



Inventions and Patents # 2390.001

INITIAL EFFECTIVE DATE:	LAST REVISION DATE:	RESPONSIBLE UNIVERSITY DIVISION/DEPARTMENT
July 2005	November 8, 2021	Office of Research and Economic Development

POLICY STATEMENT

This Policy and its procedures will not affect any agreements entered into prior to the effective date of this Policy.

University Ownership

As a condition of the University’s provision of employment, funds, services, facilities, equipment or materials to the Inventor, the University acquires and retains title to all Inventions made within the scope of University employment or research, or created with University Support or made in the field or discipline in which the Inventor is employed by the University (i.e., the field or discipline in which the Inventor conducts research, teaches, and/or provides service activities for the University). Such Inventions and related rights shall be the property of the University and are hereby assigned to the University by those covered under the scope of this Policy.

Independent Efforts

All Inventions made with Independent Efforts are the property of the Inventor, who has the right to determine the disposition of such Inventions and revenue derived from such Inventions. Nonetheless, the Inventor and the Vice President for the Office of Research and Economic Development (ORED) (or designee) may agree that the patent for such Invention be pursued by the University and the proceeds shared between the University and the Inventor as per the below License Revenue Allocation section.

Inventions Arising from Sponsored Research

Inventions resulting from research funded wholly or in part by an outside sponsor are subject to this policy as modified by the provisions of the research agreement covering such work with the sponsor. Employees engaged in sponsored research are bound by the provisions of the agreement(s) between the University and the sponsor.

Title to any Inventions conceived or first reduced to practice in the course of research supported by federal agencies, industry, or other sponsors generally vest in the University.

With respect to federally funded subject Inventions, the Inventor shall hereby assign all right, title and interest in and to each subject Invention made under a federal grant to the University.

If an Inventor is unsure whether an Invention would be University-owned (i.e., an Invention arising out of Independent Efforts), the Inventor should nonetheless disclose the Invention to the Vice President for ORED (or designee), providing all relevant facts necessary to make the determination of whether the invention is University-owned or not. The Vice President for ORED (or designee) shall advise the Inventor in writing whether it appears that the Invention should be regarded as University-owned.

Upon the University's request, the Inventor(s) shall assign his/her/their right in a University-owned Invention to a third-party designee such as an invention management agency designated by the University, or to a sponsor if required by an agreement governing the research. Inventors shall execute documents of assignment and do everything reasonably required to assist the assignee(s) in obtaining, protecting, and maintaining patent or other proprietary rights. At no time, shall the Inventor(s) commit any act that would tend to reduce or defeat the University's interest in the Invention. The Inventor(s) shall take all necessary and reasonable steps to protect the University's interest in the Invention.

Outside Activity and Invention Rights and Obligations

Before engaging in an outside activity, the employee must get approval of any potential conflicts of interest following the University's Conflict of Interest (COI) policy (<https://policies.fiu.edu/policy/106>). Any requirement that a University employee waive his/her/their or the University's rights to Inventions which may arise during the course of such outside activity must be approved in accordance with the COI Policy prior to the employee engaging in the outside activity. Invention (and other) clauses in consulting agreements must be consistent with both the COI policy and this Policy and with University commitments under sponsored research agreements. An employee who proposes to engage in such outside activity shall furnish a copy of this Policy to the outside employer prior to engaging in the outside activity.

License Revenue Allocation

The University and the Inventor are entitled to income from licensed Inventions; the University on the basis of employment, facilities and other support for the Inventor and the cost of intellectual property administration and protection; and the Inventor on the basis of creative activity, documenting the Invention, and assisting, as necessary, with patent protection process and commercialization.

The Vice President for ORED shall share with Inventor(s) any licensing revenue (without deducting for any patenting, patent maintenance or marketing expenses) received from the licensing of an Invention, the license revenue will be distributed as follows: forty percent (40%)

to the Inventor(s), ten percent (10%) to the Inventor(s)'s College, and fifty percent (50%) to the University. The fifty percent (50%) retained by the University shall be used for research purposes and for recovery of expenses related to the patenting and marketing of an Invention.

The University shall make distributions annually. No adjustments of prior distributions will be made.

If there are multiple Inventors, the percentage allocable to each of the Inventors shall be determined amongst the Inventors. If, however, the Inventors cannot reach an agreement on how the forty percent (40%) that the Inventors are allocated will be apportioned amongst the Inventors within ninety (90) days of the Invention being licensed, then the Inventors will automatically receive an equal share. If there are multiple Inventors and Inventors are not in the same College, the sharing amongst the different Colleges of the ten percent (10%) will follow the percentage split the Inventors decide amongst themselves, or if there is no agreement will be equally shared, as the case may be. An Inventor may prospectively waive in writing the receipt of a portion or all of his/her/their share of revenue received by the University under a license. The following conditions apply:

- The Inventor, at the time of the waiver, may designate his/ her/their laboratory or research program, department, or other University unit as the recipient of the waived amount. The waived funds will be regarded as regular University funds subject to all of the usual and customary legal and administrative requirements of the University.
- To ensure that the use of the funds is consistent with the broad mission of the University, or to avoid financial imbalances or hardships within or among University units, the Office of the Provost, in consultation with the Vice President for ORED, dean or deans of the involved units must approve a plan for the designation of funds submitted by the Inventor, and, thereafter, may review the use of the funds at any time. It is expected that the waiver plan will be approved only with the concurrence of the dean of the receiving unit.
- The waiver must be irrevocable during the period proscribed by the Inventor and executed prior to the end of the fiscal year in which the revenue is generated.
- Funds directed to the Inventor's research laboratory or program may only be used to support research and educational expenses associated with the Inventor's research laboratory or program. The funds must be deposited in a designated account of the Inventor's laboratory for use only for research. Such research expenses must be made conforming to the same rules applicable to direct costs on federally sponsored research grants. Only such direct costs that are customary, allowable and appropriate in supported or organized research may be made from those accounts.

SCOPE

This policy applies to all faculty (bargaining and non-bargaining), staff, and other employees at Florida International University (University). This policy also applies to FIU students who



are FIU employees, students working on a sponsored project, and students who have used University Support in arriving at the Invention (other than for lecture-based coursework).

REASON FOR POLICY

Central to the mission of Florida International University is the promotion of teaching and research that enhances public service, leads to the discovery of new knowledge and fosters creativity and innovation. Inventions and marketable forms of intellectual property may result from research conducted by personnel and students at the University. It is generally in the best interest of the University and the public to ensure that such intellectual property be appropriately developed. This policy sets forth the circumstances and procedures under which Inventions are to be disclosed to the University, and the procedures that the University will employ to review and process such inventions. This policy is promulgated pursuant to Florida Statute Sections 1004.22 and 1004.23, the Bayh-Dole Amendments Public Law 96-517 entitled "The Patent and Trademark Amendments Act of 1980," and the Act's rule revisions having document citation of 83 FR 15954.

DEFINITIONS

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TERM	DEFINITIONS
Assignment	Is a written contract that transfers title to and interest in an Invention, patent or patent application.
Independent Efforts	Refers to Inventions made using no University Support and made outside the field or discipline in which the employee is employed by the University.
Invention(s)	Shall have the meaning assigned by the U.S. Patent and Trademark Office; i.e., any art or process (way of doing or making things), machine, manufacture, design, or composition of matter, or any new and useful improvement thereof, or any variety of plant, which is or may be patentable under the patent laws of the United States. (37 CFR 501.3(d)). See http://www.uspto.gov/patent . "Invention" also includes both patentable and non-patentable innovations; any discovery; process; composition of matter; article of manufacture; know-how; design; model; software; database; technological development; biological material, strain, variety, or culture of any organism, or portion, modification, translation, or extension of these items which is or may be patentable, and/or any directly related know how used in connection with these items. An invention is deemed to be "made" when it is conceived or first actually reduced to practice.
Inventor	A person who contributes to the conception of an invention. A project supervisor is not entitled to Inventor status simply because of his/her/their supervisory role; an inventive contribution is the



	singular criterion. The determination of who has made an inventive contribution may be difficult when several researchers and students have been involved in a project. If there is doubt concerning a person’s inventor status, it is best to grant tentative inventor status at the time of disclosure and such status will be clarified, if and when, a patent application is filed. The term “Inventor” or “Inventors” shall be deemed to each refer to the singular or plural, as appropriate, or interchangeably.
License	An agreement granting another party the right to make, use and/or sell a patented invention without the transfer of title to the patent.
Royalty	Is a payment to the owner of an invention for the use of that invention, frequently in the form of a stated percentage of sales.
Royalty-Free	Is a license wherein the licensee is not required to pay royalties to the owner of an invention under specified conditions.
University	Is Florida International University.
University Support	Any use of University funds, personnel, facilities, confidential information, trade secrets, equipment, materials, or technological information, and includes such support provided by other public or private organizations when it is arranged, administered or controlled by the University.

ROLES AND RESPONSIBILITIES

The President has designated the Vice President for Research and Economic Development as the officer of the University to administer, apply and interpret the provisions of this policy. The Office of the Vice President for Research and Economic Development shall coordinate the efforts regarding the evaluation and pursuit of legal protection and commercialization of Inventions.

The University and/or the FIU Research Foundation, Inc., as appropriate, shall have the sole authority to determine whether, and if so, the manner in which Inventions shall be commercialized, including but not limited to, negotiating all contracts related to commercialization of the Inventions, such negotiation to be conducted by the Office of the Vice President for Research (or its designee) and Economic Development and the FIU Office of the General Counsel.

RELATED RESOURCES

N/A



CONTACTS

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HISTORY

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Review Dates (*review performed, no updates*): January 12, 2024

Revision Dates (*updates made to document*): November 8, 2021



Inventions and Patents #2390.001a

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PROCEDURE STATEMENT

Disclosing an Invention

Inventors shall fully and completely disclose to the Vice President for the Office of Research and Economic Development (ORED) or designee all Inventions which the Inventor(s) develops or discovers:

- while an employee of the University; or
- within the employee’s field or discipline; or
- resulting from any work performed by the employee for the University; or
- by using University Support; or
- while working on a University supported research project.

Invention Disclosures are to be submitted electronically at <http://research.fiu.edu/disclosure/>. This link also provides detailed information regarding how to submit the disclosure and the subsequent steps in the process after submission.

The Inventors shall cooperate with ORED during the Invention review and analysis process, and the patent application and commercialization process, if applicable. A complete disclosure is essential for accurate technical evaluation of the Invention, assessment of its commercial feasibility, and determination of its patentability. Moreover, it may be used in preparing a patent application, if it is determined that patent protection will be pursued. Additionally, where dated and witnessed laboratory notebooks are not available, the disclosure serves as proof of the Invention’s conception and may help to determine, in any controversy, who conceived the Invention.

University Evaluation and Disposition of Disclosed Invention

After receipt of a full and complete Invention disclosure form, the Vice President for ORED (or designee) shall conduct an invention evaluation process of the technical, legal, and marketing strengths and weaknesses of the Invention. Such evaluation will be done within one-hundred twenty (120) days of the receipt of a full and complete Invention disclosure form being received. This evaluation may be done in consultation with the Inventor(s), the FIU General Counsel’s Office, outside counsel, prospective licensees, third-party evaluators or consultants

and/or the appointment of such a committee as advisable to assist in the review of the Invention disclosure and to advise on, and recommend, the manner of disposition of the Invention. At the conclusion of such evaluation, the Vice President for ORED (or designee) shall make a determination about the disposition of the Invention. The Vice President for ORED (or designee) shall inform the Inventor of the University's decision regarding the University's interest in the Invention and the disposition of the same.

The University, at the discretion of the Vice President for ORED (or designee) may dispose of an Invention in some of the following ways:

- the University may pursue patenting and commercialization of the Invention. The University shall have the sole discretion and right as to all matters concerning the legal protection and commercialization of the Invention including, but not limited to, where and when a patent application shall be filed, what attorney shall be used for the same and negotiating and entering into or modifying an option, a license or other agreements covering the manufacture, importation, use and/or sale of University-owned Inventions;
- if the University utilized third-party evaluators or consultants to review the Invention disclosure, and a third-party evaluator or consultant exercised an option to seek commercialization of the Invention on a royalty-sharing basis, the University shall, as required by an agreement with the third party-evaluator or consultant, work with the third-party evaluator or consultant on the commercialization of the Invention and share in the royalties derived there from with that third-party evaluator or consultant;
- if the sponsored research agreement for the project from which the Invention emanated offered the sponsor an option to obtain a license or other rights in an Invention, the University will endeavor to obtain the sponsor's decision regarding the exercise of such rights within the time specified in the sponsored research agreement, or if no time is specified, within a reasonable time;
- the formation of a commercial enterprise to pursue patenting and/or commercialization of the Invention such as a "start-up" company described below;
- notwithstanding the manner of disposition of the Invention by the University, the Invention shall at all times be available royalty-free for use by the University and the State of Florida;
- such other disposition as may be agreed to in writing between the University and the Inventor(s).

Effect of Non-Confidential Invention Disclosures on Patent Protection

Invention disclosures to ORED are made on a confidential basis. As a public institution, the University should undertake sponsored research only when the results can be freely published. However, public disclosure of patentable material may affect some patent rights depending on the timing of those disclosures. A public disclosure may result from the publication of a journal article, the placement of a graduate student thesis in the library, a presentation at a conference, a poster presentation, or the release of technical information to a person not bound by a

nondisclosure/confidentiality agreement. The public disclosure of an Invention prior to filing a patent application may bar obtaining a valid patent. In the U.S. a patent application must be filed within one (1) year of a public disclosure. Most foreign patent rights will be forfeited upon public disclosure of the Invention if a patent application was not previously filed. The best procedure is to file a patent application before public disclosure takes place. The University understands the Inventors' desire for public disclosure of their work and does not wish to impede that dissemination. The University's review of Invention disclosures will be done as expeditiously as possible. In order that such review may be done prior to public disclosure, Inventors are cautioned to submit the Invention disclosure with sufficient lead time prior to anticipated public disclosure so as to allow the University sufficient time to properly review the Invention, decide if a patent application should be filed, and process the application prior to the public disclosure. Once a disclosure is timely made, the Office of the Vice President for Research and Economic Development (or designee) will work as diligently as possible so that faculty may continue with scholarly publication.

There are some reasonable procedures that can address the tension between the desire for public disclosure and preserving patent rights. For example, a thesis that has been catalogued and made accessible may constitute a public disclosure. In order to gain time for patenting consideration, the Inventor or Vice President for ORED (or designee) may petition the Dean of the Graduate School to temporarily withhold public access of the thesis until patenting considerations are evaluated.

Another example is that the University normally will not agree to sponsored research agreements that contain limits on the University researchers' right to publication. However, where patent protection issues are involved, the University may agree that publication may be deferred for a reasonable time during which the University and the sponsor can review the feasibility of patent coverage or other protection on an invention described in the publication. The University may also agree that, when publication of research involving proprietary data is contemplated by University researchers, the researchers may provide the sponsor with an advance copy of the manuscript prior to publication to allow the sponsor an opportunity to identify any inadvertent disclosure of proprietary or confidential data.

Laboratory Notebooks

Inventors are asked to maintain accurate, timely and witnessed laboratory notebooks as they are helpful in preparing an invention disclosure. It is an expectation that all faculty and staff engaged in original research and inquiry create and maintain contemporaneous accurate records that are witnessed and dated in a routine and systematic matter according to their respective disciplines. These documents should be kept in a manner that allows verification by audit of the timing and content of the information contained therein. Although the United States has moved to a first-to-file system, it is still helpful to keep accurate records in order to document the Invention and establish who the true Inventors of the Invention may be.

Equity in Start-Up Companies

The University may determine that the best course of action with reference to an Invention disposition is to take an equity position in a company that will pursue the patent protection and/or commercialization of the Invention. This equity position may be maintained by the University or by the FIU Research Foundation, Inc. and reference to "University" in this section shall also be deemed to refer to FIU Research Foundation, Inc. Ownership of such equity interests shall be at the sole discretion of the University and in accordance with all applicable securities laws, University policies and procedures, and other applicable laws and regulations. The University shall have the sole and exclusive authority to manage such equity interest including, without limitation, to make all decisions pertaining to liquidations, sales, distributions, and early distributions, including their timing, manner, and method.

One example of this type of situation is where the University receives equity in a start-up or developing business venture as part of a licensing agreement with that start-up for an Invention. Another example might occur when an employee of the University utilizes the expertise and/or technology he/she/their has developed in the course of University employment and assists a business venture in the commercialization of the Invention. (A "start-up" or developing business venture includes corporations, partnerships, or other commercial enterprises.)

There may be situations in which both the University and its employees separately own equity interests in a business venture. In such circumstances, the employee's equity interest is considered to be independent of the University's equity interest and is not held, managed, disposed of, or distributed by the University. The Inventor's equity interest may render the employee ineligible to receive a distribution of a portion of the University-owned equity interest or the proceeds from sale of such.

Release of University Interest in Inventions

At any stage of evaluating a disclosure, applying for a patent, or in the commercialization process of an Invention, if the University has not otherwise assigned to a third party the right to pursue the same, the Vice President for ORED (or designee) may elect to withdraw from further involvement in the patent protection or commercialization of the Invention. At the request of the Inventor in such case, and upon terms mutually agreed upon between the Inventor(s) and the University (i.e., University receiving ten (10%) percent of any commercialization revenue for its support in developing the Invention), the University shall transfer its rights in the Invention to the Inventor(s). In such cases, the Inventor will indemnify and hold harmless the University for any actions, claims or damages resulting from the Invention. If outside funds supported the project leading to the Invention, this transfer is subject to any provisions of a sponsoring agreement. In addition, the transfer shall not affect the right of the University or the State of Florida to royalty-free use of the Invention, nor shall



such transfer be granted until all pre-existing commitments to a sponsor, if applicable, with regard to the Invention are fulfilled. After transfer to an employee, the Invention shall be the employee's property and any costs already incurred by the University or on its behalf shall not be assessed against the employee. Note that if the Invention was funded by a federal agency, a release of the invention by the University will be to the federal sponsoring agency as per federal law; the Inventor(s) may then seek title to the invention from the sponsoring federal agency.