Complaint made in writing

OC Director's Initial Decision

Dispute
• Appeal to VP Research

IP Committee
• May appoint a sub-committee
• Recommendation to AVP-ED

AVP-ED Decision
• Appealable to VPR

VPR Decision
• Final Agency Decision

Arbitration if further disputed
IV.G. Patent Policy

5 B. Patent Inventorship Appeals

This policy applies to WSU researchers, employees, graduate and undergraduate students participating in WSU research as well as others who contribute to the creation of intellectual property and/or dispute the inventorship or ownership of intellectual property created by WSU researchers. See Executive Policy (EP) # _____ (To be drafted). When a question of inventorship or ownership arises among the WSU researchers (which may include faculty, employees an/or students) actively participating in WSU research the procedure for determination of inventorship or ownership shall be as set forth below.

The researchers or students involved are encouraged to try and resolve the dispute among themselves prior to pursuing the procedure outlined below.

(i) Initial Decision

(a). All intellectual property dispute matters will be brought in writing to the Director of the Office of Commercialization (OC) at least by one of the disputing parties. The Director of OC, in collaboration with the appropriate OC staff, will assess the situation, conduct appropriate interviews with the involved parties, and prepare a summary and present the matter with proposed resolution and/or recommendations and initial decision to the Vice President for Research.

(b). OC Director shall make his/her determination of inventorship and/or ownership, or request additional time, within forty-five (45) business days of written complaint from one of the disputing parties. If OC Director asks for additional time, he/she must, in any event, make his/her determination within thirty-five (35) business days of its request for additional time absent evidence of good cause. In any case, extensions must be approved by the Vice President for Research and should be for limited time in length to facilitate prompt resolution of these disputes. The Vice President for Research shall send notice to the employee of OC’s initial decision within five (5) business days of OC’s determination.

(ii) Process for Appeal of OC Initial Decision

(a). The employee shall have thirty (30) business days from the date of Office of Research mailing of the notice of the OC determination of inventorship to appeal the decision to the Vice President for Research. The appeal shall be heard by the Intellectual Property Committee within twenty (20) business days of the notice of the appeal.

(b). The Intellectual Property Committee will make its recommendation to the Associate Vice President for Economic Development or recommend further diligence. In cases where the IP Committee recommends further diligence, the IP Committee will appoint a sub-committee comprising the following to make an initial recommendation within twenty (20) business days. The constitution of the sub-committee should be odd-numbered.

- One member of the IP Committee from the appropriate college/unit, nominated by majority vote of the IP Committee;
- One member of the IP Committee to be selected from a college distinct from the college/unit where the dispute originates, nominated by majority vote of the IP Committee;
- Two faculty members nominated by the Vice President for Research, one from the affected College/Unit and one from a College distinct from the affected College/Unit
- Associate Dean for Research of at least one of the affected colleges.
One representative from a non-academic unit nominated by the Vice President for Research. The AVP-ED, the Director-OC and the Patent Manager, OC will not be part of the sub-committee membership and may provide consultation at the request of the sub-committee. The sub-committee will analyze the information available and prepare a summary for the IP Committee. The IP Committee will review the summary report and provide recommendation(s) to the AVP-ED within twenty (20) business days of the sub-committee’s report to the IP Committee. The employee will be notified of the IP Committee’s recommendation within five (5) business days of its determination by the Vice President for Research. The decision on appeal shall be issued within seventy (70) business days of the deadline for submitting material for an appeal unless extensions of time are approved by the Vice President for Research.

(c). The decision on appeal (the “Initial Appeal Decision”) is appealable to the Vice President for Research who will issue final decision within five (5) business days (“Final Agency Decision”). The Initial Appeal Decision is appealable only for the following reasons:

(i). Substantial deviation from the procedure;
(ii). Erroneous interpretation of the policy;
(iii). Decision not supported by evidence that is substantial;
(iv). Decision is arbitrary and capricious.

The Vice President for Research will review the appeal documentation on record and issue the Final Agency Decision.

(d) Following this internal appeal process, the employee or student will have recourse to settle inventorship by binding arbitration administered by the American Arbitration Association (AAA) under AAA Patent Arbitration Rules or by binding arbitration administered by an equivalent entity mutually agreed upon by all parties. The employee or student shall file his or her claim with any Washington office of the AAA within sixty (60) business days of the Vice President for Research’s decision, and provide a copy of such claim to the Office of the Vice President for Research within the same period of time. Costs of the arbitration shall be shared equally by the parties.

Assignment responsibilities

a) In the event an appeal determines that a WSU employee/researcher is an inventor, then the employee/researcher shall execute documents of assignment to convey to the University, its assignee, or the sponsor all of the employee's interest in the invention determined to be owned by the University, its assignee or the sponsor and assist in obtaining, protecting, and maintaining patent rights as appropriate.

b) In the event an appeal results in ownership of the invention by a WSU employee who filed the written complaint, the University shall formally file all necessary documents with the relevant intellectual property offices to establish the WSU employee/researcher’s inventorship rights in the intellectual property.

If this process results in amended inventorship of a patent or patent application, then the matter will return to OC Director for determination of percentage contribution by the amended/revised list of inventors.
For Reference, current language from faculty manual on ownership appeals:

5A. Patent Ownership Appeals

a) If there is a question of ownership, OC will determine whether the potentially patentable property is owned by the University, by the employee, jointly by the University and the employee, or by an outside sponsor. The Office may determine that the employee or sponsor is a partial owner of the intellectual property with the University in cases where it would be unfair to determine that the property is wholly owned by the University, e.g., when an employee disclosed enabling discoveries that occurred before employment with the University or when the sponsor’s employees have contributed to the invention. In such cases, OC shall notify the previous employer (if any) and negotiate percentages of respective ownership. If OC deems it to be in the best interests of the University to release its rights to the invention, it may do so.

b) When a question of ownership arises, the procedure for determination of ownership shall be as follows. OC shall make its determination of ownership, or request additional time, within forty-five (45) business days of full disclosure. If OC asks for additional time, it must, in any event, make its determination within thirty-five (35) business days of its request for additional time. The employee will be notified of OC’s decision within five (5) business days of its determination.

The employee shall have thirty (30) business days from the date of OC’s mailing of the notice of the determination of ownership to appeal the decision to the Vice President for Research. If the Vice President for Research cannot resolve determination of ownership within five (5) business days of the appeal, the appeal shall be heard by the Intellectual Property Committee within twenty (20) business days of the notice of the appeal. The Intellectual Property Committee will make its recommendation to the Vice President for Research. The decision on appeal shall be issued within thirty (30) business days of the deadline for submitting material. If OC fails to notify the employee in writing of determination of ownership within fifty (50) business days of full disclosure or eighty (80) business days if additional time is requested, then the University's rights in the patentable property shall automatically become the property of the employee or sponsor.

c) Following this internal appeal process, the employee will have recourse to settle ownership by binding arbitration administered by the American Arbitration Association (AAA) under AAA Patent Arbitration Rules. The employee shall file his or her claim with any Washington office of the AAA within sixty (60) business days of the Vice President’s decision, and provide a copy of such claim to OC within the same period of time. Costs of the arbitration shall be shared equally by the parties.

d) After the determination by OC and exhaustion of the employee's right of internal and external appeal, the employee shall execute documents of assignment to convey to the University, its assignee, or the sponsor all of the employee's interest in the invention determined to be owned by the University, its assignee or the sponsor and assist in obtaining, protecting, and maintaining patent rights.

e) In the event an appeal results in ownership by the employee, the University shall formally release all claims to the employee’s invention.