
To: Intellectual Property Managers
Contract and Grant Directors
Vice Chancellors for Research

Subject: Academic Visitor Intellectual Property Pilot Program

Background

In support of the University's mission of education, research, and public service, the University recognizes the importance of fostering interactions between University faculty and individuals from outside organizations such as other universities, non-profit research institutes, and industry. Such interactions may include visits to a University campus or Laboratory by faculty or scientists employed by such institutions. Any such visits must comply with University policies that address the risks and legal concerns that may arise as a result of the visitor's activities at the University. One such concern is the disposition of intellectual property created by a visitor while engaged in activities at a University campus or Laboratory.

The ownership of any intellectual property created by a non-University faculty or scientist while visiting a campus or Laboratory is subject to the University's Patent Policy (http://www.ucop.edu/ott/genresources/pat-pol_97.html) and Policy on Copyright Ownership (<http://www.ucop.edu/ott/staff/copyr.html>).

The Patent Policy states, in part:

“An agreement to assign inventions and patents to the University, except those resulting from permissible consulting activities without use of University facilities, shall be mandatory for all employees, for persons not employed by the University but who use University research facilities, and for those who receive gift, grant, or contract funds through the University.”

The University's Patent Acknowledgment form (<http://www.ucop.edu/ucophome/policies/bfb/upay585.pdf>) represents the University's implementation of the Patent Policy's mandatory agreement requirement. Visiting faculty or scientists who are not employed by the University and utilize University funds, resources, or facilities are required to sign the University Patent Acknowledgment form prior to gaining access to such resources. This requirement minimizes certain intellectual property risks associated with a visitor's access to University facilities, resources and funds that include:

- i) The potential for conflict of obligations with third-party sponsors of research or material providers;
- ii) The potential loss of rights or access to inventions solely created by a visitor with the use of University funds, facilities, or resources; and
- iii) The lack of fair consideration back to the University from work performed at or paid for by the University.

While the Patent Acknowledgment form does not address works of authorship, the University Policy on Copyright Ownership states under Section VI.A:

“Prior to any use of a University facility by non-University personnel or by University personnel outside University employment, a signed agreement shall be required that specifies the disposition of copyrighted works.”

The administrative requirement for implementing this policy obligation resides with the Chancellors and Laboratory Director.

Intellectual Property Risk Posed by Visitors

The level of risk to the University posed by a visiting faculty or scientist may vary depending upon the nature of the visit combined with the visitor’s outside employment status (e.g., industry scientist, faculty member on sabbatical, etc.). The requirement for signing the Patent Acknowledgment form, however, is universally-applied regardless of a visitor’s outside employment arrangement. This frequently results in protracted discussions with a prospective visitor (and employer) – often after the visitor is on-site - about the requirement to sign the Patent Acknowledgment form which further delays the commencement of the visitor’s activities at the campus or Laboratory. While the University provides an exemption from signing the University's Patent Acknowledgment form for four categories of individuals, these exemptions are limited in scope and subject to the condition that the individual does not use University research facilities or contract, grant, or gift funds obtained through the University (Business and Finance Bulletin G-40, University of California Patent Program, Section VI.A.4; <http://www.ucop.edu/ucophome/policies/bfb/g40main.html>). Should a visitor refuse to sign the Patent Acknowledgment form, the campus or Laboratory can either deny the visitor’s request for access to University facilities or request the approval of a Patent Policy exception from the Office of the President. This often results in the protracted negotiation of acceptable modifications to the Patent Acknowledgment form with the visitor (and employer), further delaying the visitor’s presence on campus. Each exception request is evaluated based upon the specific facts and circumstances surrounding a particular visitor and any approved modifications to the Patent Acknowledgment form are unique for that situation and non-precedent setting.

From a Patent Policy perspective, a visiting faculty member or scientist poses certain intellectual property risks to the University, the primary risks being a conflict of obligation with third-party sponsors of research (including material providers) and inappropriate use of public funds by a non-University entity. Based upon past experiences, the level of risk is proportional to the visitor’s outside employment status and the on-campus/Laboratory activities associated with the visit. A visiting scientist from industry collaborating on a research project at the University carries a higher level of potential intellectual property risks to the University or risks of the inappropriate use of publicly funded facilities and resources by a for-profit entity than a visiting faculty member on sabbatical furthering their scientific acumen due to, in part, the intellectual property practices of academic institutions.

In assessing the University’s universal application of the Patent Acknowledgment form requirement, it became apparent that certain academic visitors pose a lower level of intellectual property risk to the University than other types of visitors. In an effort to provide a more collegial framework for processing academic visitors, the University created

the following pilot program to assess the feasibility of using a simplified, pre-approved version of a patent agreement form as a substitute for the standard University Patent Acknowledgment form that satisfies the visitor requirements of both the University's Patent and Copyright Ownership policies.

Academic Visitor Intellectual Property Pilot Program Overview

The Academic Visitor Intellectual Property Pilot Program is a two-year pilot program implemented for the purpose of assessing campus/Laboratory use of a simplified, pre-approved visitor patent agreement template as an authorized replacement for the University Patent Acknowledgment form for certain lower-risk visiting faculty or scientists from academic, non-profit, or federal government institutions.

The goals of the Academic Visitor Intellectual Property Pilot Program are to:

- i) Adopt a more "collegial" approach regarding the ownership of intellectual property created by academic visitors;
- ii) Simplify the Patent Policy administrative processes and requirements for processing academic visitors; and
- iii) Grant local authority to use a pre-approved patent agreement form in place of the standard University Patent Acknowledgment form.

The Academic Visitor Intellectual Property Pilot Program is based upon the premise that visiting academic faculty and scientists that do not participate in sponsored research activities, utilize funds administered by or through the University, or conduct research activities containing third party obligations while on University premises are a lower Patent Policy compliance risk than other visitors who engage in such activities. The enclosed Academic Visitor Patent Agreement form (Attachment A) integrates the higher risk elements addressed by the University Patent Policy while respecting the cultural similarities shared among academic institutions. As such, the Academic Visitor Patent Agreement form embodies the following elements:

- i) Joint ownership of inventions and applicable works of authorship (limited to only those works where the University would have an interest in such works under the University Policy on Copyright Ownership) made solely or jointly in the course of the visitor's activities at the University;
- ii) Invention disclosure requirement to the University and visitor's employer;
- iii) Visitor activity restrictions on
 - a. Participating in University sponsored research projects;
 - b. Accepting/using University funds;
 - c. Using proprietary information or third party proprietary research materials administered by the University with visitor activities performed at the University; and
 - d. Using University resources and facilities for private or third-party benefit;
- iv) Third party conflict resolution provision; and
- v) Integration of the University Patent Policy requirements for inventions created outside the purpose of the visit.

Likewise, the Academic Visitor Patent Agreement includes a provision that incorporates a joint ownership interest in the visitor's works of authorship, but only to the extent provided for under the University Copyright Ownership Policy.

By signing the Academic Visitor Patent Agreement the visitor and employer agree to the above listed obligations. As implemented, the Academic Visitor Intellectual Property Pilot Program places the burden of any compliance associated with meeting these obligations on the visitor (and employer) and not the University.

Academic Visitor Intellectual Property Pilot Program Authority

University authorized Campus Licensing Office (CLO)¹ Directors are hereby authorized to approve the use of and execute the attached Visiting Academic Patent Agreement (Attachment A) in place of the standard University Patent Acknowledgment form for visitors that meet the following criteria:

- i) The visitor is a faculty member or researcher from an accredited U.S. institution of higher education; or
- ii) The visitor is a research scientist from a U.S. non-profit research institution; or
- iii) The visitor is a research scientist from a U.S. government agency.

Non-University faculty or scientists visiting under a University courtesy academic appointment or title (either with or without University compensation) under the University's APM Series (APM-112, General University Policy Regarding Academic Appointees; <http://www.ucop.edu/acadpersonnel/apm/apm-112.pdf>) are not eligible to participate in the Academic Visitor Intellectual Property Pilot Program and, as such, are still required to sign the standard University Patent Acknowledgment form.

Academic Visitor Intellectual Property Pilot Program Requirements

The campus/Laboratory implementation of the Academic Visitor Intellectual Property Pilot Program must meet the following requirements:

- i) A designated campus/Laboratory faculty host must be listed on the Academic Visitor Patent Agreement;
- ii) The Academic Visitor Patent Agreement must be signed by the visitor, an authorized representative of the visitor's employer, and the director of the CLO (or authorized designate in the director's absence);
- iii) The hosting faculty member's department dean, chairperson, or director must approve the visit by signing the acknowledgment block of the Academic Visitor Patent Agreement; and
- iv) The CLO must provide a paper or electronic summary report of all executed Academic Visitor Patent Agreement forms to the Executive Director, Research Policy Analysis & Coordination at the expiration of this Pilot Program on December 31, 2013.

¹ CLO is the campus/Laboratory-based office that has received formal reassignment of intellectual property licensing authority from the Office of the President, or the UCOP Office of Technology Transfer, as appropriate.

In addition, this Academic Visitor Intellectual Property Pilot Program authority must be applied in a manner consistent with the University Policy on “Principles Regarding Rights to Future Research Results in University Agreements with External Parties” (<http://www.ucop.edu/ott/genresources/principles.html>), the private business use limits of the Tax Reform Act of 1986, and any applicable systemwide and campus/Laboratory visitor policies and procedures. In applying this authority, it is important that the CLO consult with all stakeholders, including their local C&G Office, the appropriate campus Academic Personnel departments, and University hosting department personnel, who on a case-by-case basis, should participate in and take responsibility for decisions concerning the use of the Academic Visitor Intellectual Property Pilot Program authority. In addition, each campus/Laboratory, at its discretion and working with the relevant offices (C&G, CLO, Vice Chancellor for Research, Academic Personnel, etc.), may implement additional local restrictions and approval requirements that meet the specific needs of the campus/Laboratory when implementing the Academic Visitor Intellectual Property Pilot Program authority.

The Academic Visitor Intellectual Property Pilot Program authority is issued for immediate use and extends through December 31, 2013. The results of the Academic Visitor Intellectual Property Pilot Program and the appropriateness of any renewal will be assessed at that time. Additional guidance on exercising the Academic Visitor Intellectual Property Pilot Program authority is provided in Attachment B.

If you have any questions concerning the Academic Visitor Intellectual Property Pilot Program or its implementation, please contact Janna Tom.

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Attachments: Academic Visitor Patent Agreement (Attachment A)
Frequently Asked Questions (Attachment B)