

USF System USF USFSP USFSM

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I. INTRODUCTION (Purpose and Intent)

The Florida Legislature has declared:

The mission of the state system of postsecondary education is to develop human resources, to discover and disseminate knowledge, to extend knowledge and its application beyond the boundaries of its campuses, and to develop in students heightened intellectual, cultural, and humane sensitivities; scientific, professional and technological expertise; and a sense of purpose. Inherent in this broad mission are methods of instruction, research, extended training, and public service designed to educate people and improve the human condition. (§1004.01(2), Fla. Stat.)

As a constituent institution of the State University System under the Florida Board of Governors, the University of South Florida System (USF System) is dedicated to the above-stated mission and recognizes its obligation to encourage and support research and the development and utilization of inventions and works in a manner that benefits the public, the inventor or author, and the USF System education and research programs.

Accordingly, the USF System has exercised the authority conferred in §§1004.22 and 1004.23, Florida Statutes, by adopting Regulation USF12.003, Inventions and Works, and this USF System policy to accomplish the following objectives:

- A.** Provide an environment that will encourage innovation, research, and the creation of inventions and works, and provide appropriate incentive and support to inventors and authors in connection with the development and commercial application of inventions and works.
- B.** Provide for the determination of the relationship between USF System interests and individual interests in inventions and works according to fair and uniform guidelines and procedures that implement the terms of §§1004.22 and 1004.23, Florida Statutes, Regulation USF 12.003, and the applicable United Faculty of Florida and Graduate Assistants United-

United Faculty of Florida Collective Bargaining Agreements (Collective Bargaining Agreements).

C. Provide for the development, protection, and utilization of inventions and works to serve the public interest.

II. DEFINITIONS

The Inventions and Works policy is intended to describe guidelines and procedures that implement the terms of §§1004.22 and 1004.23, Florida Statutes; Regulation USF12.003; and the Collective Bargaining Agreements. The policy is supplemented by and subordinate to the referenced laws, regulations, rules, and agreements. The definitions that follow will apply for purposes of interpreting and implementing the policy.

"USF System" means the University of South Florida System, including USF Tampa, USF Sarasota-Manatee, and USF St. Petersburg, or any college, campus, entity, program, or activity under the authority and direction of the University of South Florida System.

"USF System -supported efforts" means:

A. With respect to inventions, activity that is in the field in which a USF System employee is employed by the USF System (i.e., the fields or disciplines for which the inventor is employed to teach or to research) or for which USF System support is used.

B. With respect to works, activity that is pursuant to the USF System employee's position description or specific professional assignment or special commission by the USF System, or for which USF System support is used.

"Sponsored research" means USF System-supported effort for which the USF System has received support under a contract or grant with a third-party sponsor.

"Independent effort" means:

A. With respect to inventions, the term means activity that is outside the field or discipline in which a USF System employee is employed by the USF System (i.e., the field or discipline for which the inventor is employed to teach or to research) and for which no USF System support is used.

B. With respect to works, the term means (1) the ideas come from the USF System employee; (2) the work is not made in the course of USF System-supported efforts, except for approved uses of USF System support as described in the policy; and (3) the USF System is not held responsible for any opinions expressed in the work.

"Invention" means any discovery, invention, process, composition of matter, article of manufacture, know-how, design, model, technological development, strain, variety, or culture of any organism, or portion, modification, translation, or extension of these items, and any mark used in connection with these items. As used in this policy in reference to inventions, the term "made" means the conception or first actual reduction to practice of an invention, provided that the term might be otherwise defined in a sponsored research contract or grant.

"Work" means 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.

"Inventor" means a person who makes an invention. As used in the preceding sentence, the term "makes" means conceives of or first reduces to practice an invention.

"Author" means a person who creates or authors a work.

"USF System support" means USF System funds, facilities, materials, equipment, personnel, or proprietary technological information that are used by an inventor or author in the making or development of an invention or work. Funds, facilities, materials, equipment, personnel, or proprietary, technological information that are provided by other public or private organizations and are arranged, administered, or controlled by the USF System shall be considered to be provided by the USF System.

"USF System employee" means all General Faculty, Administration, Staff and Temporary employees of the USF System—in-unit or non-unit—regardless of classification or source of funding for the position, and volunteers. For example: USF System employee under this definition includes a graduate student in a Temporary position as well as an undergraduate student receiving no funds and holding no appointment who would be considered a volunteer for the purposes of this policy.

"Outside activity" means any private practice, private consulting, outside teaching or research, or other activity, compensated or uncompensated, which is not part of the USF System employee's assigned duties and for which the USF System has provided no compensation. (See Collective Bargaining Agreements or personnel regulations, as applicable, for provisions for reporting outside activity.)

"Net revenue" means gross revenue received by the USF System from commercial application of the invention or work, including royalties and license fees, minus direct costs incurred by the USF System in protecting, maintaining, licensing, and preserving patent rights and copyrights. As used in the preceding sentence, the term "gross revenue" does not include tuition and fees to USF System students. Where the USF Research Foundation is granted rights and responsibilities for the commercial application of an invention or work, the term "gross

revenue" shall include the revenue received and costs incurred by the USF Research Foundation.

"Commercial application" means the exercise, assignment, or license of any rights existing under federal or state statutes or common law to make, have made, use, copy, sublicense, sell, or otherwise exploit an invention or work.

III. DETERMINATION OF RIGHTS AND ALLOCATION OF REVENUE FROM INVENTIONS AND WORKS

In accordance with Regulation USF12.003 and the Collective Bargaining Agreements, the USF System policy regarding the ownership and disposition of inventions and works is defined in terms of the various circumstances in which inventions and works may result. Further, in accordance with the referenced Regulation and Agreements, the allocation between the USF System and the inventor or author of revenue derived from commercial application of inventions and works is determined by negotiation and mutual agreement between the USF System and the inventor or author.

A. Books, Articles, and Similar Works

In accordance with Regulation USF12.003 and the Collective Bargaining Agreements, works made with the use of USF System support are the property of the USF System. However, to encourage scholarly and creative activity and in keeping with tradition and the referenced Regulation and Agreements, the USF System policy is that it will not assert rights to books, articles, and similar works, the intended purpose of which is to disseminate the results of academic research or scholarly study, unless the work is a work made for hire as defined by the United States Copyright Act. Accordingly, such books, articles, and similar works are the property of the author, and the author has the right to determine the disposition and any resulting revenue.

A USF System employee (see Section II. Definitions) may make approved use of USF System support in the authorship or creation of works under this Section. For purposes of this Section, the following shall be deemed to constitute the approved use of USF System support for a USF System employee's authorship or creation of books, articles, and similar works, the intended purpose of which is to disseminate the results of academic research or scholarly study:

1. The use of books and materials in the USF System libraries.
2. The use of office space and word processing, personnel and equipment.

3. The use of classroom and studio space and supplies for the creation of musical compositions and arts and crafts, including paintings, weavings, prints, sculptures, and other works of art.
4. The use of USF System computers.
5. The use of other USF System support upon the specific advance approval of the appropriate USF System official.

The request for approval is made by completing and submitting the “University Equipment, Facilities, and Services” form that accompanies the “Report of Outside Activity” form. The USF System and the author may agree in writing that the USF System will pursue the commercial application of books, articles, and similar works under this Section. Pursuant to such agreement, the work will be assigned or licensed to the USF System; and the USF System will be responsible for taking appropriate and effective steps to accomplish the protection or commercial application of the work as agreed by the parties. Revenue derived from commercial application of such works is allocated in accordance with an agreement between the USF System or the USF Research Foundation and the author.

B. Inventions and Works Made in the Course of USF System-Supported Effort

In accordance with Regulation USF12.003 and the Collective Bargaining Agreements, an invention or work made in the course of USF System-supported effort is the property of the USF System. Revenue derived from commercial application of inventions and works made in the course of USF System-supported effort is allocated in accordance with an agreement between the USF System or the USF Research Foundation and the inventor or author.

C. Inventions and Works Made in the Course of Independent Effort

In accordance with Regulation USF12.003 and the Collective Bargaining Agreements, an invention or work made in the course of independent effort is the property of the inventor or author, and the inventor or author has the right to determine the disposition of such invention or work and revenue derived therefrom.

The USF System and the inventor or author may agree in writing that the USF System will pursue the commercial application of an invention or work made in the course of independent effort. Pursuant to such agreement, the invention or work will be assigned or licensed to the USF System, and the USF System will be responsible for taking appropriate and commercially reasonable steps to accomplish the protection or commercial application of the invention or work as agreed by the parties. Revenue derived from commercial application of such

inventions or works is allocated in accordance with an agreement between the USF System or the USF Research Foundation and the inventor or author.

D. Inventions Made in the Course of Outside Activity

In accordance with the applicable terms of the Collective Bargaining Agreements and Regulation USF10.107 and USF System Policy 0-027, a USF System employee may engage in outside activity. However, pursuant to the referenced Agreements and Regulation USF 12.003, USF System employees may not waive or assign either their or the rights of the USF System to any inventions that arise during the course of such outside activity except as specifically approved in advance by the USF System Vice President for Research & Innovation.

The request for approval shall be made through the Outside Activity reporting module in the eDisclose System. Any agreement by the USF System President or the Vice President for Research & Innovation to assign or release any invention or work, including patent rights, to a faculty member must include that such invention or work, if patented by the employee, must be available royalty-free for governmental purposes of the State of Florida, unless otherwise agreed in writing by the USF System. The rights of the USF System and the USF System employee's obligations to the USF System are in no way abrogated or limited by the terms of outside employment/consulting agreements except as specifically approved in advance in writing by the USF System Vice President for Research & Innovation. The USF System employee is responsible for providing a copy of this policy—including Regulation USF12.003 or Article 18 of the Collective Bargaining Agreement—as applicable, to an outside employer at the time negotiations for other employment are occurring, or if there is no written agreement, before the employment begins.

E. Allocation of Revenue from Inventions and Works

The need for fair and consistent sharing of revenue with inventors/authors and the prudent exercise of the public trust require clear guidelines and procedures for the conduct of the negotiations between the USF System and the inventor or author to determine the allocation of revenue derived from the commercial application of inventions or works. Therefore, the USF System policy is to initiate the negotiations by offering terms that are at least as favorable to the inventor or author as the following:

- To the inventor or author: A share to be specified by the inventor or author but not exceeding forty-five percent (45%) of net revenue.

- To the inventor's or author's research support: A share to be specified by the inventor or author but not exceeding the difference between fifty-five percent (55%) of net revenue and the share allocated to the inventor or author.
- To the USF System: Forty-five percent (45%) of net revenue.

The share allocated to the inventor's or author's research support shall be deposited in an appropriate account within the USF Research Foundation, for which the inventor or author shall be the accountable officer, and such funds shall be utilized exclusively for support of the education and research activities of the inventor's or author's department or laboratory as determined by the inventor or author; subject to USF System and Research Foundation policy and approval. The revenue allocation agreement shall provide that, upon the retirement or termination as a USF System employee, the USF System and inventor or author shall each thereafter receive fifty percent (50%) of the inventor's or author's research support share. In the case of joint inventions or works, the above specified shares allocated to the inventor or author and inventor's or author's research support shall be divided equally among co-inventors or co-authors unless otherwise agreed by the co-inventors or co-authors.

IV. RESPONSIBILITIES, POWERS, AND DUTIES

A. Vice President for Research & Innovation

The USF System Vice President for Research & Innovation has the following responsibilities, powers, and duties in connection with the administration of this policy:

1. To serve as the President's representative for purposes of Regulation USF12.003 and the Articles relating to Invention and Works in the Collective Bargaining Agreements.
2. To represent the USF System in all matters of policy arising from the USF System research and technology transfer programs and activities.
3. To evaluate inventions for patentability, scientific merit, and practical application; and, where desirable, to appoint experts to examine the merits of a potentially patentable invention.
4. To authorize applications for patents, both U.S. and foreign, and to retain patent counsel, in coordination with the USF System General Counsel, for matters pertaining to patentability studies, the filing of patent applications, the prosecution and commercial application thereof and litigation that may arise therefrom.

5. To determine and negotiate the USF System interests in inventions and works according to the guidelines and procedures set forth in this policy, to approve the terms of revenue allocation agreements with inventors or authors, and to direct the performance of the USF System under such agreements.
6. To delegate the foregoing evaluation and protection activities to the USF Research Foundation, as appropriate.
7. To approve and execute the release or assignment of rights to inventors and authors in the circumstances described in Section IV.H.
8. To approve and execute contract and grant terms relative to the disposition of inventions and works and the amount and disposition of revenue derived therefrom.
9. To approve and execute licenses and other agreements with the USF Research Foundation and other third parties concerning the commercial application of inventions and works.
10. To report to the Florida Department of State, on behalf of the USF System President, actions taken by the USF System in securing or exploiting copyrights and patents in accordance with §1004.23, Florida Statutes.

B. Disclosure of Inventions

A USF System employee shall fully and completely disclose directly to the Division of Patents & Licensing any and all inventions that he/she may develop or discover while a USF System employee, whether USF System-supported, independent effort or as a result of approved Outside Activity. All inventors are required to disclose to the Division of Patents & Licensing all inventions that he/she may develop or discover in the course of USF System-supported effort. The disclosure should be promptly submitted directly to the Division of Patents & Licensing following conception or discovery of an invention.

The disclosure is made by completing and submitting the Disclosure of Invention Form. The employee shall not commit any act that would tend to defeat the interest of the USF System in the matter, and the USF System shall take any necessary steps to protect such interest.

The disclosure will be promptly acknowledged in writing by the Division of Patents & Licensing. The Division of Patents & Licensing will provide a copy of the disclosure to the funding sponsor if required by the terms of the contract or grant.

With respect to an invention made during the course of approved outside activity, at the request of the outside employer, disclosure by the USF System employee to the USF System

may be made under the terms and conditions of a confidentiality agreement, to protect the outside employer's interests until the decision has been made by the outside employer as to whether to seek a patent.

C. Disclosure of Works

A USF System employee is required to disclose to the Division of Patents & Licensing all works that he/she may create or author in the course of USF System-supported effort. A USF System employee is not required to disclose to the USF System any work that he/she may create or author in the course of independent effort and books, articles, and similar works described in Section III. A., unless disclosure is a condition of the approval for use of USF System support.

The disclosure is made by completing and submitting the "Disclosure of Works Form." The disclosure should be promptly submitted to the Division of Patents & Licensing following creation or authorship of a work.

The disclosure will be promptly acknowledged in writing by the Division of Patents & Licensing. The Division of Patents & Licensing will provide a copy of the disclosure to the funding sponsor, if required by the terms of the contract or grant.

D. Review of Disclosures; Notification of USF System Interest

On behalf of the USF System Office of Research & Innovation, the Division of Patents & Licensing will coordinate the review and evaluation of disclosures of inventions and works by designated USF System staff, consultants, and committees. This evaluation shall include an assessment of the respective rights and equities of the USF System and the inventor or author; the importance of the invention or work; and the extent to which the USF System should be involved in the protection, development, and commercial application of the invention or work.

The Division of Patents & Licensing shall act with due diligence and reasonable dispatch to complete its evaluation of the disclosure and to notify the inventor or author of its interest in the invention or work. Within a reasonable time, not to exceed sixty (60) days following the date of receipt of the disclosure, the Division of Patents & Licensing shall give written notice to the inventor or author as to whether the USF System wishes to assert its interest in the invention or work. The Division of Patents & Licensing and the inventor or author may agree to extend the period for USF System evaluation of the invention or work.

Within a reasonable time, not to exceed 135 days from the date of receipt of the disclosure, the Division of Patents & Licensing shall inform the inventor of the USF System decision as to

whether to apply for a patent for an invention in which the USF System has asserted its interest.

If an invention or work is made in the course of sponsored research and the sponsor has rights to the invention or work, the appropriate department within the Office of Research & Innovation will use its best efforts to obtain the sponsor's decision regarding the exercise of such rights within 120 days from the date of receipt of the disclosure.

If the USF System elects to apply for the patent or otherwise become involved in the protection, development, and commercial application of an invention or work, the Division of Patents & Licensing and the inventor or author will negotiate in good faith and with due diligence and reasonable dispatch to determine the terms of the revenue allocation agreement. The USF System will offer the inventor or author the applicable terms described in Section III.E., and the final agreement of the parties shall be reflected in a written revenue allocation agreement. Any revenue allocation agreement that does not conform to the terms described in Section III.E. must be approved by the Vice President for Research & Innovation.

E. Resolution of Disputes

Disputes regarding the ownership of inventions or works and other issues relating to the administration of this policy may be reviewed by the Vice President for Research & Innovation upon request by the affected employee. Disputes that are not resolved informally may be subject to grievance or hearing procedures as provided by the applicable Collective Bargaining Agreement or Florida law.

F. Sponsored Research Agreement

The USF System, represented by the Vice President for Research & Innovation, shall have final authority and responsibility for the approval and execution of sponsored research contract and grant terms relative to the ownership and disposition of inventions and works.

G. Commercial Application

The USF System, represented by the Vice President for Research & Innovation, shall have final authority and responsibility for the approval of licenses and other agreements with third parties concerning the commercial application of inventions and works, including the amount and disposition of revenue derived therefrom, subject to the terms of this policy and the revenue allocation agreement with the inventor or author. Subject to the terms of any applicable

contract or grant, the USF System has the following options for the commercial application of inventions and works in which the USF System has an interest:

1. USF Research Foundation. The USF Research Foundation is a Florida not-for-profit corporation certified by the USF Board of Trustees as a USF System direct-support organization pursuant to §1004.28(1)(a), Florida Statutes that has been organized for the purposes of promotion and encouragement of and assistance to the research activities of the USF System faculty, staff, and students. The USF Research Foundation provides means by which inventions and works may be developed, patented, applied, and utilized in order that the results of USF System research shall be made available to the public and that funds be made available from inventions and works to support education and research at the USF System. The general policy of the USF System is to enter into an agreement with the USF Research Foundation whereby the USF Research Foundation is granted rights and responsibilities for the development, protection, or commercial application of an invention or work in consideration of royalties, license fees, or other revenue to be dedicated to the benefit of the USF System and to be shared in accordance with the terms of the revenue allocation agreement with the inventor or author.

2. USF System/Research Foundation licensing programs. The USF System/ Research Foundation may solicit, select, and negotiate agreements with third-party licensees or assignees to manufacture, have manufactured, use, copy, sub-license, or sell inventions or works in consideration of royalties, license fees, or other compensation.

3. Patent management organizations. There are organizations that are available to the USF System to provide development, protection, and marketing services.

4. Development by inventor or author. The USF System/Research Foundation and the inventor or author may enter into an agreement whereby the inventor or author is granted rights and responsibilities for the development, protection, or commercial application of an invention or work, in consideration of royalties, license fees, or other compensation to the Research Foundation/USF System. Such agreements are required to be specifically approved by the USF System President and others as may be required in accordance with §112.313(12)(h), Florida Statutes.

The USF System/Research Foundation and a company in which the inventor or author has an ownership or management interest may enter into an agreement whereby the company is granted rights and responsibilities for the development, protection, or commercial application of an invention or work, in consideration of royalties, license fees, or other compensation to the Research Foundation/USF System. The USF System employee is responsible for providing a copy of this policy to the company prior to or at the time the agreement is executed. The USF System employee is responsible for following all USF System policies and procedures relating to outside activities, conflicts of interest, and reporting requirements.

In accordance with §1004.23, Florida Statutes, any action taken by the USF System in securing or exploiting an invention or work shall be reported in writing within 30 days by the Vice President for Research & Innovation, on behalf of the USF System President, to the Florida Department of State.

H. Release of Rights

At any stage of the protection, development, and commercial application of an invention or work, or if the USF System President or Vice President for Research & Innovation have not otherwise assigned to a third party the right to pursue their interests, the USF System President or Vice President for Research & Innovation may withdraw and abandon the invention or work. In this event, the inventor or author will be promptly notified in writing and, at the request of the inventor or author and as permitted by law, the invention or work will be assigned to the inventor or author, and none of the costs incurred by the USF System or the USF Research Foundation shall be assessed against the inventor or author.

If the USF System/Research Foundation decides to assign or release invention rights to the inventor, such assignment or release must be in writing and shall contain the provision that the invention, if patented by the USF System employee, shall be licensed royalty-free for governmental purposes of the State of Florida, unless the USF System has otherwise agreed in writing.

I. Publication and Confidentiality

The USF System encourages research that serves a public purpose and which results may be published. The USF System recognizes that the legitimate proprietary concerns of sponsors and the effective protection and commercial application of inventions and works may require confidentiality and limited delays in the publication of certain information.

In accordance with §§1004.23 and 1004.30, Florida Statutes, the USF System is authorized to keep the following items confidential: materials that relate to methods of manufacture or production, potential trade secrets, potentially patentable material, actual trade secrets, business transactions, or proprietary information received, generated, ascertained, or discovered during the course of research conducted within the USF System.

The following information or materials are not confidential:

1. The title and summary description of a research project, the name of the researcher, and the amount and source of funding provided for such project.

2. Any information or material that is in the public domain or that is described in an issued patent or publication.
3. Information or material that may be disclosed without violating the terms of a sponsored research contract or grant or without adversely affecting the proper development, protection, and commercial application of inventions or works.

The Vice President for Research & Innovation shall have authority and responsibility for the prior review and approval of disclosures of information and materials that are confidential under §1004.30, Florida Statutes. Disclosure delays mutually acceptable to the inventor, the Vice President for Research & Innovation, and the sponsor, if any, are authorized in order to allow all foreign and domestic patent applications to be filed prior to publication, thereby preserving patent rights, particularly in foreign countries requiring absolute novelty.

"Disclosure" includes public use of an invention or description of an invention in a printed publication that is accessible to the public (including non-confidential oral descriptions that may lead to printed publications).

J. Copyright Notice and Registration

Copyrightable works that are published should include a notice consisting of the following three elements:

1. The symbol © or the word "copyright" or the abbreviation "Copyr.™" For sound recordings, the symbol P is used instead of ©.
2. The year of first publication of the work.
3. The name of the copyright owner or a recognizable abbreviation of that name.

In the case of works made in the course of USF System-supported effort as described in Section II.A., if the work is to be published and protected by a registered copyright rather than being released to the public domain, a USF System employee who creates or authors the work shall affix the following notice to the work prior to the publication thereof: "Copyright (year) University of South Florida System.™" The USF System, in connection with the written notice to the author that the USF System wishes to assert its interest in the work as described in Section III.B., may take action to protect the copyright by affixing the copyright notice and by registering the work with the Registrar of Copyrights, Library of Congress.

K. Execution of Documents

The policies set forth in Regulation USF12.003 and the Collective Bargaining Agreements constitute an understanding that is binding on USF System employees, students, and other

persons as a condition of their employment by the USF System or use of USF System support. USF System employees and other inventors or authors are required to execute all documents necessary to implement the terms of the referenced Regulation and Agreements including, but not limited to, invention and copyright disclosures, assignments, reports, and applications. The USF System and each USF System employee shall sign an agreement individually recognizing the terms of the Collective Bargaining Agreement, Article 18, or Regulation USF12.003, as applicable. Such an agreement may be contained in the employee's employment contract with the USF System or may be a separate instrument to be executed in connection with the initial appointment of the USF System employee.

Authorized and signed by:

Karen A. Holbrook, Vice President for Research & Innovation
Judy Genshaft, President