COPYRIGHTS, PROTECTABLE DISCOVERIES AND OTHER INTELLECTUAL PROPERTY RIGHTS

PREAMBLE: This section outlines UI policy concerning copyrights, as they arise from university research. Particularly this section discusses the assignment of ownership to such copyrights. This section was part of the 1979 Handbook but was revised in a significant way 1) in July of 1992 to reflect changes in applicable federal law, 2) in January of 1995 by the addition of subsection C-5 to reflect the change in the Regents’ intellectual property and conflict of interest rule (former IDAPA 08.01.09.101.03c), and 3) in 2007 to update terminology and add clarity to the rights and obligations of the University and of its employees and students in dealing with intellectual property, and in 2008 edited to reflect the restructuring of technology transfer functions from Idaho Research Foundation to the Office of Technology Transfer. In 2009 revisions were made to B-2 to comply with federal law. Unless otherwise noted, the text is as of July 1996. *This policy was revised in November 2015 for consistency with the revised intellectual property policy of the Board of Regents of the University of Idaho.* For more information, contact the Research Office (208-885-6651). [ed. 7-98, rev. 2-07, 4-08, 7-0909, 03-15]

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A. INTRODUCTION. The UI encourages the creation of scholarly works as an integral part of its mission. UI participation in the development, marketing, and dissemination of educational materials has as its aim the improvement of the quality, effectiveness, and efficiency of student learning and of faculty and staff development. The UI recognizes its obligation to transfer technology and useful discoveries to society. With respect to all types of intellectual property, the rights and obligations of UI, its employees and students and other third parties shall be governed by this policy. To the extent permitted by this policy, individuals may enter into contracts with UI to address intellectual property, in which case the contract terms shall control, provided that the contract was entered into in a manner consistent with this policy.

A-1. DEFINITIONS. For purposes of this Section 5300 and Section 5400, the following terms shall have the following meanings:

a. “electronic” shall mean relating to technology having electrical, digital, magnetic, wireless, optical, electromagnetic, or similar capabilities.
b. “written” or “in writing” shall include information created, generated, sent, communicated, received, or stored by electronic means, including without limitation email, telecopy, and facsimile transmissions.
c. “natural person or persons” means natural person or persons involved in the creation or development of intellectual property.
d. “designated agent” means the person or entity acting on behalf of the UI, within the scope of and under authorization through a written agreement between the person or entity and UI, to protect, commercialize, otherwise transfer rights in intellectual property subject to this policy and to, as authorized by the UI, to enforce rights in such intellectual property. A designated agent of the University may include, by way of example and not limitation, a UI-affiliated foundation approved by the Regents of the University of Idaho and acting under an operating agreement between UI and the foundation.
B. COPYRIGHTS. UI participation in the development of copyrightable works raises questions concerning the ownership and use of materials in which UI has become an active and intentional partner through substantial investment of resources. This policy is established to clarify the rights of the natural person or persons and the UI regarding ownership and use of copyrightable materials in the absence of a valid written agreement between the natural person or persons and UI. The UI acknowledges the right of faculty and staff members and students to prepare and publish certain materials that are copyrightable in the name of the natural person or persons and that may generate royalty income for the natural person or persons. (In this policy, “the natural person or persons” is to be construed broadly as including producers of creative works in the arts and sciences and creators of literary or scholarly writing.)

B-1. Coverage. The types of materials to which this policy applies include:

a. Study guides, tests, syllabi, bibliographies, texts, books, and articles.

b. Films, filmstrips, photographs, slides, charts, transparencies, illustrations, and other visual aids.

c. Programmed instructional materials.

d. Audio and video recordings.

e. Simultaneously recorded live audio and video broadcasts.

f. Dramatic, choreographic, and musical compositions.

g. Pictorial, graphic, and sculptural works.

h. Computer software, including computer programs, procedural design documents, program documents, and databases as defined below: [ed. 7-00]

(1) “Computer program” means a set of instructions that direct a computer to perform a sequence of tasks.

(2) “Procedural design document” refers to material that describes the procedural steps involved in the creation of a computer program.

(3) “Program document” refers to material created for the purpose of aiding the use, maintenance, or other interaction with a computer program.

(4) “Data base” means a collection of data elements grouped together in an accessible format.

i. Other copyrightable materials, including materials generated in the production of any of the above works.

B-2. Assignment of Ownership. Faculty staff members, UI employees and students retain all rights in the copyrightable materials they create except in the cases of “UI-Sponsored Materials” as defined in Subsection B-2-b below, materials subject to grant of a non-exclusive license to UI for public access as described in Subsection B-2-c below, materials covered by a Grant or Contract as discussed in Subsection E below, and materials covered by a valid written agreement between the natural person or persons and the UI as discussed in Subsection B-5 below. Faculty members, staff members, and students shall, consistent with Subsection G, assign rights in copyrightable materials claimed by UI under the above-identified exceptions and shall co-operate with reasonable requests from UI for the creation of any documents and records needed to vest and memorialize UI’s rights, if any. [rev. 7-09]

a. Retention of Rights by University Faculty. Except as otherwise provided in Subsection B-2-b and B-2-e2, above, the natural person or persons retain the rights to: (1) copyrightable works prepared while on sabbatical leave; (2) course materials, study guides, and similar materials prepared by University Faculty

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in the furtherance of their instructional responsibilities at UI. See FSH 1565 D-G; and (3) works prepared by University Faculty as part of the general obligation to produce scholarly or other creative works of the natural person or persons, such as, but not limited to, articles, books, musical compositions, and works of art. See FSH 1565 C-2. [rev. 7-09]

b. UI-Sponsored Materials. Materials are “UI-Sponsored Materials” within the meaning of this policy, and shall be and are assigned to UI consistent with Subsection G, if the natural person or persons: (1) was commissioned specifically prepared the work as part of his or her employment duties at UI, excluding those works identified in B-2-a; (2) was specially ordered or commissioned in writing by UI or one of its distinct units to develop the material as part of his or her employment duties and the writing states that the resulting works would be considered “UI Sponsored”; (2) received extra pay from UI to prepare the specific materials pursuant to a valid written agreement providing that the extra pay is consideration for the preparation of the specific materials; (4) received release time from regular duties, not including sabbatical leave, to produce the specific materials; or (4) made “substantial use” of UI resources in the creation or development of the specific materials, provided however that the use of UI resources regularly and customarily openly available to him/her as part of his/her regular employment or as part of his/her regular academic enterprise, the public shall not be considered “substantial use” of UI resources. Works identified in Section B-2-a of this policy shall not be considered, even if they otherwise fall within the definition of UI-Sponsored Materials, unless there is a valid written agreement between the University and the Faculty member providing for University ownership of specific work(s) or such disposition is contrary to the requirements of a sponsored program award. See Section E., below.

c. University Non-exclusive License for Public Access. In order to permit UI to comply with public access mandates established by federal law or federal agency or university policy (e.g. the National Institutes of Health Public Access Policy, Division G, Title II, Section 218 of PL 110-161 [Consolidated Appropriations Act, 2008]) and related terms and conditions of research agreements, faculty, staff, employees and students accepting research grants or contracts from, and conducting research from United States federal agencies shall hereby grant UI an irrevocable, non-exclusive, non-transferable, non-commercial, royalty-free license in copyrightable materials produced as a result of such research, such license to be used solely to comply with public access mandates. This grant of non-exclusive license is deemed by UI to be a special arrangement for federal grants and contracts, per Subsection E below, and is not subject to the disposition of rights described in B-2-b or to negotiation under Section B-5 below. [add. 7-09]

B-3. Registration of Copyrightable Materials. Absent a valid written agreement otherwise, UI Sponsored Materials are to be registered in the name of the Regents of the University of Idaho or its’ assignee. UI, through the provost or is his or her designee, has the right to file registrations of UI Sponsored copyrightable works. Additionally, UI, through the provost or the provost’s designee, may market, protect, transfer, convey, license, or otherwise derive income from University-Sponsored Materials. The provost, or designee, shall undertake evaluation, protection, transfer, and commercialization of UI Sponsored Materials consistent with this policy and the policies of the Board of Regents of the University of Idaho, including but not limited to Idaho State Board of Education Policy Section V. Financial Affairs, Subsection M. Intellectual Property and the related Idaho State Board of Education Institution Technology Licensing Guidelines. In light of the university’s educational mission and its role in the creation of the copyrightable materials, when entering into agreements to transfer, convey, or license the copyrightable works, the university may retain an irrevocable, non-exclusive, non-transferable, royalty-free license in University-Sponsored Materials.

B-4. Royalties and Income.

a. Out of the gross receipts from royalties and other income from sale or rental licensing of UI Sponsored Materials, the UI, college, department, other unit, or UI’s designated agent may recover reasonable expenses that it incurred in the development, marketing, or dissemination of the materials.
b. Absent a valid written agreement to the contrary, the net proceeds are distributed as follows: 40 percent to the natural person or persons, 40 percent to UI or its designated agent, and 20 percent to the ‘college or service unit of the natural person or persons. In the event that any UI Sponsored Material is a jointly authored work, the portion of the net proceeds allocated to the natural person or persons, 40 percent, shall be divided among the original authors of the UI Sponsored Material and the portion of the net proceeds allocated to the college or service unit of the natural person or persons, 20 percent, shall be divided among the appropriate colleges and/or service units. At least half of the share allocated to the college or other unit is given to the department of the natural person or persons for use in furtherance of its goals.

c. UI retains a right to royalty-free internal use of any materials designated UI Sponsored under this policy. Allocation and distribution of any royalties or other income from a jointly authored work constituting UI Sponsored Material and to which ownership vests in UI and another third party shall be made in accordance with a written agreement between UI and the third party. UI’s portion of royalties or other income distributed to UI pursuant to such an agreement shall be distributed within UI following the schedule set forth in Section B-4(b), unless subject to a prior agreement between UI and the UI original author(s) of such works.

B-5. Written Agreements.

a. The provost, or designee, represents UI in negotiating agreements with the natural person or persons pursuant to this policy. The natural person or persons who authored the copyrightable material may negotiate with the provost and arrive at a mutually agreeable contract. The provost consults with the dean or departmental administrator of the department of the natural person or persons in drafting these agreements. (For purposes of this policy, “dean” includes persons with equivalent administrative capacities.)

b. Valid written agreements concerning copyright ownership, use of copyrighted materials, and distribution of royalties and income from copyrightable works which are entered into by one or more natural person or persons and the provost, or designee, supersede the provisions of this Section 5300. To be valid, such agreements must (1) comply with the terms of any relevant Grants or Contracts as discussed in Subsection E below, (2) comply with the policies of the UI Board of Regents, and 3) comply with Idaho state and federal law. [rev. 4-08]

c. The provost, or designee, represents UI in negotiating and exercising agreements with third parties with respect to the transfer and/or commercialization of UI Sponsored Materials.

B-6. Use of UI-Sponsored Materials. Use of UI Sponsored Materials under this policy is subject to the following conditions:

a. Internal Use. Internal use is use by anyone employed by UI, or attending the UI as a student, while acting within the scope of his or her employ or academic enterprise, or any agent of UI acting within the scope of his or her agency, either directly or through a grant or contract, or by any UI unit. Internal use of UI Sponsored Materials for the same general purpose for which they were developed, and revision of such materials, do not require the prior approval or notification of any of the natural person or persons. However, for as long as any natural person or persons involved in the creation or development of UI Sponsored Materials remains a UI employee or student, such natural person or persons may, in a professionally appropriate manner, propose revisions of the material.

b. External Use. External use is any use other than that defined in Subsection B-6-a. above. Licensing or sale of UI Sponsored Materials for external use must be preceded by a valid written agreement between the natural person or persons and UI or the UI’s designated agent specifying the conditions of use, and including provisions concerning updating or revision of the materials.

B-7. Protection.
a. Allegations of unauthorized use or copyright infringement of UI Sponsored Materials should be made to the Intellectual Property Committee for investigation. The committee will recommend appropriate action to the provost.

b. If such action is initiated by UI alone or in concert with the natural person or persons, the costs are borne by UI or UI’s agent. Proceeds from the action in excess of costs are shared as provided in Subsection B-4-b.

c. If the natural person or persons involved in the creation or development of the allegedly infringed intellectual property desires to institute a suit and UI decides not to act, UI will co-operate either by assigning to the natural person or persons such rights as are necessary for the natural person or persons to pursue redress or by some other reasonable method acceptable to UI. The costs of the suit will be born by the natural person or persons desiring to sue, who will also obtain any monetary relief obtained from the alleged infringer due to the prosecution of the suit.

B-8. Liability. When either UI or the natural person or persons involved in the creation or development of materials copyrighted by UI or its assignee is alleged to have violated personal or property rights, UI or its designated agent assumes responsibility for the defense against such allegation and the satisfaction of any judgment rendered against UI or the natural person or persons except insofar as liability of governmental entities is limited by Idaho Code 6-903 as currently written or later amended. Defense of claims against UI employees arising from creation, development or use will be governed by the Idaho Tort Claims Act.

B-9. Waiver. Any person involved in the development of copyrightable materials governed by Section 5300 B waives any claim that otherwise legal use of the material by UI, its agents, employees, or distinct units, creates legal liability by UI, its agents, employees, or distinct units on any theory of indirect liability for allegedly infringing actions of third parties. [ed. 4-08]

C. PROTECTABLE DISCOVERIES. “Protectable Discoveries,” for purposes of this Section 5300 is defined to include anything which might be protected by utility patent, plant patent, design patent, plant variety protection certificate, maskwork, or trade secret. All Protectable Discoveries made by UI employees or students at any of its facilities in the course of programs carried on by UI or made by persons in the course of working on such programs or projects under contracts or agreements with UI belong to UI. The natural person or persons involved in the creation or development of such Protectable Discoveries shall and do(s) hereby assign to UI, as required by Subsection G., all such (1) Protectable Discoveries, (2) applications for legal protection of such Protectable Discoveries, and (3) utility patents, plant patents, design patents, and plant variety protection certificates resulting from such Protectable Discoveries. Absent a valid written agreement to the contrary, any Protectable Discoveries made by UI employees, students, or such other natural person or persons identified above with the use of facilities (other than library resources, normal office use, incidental use of the UI internet network consistent with UI internet use policy, and other facilities for which the person has paid use fees those resources openly available to the public) owned by UI or made available to it for project or research purposes are deemed to have been made in the course of working on a research program or project of UI.

C-1. Ownership by Other Than UI. A Protectable Discovery made conceived and reduced to practice by a natural person or persons wholly on his or her own time outside of his or her duties at UI and without the use of UI facilities (other than library resources, normal office use, incidental use of the UI internet network consistent with UI internet use policy, and other facilities for which the person has paid use fees those resources openly available to the public) belongs to that natural person or persons, even though it falls within the field of competence relating to the person’s UI position. This provision also allows any Protectable Discovery made by a natural person or persons in the course of private consulting services carried out by the person in conformance with the UI’s policy on professional consulting and additional workload [see 3260] to be assigned to the consulting sponsor.
C-2. UI Processes. All Protectable Discoveries made by a natural person or persons in the course of working on a UI research program or project must be submitted to the Office of Technology Transfer (OTT). If a Protectable Discovery is accepted by OTT for development, management, marketing, licensing, or assignment in any manner for the purposes of this policy, OTT must ensure that such property is conveyed, assigned, or transferred to UI. OTT shall have full power to manage such rights and to enter into contracts and licenses concerning such rights, including the right to join in agreements with other nonprofit intellectual property-management entities. At its discretion, UI shall, through OTT, initiate and control the prosecution of patents on or otherwise secure the legal protection of Protectable Discoveries subject to assignment to UI under this policy. OTT shall be responsible for financing associated with such Protectable Discoveries, including but not limited to the payment of legal fees associated with the prosecution and/or protection of such Protectable Discoveries. In those circumstances in which OTT decides to seek legal protection for Protectable Discoveries, OTT shall provide direction to and shall be responsible for payment of legal counsel engaged by UI. OTT may, however, enter into alternate arrangements for legal protection of Protectable Discoveries by third parties, through written agreement with such third parties. OTT shall undertake protection and commercialization of Protectable Discoveries consistent with this policy and the policies of the Board of Regents of the University of Idaho, including but not limited to Idaho State Board of Education Policy Section V. Financial Affairs, Subsection M. Intellectual Property and the related Idaho State Board of Education Institution Technology Licensing Guidelines. [rev. 7-97, 7-06, 4-08]

a. Upon submission of intellectual property to OTT, OTT must make a formal written decision to pursue commercialization for that property within three months. If OTT does not file for protection of the intellectual property within eighteen months of the date the disclosure was submitted, the rights shall be evaluated for return to the inventors. If OTT submits a provisional patent application for intellectual property protection, a “full” and non-provisional patent application must be submitted within nine months of the date of the submission of the provisional patent. [add. 7-97; ed. 7-98, rev. 4-08]

b. The OTT shall submit semi-annual reports, as long as UI owns the property, to both the inventor/natural person or persons of and to the college or center where the inventor(s) are located. The report will include on 1) the status of the application until such time that protection is granted, 2) the marketing activities for the property being serviced, and 3) an accounting for funds received from the property. In the event that OTT has been unsuccessful in transferring a property or filing a patent application within three years after its first acceptance, OTT must notify the college or center and inventor(s) in writing. [add. 7-97, rev. 7-06, 4-08]

c. If OTT determines not to pursue commercialization of a Protectable Discovery, the University may elect, subject to controlling federal law, including but not limited to 37 CFR 401 (“Bayh-Dole”), to reconvey, assign and transfer the Protectable Discovery to the natural person or persons (inventors) involved in the creation of the intellectual property. [rev. 4-08]

d. OTT may, in furtherance of the dissemination, use, or commercialization of UI Protectable Discoveries, engage in a range of activities including but not limited to: granting exclusive or non-exclusive licenses; assigning rights in Protectable Discoveries; entering into contracts with third parties to provide controlled access to information concerning Protectable Discoveries, materials closely related to Protectable Discoveries, or Protectable Discoveries; negotiating for acceptance of an equity interest by the Idaho Research Foundation in a company licensing a Protectable Discovery; offering guidance with respect to business planning; or making University facilities available for further development of licensed UI Protectable Discoveries or business incubation, subject to contract.

C-3. Proceeds. OTT will make provision to share the net proceeds, management, and licensing of any Protectable Discovery as follows: [ed. 4-08]

a. Legal and development expenses incurred by OTT will be reimbursed first out of the net proceeds, prior to any distributions. [rev. 4-08]
b. Absent a valid written agreement to the contrary, the net proceeds in excess of legal and development expenses shall be distributed as follows: 40 percent to the natural person or persons; 40 percent to OTT; and 20 percent to the college or service unit of the natural person or persons. At least half of the share allocated to the college or other unit is given to the department of the natural person or persons for use in furthering its goals. [rev. 4-08]

C-4. Ownership Questions. Questions as to the ownership of a Protectable Discovery or division of proceeds between persons involved in development of such discoveries and departments are referred in the first instance to the Intellectual Property Dispute Committee. The disputes will be decided in accordance with Section 5300(D).

D. DISPUTE RESOLUTION. From time to time, disputes will inevitably occur concerning ownership of the intellectual property (copyrights and Protectable Discoveries) contemplated in this Section 5300. Resolution of such disputes shall be achieved by the following procedure:

D-1. Intellectual Property Dispute Committee. The Intellectual Property Dispute Committee (IPD Committee) shall be an Ad Hoc Committee formed when necessary by appointments made by the Provost, in consultation with the Chair of Faculty Council, Senate, and the President of the Graduate and Professional Student Association (GPSA). Normally the IPD Committee shall be composed of five faculty members and two graduate students. The Provost shall appoint the chair from among the faculty members. In the event the GPSA shall fail to appoint one or more student members, the IPD Committee may nonetheless be formed by the Provost and conduct business without the GPSA student representatives. [ed. 1-10]

D-2. Recommendation by the Intellectual Property Dispute Committee. The IPD Committee considers, investigates, and makes recommendations toward resolution of disputes concerning (1) ownership of copyrightable materials and Protectable Discoveries, and (2) allegations or unauthorized use or copyright infringement of UI Sponsored Materials. It reviews all relevant evidence submitted to it before making its recommendation to the provost. The IPD Committee’s recommendation is to be made no later than 60 days after receiving the matter for consideration. The IPD Committee’s recommendation is determined by a majority of all its members voting by secret ballot at a meeting at which over one-half its appointed members are present. No member may participate in any matter in which his or her ownership rights are being determined.

D-3. Decision by the Provost. After receiving the recommendation of the IPD Committee, the provost makes a decision concerning ownership or infringement. The provost’s decision is made no later than 30 days after receiving the IPD Committee’s recommendation. That decision is transmitted in writing to the natural person or persons and to his or her departmental administrator and dean.

D-4. Appeal of the Decision of the Provost. The decision of the Provost may be appealed to the President of the University. Further appeals shall be made as from any other decision of an administrative body under the laws of the State of Idaho in effect from time to time.

E. SPECIAL ARRANGEMENTS FOR FEDERAL, STATE, AND PRIVATE GRANTS. Nothing in this policy shall prevent UI from accepting research grants from, and conducting research for, agencies of the United States upon terms and conditions under applicable provisions of federal law or regulations that require a different disposition of rights in any form of intellectual property. Moreover, nothing herein shall prevent cooperative arrangements with other agencies of the state of Idaho for research. Where receipt of a grant in support of research from any nonprofit agency or group may be dependent upon acceptance of terms and conditions of the established intellectual property policy of the grantor that differ from those stated herein, UI may specifically authorize acceptance of such grant upon such terms and conditions. UI may also specifically authorize contractual arrangements with an industrial sponsor for different disposition of rights in any form of intellectual property resulting from its sponsored research. UI may assign and license intellectual property rights to any third party, regardless of whether that third party is a research sponsor.

F. RECORD-KEEPING. See Section 5500 for record-keeping procedures that are recommended in order to safeguard the property rights of UI or the faculty member in research and potentially patentable results.
G. PRESENT ASSIGNMENT OF RIGHTS IN INTELLECTUAL PROPERTY. All intellectual property to which UI claims ownership by this policy shall belong to UI, and UI employees, students, and other persons subject to this policy do hereby assign to UI all rights, including future rights, in intellectual property to which UI claims ownership by this policy or as otherwise required by policy of the UI Board of Regents, and in any related application for legal protection of such intellectual property. Any person assigning intellectual property to UI subject to this Section G. shall cooperate fully with UI in preserving, perfecting, and protecting legal rights associated with such assigned intellectual property. Such cooperation may include, but is not limited to the execution, of confirmatory assignment to the University of particular intellectual property.

[For form of employment agreement concerning patents, see 5400.]
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