

## Updates

- UAHuntsville Board Committee met 10/23
- UAHuntsville Community Committee met 10/24
- Board of Trustees meeting Nov 1 and 2, Tuscaloosa
  - Appoint Financial Advisor and Bond Counsel for Charger Union (\$25 million) and Nursing (\$10 million) bond issues
  - Current debt (fixed rate) \$81.4 million; \$6.2 million annual debt service
  - Academic Program approval
  - Approval of Sales and Purchase Agreement for University Place School

## **Sale and Purchase Agreement University Place School**

- Approved by Huntsville City Board of Education  
October 18, 2012
- Purchase price of \$4.7 million
- \$2.857 million from University Plant Fund; \$1.843 million loan from UAH Foundation with 5 yr payback
- Deposit of 10% of purchase price
- Closing on or about October 1, 2014
- Closing extensions to October 1, 2018 with 180 days notice

## Patent Policy

### Bayh-Dole Act (1980) and Amendments (1984)

- Prior to Bayh-Dole federal government owned federally-funded inventions
- Post Bayh-Dole
  - universities permitted to own inventions made under federal funding
  - universities obligated to have written agreements with faculty and staff requiring disclosure and assignment
  - universities must share a portion of licensing revenue with the inventor

## **UAH Patent Policy-Board Rule 509**

- Condition of employment and contractually binding
- All inventions that meet the following “shall be automatically assigned to the University”
  - results of research carried on by an employee and costs paid for by the University
  - made by an employee “and which relates to the employee’s field of work”
  - developed in whole or in part utilizing university resources

## Stanford v Roche

- Stanford assignment language: “I agree to assign” inventions to Stanford arising from employment at Stanford
- A faculty member made an invention while being assigned by Stanford to conduct research at a private company
- Faculty member signed an agreement with the private company: “I will assign and do hereby assign” inventions made while at the private company

## Stanford v Roche

- Faculty member made an invention while at the private company
- Private company was sold to Roche
- Roche made a product using the invention
- Stanford sued for patent infringement
- Supreme Court ruled in favor of Roche
  - agreement with Stanford only a promise (“I agree”) to assign
  - agreement with Roche an authentic (“I do hereby assign”) assignment
- Legal Counsel to recommend to the Board to incorporate “I do hereby assign” language in Board Rule 509