

When your company wants to license your invention from WSU: boundaries for WSU employees

When a WSU employee is an owner or executive officer of a company that wants to commercialize technology that the WSU employee invented during their WSU employment, the WSU employee must clearly separate when they are acting in their company role and when they are acting as WSU inventor/contributor. The WSU employee inventor cannot sit on both sides of the licensing agreement negotiation table.

By default, a WSU employee inventor acts in their capacity as a university employee and does not participate in negotiation or decision-making regarding the license on the company side. If the WSU employee inventor prefers to participate on behalf of the company, they must sign a waiver that states that they waive their right to participate on the university side.

A. Default Roles and Responsibilities. WSU employee inventor chooses to remain on the University side of the negotiation, i.e., the WSU employee inventor has not yet signed a waiver.

Type of Matter/Interaction with OC	In what role is the university employee-inventor participating?	Nature of participation	Comments/Notes
IP invention disclosure	University employee	Content expertise	As content expert, provides information on the novelty and possible commercial application of invention
Patent drafting	University employee	Content expertise	As content expert, provides information on how broad the claim scope can be to adequately cover the invention and provides supporting data
Patent filing and selection of countries for filings	University employee	Advisory only; no decision-making authority	<u>On request</u> , can advise technology licensing officer on countries where the technology may be valuable.
Patent prosecution	University employee	Content expertise; no decision-making authority	Provides information on how to technically address the patent office rejections
Patent maintenance	University employee	Advisory only; no decision-making authority	No decision-making role
License/option negotiation	University employee	Advisory only; no decision-making authority	Provides negotiation team with content expertise. May communicate priorities or special considerations to negotiators
Promoting IP licensed to their own company	University employee	NONE	Use of position as a state officer to promote private business interests is <u>not permitted</u> under the WA Ethics in Public Service Act.

B. WSU Employee/Inventor has chosen to represent the company and waives participation on WSU-side of negotiations. (Note: Table B applies only after the WSU employee-inventor has signed a waiver regarding the relevant technology. Until a waiver is in place, WSU employee-inventor may engage only in their capacity as a WSU and WA state employee—see Table A.)

Type of Matter/Interaction with OC	In what role is the university employee-inventor participating?	Nature of participation	Comments/Notes
IP invention disclosure Patent drafting	IP with signed waiver: company representative	None, unless IP is jointly owned	If jointly owned, then provides content expertise on behalf of company. No role for company employee otherwise.
	New IP: University employee	See Table A	
Patent drafting	Company representative	Same as unrelated licensee—advisory only	Provides content expertise only if IP is jointly owned or to the extent OC requests. No role for company employee otherwise.
Patent filing and selection of countries for filings	Company representative	Advisory only; no decision-making authority	With signed licensing agreement under which Company has agreed to cover costs, Company can provide a list of countries .
Patent prosecution	Company representative	Limited content expertise	Provides content expertise only to the extent OC requests. <i>Company, as Licensee, covers costs and hence makes business decisions under the license.</i>
Patent maintenance	Company representative	Decision-maker	Company, as Licensee, covers costs and hence makes business decisions. No role on University side.
License/option negotiation	Company representative	Decision-maker	No University role. Limit discussion of negotiation with WSU colleagues not party to the negotiation. Withdraw from internal WSU policy discussions concerning WSU’s standard license terms until negotiations have concluded.
Promoting IP licensed to their own company	Company representative	Decision-maker; can promote in company role	No promotion allowed in University employee role. Employee must clearly separate company and university activities to avoid appearance of utilizing position as state employee to promote their private business.