

To: **Officers of Instruction, Officers of Research, Postdoctoral Fellows,
Student Officers of Research and Graduate Students**

From: **Dennis A Mitchell, Interim Provost**

Subject: **Information Regarding Assignment to the University of Certain Inventions,
Discoveries and Associated Technologies**

You have been asked to sign a letter assigning to the University certain inventions, discoveries and associated technologies ("Agreement"). This memorandum provides some background information concerning the Agreement, including the reasons for the Agreement, what it covers, who is required to sign it, and its implementation.

We certainly appreciate your cooperation in this administrative process and we hope this memorandum addresses any questions or concerns you may have.

Reasons for the Agreement

The University requires applicable individuals to sign the Agreement in order to enable the University to comply with both the University's Statement of Policy on Proprietary Rights in the Intellectual Products of Faculty Activity ("IP Policy") and applicable Federal law.

The IP Policy calls for assignment to the University of "inventions and discoveries which are or may be patentable, as well as the technology associated with them." The IP Policy is found in Appendix D of the Faculty Handbook (<http://www.columbia.edu/cu/vpaa/handbook/appendixd.html>). Also, Federal law requires the University to obtain written agreements to disclose inventions to the University and execute all papers necessary for the filing of patent applications from all personnel engaged in Federally-funded research.¹ Most non-Federal grants now also contain similar provisions.

What the Agreement Covers

The Agreement covers any discovery, invention or algorithm that is or may be patentable, together with any supporting technology that result primarily from the use of Columbia's facilities or from activities while engaged in Columbia's service ("Inventions"). Such Inventions include any patentable inventions that are conceived or reduced to practice in the course of research supported in whole or part by the Federal government or by any other internal or external funding source to the University.

¹ The Federal Law, known as the Bayh-Dole Act, is codified at 35 USC §200 et seq. The implementing regulations in question, issued by the Department of Commerce, are codified at 37 CFR part 401.

Who is Required to Sign the Agreement

The following are required to sign the Agreement:

- Full time Officers of Instruction;
- Salaried Officers of Research;
- Postdoctoral Clinical and Research Fellows;
- Student Officers of Research; and
- Graduate Students who receive stipends from pre-doctoral training grants or from individual pre-doctoral fellowships (these individuals do not hold appointments as Student Officers).

Such individuals include those appointed for the first time and those switching to a covered category (e.g., Student Officers switching from a teaching to a research appointment and Officers of Research switching from a non-salaried to a salaried appointment).

Implementation

PLEASE RETURN THE SIGNED AGREEMENT TO YOUR DEPARTMENTAL ADMINISTRATOR.

We note that appointments will not be processed without a signed Agreement. Further, grant proposals may not be processed, and Columbia Technology Ventures (formerly Science and Technology Ventures) and the CUIMC Clinical Trials Office may not execute agreements on behalf of investigators who have not signed the Agreement.

Please direct questions about the procedure for signing and filing the Agreement to your Departmental Administrator. Please direct questions about the University's IP policy to Columbia Technology Ventures (techventures@columbia.edu). Please direct questions about the Federal requirements and other legal questions to the Patent and Licensing Group at the Office of the General Counsel (plg@gc.columbia.edu).

Thank you again for your cooperation in this process.