

# ARTICLE 18

## *INVENTIONS AND WORKS*

**18.1 University Authority and Responsibilities.** The University is authorized to establish regulations and procedures regarding patents, copyrights, and trademarks consistent with federal and state law. Such regulations and procedures shall be consistent with the terms of this Article.

**18.2 Definitions.** The following definitions shall apply in Article 18:

(a) A "Work" means, in accordance with Title 17 of the U.S. Code, any original work of authorship that is or may be subject to copyright. Work includes but is not limited to printed material (such as books, articles, memoranda, and texts), computer software or databases, audio and visual material, circuit diagrams, architectural and engineering drawings, lectures, compositions (e.g., written, musical, dramatic), motion pictures, multimedia works, web pages, sound recordings, choreographic works, and pictorial or graphic illustrations or displays, and any creative expression of a Trademark used in connection with these items. Instructional Technology Material is included in this definition.

(b) An "Invention" shall include (i) any discovery, process, composition of matter, article of manufacture, know-how, design, model, technological development, biological material, strain, variety, culture of any organism, or portion, modification, translation, computer software or databases, or extension of these items which is or may be patentable or otherwise protected under Title 35 of the United States Code, or that is or may be protected as a Trade Secret, under the Florida Trade Secrets Act, Ch. 688, Fla. Stat. or any similar act of another State, as may be relevant, (ii) any novel variety of plant that is or may be patentable or otherwise protected under the Plant Variety Protection Act (7 U.S.C. §2321 et seq.), (iii) any Trademark, and/or (iv) any directly related know-how used in connection with these items. Instructional Technology Material which is or may be patentable is included in this definition.

(c) "Instructional Technology Material" includes video and audio recordings or transmissions, motion pictures, films, slides, photographic and other similar visual materials, electronic and digital media, computer programs, programmed instructional materials, web pages, electronic, electro-mechanical, or solid state physics-based

equipment, three dimensional materials and exhibits, and combinations of the above, which are prepared or produced in whole or in part by an employee and that are used for instruction. All distance and distributed learning courses and/or modules are included in this definition.

(d) "University Support" shall mean the non-incidentual use of University funds, personnel, facilities, equipment, materials, technological information, or students in the creation or making of a Work or Invention; and does not include the incidental use of resources made available to the University community for common use. University Support includes such support provided by other public or private organizations when it is arranged, administered, or controlled by the University.

### **18.3 Works.**

(a) Independent Creative Efforts. A Work made in the course of Independent Creative Efforts is the property of the employee, who has the right to determine the disposition of such Work and the revenue derived from it. The employee shall provide documentation to substantiate his or her Independent Creative Efforts. As used in this Section, the term "Independent Creative Efforts" means that:

(1) the ideas came from the employee;

(2) the Work was made without the use of appreciable University Support; and

(3) the University is not responsible for any opinions expressed in the Work.

(b) University-Supported Efforts. A Work that is created with the use of University Support as defined in 18.2(d) is the property of the University, and the employee shall share in the proceeds therefrom. For example, Web-based courses developed with University resources use a team of technical support experts and faculty members to develop materials and software used in the course. Accordingly, the University maintains the right of ownership to such software and materials. These materials may be licensed by mutual agreement between the University and the employee(s) who developed the materials.

(c) Exceptions. The University shall not assert rights to the following Works:

(1) Those Works for which the intended purpose is to disseminate the results of academic research or scholarly study, such as books, articles, electronic and digital media; and

(2) Works developed without the use of appreciable University Support and used solely for the purpose of instruction.

(3) The intellectual content developed by faculty members for Web-based courses.

(d) Disclosure/University Review.

(1) Upon the creation of a Work and prior to any publication, the employee shall disclose to the president or president's representative any Work made in the course of University-supported efforts, together with an outline of the project and the conditions under which it was done. Consistent with the provisions of Section 18.3.(c) above, employees need not disclose any Work regarding books, articles, and similar Works the intended purpose of which is to disseminate the results of academic research or scholarly Work.

(2) The president or president's representative shall assess the relative equities of the employee and the University in the Work.

(3) Within one-hundred twenty (120) days after such disclosure, the president or president's representative will inform the employee whether the University seeks an interest in the Work, and a written agreement shall thereafter be negotiated to reflect the interests of both parties, including provisions relating to the equities of the employee and the allocation of proceeds resulting from such Work. Allocation of proceeds/royalties shall be made in accordance with the University's policy on copyrights and patents. The agreement will also include provisions relating to the creation, use, and revision of such Works by the University or the employee, as well as provisions relating to the use or revision of such Works by persons other than the University or employee. All such agreements shall comport with and satisfy any preexisting commitments to outside sponsoring contractors.

(4) The employee shall assist the University in obtaining releases from persons appearing in, or giving financial or creative support to, the development or use of these Works in which the University asserts an interest, including Instructional Technology Materials as defined in Section 18.2(c). The employee shall certify that such development or use does not infringe upon any existing copyright or other legal right.

(5) The employee and the University shall not commit any act that would tend to defeat the University's or employee's interest in the Work, such as making a public disclosure prior to the University obtaining intellectual property protection, and shall take any necessary steps to protect such interests.

(e) Outside Activity. An employee may, in accordance with Article 19, Conflict of Interest or Commitment and Outside Activity, engage in outside activity, including employment pursuant to a consulting agreement.

(1) Any requirement that an employee waive the University's rights to any University-supported Work as defined in Section 18.3(b), or Inventions that arise during the course of such outside activity shall not be entered into unless specifically approved by the president or president's representative, in writing, prior to the start of such outside activity.

(2) An employee who proposes to engage in an outside activity where the employee may be asked to waive the University's rights shall furnish a copy of this Article and the University's Copyrights and Works Regulation to the outside employer prior to the time a consulting or other agreement is signed or, if there is no written agreement, before the outside activity/employment begins.

#### **18.4 Inventions.**

(a) Independent Inventive Efforts. All Inventions made outside the field or discipline in which the employee is employed by the University, and for which no University Support has been used, are the property of the employee, subject to 35 U.S.C. 115, who has the right to determine the disposition of such property and revenue derived from such property. The employee and the president or president's representative may agree that the patent for such Invention be pursued by the University and the proceeds shared.

(b) University-Supported Efforts. Inventions made in the field or discipline in which the employee is employed by the University, or by using University Support, are the property of the University and the employee shall share in the proceeds therefrom. Such Inventions and related rights shall be the property of the University and are hereby assigned to the University by the employee. If the University decides to patent, develop and market the Invention, all costs of the patent application and related activities, including those which lead to active licensed production, shall be paid from University funds. These costs shall be recovered before any division of patent or license revenue is made between the University and the employee.

(c) Private or Industrially Sponsored Efforts. Except in unusual cases, Inventions developed in the course of privately or industrially sponsored research are the property of the University. The sponsor may be accorded the first option to negotiate an exclusive license, in which case the term of exclusivity and the compensation shall be

negotiated at the time the Invention is made or under the provisions of the University's policy on copyrights and patents. If the sponsor exercises this option, the University retains royalty-free license rights to use the Invention or discovery for its own purposes.

(d) Outside Activity. An employee may, in accordance with Article 19, Conflict of Interest or Commitment and Outside Activity, engage in outside activity, including employment pursuant to a consulting agreement. All Inventions arising from authorized Outside Activity and outside of the field or discipline of the employee are the property of the employee, subject to the following conditions:

(1) Any requirement that an employee waive the University's rights to any Inventions that arise during the course of such outside activity shall not be entered into unless specifically approved by the president or president's representative, in writing, prior to the start of such outside activity.

(2) An employee who proposes to engage in an outside activity where the employee may be asked to waive the University's rights shall furnish a copy of this Article and the University's Patents, Trademarks, and Trade Secret Regulation to the outside employer prior to the time a consulting or other agreement is signed or, if there is no written agreement, before the outside activity/employment begins. Employees are not authorized to waive University rights, and any such waiver is deemed rejected unless specifically accepted by the Vice President of Research and Commercialization or designee.

(3) Undisclosed Outside Activity is considered unauthorized.

a. Any Invention arising from undisclosed Outside Activity must be disclosed to the Vice President of Research & Commercialization (see 18.4(e)). If the employee claims the Invention resulted from Independent Inventive Effort(s), then as part of the disclosure, the employee shall provide sufficient documentation to substantiate the claim.

b. Upon receipt of written notice from the Vice President of Research & Commercialization confirming the University's decision not to assert a University interest in an Invention resulting from unauthorized Outside Activity, the employee shall have the right to determine the disposition of such Invention. However, the employee and the Vice President of Research & Commercialization may agree that a patent for such Invention will be pursued by the University; in that event, the employee and University shall share in the proceeds of any Invention as provided by this Article any applicable University policies or procedures, including applicable University of Central Florida Research Foundation ("UCFRF") Guidelines and Procedures

for Distribution of Funds or in such other manner as the employee and the Vice President of Research & Commercialization may agree.

(e) Disclosure/University Review. Employees are required to disclose all Inventions owned by the University and all Inventions resulting from any Outside Activity within the field or discipline of the inventing employee. It is the policy of the University that, in general, research results should be publishable; publication of such results in appropriate venues is encouraged. However, if the publication of research results may reveal an Invention in which the University has an interest, employees should seek advice on how and when to publish the results in order that potential patent rights for the Invention are not compromised. That is, upon the making of an Invention and prior to any publication or public disclosure, employees shall promptly and fully disclose to the Vice President of Research & Commercialization any Invention described in 18.4(b). Any delay in publication resulting from seeking such advice shall be minimized, but in any event shall not exceed 120 days from the date of presentation of the proposed publication.

(1) The disclosure shall be made on the forms and according to procedures prescribed by the Vice President of Research & Commercialization. At a minimum the disclosure shall: (1) identify each employee, (2) provide a brief description of the Invention, and (3) identify and summarize the research project including the participants and applicable funding sources

(2) The Vice President for Research & Commercialization shall conduct an investigation to assess the patentability and marketability, as well as the respective equities of the employee and the University in the Invention, and to determine the extent to which the University should be involved in its protection, development, and promotion.

(3) The Vice President for Research and Commercialization shall inform the employee of the University's decision regarding the University's interest in the Invention within a reasonable time, not to exceed 120 days from the date of the disclosure.

(4) In the event the University elects to obtain a Patent, register a Trademark or a Copyright, or to formally define a Trade Secret to protect the University's rights in the Invention, employees will execute any and all necessary documents to affirm, publicly formalize, and record the transfer of all rights to the University or to UCFRF. UCFRF is required to comply with the same policies and procedures regarding allocation of proceeds/royalties as the University.

(5) In the event the University asserts its rights in the Invention, all costs and expense of patenting, developing, and marketing the

Invention and related activities, including those which may lead to active licensing of the Invention, shall be paid by the University.

(6) The division, between the University and the employee, of proceeds generated by the licensing or assignment of an Invention shall be negotiated and reflected in a written contract between the University and the employee and/or as set forth in the University's policy on copyrights and patents, including the applicable UCFRF Guidelines. All such agreements shall comport with and satisfy any preexisting commitments to outside sponsoring contractors.

(7) The employee shall not commit any act that would tend to defeat the University's interest in the matter, and the University shall take any necessary steps to protect such interest.

(f) Release of Rights.

(1) In the event a sponsored research contractor has been offered the option to apply for the patent to an Invention or other rights in an Invention, the University will obtain the contractor's decision regarding the exercise of such rights within 120 days, or within the time provided in the sponsored research agreement.

(2) Prior to making a patent application, at any stage of the patent process, or in the commercial application of an Invention, if the University has not otherwise assigned to a third party the right to pursue its interests, the president or president's representative may elect to waive the University's rights to the patent, or withdraw from further involvement in the protection or commercial application of the Invention. At the request of the employee in such case, the University shall transfer the Invention rights to the employee. The Invention shall be the employee's property and any costs already incurred by the University or on its behalf shall not be assessed against the employee.

(3) All assignments or releases of Inventions, including patent rights, by the president or president's representative to the employee shall contain the provision that such Invention, if patented by the employee, shall be available royalty-free for governmental purposes of the State of Florida and research or instructional purposes of the University, unless otherwise agreed in writing by the University.

(g) University Policy.

(1) The University shall have a policy addressing the division of proceeds between the employee and the University.

(2) Such policy may be the subject of consultation meetings pursuant to Article 2.