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COPYRIGHTS, MASKWORKS, AND PATENTS

*PREAMBLE: This section outlines UI policy concerning copyrights, maskworks, and patents as they arise from university research. Particularly this section discusses the assignment of ownership to such copyrights, maskworks, and patents. This section was part of the 1979 Handbook but was revised in a major way in July of 1992 to reflect changes in applicable federal law and in January of 1995 by the addition of subsection C-5 to reflect the change in the Regents= intellectual property and conflict of intent rule (IDAPA 08.01.09.03c). Unless otherwise noted, the text is as of July 1996. For more information, contact the Research Office (208-885-6651). [ed. 7-98]*

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**A. INTRODUCTION.** The university encourages the creation of scholarly works as an integral part of its mission. UI participation in the development, marketing, and dissemination of educational materials has as its aim the improvement of the quality, effectiveness, and efficiency of student learning and of faculty and staff development. The university recognizes its obligation to transfer technology and useful discoveries to society.

**B. COPYRIGHTS AND MASKWORKS.** UI participation in the development of copyrightable works and maskworks raises questions concerning the ownership and use of materials in which UI has become an active and intentional partner through substantial investment of resources. This policy is established to clarify the rights of authors and the university regarding ownership and use of copyrightable materials and maskworks in the absence of a valid written agreement between the author and UI. The university acknowledges the right of faculty and staff members and students to prepare and publish materials that are copyrightable in the author's name and that may generate royalty income for the author. (In this policy, "author" is to be construed broadly as including producers of creative works in the arts and sciences and of literary or scholarly writing.)

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

- a. Study guides, tests, syllabi, bibliographies, generation tapes, (a) having or representing the predetermined three-dimensional

texts, books, and articles.

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

c. Programmed instructional materials.

d. Audio and video recordings.

e. Live audio and video broadcasts.

f. Dramatic, choreographic, and musical compositions.

g. Pictorial, graphic, and sculptural works.

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

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

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

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

(4) "Maskwork" refers to a series of related images, however fixed or encoded, including but not limited to pattern

of metallic, insulating, or semiconductor material present or removed

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from the layers of a semiconductor chip product and (b) in which series the relation of the images to one another is that each image has the pattern of the surface of one form of the semiconductor chip product.

(5) "Data base" means a collection of data elements grouped together in an accessible format.

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

**B-2. Assignment of Ownership.** Faculty and staff members and students retain all rights in the copyrightable materials and maskworks they create except in the cases of "university-sponsored" materials [see B-2-b], materials covered by the terms of a grant or contract, and materials covered by a valid written agreement between the author and the university.

a. In particular, authors retain the rights to: (1) copyrightable works produced while on sabbatical leave, unless there is a valid written agreement to the contrary; (2) study guides and similar materials not specifically commissioned by UI and the preparation of which did not involve substantial use of UI resources [see B-2-b(4)]; and (3) works prepared as part of the author's general obligation to produce scholarly or other creative works as well as works that customarily have been considered the property of the author, including but not limited to articles, books, musical compositions, and works of art.

**b. University-Sponsored Materials.** Materials are UI-sponsored within the meaning of this policy if the author: (1) were specifically commissioned in writing by UI or one of its distinct units to develop the materials as part of his or her regular duties; (2) received extra pay from UI to prepare the materials; (3) received release time from regular duties to produce the materials; or (4) made substantial use of UI resources (such as computer centers, audiovisual service units, or other similar department service centers) in their development, unless UI accepts or waives reimbursement for such use; limited use of secretarial support, use of the library for which special charges are not normally assessed, and

other routine use of UI resources are not considered to be "substantial" use of UI resources.

**B-3. Registration of Copyrightable Materials and Maskworks.** UI or its designee is responsible for applying to the U.S. Copyright Office for registration of copyrightable materials when under this policy materials have been finally designated UI-sponsored. Such application must be made no later than 60 days after the materials have been designated UI-sponsored. Absent a valid written agreement to the contrary, UI-sponsored materials are copyrighted and maskworks registered in the name of the Regents of the University of Idaho or UI's assignee.

**B-4. Royalties and Income.**

a. Out of the gross receipts from royalties and other income from sale or rental of UI-sponsored materials, the university, college, department, other unit, or UI's designated agent may recover reasonable expenses that it incurred in the development, marketing, or dissemination of the materials.

b. Absent a valid written agreement to the contrary, the net proceeds are distributed as follows: 40 percent to the author(s), 40 percent to UI or its designated agent, and 20 percent to the author's college or service unit. At least half of the share allocated to the college or other unit is given to the author's department for use in furtherance of its goals.

c. UI retains a right to royalty-free internal use of any materials designated UI-sponsored under this policy.

**B-5. Written Agreements.**

a. The provost represents UI in negotiating agreements with authors pursuant to this policy. The author of copyrightable material may negotiate with the provost and arrive at a mutually agreeable contract. The provost consults with the author's departmental administrator and dean in drafting these agreements. (For purposes of this policy, "dean" includes persons with equivalent administrative capacities.)

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**b.** Valid written agreements concerning copyright ownership, use of copyrighted materials, and distribution of royalties and income entered into by an author and the provost may supersede this policy and are binding, provided they are in compliance with the regents' rules, UI agreements with the Idaho Research Foundation (IRF), and other UI contractual agreements.

**B-6. Use of University-Sponsored Materials.** Use of UI-sponsored copyrightable materials under this policy is subject to the following conditions:

**a. Internal Use.** Internal use is use by anyone employed by UI, while acting within the scope of his or her employ, or any agent of UI acting within the scope of his or her agency, either directly or through a grant or contract, or by any UI unit.

**(1)** Internal use of UI-sponsored materials for the same purpose for which they were developed does not require prior approval by the author unless there is a valid written agreement to the contrary between the author and the provost or designee. Even so, as long as the author remains a UI employee or student, he or she may propose reasonable revisions of the materials. If the author and the departmental administrator cannot agree on appropriate revisions, the question will be referred to the author's dean for final determination.

**(2)** If the use is to be for a purpose other than that for which the materials were developed, the author, as long as he or she remains a UI employee or student, may propose reasonable revisions before each instance of such use. If the author and the departmental administrator cannot agree on appropriate revisions, the questions will be referred to the author's dean. If the author and the dean cannot agree on appropriate revisions, the author may withdraw the materials from use.

**(3)** If withdrawn materials have been copyrighted, UI may assign its rights to the author, subject to a valid written agreement between UI and the author regarding

further internal or external use of the materials and division of income from any subsequent use.

**(4)** When the author ceases to be a UI employee or student, UI retains the right to make internal use of the materials without the author's consent unless the author and UI have agreed in writing on different conditions for subsequent internal use of the materials and the procedures for their revision.

**b. External Use.** External use is any use other than that defined in a above. Licensing or sale of UI-sponsored materials for external use must be preceded by a valid written agreement between the author and UI or the university's designated agent specifying the conditions of use, and including provisions concerning updating or revision of the materials.

**B-7. Protection.**

**a.** Allegations of unauthorized use or copyright infringement of UI-sponsored materials should be made to the Intellectual Property Committee for investigation. The committee will recommend appropriate action to the provost.

**b.** If such action is initiated by UI alone or in concert with the author, the costs are borne by UI or UI's agent. Proceeds from the action in excess of costs are shared as provided in B-4-b.

**c.** If the action is initiated by the author and UI decides not to act, UI assigns to the author such rights as are necessary for the author to pursue redress. The costs are borne by the author, and the proceeds go to the author.

**B-8. Liability.** When either UI or the author of materials copyrighted by UI or its assignee is alleged to have violated personal or property rights, UI or its designated agent assumes responsibility for the defense against such allegation and the satisfaction of any judgment rendered against UI or the author except insofar as liability of governmental entities is limited by Idaho Code 6-903 as currently written or later amended.

**C. PATENTS.** All patentable inventions made by UI employees at any of its facilities in the course of projects or research programs carried on by UI or made by persons in the course of working on such programs

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or projects under contracts or agreements with UI belong to UI. The inventor(s) assign all such inventions, patent applications, and resulting patents as directed by UI. Any such inventions made by UI employees or such other persons in the course of their employment by or for UI or with the use of facilities (other than library resources and normal office use) owned by UI or made available to it for project or research purposes are deemed to have been made in the course of working on a research program or project of UI.

**C-1.** An invention made by a person wholly on his or her own time outside of his or her duties at UI and without the use of UI facilities (other than library resources and normal office use) belongs to that person, even though it falls within the field of competence relating to the person's UI position. This provision also allows any invention made by a person in the course of private consulting services carried out by the person in conformance with the UI's policy on professional consulting and additional workload [see 3260] to be assigned to the consulting sponsor.

**C-2.** UI and the Idaho Research Foundation (IRF) agree that all inventions made by persons in the course of working on a UI research program or project must be submitted to IRF for acceptance. If such property is accepted by IRF for development, management, marketing, licensing, or assignment in any manner for the purposes of this policy, UI must cause such property to be conveyed, assigned, or transferred to IRF. IRF has full power to manage such patent rights and to enter into contracts and licensing concerning such rights, including the right to join in agreements with other nonprofit patent-management entities. [rev. 7-97]

**a.** Upon submission of intellectual property to IRF, IRF must make a formal written decision to pursue commercialization for that property within three months or return the rights to UI. If IRF does not file for protection of the intellectual property within eighteen months of the date the disclosure was submitted, the rights are returned to UI. If IRF submits a provisional patent application for intellectual property protection, a "full" and non-provisional patent application must be submitted within nine months of the date of the submission of the provisional patent or the rights to the property are returned to UI. The property may remain with IRF for a second eighteen month period if both UI and IRF agree. [add. 7-97; ed. 7-98]

**b.** The IRF shall submit semi-annual reports, as long as it owns the property, to both the inventor/author and UI on 1) the status of the application until such time that protection is granted, 2) the marketing activities for the property being serviced, and 3) an accounting for funds received from the property. In the event that IRF has been unsuccessful in transferring a property or filing a patent application within three years after its first acceptance, IRF must notify UI in writing and the property shall be transferred to UI. [add. 7-97]

**C-3.** IRF will make provision to share the net proceeds, management, and licensing of any patent assigned to IRF as follows:

**a.** Legal and development expenses incurred by IRF constitute a lien on the net proceeds until paid.

**b.** Absent a valid written agreement to the contrary, the net proceeds in excess of such expenses shall be distributed as follows: 40 percent to the inventor(s), 40 percent to IRF for tax-exempt purposes, and 20 percent to the college or service unit of the inventor(s). At least half of the share allocated to the college or other unit is given to the inventor's department for use in furthering its goals.

**C-4.** Questions as to ownership of an invention or division of proceeds between inventors and departments are referred to the Intellectual Property Committee. The final decision is made by the provost after a review of the findings and conclusions of the committee and is binding.

**C-5.** As required by rule promulgated by the Regents (IDAPA 08.01.09.03c), the provost shall report two weeks in advance of the state board meeting on patent, copyright, and technology transfer activities that have occurred at the institution since the prior meeting of the board. With respect to patents, that report will also indicate whether employees of the institution or of its research foundation have a financial interest in the company to which the intellectual property was transferred. Terms of any licensee or technology transfer contract will be made available in confidence upon request for inspection by the state board.

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

**D-1. Intellectual Property Committee.** The Intellectual Property Committee is composed of five faculty members appointed each year by the Committee on Committees. The term of membership on the panel is three years, with initial terms staggered to form a rotation pattern. The Committee on Committees selects the chair.

**D-2. Recommendation by the Intellectual Property Committee.** The committee considers, investigates, and makes recommendations toward resolution of disputes concerning (1) ownership of maskworks and copyrightable and patentable materials, and (2) allegations or unauthorized use or copyright infringement of UI sponsored materials. It reviews all relevant evidence submitted to it before making its recommendation to the provost. The committee's recommendation is to be made no later than 60 days after receiving the matter for consideration. The committee's recommendation is determined by a majority of all its members voting by secret ballot. No member participates in any matter in which his or her ownership rights are being determined.

**D-3. Decision by the Provost.** After receiving the recommendation of the committee, the provost makes a decision concerning ownership or infringement. The provost's decision is made no later than 30 days after receiving the committee's recommendation. That decision is transmitted in writing to the author or inventor and to his or her departmental administrator and dean.

**E. SPECIAL ARRANGEMENTS FOR FEDERAL, STATE, AND PRIVATE GRANTS.** Nothing in this policy shall prevent UI from accepting research grants from, and conducting research for, agencies of the United States upon terms and conditions under applicable provisions of federal law or regulations that require a different disposition of patent rights. Moreover, nothing herein shall prevent cooperative arrangements with other agencies of the state of Idaho for research. Where receipt of a grant in support of research from any nonprofit agency or group may be dependent upon acceptance of terms and conditions of the established patent policy of the grantor that differ

from those stated herein, UI may specifically authorize acceptance of such grant upon such terms and conditions. UI may also specifically authorize contractual arrangements with an industrial sponsor for different disposition of patent rights resulting from its sponsored research.

**F. RECORD-KEEPING.** See 5500 for record-keeping procedures that are recommended in order to safeguard the property rights of UI or the faculty member in research and potentially patentable results.

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