



MEMORANDUM

To: Donna E. Shalala, President

From: Richard L. Williamson
Chair, Faculty Senate

A handwritten signature in blue ink, appearing to read 'Richard L. Williamson'.

Date: November 17, 2011

Subject: Faculty Senate Legislation #2011-21(B) – Amend the *Faculty Manual* Section on Patent and Copyright Policy

At its November 16, 2011 meeting, the Faculty Senate unanimously approved the amendment of the *Faculty Manual* Section on Patent and Copyright Policy, with the stipulation that the legislative history include the understanding that there are additional problems with the policies concerning both patent and copyright that will need to be addressed at some time in the future.

The approved revisions concerning patents are necessary to conform the University's Patent and Copyright Policy to the recent Supreme Court decision in the case of Board of Trustees of Leland Stanford Junior Univ. v. Roche Molecular Systems, Inc., 563 U.S. __ (2011). The specific change was proposed by the General Counsel's Office.

The revision dealing with copyright is in Paragraph 4.3 which states the Patent and Copyright Committee has the same authority with respect to copyrightable material authored by a faculty member, staff member or student as it does to patentable material invented or discovered by the same. However, Paragraphs 4.1 and 4.2 correctly state that original copyright ownership is retained by the author unless specifically assigned to the University. Thus, if read literally, Paragraph 4.3 appears to negate the provisions of Paragraphs 4.1 and 4.2. In order to ensure that Paragraphs 4.1 and 4.2 are not rendered superfluous, a clarifying revision was made.

The supporting materials are enclosed for your reference.

This legislation is now forwarded to you for your action.

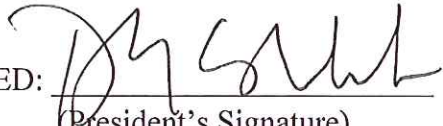
RW/rh

Enclosure

cc: Thomas LeBlanc, Executive Vice President and Provost
Aileen Ugalde, General Counsel

CAPSULE: Faculty Senate Legislation #2011-21(B) – Amend the *Faculty Manual* Section on Patent and Copyright Policy

PRESIDENT'S RESPONSE

APPROVED:  DATE: 12/10/11
(President's Signature)

OFFICE OR INDIVIDUAL TO IMPLEMENT: FACULTY SENATE OFFICE

EFFECTIVE DATE OF LEGISLATION: IMMEDIATELY
(if other than June 1 next following)

NOT APPROVED AND REFERRED TO: _____

REMARKS (IF NOT APPROVED): _____

MEMORANDUM

TO: Faculty Senate

FROM: Provost Thomas LeBlanc DATE: November 1, 2011

RE: Amendment to the Patent & Copyright Policy

Due to the recent Supreme Court decision in the Board of Trustees of Leland Stanford Junior Univ. v. Roche Molecular Systems, Inc., 563 U.S. ___ (2011) case, the University is seeking to revise the University's Patent & Copyright Policy ("Policy") to conform to the Supreme Court's opinion in *Stanford v. Roche*.

In a 7-2 decision, the Supreme Court upheld long-standing precedent that patent rights initially vest in individual inventors, and noted that a federally funded contractor, such as a university, may only "elect to retain title" under the Bayh-Dole Act if title has already been granted by the inventor(s). Accordingly, a federal contractor, such as a university, does not automatically obtain rights to an invention simply because it occurred as a result of federal funding. Rather, such rights must be effectively *transferred* from the inventor. It is well settled that, based on contract law, an inventor could assign an invention to a third party, even if the invention was federally funded. The Roche case highlights the necessary language to effectively transfer these rights.

The Federal Circuit analyzed whether a contract between Stanford and its researcher-employee concerning intellectual property rights trumped a later agreement between the same employee and an outside research company concerning the same intellectual property rights. Board of Trustees of Leland Stanford Junior Univ. v. Roche Molecular Systems, Inc., 939 F. 2d 1568 (Fed. Cir. 2009). In the employee's agreement with Stanford, the researcher merely agreed "to assign" to Stanford his "right, title and interest in" inventions resulting from his employment there. In contrast, the employee's agreement with the outside research company, Cetus (predecessor-in-interest to Roche) stated that he "will assign and do[es] hereby assign" to Cetus his "right, title and interest in... the ideas, inventions, and improvements" made "as a consequence of [his] access" to Cetus' facilities. The former was construed as a *mere* promise to assign, whereas the latter was construed as an actual assignment.

Moreover, though the agreement with Stanford was executed prior to the agreement with Cetus, its wording did not confer legal title, since it reflected a "mere promise to assign rights in the future." Thus, the court held that while the agreement with Stanford was executed first, the agreement with Cetus conferred legal title first, and once that occurred, the employee was divested of legal title and no longer possessed any rights to convey. Consequently, even though the employee eventually did execute an assignment to Stanford, it was too late, as legal title had already vested with Cetus.

In light of the foregoing, it is necessary to revise the University's Policy to ensure that future inventions are vested in the University. Please note, that it has always been the University's policy that any invention or discovery of an employee, including faculty members and students, using University facilities, funds, space, or on University time or along similar lines related to

University research then in progress, known to the faculty member or to which the University is committed is owned by the University and may not be transferred by the faculty member absent a release by the University. This amendment further protects an inventor from an inadvertent assignment of rights.

The Office of Technology Transfer has requested that we take this opportunity to clarify the University's intent as to revenue derived from copyrightable material. Section 4.3 of the Policy is being revised to confirm that the University has no rights, monetary or otherwise, to copyrightable material unless it has been assigned to the University pursuant to Section 4 of the Policy.

For your ease of reference, attached hereto is a redlined and clean version of the Patent & Copyright Policy.

PATENT AND COPYRIGHT POLICY

The Patent and Copyright Policy was adopted by the Board of Trustees November 22, 1967 and amended by the Board on May 31, 1976. Clarification and an expansion of this policy was approved by the Senate and then by the President on February 10, 2001 and is incorporated in this section.¹

I. Preamble

In adopting this policy the Board of Trustees recognizes that there may be research projects sponsored by governmental authorities, industrial concerns or others that may entitle the sponsors to the ownership, without payment of any royalty to any person, of a discovery or invention made by a faculty member, staff member or student of the University as to which there is a reasonable likelihood of obtaining a patent or a copyrightable material authored by a faculty or staff member or student.

II. Creation of Patent and Copyright Committee

The Board of Trustees of the University of Miami hereby authorizes the President to appoint a University of Miami Patent and Copyright Committee (to be referred to as "the Committee"), with the authority and responsibility provided below, and consisting of four members of the University's faculty and three members of the University's administrative staff. Legal counsel for the University shall serve as counsel to the Committee.

III. Discoveries and Inventions

3.1 Disclosure of Discoveries and Inventions. Any faculty member or staff member or student of the University who has made a discovery or invention that is arguably reasonably appears to be patentable (hereinafter referred to as "patentable") shall bring such discovery or invention to the attention of the President of the University, or a designee, for the purpose of determining whether and to what extent the University has an interest in the discovery or invention. Any such discovery or invention shall be so disclosed promptly, but in any event within a period of not more than two months.

3.2 Ownership of Discoveries and Inventions.

(a) A discovery or invention, whether or not subject to patent, developed as a direct result of the regular duties of a faculty or staff member, or developed by a faculty member or staff member or student as a result of research done on or in connection with theses or dissertations or problems pertaining thereto, or as a result of a program of research financed wholly or in part by University funds, or by funds under the control of the University, ~~shall~~ be-is the exclusive property of the University.

¹ #2000-15(B)

Any and all right, title and interest in The ownership of any such discovery or invention, and any patent rights pertaining thereto, areis hereby and will beshall be assigned to the University or its designee and shall be administered in accordance with the determination of the Committee.

(b) A discovery or invention developed by a faculty member or staff member or student shall be the exclusive property of the inventor or inventors if all of the following conditions exist:

(1) if the University has contributed nothing substantial or essential to the production and development of such discovery or invention in funds, space, facilities or time of a faculty member, staff member, or student, and

(2) if the discovery or invention is not along lines related to any University research then in progress, known to the faculty member or to which the University is committed, and with which in either case such faculty member or staff member or student is connected, and

(3) if the discovery or invention was developed by the inventor or inventors on their own time without any expense to the University.

(4) If there is a difference of opinion as to whether a discovery or invention is within subparagraph (1) or subparagraph (2) above, or if a discovery or invention is within neither such category, the ownership of the discovery or invention, and the determination of equities with respect thereto shall be decided by the Committee whose decision, subject to appeal to the President of the University as provided for hereinafter, shall be binding upon the University and upon the faculty member, staff member, or student who made the discovery or invention.

3.3 Authority and Responsibility of the Committee.

With respect to discoveries and inventions, the Committee, subject to appeals to the President hereinafter provided for, shall have the following authority and responsibility with respect to discoveries and inventions:

(a) To receive and act upon reports of discoveries and inventions.

(b) To determine the ownership of discoveries and inventions and to determine the dates of their conception, disclosure and reduction to practice.

(c) To determine the equities of the University, the inventor or inventors, and other parties in discoveries and inventions and to provide equitably for the sharing between the University and the inventor or inventors of royalties received for any patented or patentable discovery or invention in which the University has a property interest, in accordance, however, with the following:

(1) In situations where an agreement, letter or other document involving the University and another party or governmental agency having an interest in such discovery or invention requires that royalties on such discovery or invention be distributed in a particular manner, the sharing of such royalties between the University and the inventor or inventors shall be in accordance with the royalty distribution provisions of such agreement, letter or other document. In all other cases, the procedure set out hereafter in subparagraphs (2), (3) and (4) shall be followed; provided, however, that where an agreement, letter or other document involving the University and another party or governmental agency having an interest in such discovery or invention places a limitation upon the amount of royalties to be paid to the inventor or inventors, then the amount of royalties to be paid to the inventor or inventors in accordance with subparagraphs (2), (3), and (4) shall not exceed such limitation.

(2) The University shall retain all such royalties until it shall have recovered in full all expenses incurred in connection with the filing and prosecution of a patent application, or applications, for the discovery or invention in question.

(3) The next \$1,000 of such royalties shall be paid to the inventor or inventors of the discovery or invention.

(4) Royalties received beyond those required to meet the conditions specified in (1), (2) and (3) above shall be divided as follows:

(i) One-third of such royalties shall be retained by the University.

(ii) One-third shall be paid to the inventor, or to the inventors in accordance with their rights thereto.

(iii) One-third to the primary department of the inventor, or primary departments of co-inventors according to the establishment of proportionate participation as determined under (d) below.

(d) When there are co-inventors, to recommend the extent of the participation of each inventor in the financial returns from the discovery or invention.

(e) To determine, in the case of a discovery or invention in which the University has a property interest, whether the University should attempt to obtain a patent or should submit the discovery or invention to the University's patent agent, any such determination to be made within two months from the date the discovery or invention has been disclosed to the Committee or, if sooner, within thirty (30) days after a written request that such determination be made is received from the President of the University or from the inventor or inventors.

(f) If the Committee decides to submit a discovery or invention of the University to the University's patent agent, and if the patent agent shall decide either not to file an application for a patent or to abandon an application that has been filed, then the Committee shall determine whether the University shall file such application or proceed with an application already filed, or shall assign any right that the University may have in the discovery or invention to the inventor or inventors, such determination to be made within thirty (30) days after the receipt by the Committee of notice from the University's patent agent of a determination not to file such application or to abandon an application already filed.

(g) To report to the President of the University and other interested parties its findings and determinations with respect to a discovery or invention within four (4) months of the receipt by it of knowledge of the discovery or invention except in those situations for which a different period of time for making a determination is established.

(h) To report its findings to the President of the University on all matters bearing on patentable research, or on patents offered to the University by gift, devise, purchase, sale or assignment, regardless of the potential value thereof or the circumstances under which such patentable research or patents were discovered.

3.4 Management and Exploitation of Patents.

The President of the University shall determine the manner in which patents that are the property of the University shall be managed and exploited.

IV. Copyrightable Material

4.1 Rights of Authors.

In accordance with custom in institutions of higher learning, and except as provided below, the right of first publication and of statutory copyright in any book, manuscript, television or motion picture script or film, educational material, or other copyrightable work, whose author is a faculty member or staff member or student, shall be the property of the author.

4.2 Rights of the University.

Copyrightable material resulting from a project assigned to members of the faculty as a part of their regular duties shall inure to the University only if so specified at the time of assignment by an instrument of specific detail and agreement signed by the faculty or staff member, by the department chair or director, and by the school or college dean.

4.3 Authority and Responsibility of the Committee with Respect to Copyrightable Material.

~~The Committee shall have the same authority and responsibility with respect to copyrightable material authored by a faculty member, a staff member, or student as it has in respect to discoveries or inventions made by such persons and dealt with in part III. The specific authority and responsibilities of the Committee with respect to discoveries and inventions, described in paragraph 3.2, shall apply with equal force to copyrightable material except as context does not permit or require change.~~

In the event that the University obtains ownership rights to copyrightable material authored by a faculty member, a staff member, or a student pursuant to Paragraph 4.2 of this Policy, the following provisions shall apply:

- (a) To the extent relevant, the Committee shall have the same authority and responsibility with respect to copyrightable material authored by a faculty member, a staff member, or a student as it has with respect to discoveries or inventions made by such persons as outlined in Paragraph 3.3 of this Policy.
- (b) The President of the University shall determine the manner in which copyrightable material that is the property of the University shall be managed and exploited.

[The following is an explanation of the proposed changes in 4.3, and is not to be included in the actual policy.

Purpose:

Paragraph 4.3 of the Patent and Copyright Policy states the Patent and Copyright Committee has the same authority with respect to copyrightable material authored by a faculty member, staff member or student as it does to patentable material invented or discovered by the same.

However, Paragraphs 4.1 and 4.2 state original copyright ownership is retained by the author unless specifically assigned to the University. Thus, if read literally, Paragraph 4.3 appears to negate the provisions of Paragraphs 4.1 and 4.2. In order to ensure that Paragraphs 4.1 and 4.2 are not rendered superfluous, the following revisions are suggested.]

4.4 Notice to Committee.

Department chairs, deans and directors, shall notify the Committee in writing of any work assigned in accordance with paragraph 3.2 of this Policy that might result in a manuscript or other property for which copyright may be obtainable.

4.5 Software.

For individuals who are staff members, software developed as part of their normal or assigned duties at the University shall be deemed "works-for-hire" and shall be the property of the University. Software that is developed by a staff member that is unrelated to the staff member's duties at the University and is developed without the use of University resources, shall be the property of the staff member.

Faculty, students, and research associates or postdoctoral researchers working under faculty guidance on funded research, who develop software will normally be deemed to own the software. Exceptions are 1) when a prior, written agreement between the individual and the University exists, as described in paragraph 4.2, above; 2) when the individual is engaged in a research grant or contract, where software ownership is specified by the grant or contract (If such a grant or contract leaves ownership with the grant recipient, that shall be interpreted to mean the creator(s), subject to this policy.); 3) when the software is an integral part of a patentable invention or machine developed at the University, in which case ownership and rights will be the same as for a patentable device, as described above; 4) when the University has committed substantial resources (University funds, facilities, equipment, or other resources significantly in excess of the norm for educational and research purposes in the department or unit in which the creator holds his or her primary appointment) to the development of the software, in which case ownership and rights shall be the same as described above for patentable devices. Faculty or student use of an office and desktop computer, or use of limited time on the mainframe computer, is, alone, not considered to be a "substantial" use of University resources; 5) software created by students who have also been hired by the University in a staff position not directly related to their education as a student, and who create software as part of their regular job responsibilities, shall be the property of the University.

Courseware.

Syllabi, lecture notes, class handouts, and other such materials, whether on paper or posted on the web, are considered the property of the faculty member who creates such documents. Lectures at the University of Miami are a public performance of the lecturer's intellectual property, and thus the property of the speaker under federal copyright law. Unless otherwise provided in an agreement with a faculty member, faculty own the rights to their web-based courses, courseware, and to the representation in any medium of teaching which forms part of their ordinary duties.

- 4.6.1 Unless a faculty member specifically objects, the University may use photographs and reasonable audio and/or video recordings of classroom or other teaching for publicity purposes.
- 4.6.2 Faculty members must obtain permission from the Provost or Provost's designee before offering for sale audio or video products produced in University classrooms or University facilities.
- 4.6.3 If the University has committed substantial University resources (as defined in paragraph 4.5, above), any further use of such courseware is subject to an agreement between the faculty member and the University, as described below. Also, faculty participation in the preparation of distance learning materials, or of other materials, which the University will sell or re-use beyond the initial class or session, must be the subject of an agreement with the faculty member before such sale or reuse. In forming such agreements, both the University and the faculty member should strive to conform to the following principles:
- (a) Equitable division of the revenues in a manner proportionate to the value of the efforts contributed by the persons and institutions involved in the preparation and marketing of the materials;
 - (b) Regard for the intellectual property rights of third parties who are not parties to the agreement;
 - (c) The University's rights to use the product produced may be exclusive, but the faculty must retain the right to use information and ideas contained in it in all forms other than those directly competitive with the product;
 - (d) Agreements should be for a definite period of time, ordinarily not to exceed five years, after which ownership of the intellectual property would revert to the faculty member(s) who created it;
 - (e) Provisions must be made to safeguard the "moral rights" of the author(s). For example the authors must have a right to include corrections or updates in a form accessible to purchasers of the original courseware or other product, especially in circumstances where the professional reputation of the author might otherwise be affected;
 - (f) The agreement should specify what happens to the courseware or other product in the event that the author(s) are no longer employed by the University;
 - (g) Written consent of students whose voice or image will be captured as part of distance learning or other products for sale or re-use should be obtained in advance of the recording.

- 4.6.4 A copy of each agreement between a faculty member and the University and/or a department or unit made pursuant to this clause (after removal of the faculty member's name and replacement of any specified dollar payments with either percent of royalties or percent of faculty member's salary, as appropriate) will be deposited with the Faculty Senate and kept on file for review of any interested faculty member. Experience with this process will be reviewed after 5 years.

V. Publication of Materials Relating to Discoveries, Invention and Scholarly Investigation

The Board of Trustees recognizes and wishes to give the fullest possible operation of traditional principles and practices of academic freedom in connection with the publication of writings that relate to discoveries and inventions. At the same time it also recognizes that governmental authorities, industrial concerns or other organizations that sponsor research projects may require temporary restriction on publication in order to protect the sponsor's interest in patentable inventions or discoveries, or because of considerations relating to the national interest or for other reasons considered sufficient by the sponsor. If the University has been authorized or required by the sponsor to determine whether or not publication would be in compliance with such restrictions and conditions such determination shall be made by the Committee.

VI. Appeals from Committee Determinations

If any interested person is dissatisfied with the determination or disposition by the Committee of any matter relating to any discovery, invention, patent, copyright, or copyrightable material, or the publication of any writing discussing or disclosing any of the foregoing, such person may request that the determination be reviewed by the President of the University. Any such request shall be in writing and shall be delivered to the Committee not later than fifteen (15) days after such person has received notice of the determination or disposition which the person regards as unsatisfactory, or if sooner, within fifteen (15) days after the expiration date of the period of time within which the Committee should have reported its findings and determinations to interested parties. The Committee, on receipt of such request, unless it reconsiders its original determination and modifies the same in a manner that is satisfactory to all interested parties, shall forward promptly such request, together with its determination and recommendations, to the President. The President may affirm, modify or reverse the Committee's determination, on the basis of such information as the President wishes to consider, and the President's decision shall be binding on all interested parties. The Committee shall assist the President in reviewing any such matter in whatever manner the President may request.