



University of Pittsburgh

Office of the Provost and Senior Vice Chancellor

801 Cathedral of Learning
4200 Fifth Avenue
Pittsburgh, PA 15260
412-624-4223
Fax: 412-383-9640
E-mail: beeson@pitt.edu

Patricia E. Beeson
Provost
Senior Vice Chancellor

October 24, 2014

Dear Colleague:

In August, my office sent a request to faculty asking that they sign an agreement explicitly assigning intellectual property rights to the University, consistent with university policy (see attached August 2014 Assignment Agreement). In response to concerns raised by several faculty members about the language of the agreement, an ad hoc faculty committee was formed to provide advice on the agreement. That committee met several times over the past few weeks and has provided invaluable insights and advice into the process. The options provided in this letter are informed by those discussions.

By way of background, as a condition of receiving federal support, funding agencies require the University to have agreements in place with individual faculty that protect the government's interest in intellectual property developed as a result of research supported by federal grants and contracts. In addition, corporate and foundation contracts and material transfer agreements increasingly require agreements to be in place at the time the contract is signed that assign to the University any intellectual property developed as a result of the sponsored research in order to ensure the rights granted to the sponsor and/or provider of material are protected. The University has obtained written agreements from new faculty and staff for many years, but such agreements have not always been consistently obtained and the University has determined, as a matter of contract administration, that we need to confirm by a certain date that we have the necessary agreements in place. To meet these obligations, starting November 21, faculty members submitting federal grants or contracts through the Office of Research or receiving funding from an active federal grant or contract will be required to execute one of the three agreements discussed below.

Please note, regardless of which agreement you choose to sign, University Policy 11-02-01, established in 1985 and revised in 2005, requires prompt disclosure of inventions and asserts the University's ownership of the worldwide patent and intellectual property rights of these inventions subject to conditions discussed in that policy. The policy also specifies that, as an inventor, you are entitled to share in the proceeds from the licensing or other transfer of patent rights or other intellectual property rights. Under current policy the inventor's share is normally 30% of the net financial return; should the University policy change to have more favorable economic terms after you have assigned the rights to the University pursuant to either of the assignment agreements described under Options 1 or Option 2, you will be entitled to the more favorable economic terms for inventions disclosed after the effective date of any such policy change.

Option 1 - August Assignment Agreement Form: If you have already signed the August 2014 assignment agreement circulated with Vice Provost Balaban's August 4, 2014 memorandum and wish to leave it standing, you do not need to do anything. This agreement meets the University's obligations to federal funding agencies and assigns patent rights to the university consistent with university Policy 11-02-01.

Option 2 - Revised Assignment Agreement Form: The revised assignment agreement form (attached) incorporates suggestions made by the ad hoc committee to clarify and improve the original assignment agreement. By signing this agreement, you will assign to the University ownership of intellectual property covered by University policy. This protects the interests of the government, the University, and other sponsors of your research as well as your own interest should you inadvertently assign rights to a third party, as was the case in *Stanford v Roche*. Signing this agreement also will facilitate processing of third-party agreements that require the University to demonstrate ownership of intellectual property developed under the contract, as is often the case with material transfer agreements and corporate contracts. If you have already signed the August assignment agreement form, you may choose to sign this revised assignment agreement, which will then replace the August assignment agreement form.

Option 3 - Intellectual Property Rights Acknowledgment Form: If you elect option 3, you must sign the intellectual property rights acknowledgement form (attached) by November 21, 2014 in order to continue to submit federal grant applications or to receive access to federal grant or contract funds. This agreement fulfills the University's obligations to federal agencies to have written agreements regarding intellectual property rights in place with persons working on federal grants and federal contracts. By signing this agreement, you will agree to abide by University policy regarding patent rights and technology transfer (Policy 11-02-01) including your responsibilities to disclose inventions and take steps necessary to protect sponsors' rights in the intellectual property developed through funded research. This agreement also confirms that you have not entered into other agreements that would limit your ability to meet this obligation. As with option 2, if you have already signed the August assignment agreement form, you may choose to sign this acknowledgement form, which will then replace the August assignment agreement form. Signing this acknowledgment form does not supersede or replace any other assignment agreements you have executed prior to the August 2014 assignment agreement.

Additional background information and answers to frequently asked questions can be found at <http://www.provost.pitt.edu/leadership-in/IPagreements.html> and information sessions with people available to answer questions will be held at the following times:

- Friday, October 31, 3 p.m., University Club, Gold Room
- Tuesday, November 4, 9 a.m., University Club, Gold Room

Questions not addressed through these resources can be directed to Sandy Latini (slatini@innovation.pitt.edu) who will forward them to the appropriate people to address. She will also post the answers to any question received in the FAQs on the website above.

Signatures on the agreement or assignment forms will be collected at the school level. You will be receiving more information from your dean regarding the process within your school.

Finally, I want to personally thank you for your patience and understanding through this process. I do believe that the input I received from the faculty and specifically the ad hoc faculty committee has resulted in a better understanding of the requirements from the federal government and a better set of options to meet the needs of the broader University community.

Sincerely,

A handwritten signature in blue ink, appearing to read 'Patricia E. Beeson', with a long horizontal flourish extending to the right.

Patricia E. Beeson