Chapter 100: Patent and Copyright Law

100.020 Patent and Plant Variety Regulations

Bd. Min. 6-25-71, p. 35,974, Amended 9-17-92, 4-25-96, 4-8-05, 11-29-07, 7-23-10.

1. **Purpose** – These regulations are adopted by The Curators of the University of Missouri in order to:

   Secure for the people of the State of Missouri and the United States the full benefits of research and investigation made by the University of Missouri;

   Establish the definite rights and obligations of Employees with respect to any Invention or Plant Variety made by them during employment by the University and to establish the definite rights and obligations of students with respect to any Invention or plant Variety made by them during their period of enrollment with the University;

   Establish a uniform procedure by which these rights and obligations may be equitably determined in each case; and

   Encourage and recognize individual and cooperative achievement in research and investigation.

2. **Application of Regulations** – With respect to Employees, these patent and plant variety regulations form a part of the employment contract. These regulations constitute a condition of employment of all Employees of the University, and shall be effective as to all Inventions and Plant Varieties made during any period of employment from and after the date of their adoption. The rights and obligations of students who do not fall within the definition of Employee found in Section 100.020C.2.b. are addressed in Section 100.020D.6 hereof.

   If a patent or Plant Variety Protection application is filed upon an Invention or Plant Variety which has been made by an Employee of the University within the general scope of her/his duties as defined in Section 100.020 D.1 hereof, but which has not been reported to the Patent Committee pursuant to these regulations, title to such Invention or Plant Variety shall immediately vest in the University and the contract of employment shall be considered as an assignment of such rights, and each Employee as a condition of employment agrees to execute any assignments requested by the University.

3. **Definitions**

   1. "University" as used herein shall be deemed to mean The Curators of the University of Missouri. Any action or consent on the part of the University herein shall be an action or consent duly taken or given by the Board of Curators, or its authorized officer.
2. "Employee" as used herein shall be deemed to mean 1) any person receiving compensation from the University for services rendered, regardless of whether the Employee be full-time or part-time, 2) any person receiving compensation paid through the University from any funds placed in its hands for distribution, or 3) any person that has voluntarily elected to enter into a written agreement with the University in exchange for the University's agreement to treat such person as an Employee for purposes of this policy. For purposes of the definition of Employee and for the avoidance of doubt, student financial aid including, but not limited to, scholarships, grants, loans, tuition waivers and educational fee reductions, generally available to University students and unrelated to any provision of services by the student to the University shall not be interpreted as compensation. Also, for purposes of this policy, full-time students receiving compensation for services rendered to the University which services are unrelated to research or investigation and are unrelated to the creation of computer software shall not be considered to fit within the foregoing definition of Employee.

3. "Supervisor" shall mean any Employee of the University in charge of a project under the supervision of the head of a department or some superior officer.

4. "Head of the Department" shall mean the person having charge of the department of the Employee reporting the Invention, and in case there be no such head of the department, the Dean, or on campuses with no schools and colleges, the Provost shall perform the duties herein provided for the head of the department.

5. "Dean" shall mean the Dean of the college or school having jurisdiction over the Employee, and in case of those Employees not under jurisdiction of any Dean, the business manager shall receive the reports and perform the duties herein prescribed for the Dean.

6. "Patent Committee" shall mean the committee herein provided in Section 100.020 E.

7. "Invention" is comprised of:

   Conception of the idea (mental element); and

   Reduction to practice of the inventive concept (physical element).

   As used in these regulations, the term "Invention" means existence of either the completed mental element or both the mental and physical elements, whichever situation first occurs. (See footnote 1 at end of Section 100.020.)

8. "Plant Variety" shall mean seed varieties that can be protected under a Certificate of Plant Variety Protection. Such varieties are self-pollinated plant varieties.

9. "President" as used herein shall be deemed to mean the President of the University of Missouri or her/his designee and shall include, when applicable, the Interim President or Acting President.
4. Inventions by Employees of the University

1. Rights of University and of Employees

1. The University, as the employer and as the representative of the people of the state, shall have the ownership and control of any Invention or Plant Variety developed in the course of the Employee's service to the University. Each Employee of the University is required and shall upon request assign to The Curators of the University of Missouri all domestic and foreign rights to any Invention or Plant Variety made by the Employee within the general scope of her/his duties as Employee of the University, unless such requirement is waived in writing by the University. Remuneration to the Employee for such assignment is detailed in Section 100.020 E.2.c and E.2.d.

An Invention or Plant Variety shall be considered as having been made within the general scope of the Employee's duties for the University if either of the following conditions are met:

(1) Whenever the Employee's duties include research or investigation, and the Invention or Plant Variety arose in the course of such research or investigation and is relevant to the general field of an inquiry to which the Employee was assigned; or

(2) Whenever the Invention or Plant Variety was in a substantial degree made or developed through the use of University facilities or financing, or on University time, or through the aid of University information not available to the public.

2. An Employee of the University shall be entitled to all rights resulting from any Invention or Plant Variety which was made by her/him outside the general scope of her/his University duties, as defined in Section 100.020 D.1.a; for example, the University shall have no rights to Inventions or Plant Varieties developed in the course of summer or consulting employment by an employer other than the University of Missouri, and not resulting from research or information obtained from University services.

3. If the University finds that an Invention or Plant Variety made by an Employee of the University outside of the general scope of her/his University duties is used or liable to be used in the public interest and executes a certificate of that effect, the Employee may, if he/she wishes to do so, request that an application for a patent or Certificate of Plant Variety Protection be filed and prosecuted at the expense of the University. Under such circumstances the Invention or Plant Variety may be manufactured and used by or for the University, State of Missouri, or the government of the United States for governmental purposes without the payment of any royalty.
4. Except as provided herein, the President may approve the following:

(1) Assignment of Inventions or Plant Varieties owned by the University.
(2) Licensing of Inventions or Plant Varieties by the University.
(3) In determining whether to grant such assignment or license, the President shall consider all relevant factors including, but not limited to, those factors stated in Section 100.020 D.1.f.

5. The requirement relative to the assignment of domestic and foreign patent and Certificate of Plant Variety Protection rights, as set forth in Section 100.020 D.1.a. may be waived in whole or in part in writing by the University as to any Invention or Plant Variety as to which it finds that the interests of the University do not require full assignment of such rights. An Employee of the University shall not file in any domestic or foreign jurisdiction any patent application or Plant Variety Protection Application relating to an Invention or Plant Variety made within the general scope of his University duties unless the University has waived in writing the requirement that rights be assigned to the University. The decision on the waiver should be made within a reasonable time following the request for waiver.

6. The patent rights and/or Certificate of Plant Variety Protection of the University provided under these regulations may be waived, assigned or licensed by the President of the University if the President is satisfied that the patent and Plant Variety provision will reasonably and substantially discharge the obligations of the University of Missouri consistent with the University's interest. In making such determination, the President shall consider all relevant factors including, but not limited to the following:

(1) The amount of royalty or other consideration offered in exchange for such waiver, assignment or license.
(2) The amount of support being provided by any sponsor.
(3) The originator of the research concept.
(4) Whether the research supports work by students who will use the research findings to fulfill educational requirements in their chosen academic programs.
(5) The potential commercial value of the patentable or Plant Variety findings which are likely to result.
(6) The likelihood of patentable or Plant Variety findings resulting from the research.
(7) The recommendation of the principal investigator, the head of her/his department and her/his dean, or on campuses with no schools or colleges, the Provost.
(8) The extent of utilization of University resources and facilities in the development of the Invention or Plant Variety.
(9) The amount of indirect costs provided by any sponsor.
(10) The extent to which the University reserves the right to use any patented or patentable products, materials, processes, or Plant Variety.
(11) The extent to which the University can reserve its right to publish all data of fundamental value to science and technology.
(12) The identity and nature of the sponsor of the research and any contractual restrictions on waiver, assignment and licensing of research results.

2. **Reports of Inventions and Plant Varieties** (See footnote 2 at the end of Section 100.020)

   1. **For Inventions:**

      (1) Every Invention made by an Employee of the University shall be reported by such Employee to the President. The Patent Committee may prescribe the form and manner of execution of the Invention disclosure report, and such Invention reports shall be treated as restricted reports of the University.

      (2) The report shall be made as promptly as possible, taking into consideration such factors as possible publication, public use, or sale and the necessity for protecting the inventor's and the University's rights in the Invention. If an inventive concept is reduced to practice after the Invention report is filed, the patent administrator must be notified forthwith.

      (3) For the protection of the rights of the inventor and of the University, laboratory notebook-diaries, Invention reports, seed development data and memoranda or correspondence concerning them are to be considered University restricted data, and should be so marked.

   2. **For Plant Varieties:**

      Every Plant Variety made by an Employee of the University shall be reported by such Employee to the Employee's head of department (or Dean). The Agricultural Experiment Station may prescribe the form and manner of filing for Certificates of Plant Variety Protection. The report of Plant Variety and all related documents shall be filed with the Patent Administrator prior to the licensing or release (whichever occurs first) of the Plant Variety.

   3. **Inventor Requests for Waiver of University Rights** – If the inventor believes that the Invention or Plant Variety was made outside the general scope of her/his University duties, and if he/she is unwilling to assign the rights in the Invention or Plant Variety to the University, he/she shall, in her/his Invention or Plant Variety report, request that the Patent Committee determine the respective rights of the University and the inventor in the Invention or Plant Variety, and shall also include in her/his Invention or Plant Variety report information on the following points:
1. The circumstances under which the Invention or Plant Variety was made and developed;
2. The Employee's official duties at the time of the making of the Invention or developing the Plant Variety;
3. Whether he/she wishes a patent or Plant Variety Protection application to be prosecuted, if it should be determined that an assignment of the Invention or Plant Variety to the University is not required under Section 100.020 D.1; and
4. The extent to which he/she would be willing voluntarily to assign the rights in the Invention or Plant Variety to the University if it should be determined that an assignment of the Invention or Plant Variety to the University is not required under Section 100.020 D.1.

4. Publication, Public Use and Sale – Publication, public use, or sale of an Invention or Plant Variety constitutes a statutory bar to the granting of a United States patent or Plant Variety Protection for the Invention or Plant Variety unless a patent or Plant Variety Protection application is filed within one year of the date of such publication, public use, or sale. Publication, public use, or sale also can be an immediate bar to patentability in certain foreign countries. In order to preserve rights in unpatented Inventions or Plant Varieties, it shall be the duty of the inventor, or of her/his supervisor if the inventor is not available to make such report, to report forthwith to the Patent Administrator any publication, use, or sale (other than experimental) of an Invention or Plant Variety, irrespective of whether an Invention or Plant Variety report has previously been filed. If an Invention or Plant Variety report has not been filed, such a report, including information concerning the public use, publication, or sale shall be filed at once. If an Invention is disclosed to any person who is not employed by the University or working in cooperation with the University upon that Invention or Plant Variety a record shall be kept of the date and extent of the disclosure, the name and address of the person to whom the disclosure was made, and the purpose of the disclosure.

5. Action by Supervisor or Department Head

1. The preparation of an Invention or Plant Variety report and other official correspondence on patent and Certificate of Plant Variety Protection matters is one of the regular duties of an Employee who has made an Invention or developed a Plant Variety, and the supervisor or department head shall see that he/she is allowed sufficient time from her/his other duties to prepare such documents. The supervisor or department head shall ascertain that the Invention or Plant Variety report and other papers are prepared in conformity with these regulations; shall check its accuracy and completeness, especially with respect to the circumstances in which the Invention or Plant Variety was developed; and shall forward whatever comments he/she may deem to be necessary or desirable to the Patent Administrator. The supervisor or department head shall add to the file whatever information he/she may have concerning the governmental and commercial value of the Invention or Plant Variety, and the foreign
1. In general, students of the University of Missouri will be entitled to own any Invention or Plant Variety made during their enrollment as a student of the University and will generally not be required to assign his or her ownership to the University; provided, however, the foregoing general rule does not apply and the student will be required to assign his or her ownership interest to the University in any circumstance in which the student meets the definition of Employee, as defined in Section 100.020 C.2. provided such Invention or Plant Variety was developed in the course of the student-Employee's service to the University.

2. Without limiting the language of the foregoing general rule or the language of the foregoing exceptions to the general rule, the following are examples of fact situations in which the University will not claim ownership of an Invention or Plant Variety made by a student of the University:

   (1) The Invention or Plant Variety was developed by a student as part of a University class project using no greater University resources than those generally available to all other students within the class or than those available to the student as part of his/her enrollment with the University.

   (2) The Invention or Plant Variety was developed by a student as part of a University approved student competition using no greater University resources than those generally available to all other students within the competition or than those available to the student as part of his/her enrollment with the University. The student shall be entitled to receive any monetary or other prize awarded to the student for his/her performance under such competition in accordance with the rules of the competition and such prize shall not be considered compensation under Section 100.020, C.2 hereof.

   (3) The Invention or Plant Variety was developed by a student as part of a University approved extracurricular activity, using no greater University resources than those generally available to all other students participating in the activity or than those available to the student as part of his/her enrollment with the University.

   (4) The Invention or Plant Variety was developed by a student on his/her own free time, outside of any University class or sponsored activity, and
using no greater University resources than those generally available to all other students as part of their enrollment with the University,

3. The Patent Administrator shall implement reasonable procedures designed to make students aware of this Section 100.020, and to provide one or more avenues for students to receive information regarding to the University's interpretation of the student's rights and obligations with respect to Inventions and Plant Varieties in which they may be an inventor or co-inventor.

5. **The Patent Committee**

   1. **Appointment**

      1. Notwithstanding other regulations affecting University committees, the President of the University shall annually appoint a Patent Committee. The Patent Administrator or other person designated by the Vice President for Academic Affairs shall be an ex officio member of the committee and shall provide a secretary to the committee. The General Counsel or her/his delegate shall also be an ex officio member of the committee.

      2. The President of the University shall designate the chair of said committee.

      3. The committee shall make and keep, in a book to be provided for that purpose, minutes of all its meetings.

   2. **Duties**

      1. The Patent Committee shall review all Invention and Plant Variety reports referred to it by the Patent Administrator, and make recommendations thereon and forward the same to the President of the University for appropriate action.

      2. The Patent Committee shall review, report and make recommendations on all matters affecting patents and Plant Varieties as may be referred to or come before the committee.

      3. If an Employee-inventor shall claim an Invention or Plant Variety as her/his own, the Patent Administrator shall refer such claims to the Patent Committee. The Patent Committee shall afford the Employee-inventor the opportunity to appear before the committee to present such evidence relating thereto as he/she may have or the committee may desire and the committee may make an independent investigation of said claim. Based on these findings, the committee shall make appropriate recommendations in writing to the President of the University for appropriate action. The inventor shall be afforded a copy of the findings and recommendations of the Patent Committee and shall have an opportunity to review the findings of the committee by filing a written argument with the President.

      4. Subject to the approval of the President and upon being advised by the Patent Administrator that he/she has been unable to reach agreement with
the inventor, the Patent Committee shall seek to reach agreement with the Employee-inventor upon division of the financial returns from the patent.

5. The Patent Committee may, when circumstances warrant, i.e., when the Invention or Plant Variety was not made in the regular course of the Employee's duties or as a part of her/his ordinary assigned or assumed functions or when the University contribution in terms of equipment or facilities is either non-existent or minimal, recommend additional remuneration to the inventor from royalties received by the University from income realized from patent rights or Certificate of Plant Variety Protection. Such recommendation shall be made to the President for appropriate action.

6. The Patent Committee will consider such other matters regarding the Employee-inventor's claims, interest or right to patentable findings, as may be referred to it by the Patent Administrator.

7. The Patent Committee shall give consideration as to whether it will be to the best interest of the University and the inventor to place the matter with an entity organized for marketing of patent rights for development by such entity in accordance with its contract with the Curators of the University of Missouri and its general procedure, or for the University to make application for the patent or Plant Variety Protection in its own name.

8. In those cases in which the inventor acknowledges all patent or Plant Variety Protection rights are vested in the Curators of the University of Missouri and where the committee has recommended that the same be referred to an entity organized for marketing of patent or Plant Variety Protection rights with which the Curators have approved a continuing contract, the President of the University, upon approving such reports, in her/his discretion may order the same submitted to such entity. It shall be the duty of the Patent Administrator to carry out orders and directions with reference to the patent or Plant Variety Protection, and he/she shall see that all necessary steps are taken to protect the interests of the University and of the Employee-inventor.

9. In the event the report of the Invention or Plant Variety is submitted to an entity organization for marketing of patent rights with which the Curators have approved a continuing contract and that entity advises that it is not to the best interests of the University to seek a patent thereon, the President shall within a reasonable time seek other means of obtaining a patent or release the rights of the Invention to the Employee-inventor.


1. **Appointment** – The Patent Administrator will be appointed to serve as a member of the staff under the supervision of the Vice President for Academic Affairs.

2. **Duties**

   1. It shall be the duty of the Patent Administrator to establish a liaison with the faculties of the four campuses of the University to assist the faculty in identifying potentially patentable and commercially viable findings, the
filing of reports of such findings, to receive such reports, to advise the faculty regarding steps to be taken to establish record of conception, disclosures, and publication restrictions. The research Coordinators of each campus will assist the Patent Administrator in the fulfillment of these duties on their respective campuses.

2. It shall be the duty of the Patent Administrator to review and make recommendations to the President upon all Invention and Plant Variety reports, except as noted in the paragraph below.

3. The Patent Administrator shall refer to the Patent Committee all matters concerning the Employee-inventor(s) participation in the financial return from the patents, any conflicting claims to protectable findings, Employee-inventor claims to ownership to patent and Plant Variety rights and such other matters as he/she deems necessary to protect the interests or rights of the Employee-inventor and the University.

4. Publicity concerning Inventions: In order that the public may obtain the greatest possible benefit from the Inventions in which the University has transferable interest, the Patent Administrator shall see that Inventions assigned to the University shall be publicized to the greatest possible extent. Where patents are obtained by the University, it shall be the duty of the Patent Administrator, upon being advised of the issuance of the patent, to take steps toward listing the patent as available to those who may be interested in securing the use of the patent rights or otherwise marketing the same.

7. Notification of Abandonment – In the event a decision is reached not to file a patent or Plant Variety Protection application or to abandon a filed application, notice shall be given to the inventor and to the sponsor if the sponsor's contract with the University so provides.

8. Use Of Funds Received By University Relating To Inventions, Patents And Plant Varieties – Whenever the University receives money from any source for the sale, waiver, assignment or licensing of University-owned patents, Inventions, discoveries, or Plant Varieties, the entire amount of such money (except that money received for reimbursement of U.S. Patent and Trademark Office Fees, foreign patent and trademark office fees, external attorneys fees or other external expenses incurred by the University in connection with reexamination of the patent, patent infringement, other defense of the patent or the enforcement or defense of a license agreement, that portion which is for the negotiated indirect cost rate associated with the research project from which the patent, Plant Varieties, Invention, or discovery resulted, and except that portion of money received by the University and paid by the University to the co-owner of a joint invention) shall be divided, distributed and allocated as follows or, in the case of inventions made jointly by University employee(s) and individual(s) employed by the United States Department of Veteran's Affairs, with or without compensation, the President of the University has executed a written agreement with the United States Department of Veteran's Affairs which provides for different division, distribution and allocation of funds:

1. For Inventions and Discoveries
1. Thirty-three and one-third (33 1/3) percent shall go to the inventor.
2. After reimbursement of the University or research sponsor for reasonable costs of procuring and defending the patent rights and reducing the Invention to practice and payment of the inventor's share, all monies derived by the University shall be allocated as follows:

   (1) 66.7 percent to the campus from which the patent, Invention or discovery originated, half of which the campus must allocate to the originating department.

   (2) 33.3 percent shall go to the University.

3. Funds allocated to the departments, campuses and the University are restricted to the support of research, development and other scholarly activities.

2. For Plant Varieties

   1. Ten (10) percent shall go to the inventor.
   2. After reimbursement of the University or research sponsor for reasonable costs of procuring and defending Plant Variety rights and payment of the inventor's share, all monies derived by University shall be allocated as follows:

      (1) Ninety-five (95) percent to the breeding program from which the Plant Variety originated.

      (2) Five (5) percent to the University.

9. Footnotes to Patent Regulations

10. Footnote 1 – The elements of Invention, and their interrelationship may be described generally as follows:

    **Conception of the idea** – This involves complete performance of the mental part of the inventive act. All that remains is to convert the idea into reality by reducing it to practice. Both what is to be accomplished and how it is to be accomplished are necessary. Knowledge of a desirable result alone is not enough; nor is a means for an unknown result. Additional statutory requirements for an Invention to be found patentable, such as novelty and utility, are exceedingly complex concepts and beyond the scope of this summary. Similarly, other patentability bars, such as prior use or disclosure of the Invention more than one year prior to patent application, are not presented due to complexity of the matters involved.

    **Reduction to Practice** – This involves creating either actual or constructive proof that the idea actually works, can exist, or the like. Purely actual reduction to practice is creating a physical embodiment of the idea, although complete perfection is not required. Purely constructive reduction to practice results when a patent application covering the completed concept is accepted by the patent office. The theory is that an acceptable filing is both conclusive proof of practicality and a sufficient disclosure of the concept in the
application papers that one with ordinary skills in the arts involved would be able to practice the Invention. Most often, sufficient reduction to practice is neither purely actual nor purely constructive.

**Interrelation between Mental and Physical Elements** – As between inventors with essentially the same idea, the date of conception controls priority for the right to a patent; provided that he/she who first conceived the idea used reasonable diligence in perfecting and reducing her/his conception to practice. However, if the inventor who first conceived the idea is the second to reduce it to practice, he/she bears a heavy burden to prove her/his priority. The uncorroborated testimony of the inventor on either element is insufficient alone. Therefore, sufficient records to prove both the earliest possible date of conception and diligence in assuring the concept is workable are essential.

Accordingly, any project work or research out of which Invention rights may arise should be documented by contemporaneous maintenance of a laboratory notebook-diary in which periodic entries are made describing the work accomplished. Each entry should be dated and signed by the persons actually doing the work recited. The notebook-diary also should be read and signed periodically as "witnessed" by one or more associates of the inventor who are not engaged in the work but who are capable of understanding the descriptions recited and can testify as to their understanding of the concepts therein disclosed at the time of their signatures. Such a witnessed record may be vital in obtaining or defending the rights of the inventor and of the University should others assert prior Invention. The next best evidence would be a timely, complete, and accurate Invention report in accordance with these Patent Regulations.

11. **Footnote 2** – Disclosure of Invention form (UMUW 16B and 16C) is available from the Graduate Deans' and Research Coordinators' offices on each campus, or from the Office of Technology Commercialization and Economic Development.

12. **Footnote 3** – The elements of Plant Variety Protection may be described generally as protection available for self-pollinating seeds and plants. Such seeds or plants cannot have been offered for sale or sold for a period of more than one year prior to filing an application under the Plant Variety Protection Act. Disclosure of Plant Variety form (UMUW 16D) is available from the Graduate Dean's and Research Coordinator's offices on each campus, or from the Office of Technology Commercialization and Economic Development.