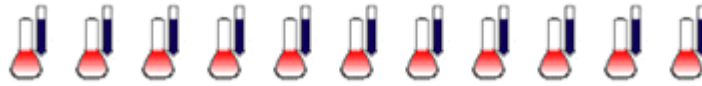


# Patent Policy



## Contents:

- [Preamble](#)
- [General Policy](#)
- [Reporting Procedures](#)
- [Administration of Policy by DSR](#)
- [Royalty Distribution](#)

## Preamble

As a state supported public institution, Florida Atlantic University's primary missions are teaching, research and public service. The University dedicates these efforts to the public welfare and promotes the dissemination of research results and scholarly works. However, the University recognizes that inventions and discoveries of commercial importance may be the natural outgrowth of research conducted by University faculty, staff and students.

As a public institution, the University is entrusted with the responsibility to see that discoveries or inventions made at the University are administered in the best interests of the local and national public. It is therefore essential to maintain a favorable atmosphere for research and scholarly pursuits on campus. The University will provide an additional incentive for research and development by virtue of an enlightened patent policy which will provide direction and protect the inventor, the University, and the public.

The policy as offered was originated by the Division of Sponsored Research and oversight responsibility for its implementation rests with the Division. Future modifications of the policy, including those necessary to maintain consistency with any University contract in force or Board of Regents directives, are to originate in the University Research Committee and to be approved by the University Senate.

## General Policy\*

An employee shall disclose all patentable inventions and technological developments which the employee may develop or discover while an employee of the State University System. With respect to discoveries or inventions made during the course of approved outside employment, the employee may delay such disclosure, when necessary to protect the outside employer's interests, until the decision has been made by the University to seek a patent.

All discoveries or inventions made outside the field in which the discoverer or inventor is employed by the institution and for which the University has provided no support are the private property of the inventor. However, the employee and the President, or representative, may agree that the patent for such discovery and invention be pursued by the University and the proceeds shared.

Except for discoveries or inventions made during the course of approved outside employment, a discovery or invention which is made in the field in which the investigator is employed by the University, or by using University funds, facilities, materials, equipment, personnel, or proprietary technological information, is the property of the University and the inventor shall share in the proceeds therefrom.

Employee who proposes to engage in such outside employment shall furnish a copy of this patent policy to the outside employer prior to or at the time the consulting agreement is executed.

### Reporting Procedures\*\*

The employee shall report to the Dean of the appropriate College the nature of the discovery or invention, together with an outline of the project and the conditions under which it was done. The Division of Sponsored Research is available to provide information to the inventor related to what should be incorporated in an invention disclosure. It is the responsibility of the Dean to review the disclosure, and determine with the assistance of faculty from the College, if the discovery is worth pursuing and investing university resources in. If the Dean wishes to assert the College's interest in the disclosure he/she shall inform the employee within thirty (30) days. Within the same thirty day time frame the Dean shall forward the disclosure to the Director of the Division of Sponsored Research with the College's written recommendation.

The Director of Sponsored Research shall review the recommendation of the College and shall assess the respective equities of the employee and the University in the invention or technological development, and determine its importance and the extent to which the University should be involved in its protection, development and promotion. The President or representative shall inform the employee of the University's decision to apply for the patent within a reasonable time, not to exceed 135 days from the date of the disclosure. The date of disclosure is the date that the Director of Sponsored Research receives a recommendation from the appropriate College. The division, between the University and the employee, of proceeds generated by the licensing or assignment of patent rights or trade secrets, shall be reflected in a written contract between the University and the employee consistent with this policy. All such agreements shall comport with and satisfy any preexisting commitments to outside sponsoring agencies, but the employee shall not commit any act which would tend to defeat the University's interest in the matter, and the University shall take any necessary steps to protect such interest. It is the responsibility of the University Attorney to assure that any agreements that may be necessary are consistent with the Article 18 of the Collective Bargaining Agreement between the SUS of Florida and the United Faculty of Florida.

In the event a contractor has been offered the option to apply for the patent, the University will use its good offices in the effort to obtain such a decision within 120 days. At any stage of making the patent application, or in the development of a patent secured, if it has not otherwise been assigned to a third party the right to pursue its interests, the President, or representative, may withdraw and shall return the patent rights to the employee, in which case the patent shall be the employee's property, and none of the costs incurred by the University or on its behalf shall be assessed against the inventor.

All assignments of or release of patents rights by the President, or representative, to the employee shall contain the provision that such invention and/or process, if patented by the employee, shall be available royalty-free for governmental purposes of the State of Florida.

In the case of inventions arising out of projects funded by a federal government agency, the University (if not interested in pursuing a patent procurement process) will petition to the federal agency involved, that the invention rights be relinquished to the inventor so that he/she can apply directly for patent protection for his/her invention. Such release will be subject to making the inventions available (royalty-free) to the federal government and all it's agencies.

### Administration of Policy by Division of Sponsored Research

For each patent disclosure submitted the Division of Sponsored Research, acting on behalf of the President, will utilize a standing committee, formed for each such disclosure, as a decision making committee regarding the disposition of patent disclosures for the University. This standing committee will consist of senior administration including the University Provost, the Dean of the respective College, the University Attorney, the Executive

Using an expert witness to corroborate his/her theories. It is the responsibility of the inventor to conduct a preliminary patent search for the invention, as well as a market analysis, which can be performed by NASA-STAC at a nominal cost. Such a preliminary patent search can be conducted at the Federal Depository for the U.S. Patent and Trademark Office at the Broward County Library. Such searches can be conducted at minimal or no cost to the inventor. It is suggested that such a search be conducted in the early stages of the disclosure process, and be included with the recommendation of the respective Dean to the Division of Sponsored Research. The standing committee may ask other University faculty members to join in a non-voting capacity to aid in the discussion of the disposition of the disclosure. Recognizing that the expertise to provide an adequate evaluation of the merits of a given disclosure may not exist among the members of the Committee or the faculty, the standing committee may request the Division of Sponsored Research to engage an outside consultant to assist in the evaluation of the disclosed patent at the expense of the respective College and the Division of Sponsored Research. If deemed appropriate confidentiality agreements will be signed by any outside consultants and/or reviewers of the invention disclosure. The standing committee will make the final determination in regard to investment of university resources in securing the services of a qualified and State approved patent attorney. The source of such resources shall be determined by the standing committee for such an investment. Such a decision shall be made in accordance with Article 18 of the Collective Bargaining Agreement between the SUS of Florida and the United Faculty of Florida.

### **Royalty Distribution**

In cases where it has been determined by the standing committee that a discovery or invention is the property of the University, the written contract between the discoverer and the University will reflect a royalty distribution as follows: All expenses incurred by the University or its patent agent in securing a patent will be paid from proceeds prior to distribution of royalties. When the patent agent has title to an invention or patent and income results, it shall be shared, except where specified otherwise by the funding source, on the following basis:

Net Income	Inventor	University
\$0 - \$5,000	100%	0
\$5,001 - \$50,000	50%	50%
\$50,001 - Infinite	35%	65%*

\* 10% of the University net income from royalties shall be provided to the inventor in the form of a special research account to be utilized for enhancing research and creative activities of the inventor.

Net income is defined as gross royalties and/or other receipts by the patent agent less deductible costs (administrative, legal, and patent expenses).

In other cases in which a discovery or invention has been assigned to a third party for disposition, and the University receives income as a result, the same royalty distribution will apply. In cases where it has been determined that the discovery or invention is not the property of the University yet the faculty member and the President agree to share the proceeds, a contract may be written which causes distribution of royalties which differ from the schedule shown above.

In the event that the standing committee determines that the faculty member's Department made substantial contributions to the research effort resulting in the patent, the Committee may, at its discretion, award up to 10 percent of the University's share to the Department. These funds must be spent by the Department to further enhance research activities.

Co-inventors share the Inventor's share in proportions agreed to among themselves.

\* Refer to BOR/UFF Collective Bargaining Agreement, 1985-1988, Articles 18.2, 18.3, and 18.4.

\*\* Ibid., Articles 18.5, and 18.6.



*URL: <http://www.fau.edu/academic/provost/patent.htm>*