

ARTICLE 22
INTELLECTUAL PROPERTY

22.1 Definitions. The following definitions shall apply in Article 22:

(a) "Intellectual property" means any work or invention.

(b) "Faculty member" or "creator" means a member of the bargaining unit who creates a work or invention. "Creator" shall also mean other University personnel who create a work or invention.

(c) A "work" means any copyrightable material, that is, any material fixed in a tangible medium of expression from which it can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Such copyrightable material includes, but is not limited to, such things as printed material, computer software or databases, audio and visual material, circuit diagrams, architectural and engineering drawings, lectures, musical or dramatic compositions, choreographic works, pictorial or graphic works, and sculptural works. Instructional material, as defined in Section 22.1(f), below, is included in the definition of a "work." A "work" does not include any patentable material, which patentable material is encompassed within the definition of an "invention" in Section 22.1(d), below.

(d) An "invention" means any discovery, invention, process, composition of matter, article of manufacture, design, model, technological development, biological material, strain, variety, culture of any organism, or portion, modification, translation, or extension of these items, and any mark and/or directly related know-how used in connection with these items. It includes, but is not limited to, such things as new or improved devices, systems, circuits, chemical compounds, or mixtures and directly related know-how.

(e) "Instructional technology," as used in this Article, means the form of an "invention" that is substantially new technology and is used to deliver instructional material, as distinct from the application of existing technology to deliver such instructional material.

(f) "Instructional material," as used in this Article, means the form of a "work" (i.e., copyrightable) that includes materials delivered through the use of existing or new technology such as video and audio recordings, motion pictures, film strips, photographic and other similar visual materials, live video and audio transmissions, computer programs, computer-assisted instructional course work, programmed instructional materials, three-dimensional materials and exhibits, web pages, and combinations of the above materials that are prepared or produced in whole or in part by a faculty member and that are used to assist or enhance instruction.

(g) "Independent efforts" with regard to a work means that the ideas for the work came from the faculty member and the work was not made with the use of University support. The University is not liable for any opinions expressed in such works.

(h) "University support" means the use of University funds or more than the incidental use of University personnel, facilities, equipment, materials, or technological information in the creation of a work or invention and includes such support provided by outside sponsors when it is arranged, administered, or controlled by the University.

(i) “Distance learning” means learning in a course that is rarely or never conducted with the instructor and the student in the same general physical space simultaneously.

(j) “Gross revenue” means (1) proceeds from the sale, lease, transfer, or other conveyance of any interest in an invention or work owned by the University and (2) license issue fees, option fees, running royalties, minimum royalties, equity and other ownership interests, and any other remuneration paid to the University by a licensee of an invention or work, except that such equity or other ownership interests, or portion thereof, shall not be considered “gross revenue” unless and until the equity or other ownership interests, or portion thereof, are sold or liquidated by the University.

(k) “Development expenses” means all monies paid by the University and UFRF for goods and services to protect, develop, and/or enhance the marketability or any other aspect of a work or invention, including, but not limited to, patent-filing fees, intellectual property protection and patent enforcement and defense expenses, marketing expenses, patent maintenance, consulting fees, prosecution expenses, expenses incurred in dealing with equity and other ownership interests, travel, attorneys’ fees, commercialization expenses, and research costs. Not included as development expenses are salaries and general operating expenses of University administrative personnel.

(l) “Net adjusted income” means gross revenues less any foreseeable development expenses University deems necessary to defend or maintain a work or invention and its improvements.

(m) “Program” means the specific University research program within which an invention or work was developed.

(n) “Office of Technology Licensing” or “OTL” means the designee responsible for all matters relating to patents, trademarks, and copyrights as related to the identification, protection, and commercialization of works and inventions owned by the University.

(o) “UFRF” means the University of Florida Research Foundation, Inc., a direct support, not-for-profit organization authorized by the Trustees to promote, encourage and provide assistance to the research activities of University faculty, staff, and students, primarily through the facilitation of technology transfer.

(p) “Sponsored agreement” means any award from an outside sponsor to support research or any other University activity, whether such support is through a grant, contract, cooperative agreement, or any other means.

22.2 Policy.

(a) Statement of Principles. Research is undertaken to create new knowledge, to stimulate a spirit of inquiry, to solve problems, and to educate students. Adequate recognition of and incentive to potential inventors through the sharing of the financial benefits resulting from the transfer and development of patentable inventions and other marketable forms of intellectual property encourages the creation of such intellectual property and serves the public interest. The research and teaching missions of the University always take precedence over patent considerations. While the University recognizes the benefits of patent development, it is

most important that the direction of University research not be established or unduly influenced by patent considerations or personal financial interests.

(b) Authority and Responsibilities. Section 1004.23, Florida Statutes, and the Board of Governors' delegation to the University of Florida Board of Trustees, authorizes the University to establish regulations and procedures regarding the works and inventions of its personnel, including regulations and procedures regarding patents, copyrights, and trademarks. The University has the authority to agree to the terms of this Article, and any regulations and procedures applied to in-unit faculty shall be consistent with the terms of this Article.

(c) Faculty Authority and Responsibilities. Intellectual property created, made, or originated by a faculty member shall be governed by the terms of this Agreement, including but not limited to this Article and Article 26, Outside Activity and Conflict of Interest. The faculty member shall also be governed by the University implementing procedures concerning works and inventions of University personnel unless the procedure is inconsistent with the terms of this Agreement.

(d) When a faculty member is acting in the capacity of Principal Investigator of a research project, the faculty member shall be granted the right, within the conditions set forth in this Article and in any applicable sponsored agreement and federal and state laws and regulations and with the proper administrative approval, to raise resources from sponsors, shall be responsible for properly utilizing the resources obtained from the sponsors, and for executing the sponsored research.

22.3 Rights to Working Papers. Except as otherwise required by the Florida Sunshine Law and other applicable federal and state laws, federal and state regulations, or the terms of any applicable sponsored agreements, faculty members shall have the right to control of their personal correspondence, notes, unpublished drafts, and other working papers.

22.4 Works.

(a) Faculty Exclusive Ownership Rights.

(1) A work made in the course of independent efforts is the property of the faculty member, who has the right to determine the disposition of such work and the revenue derived from such work.

(2) In accordance with academic tradition, and unless required by federal and state laws, federal and state regulations, or the terms of any applicable sponsored agreements, the University shall not assert rights to the following works:

a. Scholarly or artistic works, regardless of their form of expression, for which the intended purpose is to disseminate the results of academic research, scholarly study, or artistic expression, such as books, monographs, articles, bibliographies, poems, novels, dramatic works, pictorial or sculptural works, films, videotapes, musical compositions, or other scholarly or artistic expressions in any medium;

b. Instructional material, except if the University either (1) expressly commissioned the faculty member in writing to produce, or participate in the production of, the work with University funds for a specific University purpose; or (2) expressly assigned the faculty member in writing to produce, or participate in the production of, the work. The University may grant a non-exclusive license to the faculty member who is the author of instructional materials

for the use of that portion of the materials. The non-exclusive license must be negotiated as set forth in writing and must be limited to noncommercial educational uses. That such a license is not granted shall not be deemed a violation of this Collective Bargaining Agreement.

c. Works made without University support, as defined in Section 22.1(h), above.

If the terms of a sponsored agreement or applicable federal and state laws and federal and state regulations require publication of articles in specified ways or in specified places, the terms of this subsection 22.4(2) shall not be construed to relieve the faculty member of these publication obligations.

(b) Works Owned by the University. The following works are owned by the University. The faculty member shall share in the proceeds from such works, pursuant to Section 22.7(a):

(1) Instructional material if the University has either (a) expressly commissioned the faculty member in writing to produce, or participate in the production of, the work with University funds for a specific University purpose; or (b) expressly assigned the faculty member in writing to produce, or participate in the production of, the work. The creation, use, and revision of such works shall be governed by Section 22.4(f).

(2) Works whose authorship cannot be attributed to one (1) or a discrete number of authors but rather result from simultaneous or sequential contributions over time by multiple faculty, staff, and/or students, such as software tools developed and improved over time by multiple faculty, staff, and/or students. However, the mere fact that multiple individuals have contributed to the creation of a work shall not cause the work to become a work owned by the University.

(3) Any other works made with University support, as defined in Section 22.1(h), above.

(c) Disclosure. Upon the creation of a work and prior to any publication, the faculty member shall disclose to the Office of Technology Licensing any work that was made in the course of University-supported efforts, together with an outline of the project and the conditions under which it was done. However, consistent with the provisions of Section 22.4(a)(2), faculty members need not disclose works referenced in subsections (1)–(3), immediately below, unless the work raises a possible conflict of interest pursuant to Article 26:

(1) Books, monographs, articles, bibliographies, poems, novels, dramatic works, pictorial or sculptural works, films, videotapes, musical compositions, or other scholarly or artistic expressions in any medium; and similar works, the intended purpose of which is to disseminate the results of academic research or scholarly work;

(2) Instructional material except for works described in Section 22.4(b)(1); or

(3) Works made without University support, as defined in Section 22.1(h), above.

(4) Exception: Even if a work is not required to be disclosed under this Article, the work must still be disclosed pursuant to Article 26 if its production, dissemination, or use raises a possible conflict of interest.

(d) Review. The Office of Technology Licensing shall assess the relative equities of the faculty member and the University in the work. If the University wishes to assert its interest in the work, the Office of Technology Licensing shall inform the faculty member as soon as practicable but in no case later than sixty (60) days after disclosure to the OTL.

(e) The allocation of proceeds resulting from works owned by the University shall be as set forth in Section 22.7(a) below.

(f) Creation, Use, and Revision of Certain Works Owned by the University. With respect to any work that represents instructional materials owned by the University pursuant to Section 22.4(b)(1), the terms of any agreement entered into by the University concerning the work must be consistent with the terms of any sponsored agreement supporting the creation of the work and applicable laws.

(1) The University shall make reasonable efforts to negotiate the terms listed as a, b, and c below in any agreement concerning the work with any third party, including but not limited to any licensee, assignee, or publisher of the work, insofar as such terms are consonant with the terms of any sponsored agreement supporting the creation of the work and applicable laws. That any or all of these terms are not included in the agreement with the third party shall not be deemed a violation of this Collective Bargaining Agreement.

a. That the faculty member be identified as an author of the work, including, if the work is materially altered at the time of its assignment, initial licensing, or initial publication, the right to decide whether to allow the author's name to be displayed in association with the work;

b. That the faculty member may freely reproduce the work without paying any licensing fees to use in academic teaching, research, or university service whether at the University of Florida or another tax-exempt academic or research institution; and

c. That the faculty member may freely use the work in pursuit of one's profession, such as during expert witness testimony or in consulting.

(2) Other rights and protections for the faculty member may be agreed to by mutual consent of the faculty member and the University, provided that they are consonant with the terms of the UFBOT-UFF Collective Bargaining Agreement, any sponsored agreement supporting the creation of the work, any agreement, license, assignment, publishing or other agreement entered into by the University concerning the work, and applicable laws. Such rights granted to the faculty member may include:

a. borrowing portions of the work for use in compilations, other composite works, or new projects;

b. making derivative works, such as translations, videotaped versions, and film scripts;

c. adding to the work or updating the content of the work; and

d. approving decisions related to the publishing or display of new versions of the creator's work or new works based on the creator's work.

(g) Release of Rights. The faculty member shall assist the University in obtaining releases from persons appearing in, or giving financial or creative support to, the development or use of works in which the University has asserted an interest.

(h) Reconveyance of Copyright to the Faculty Member.

(1) When copyright is assigned to the University in full or in part because of the provisions of this Article, the creator of the copyrighted material may request of the Director of the Office of Technology Licensing that ownership be returned to the faculty member.

(2) Such request may be granted if it does not

- a. violate any legal obligations of or to the University;
- b. limit appropriate uses of the materials by the University;
- c. create a conflict of interest for the faculty member; or
- d. otherwise conflict with specific goals of the University.

(3) Such request shall also be granted if the faculty member establishes that the University has willfully misrepresented to the faculty member's substantial detriment the necessity or cost of development expenses.

22.5 Instructional Technology and Related Instructional Materials.

(a) The University and UFF recognize the increasing development and use of technology, and related instructional materials, such as videotapes, interactive television, and computer software, to support teaching and learning and to enhance the fundamental relationship between the faculty member and the student.

(1) Instructional technology may be used to deliver distance learning.

(2) The University and UFF affirm that instructional technology and related instructional materials should be used to the mutual benefit of the University and the faculty member.

(3) Development of new technology for use in delivering instructional material is an invention covered by Section 22.6, and is distinguished from the use of existing or new technology to deliver instructional material, which are works covered by Section 22.4.

(b) When the University assigns a faculty member to develop or provide instruction through the use of instructional technology or instructional material specifically designed to be used with such instructional technology, including but not limited to distance learning, the University shall provide to such faculty member:

(1) Training and resources to support the assignment for adaptation of instructional material to instructional technology; and

(2) Additional compensation if the assignment is an overload assignment and/or adjustment in a faculty member's assignment.

(c) Property Rights and Releases. Provisions governing the intellectual property rights of faculty and releases to be obtained when the University has asserted an interest in instructional materials constituting a work are contained in Sections 22.4, above.

22.6 Inventions.

(a) Faculty Exclusive Ownership Rights.

(1) An invention made outside the field or discipline in which the faculty member conducts research, teaching, and/or service activities for the University (which shall include any enhancements, adaptations, or improvements of inventions previously disclosed, or that were required to be disclosed, hereunder) and for which no University support has been used is the property of the faculty member, who has the right to determine the disposition of such invention and revenue derived from it.

(2) However, the faculty member and the University may agree that the patent for such invention be pursued by the University and the proceeds shared.

(b) University-Supported Efforts. An invention that is made by using University support, as defined in Section 22.1(h), is the property of the University. In addition, an invention

made within the field or discipline in which the faculty member conducts research, teaching, and/or service activities for the University (which shall include any enhancements, adaptations, and improvements of inventions previously disclosed or that were required to be disclosed hereunder) is the property of the University. The faculty member shall share in the proceeds from any invention that is the property of the University pursuant to this Article.

(c) Disclosure.

(1) A faculty member shall fully disclose to the Office of Technology Licensing any invention that the faculty member develops, makes or reduces to practice while a faculty member of the University of Florida.

a. The disclosure shall include an outline of the project and the conditions under which it was conducted.

b. If the faculty member wants the University to attempt to patent the invention, the faculty member shall explain why it has sufficient commercial potential to warrant the University investment in the patent process.

(2) With respect to inventions made during the course of an approved outside activity when the University has specifically waived its rights to any inventions as part of their approval of the outside activity under Article 26.4, the faculty member may delay such disclosure, when necessary to protect the outside employer's interests, until the outside employer has made the decision whether to seek a patent.

(d) Review.

(1) If the University wishes to assert its interest in the invention, the Office of Technology Licensing shall inform the faculty member in writing as soon as practicable but in no case later than one hundred twenty (120) days after the faculty member's disclosure to the OTL.

a. If the faculty member desires a preliminary, non-binding assessment of the University interest, the faculty member shall make a written request for such assessment at the time of filing the disclosure.

b. Such preliminary assessment shall be provided within sixty (60) days, and such assessment shall not be binding upon OTL or the University.

(2) The OTL shall conduct an investigation that shall assess the respective equities of the faculty member and the University in the invention, and determine its importance and the extent to which the University should be involved in its protection, development, and promotion.

(3) The OTL shall determine whether sponsored agreements require the University to take ownership of the invention.

(e) If the University asserts an interest in an invention and the faculty member disputes the University interest, the faculty member may seek to resolve the matter pursuant to Article 28, Grievance Procedure and Arbitration. During the pendency of the grievance, the invention will be assigned to the University which will take appropriate steps to protect it. If the grievance and any appeal or other legal proceedings end with a determination that the faculty member is the owner of the invention, the University shall transfer ownership of the invention to the faculty member and none of the costs incurred by the University in the dispute or for the protection of the invention prior to the transfer shall be assessed against the faculty member.

(f) Release of Rights.

(1) In the event a sponsor under a sponsored agreement has been offered the option to apply for the patent to an invention or other rights in an invention, the University will use its good offices in an effort to obtain the sponsor's decision regarding the exercise of such rights within the period set forth in the sponsored agreement.

(2) At any stage of making the patent applications, or in the commercial application of an invention, if the University has not otherwise assigned to a third party the right to pursue its interests, the University may elect to withdraw from further involvement in the protection or commercial application of the invention. At the request of the faculty member in such case, and subject to any applicable sponsored agreement or law, the University shall transfer the invention rights to the faculty member, in which case the invention shall be the faculty member's property and none of the costs incurred by the University shall be assessed against the faculty member unless they are development expenses deducted from gross revenues received by the University prior to the transfer.

(3) All assignments or releases of inventions, including patent rights, by the University to the faculty member shall contain the provision that such invention, if patented by the faculty member, shall be available royalty-free for governmental purposes of the State of Florida and in connection with federally-sponsored research, the United States, and for teaching and research purposes for all tax-exempt educational and research institutions, unless otherwise agreed in writing by the University.

(4) If the University ownership interest in an invention is waived, the creator must disclose the potential conflict of interest created by the creator's ownership of the invention when proposing research to be conducted using University resources that could reasonably appear to influence the financial value of the invention. In such case the University through the creator and appropriate administrators, may establish the means to manage any conflict of interest that exists in conducting the research.

(g) It is the policy of the University that in general research results should be publishable, and publication of such results in appropriate venues is encouraged. However, if the publication of research results may reveal an invention in which the University has an interest, faculty members must ask OTL for advice on how and when to publish the results in order that patent protection for the invention is not compromised.

(h) Voluntary Surrender of Patent Interests. A faculty member and the University may agree to surrender any interests that the faculty member and the University might have to any part of any prospective invention to any outside organization, if the faculty member and the University deem such surrender to be in the best interests of the University and if such surrender is allowable under applicable law and sponsored agreements and such surrender does not impair the intellectual property rights of other employees, students, and other third parties. All faculty members and other University employees involved must agree to the surrender of the patent rights subject to the concurrence of the University in each case.

22.7 Division of Proceeds.

(a) With regard to any work or invention owned by the University and subject to the requirements of any applicable sponsored agreements, the net adjusted income shall be distributed as follows:

- (1) Schedule A: Up to \$500,000:
40% to the individual creator(s)

10% to the University program(s)
7.5% to the creator(s)'s department
7.5% to the creator(s)'s college
35% to the University

- (2) Schedule B: \$500,000 or over:
25% to the individual creator(s)
10% to the University program(s)
10% to the creator(s)'s department
10% to the creator(s)'s college
45% to the University

(3) Notwithstanding the above, all net adjusted income from the University sale or liquidation of equity or other ownership interests originally paid to the University by a licensee in lieu of cash royalties or license fees shall be distributed according to Schedule B. The decision as to when to sell, exchange or convert equity interests resides with the University in its sole discretion.

(4) The division of proceeds set forth in this Section 22.7(a) does not apply to any works or inventions that are the subject matter of any license agreement or other transaction entered into by the University or UFRF before July 15, 1997, and the proceeds in such cases shall continue to be distributed pursuant to the University of Florida Patent Policy dated February 1993 or any previous agreement entered into by the creator and the University.

(b) Distributions of income shall be made semiannually on or before June 1 and December 1 of each year.

(1) The University may, at its sole judgment, withhold or delay distribution of any income if there is a foreseeable development expense yet to be incurred.

(2) In instances where funds are held because of foreseeable development expenses or where expenses exceed revenue, an accounting of such shall be sent to the creator's department and college indicating the amounts received for the current six-month period and the amount of the anticipated expense or deficit.

(3) Once expenses are known with certainty, any excess withholding shall be distributed.

(c) Payments of the portion allocated to the creator(s) must be made to creator(s) individually and cannot be assigned by the creator(s) to other parties or entities. The only exception shall be that after a creator's death, appropriate notification by the personal representative of the creator's estate, and court approval, if necessary, payment shall be made to the creator's heirs or devisees.

(d) In the event there are multiple creators for an invention or work, the creators' share shall be divided equally among all creators unless the creators agree among themselves to a different division.

(1) If the creators agree among themselves to a different split, OTL must be notified in writing at least one month prior to the date of the first income distribution as to the agreed upon division of income.

(2) The portions distributed to the academic units, which are the academic units of the creator(s) at the time of the creation of the invention or work, shall be pro-rated when more than one unit is involved.

(3) The University shall make the final decisions on the pro-ration of such portions to academic units.

(e) In the case of licenses or other transactions involving multiple inventions or works, the University shall resolve any potential conflicts concerning the applicable distribution schedules after reviewing the technologies involved.

(f) That portion allocated to the program (or programs) remains under the control of the University. If there is more than one program in which the invention or work was developed, the program portion will be pro-rated as determined by the University. If a creator should leave the University, the portion allocated to the creator's program shall be allocated to that program as long as the program exists and consists of research in the same area as that conducted by the creator prior to leaving the University. If the program ends, the portion allocated to the program shall be allocated to the University. Any determinations regarding the distribution of the program portion of net income shall be at the sole discretion of the University.

22.8 Other Requirements.

(a) A faculty member and the University shall not commit any act that would tend to defeat the University's or the faculty member's interest in a work or invention. The University shall neither require nor pressure a faculty member to waive the faculty member's intellectual property rights, nor shall the University retaliate against a faculty member who declines to waive or otherwise exercises intellectual property rights in accordance with this Agreement as long as the intellectual property rights of the University, other employees of the University, students, and other third parties are unimpaired or not at risk of impairment. Any such waiver shall be in writing and signed by the faculty member.

(b) In accordance with recognized scientific research procedures and sponsored agreement requirements, faculty members are required to record all research data and information accurately and clearly and to keep all such data in a permanent and retrievable form. In addition, with regard to a patentable invention, original laboratory data must be kept for the life of the patent.

(c) Faculty members must securely store tangible property (such as biological materials, chemical compounds, and computer discs) related to an invention or work to which the University has asserted or may assert ownership rights.

(d) Faculty members who leave the University shall be permitted to copy their laboratory notebooks and take the copies with them, or take samples of tangible property with them, although they are required to maintain the confidentiality of the data contained within the notebooks or the tangible property. The original notebooks and other research data will remain at the University.

(e) The University and the faculty member shall document the terms of any such transfer of tangible property.

22.9 Execution of Documents. Upon employment the faculty member shall be provided with a copy of this Article and shall sign an agreement recognizing the terms of this Article.