1998


University of Rhode Island Faculty Senate

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UNIVERSITY OF RHODE ISLAND  
Kingston, Rhode Island  
FACULTY SENATE  
BILL  
Adopted by the Faculty Senate

TO: President Robert L. Carothers  
FROM: Chairperson of the Faculty Senate  


2. The original and two copies for your use are included.  

3. This BILL was adopted by vote of the Faculty Senate on April 9, 1998.  

4. After considering this bill, will you please indicate your approval or disapproval. Return the original or forward it to the Board of Governors, completing the appropriate endorsement below.  

5. In accordance with Section 10, paragraph 4 of the Senate’s By-Laws, this bill will become effective April 30, 1998, three weeks after Senate approval, unless: (1) specific dates for implementation are written into the bill; (2) you return it disapproved; (3) you forward it to the Board of Governors for their approval; or (4) the University Faculty petitions for a referendum. If the bill is forwarded to the Board of Governors, it will not become effective until approved by the Board.

April 10, 1998
(date)

Leland Jackson  
Chairperson of the Faculty Senate

ENDORSEMENT

TO: Chairperson of the Faculty Senate

FROM: President of the University

Returned.

a. Approved     .

b. Approved subject to final approval by Board of Governors    .

c. Disapproved   .

(date)

President

Form revised 9/91
UNIVERSITY OF RHODE ISLAND
Kingston, Rhode Island

FACULTY SENATE

REPORT OF THE COUNCIL FOR RESEARCH
REVISED INTELLECTUAL PROPERTY POLICY
March 25, 1998
Amended by the Faculty Senate on April 9, 1998

BACKGROUND

Last semester the Council for Research recommended approval by the Faculty Senate of a revised Intellectual Property Policy (dated 11/18/97). This proposed Intellectual Property Policy appeared on pages 25-36 of the Agenda for the December 11, 1997 Faculty Senate Meeting and was discussed at that meeting. Following discussion, the Faculty Senate voted to return the report to committee and a number of suggestions and instructions were provided by members of the body.

Since the December meeting, Dr. Charles Turtle, representing the Research Office, has met with a number of groups and individuals, including Senators, representatives of the URI AAUP, the Faculty Senate Executive Committee and legal advisors. The following revised proposal has taken into account many of the suggestions and the policy represents intellectual property case law in greater detail than the previous proposal.

The major change, in structure, from the previous proposal is the clear separation of copyright from inventions. In addition, illustrative cases are provided to clarify possible situations and flow-charts have been revised as well. For example, a new Figure 1a and accompanying examples (A-F) are based upon copyright law.

RECOMMENDATION

The following revised Intellectual Property Policy is presented to the Faculty Senate for approval. Proposed new sections of the UNIVERSITY MANUAL replace existing sections 10.40.10 through 10.46.11.

The policy statement is structured as follows:

10.40.10 to 10.40.27 Preface and General Policy
10.41.10 to 10.41.18 Policy for Inventions, Trademarks, Trade Secrets
10.42.10 to 10.42.18 Policy for Copyright
10.43.10 to 10.43.15 Commercialization and Revenue Distribution
10.44.10 Replacement statement

10.40.10 Intellectual Property Policy. Preface. This section of the University Manual, presented in Sections 10.40.10 through 10.44.10 (the "policy"), defines policy and procedures for dealing with intellectual property generated by University personnel or offered to the University by alumni or friends. All University personnel are subject to the provisions of this policy. The University recognizes the importance of the protection gained by patent, copyright, trademark, and trade secret laws. Such protection is critical if innovative research and scholarly findings and associated intellectual property, which are often fortuitous by-products of basic research, are to be made available for broad utilization and commercial application. To protect the rights of the creator, the University, and the public, and to be in compliance with Federal regulations, the policy defines the types of intellectual property, the steps to follow for disclosure, the
methods of determining ownership, and the procedures for obtaining legal protection of intellectual property. This policy also summarizes the role of the URI Foundation and the mechanisms for commercialization and presents methods of safeguarding the royalty income, a potentially important source of revenue for both the creator of the intellectual property and the University. The University and the URI Foundation will make its best effort to prevent the unauthorized disclosure by the University or the URI Foundation or any of their agents or employees of any intellectual property submitted by a creator to either the University or the URI Foundation pursuant to this policy. Furthermore, the University and the URI Foundation will make their best efforts to protect and promote all intellectual property which it agrees to commercialize pursuant to this policy.

10.40.11 Coverage of Personnel. The policy applies to all University employees including, but not limited to, faculty and staff, predoctoral and postdoctoral fellows, and students (including graduate assistants in any combination of study, research, and teaching) who are employed by or receive financial support from the University. It also applies to all students not employed or not receiving financial support, but who are using University resources, and, unless otherwise negotiated, official University guests using University resources are also governed by this policy. Hereinafter, all of the above shall be referred to as University personnel.

10.40.12 Rhode Island Board of Governors for Higher Education. Section 1.10.10 describes the establishment of the Rhode Island Board of Governors for Higher Education, hereinafter referred to as the Board of Governors.

10.40.13 Responsible URI Organization. The University shall be represented by an Intellectual Property Committee (IPC), duly authorized by the President of the University of Rhode Island. All review of intellectual property governed under the terms of this policy, as well as all decisions regarding the protection of said intellectual property, shall be the responsibility of this Committee. This Committee shall report to the President of the University. (See Sections 5.85.10-11 for charge and membership.) Administrative responsibility for this policy and these procedures shall rest with the Vice Provost for Graduate Studies, Research and Outreach, hereinafter referred to as the Vice Provost for Research. The University of Rhode Island Foundation is responsible for management of patents and other intellectual property owned by the Board of Governors.

10.40.14 Intellectual Property. Intellectual property is defined as original ideas, objects, data, applications, processes and expressions thereof. Expressions could include written material, spoken description, models, sketches, musical scores, sculptures, software code, and paintings. This includes, but is not limited to, inventions, goods, materials, instruments, equipment, biological organisms, chemical compositions, mask works, computer software, graphic, literary and musical works, and trademarks. The intellectual property may be in tangible or intangible form. Intellectual property in tangible form may be physically distributed. Intellectual property may be protected by one or more of the following: patent, copyright, trade secret, trademark, contract, or agreement.

10.40.15 Coverage of Items. The policy applies to all intellectual property discovered, made, or developed by University personnel using any University resources whether or not said intellectual property can be protected by applicable statute, law, or regulation.

10.40.16 Computer Software. "Computer software" is defined in this policy to include any and all computer "instructions" written or developed as a code for use with a computer or computer component. This includes, but is not limited to, data bases, operating systems, information packages, and computer applications programs. While software is often thought of as copyright material, it can also include inventions, trademarks, or trade secrets.

10.40.17 Creator. The term creator shall be used in this policy to include inventors, authors of copyrightable material, designers of trademarks, and creators of all other types of intellectual property.
10.40.18 Determination of Ownership. Figure 1 is a decision tree for determining assignment of ownership of intellectual property. The Board of Governors shall own and have all rights to any inventions, trademarks, trade secrets, and copyrights discovered, created, or developed by University personnel using University time, resources, facilities, or equipment, except as otherwise provided in this policy. This shall include, but not be limited to, inventions that are (a) developed in the course of or pursuant to a sponsored project or other agreement, or (b) developed under a written agreement with URI and with funds provided by the University, or (c) developed using University time, resources, facilities, or equipment, or (d) offered to the University by any creator and accepted by the Board of Governors, or (e) copyrights in copyright material created as a work-for-hire or other material as indicated in Figure 1a. In cases of disputed ownership, the parties will work together to resolve any issues germane to ownership determination, and, if the dispute is not resolved, Section 10.40.26 shall prevail. To the extent that an invention, trademark, trade secret, or copyright which is to be owned by the Board of Governors pursuant to this Intellectual Property Policy stands in the name of the creator, the creator shall assign and transfer such invention and all right, title and interest thereto to the Board of Governors, and the creator will further agree to execute any other documentation that the Board of Governors, or its designee, may deem advisable or necessary for the assignment and transfer of such rights to the Board of Governors.

10.40.19 Outside Consultation. The Research Office may provide University personnel with guidance regarding protection from liability and protection of their intellectual property rights and the University's rights when the University personnel are acting as private consultants. University personnel involved in outside consultation cannot use the University name or logo and are bound by the University agreements with bargaining units in all consultant activities. Any agreement signed with a company cannot abridge or compromise Board of Governor's ownership of other intellectual property developed by University personnel. For example, rights to past and future work generated by University personnel covered in this policy cannot be restricted nor affected by the outside consultancy agreement or arrangement or be subject to any claims of the employer of university person acting as a private consultant.

10.40.20 Agreements with Outside Parties. The University and University personnel shall not enter into any agreement with any outside party which fails to safeguard the rights of the University community and the public interest as outlined in this policy. All valid research and development agreements (contracts, grants, etc.) with any outside sponsor shall be signed and approved by a designated University official authorized by the Board of Governors. No agreement in violation of this provision shall be binding on the University without its consent. University personnel assigned to work under such agreement will abide by University policies, procedures, and agreements. A copy of this policy shall be made available to all outside sponsors.

10.40.21 Intellectual Property Ceded to the University. The University may accept ownership of intellectual property offered to the Board of Governors by persons or groups outside the University and from University personnel who hold the rights to intellectual property. In this case, the referral, review, and decision process outlined in Section 10.40.22 and 10.40.24 shall apply.

10.40.22 Execution of Intellectual Property Procedures. The Intellectual Property Committee (see Section 5.85.10-11) (occasionally referred to herein as the “IPC”) shall represent the University and work with the Research Office, the URI Foundation, and University personnel in executing this policy. All meetings and deliberations concerning intellectual property are confidential and due diligence of all IPC members and staff will be exercised to protect the intellectual property.

10.40.23 Procedures for Disclosing Intellectual Property. All University personnel who generate intellectual property must complete and sign a URI Intellectual Property Disclosure Statement form regarding any intellectual property owned or to be owned by the Board of Governors, as indicated by this policy. The form must be submitted to the IPC for review, evaluation, and action. Such disclosure should be filed immediately following the discovery, development, or creation of the intellectual property so that protection is not jeopardized. If the creator is in
doubt as to ownership, he or she shall make the disclosure and request the Intellectual Property Committee to determine the ownership rights. Failure to disclose or otherwise comply with any of the provisions of the policy shall create an inference of Board of Governor's ownership of the intellectual property. Upon submission of the disclosure statement to the Research Office, a personal presentation to the IPC will be scheduled.

10.40.24 Procedure for Dealing with Intellectual Property Offered to the University. Individuals who own the rights to intellectual property and wish to offer ownership to the University either as a gift or in return for help in commercializing the intellectual property will follow the same disclosure procedure given in Section 10.40.23. The IPC will decide within 90 days if they will accept or decline rights to the intellectual property for the Board of Governors. Upon acceptance, an agreement will be developed between the inventor(s), the IPC, and the URI Foundation for the allocation of protection and marketing costs and the division of licensing fees and royalties.

10.40.25 Intellectual Property Committee Review Procedure. After a personal presentation by the creator regarding the nature of an intellectual property to the IPC, the Committee shall advise the creator whether the Committee wishes the URI Foundation to take initial steps to evaluate, register, patent, commercialize, or otherwise protect the intellectual property. The URI Foundation may, for example, use the services of a qualified intellectual property management organization or other business organization which can aid the commercialization process. The Committee may decide to direct an attorney to apply for a patent or register a copyright or trademark. Agreement is sometimes reached with the creator or developers to work together in establishing a stronger relationship with one or more companies that may be interested in the intellectual property. In addition to the above, other approaches may also be taken as initial steps. A best effort attempt will be made to notify the creator of the action within 60 days of the presentation of the initial steps to be taken. Within 90 days after the initial steps have been completed, the IPC must take additional action which may include legal protection, commercialization, or return of the intellectual property to the creator. If all parties agree, this deadline may be extended. If the IPC decides not to register, patent, or protect a disclosed intellectual property, or if it fails to act as described within the 90-day deadline outlined here, all intellectual property rights and ownership rights to the intellectual property, except for the right of the University to a non-exclusive use of disclosed intellectual property and any other federal or legal obligations regarding that property, will pass to the creator, who will be responsible for protecting the ownership rights. If the creator is dissatisfied with the progress, he or she may request a hearing with the IPC to create a mutually acceptable plan for obtaining protection.

10.40.26 Procedure for Resolution of Disputes.

10.40.27 Right to Publish. Except as otherwise provided in this 10.40.27, nothing in this policy shall be construed as affecting the rights of University personnel to publish once disclosure has been completed. Protecting intellectual property may require a limited period of nondisclosure in order to secure certain rights. University personnel shall be required, as a condition of involvement in certain sponsored projects, to observe properly executed confidentiality and nondisclosure agreements regarding dealings with intellectual property. Further, the University will agree to limited and reasonable delays in publications upon recommendation of those faculty, students, and staff involved in projects requiring such delay or upon request of designated University officials acting on behalf of the IPC or in implementing the terms of agreements with outside sponsors.

Policy for Inventions, Trademarks, & Trade Secrets

Policy set forth in Sections 10.40.10 through 10.40.27 and Sections 10.43.10 through 10.43.15 also applies to inventions, trademarks, and trade secrets.
10.41.10 Invention. A broad definition of "invention" is "anything that is new." However, more specifically, an invention is: (1) a new idea for a product or device; (2) a new process, sequence, or methodology; or (3) a new use or application of a product, device, process, sequence, or methodology. An invention may also be an improvement of any of these three.

10.41.11 Inventor/Creator. To be the inventor or creator one must be responsible for the conception of the idea, the conception of a method for actualizing the idea, and be involved in its reduction to practice. Upon conception of an idea, the creator should record the idea in a hard bound notebook, date it, and have it witnessed by a knowledgeable but uninvolved party. This important document is key to protection. Work on the development without contributing to the conception, regardless of the skill level or amount of work, does not constitute an inventive contribution. Procedure for resolving disputed inventorship is given in section 10.40.26.

10.41.12 Trademark. A trademark is any word, name, symbol, or any combination thereof which identifies and distinguishes goods, including a unique product, from those manufactured or sold by others and which indicates the source of the goods such as the name of a company, even if the party owning the source is unknown, and which word, name, symbol, or any combination thereof is 1) used by a person or party or 2) the subject of an "intent-to-use" application for trademark registration by a person or party having a bona fide intention to use such word, name, symbol or any combination thereof in commerce.

10.41.13 Trade Secret. A trade secret is defined as any information, including but not limited to, a formula, pattern, compilation, computer software, data, device, method, technique, process, or application that: (1) derives independent economic value, actual or potential, from not being generally known to and not being readily ascertainable by proper means by other persons who can obtain economic value from its disclosure or use and (2) is the subject of efforts that are reasonable, under existing circumstances, to maintain its secrecy.

10.41.14 Protection as a Trade Secret. Intellectual property is sometimes classified as a trade secret and remains so indefinitely or until the protection process is completed. Public disclosure destroys trade secret status. In order to maintain trade secret status, the creators must request, and all parties involved in handling the trade secret material must agree, to not disclose.

10.41.15 Mask Works. A "mask work" is intellectual property developed for the purpose of fabricating printed circuit boards or integrated circuitry. This includes materials, hardware, and software developed specifically for the purpose of designing and manufacturing printed circuit boards or integrated circuitry. Mask works may involve inventions, trademarks, and trade secrets.

10.41.16 Ownership of Inventions, Trademarks, or Trade Secrets, Developed with Support of Outside Sponsors. Inventions, trademarks, or trade secrets developed exclusively by University personnel working under an agreement between the University and an outside sponsor, such as a federal or state agency or a private sector company, shall belong to the Board of Governors. The Federal Government has certain rights in invention made with government support under a grant awarded by a federal agency. There are state and federal laws which require the University to retain title to intellectual property developed under sponsorship with an outside organization but created by the University personnel. If the intellectual property is created jointly by University personnel and an employee(s) of the sponsor, it shall be owned jointly by the Board of Governors and the sponsor, unless the sponsor assigns ownership to the Board of Governors. Provisions for licenses are discussed in Section 10.43.

10.41.17 Thesis and Dissertation Invention, Trademark Ownership. If the thesis discloses an invention or a trademark or both, the ownership of such invention and/or trademark will be determined by this policy.

Policy for Copyright Material
Policy set forth in Sections 10.40.10 through 10.40.27 and Sections 10.43.10 through 10.43.15 also applies to copyright.

10.42.10 Copyright. "Copyright" is defined as the ownership right a party has in written material and other expressions of an idea or ideas. As used herein, "copyright material" means written material and other embodiments or expressions of an idea or ideas.

10.42.11 Author. The author or creator of a copyrightable work is the individual responsible for creation of the copyrightable material which may be recorded as an expression of an idea in writing, in computer software, a picture, a sculpture, a musical score, other tangible form, or otherwise as defined by law.

10.42.12 Mask Works. In some cases, mask works (as defined in 10.41.16) constitute copyright material.

10.42.13 Scope of Employment. For the purposes of this policy Scope of Employment is a term used in copyright law and is defined by the various examples associated with Figure 1a. It does not have the same meaning as does the term: normal expectations of faculty scholarship. Faculty expectations are defined in the URI AAUP/BOG collective bargaining agreement; other expectations are defined by other agreements between the BOG and other units. The term Scope of Employment is used herein for the purpose of determining ownership in this intellectual property policy.

10.42.14 Work-for-Hire. Work-for-Hire is copyrightable intellectual property, which is, for the purposes of this policy, a deliverable to the University, (a) prepared by an employee within the Scope of his or her Employment, or (b) produced as a result of a special order or commission by the University. Work created pursuant to a research agreement between the University and an outside party, either a private sector company or a governmental agency, is considered to be within the scope of employment. Lecture notes, articles, books, art and music works and other publications created by faculty members are not considered within the Scope of Employment for purposes of this policy unless there is a specific written agreement between the University and faculty member, which agreement provides that a specific publication will be considered a "work-for-hire." Work-for-hire shall belong to the Board of Governors under the circumstances described in Figure 1a and in the accompanying example cases.

10.42.15 Thesis and Dissertation Copyright Ownership. The rights in copyright for theses and dissertations produced as part of a University degree requirement shall belong to the student preparing the material. A student must, as a condition of the award of any degree, grant a royalty-free license or permission to the University and any outside sponsor, if appropriate, to reproduce, publicly distribute on a non-commercial basis, copies of student project reports, theses, or dissertations which would include any software developed as a part of the student project.

10.42.16 Ownership of Copyright Material -Developed with Support of Outside Sponsors. Copyright material developed exclusively by University personnel working under an agreement between the University and an outside sponsor, such as a federal or state agency or a private sector company, shall belong to the Board of Governors. There are state and federal laws which require the University to retain title to certain copyrights developed by university personnel under sponsorship with an outside organization. If the intellectual property is created jointly by University personnel and an employee(s) of the sponsor, it shall be owned jointly by the Board of Governors and the sponsor. Provisions for licenses are discussed in Section 10.43.

10.42.17 Ownership of Copyright Material Developed Under Agreement with the University and University Personnel. University personnel may enter into an agreement with the University, written and signed by the person, his or her supervisor, and the Provost, to spend a defined portion of his or her time and other University resources to create a copyrightable intellectual
property. The agreement must state that the work is a work-for-hire and that copyright
ownership shall belong to the Board of Governors.

10.42.18 Additional Provisions for Copyright Ownership. Rights to copyright ownership arising
from items such as scholarly papers, reports, books, and art and music works are further
described by and shall be determined in accordance with the flowchart in Figure 1a and its
associated case studies.

Commercialization of Intellectual Property.

10.43.10 University Development and Licensing. The University will make a reasonable and
good faith effort to commercialize all intellectual properties to which the University has
acquired rights. To this end the University recognizes the URI Foundation as the agent for the
Board of Governors in the commercialization of its intellectual property (see 10.43.15). All
activities with outside organizations, including companies, to license for use commercial
applications of any Board of Governors owned intellectual property, must be undertaken by or
with the explicit approval of the URI Foundation. The Executive Director of the URI
Foundation (or designee) may, in consultation with the Provost (or designee), use the services of
a qualified intellectual property management organization or any other business organization
which can aid the commercialization process. The objective of the commercialization activity is
to maximize the return to the creator and the University while making available to the public
the related processes and products at reasonable prices and of appropriate quality. If after two
years the creator is dissatisfied with or questions the development efforts, he/she may express
in writing such dissatisfaction to the Intellectual Property Committee. In such cases the
Intellectual Property Committee shall respond in writing within 120 days by (i) finding the
complaints to be without merit, (ii) by finding the complaint to have merit and assuring the
creator that corrective steps, or other recommended action, will be taken, or (iii) by
recommending return of all patent rights to the creator. If the Committee fails to act within 120
days from the date of the original filing of the complaint, legal rights to the invention shall pass
to the creator, except for a non-exclusive use and license for the University and any other
federal or legal obligations regarding that property.

10.43.11 Responsibility for Licensing. In accordance with the Board of Governors’ resolution
cited in Section 10.43.15, the URI Foundation, acting as the fiscal and licensing agent with the
assistance of the Provost (or designee), shall be responsible for obtaining legal protection for
marketing and for development of any intellectual property and for executing all agreements for
the subsequent use and/or licensing of any intellectual property owned by the Board of
Governors or included under the provisions of this policy. The URI Foundation is responsible
for initial cost which will be recovered from royalties and other payments. Upon written request
the URI Foundation may ask the University to assume these costs for a given project under the
condition that the URI Foundation will reimburse the University from royalties received from
said project.

10.43.12 Distribution of Income. Figure 2 illustrates the distribution of royalty income for
license agreements entered into in the past. Figure 3 illustrates the royalty income distribution
effective with this revised policy.

"Royalty Income" as used in this section shall mean all royalties and other payments (including,
but not limited to signing fees and infringement rewards, whether in cash or in kind), received
by the URI Foundation and derived directly from the marketing of the intellectual property
attributable to the creator, minus any and all legal, developmental, and marketing costs
incurred in connection with such intellectual property. In the past, the policy was as follows:
The creator(s) receives, on an annual basis, thirty-three and one-third percent (33 1/3%) of the
royalty income. A second third goes to the Dean of the Creator's college and the last third goes
to the University from which a 10% management charge is taken and the remainder is divided
as follows: 25% goes directly to the Provost to support research and 75% goes to the patent
endowment the interest of which is used to support research.
Under the new policy, illustrated in Figure 3, the distribution is as follows: one third goes to the Creator. A second one-third (33 1/3 per cent) of the royalty income will be used to support research in the various colleges and will be distributed by the Council of Deans and the Dean of the Creator's college. This amount will be divided, and 75% will go into the patent endowment, while the other 25% will go to the Dean of the creator's college. Of the 75% that goes into the patent endowment, 50% of the interest earned will go to the Council of Deans for expenditure on research in the colleges. Of the last thirty-three and one-third percent (33 1/3%) of the royalty income, ten percent (10%) of such amount shall be paid to the URI Foundation as a management fee. Twenty-five percent of this remainder will be dispersed annually by the Provost's Office to support research. The remaining 75 percent will be placed in a patent endowment. Each year the earned interest from the patent endowment will be spent in support of research (specific projects, facilities, equipment, travel, etc.) by the Provost and the Council of Deans, 50% going to each. Because of the critical nature of product development in protecting the intellectual property revenue stream, the Provost will commit up to 20 percent of its endowment income to development projects to reduce ideas to practice and enhance the commercial value of University intellectual property.

10.43.13 License Agreements with Research Sponsors. The University may grant to the sponsor(s) in any sponsored project agreement an exclusive license (with appropriate milestone and performance criteria) or non-exclusive license to the intellectual property resulting from that sponsored project. In cases of joint ownership, the outside sponsor shall have the right of first refusal to develop and/or produce and/or market a jointly owned intellectual property subject to appropriate milestone and performance criteria.

10.43.14 Determination of Shared Royalty Payments. In situations where the intellectual property is the product of joint creative or development effort, the IPC shall, upon consultation with the creators, determine an equitable division of any creator's share payable under 10.43.12 and 10.43.13.

10.43.15 State of Rhode Island Board of Governors for Higher Education Resolution* Regarding the Role of the URI Foundation in Patent Management. For the purpose of making research discoveries and helping support further research at the University of Rhode Island, the Board of Governors for Higher Education hereby designates the University of Rhode Island Foundation as its patent management arm and hereby appoints it as its agent to apply for, accept assignment of service, administer and market patents, patent protection rights and other forms of intellectual property, and to take steps to protect such rights. Revenue received from these efforts shall be distributed by the foundation in accordance with the approved patent and other intellectual property policies of the University. From the gross revenues the Foundation shall reimburse itself for all costs and expenses incidental thereto and from the University's share of the revenues shall deduct a management charge of 10 percent. From the balance of the University's share 25 percent shall be used primarily for research. The other 75 percent shall be used to create a permanent Foundation Endowment for the University from which the earned income shall be distributed to the University primarily for research. The Foundation shall report semi-annually to the Board of Governors for Higher Education. This appointment may be terminated at the discretion of the Board of Governors upon reasonable notice.

*Adopted January 21, 1982 (Approved previously by URI Foundation)

10.44.10 Replacement of Previous Policies. The above stated policy shall, upon the date of its adoption, supersede all previous intellectual property and patent policies of the University of Rhode Island and all other conflicting intellectual property and patent policy statements and resolutions.
Fig. 1 Decision Flow Chart for Determining Ownership of Intellectual Property

To accompany University Manual 1:44. Revised 1:44.

Copyrightable material is created by university personnel.

Was the work created in the performance of a project covered by a research agreement between the University *and* an outside party?

* This is the University, not the URI Foundation

Is work within Scope of Employment?

Yes

No

Was work ordered or commissioned by URI?

Yes

No

Is there a written agreement giving URI the ownership?

Yes

No

Ownership to creator

URI owns

Ownership to creator

Ownership will initially vest in the creator


In order to qualify as a written agreement, the agreement must be specific. That is, it must address the specific work for which it is intended. It is preferably a separate written and signed agreement covering the book or music score, for example. It can be a part of an agreement between the individual and the dean signed at the beginning of the semester, but the written agreement defined in this policy must then be a separate article of the deans agreement addressing the specific copyrightable work.

URIs right of ownership in employees work occurs automatically upon creation of work.

URI owns

Work-for-Hire

正义

URI owns

Work-for-Hire

URIs right of ownership in employees work occurs automatically upon creation of work.

The above nine do not require supervision.
Following are examples to illustrate the dynamics of how the first question in Figure 1a is answered:

a) Adams writes a book that is not related in any way to a research agreement. The work is not within the Scope of Employment and URI does not assign or commission Adams to write the book. The copyright of the book belongs to Adams.

b) Stephenson writes a book that is derived from research results accrued over time as she works on an NIH project under an agreement between the university and NIH. The book is a compilation of ideas expressed by Stephenson after her NIH assignment had terminated. Because the NIH grant had been terminated and because URI did not assign or commission the work, the copyright of the book is owned by Stephenson.

c) Nelson is budgeted to create software as part of a project under an agreement between the university and a private company. As a result, the software that Nelson creates is within the Scope of his Employment and is, therefore, work-for-hire for the university. Therefore, the software is not within the traditional types such as lecture notes, articles, or books excepted from the definition of work-for-hire in this policy. The copyright ownership to the software is owned by URI.

d) Milford creates a translation. The work was not created in the performance of a project covered by a research agreement between the University and an outside party. However, the work was commissioned by URI. There is no agreement declaring the work a work-for-hire nor is there a written transfer of ownership to URI. Consequently, Milford has copyright ownership.

e) Anderson is budgeted to create software as part of an NSF project under an agreement between the university and NSF. As a result, the software that Anderson creates is within the Scope of his Employment and is, therefore, work-for-hire. The software is not within the traditional types such as lecture notes, articles, or books excepted from the definition of work-for-hire in this policy. The copyright ownership to the software is owned by URI.

f) Gingras receives a gift through the URI Foundation to support his program. He writes a monograph on labor relations. There is no written agreement giving URI the ownership. Gingras owns the copyright to the monograph.
6. Jones, a computer buff on the University staff, is frustrated by what he perceives to be a lack of technical support from the computer department. He develops an instructional manual explaining the ins and outs of a complicated new word processing program that was recently installed on all office computers. Both Jones and the University understand that it is within Jones' scope of employment to prepare material that he needs to properly perform in his own department. Jones writes the manual at the office during normal working hours and with his boss's permission, but with his own computer that he brought from home. Jones distributes the manual to the staff, receiving rave reviews.

Jones was acting "within the scope of his employment" when he wrote the word processing manual; consequently, the University would be considered the statutory author of the work, absent a written agreement to the contrary between Jones and the University.

URI owns the copyright to manual.

7. Yamamoto, a music professor, needs to write a music score in order to properly teach an assigned course in music. There is written documentation within the department that Yamamoto is assigned to teach the course. This is not work-for-hire because Yamamoto is a professor, and the law has placed professors in a different category than, for example, Jones in Example 6. Yamamoto owns the copyright to the music score.

8. Wilson, a lathe operator, spends university time creating new software that would save several machining steps. This new software has nothing to do with his assignment. This is not work-for-hire. The university may have an agreement with the operator that, if such a creation arises, then the university has the right to use the new process royalty free within the university. The university cannot, however, inhibit the lathe operator from collecting royalties through commercialization of his copyrightable property.

Wilson owns copyright to the software.

9. Mitchell, a professor, is hired (or assigned) primarily to conduct research in a specific discipline. Both the University and the professor recognize software will be developed both to continue the research and possibly to exploit the findings of research. The software developed is owned by the University because it is created within the scope of employment. Publications ancillary to the research are owned by the professor. No specific written agreement is required.

URI owns copyright to the software.

10. Andrews, a professor, is on sabbatical leave of absence. While on sabbatical, she spends all of her time writing a book. The University of Rhode Island pays her salary while on sabbatical. The book belongs to Andrews, unless there is a specific written agreement to the contrary, which in this case there was not. Andrews owns copyright to the book.

It is important to note that if an individual is a full-time employee, then the criterion is not the degree of supervision but rather the scope of employment. If the individual is a part-time employee or a consultant, then the degree of supervision comes strongly into play.
ROYALTY REVENUE DISTRIBUTION
FOR LICENSE AGREEMENTS ENTERED INTO AFTER JULY 1997
To accompany University Manual 10.43., Figure 3
(Dollar amounts are for illustration only.)

GROSS ROYALTY REVENUE FROM INTELLECTUAL PROPERTY A. (RECEIVED BY FOUNDATION) $100,000/YR

LESS LEGAL, DEVELOPMENTAL MARKETING, AND PATENT COSTS FOR PROPERTY A. NOT COVERED BY LICENSEE $10,000

NET ROYALTY INCOME FROM PROPERTY A. $90,000

DEAN PORTION $30,000
CREATOR $30,000
UNIVERSITY $30,000

LESS 10% FOUNDATION MANAGEMENT CHARGE $3,000

DIRECT TO PROVOST FOR RESEARCH USE $6,750

$20,250

PATENT ENDOWMENT $42,750

$22,500

INTEREST EARNED FOR RESEARCH $2,138

COUNCIL OF DEANS $1,069
PROVOST (Research and Patent Development) $1,069