAFT CLEAN 20140415).docx
REQUEST FOR APPROVAL OF OUTSIDE PROFESSIONAL WORK FOR COMPENSATION

The UW’s Executive Order 57, Outside Professional Work Policy (the “Policy”), requires faculty members, librarians, and all other academic personnel to obtain University approval before engaging in any activities for which you receive compensation directly from an outside or non-UW source (i.e., the paycheck does not come from a UW account). Note that this does not include honoraria. A full description of what constitutes outside professional work for compensation can be found in the Policy. 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.

Your compliance with the Policy provides you significant protection from potential complaints under the Washington State Ethics Act, RCW 42.52 (the “Ethics Act”).

Submitting the Request

1. Fill in the blanks below and print and sign the Request Form.
2. Send the Request Form to your department chair or program director for review and recommendation.
3. The department chair or program director will evaluate the Request Form, make a recommendation, and submit the Request Form 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 ______________________________________________________
Contact at Organization (name, title, email, and telephone) __________________________
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 □
D. UW Resources and Proprietary Information *(Please refer to Section 7 of Administrative Policy Statement 59.04)*

1. Is there a reasonable possibility that this work will result in the transfer or use (other than through a C4C authorized license) of a patentable invention conceived or actually reduced to practice at the UW? yes □ no □
   
   If the answer is “yes,” please describe the patentable invention:
   
   ______________________________________________________________________________________

2. In this outside work, will you be participating in activities that are likely to result in patentable inventions? yes □ no □
   
   If the answer is “yes,” please describe the activities:
   
   ______________________________________________________________________________________

   If the answer to either question 1 or 2 is “yes,” you must submit a signed copy of Attachment A, Patent Assignment Agreement.

   NOTICE: You should carefully review any agreements with the outside organization to be certain any terms you agree to are consistent with your obligations as a UW employee. Further information is available at http://www.washington.edu/research/topics/outside-work/.

3. UW employees, including faculty members, librarians, and other academic personnel, may not use UW supplies, equipment, or facilities for outside work except for limited uses in approved outside work. APS 47.02 describes the scope of these limited uses. This Form is the means by which you can get outside work approved in part to authorize these limited uses. By checking the “I agree” box below you certify that you will make no more than these limited uses in any outside work approved under this Form.
   
   I agree □

   **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.

   ___________________________________________ 
   Chair/Director Signature Date

   **Provost Approval (where required)**
   
   I □ approve □ do not approve this request.

   ___________________________________________ 
   Dean/Vice Provost Signature Date
ATTACHMENT A: Patent Assignment Agreement

This Agreement ensures that the rights to inventions made at the UW are protected from being transferred to outside parties in ways that could: (1) deprive the Applicant and the UW of rights promised to each of them by the UW’s Patent, Invention, and Copyright Policy; and (2) subject the Applicant to claims of breach of contract or state ethics violations.

On this basis, the undersigned Applicant and the UW hereby agree to the following:

1. **Public Domain.** The UW agrees that the Applicant is free to place his or her inventions in the public domain by disclosing research results in publications, conferences, or other public fora; provided, however, that the Applicant has obtained the consent of the Principal Investigator and any co-creators on the research that led to the invention, and that such disclosure will not violate any other agreements, such as funding agreements or agreements within the UW.

2. **Inventions.** The Applicant hereby assigns to the UW all rights, title, and interest in every Patentable Invention conceived or actually reduced to practice in the course of my UW employment.

3. **“Invention” and “Patentable Inventions” Defined.** The term "Invention" shall have the meaning given to it in the UW’s Patent, Invention, and Copyright Policy. For purposes of this Agreement, the term “Patentable Invention” means only those Inventions that are patentable, i.e., meet the criteria for patentability under U.S. patent laws.

4. **Failure of UW to Approve this Form.** In the event that the UW does not approve this Request for Approval of Outside Professional Work for Compensation, this Patent Assignment Agreement shall have no effect and be considered null and void as if it had never been signed by the Applicant.

Applicant: _______________        UW: _______________

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1 "The term ‘invention’ means any invention or discovery which is or may be patentable or otherwise protectable as to ownership.” University Executive Order No. 36, Sec. 1.B. Further, “An invention may be a process, machine, manufacture, composition of matter or design, or any new or useful improvement thereof.” Id. “Invention” includes things which are protectable by trade secret as well as those that may be patentable.

2 E.g., Inventions that: i) constitute a process, machine, manufacture, composition of matter or design, or any new or useful improvement thereof; and ii) are useful novel, non-obvious, adequately described and enabled to one of ordinary skill in the field to which they pertain. See 35 U.S.C. Secs. 101, 102, 103, and 116.