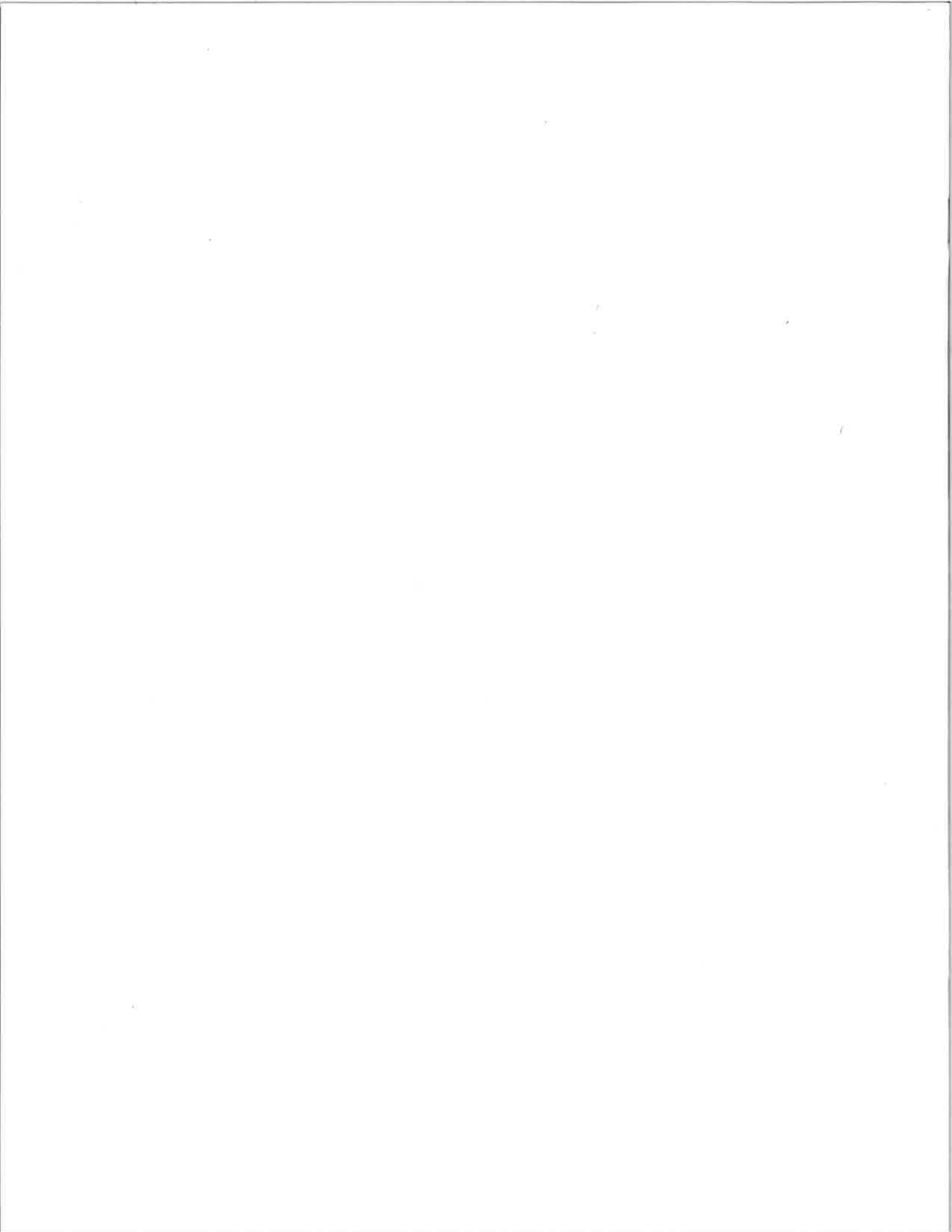

JANUARY 1998

GRADUATE SCHOOL

INTELLECTUAL PROPERTY
POLICIES AND PROCEDURES
FOR UNIVERSITY RESEARCH

UNIVERSITY OF
WISCONSIN
MADISON



January 1998

Welcome to the new UW-Madison Red Book: *Intellectual Property Policies and Procedures for University Research*.

The title change mirrors the additions and format changes aimed at illuminating the University's policies and your responsibilities and options regarding the rights of intellectual property generated from your research efforts.

We have clarified the differences in provisions regarding federal versus non-federal agreements and added information pertinent to material transfer agreements, copyrights, and computer software. Copies of the current Research Compliance Agreement, Invention Disclosure Report, and Software Development Disclosure Report forms can be found in the Appendices.

I urge you to take a few minutes to read and become familiar with the University's updated policies and procedures for handling intellectual property. I hope that you will find this new Red Book a valuable resource. Please let me know how we can make this guide even more helpful to you.



Sincerely,

A handwritten signature in black ink, appearing to read "Virginia S. Hinshaw". The signature is fluid and cursive, with a long horizontal line extending to the right.

Virginia S. Hinshaw
Dean/Senior Research Officer
UW-Madison Graduate School

The UW–Madison Red Book is distributed to all deans, directors, department chairs, faculty, and academic staff with active awards. Additional copies are available from department offices or through the Office of Research and Sponsored Programs website at <http://info.gradsch.wisc.edu/rsp>

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ownership, of new materials or inventions made by the researcher. As with funding agreements, it is essential that the researcher carefully examine all commitments made in the MTA in light of past and future obligations relating to funding. If materials received from one company and covered by an MTA are to be used in research funded under a consortium or a grant from another company, access rights to inventions must not conflict.

If an invention covered by an MTA was supported with federal funding, the invention must be disclosed to the University and WARF in the normal way, and the inventors must inform the University and WARF about the MTA. WARF is not obligated to take any particular invention submitted to it, and the federal funding agency has the opportunity to take title to inventions declined by WARF.

If title to an invention were to be taken by a federal funding agency, the agency would not be bound by the terms of an MTA. Therefore, the researcher and University must take care not to make promises in an MTA that the federal funding agency may not be willing to honor. In contrast, if WARF accepts an invention that is subject to an MTA of which it has notice and that has been correctly processed through the University, WARF's acceptance will be subject to the obligations of the MTA.

Under current policy, the University assumes that a researcher who transmits an MTA has read and agrees with all of its terms. Unless a provision of the MTA is inconsistent with law or University policy, the University will sign the agreement.

E) Data, Research Records, Laboratory Notebooks, and Other Similar Products of Research

Subject to restrictions imposed by federal statute or other prior agreements, the researcher may assign rights in patents, copyrights, and mask works that are made as a part of sponsored research. However, ownership of raw data and other immediate products of the research, such as lab books and other research records generated during the research, may not be given up. Because the mission of the University and, therefore, the goal of all University research, is the discovery and dissemination of knowledge, both the University and its faculty, staff, and students have an obligation to publish the results of University research. Allowing a sponsor to own the raw data of the research effectively forecloses the ability to publish. Therefore, under University policy, ownership of such materials may not be transferred to a third party. Certainly, access to the data or other research materials may be granted to the sponsor and, if appropriate, the sponsor may be authorized to use such material freely.

IV. RESPONSIBILITIES FOR REVIEW OF PROPOSALS AND AWARDS

When developing proposals, the principal investigator must carefully consider any concurrent and previously funded projects, as well as any individual agreement(s) (such as a consulting agreement), the principal investigator may have. The principal investigator should not knowingly develop a project proposal in which the subject matter would create a conflict regarding intellectual property rights assigned in other agreements, including any individual agreements. Review by the Dean or Director, or designated representative, should include a determination of whether the proposed project has a direct relation to any other previously funded projects in which intellectual property rights were assigned to the sponsor of the research.

When the University receives an award document from a sponsor, the principal investigator should give special attention to the intellectual property rights clause to assure that similar rights have not previously been assigned to another extramural sponsor or to anyone for whom the researcher(s) have done consulting. Principal investigators and others involved in the research should also consider whether the assignment of intellectual property will have an adverse impact on their ability to seek future funding from other sponsors.

V. REQUIREMENT TO DISCLOSE

To assure the University's ability to comply with obligations arising under federal laws or in extramural sponsor agreements, faculty, staff, and students participating in sponsored research are required as a condition of such participation to file disclosure reports for any invention or discovery that was made during the course of his or her University activities. The principal investigator for a sponsored research grant is responsible for assuring that a disclosure form is filed for any such discovery. The person filing the form is responsible for providing complete and accurate information as required on the form, and transmitting the form to University-Industry Relations (UIR). UIR is responsible for determining the disposition of the intellectual property rights and for any required notification, whether to the federal government or other extramural sponsor. A sample of the form used to disclose inventions is found in Appendix B.

Computer software may be an invention (i.e. patentable) and covered under the federal law. Additionally, computer software and other types of copyrightable soft materials may be subject to intellectual property rights set forth in the sponsorship agreement. Before making any disposition of rights to copyrightable material produced under extramural support

and as part of the funded research, the principal investigator should fill out a disclosure report and submit the form to UIR for an equity determination. A sample of the form that may be used to request an equity determination for software, including computer software, is found in Appendix C.

VI. THE ROLE OF THE OFFICE OF RESEARCH AND SPONSORED PROGRAMS

The Office of Research and Sponsored Programs (RSP) administers grants and contracts for sponsored University research. RSP reviews grant and contract documents to assure that the disposition of intellectual property complies with any federal requirements and University policy.

RSP endeavors to protect the rights of extramural sponsors by ensuring that principal investigators and all project staff, except clerical and non-technical, sign an agreement that states that they will comply with the intellectual property provisions of the specific agreement between the University and the Sponsor. RSP obtains the principal investigator's agreement and signature through the "Addendum to Extramural Support Transmittal Form" (T-Form) at the time the project is routed for University approval. The principal investigator is responsible for obtaining appropriate signatures from project staff prior to their commencing work on the project. The principal investigator is also responsible for maintaining a copy of the agreement reflecting project staff signatures. **Principal investigators should remember that they may not obligate the intellectual property of project staff unless such staff have signed an intellectual property agreement prior to commencing work.** While obtaining project staff signatures may not seem important at the time a grant or contract is being processed and may be far removed from the actual making of an invention or creation of other intellectual property, it in fact is very important. Failure to get such signatures can lead to a lawsuit for breach of contract and may also jeopardize a patent or copyright or other types of intellectual property protection.

VII. THE ROLE OF THE WISCONSIN ALUMNI RESEARCH FOUNDATION

The Wisconsin Alumni Research Foundation (WARF) is an independent, non-profit, non-stock Wisconsin corporation organized in 1925 by University alumni and faculty. WARF's mission is to support the University through a program of grants to the Graduate School, as well as assisting University faculty, students, and staff in protecting and commercially

marketing their intellectual property. WARF is capable of handling all forms of intellectual property including patentable materials or processes, copyrightable materials such as computer software and multimedia works, and other non-patented products such as biological materials. WARF does not itself develop or manufacture any products, copyrightable works, or biological materials. Instead WARF licenses intellectual property to industrial partners. WARF is also able to take an equity position in start-up companies (usually in lieu of up-front licensing fees) to which WARF licenses University intellectual property.

WARF is an outstanding resource that is available to the entire University research community whether or not federal funding was involved in the development of intellectual property. However, the existence of federal funding or other contractual obligation may require that intellectual property rights be assigned to WARF.

If a patent is to be considered, for reasons of foreign and United States patent law, the best time to bring technology to WARF is before any public or other, non-confidential communication of it. Non-confidential communication may put the invention into the public domain outside of the United States. Even if only a United States patent is to be considered, any publication, public use, sale, or offer to sell an invention will place the invention in the public domain unless a patent application is filed within one year of the public event.

Upon acceptance of a properly cleared invention or software disclosure, WARF provides a payment to be divided equally among the creators, i.e., inventors or authors. If WARF generates income from technology assigned to it, WARF pays a percentage of that gross income directly back to the individual researcher or the group of researchers who assigned the technology to WARF. This is private income for the researchers. The other licensing income, combined with WARF income from other sources, is provided to the University. By University policy, a portion of this money is provided to the unit(s) in which the technology was created. The remainder of the gift is administered by the Graduate School in support of research.

VIII. THE ROLE OF THE OFFICE OF UNIVERSITY-INDUSTRY RELATIONS

The Office of University-Industry Relations (UIR) formerly University-Industry Research Program, was established in 1963. The mission of the UIR is to establish and maintain the most productive relationship possible between the private sector and the University of Wisconsin—Madison in order to foster industrial and economic development, assist in technology transfer, and secure private support for University research activities.

UIR is the office on campus to which all disclosures should be sent. To protect inventors and the University, the UIR conducts an equity review, which is a review of the funding history of inventions to determine what obligations may attach to the inventions. UIR has the responsibility of forwarding disclosures to WARF, and notifying the federal government and/or other parties mandated by contract.

IX. CONTACT POINTS FOR FURTHER DOCUMENTS AND INFORMATION

This document briefly describes the University's policies regarding intellectual property created during research. You are encouraged to contact the offices identified in the Introduction if you have questions or would like more information regarding University research. The following materials are also relevant to intellectual property created during research. Forms, additional written materials, and information regarding the form may be obtained from the office listed below:

Researcher Compliance Agreement (Form)	Dean's Office
Invention Disclosure Report (Form)	UIR
Software Development Disclosure and Report (Form)	UIR
Annual/Final Invention Statement (Form)	RSP
Extramural Support Transmittal Form and Addendum (T-Form)	RSP or Dean's Office
Disclosure to Sponsoring Agency	UIR
WARF Policies and Procedures	WARF
General Administrative Policies Relating to Intellectual Property	Office of Administrative Legal Services or RSP

Appendix A

UNIVERSITY OF WISCONSIN-MADISON

Researcher Compliance Agreement

All Project Participants: In order for the University to carry out its obligations, and as a condition of and in consideration of my participation in this extramurally sponsored research or other activity at the University of Wisconsin-Madison, I hereby agree to disclose promptly to the University any invention, computer software, or mask work made by me in whole or in part, whether solely or jointly with others, during and in the course of such extramurally supported research or other activity. I further agree that I will comply with the provisions of any agreement between the University and the sponsor, and will cooperate in assuring that the sponsor's rights in intellectual property are fully protected. I confirm that I am now under no obligation to any other person or extramural sponsor with respect to any rights in inventions, discoveries, or copyrightable material which are in conflict with the subject agreement or project proposal.

Principal Investigator: As the principal investigator of the extramurally sponsored project, I shall require that all persons participating in the project, other than clerical and nontechnical, at the time of award or prior to commencing work on the project, sign a copy of this Agreement and become familiar with the terms and conditions in the agreement between the extramural sponsor and the University pertinent to the project, including intellectual property provisions, and with the University's policies concerning sponsored research. To secure project staff signatures, principal investigators may use a copy of this document or the same version appearing in the University's "Intellectual Property Policies and Procedures for University Research" (January 1988).

PROJECT STAFF SIGNATURES AGREEING TO THE TERMS OF THE FIRST PARAGRAPH:

NOTE: The Office of Research and Sponsored Programs will assure that this agreement is on file for each principal investigator. The principal investigator is responsible for maintaining a copy of this agreement reflecting project staff signatures.

Appendix B

UNIVERSITY OF WISCONSIN-MADISON

Invention Disclosure Report

Please type and complete by answering all questions on form.
This form may also be downloaded via the internet at: <http://www.wisc.edu/uir>

To be reviewed by University-Industry Relations (UIR). This information is needed so that the investigators and University can discharge their legal obligations to the federal government and any extramural sponsors of research.

Date: _____ WARF case number (if available): P- _____

1. Person filing this report:

NAME:

TITLE AND DEPARTMENT:

CAMPUS ADDRESS:

E-MAIL ADDRESS:

CAMPUS PHONE NUMBER:

2. Short descriptive title of invention.

3. Full name and address of all University employees or students and any non-University personnel who have worked on the invention by conceiving or elaborating on the idea, designing experiments, evaluating experimental results, contributing features while first building a device or performing a method, or otherwise directly contributing to the invention beyond merely providing funds, work space, or entirely directed labor. If any person holds a joint appointment with any other university, a company or governmental agency, or the like, note that fact.

A.

First name

Middle name*

Last name

Nature of contribution

Work address

Home address

Work phone number

Home phone number

Fax number

E-mail address

Title and department affiliation(s)

Citizenship

*Please indicate if no middle name.

(ATTACH ADDITIONAL SHEETS IF NECESSARY)

B.

First name	Middle name*	Last name
Nature of contribution		
Work address	Home address	
Work phone number	Home phone number	
Fax number	E-mail address	
Title and department affiliation(s)		
Citizenship		

C.

First name	Middle name*	Last name
Nature of contribution		
Work address	Home address	
Work phone number	Home phone number	
Fax number	E-mail address	
Title and department affiliation(s)		
Citizenship		

*Please indicate if no middle name.

(ATTACH ADDITIONAL SHEETS IF NECESSARY)

4. Provide in the space below a concise abstract of the invention. The abstract should convey a clear understanding, to the extent known, of the nature, purpose, operation, and the physical, chemical, biological, or electrical characteristics of the invention. Your abstract will be provided, when required, to sponsoring agencies.

5. State the chief objectives or results to be achieved by this invention.

6. Chronology of principal events in conception and developments:

(a) Earliest known conception date (reference to substantiating evidence desirable):

(b) Date of any public disclosure (orally, in writing, or in any other manner.) If so, to whom? _____

Date: _____

(c) To the extent not identified in (b) identify date and place (e.g., particular periodical) of any publication regarding invention (whether publication has occurred or is projected), or any other public disclosure (e.g., poster session or talk).

(d) First written record pertinent to invention: _____

(e) Date and result of first test of the invention. If invention is a process, its first test is the first successful trial; if a composition of matter or a compound or a machine, article or device, its first test is its first creation and evaluation with respect to new or improved properties or behavior:

7. List the sources and amounts of all federal and non-federal grant or contract funds used to support the persons identified under question 3 during the period starting with the beginning date noted in question 6a and continuing to the present, whether or not used in the making of the invention. Identify each source by sponsoring agency, agency grant or contract number (if applicable,) and UW account number. (A computer-generated listing of research funding may be available for each University faculty member through the appropriate academic dean's office. If the computer listings are complete, they may simply be attached in response to this item.)

SPONSORING AGENCY	AGENCY NUMBER	UW ACCOUNT NUMBER
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8. Identify which of those sources listed in question 7 contributed to the making of the invention. Sources of the relevant portions of salaries and of money for supplies and services all should be considered. Equipment funded specifically for the project also should be considered. It may be convenient to number the sources listed in question 7 and simply refer here to the appropriate numbers. **If a research laboratory, group, or investigator has federal funding for research, the University presumes that any invention arising during the same time period as the term of the federal funding is subject to the federal law and notification of the invention to those federal agencies by the University will be made. Thus, all federal funding that is concurrent with the invention period should be noted here as contributing to the making of the invention.**

9. Of those federal agencies identified in question 8 above (if any), indicate the federal agency which is the primary funder for the invention.

Primary federal agency: _____

Agency number: _____

UW fund/Acct. no.: _____

10. Identify any agreements that you have entered into with any funder identified in question 8, along with any other agreement that you believe may grant a right of any sort in this invention to a company or other non-governmental party (material transfer agreements, commercially sponsored research agreements, consortia agreements, consulting agreements, etc.)

UNIVERSITY OF WISCONSIN-MADISON Software Development Disclosure Report

To be reviewed by University-Industry Relations. This information is needed so that the investigators and University can discharge their legal obligations to any extramural sponsors of research.

Date: _____

1. Person filing this report

NAME: _____

TITLE AND DEPARTMENT: _____

CAMPUS ADDRESS: _____

E-MAIL ADDRESS: _____

CAMPUS PHONE NUMBER: _____

2. Brief descriptive title of software.

3. Full name of all University employees or students and any non-University personnel who have worked on the software. If any person holds a joint appointment with any other university, a company or governmental agency, or the like, note that fact. Provide each person's address, University title and department, and a brief description of the person's contribution to the development of the software.

NAME: _____

ADDRESS: _____

TITLE AND DEPARTMENT: _____

NATURE OF CONTRIBUTION: _____

NAME: _____

ADDRESS: _____

TITLE AND DEPARTMENT: _____

NATURE OF CONTRIBUTION: _____

NAME: _____

ADDRESS: _____

TITLE AND DEPARTMENT: _____

NATURE OF CONTRIBUTION: _____

(ATTACH ADDITIONAL SHEETS IF NECESSARY)

4. Provide in the space below a concise abstract describing the software. Your abstract will be provided, when required, to sponsoring agencies.

5. Give an account of the major stages in the writing of the software, with dates, from the beginning through to the completion of the current version. Note who contributed at each stage.

6. List the sources and amounts of all federal and non-federal grant or contract funds used by persons identified under question 3 during the period spanned by the events described in question 5, whether or not used in the developing of the software. Identify each source by sponsoring agency, agency grant or contract number (if applicable), and UW account number. (A computer-generated listing of research funding may be available for each University faculty member through the appropriate academic dean's office. If the computer listings are complete, they may simply be attached in response to this item.)

SPONSORING AGENCY

AGENCY NUMBER

UW ACCOUNT NUMBER

7. Identify which of those sources listed in question 6 contributed to the development of the software. Contribution to salaries and such things as supplies and services all should be considered. Equipment supplied specifically for the project should also be considered. It may be convenient to number the sources listed in question 6 and simply refer here to the appropriate numbers.
8. Identify any agreements that you have entered into with any funder identified in question 6, along with any other agreement or relationship that you believe may grant a right of any sort in this software to a company, source of underlying software, etc.
9. Identify the department(s), center(s), and/or institute(s) that supported the work. Include all units that provided administrative support and/or space.

DEPT/CENTER/INSTITUTE

SCHOOL/COLLEGE

UW UDDS CODE

Signature of person filing report: _____

Type or print name: _____

Date: _____

THIS SOFTWARE DEVELOPMENT DISCLOSURE AND REPORT SHOULD BE FORWARDED TO:

**University-Industry Relations
Room 1215 WARF Office Building
CAMPUS**

**AND COPIES DISTRIBUTED TO ALL INDIVIDUALS WHO HAVE WORKED ON THE SOFTWARE LISTED
IN QUESTION 3.**

