

FLORIDA A&M UNIVERSITY BOARD OF TRUSTEES



NOTICE OF PROPOSED NEW REGULATION

DATE: March 3, 2009

REGULATION CHAPTER NO.: Chapter10

REGULATION CHAPTER TITLE: Personnel

REGULATION TITLE AND NUMBER: Copyrights and Patents (Works and Inventions) (10.128)

SUMMARY OF REGULATION: This regulation has been substantially reworded and established to encourage research and innovation, clarify ownership of intellectual property rights, and provide for the equitable distribution of monetary and other benefits derived from intellectual property.

AUTHORITY FOR REGULATION: Article IX, Florida Constitution; Board of Governors Regulation Development Procedure dated July 21, 2005, Board of Governors Resolution Adopted January 7, 2003; Section 1004.23, Florida Statutes.

UNIVERSITY OFFICIAL INITIATING THIS REGULATION: Dr. G. Dale Wesson, Interim Vice President for Research.

PROCEDURE FOR COMMENTS: Written comments concerning this proposed regulation shall be submitted within 14 days of the date of this notice to the person identified below. The comments must specifically identify the regulation you are commenting on.

THE PERSON TO BE CONTACTED REGARDING THE PROPOSED REGULATION IS: G. Dale Wesson , Interim Vice President for Research, 410 Foote-Hilyer Administration Center, Tallahassee, Florida 32307-3100, 850-412-5102 (phone) 850-412-5096 (fax), Tallahassee, FL 32307-3100, garlen.wesson@famuedu.

FULL TEXT OF THE PROPOSED REGULATION: The full text of this regulation follows:

**Regulations of
Florida A&M University**



10.128 Copyrights and Patents (Works and Inventions).

(1) Policy Statement

The Florida A&M University (FAMU) Board of Trustees hereby establishes this regulation to encourage research and innovation, clarify ownership of intellectual property rights, and provide for the equitable distribution of monetary and other benefits derived from intellectual property.

(2) University Authority and Responsibilities.

Section 1004.23, Florida Statutes, authorizes the University to establish rules and procedures regarding patents, copyrights, and trademarks. To the extent that this regulation and the procedures stated herein conflict with the provisions or the terms of any applicable collective bargaining agreement, the terms of the applicable collective bargaining agreement shall govern, for employees who are members of the collective bargaining unit(s).

(3) For the purposes of this regulation, the following definitions shall apply.

(a) Creator means a member of the University personnel or University student who invented, authored, or was otherwise responsible for the creation of a work or invention.

(b) Contractor means a person external to the University whose services have been engaged to complete a specific task for and on behalf of the institution.

(c) University Student means a member of the student body who invented, authored, or was otherwise responsible for the creation of a work or invention during the time of matriculation at FAMU. This definition includes student workers, graduate/teaching/research assistants and post-doctoral fellows.

(d) Independent Efforts with regards to a work means that the ideas for the work came from the creator, the work was not made with the use of University support; and the University is not held responsible for any opinions expressed in the work.

(e) Instructional technology material, includes video and audio recordings, motion pictures, film strips, photographic and other similar visual materials, live video and audio transmissions, computer programs, computer assisted instructional course work, programmed instructional materials, three dimensional materials and exhibits, and combinations of the above materials, which are prepared or produced in whole or in part by an employee, and which are used to assist or enhance instruction.

(f) Intellectual Property includes all works and inventions.

(g) Invention - "invention" includes any discovery, novel development, process, composition of matter, article of manufacture, know-how, design, model, technological

development, variety, culture of any organism, or portion, modification, translation, or extension of these items, and any mark used in connection with these items. “Instructional technology material” as defined above is included in this definition.

(h) **Protection** refers to the various methods of making application for intellectual property which includes a patent, trademark, copyright, trade secret or domain name.

(i) **University Personnel** shall include full-time and part-time employees of the University, including Faculty and other academic personnel, Executive Services employees, Administrative and Professional employees, University Support Personnel System (USPS), and Other Personnel Services (OPS) employees; appointees of the University, including certain faculty members; persons paid by or through the University, including fellows; and anyone working under University auspices. Students who are encompassed within any of these categories as student workers shall be considered University Personnel.

(j) **University Support** includes the use of University funds, personnel, facilities, equipment, materials, or technological information, and includes such support provided by other public or private organizations when it is arranged, administered or controlled by the University.

(k) **University-supported work** shall mean a work of a creator not made in the course of “independent efforts” as defined herein. The work in this instance is the property of the University and the creator shall share in the proceeds there from. Notwithstanding this provision, “University-supported work” does not include academic research or scholarly study, such as books and articles published in journals independent of the University and electronic media; works developed without the use of University support and used solely for assisting or enhancing the employee’s instructional assignment; and theses or dissertations of graduate students. Persons who complete work under contract are considered “work for hire” and their work is, therefore, the property of the University.

(l) **Works** - A “work” shall include any copyrightable material, such as printed material, computer software or databases, audio and visual material, circuit diagrams, architectural and engineering drawings, lectures, musical or dramatic compositions, choreographic works, pictorial or graphic works, and sculptural works. A work is defined to also include “instructional technology material”, as defined herein.

(4) **Works**

(a) If the work is a university-supported effort, the work is the property of the University. In this instance, the creator of the work shall share in the proceeds of the work subject to pre-existing commitments to outside sponsoring agencies. Upon creation of a university-supported work and prior to any publication, the creator shall promptly disclose the work to the President or the President’s designee in accordance with the procedures outlined herein.

(b) A work which is made in the course of independent efforts and for which no University support has been provided is the property of the creator. The creator and the University may agree that the copyright for any such discovery and invention be pursued by the University and the proceeds shared.

(5) **Inventions.**

(a) Except for inventions made during the course of approved outside employment, an invention which is made in the field or discipline in which the creator is employed by the

University or made by using University support, is the property of FAMU. Florida A&M University and the creator shall share in the proceeds therefrom, subject to pre-existing commitments to outside sponsoring agencies.

(b) A creator shall disclose any inventions made or discovered by them promptly, to the President or the President's designee, in accordance with the procedures outlined herein. With respect to discoveries or inventions made during the course of approved outside employment or matriculation, the creator may delay such disclosure, when necessary to protect the outside employer's interest, until the decision has been made whether to seek a patent.

(c) All inventions made outside the field or discipline in which the creator is employed by the University or matriculating and for which no University support has been provided are the private property of the creator. The creator and the University may agree that the patent for any such discovery and invention be pursued by the University and the proceeds shared.

(6) Although University personnel or students may, in accordance with Regulations 10.122 (Outside Employment/Activities; Financial Interests and Other Conflicts) and 10.110 (Additional Employment) engage in outside employment pursuant to a consulting agreement requiring waiver of the creator's rights to any inventions which arise during the course of such outside employment, the University personnel or student shall not, in doing so, sell or assign patent rights to inventions conceived or developed as University personnel or as a matriculating student. Any University personnel or student who proposes to engage in such outside employment shall furnish a copy of this regulation to the outside employer prior to or at the time the consulting agreement is executed.

(7) **Reporting Procedures**

(a) All University personnel and students shall report to the President or President's designee the nature of the work or invention together with an outline of the project and the conditions under which it was done. If the University wishes to assert its interest in the work or invention, the President or President's designee shall inform the employee or student within 60 days. The University shall designate a representative to conduct an investigation which shall assess the respective equities of the creator and the University in the works or invention, and determine its importance and the extent to which the University should be involved in its protection, development, and promotion. The distribution of income between the University and the creator generated by the licensing or assignment of rights related to patents, trademarks, copyrights or trade secrets shall be reflected in a written contract between the University and the creator consistent with this regulation. All such agreements shall comport with and satisfy any pre-existing commitments to outside sponsoring agencies, but the University Personnel, student or contractor shall not commit any act which would tend to defeat the University's interest in the matter and shall take any necessary steps to protect such interest.

(b) A decision as to whether the University will apply for intellectual property protection for the discovery will be made within 120 days from the date of the disclosure to the President or President's designee. In the event a contractor had been offered the option to apply for the intellectual property protection, the University will use its best efforts to obtain such a decision within 120 days. At any stage of making application, or

while in the process of securing protection, and, if the right to pursue the University's interests has not otherwise been assigned to a third party, the University may withdraw and shall return the appropriate intellectual property rights to the creator, in which case the intellectual property shall be the creator's property and none of the costs incurred by the University or on its behalf shall be assessed against the creator. All assignments of or release of intellectual property rights by the University to the creator shall contain the provision that such intellectual property, if protected by the creator, shall be available royalty-free for use by the State of Florida and the United States Government.

(8) Distribution of Net Income from Works and Inventions.

(a) With regard to any work or invention owned by the University, net income less any foreseeable development expenses the University deems necessary to defend or to maintain the work or invention, the income will be distributed as follows:

(1) 40% to the individual creator(s);

(2) 10% to the creator's department, division, or center that supported the creation of the intellectual property to be spent in support of the creator's research or other directly related University work;

(3) 10% to the creator's college or school that supported the creation of the intellectual property; and

(4) 40% to the Division of Research to support the University's Office of Technology Transfer and to support research and scholarly activity at the University.

For schools or colleges without departments, twenty percent (20%) will be distributed to the school or college.

(b) The President or President's designee shall determine when a distribution of income will be made annually, so as to ensure that all applicable licensing and related expenses have been accounted for. The President or President's designee may, at its sole judgment, withhold or delay distribution of any income if there is a foreseeable development expense yet to be incurred. In instances where funds are held because of foreseeable development expenses or where expenses exceed revenue, an accounting of such will be sent to the creator's department and college/school indicating the amounts received and the amount of the anticipated expense or deficit. When expenses have been ascertained, any excess withholding will be distributed.

(c) In the event there are multiple creators for an invention or work, the creators' share will be divided equally among all creators, unless otherwise agreed upon in a written agreement among the creators. If the creators agree among themselves to a different split, the University's Office of Technology Transfer and Vice President for Research shall be notified and provided with a copy of the written agreement prior to the first income distribution.

(d) The portions distributed to academic units, which are the academic units of the creator(s) at the time of the creation of the invention or work, will be pro-rated when more than one unit is involved. The President or President's designee will make the final decisions on the pro-ration of such portions to academic units.

(9) Compliance

Failure to comply with the provisions of this regulation may result in discipline of University personnel or student in accordance with applicable University regulations and policies.

Specific Authority Board of Governors Regulation Development Procedure Dated July 21, 2005 1004.23, F.S. Law Implemented Article IX, Florida Constitution, Board of Governors Resolution Adopted January 7, 2003, Florida Statutes History- New 6-27-96 (Formerly Rule 6C3-10.142; Amended 3- -09.

~~(1) University Authority and Responsibilities. Section 1004.23, F.S., authorizes the University to establish rules and procedures regarding patents, copyrights, and trademarks. This rule and the procedures stated herein are supplemented by the terms of the BOR/UFF Collective Bargaining Agreement for employees who are members of the collective bargaining agreement.~~

~~(2) Copyrights — An employee, including a University Support Personnel System employee, may procure copyrights, and receive the royalties resulting therefrom, for the employee's products provided the ideas came from the employee, the products were the result of the employee's independent labors, and the employer was not held responsible for any opinions expressed therein. If the products were in any way supported by University funds, personnel, facilities equipment, or materials, the employee shall report to the President or President's designee the employee's interest in having the product copyrighted. Within 60 days after receiving such report, the President or President's designee will inform the employee whether the employer seeks an interest in the copyright or works, and written contract shall thereafter be negotiated to reflect the interest of both parties. All such agreements shall comport with and satisfy any pre-existing commitments to outside sponsoring agencies, but the employee shall not commit any act which would tend to defeat the employer's interest in the matter and shall take any necessary steps to protect such interest.~~

~~(3) Patents:~~

~~(a) An employee shall disclose to the University all patentable inventions and technological developments which the employee may develop or discover while an employee of the University. With respect to discoveries or inventions made during the course of approved outside employment, the employee may delay such disclosure, when necessary to protect the outside employer's interest, until the decision has been made whether to seek a patent.~~

~~(b) All discoveries or inventions made outside the field in which the discoverer or inventor is employed by the University and for which the employer has provided no support are the private property of the inventor. The employee and the employer may agree that the patent for any such discovery and invention be pursued by the University and the proceeds shared.~~

~~(c) Except for discoveries or inventions made during the course of approved outside employment, a discovery or invention which is made in the field in which the investigator is employed by the University or by using University funds, facilities, materials, equipment, personnel or propriety technological information, is the property of Florida A & M University and the inventor shall share in the proceeds therefrom.~~

~~(d) Although an employee may, in accordance with Rule 6C3-10.135, F.A.C., Outside Employment, engage in outside employment pursuant to a consulting agreement requiring waiver of the employee's rights to any patentable inventions or discoveries which arise during the course of such outside employment, the employee shall not, in doing so, sell or assign patent rights to inventions or discoveries conceived or developed as an employee of the University. An employee who proposes to engage in such outside employment shall furnish a copy of this patents policy to the outside employer prior to or at the time the consulting agreement is executed.~~

~~(e) Reporting Procedures—The employee shall report to the President or President's designee the nature of the discovery or invention together with an outline of the project and the conditions under which it was done. If the employer wishes to assert its interest in the patent, the President or President's designee shall inform the employee within 60 days. The employer shall designate a representative to conduct an investigation which shall assess the respective equities of the employee and the employer in the invention or technological development, and determine its importance and the extent to which the employer should be involved in its protection, development, and promotion. The division of proceeds between the employer and the employee generated by the licensing or assignment of patent rights or trade secrets shall be negotiated and reflected in a written contract between the employer and the employee. All such agreements shall comport with and satisfy any pre-existing commitments to outside sponsoring agencies, but the employee shall not commit any act which would tend to defeat the employer's interest in the matter and shall take any necessary steps to protect such interest.~~

~~(f) A decision as to whether the employer will apply for the patent will be made within 120 days from the date of the disclosure to the President or President's designee. In the event a contractor had been offered the option to apply for the patent, the employer will use its good offices in an effort to obtain such a decision within 120 days. At any stage of making the patent application, or in the development of a patent secured, if it has not otherwise assigned to a third party the right to pursue its interests, the employer may withdraw and shall return the patent rights to the employee, in which case the patent shall be the employee's property and none of the costs incurred by the employer or on its behalf shall be assessed against the inventor. All assignments of or release of patent rights by the employer to the~~

~~employee shall contain the provision that such invention or process, if patented by the employee, shall be available royalty free for governmental purposes of the State of Florida.~~