Memorandum to Presidents

Vol.16, No. 2

Date: April 13, 2017

From: Office of the Executive Vice Chancellor and Provost

Subject: Policy and Guidance: Patents and Inventions

To: Presidents, State-Operated Campuses
    Presidents, Community Colleges
    Statutory College Contacts

This memorandum provides guidance on implementing the State University of New York Board of Trustees’ Resolution 2016-71, Amendment to the SUNY Patents and Inventions Policy 8 NYCRR Part 335.28, adopted on November 3, 2016. The revised policy codifies nearly five years of collaborative effort to update SUNY’s policy in a way that creates a best-in-class environment for supporting research growth across the System, thereby increasing SUNY’s ability to find solutions for state and global challenges.

Accompanying this memorandum are the SUNY Patents & Inventions Policy, SUNY Procedures for the Management of Patents and Inventions, and SUNY Guidelines for the Management of Patents and Inventions (Appendices A, B, and C, respectively).

This effort began in 2012 when SUNY Chancellor Nancy L. Zimpher appointed and charged the SUNY Patents and Inventions Policy Board to define SUNY’s intellectual property and commercialization policy objectives, and ensure alignment with SUNY’s strategic goals, including the entrepreneurial goals set forth in The Power of SUNY 2010 and Beyond. This work was driven by SUNY’s unwavering commitment to uphold the highest standards of ethical behavior and informed by a number of factors, including: the evolution of state and federal law; the transforming profile of SUNY research and innovation; the rising costs of supporting technology transfer; and a broad desire to increase partnerships with business and industry, including opportunities that would provide applied learning and research opportunities for SUNY students. Together, these elements drove an effort to modernize SUNY’s previous policy on patents and inventions, which had last been modified in 1988.

The Patents and Inventions Policy Board solicited input from stakeholders across the system to arrive at the revised policy. It was developed in consultation with the SUNY Trustees, SUNY Provost and Executive Vice Chancellor Alexander N. Cartwright (who chaired the Policy Board beginning in June 2015), Presidents, Chief Academic Officers, Vice Presidents for Research, the University Faculty Senate, Faculty Council of Community Colleges, SUNY Student Assembly, Faculty at Large, Technology Transfer Directors, as well as United University Professions.
The extensive stakeholder process resulted in comprehensive revisions to the policy, including new mechanisms for cost recovery, conflict management and transparency, with an overarching focus on community and industry engagement. Significantly, the changes now provide unprecedented flexibility for campuses to exercise individualized business judgment.

This memorandum addresses the principal areas of change introduced by SUNY’s revised Patents and Inventions policy, including:

- **Ownership**: A best practices approach to the ownership and management of patentable inventions;
- **Royalties**: Ability to recover costs incurred during the commercialization process while preserving SUNY’s national position as an institution with one of the most generous royalty-sharing policies in the country;
- **Flexibility & Transparency**: Enhanced flexibility for campuses to make business decisions when working with external partners (always including consultation with faculty inventors), and increased transparency, including the elimination of confusing and ambiguous terminology surrounding “own time” inventions;
- **Students**: A system that encourages student innovation and entrepreneurship; and
- **Innovation Policy Board**: formerly the Patents and Inventions Policy Board, this body is empowered to interpret and implement the policy, including oversight of the process for the swift handling of any dispute.

Community colleges are strongly encouraged to consider adopting similar policies that promote the creation of intellectual property and support innovation on campus. Campuses interested in working with SUNY System in this area are encouraged to reach out to the Office of the Provost.

Individual contact information is provided throughout this memorandum. Questions may also be directed to the Office of the Provost at: provost@suny.edu.

Attachment

Cc: Chief Academic Officers, All Campuses  
Vice Presidents for Research, All Campuses  
President, University Faculty Senate  
President, Faculty Council of Community Colleges  
President, Student Assembly
Guidance on SUNY Board of Trustee Policy, Resolution 2016-71

Patents and Inventions Policy of The State University of New York

I. Ownership

The ownership of Intellectual Property (“IP”) developed under the auspices of SUNY is subject to a two part test. Specifically, as of the effective date of the new regulations (November 23, 2016), SUNY shall own IP created within the scope of the Creator(s)’ employment by SUNY, or through the Substantial Use of SUNY Resources.

This policy generally provides for SUNY ownership of IP created by employees of any of the family of SUNY entities, including campuses, campus auxiliary service corporations, campus foundations, the Research Foundation for SUNY, and the State University Construction Fund. The scope of one’s employment by and for the university is generally a fact-specific inquiry that is determined by the leadership of the campus. The most common circumstances in which inventions are created under SUNY’s auspices are by academic staff engaged in research. In such cases, the Chief Academic Officer, or delegate, of the campus at which the individual is employed is empowered to determine what activities are within and beyond the scope of one’s employment for purposes of implementing this policy. Chief Academic Officers should be aware that questions may arise on campus regarding whether a given activity is within the scope of an individual’s employment for the purpose of determining the ownership of inventions. The local campus Office of Human Resources and SUNY System’s Office of Employee Relations should be consulted in determining scope of employment issues.

The substantial use of university resources is also a determining factor in the ownership of inventions. In this context, the substantial use of SUNY resources means any use of SUNY resources that is more than incidental, including, but not limited to, use of: financial support, funds and grants administered by SUNY or a SUNY Affiliate; inter-institutional collaborations facilitated by SUNY; equipment, facilities, services, laboratories, or space; computers and computer or communications networks not publicly or routinely-available; research, clinical, or other scientific instruments; time spent by Personnel, including secretarial, clerical, administrative staff, and research and teaching assistants; confidential information; Inventions and other proprietary or intellectual property owned by SUNY; and any privileged access as a result of a person’s affiliation with SUNY. Incidental Use is any use of publicly or routinely-available SUNY resources, such as residence halls, common areas, meeting rooms, cafeterias, gymnasiums, libraries, office spaces, furnishings, office supplies, photocopiers, telephones, fax machines and other standard office equipment, personal-type computers, and commercially available software in use on such computers, computer and communications networks, including internet access and data storage, that is nonessential to the creation of the IP, and any use of SUNY resources by a Student in accordance with assigned coursework pursuant to that Student’s academic curriculum. The circumstances under which use of university resources gives rise to SUNY’s ownership of the invention is well-defined within the policy and is further explained in its accompanying Guidelines, appended hereto in Appendix C.

There may be cases in which an individual employed within SUNY creates Intellectual Property outside the scope of his or her employment and without the substantial use of university resources. Where an individual working under such circumstances creates a patentable invention, the Policy requires that the individual submit to the Chief Academic Officer (or delegate) of their campus an External Invention
Disclosure (form attached as last page in Appendix B). The CAO (or delegate) should make reasonable inquiry to confirm the accuracy of the affirmations in the Disclosure form, and may execute a release and waiver only if and when satisfied that the invention was created outside the scope of the individual’s employment for SUNY and without substantial use of university facilities. Campus Technology Transfer Offices are prepared to assist CAOs in the evaluation of these materials and may be delegated the authority to execute the referenced release and waiver forms, if desired.

It is important to note that as campuses are implementing this policy, if a matter arises in which the facts do not fit squarely within the policy, whether in determining the scope of one’s employment or whether one’s use of university resources is or was substantial, the matter can always be referred to the Innovation Policy Board. As of November 23, 2016, the Innovation Policy Board replaced the Patents and Inventions Policy Board as the body with authority to hear such disputes under the policy. Section V below contains more information about that board’s role.

II. Royalties

This Policy introduces significant changes to the amounts and manner in which royalties are distributed to the creators of income-generating IP. SUNY’s prior policy required campuses to distribute to inventor(s) 40% of the gross royalty received in all circumstances, while this Policy shifts the distribution from a gross to net formula, increases the percentage of royalty that is distributable to inventors, and creates flexibility for campuses to determine the distribution of income from inventions that are not patented.

First, the shift from gross to net enables campuses to recover their investments in the technology commercialization process when successful licensing generates royalty income. Under this policy, campuses are empowered to recover from licensing proceeds our actual out-of-pocket expenses for investments in the commercialization process. Specifically, we can now apply royalty income to offset our costs for the evaluation, marketing, development, protection, maintenance, and enforcement of our IP.

Second, while incoming licensing revenue can be used to offset costs, the portion of the remaining net royalty that is distributed to inventors and creators has been increased. Where the previous policy provided for inventors to share in 40% of gross royalty, this policy provides for inventors to share in 45% of the first $100,000 of net royalty and 40% thereafter.

Finally, this policy redefines the type of IP that is subject to royalty distribution provisions, and enables greater flexibility to set campus policies that specify adjustable distribution rates. Patentable inventions will always be subject to the distribution rates defined above, with 45% of the first net $100,000 distributed to the inventor and 40% thereafter. This is also the default distribution for computer software and other IP that is not patentable (or may be patentable but is not patented), unless the campus has adopted its own policy. Specifically, campuses can create local policies requiring the reinvestment into university research programs the income generated from computer software and unpatented inventions, so long as no less than 45% of the first net $100,000 and 40% thereafter is dedicated to the program within which the IP was created.

It is important to note that these are all default provisions that can be superseded with customized royalty arrangements between faculty and administration so long as all of the creators and SUNY agree otherwise in a written and duly executed instrument. However, royalties paid to a creator may never exceed 45 percent of the net royalty received.

These are all significant measures to promote the recovery of costs for campuses who invest heavily in IP commercialization, but there are also very specific procedures that must be followed to ensure accountability and transparency for the stakeholders in this activity.
The Research Foundation for SUNY (RF SUNY) is responsible for implementing these provisions. RF SUNY, in cooperation with campus technology transfer offices, has adopted this new policy, procedure and guidelines, and developed step-by-step instructions for administration. Any questions regarding the administration of royalty income should be directed to RF’s Senior Director for Innovation and Partnerships, Heather Hage, at heather.hage@rfsuny.org or (518) 434-7156.

III. Flexibility & Transparency

Prior to the revisions, SUNY’s prior policy was often viewed as inflexible and even a barrier to industry partnerships. With current changes, campuses now have maximum flexibility in contracting with outside partners. Campuses may freely enter into creative arrangements for IP ownership with external partners as long as such arrangements are memorialized in a written agreement between the Partner and SUNY or SUNY Affiliate. This empowers campuses to make business decisions locally while enabling campus faculty to suggest the appropriate disposition of IP. Also, faculty are now permitted to dispose of income by way of assignment, which enables effective estate planning.

Policy revisions have also increased transparency in the IP disclosure process. The policy establishes a new process whereby SUNY is able to expressly waive its rights to ownership (discussed in section I above) in certain IP created by a faculty member outside of SUNY employment and without substantial use of SUNY resources. In such cases, the creator can disclose using a non-confidential description of the IP and subsequently secure a waiver from the university. This practice adds a level of transparency and empowers faculty who engage in consulting activities. Outside activities such as faculty consulting are discussed in section 10 of the Guidelines (Appendix C).

It has long been SUNY’s practice that decisions regarding intellectual property are made in consultation with the creator. Additionally, in furtherance of a more transparent process, creators of intellectual property may request an accounting of the distribution of royalties earned from their creation.

IV. Students

With policy revisions, SUNY has allowed for greater support of student innovation and entrepreneurship. The policy contemplates student ownership of IP created by them in a course of study at SUNY. While SUNY is proud to empower its students to pursue entrepreneurial activities, it recognizes that the process of disseminating or commercializing an invention is complex. In all circumstances, students are encouraged to avail themselves of the University’s services and seek the assistance of a University technology transfer office, which may or may not necessitate assignment of student IP or other consideration for the provision of innovation and entrepreneurial assistance.

V. Innovation Policy Board

As described in Section (g) of the Policy, the Chancellor-appointed Innovation Policy Board (formerly the Patents and Inventions Policy Board) will undertake periodic review of the Policy and create, revise and enhance guidelines and procedures to interpret and implement the policy. The Board is also empowered to create committees to hear disputes and issue recommendations for their resolution to the full Board. The scope of the Board’s jurisdiction and the initial Procedures and Guidelines developed by the Board to interpret the Policy can be found in Appendices B and C. Any questions regarding exceptions, releases, waivers and disputes may be submitted to the Secretary to the Innovation Policy Board, Elise Puzio, at elise.puzio@suny.edu or (518) 445-4028.
APPENDIX A:
SUNY Patents and Inventions Policy
STATE UNIVERSITY OF NEW YORK INTELLECTUAL PROPERTY POLICY

TITLE J – INTELLECTUAL PROPERTY POLICY

§ 335.28 Patents and Inventions Policy

(a) Purpose of the Patents and Inventions Policy (“this Policy”)

(1) The State University of New York (“SUNY”) recognizes that the three primary missions of an educational institution are teaching, research, and public service. SUNY further recognizes that, in the course of performing its mission, innovations of public value will be developed under its auspices. It is the policy of SUNY to encourage such innovation and to take appropriate steps to aid Creators and ensure that the public receives the benefit of such innovation in accordance with its public service mission. Appropriate steps include securing research support, identifying and encouraging disclosure of Intellectual Property, securing appropriate protections, marketing Intellectual Property through licensing and other arrangements, and managing royalties and other related income, such as litigation proceeds. These activities are undertaken in a spirit of cooperation with governmental agencies and private industry as part of SUNY’s contribution to the economic well-being of the State of New York and of the Nation.

(2) In implementing its policies, SUNY will take appropriate steps to ensure that its academic community may freely publish the results of scholarly research pursuant to SUNY’s policy on unrestricted dissemination of research activities. In conformance with this principle, all concerned shall cooperate so that essential rights to Intellectual Property shall not be lost.

(3) All net proceeds realized from the commercialization or other monetization of SUNY Intellectual Property, after payment of the Creator’s share as defined in subpart (e) of this Policy and other appropriate costs associated with the evaluation, marketing, development, protection, maintenance, or enforcement of Intellectual Property, shall be used for the support of SUNY research programs in a manner consistent with the Bayh-Dole Act and its implementing regulations. Campus net proceeds shall be applied in a manner consistent with local campus policies and procedures. Upon the request of a Creator, SUNY shall provide an accounting of the distribution of royalties earned from Intellectual Property of the Creator.

(b) Definitions

(1) Affiliate: For purposes of this Policy, Affiliates include The Research Foundation for The State University of New York (“The Research Foundation”), State University Construction Fund, all campus auxiliary service corporations, and all campus foundations.

(2) Created: Having conceived, authored, reduced to practice, designed, developed, or otherwise having contributed to the making of Intellectual Property.
(3) Creative and Course Content: Academic course content and materials Created by Personnel including, but not limited to syllabi, course materials and textbooks; other scholarly or creative works of authorship; instructional, dramatic, musical and artistic works; and manuscripts, articles, poetry, prose, short stories, digital shorts, novels, plays, screenplays, and creative writings.

(4) Creator: One who has Created Intellectual Property, in whole or in part.

(5) Incidental Use of SUNY Resources (“Incidental Use”): Any use of publicly or routinely-available SUNY resources, such as residence halls, common areas, meeting rooms, cafeterias, gymnasiums, libraries, office spaces, furnishings, office supplies, photocopiers, telephones, fax machines and other standard office equipment, personal-type computers, and commercially available software in use on such computers, computer and communications networks, including internet access and data storage, that is nonessential to the creation of Intellectual Property, and any use of SUNY resources by a Student in accordance with assigned coursework pursuant to that Student’s academic curriculum.

(6) Intellectual Property: Patentable Inventions, tangible research materials, computer software, and any unique or novel innovation in the technical arts or any new and useful improvements thereof, including methods or processes for creating an object or result (a way of doing or making things), machines, devices, products of manufacture, product designs, or composition, maskworks or layout designs for printed circuit boards or integrated circuits, compositions of matter, materials, any variety of plant, and any know-how essential to the practice or enablement of such innovations and improvements, whether or not patentable.

(7) Inventor: One who contributes to the conception of a Patentable Invention under the patent laws of the United States or other relevant jurisdiction.

(8) Net Royalty: Royalty less reasonable out-of-pocket expenses incurred by SUNY and not reimbursed by licensees for the evaluation, marketing, development, protection, maintenance, and enforcement of the subject Intellectual Property.

(9) Partner: Any entity or individual who is neither Personnel nor Student, who engages with SUNY or a SUNY Affiliate through a contract or other business transaction that will facilitate the research, teaching, or public service missions of SUNY.

(10) Patentable Invention: Any art or process (way of doing or making things), machine, manufacture, design, or composition of matter, or any new and useful improvement thereof, or any variety of plant, which is or may be patentable under the patent laws of the United States or other relevant jurisdiction, and the patent applications or patents that embody them.

(11) Personnel: All full-time and part-time employees of SUNY and SUNY Affiliates, Student employees (including, but not limited to, research assistants, teaching assistants, fellows, post-
doctoral scholars, and students providing services under sponsor agreements), and other persons
holding any paid appointment or position with SUNY.

(12) Royalty: Cash, equity, or other value received by SUNY as consideration for use of rights to
SUNY Intellectual Property.

(13) Students: Individuals enrolled in SUNY, including, but not limited to, continuing education,
undergraduate, graduate and professional students, non-degree students, and not-for-credit
students.

(14) Substantial Use of SUNY Resources ("Substantial Use"): Any use of SUNY resources that is
more than Incidental Use, including, but not limited to, use of: financial support, funds and grants
administered by SUNY or a SUNY Affiliate; inter-institutional collaborations facilitated by SUNY;
equipment, facilities, services, laboratories, or space; computers and computer or communications
networks not publicly or routinely available; research, clinical, or other scientific instruments; time
spent by Personnel, including secretarial, clerical, administrative staff, and research and teaching
assistants; confidential information; Inventions and other proprietary or intellectual property owned
by SUNY; and any privileged access as a result of a person’s affiliation with SUNY.

(15) The State University of New York ("SUNY"): References to “SUNY” in this Policy may include
Affiliates where appropriate under the contexts, whether or not specifically stated. In addition, at the
request of SUNY, SUNY Ownership of Intellectual Property under subpart (d)(1) of this Policy may
include ownership, management, promotion, licensing and other transfers, commercialization, and
monetization of certain Intellectual Property by The Research Foundation.

(c) Scope

(1) This Policy applies to Intellectual Property Created, in whole or in part, by SUNY Personnel,
Students, Affiliates, and Partners.

(2) This Policy sets forth the rights and responsibilities of SUNY and SUNY Personnel, Students,
Partners, and Affiliates in the development, creation, ownership, protection, maintenance,
dissemination, marketing, licensing, and monetization of Intellectual Property.

(3) Creative and Course Content is beyond the scope of this Policy.

(d) Ownership of Intellectual Property

(1) SUNY Ownership: Subject to the exceptions of (d)(2) below, SUNY shall own, and Creator shall
promptly disclose and assign to The Research Foundation, Intellectual Property Created, in whole
or in part:
(a) within the scope of the Creator’s employment by SUNY; or

(b) through the Substantial Use of SUNY Resources, unless otherwise agreed in writing.

(2) Creator Ownership: Ownership rights to Creative and Course Content shall be governed by SUNY’s Copyright Policy. A Creator who is Personnel may retain ownership rights to Intellectual Property that is not Creative and Course Content if:

(a) the Intellectual Property was Created exclusively outside the scope of the Creator’s employment by SUNY; and

(b) the Intellectual Property was Created through no more than Incidental Use of SUNY Resources; and

Creators of Intellectual Property satisfying (d)(2)(a) and (d)(2)(b) above shall submit an External Invention Disclosure Form as prescribed in SUNY’s Procedures for Disclosure and Management of Patents and Inventions.

(3) Student Ownership: A Creator who is a Student and not also Personnel may retain ownership rights to Intellectual Property Created through no more than Incidental Use of SUNY Resources, subject to those restrictions that may be required by an external sponsor, if any. A Student shall own the copyright to his or her thesis unless an agreement supporting the underlying work specifies otherwise. Under all circumstances, SUNY shall have an unrestricted royalty-free license to reproduce and disseminate Student theses.

(4) Partner Ownership: Where SUNY intends that a Partner engage in Substantial Use of SUNY Resources, the ownership of Intellectual Property Created by or for the Partner in connection with the use or sponsorship of SUNY Resources shall be memorialized in a written agreement between the Partner and SUNY or an Affiliate.

(5) Joint Ownership: Intellectual Property may be subject to exercise of ownership rights by two or more parties, including SUNY, Affiliates, Personnel, Students, and Partners, in which case joint ownership may be appropriate.

(6) Questions as to Ownership: Where any dispute is raised as to ownership of Intellectual Property, patents, or patent applications under these provisions, the matter shall be referred to the Innovation Policy Board in a manner consistent with SUNY’s Procedures for Disclosure and Management of Patents and Inventions.
(e) Royalty Income

(1) Patentable Inventions: With respect to any Patentable Invention obtained by or through SUNY or assigned to or as directed by SUNY in accordance with the foregoing provisions, SUNY, in recognition of the meritorious services of the Inventor and in consideration of the Inventor's assignment of the Patentable Invention to SUNY, will make provision entitling the Inventor and the Inventor's heirs or legatees to share in the proceeds from the management and licensing of such Patentable Invention to the extent of forty-five percent (45%) of the first $100,000 of Net Royalty received by SUNY and forty percent (40%) of Net Royalty thereafter, unless the Inventor and SUNY agree otherwise in a written and duly executed instrument, or if this exceeds the limits fixed by applicable regulations of the relevant sponsoring agency, which will control in such cases.

(2) Computer Software and Intellectual Property Other Than Patentable Inventions: With respect to any Intellectual Property that is not a Patentable Invention, including Computer Software that is not a Patentable Invention, Created in the performance of academic or research activities and obtained by or through SUNY or assigned to or as directed by SUNY in accordance with the foregoing provisions, SUNY, in recognition of the meritorious services of the Creator and in consideration of the Creator's assignment to SUNY, will make provision entitling the Creator and the Creator's heirs or legatees to share in the proceeds from SUNY's management and licensing to the extent of forty-five percent (45%) of the first $100,000 of Net Royalty received by SUNY and forty percent (40%) of Net Royalty thereafter, unless:

i) the campus has adopted a local policy requiring reinvestment in support of university research programs, in which case no less than forty-five percent (45%) of the first $100,000 received by SUNY and forty percent (40%) of such income thereafter shall be directed to the program within which the Intellectual Property was Created; or

ii) the Intellectual Property is a work for hire or subject to a conflicting obligation to a sponsor or a Partner; or

iii) the Creator and SUNY agree otherwise in a written and duly executed instrument; or

iv) if this exceeds the limits fixed by applicable regulations of the relevant sponsoring agency, which will control in such cases.

(f) Release and Waiver

(1) SUNY decisions regarding evaluation, marketing, development, protection, maintenance, or enforcement of Intellectual Property shall be made in consultation with the Creator(s). SUNY may, at the Creator's written request, release its ownership rights in Intellectual Property to the Creator(s), subject to those restrictions that may be required by an external sponsor, if any.
(2) SUNY shall make an initial determination regarding whether to retain title to Intellectual Property within one year of SUNY’s acceptance of the Creator’s fully disclosed, assigned and properly executed disclosure statement. SUNY shall proceed with patenting, development and marketing of the Intellectual Property as soon as practicable thereafter. If SUNY elects not to retain title or fails to make such an election within one year, all of SUNY’s rights to the Intellectual Property shall be released upon written request to the Creator, subject to those restrictions that may be required by an external sponsor, if any.

(3) For any Intellectual Property so released to a Creator, SUNY shall receive ten (10) percent of the net proceeds to the Creator, in recognition of the contribution of the State and people of New York to the support of the research that resulted in the Intellectual Property. For purposes of this subpart, (f)(2), “net proceeds” means income realized by the Creator from commercialization or other monetization of the Intellectual Property less reasonable costs incurred directly by the Creator for the evaluation, marketing, development, protection, maintenance, or enforcement of the subject Intellectual Property.

(g) Innovation Policy Board

(1) The Chancellor shall establish and appoint an Innovation Policy Board of the State University of New York and designate the chair thereof in accordance with the procedures accompanying this Policy. The Innovation Policy Board shall have full powers of organization to undertake periodic review of this Policy and to create, revise and enhance guidelines and procedures to interpret and implement this policy.

(h) Applicability

(1) Intellectual Property which is fully disclosed and assigned in a properly executed new technology disclosure statement before the effective date of these regulations shall be subject to SUNY’s prior Patents and Inventions Policy.
APPENDIX B:
Procedures for Disclosure and Management
STATE UNIVERSITY OF NEW YORK PROCEDURES FOR THE DISCLOSURE AND MANAGEMENT OF PATENTS AND INVENTIONS

SUNY’s Patents and Inventions Policy empowers the Chancellor to appoint an Innovation Policy Board to advise the Chancellor in the development of guidelines and procedures to interpret and implement the Policy. These Procedures for the Disclosure and Management of Patents and Inventions, recommended by SUNY’s Innovation Policy Board, are designed to assist faculty and administration in the interpretation and application of the Policy to advance innovation and the dissemination of knowledge for the benefit of the public and the SUNY community. All definitions in these Procedures derive from SUNY’s Patents and Inventions Policy (hereinafter “SUNY’s Patent Policy” or simply “the Policy”).

(a) Disclosures of Intellectual Property

(1) A Creator of Intellectual Property that satisfies either of the conditions set forth in subpart (d)(1) of SUNY’s IP Policy shall promptly disclose and assign such Intellectual Property to The Research Foundation, and shall execute any additional documents as may be required by the United States Patent and Trademark Office, United States Copyright Office, and any foreign patent offices or other agencies overseeing governmental systems of intellectual property.

(2) Personnel who Create Intellectual Property that is not Creative and Course Content and satisfies both of the conditions set forth in subpart (d)(2)(a) and (b) of the Policy shall, consistent with the Policy, sponsor requirements, local and system-wide SUNY Conflict of Interest policies and procedures, and New York State Public Officers Law, provide to the Chief Academic Officer (or delegate) of the campus at which the Creator is appointed, a sworn statement, including a nonconfidential description of the Intellectual Property and affirming the circumstances under which the Intellectual Property was Created as only through Incidental Use and as exclusively outside the scope of any employment by SUNY. These affirmative demonstrations must be made through the External Invention Disclosure Form accompanying the Policy and these Procedures.

(b) Innovation Policy Board

(1) The Innovation Policy Board (hereinafter “IPB”) shall have no more than ten (10) members, and shall include one representative of system administration, two from the university centers, one from the health sciences centers, one from another major research institution of the university, one from the colleges of arts and sciences, one from the agriculture and technology colleges, one from The Research Foundation, and two representatives from business and industry.

(2) The IPB shall meet at least once annually.

(3) The members of the IPB shall serve without extra compensation and at the pleasure of the Chancellor. The normal term of appointment shall be for three years.
(3) The IPB shall advise the Chancellor or delegate on the following matters:

(i) periodic review of the Policy;

(ii) revision and enhancement to these procedures and other guidelines to interpret and implement the Policy;

(iii) requests for exception to the Policy in unusual circumstances;

(iv) determining the extent of SUNY’s interest in particular Intellectual Property on written request from a Creator or appropriate campus administrator; and

(v) any such other matters as the Chancellor may deem appropriate.

(4) The IPB shall report at least annually to the Board of Trustees concerning its activities and recommendations during the preceding year.

(c) Exceptions and Waivers

In all cases, any Creator is entitled to request the IPB grant an exception or waiver to the provisions of the Policy. The Creator requesting an exception or waiver shall have the right to appear, accompanied by representatives of their choice, before the IPB for consideration of the request for an exception or waiver. The IPB shall prepare a report of its findings and an advisory recommendation to the Chancellor. The decision of the Chancellor shall be final.

(d) Disputes as to Ownership

Where any dispute is raised to the IPB regarding the ownership of Intellectual Property, patents, or patent applications under section (d)(6) of the Policy, the matter shall be referred to a committee of five members to be named by and act as the delegate of the Innovation Policy Board (“IPB”). At least three of such members shall be Personnel who are also members of the SUNY academic staff. Such committee shall make a careful investigation of the circumstances under which the Intellectual Property was Created and shall transmit its findings and recommendations to the IPB for review and final determination of ownership.
EXTERNAL INVENTION DISCLOSURE
8 NYCRR § 335.28(d)(2)
and
SUNY Procedures for Disclosure and Management of Intellectual Property

Instructions for completing this form. This form should be used to clear legal title to external inventions created by SUNY employees in compliance with Section (d)(2) of SUNY’s Patents and Inventions Policy and Section (a) of SUNY’s Procedures for Disclosure and Management of Intellectual Property. In completing this form, be mindful of any confidentiality obligations you may owe to third parties and refrain from disclosing any information that may constitute a public disclosure under US Patent Law.

Part A. Describe the invention created. Please describe the general essence of the invention. Do not disclose technical or enabling features.
____________________________________________________________________
____________________________________________________________________
____________________________________________________________________
____________________________________________________________________

Part B. Describe the circumstances under which the invention was created (where, how, for whom, and what facilities and other resources were used).
____________________________________________________________________
____________________________________________________________________
____________________________________________________________________
____________________________________________________________________

Part C. Identify to whom the invention has been or will be assigned.___________
____________________________________________________________________

I do hereby attest that the foregoing Intellectual Property was Created:
(a) exclusively outside the scope of the my employment by SUNY; and
(b) through no more than Incidental Use of SUNY Resources.

Name:
Campus:
Title:

SUNY hereby waives and releases any and all legal interest in the foregoing invention, as disclosed herein.

____________________________________
Chief Academic Officer
APPENDIX C:
Management Guidelines
STATE UNIVERSITY OF NEW YORK
GUIDELINES FOR THE MANAGEMENT OF PATENTS AND INVENTIONS

Background

Supporting and rewarding the SUNY community’s efforts to benefit the public through innovation, translation of research, and broad dissemination of knowledge are critical to the achievement of SUNY’s missions of teaching, research and service. SUNY is committed to excellence in the conduct of scholarly research and leveraging that research for the public good is paramount. The transfer of knowledge happens in many ways, from teaching and mentoring students who take their learning to the workforce to collaborative research with industry; from publications in academic journals to patenting inventions for licensing to new and existing companies. Effective translation of research for the public benefit requires that the university and its faculty, staff, and students adhere to the highest standards of research integrity, with transparency and clarity regarding the use and ownership of research results and the identification and management of conflicts of interest.

SUNY encourages innovation; rewards faculty, staff, and students for their entrepreneurial thinking and action; and ensures its various constituencies benefit from University services, while vigorously promoting compliance with applicable laws, regulations, policies and other obligations. In the area of innovation and entrepreneurship, the key rules are SUNY’s Patents and Inventions Policy and New York State Public Officers Law §74, which governs conflict of interest for state actors.

SUNY’s Patents and Inventions Policy empowers the Chancellor to appoint an Innovation Policy Board to advise the Chancellor in the development of guidelines and procedures for the implementation of the Policy. These Guidelines for the Management of Patents and Inventions, endorsed by SUNY’s Innovation Policy Board, are designed to assist faculty and administration in the interpretation and application of the Policy to advance innovation and the dissemination of knowledge for the benefit of the public and the SUNY community.

Definitions

All terms used in these Guidelines but not defined herein shall have the definitions assigned to them in SUNY’s Patents and Inventions Policy (hereinafter the “Policy”).
Guidelines

1.) Public Benefit.

State University of New York encourages creative, collaborative arrangements with business partners that provide an experiential learning landscape for its community of students, faculty and staff. The primary motivator for the University in the protection and transfer of Intellectual Property is to make available to the public those innovations that will improve human health and welfare, and the dissemination of knowledge is paramount. As an academic institution, the University acknowledges that for the public to benefit from its innovation, the University must rely upon industrial partners to translate its research into products and services. Thus, the University’s management of Intellectual Property developed under its auspices must take into account Intellectual Property considerations that are relevant to industry. The University therefore expects that all members of its community shall cooperate so that Intellectual Property rights that are essential to the commercialization of its innovations shall not be lost.

2.) Publications.

SUNY’s Policy on Unrestricted Dissemination of Research Activities requires unrestricted dissemination of the conduct, progress, and results of sponsored research, and The Research Foundation adheres to the intent of this policy in its contracting with third parties on behalf of SUNY campuses. Where an industry partner is sponsoring or otherwise supporting research at SUNY, it may be appropriate to grant the partner access to manuscripts or other proposed publications of the project’s staff for the purpose of identifying confidential and/or potentially patentable subject matter. In such cases, a reasonable delay of publication may be necessary and appropriate. However, agreements with industry partners should never include a right of a sponsor to suppress or prevent the dissemination of research results generated by a SUNY researcher absent extraordinary circumstances, such as for the protection of state and national security, in which case it may be appropriate to submit to the Chancellor or his/her designee a request for exception under the above-referenced policy.

3.) Disclosures, Elections of Title, and Patent Filings.

Consistent with federal regulations governing invention disclosures, elections of title, and patent application filings, SUNY and RF will decide, in consultation with the inventor(s), whether to elect to retain title to Intellectual Property owned by SUNY under Section (d) of the Policy, within one year of SUNY’s acceptance of the inventor’s properly executed disclosure statement.
4.) Computer Software.

Computer software is an increasingly common medium and form of Intellectual Property that plays various roles in the State University community. For example, the use of State University computers may result in the creation of computer software. The University may also contract with external suppliers and/or hire Personnel specifically to Create computer software to facilitate some business purpose of the University. In cases where a work is commissioned by the University, whether as an assignment to Personnel or a project contracted out to a vendor, the resulting computer software should be owned by the University, subject to reasonable exceptions which should in all cases be agreed upon, in writing, prior to the Creation of the work.

Computer software can be either copyrighted or patented, depending on the particular circumstances, and can often be licensed for commercial use. As discussed above, the proprietary interests of several groups can be involved when computer software is generated; the Creator or Creators, the University or its Affiliates, or an outside sponsoring agency. The University wishes to clarify and protect the rights and interests of these parties before the work is Created, and encourages local concerns to consult with the appropriate Technology Transfer Office for guidance on Intellectual Property considerations for transactions involving the development of computer software before it is created.

5.) Industry Sponsored Projects.

SUNY’s Patents and Inventions Policy provides broad flexibility for the treatment of Intellectual Property in agreements with industry. Campus administrators are encouraged to consult with principal investigators and other project staff as appropriate when negotiating the Intellectual Property terms of SUNY’s agreements with industry.

6.) Student Intellectual Property.

SUNY’s Patents and Inventions Policy contemplates Student ownership of Intellectual Property Created by them in a course of study at SUNY. While SUNY is proud to empower its Students to pursue entrepreneurial activities, it recognizes that the process of disseminating or commercializing an Invention is complex. In all circumstances, Students are encouraged to avail themselves of the University’s services and seek the assistance of a University technology transfer office, which may or may not necessitate assignment of Student Intellectual Property or other consideration for the provision of innovation and entrepreneurial assistance.
7.) Multiple forms of IP.

SUNY’s Patents and Inventions Policy acknowledges that various forms of intellectual property may come into being in the course of performance of one’s University service. Nothing in the Policy may be construed to grant to a Creator who is not an Inventor the right to assert an ownership interest in a Patentable Invention, or the patent application or patents associated therewith.

8.) Program Income.

A myriad of federal, state and local laws, regulations, and policies may apply in a given set of circumstances under which Intellectual Property is Created. Faculty, staff and students are encouraged to be aware and use all reasonable diligence in identifying the sources of funding or other support that may give rise to the Creation of Intellectual Property, and to seek to clarify, in writing, these various proprietary interests prior to the performance a project through which Intellectual Property may be Created and/or disseminated. For example, where federal agency funds are used to fabricate items that are offered for sale, federal regulations may require that the income derived from the sale during the period of performance be used to defray the cost of the program. This is one of a great many examples of requirements imposed by program sponsors that the University must observe. Thus, faculty, staff and students are encouraged to work with the University’s contracts and grants specialists and technology transfer professionals to evaluate the circumstances under which Intellectual Property was Created and to work collegially to establish the relative rights and responsibilities of the various entities that may be involved.

9.) Affiliated Organizations.

The University facilitates its mission of teaching, research and public service through no less than 100 entities operating under the auspices of the State University of New York. These organizations are essential to the performance of the various functions that enable State University to be the largest, most comprehensive system of public education in the United States. Service to an Affiliate is service to State University, and any individual in service to State University is expected adhere to the principles articulated in State University’s innovation policies, absent contrary provisions in a written agreement or entity-specific policy, which shall control in such cases.

10.) Outside Activities.

University employees generally are permitted to engage in outside activities, such as consulting, provided the activities do not pose of conflict of interest with their University duties. Personnel should consult their local campus policies on the amount of time that he or she may be permitted to dedicate
to outside activities and ensure the proposed activity is first disclosed to and approved by the individual’s supervisor and local authority for conflict management, as applicable.

Generally, Substantial Use of SUNY Resources in connection with approved consulting or other outside activities is not permitted without a separate written project agreement, which in most cases will require sponsorship of the facilities and Personnel to be involved in the project. SUNY staff or other employees should not be used to support outside activities absent specific authorization from an appropriate campus administrator.

For additional guidance on managing conflicts of interest, see the RF Guidelines for Managing Conflict of Interest in Innovation and Partnerships.

11.) Assignability of Royalty Income.

SUNY places no restrictions on the assignment or waiver of royalties by an Inventor.

12.) Research Grants and Contracts.

Grants and contracts made available to SUNY by or through The Research Foundation or other Affiliate shall be subject to the Policy herein stated except nothing in the Policy shall prevent the acceptance of research grants or the establishment of other cooperative arrangements with or from, or the conduct of research for, agencies of the United States or The State of New York, either directly or through The Research Foundation or other Affiliate, upon terms and conditions under applicable provisions of federal law or regulations which require a different disposition of Intellectual Property. In most cases, grants or contracts which provide for ownership of SUNY Intellectual Property by other than SUNY or The Research Foundation should include a reservation of rights or license for SUNY to practice the subject Intellectual Property for its own internal research and educational purposes.