

PATENT POLICY
of
STATE UNIVERSITY

The patent policy of the State University, approved by the Board of Trustees, is as follows.

Title 8, Section 335.28 of the Official Code of Codes, Rules and Regulations of the State of New York. (Article 130 of the Policies of the Board of Trustees.)

(a) State University recognizes that its primary purpose is to conduct research and not to make inventions for profit. It shall permit its research activities to result in inventions and discoveries for the public interest. It is also recognized, however, that inventions and discoveries do result from university activities. In such cases, the best interests of the university should be obtained. The university's purpose in securing patents is the successful development of such inventions for the benefit of the state and it is the university's policy to devote all efforts that it may realize from such patents to the support of its University research programs, subject to the approval of the State Board of Regents. The university shall cooperate with the inventor in the publication of the results of university research, and shall cooperate to the end that all such results be made timely made. To this end, the university shall cooperate with the inventor in the publication of university research results.

(b) All patentable inventions shall be made by employees of the State University. The State University shall be the assignee of all such inventions. However, a patentable invention made by an individual wholly on his own time, and without the use of university facilities, shall belong to the individual inventor.

field of competence relating to his subject matter. For the purposes of this provision an individual's "own time" shall mean time other than that devoted to his normal and assigned functions in teaching, university service, education and research on campus. The term "university facilities" shall mean any facility available to the inventor as a function of his employment with State University, or a public university, or a non-State University, or a private institution of higher education. Where any question is raised as to ownership of an invention or patent under these provisions, the matter shall be referred to a committee of five members to be named by the chancellor of State University. At least three of such members shall be members of the academic staff of the university. The committee shall make a careful investigation of the circumstances under which the invention was made, and conclude whether the invention was made in the course of university facilities and not in the inventor's own time. In such determination, the committee shall determine whether the invention or to any patent obtained thereon.

(c) If an invention is made by an inventor who is employed by a university or assigned to or assigned by the university, and in recognition of the meritorious services of the inventor and in conformity with his agreement that the invention shall be assigned to the university, the university, will make provision for awarding the inventor, and his heirs or legatees to a non-exclusive license for the invention, which may be made in whole or in part, but shall not exceed a percentage of the net income derived from the invention, which will not exceed the license fee payable to the university by the management agency for the purpose of providing scientific and management agencies for the purpose of providing scientific and advice with respect to the patentability of an invention, and the obtaining of a patent thereon, and the management and marketing of any such patent. The net income shall be divided equally between the management agency and the university.

(d) Upon recommendation of the patent policy board, the chancellor may grant exclusive licenses for the marketing of inventions since it is recognized that such a license is in the public benefit. Normally, such an exclusive license shall be granted for a period of not more than five years, and in special circumstances as determined by the patent policy board. The term of exclusive licenses for a five-year period shall be determined by the patent policy board.

chancellor as a condition of an external sponsor's contribution to the university's research program within the university's research program. The board shall have the authority to make such arrangements as may be necessary to carry out the provisions of this section.

(e) Grants made available to the university by or through The Research Foundation of State University of New York shall be subject to the provisions of this section, except as hereinafter provided. Nothing in this section shall prohibit the university from entering into contracts for the conduct of research for agencies of the United States Government directly or through the Research Foundation of State University of New York on conditions under which the university retains the right to use the results of such research which require a different disposition of patents or patent rights, nor shall any provisions contained in any cooperative arrangements with other agencies of the State of New York for research in any field prohibit the university from entering into such research from any other source. The provisions of this section shall apply upon the same terms and conditions as the established patent policy of the university which differ from the provisions of this section. The chancellor, acting with the advice of the patent policy board, may specifically authorize the university to enter into such terms, and conditions, as may be necessary to carry out the provisions of this section.

(f) The chancellor, acting with the advice of the patent policy board, may determine not to file a patent application in any case of invention. The final decision shall be made known to the inventor within a period not to exceed six months from the date of first submission of the inventor's properly executed disclosure statement. In the event the inventor fails to file a patent application within the time specified in the disclosure statement, the university may then file for a patent on the invention, if and when that may be required by an external sponsor, if any, of the invention so long as the net proceeds from the sale of the invention receive 10 percent of the net proceeds in recognition of the contribution of the state and people of New York to the support of the research which resulted in the invention. In the event of this provision, the term "net proceeds" shall mean earnings to the inventor from the patent over and above the expenses incurred in the process of patent application and management.

(g) In all cases, any person who requests an exception or waiver to the provisions of this patent policy shall appear, accompanied by a written statement, before the patent policy board for consideration of his request for an exception or waiver. The patent policy board shall prepare a report on the request and shall recommend to the chancellor whether or not to grant the request.

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report of his findings and recommendations to the Chancellor for his review. The decision of the Chancellor on the findings and recommendations shall be final.

(h) The Chancellor shall establish a patent policy board with the following:

(1) The patent policy board shall have no more than 10 members, and shall include one representative of the central administration, one from each of the health sciences centers, one from another major research institution of the university, one from the colleges of arts and science, one from the agricultural and technical college, and one from The Research Foundation of State University of New York.

(2) The patent policy board shall have full authority over the organization.

(3) The members of the patent policy board shall serve without extra compensation and at the pleasure of the Chancellor. The normal term of office shall be three years.

(4) The patent policy board shall meet at least once annually.

(5) The patent policy board shall develop and recommend to the Chancellor:

- (i) guidelines and procedures for the implementation of these policies;
- (ii) exceptions to these policies and circumstances;
- (iii) determining the extent of the university's interest in inventions;
- (iv) determining whether or not to grant exclusive licenses or to retain the university's right of granting of exclusive licenses as a condition of sponsorship for particular research projects;
- (v) such other matters as the Chancellor may determine as appropriate.

(6) The patent policy board shall submit an annual report to the Chancellor in view of these policies and advise the Chancellor of any changes that may be necessary.

(7) The patent policy shall include provisions for the resolution of any dispute concerning patenting activities, and encourage the development of a patenting interest concerning patents within the university.

(8) The patent policy shall provide that the university shall report annually to the Board of Trustees concerning its patenting activities and the progress of the program.