

On Sep 8, 2014, at 2:33 PM, "Patricia Beeson" <[beeson@pitt.edu](mailto:beeson@pitt.edu)> wrote:

Dear Michael:

Thank you for your thoughtful questions regarding the IP assignment request.

As you note correctly, the University of Pittsburgh policies for patent assignment and copyrights have not changed. The 2014 IP Assignment Agreement document is a simplified revision of earlier agreements, following models from peer institutions including Cornell and Yale. This one page assignment agreement meets the required assignment language for compliance with the terms of the U.S. Supreme Court decision in Board of Trustees of Leland Stanford Junior University v. Roche Molecular Systems, Inc.

It is important to obtain these signed agreements to be in compliance with posted NIH ([http://grants.nih.gov/grants/policy/nihgps\\_2013/nihgps\\_ch8.htm#\\_Toc271264954](http://grants.nih.gov/grants/policy/nihgps_2013/nihgps_ch8.htm#_Toc271264954)) and NSF (<http://www.nsf.gov/pubs/policydocs/gc1/march14.pdf>) requirements, consistent with federal law and regulations. Please note that footnote 3 to Article 27 of the NSF policy document states quite explicitly: "Awardees are reminded that, in view of the U.S. Supreme Court decision in Stanford v. Roche, employee assignment agreements should include a present conveyance of rights ("I hereby assign" rather than a promise or intent to assign) in order to effectively convey patent rights to the institution, allowing the institution to meet its responsibility under the Bayh-Dole Act to provide the agency with a license to patented inventions)." This IP assignment standard is now being requested by other funding sources outside the federal sector.

As you noted, the Assignment Agreement states that it "is a condition of employment ... for being granted access to University of Pittsburgh resources." Thus, signing the agreement is a condition of access to research funds received by the University as a result of grant applications. The use of the phrase 'condition of employment' or 'consideration of employment' is quite common in IP assignment agreements and relates to employment law in several states, including Pennsylvania. Here are some examples of IP Assignment Agreements at other universities that use this or similar language:

Penn State University: <https://guru.psu.edu/policies/ip01.html>

University of Pennsylvania: [www.upenn.edu/provost/images/uploads/Patent\\_Policy.pdf](http://www.upenn.edu/provost/images/uploads/Patent_Policy.pdf)

University of Virginia: <http://www.virginia.edu/vpr/patent.pdf>

University of California: <http://ucnet.universityofcalifornia.edu/forms/pdf/upay-585.pdf>

University of Washington: <http://www.washington.edu/admin/rules/policies/PO/EO36.html#1>

Cornell University:

<http://www.research.cornell.edu/VPR/Policies/images/forms/Inventions%20and%20Related%20Property%20Rights%20Assignment%20Form.pdf>

University of Chicago:

[http://facultyhandbook.uchicago.edu/sites/facultyhandbook.uchicago.edu/files/uploads/PAA%20policy\\_0.pdf](http://facultyhandbook.uchicago.edu/sites/facultyhandbook.uchicago.edu/files/uploads/PAA%20policy_0.pdf)

Please note that we have been obtaining signed IP assignments from new staff (and some faculty) at time of hire. The University is now ensuring that this is done uniformly for all faculty and staff. However, as a practical matter, at this time we are focused on faculty seeking external grant funding.

Your 'Starter Questions' are related to broader issues of internal procedures for IP disclosure, management and commercialization. This area is the subject of considerable attention by the Innovation Institute. The most relevant website is at OTM (<http://www.otm.pitt.edu/>) and has extensive links to assist faculty and staff. Marc Malandro is a great resource for specific questions about these issues if they are unclear from the posted materials.

Finally, your suggestion that we review our IP policy is a good one and very much in line with discussions currently underway. I think it would be a good idea to discuss this and Senate involvement at our lunch meeting next week.

I hope that this information answers your questions.

Sincerely,

Patty

On Sep 2, 2014, at 6:09 AM, "Michael Spring" <[spring@pitt.edu](mailto:spring@pitt.edu)> wrote:

Dear Provost Beeson and Vice Provost Redfern:

I am sorry to be such a pain in the butt related to the policy issues that relate to federal regulations. I appreciate the efforts of the Provost Office to address the new visitor policy and clarify the export controls provisions.

As I mentioned to you, Provost Beeson, I had one person question the IPR assignment. I hope that was it, but I decided to do my due diligence in the event that I start getting questions. As with the visitor and export control issues, I am pretty confident it is a matter of presentation, not substance. I went back and read everything I could over the weekend and came up with the attached. You may remember in our conversation that I indicated it was not the agreement so much, which I think I have signed before, as it was the preamble which said "Signing and submitting this form is a condition of employment, for receiving a University of Pittsburgh appointment, and/or for being granted access to University of Pittsburgh resources." I think, I could be wrong, this is different than saying it is a requirement for submitting a grant, which is what I recollect is how it was put in the past.

In any case, the attached document has four parts, Intro, Givens, Questions, Alternative Wording. I would suggest you might want to read the last part first. I believe that I understand the legalities and issues, although I am very prepared to have lots of facts wrong based on my exhaustive 5 hours of research!!! ;-/ What I wonder is if somewhere an introduction to the policies with the flavor of my Alternative Wording isn't missing. Obviously, I have no investment in the particular words and I am sure other could do better, but the key is to assure faculty that what is being done is with their best interests in mind.

With best wishes,

Michael

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