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*The “effective date” referenced in 8 NYCRR Part 335.28 section (h)(1) is November 23, 2016.*

## **TITLE J – PATENTS, INVENTIONS AND COPYRIGHT 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](#).

### § 335.29 Copyright Policy

Generally the members of the staff of the university shall retain all rights to copyright and publish written works produced by them. However, in cases where persons are employed or directed within the scope of their employment to produce specific work subject to copyright, the university shall have the right to publish such work without copyright or to copyright it in its own name. The copyright will also be subject to any contractual arrangements by the university for work in the course of which the writing was done. Staff members will be expected not to allow the privilege to write and retain the right to their work to interfere with their university duties. In those cases where an author desires the help of university facilities, arrangements should be made through the administrative staff of the author's institution in advance with respect to the assistance which may be appropriately given and the equity of the university in the finished work.