Invention Ownership and Disclosure

DISCLOSURE POLICY

University inventors and all investigators working on sponsored projects are responsible for disclosing all inventions developed prior to and while employed by the University. (RCW 49.44.150) Investigators working on WSU-funded research are responsible for disclosing inventions developed during the research.

Disclosure is required for the purpose of determining the rights of employees, other contributors, and the University. See Invention Disclosure.

Inventor

For purposes of this policy an inventor can be a person receiving compensation for service, any person with a faculty appointment whether compensated or uncompensated, any student working as an investigator on sponsored research, or any person volunteering services for the benefit of the University.

NOTE: Volunteers are not required to disclose all inventions developed prior to University service.

OWNERSHIP CRITERIA

In most cases WSU owns inventions produced by WSU inventors. Address questions concerning ownership to the Office of Commercialization (OC); telephone 509-335-5526.

The University's OC is responsible for determining ownership of intellectual property produced by University personnel. The OC uses the criteria in the table below and on the following page when determining ownership rights to inventions or trade secrets produced by University employees.

<table>
<thead>
<tr>
<th>Invention Ownership</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>WSU</td>
<td>Produced by WSU inventor within the scope of employee duties.</td>
</tr>
<tr>
<td>WSU</td>
<td>Produced with WSU equipment, supplies, utilized WSU facilities, or arising from research funded by grants to or funds of the University. (Minor or incidental use may not constitute WSU ownership. Ownership determination is made by the Intellectual Property Committee in such cases.) See also BPPM 30.15.</td>
</tr>
<tr>
<td>WSU</td>
<td>Produced by WSU inventor. The invention relates directly to University business or to WSU's actual or demonstrably anticipated research or development.</td>
</tr>
<tr>
<td>WSU</td>
<td>Produced by WSU inventor using WSU confidential or research trade secret information.</td>
</tr>
<tr>
<td>WSU</td>
<td>Ownership rights released to WSU by an inventor or outside party by written agreement.</td>
</tr>
</tbody>
</table>
**Invention Ownership And Disclosure**

<table>
<thead>
<tr>
<th>Invention Ownership (cont.)</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Split</strong></td>
<td>Produced by WSU inventor partially or wholly with WSU equipment, supplies, facilities, or trade secret information and the Intellectual Property Committee has determined that it would be unfair to determine that either WSU or the inventor wholly owns the property.</td>
</tr>
<tr>
<td><strong>Student</strong></td>
<td>Produced by WSU student and none of the above criteria apply to invention development.</td>
</tr>
<tr>
<td><strong>Employee</strong></td>
<td>Produced by WSU employee on own time and none of the above criteria apply to invention development. (RCW 49.44.140)</td>
</tr>
<tr>
<td><strong>Employee</strong></td>
<td>Ownership rights released to WSU employee by WSU or extramural sponsor by written agreement.</td>
</tr>
<tr>
<td><strong>Outside Party</strong></td>
<td>For outside party ownership rights, see the <em>Faculty Manual</em>, Section IV.G.2: Patent Policy—Sponsored Research.</td>
</tr>
</tbody>
</table>

**INVENTION DISCLOSURE**

Timely invention disclosure permits accurate determination of ownership rights and assures that the University, its employees and sponsors do not lose patent rights.

**Comprehensive Assignment**

All current and new employees and individuals on appointment at WSU, who reasonably may develop intellectual property during the course of their appointment or employment at WSU are required to sign the Intellectual Property (IP) Assignment form.

The IP Assignment form is available at:

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myresearch.wsu.edu/
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Select **Training**, then
Select **Assignment**.

Employees must upload the completed form to the website above and send the original to the Employee Records and Compliance section of Human Resource Services (HRS).

**Prior Inventions**

At the time of employment, report prior inventions by memorandum. Route the memorandum to the OC. It is not necessary to complete an Invention Disclosure to report prior inventions.

**NOTE:** This requirement is not applicable to volunteers.
Invention Ownership and Disclosure

Inventions While Employed or Acting for Benefit of WSU

Use the Invention Disclosure form to report the details of inventions developed while employed by or acting for the benefit of the University.

Disclosure Form

Obtain copies of the Invention Disclosure form from the OC in Lighty, Room 280/286, or obtain a copy of the form from the OC website at:

commercialization.wsu.edu/

Select Researchers.

Directions for completing the form are available from the OC or online from the OC website.

Route a completed invention disclosure form to the OC at mail code 1060; or submit online at the OC website.

Sponsored Projects

The OC examines each invention disclosure form to determine if a prior right exists by the terms of a sponsored grant or contract. Compliance with the terms of an agreement may include disclosure of the invention to the sponsor.

Incomplete Disclosure

If the OC determines that the invention disclosure is incomplete, the OC returns the disclosure to the inventor specifying what additional information or action is necessary.

Appeals of Ownership Determination

The inventor has 30 days from the mailing date of the ownership determination notification to appeal the OC's decision. The researcher must direct the appeal to the Intellectual Property Committee.

The Intellectual Property Committee must initiate review of the appeal within 20 days of receiving notice of the appeal.

The Intellectual Property Committee must issue the decision on the appeal within 30 days of the deadline for submitting materials relating to the appeal.

WAIVER OF RIGHTS

If the University or its assignee is determined to be the owner, the inventor signs documents assigning their interest in the invention to the University or its assignee. The inventor is also responsible for assisting in obtaining, protecting, and maintaining patent rights.

INVENTION DEVELOPMENT

If it is determined that the University owns the invention the OC reviews the novelty, usefulness, and potential marketability of the invention.
Invention Ownership And Disclosure

**OC Action**

- Direct Supervision: Directly supervise the development of the invention.
- Assign Responsibility: Assign development responsibility to another development organization or a University collaborator.
- Return to Inventor: Return the invention to the inventor with a written explanation stating why the invention does not warrant other action by the University.

This releases the inventor from any obligation to assign ownership of the invention to the University; however, the University retains the right to use the invention in its normal teaching, research and service operations. The University waives its right to realize income from invention commercialization.

**Patenting**

The OC evaluates the potential patentability of the invention, working closely with the inventor. The OC may then take one of the following actions:

- Proceed with the patent application.
- Request more information with the inventor.
- Work with the inventor to determine an alternative to patenting.
- Return the technology to the inventor or funding source, if applicable.

**Royalties**

See BPPM 35.53 for information regarding invention income distribution.