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OF COUNSEL – Winter 2011-2012
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NORTHEASTERN UNIVERSITY
OFFICE OF THE UNIVERSITY COUNSEL
378 COLUMBUS PLACE
X2157

International Contracts: Important Changes to the Process
Engaging a Photographer or Videographer: Policy on Ownership of Photos and Videos
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Independent Contractor or Employee?

UPCOMING SEMINAR: On **January 19, 2012 at noon** Matt McIntyre and Nick Bradley will re-present a version the July 2011 seminar, “*How Your Efforts Can Speed Up the Contract Review Process.*” The event will be held in the **Alumni Center - Sixth Floor, Columbus Place.**

International Contracts: Important Changes to the Process

For International Contracts only: Please note that *all international contracts* must first be submitted to **Dr. Robert Lowndes, Vice Provost for International Affairs.** An international contract is any proposed academic agreement between the University and a foreign person or entity focused on education, research or service. If you wish to contract with an international person or entity, please work first with Vice Provost Lowndes, who will manage the submission of your agreement to University Counsel for review. If you send an international contract directly to University Counsel, we have been asked to return it to you with a reminder to first contact Vice Provost Lowndes.

Engaging a Photographer or Videographer: Policy on Ownership of Photos and Videos

The University requires that all videographers and photographers who are engaged on a work-for-hire basis must assign to the University ownership rights associated with the videos and photos that they take for the University. Among other things, this requirement allows the University to retain control over how its name and images, as well as images of students, are used and disseminated. The current photographer template agreement, available from University Counsel’s website, provides that the University is the owner of all photographs and videos created pursuant to the agreement.

Although the University must own all such videos and photos, the University is able to license certain rights to the videographer or photographer. For example, the University may grant limited rights to the photographer or videographer to use and display images as part of a professional portfolio. You can work with University Counsel to make the necessary edits to the template agreement. Please note all University-approved template agreements are available from the University Counsel website.

Protecting your Intellectual Property: Filing Provisional Patent Applications

You have an exciting, new idea, and you have been invited to give a lecture during which you plan on discussing some of the particulars of your idea. If you haven’t spoken with **Anne-Marie Dinius, Intellectual Property Manager** and the newest attorney to join University Counsel’s legal team, your right to patent this idea could be

in jeopardy. Here, Anne-Marie answers some of your questions about how to protect your patentable ideas by filing provisional patent applications:

Q: When should I consider filing a provisional patent?

A: Filing a provisional patent application should occur simultaneously with your preparation for your talk or submission of your grant application or abstract. Once you have taken the steps necessary to disseminate your paper or prepare your talk, you have done all that is necessary to file a provisional patent application. If you send your paper or talk to me prior to sending it to individuals outside of the university, we can file a provisional patent application for you. *You will also have to complete an invention disclosure form, available at: <http://www.northeastern.edu/research/wp/cri>.*

Q: What is a provisional patent?

A: A provisional patent is an informal patent application that is filed with the U.S. Patent Office. The purpose of filing a provisional patent application is to allow you to preserve your date of invention while you decide whether you would like to invest the University resources necessary to prepare and file a formal patent application. You have **one year** from the date of filing your provisional patent application to convert the provisional into a U.S. patent application or an international patent application. Provisional patent applications do not have to include patent claims or figures.

Q: How long does the filing process take? How much advance notice should I provide?

A: Please allow at least two weeks to review your invention disclosure form and whatever other documents we will ultimately file as your provisional patent application, e.g., your paper, your power point slides, test results, or an abstract.

Q: What might happen if I don't file a provisional patent application?

A: *If you publicly disclose your invention before you file a provisional patent application, you give up patent rights in ALL countries except the U.S. and Canada.* Importantly, in 2013, when the U.S. implements the America Invents Act, the one-year grace period is going to be substantially altered. This will affect public disclosures in the following way – if you disclose something, and then subsequently file for a patent application, your disclosure will not bar you in the U.S. and Canada, so long as you file your patent application within a year from the date of your disclosure. But, if someone else takes your ideas and publishes those ideas, that publication will be an invalidating prior art reference for your later-filed patent application.

The motto here is – File Your Provisional Patent Application First, Publicly Disclose Second.

Safely Navigating the Co-op Waters: International Students and their Advisors

International students who engage in co-ops, internships, practicums or any other kind of off-campus research or training must have advance written authorization from the International Student & Scholar Institute (ISSI) to comply with federal law. Students may work only within the dates and at the location specified on the documents that will be issued by ISSI. Working without first obtaining authorization from the ISSI may result in the student's loss of legal status in the United States. This applies to all positions, paid or unpaid. It is also very important to know that a student cannot extend the period of employment without first receiving amended authorization from the ISSI. Overstaying one's co-op job or other external placement will jeopardize the student's status and put the employer at risk for unauthorized employment. **If you have any questions or concerns please contact the ISSI at 617.373.2310.**

Examples¹ of unauthorized employment:

- Nicolette, a graduate student from Tunisia, worked at a six month-long co-op for a Boston company having secured in advance approvals by both her co-op advisor and ISSI. At the end of her authorized co-op period she continued her employment at the company on a part-time basis without amended authorization from ISSI. Working without authorization resulted in the termination of Nicolette’s non-immigrant student status in SEVIS and she was forced to leave Northeastern and the United States in the middle of the semester.
- Nigel, an undergraduate student from Belize, successfully completed his first co-op assignment with all proper authorizations, including that of the ISSI. He later went out on a second co-op assignment with the approval of his co-op advisor but without proper ISSI authorization for that co-op assignment. Working without authorization for his second co-op resulted in the termination of Nigel’s non-immigrant student status in SEVIS due to unauthorized employment. He was forced to leave Northeastern and the United States in the middle of the semester. Nigel eventually was able to be reinstated but had to forfeit his eligibility for the one year of Post-Completion Optional Practical Training visa status after he completed his degree, which otherwise would have been available to him.

TAKEAWAY POINT: The ISSI is responsible for clearing all international students who wish to participate in co-ops, internships, practicums or any other kind of off-campus research or training. ISSI approval is required EACH TIME before any international student can engage in these types of opportunities. Lack of prior ISSI authorization will adversely affect the international student’s status and put both the student and the employer at risk.

Independent Contractor or Employee?

The Massachusetts Wage and Hour law (M.G.L. c. 149, §148B) creates the *presumption* that any work arrangement, including a professional services type arrangement, is an **employer-employee** relationship. In other words, Massachusetts law can be construed to assume that the worker is the University’s employee and, if challenged, the University has to demonstrate otherwise. This is important because the existence of an employer-employee relationship triggers a number of rules and obligations (such as tax withholding) that hiring an independent contractor does not. If one of the University’s independent contractors is later determined to be an employee, the University could face significant legal and financial exposure.

As a general matter, a consultant paid by the University may be considered an “employee” of the University unless all three (3) of the following are true:

1. The consultant is **free from the University’s direction and control**.
 - If the consultant is being directly supervised by the University, he or she may not be independent.
 - This must be true **by contract *and* in fact**.
2. The consultant performs services that are **outside the scope of the University’s usual course of business**.
 - For example, a librarian may not be hired as an independent contractor, because library services are within the scope of the University’s business.

¹ These are hypothetical scenarios. Any resemblance to actual persons or situations is unintentional and coincidental.

3. The consultant is **customarily engaged in the trade** for which the University retained him or her.
 - The consultant must regularly be available to provide the types of services for which the University retained him or her to a number of clients. In other words, the consultant holds him or herself as performing this service for others, not just the University.

How can you properly treat service providers and consultants as truly independent contractors and not employees of the University?

- Use the University-approved contract templates, available on University Counsel's website.
- Make sure the services are not already performed by someone at the University as part of the scope of the University's business.
- Conduct due diligence on the potential service provider.
- If you are uncertain, ask questions! See the University's Independent Contractor policy at <http://www.northeastern.edu/ap/independent/policy.html>, or call Accounts Payable at x2652 or University Counsel at x2157.

A reminder about the process for engaging independent contractors:

1. A contract must be prepared to govern the relationship. The *Northeastern University Professional Services Agreement* template is available at the Purchasing and the University Counsel websites and may be downloaded to assist with the preparation of the contract. The contract must be submitted to the University Counsel's office. Once reviewed, the contract will then be forwarded to the Treasurer's office for signature.
2. The unit or department head who seeks to retain an independent contractor must also complete the *Employee/Independent Contractor Certification Form*, which can be downloaded from the Purchasing website.
3. The completed *Employee/Independent Contractor Certification Form* and signed *Professional Services Agreement* must then be submitted together to the Purchasing Department, along with a purchase requisition.
4. A purchase order will not be issued without the completed Certification Form and a properly executed contract. A purchase order is required for all independent contractors, regardless of the value of the assignment.

If you have any questions you would like to see answered in this space, please submit them to the Office of University Counsel at 378 Columbus Place. Depending upon the nature of your question, we'll either answer you personally or address your issue in a future edition of this newsletter.

Of Counsel has been prepared as a general summary of important developments. It is not intended as individual legal advice. Should you have any questions or need information concerning a specific situation or any of the content of this advisory, please contact the Office of University Counsel, 378 Columbus Place, x2157.