



Executive Policy Chapter 12, Research
Executive Policy EP 12.205, Administration of the Patent and Copyright Policy
Effective Date: October 2014
Dates Amended: March 1985, December 2020
Responsible Office: Office of the Vice President for Research and Innovation
Governing Board of Regents Policy RP 12.205, Patent and Copyright Policy
Review Date: Three-Year Review Cycle

I. Purpose

The University of Hawai'i (University) is dedicated to the expansion of knowledge through research and academic scholarship, and the preservation and transmission of knowledge through instruction. In the course of research, scholarship, and instruction, University faculty, staff and students may develop novel and useful inventions, manufactured products, devices, processes or create literary, musical, or artistic works of art. These inventions and works of authorship may have commercial value in addition to their academic and research value. This commercial value may be protectable by patent, copyright, or other means provided by law.

These executive policies provide the University's system-wide framework to identify, preserve, and promote the commercial value in the following areas: (a) the disclosure of inventions and works of authorship created by University employees and others associated with the University; (b) the recognition and protection of ownership rights through means such as patents and copyrights; and (c) the equitable allocation of economic returns generated by the commercialization of the invention or work of authorship among the inventors, authors, research sponsors or funders, and the University commensurate with their contribution in creating, protecting and commercializing intellectual property rights.

II. Definitions

No policy specific or unique definitions apply.

III. Executive Policy

A. Policy Objectives

It is the policy of the University to encourage and facilitate the creation and transfer of innovative and useful technology and works of authorship created at the University in a manner consistent with its mission as a publicly-supported institution of higher education. The University may pursue the best opportunities to make use of any invention or work of authorship in which it has an ownership interest. Inventions and works of authorship may be patented or otherwise protected by the University and appropriately commercialized. The inventor or author shall cooperate fully with the University with respect to the protection, transfer and commercialization of inventions and works of authorship where the University has an ownership interest.

B. General Guidelines

1. This policy applies to University employees, students and others affiliated with the University using University equipment, facilities, funds or other resources.
2. The University may provide administrative support and assistance to University employees and students to facilitate the creation and development of inventions and works of authorship, as well as recognizing its potential commercial value.
3. University employees, students and others using University equipment, facilities, funds or other resources shall promptly disclose such discoveries, inventions or works of authorship to the University. The timing of scholarly publication or other public disclosure should be done in a manner that does not prejudice the ability to secure a patent or other protection of the intellectual property rights. Public disclosure, written or oral, of an invention shall be appropriately delayed to assure viability of a patent application.
4. The University may license, assign or sell, archive, release or dedicate to the public domain any invention or work of authorship where the University has an ownership interest.
5. Those contributing to the creation and commercialization of intellectual property shall fairly share rights, any royalties or other net revenue generated by the commercialization. As the case may be, these contributors may include:

- a. The inventor or author of the intellectual property;
 - b. The University, to the extent that University equipment, facilities, funds or other resources supported the research activity leading to the conception, development or creation of the technology or work of authorship;
 - c. Any external sponsor who provided extramural funds or other means to support the research activity;
 - d. The general public to the extent that public funds were used to support the research activity.
6. University patent and copyrights shall be coordinated and uniformly administered through the system-level Office of Technology Transfer (OTT), or any successor office.

C. Patents

Disclosing Inventions, Executing Necessary Documents, Maintaining Research Records.

1. Maintaining Research Records

All employees of the University, and all nonemployees who use University equipment, facilities, funds or other resources, and those who receive extramural funds through the University ("Originator") shall maintain laboratory notebooks, equipment records, and/or other documentation that are reasonably necessary to document conception and/or the first actual reduction to practice of inventions and to show that the procedures for identifying and disclosing inventions are followed. These records shall be available upon request by the University and its duly appointed representatives or, if applicable, sponsoring agencies.

2. Reporting and Disclosing Inventions and Discoveries

The Originator shall *promptly report and fully disclose in writing to OTT any idea or reduction to practice of an invention or discovery.

*Promptly means as soon as possible after conception or creation, but in any event before public disclosure or publication of results of research or other acts that could negatively affect the University's rights to protect the invention in which the University may have an ownership interest.

The University may require additional information from the Originator to identify and assess the University's or any third party's comparative ownership interest. The Originator shall provide the additional information upon request.

3. Executing Necessary Documents.

The Originator shall execute all such declarations, assignments, and/or other documents as may be necessary in the course of evaluation, patent prosecution, or protection of patent rights to assure the University's ownership or the University's ability to meet its overriding patent obligations arising from grants, contracts or other agreements of any kind with outside organizations, as the case may be.

4. General Allocation of Ownership Interests.

- a. University. The University has exclusive rights and title, in and to, any invention or discovery resulting from any research, development or other work funded by the University, or is conceived or developed wholly or partially at the expense of the University, or with the aid and/or use of University equipment, facilities, funds or resources provided by or through the University.
- b. Inventor. The inventor, or an external research sponsor as the case may be, has exclusive rights to inventions or discovery in the following circumstances:
 - (1) The invention or discovery is determined to have been made by the inventor independently of any contractual obligations to the University and without using University equipment, facilities, funds or resources provided by or through the University and made solely during the inventor's personal, private time.
 - (2) The invention or discovery is a result of permissible independent consulting activities without any use of University equipment, facilities, funds or resources provided by or through the University or an extramural sponsor.
 - (3) The invention or discovery was made with the aid of University equipment, facilities, funds or resources, but the University, with the written approval of the President or the President's designated representative, decides to waive the University's rights or equity therein.

- c. Relinquish or Waiver of Rights. Either the University or the inventor may relinquish their respective rights to the other on mutually agreeable terms and conditions. See Section 6 “Voluntary Transfer of Private Invention to University and Royalty Sharing” below.

5. Inventor’s Share of Royalties Absent Specific Contractual Agreement:

Except as otherwise set forth in a collective bargaining agreement (“CBA”) or other employment agreement applicable to an inventor, and subject to any contrary contractual obligations arising from grants, contracts, or other agreements with outside sponsoring organizations, the inventor’s share of royalties derived from the commercialization of any patent resulting from the inventor’s work shall be as follows:

- a. The inventors shall be entitled to receive FIFTY PERCENT (50%) of the Net Revenue. “Net Revenue” is defined as gross revenue actually received or realized less all costs incurred in connection to prosecuting and commercializing a patent.
- b. If there are two or more inventors, each inventor shall share equally in the inventors’ share, unless all inventors have previously agreed in writing to a different distribution and have notified the University in writing of their distributional shares.
- c. Distribution of the inventors’ share shall be made annually, if any, from Net Revenue actually received.
- d. In the event of any litigation, actual or imminent, or any other action to protest patent rights, distribution of Net Revenue to the inventor may be withheld or suspended until resolution of the dispute.
- e. In the event the share and royalties of this section conflict with any applicable CBA or extramural sponsorship agreement in effect, the CBA or the extramural sponsorship agreement shall take precedence over this section.

6. Voluntary Transfer of Private Invention to University and Royalty Sharing.

A purely private invention, developed by a University employee or others associated with the University, independently of any contractual obligations, and without the use of University equipment, facilities, funds or resources, or funds from an extramural sponsor, may be voluntarily offered to the University for the purposes of patenting, development, and

commercialization as if it were an invention in which the University had an ownership interest. If such offer is accepted by the University, the inventor shall assign all of their rights in such invention to the University and shall receive seventy-five percent (75%) of the Net Revenue, if any, derived from the commercialization of the invention.

7. Outside Employment and Avoiding Conflict of Interest

Each University employee engaged in outside consulting and/or other activities with outside entities has an obligation to ensure that their activities and agreements with third parties are not in conflict with or in violation of the provisions of this policy and should inform those outside parties with whom the employee makes these agreements with of their primary obligations to the University. If the employee's primary obligations under this policy conflict with the employee's secondary obligation to the consulting entity, the obligations under this policy shall take precedence.

In the event an agreement with an outside employer provides or contemplates the University employee granting any intellectual property rights to the outside employer arising from the outside employment, the Office of Innovation and Commercialization ("OIC") shall be consulted.

8. Special Procedures for Extramural Sponsorship of Research

Extramural contracts and grants usually contain patent clauses relating to the respective rights or options available to the parties in respect to inventions developed thereunder. If a contract or grant contains such a clause, it is essential that the Principal Investigator ("PI") be thoroughly familiar and complies promptly with the procedural requirements relating to timely invention disclosure and reporting. Otherwise, the patent rights available to the University and the continuing relationship between the sponsoring agency and the University may be placed in jeopardy.

a. Contracts and other agreements between the University and extramural sponsors of research must comply with the following criteria:

- (1) Researchers and the University shall be free to disseminate and publish the results of sponsored research, provided that to avoid jeopardizing patent rights, the University may agree that any proposed publication will be submitted to the sponsor with notice of intent to submit for publication, and sponsor may in writing request a delay of publication from the date of such notice. However, if the sponsor requests a delay, the submission of the manuscript will be

withheld for the period requested, but in no event for longer than two (2) months from the date of the notice of intent to submit for publication, and only for the purpose of permitting the sponsor to prepare and file the necessary patent application.

- (2) The University shall retain the right to take title to any inventions or discoveries arising from the undertaking of sponsored research, except that the University may grant rights to the sponsor, as deemed appropriate.
- (3) Any agreement or arrangement with the sponsor shall not impose any restrictions upon the University in conflict with its established policies and practices, but shall permit performance of the research or other investigation in the same manner and subject to the same administrative requirements applicable to research financed with the University's own funds.

D. Copyrights

1. Scope.

This Policy covers books or other written materials, as well as other original works of authorship in the various forms that are copyrightable under the copyright laws of the United States and international copyright conventions.

2. General Rights of Employees.

Except in the case of works written or produced for hire, and subject to any restrictions imposed by outside sponsoring or funding organizations, University employees ("author") who create or produce any work of authorship shall have exclusive rights thereto, including the ownership of copyright therein. The author may register the copyright, dedicate the work to the public, or transfer and relinquish the copyright as the author chooses, subject to any restrictions imposed by sponsoring or funding agencies.

3. Rights to Classroom, Educational and Professional Materials

University employees shall own all rights to materials prepared on their own initiative for classroom, educational or professional purposes, including any royalties derived therefrom. Faculty or staff members shall not profit from materials that are assigned by the faculty or staff author to their own students for purchase; materials that are assigned by the faculty

or staff author to their own students for purchase shall be reported in the, University of Hawai'i Conflicts of Interest Disclosure Form, under Administrative Policy 5.504.

- a. Classroom lectures. Faculty or staff members shall own all rights to materials prepared on their own initiative for classroom, educational or professional purposes, and shall be exclusively entitled to the benefit of any royalties derived therefrom.
 - b. Class syllabi and instructional materials. Class syllabi and instructional materials created by faculty or staff members shall be treated as materials prepared on their own initiative for classroom and educational purposes. The University may require, for the sole purpose of complying with accreditation requirements or program articulation, that faculty or staff members provide copies of syllabi or instructional materials to designated managerial personnel. Unless the faculty or staff member has given written consent, furnishing of these materials does not entitle the University, or any member of the faculty or staff, to publish or reuse the materials.
 - c. Distance learning and multimedia presentations. The University may transmit or record for transmission any classroom instruction, lecture or other instructional or performance event produced by faculty or staff as part of a program of distance learning where the faculty or staff member has received either an equivalent reduction in other classroom assignments or overload compensation as set forth in an applicable CBA. The University, however, may not sell or re-transmit in future semesters any such recording except under mutually agreeable terms in a written agreement between the University and the faculty or staff member.
4. Works for Hire.
- a. A work written or produced for hire includes:
 - (1) A work commissioned by the University and prepared by an employee who is hired or assigned by the University specifically to produce such work or released from other work to produce such materials.
 - (2) A work prepared by a person who is not a regular employee of the University but who is specifically commissioned by the University to produce the work pursuant to a signed written agreement which provides that the work shall be considered a work for hire.

b. Rights in Works for Hire:

With respect to works for hire, the University shall have exclusive rights, including the copyright, subject to any contrary terms of any applicable CBA or employment agreement and any restrictions contained in any contract with or grant from an outside sponsor. The employee(s) who prepared or produced the work shall be entitled to receive such proportions as the University in its discretion may determine, of the net revenues, if any, which may be derived from the sale or licensing of such work. However, such sale or licensing shall be within the sole discretion of the University, which shall be under no obligation to develop royalties therefrom.

5. Procedure for Submitting Notification of Intent to Publish Works

An employee who writes or produces a work which he or she intends to publish or exploit commercially shall notify OTT in writing through their departmental head or immediate supervisor of such intention, providing sufficient and appropriate details of the work and the circumstances of its preparation, and seeking a determination as to whether the work is or is not a work for hire.

E. Appealing Adverse Decisions.

1. Decisions that May be Appealed

The following decisions may be appealed:

- a. Whether an invention or discovery is owned by the University;
- b. Whether a copyright work is a “work for hire”; or
- c. Whether an outside employment agreement may not be entered into or requires modification

2. Appeals of Decisions of OTT

Any person aggrieved (“petitioner”) by decisions of OTT may appeal the decision to the OIC Director. The OIC Director will notify the petitioner in writing of their decision.

3. Appeals of Decisions of OIC Director

Any person aggrieved by decisions of the OIC Director may appeal the decision to the Vice President of Research and Innovation (“VPRI”) or their designee. At the discretion of the VPRI, a committee may be convened to review and evaluate the decision and provide a recommendation to the VPRI. The VPRI will notify the petitioner in writing of their decision.

4. Appeals of Decisions of VPRI

Petitioner may pursue any available rights under applicable CBA or other employment agreement.

IV. Delegation of Authority

There is no policy specific delegation of authority.

V. Contact Information

The Office of the Vice President for Research and Innovation may be contacted for information relating to this Executive Policy.

Phone Number: (808) 956-5006

Email uhovpri@hawaii.edu

VI. References

A. Link to superseded Executive Policies in old format

<https://www.hawaii.edu/policy/archives/ep/>

B. Link to Administrative Procedures in old format

<https://www.hawaii.edu/policy/archives/apm/sysap.php>

VII. Exhibits and Appendixes

A. *myInvention* web page: <https://www.hawaii.edu/research/disclosing-an-invention/>

B. [Reserved for notification to publish form.]

Approved:

David Lassner
President

Date