



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.