

University Senate Research Committee Meeting
29 August 2018
1:00 PM
156 CL

In Attendance: N. Bircher, C Bonneau, E. Chasen, D. Curran, D. DeAlmeida, D. Harrell, M. Madison, R. Melhem, P. Morel, R. Rutenbar, D. Salcido, P. Smolinski, B. Yates

Those in attendance introduced themselves.

R. Rutenbar stated that in the spring of 2018 there was a change in the wording of the Bayh-Dole Act (B-D) that mandated a change to University of Pittsburgh Intellectual Property Assignment Option 3 form. The change in wording was published in the Federal Register in April of 2018. He stated that the change in wording made it mandatory for the University to acquire intellectual property (IP) rights for IP created under federally sponsored research. He passed out a memo (Recent and Planned Changes in Pitt IP Assignment Forms) to the Committee (Appendix I). This memo contained the draft for a new IP assignment form (Option 3+). He reviewed the draft Option 3+ form. At present, all signing of the IP assignment issued in August has been put on hold until the new form is approved. This form will supersede all previously signed forms and includes a bullet that specifically assigns IP to the University in the case of research supported by Federal grants. This new form preserves ownership of scholarly works and is in compliance with the new Federal regulations.

In addition, R. Rutenbar stated that his office would be working over the next year to revise the IP policy. He will assign a new committee to finish the work that had been started on this under Mark Redfern. The hope is to create a robust policy that will only require a single IP assignment agreement, and thus replace the existing options 1, 2 and 3.

The form was opened up for discussion

D. Curran stated that wording in the Bayh-Dole Act reads “may” not “must” take ownership.

M. Madison stated the wording to the Bayh-Dole Act remains unchanged. He stated in the Stanford v. Roche decision the court ruled that the University needed a signed form to acquire IP from the inventor. He said the time of assignment of IP to the contractor under B-D has not been defined.

A question was brought up whether B-D requires graduate students to assign IP to the University.

R. Rutenbar stated that graduate student assignment of IP is not required. He further stated that assignment of IP could potentially be done electronically with federal grant submission, however, feedback from the Deans stated that the deadlines of award submission can make that time particularly hectic.

N. Bircher asked if language in forms could be changed to read “subject inventions” and not all IP. It was pointed out that the new bullet 4. refers specifically to subject inventions. M. Madison stated that the application of B-D to IP is unclear at this time in that there is little case law. He stated the definition of subject inventions can be done by citing B-D or by the University patent policy. N. Bircher stated that a regulatory standard could be cited.

Action Item: It was agreed that bullet #4 should be amended to include reference to the B-D definition of the term “subject invention” for increased clarity. R. Rutenbar agreed to make this change, following consultation with the legal staff.

D. Curran asked if it is necessary for Post-Doctoral researchers to sign the IP form.

R. Rutenbar stated that there are many different types of Post-Doctoral researchers with some being trainees and others being researchers. As of right now Postdocs are not being asked to sign the form, although this is under some discussion. He said that those listed as “key personnel” on grants would be required to sign an IP form.

D. Curran asked if the IP form included copyrights.

R. Rutenbar stated that the revised Option 3+ IP form has a statement to deliberately exclude copyrights even though this statement maybe redundant. Two options for the statement are included.

M. Madison said the statement on excluding copyrights would be helpful to those concerned about copyrights and not patent IP. He stated that he had a preference for the second option for this statement

E. Chasen asked at what time would people be asked to sign the form. N. Bircher said that a signature of the form could be requested at grant activation. R. Rutenbar agreed that the IP assignment could be made at the time of grant activation

R. Rutenbar agreed that it would have been preferable to get faculty input during the summer and asked if it were possible for the Committee to have a summer meeting.

P. Morel said this could be possible in necessary situations, since many of the faculty are on campus during the summer. N. Bircher stated there is an option for summer meetings of the Faculty Assembly when needed. These are scheduled and although they are rarely used they can be initiated should the need arise.

Overall the committee felt that the revised IP assignment form was a big improvement and the committee leadership will present to Faculty Assembly on September 4, 2018. If the revised form is available by then, it will be presented to Faculty Assembly. R. Rutenbar said he would attempt to get the revision to the committee by then, but noted that there were additional people that would be consulted. He also noted that there was

some urgency in getting this resolved such that the University can be in compliance the revised B-D regulations.

P. Smolinski stated that future Committee business may include efforts to define the needed of community-based and non-funded researchers.

Future meetings will return to Fridays. The next meeting of the committee will be September 28 at 1 PM in CL156

The meeting was adjourned at 2:20 pm.

Minutes submitted by P. Smolinski and P. Morel.

Appendix I



University of Pittsburgh

Office of the Senior Vice Chancellor for Research

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Rob A. Rutenbar, PhD
Senior Vice Chancellor for Research

TO: University of Pittsburgh Senate Research Committee
FROM: Rob A. Rutenbar, Sr Vice Chancellor for Research
SUBJECT: Recent and Planned Changes in Pitt IP Assignment Forms
DATE: August 28, 2018

On August 1, 2018, the Office of Senior Vice Chancellor for Research (OSVCR) announced a set of changes to Pitt's Intellectual Property (IP) Assignment forms and procedures. This was necessitated by a set of changes in the federal Bayh-Dole regulations¹, that were published in April 2018, and became effective May 14, 2018.

For context, the Bayh-Dole regulations implement the Bayh-Dole Act, passed in 1980 to allow institutional recipients of federal research funding to elect legal title to inventions created through use of federal funding. As a result of a prominent Supreme Court case in 2011 (*Stanford v. Roche*), it became standard practice for all research universities to establish clear mechanisms for their employees to assign rights to such IP to the university. Pitt established such IP Assignment procedures in 2014, and created three IP Assignment Options: Options #1, #2, and #3. At the same time, the University chose to undertake a significant policy update process for the IP policy, because of broader concerns about its structure, and several inadequacies in comparison with peer research schools.

The problem arising from the May 2018 change in federal Bayh-Dole regulation was that the Pitt IP Assignment Option #3 – which was, in effect, a promissory note, an acknowledgment of an obligation to sign, without actually assigning the IP – became *non-compliant*. The new Bayh-Dole rule changed the landscape of IP assignment for places like Pitt, that receive federal awards, from being an accepted “best practice”, to being *mandatory* for all those receiving federal funds.

These regulation changes were unfortunate for several reasons. First, they disrupted a stable set of assignment policies. Second, they became public at the end of an academic semester, with a very short (30 day) window to operationalize. Our office, working with the Pitt Office of General Counsel (OGC) spent some weeks working to determine if our existing Option #3 could comply with the new rules, but ultimately it was determined #3 was not compliant. For Pitt to continue to receive federal awards, it became necessary to change the assignment forms, and to do so during the summer, when critical partners in the Pitt governance structure, such as the

¹ [Rights to Federally Funded Inventions and Licensing of Government Owned Inventions: A Rule by the National Institute of Standard and Technology on 04/13/2018.](#)

Faculty Senate Research Committee, are not meeting. Third, the new rules also made a large set of other “back office” changes to how and when Pitt is required to report IP disclosures, patent activity, and the like, to the federal government, which are themselves rather complex.

Working with OGC, our office worked to design a single, *unified* IP Assignment form (See Appendix A) which could replace all three of the previous forms #1 #2 and #3. It was also determined, mid-summer, that it appeared that graduate students were also subject to these new rules. We published the new form and procedures on August 1. Subsequently, we received significant feedback from researchers across Pitt about concerns about the new unified assignment form and procedures. Prominent among these were (i) the lack of a #3-style option for deferred IP assignment for non-federal awards, (ii) lack of clarity about whether “Scholarly Works” that are protected by Pitt’s Copyright policy² were included in this new Bayh-Dole rule; and (iii) questions about graduate students’ need to participate in these new IP rules.

Based on this useful feedback, on August 17, 2018, we decided to “pause” the new IP assignment rules and procedures, and work to redesign them to address these concerns. Again working closely with OGC, we have found a way to preserve most of the structure of the previous IP Assignment procedures, by introducing a proposed, new “Option #3+” form (see Attachment B; changes from Option 3 are *highlighted*). The new strategy has the following features:

- **Three Assignment Options, Again:** It returns to the familiar Options #1 #2 #3 format, with Options #1 and #2 unchanged.
- **Minimally Updated Option #3:** Option #3+ is essentially identical to the old Option #3 – an acknowledgement of an obligation to assign – but with the two modest changes. First, for federal awards that are subject to the new Bayh-Dole rules, it immediately assigns *only* the IP from these federally funded efforts. And second, it clearly and specifically acknowledges that Scholarly Works are *excluded*, as per Pitt copyright policy, from this new assignment.
- **Faculty/Staff Only:** We have also determined that we are *not required* to ask students to execute any of these IP assignment options as part of the new Bayh-Dole. So, as per the previous assignment procedures, we will focus only on research faculty/staff.

We believe this is a positive response to the overall set of concerns voiced by our Pitt researcher colleagues, and that we can roll these out with minimal impacts on working researchers.

Finally, another area of concern voiced was lack of clarity on the status of the overall IP Policy redesign effort, that was launched after the initial 2014 IP assignment discussion. The original form of IP Assignment Option #3 was introduced by the Provost in October 2014; the IP Committee under then Vice Provost for Research Mark Redfern was charged on June 22, 2015, and deliberated over 2015 and 2016. In January of 2017 this IP Committee had an incomplete draft version of some facets of a new IP policy, but ceased to meet while waiting for the arrival

² [University of Pittsburgh Policy 11-02-02: Copyrights](#)

of Rutenbar in the new Senior Vice Chancellor for Research (SVCR) role to assume responsibility to move this forward. For context, note that prior to 2017, the position of SVCR, reporting directly to the Chancellor, and with institution-wide responsibility for all Pitt's research infrastructure and strategy, did not exist. Instead, the various units were distributed across the campus, and the most prominent position was that of Vice Provost Redfern, reporting to the Provost.

In July 2017, Rutenbar arrived and assumed the SVCR role, and was tasked with two Pitt policy redesign efforts: the Conflict of Interest Policy (COI), and the IP Policy. Completion of the COI policy – and in particular presenting this rather complicated and vastly updated policy initiative to all the critical Pitt governance stakeholders for input and advice – was judged to be the highest priority. This policy work consumed the entirety of AY17-18. It is the goal of our office to take up the IP Policy as our next policy priority, and work to complete this redesign effort, in AY18-19, again working closely with key Pitt stakeholders, most notably this committee.

We note, in closing, that it is possible for IP Assignment forms and procedures to be relatively *simple* and *shorter* (and not requiring of three separate forms), when the underlying IP Policy of the institution is well constructed and widely understood. This seems clearly to be a source of our current difficulty, as well as a source of frustration for working researchers. We include two examples of IP Assignment forms, from two peers, for comparison:

- **Boston University** (former home of our new Provost, Ann E. Cudd; see Attachment C). the entire agreement in less than 150 words – because it is able to refer to a robust, and well-designed IP policy for the university.
- **Cornell University** (see Attachment D). The core of the assignment is less than 100 words (item 1 in the list, highlighted); the other items acknowledge that the signer has read the agreement, won't enter into other conflicting assignments to other entities, agrees to disclose new inventions, etc.

Our next goal is to rebuild the IP Policy in a way that is widely understood and agreed to by the broader Pitt research community, and by so doing, allow us to move to a much simpler IP Assignment strategy, in a way consistent with our strong research peers.

ATTACHMENT A: August 1, 2018 “Unified” IP Assignment Form

**UNIVERSITY OF PITTSBURGH
INTELLECTUAL PROPERTY ASSIGNMENT**

Effective July, 2018

I understand and acknowledge that the University of Pittsburgh has policies regarding the ownership of intellectual property, as outlined in University Policy No. 11-02-01, Patent Rights and Technology Transfer and University Policy No. 11-02-02, Copyrights (hereafter, the “Policies”), which may be revised from time to time. I also understand that the University of Pittsburgh’s funding agreements with third parties, including the United States Government, impose certain obligations upon the University, its faculty, staff and students with respect to rights in inventions. I further understand that the Policies affirm my copyright ownership in scholarly works as defined therein. In consideration of my employment and/or my use of or access to resources at the University of Pittsburgh and with the intent to be legally bound, I agree as follows:

1. I will abide by the University’s Policies noted above, and I will submit any invention disclosures, and execute any confirmatory assignments or other documents necessary (a) to comply with the Policies and (b) to confirm ownership of intellectual property by the University as required by the Policies. In some cases, the University may waive ownership after disclosure, review and an acknowledgement signed by the University.
2. Subject to the terms of the Policies, I hereby irrevocably assign and transfer to the University my rights, title and interest to all intellectual property that I conceive, create and/or invent during my employment or association with the University and to which the University has rights pursuant to the Policies.
3. I certify that I have no agreements with or obligations to others in conflict with this assignment and transfer, except as identified on the reverse side of this document or on pages attached to this document, and I will not knowingly enter into any such agreement in the future.
4. I agree and intend for this Agreement to supersede the Intellectual Property Rights Assignment Agreement or Intellectual Property Rights Agreement which I may have executed on or after August 4, 2014. This Agreement supersedes no other assignment agreements made with the University.

Date

Signature

Name (Print or type)

Department and School

A pdf copy of the fully executed form should be sent to IPAssignmentform@pitt.edu, and the original must be filed with the Innovation Institute. Attn: Sandy Latini, 200 Gardner Steel Conference Center, Pittsburgh, PA 15260.

ATTACHMENT B: Proposed New Option 3+ Pitt IP Assignment Form

University of Pittsburgh

Intellectual Property Rights Agreement and Assignment for Federally Funded Awards

I understand and acknowledge that the University of Pittsburgh (the "University") has a policy regarding the ownership of intellectual property as outlined in University Policy No. 11-02-01, Patent Rights and Technology Transfer (hereafter, the "Policy"). In consideration of this agreement, my use of or access to resources at the University of Pittsburgh, the terms and conditions of my employment, and intending to be legally bound, I agree as follows:

1. I agree to abide by the Policy noted above and to submit any invention disclosures and execute any confirmatory assignments or other documents necessary to establish and protect the government's or any other sponsor's rights in the intellectual property.
2. I certify that I have no agreements with or obligations to others and have taken no actions that are in conflict with this Agreement or that limit my ability to comply with the obligations set forth in Paragraph 1 and Paragraph 4 below, except as identified on the reverse side of this document or on pages attached to this document. I will not knowingly enter into any such agreement in the future
3. I agree and intend for this Agreement to supersede the Intellectual Property Rights, Assignment Agreement which I may have executed on or after August 4, 2014. This Agreement supersedes no other assignment agreements made with the University.
4. If I am listed on the budget of any federal grant, award, or contract (a "Federal Award"), upon the University's activation of such Federal Award, I hereby assign and transfer to the University my rights, title, and interest to subject inventions I create under the Federal Award.

My copyright(s) in my Scholarly Work, as defined by the University's Copyright Policy (11-02-02), will not be covered by this Agreement or Assignment.

[OR]

[This Agreement and Assignment will not affect my ownership of or my rights to the copyright(s) in my Scholarly Work(s) as defined by the University's Copyright Policy (11-02-02).]

Date

Signature

Name (Print or type)

Department

A pdf copy of the fully executed form should be sent to IPAssignmentform@pitt.edu, and the original must be filed with the Innovation Institute. Attn: Sandy Latini, 200 Gardner Steel Conference Center, Pittsburgh, PA 15260.

ATTACHMENT C: Peer IP Assignment Form – Boston University

Intellectual Property Agreement

I affirm that I have received and have read the Boston University Intellectual Property Policy. In consideration of the provision by Boston University of support in the form of funds, space, personnel, employment, facilities, instruction, supervision, or other assistance, I hereby accept, and will abide by, and fully comply with the policy, including any amendments or modifications of that policy that are approved by the University in the future, as determinative of my rights and obligations in relation to any discoveries or patentable inventions. I further agree to assign and do hereby assign to the Trustees of Boston University all my right, title, and interest in such intellectual property that is subject to this Policy. I agree to execute and deliver all documents and do any and all things necessary and proper on my part to effect such assignment.

Signature

Date

Name (please type or print)

Department

Institution

ATTACHMENT D: Peer IP Assignment Form – Cornell University

CORNELL UNIVERSITY

Office of the Vice President for Technology Transfer, Intellectual Property and Research Inventions and Related Property Rights Assignment Form

Last updated June 7, 2017

Instructions for ALL CORNELL UNITS. This form must be signed and submitted by anyone receiving a university appointment to an academic position, including those with modified titles (visiting, courtesy, adjunct, etc.), clinical and affiliation appointments, regardless of pay, percent time, or duration, and assistantship and fellowship appointments (e.g., research and teaching assistant, graduate research assistant, fellowship recipient, and training grant recipient). See University Policy 1.5 Inventions and Related Property Rights https://www.dfa.cornell.edu/sites/default/files/policy/vol1_5.pdf

Signing and submitting this form is a condition placed on receiving a Cornell University appointment or being granted access to university resources. Modifications to this form are not permitted.

Individuals having a principal employer other than Cornell University and whose pre-existing invention and property rights agreement conflicts with Cornell's policy may be eligible to sign an alternate form. Questions should be directed to Patricia A. McClary, Deputy University Counsel, at pam4@cornell.edu or 607-255-5124.

Questions about the use of this form should be directed to the Office of the Vice President for Technology Transfer, Intellectual Property and Research Policy at vp_research@cornell.edu or 607-255-7200.

INVENTIONS AND RELATED PROPERTY RIGHTS ASSIGNMENT

1. I agree to assign and do hereby assign to Cornell University all right, title, and interest in any Cornell Invention as defined in Cornell Policy 1.5 Inventions and Related Property Rights, i.e., a novel creation, discovery, and/or idea that may be protected by patent, plant variety protection certificate, plant breeder's right, international treaties, or similar intellectual property right resulting from activities carried out in furtherance of my University Responsibilities, and/or with the use of University Resources including but not limited to a grant, contract, award or gift made to Cornell ("Cornell Invention").
2. I agree to familiarize myself with and comply with the provisions of Policy 1.5 Inventions and Related Property Rights as amended from time to time.
3. I agree to disclose promptly any Cornell Invention through an enabling Invention Disclosure submitted to the Cornell Center for Technology Licensing (CTL) .
4. I understand that Cornell shares license revenue with inventors in accordance with the revenue distribution provisions of the Policy 1.5.
5. I am not now under any consulting or other obligation to any third party, organization or corporation with respect to rights in any invention that is, or could reasonably be construed to be, in conflict with this agreement.
6. I will not enter into any agreement creating obligations in conflict with this agreement.
7. Electronic signatures and those transmitted by facsimile or portable document format (PDF) shall be deemed valid as original signatures. This Inventions and Related Property Rights Assignment shall not be denied legal effect, validity, or enforceability solely because an electronic record and electronic signature may have been used in its execution. Similarly, any photocopy or facsimile of this fully executed Assignment shall have the same legal force as any copy bearing original signatures.

Signed: _____ Date: _____

Printed Name: _____ Position Title: _____

Department: _____