

STATE OF OKLAHOMA

2nd Session of the 46th Legislature (1998)

COMMITTEE SUBSTITUTE

FOR

HOUSE BILL NO. 3211

By: Roach and Pope (Clay)

COMMITTEE SUBSTITUTE

An Act relating to technology transfer; enacting the Higher Education Research and Development Facility Utilization Act; stating policy of the Oklahoma State Regents for Higher Education; providing for acquisition of title to inventions, discoveries and improvements; providing exception; providing for binding nature of policy on faculty, staff and students; providing for effect of patent policy; providing for presumption regarding results of research or other activity; providing for disclosure to Technology Transfer Office; imposing duties upon faculty, staff and employees of The Oklahoma State System of Higher Education; authorizing release of rights; providing for property to which no claims asserted; creating Technology Transfer Office; prescribing duties; providing for appointment of Patent Review Committee; prescribing duties of Patent Review Committee; requiring policy governing ownership of equity interests and royalty negotiation; providing policy supersedes certain other provisions of law; providing for codification; providing for noncodification; providing enactment contingent upon passage of certain measure; and providing an effective date.

BE IT ENACTED BY THE PEOPLE OF THE STATE OF OKLAHOMA:

SECTION 1. This act shall be known and may be cited as the "Higher Education Research and Development Facility Utilization Act".

SECTION 2. NEW LAW A new section of law to be codified in the Oklahoma Statutes as Section 3231 of Title 70, unless there is created a duplication in numbering, reads as follows:

As a public institution, the Oklahoma State Regents for Higher Education are entrusted with the responsibility to facilitate application of scientific and technical research findings for public use and to provide an equitable disposition of interests

among the inventors, the institutions within The Oklahoma State System of Higher Education, and where applicable, the sponsor.

SECTION 3. NEW LAW A new section of law to be codified in the Oklahoma Statutes as Section 3232 of Title 70, unless there is created a duplication in numbering, reads as follows:

A. As a condition of the provision of employment, services, facilities, equipment or material to faculty, staff and students, the Oklahoma State Regents for Higher Education acquires and retains title to all inventions, discoveries and improvements made as a result of college or university sponsored employment or research, or created through the use of time, facilities, equipment or materials owned or paid for by or through the Oklahoma State Regents for Higher Education, except when such facilities, equipment or material are available to the general public. Each full-time faculty and staff member is bound through this policy as is each part-time faculty and staff member and student employee or student participating in research, and any of the foregoing may be asked to execute an assignment of such inventions, discoveries, and improvements to the Oklahoma State Regents for Higher Education and shall do so on request.

B. The signing of a patent agreement is an administrative convenience for dealing with technology ownership rights, but the terms of this policy are controlling and as with other policies, constitute conditions of employment and participation in research.

C. Where an invention, discovery or improvement is related to research conducted by faculty, staff or students in connection with both employment within a college or university or other research activity involving the use of time, facilities, equipment or materials owned or paid for by The Oklahoma State System of Higher Education, and with non-System activities, such invention, discovery, or improvement shall be presumed to result from System-related activity unless the inventor can demonstrate to the appropriate officials that the technology in question was developed solely in connection with non-System activity and without the use of confidential information belonging to the System.

D. Each full or part-time faculty and staff member and student employee or student participating in research shall promptly inform the Director of the Technology Transfer Office concerning all inventions, improvements, and discoveries made as a result of System employment, or created through the use of time, facilities, equipment, and/or materials owned or paid for by or through the System or as a result of System employment or participation in research within the System, to cooperate with and assist the Director of the Technology Transfer Office in the handling of such matters and to abide by and benefit from the patent policy of the System in effect during the inventor's respective associations with the colleges or universities within the System.

E. The System, in its sole discretion, may release to an inventor, by written instrument only, those inventions owned by, but not of interest to the System. If the System does not actively promote or develop the invention over a three-year period, the inventor's claim to full rights shall be honored. Requests for releases should be made to the Director of the Technology Transfer Office.

F. The System claims no right in or to any invention originated by full or part-time faculty and staff members and student employees as a result of private consulting services performed in compliance with the policies and procedures adopted by the Oklahoma State Regents for Higher Education governing such activities. The System claims no right in or to any invention originated by any full or part-time student who is not participating in organized or sponsored research.

SECTION 4. NEW LAW A new section of law to be codified in the Oklahoma Statutes as Section 3233 of Title 70, unless there is created a duplication in numbering, reads as follows:

A. There is hereby created the Technology Transfer Office as an administrative subunit of the Oklahoma State Regents for Higher Education.

B. The Director of the Technology Transfer Office shall report to the vice-president for Research. The Office shall be

responsible for meeting patent regulations associated with research grants and contracts, oversight of patentable research, retaining where possible the rights to inventions developed pursuant to that research and to provide information and general assistance to faculty and other employees within the System and research participants concerning patent development.

C. The Technology Transfer Office shall evaluate and pursue patent protection of those inventions deemed appropriate for commercialization.

SECTION 5. NEW LAW A new section of law to be codified in the Oklahoma Statutes as Section 3234 of Title 70, unless there is created a duplication in numbering, reads as follows:

A. The State Chancellor for the Oklahoma State Regents for Higher Education shall appoint a Patent Review Committee. The Committee shall provide policy interpretation, dispute resolution and advice on pursuing patent protection of inventions. The Committee shall also recommend changes in policies adopted by the System and shall be available to foundations for technical advice.

B. No exception to a patent procedure, royalty distribution agreement or related matters shall be approved except pursuant to official action of the Patent Review Committee.

SECTION 6. NEW LAW A new section of law to be codified in the Oklahoma Statutes as Section 3235 of Title 74, unless there is created a duplication in numbering, reads as follows:

A. The Technology Transfer Office shall adopt policies expressly permitting professors and faculty of an institution within The Oklahoma State System of Higher Education to:

1. Own equity interests in business entities involved in research conducted on the premises of or with the assistance of an institution within The Oklahoma State System of Higher Education;

2. Negotiate for and receive royalty income related to the sales of products, processes or intangible personal property resulting from research conducted on the premises of or with the assistance of the professor or faculty of the institution; and

3. Accept compensation from sources other than the salary or other compensation provided to the professor or faculty member

from the resources of The Oklahoma State System of Higher Education if the additional compensation is related to research conducted on the premises of or with the assistance of an institution within The Oklahoma State System of Higher Education.

B. A policy adopted by the Technology Transfer Office pursuant to paragraph 3 of subsection A of this section shall supersede the provisions of any statute or administrative rule that would otherwise prohibit the receipt of such compensation.

SECTION 7. NONCODIFICATION Section 1 of this act shall not be codified in the Oklahoma Statutes.

SECTION 8. The provisions of this act shall be contingent upon the passage of the amendment to Section 14 of Article 10 of the Oklahoma Constitution as contained in Enrolled House Joint Resolution No. 1088 of the 2nd Session of the 46th Oklahoma Legislature.

SECTION 9. This act shall become effective November 1, 1998.

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