

FLORIDA A&M UNIVERSITY BOARD OF TRUSTEES



NOTICE OF PROPOSED NEW REGULATION

DATE: January 29, 2009

REGULATION CHAPTER NO.: Chapter10

REGULATION CHAPTER TITLE: Personnel

REGULATION TITLE AND NUMBER: Works and Inventions (10.142)

SUMMARY OF REGULATION: This new regulation is 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**



10.142 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, F.S., authorizes the University to establish rules and procedures regarding patents, copyrights, and trademarks. This regulation and the procedures stated herein are supplemented by the terms of the FAMU BOT/UFF Collective Bargaining Agreement for employees who are members of the collective bargaining agreement.

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

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

(b) Student Creator 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.

(c) 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.

(d) 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.

(e) Intellectual Property includes all works and inventions.

(f) 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.

(g) **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.

(h) **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.

(i) **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.

(j) **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 work which is made in the course of independent efforts is the property of the creator. If the work is a university-supported work, 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 disclose to the work to the President or the President’s designee with an outline of the project and the conditions under which the work was done. Within 60 days after receiving such report, the President or President’s designee will inform the creator whether the University seeks an interest in the work, and a written contract shall thereafter be entered into consistent with this regulation and 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 creator 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.

(5) **Inventions.**

(a) University personnel and Student Creators shall disclose to the University any inventions made or discovered by them promptly. 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.

(b) All discoveries or 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.

(c) 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 Florida Agricultural & Mechanical University and the creator shall share in the proceeds there from, subject to pre-existing commitments to outside sponsoring agencies.

(d) Although University personnel or student 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.

(e) **Reporting Procedures** – All University personnel and students shall report to the President or President's designee the nature of the 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 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 invention, and determine its importance and the extent to which the University should be involved in its protection, development, and promotion. The division of proceeds 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 employee, 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.

(f) A decision as to whether the University will apply for a patent 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 patent, the University will use its good offices in an effort to obtain such a decision within 120 days. At any stage of developing the patent application, or while in the process of securing a patent and if it has not otherwise been assigned to a third party the right to pursue its interests, the University may withdraw and shall return the patent rights to the creator, in which case the patent 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 patent rights by the University to the creator shall contain the

provision that such invention, if patented by the creator, shall be available royalty-free for use by the State of Florida and the United States Government.

(6) **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, will be distributed according to rules and procedures established by the President or President's designee.

(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 his/her 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.

(7) **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. Law Implemented Article IX, Florida Constitution, Board of Governors Resolution Adopted January 7, 2003, Florida Statutes History-New -08.