

# SUNY's New Intellectual Property Policy: Tips and Tools for Working with Industry

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# Innovation at SUNY



*"I'll be happy to give you innovative thinking. What are the guidelines?"*



# A SUNY Story: Senior Design Projects in Computer and Information Systems









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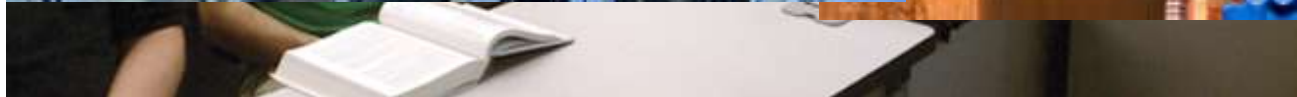


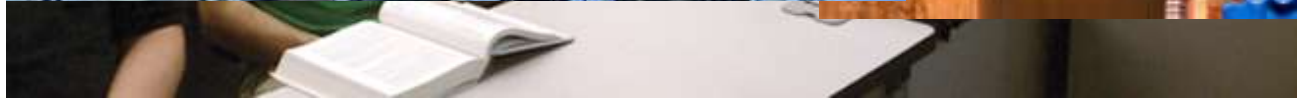
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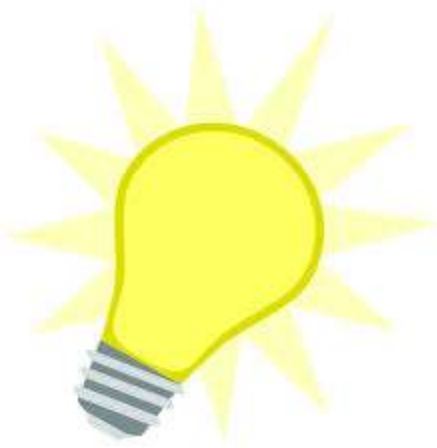


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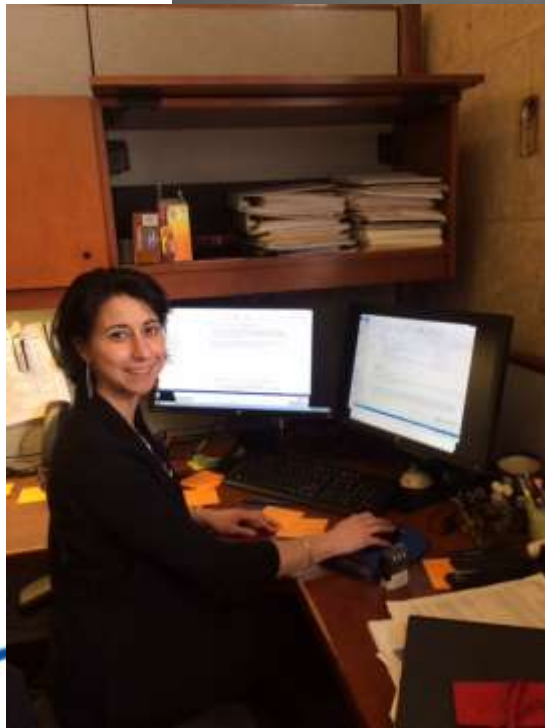
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# Current Challenges

- Ambiguity regarding “own time” inventions and COI
- Students and employees are treated the same
- No acknowledgement of nonpatentable research materials and program income requirements
- Misaligned incentives for faculty and administration
- Strict language regarding nonassignment of royalty
- Rigidity in industry partnerships

# Proposed Changes

- Ownership of Intellectual Property
  - Scope of employment
  - Substantial vs. Insubstantial Use of University Resources
  
- Remove barriers to contracting with industry
  - Maximum flexibility in contracting with partners
  - Business judgments made locally

# Proposed Changes

- Promote student innovation and entrepreneurship
  - Carve out for student ownership of IP
  - Students may choose to work with the university
  
- Income related to nonpatentable intellectual property
  - Distribution of income determined locally



# Proposed Changes

- Disclosure of extra-institutional inventions
  - One-page disclosure
  - Waiver process for university to disclaim ownership

# Proposed Changes

- Royalty Distribution
  - Modify individual royalty payouts to from gross to net
  - 40% share remains unchanged
  - Enables faculty to assign or waive royalties
- Why?
  - Best practices
  - Alignment of incentives
  - Sustainability

# University IP In the News

*Tech Transfer News: Significant Use of University Resources*



*Penn State's Approach to IP from Company Sponsored Research*

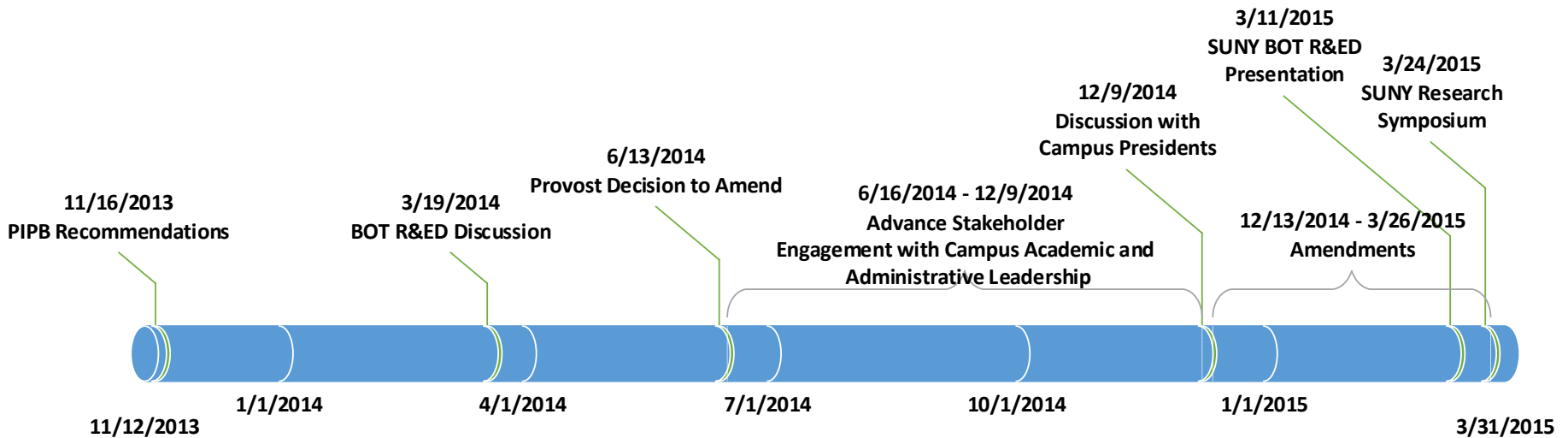
*U research jumps into the big time*



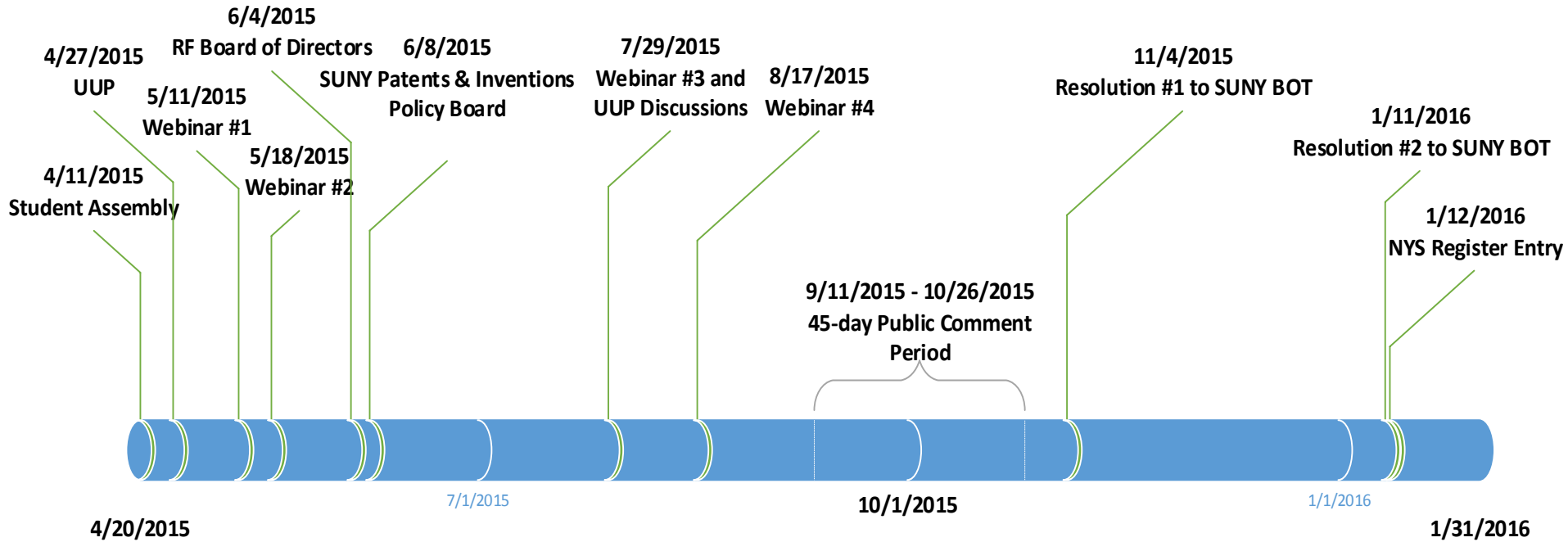
*University of Minnesota expands MN-IP program to promote industry partnerships and boost regional economies*



# Where are we now?



# What's Next?



# What else are we doing to prepare?

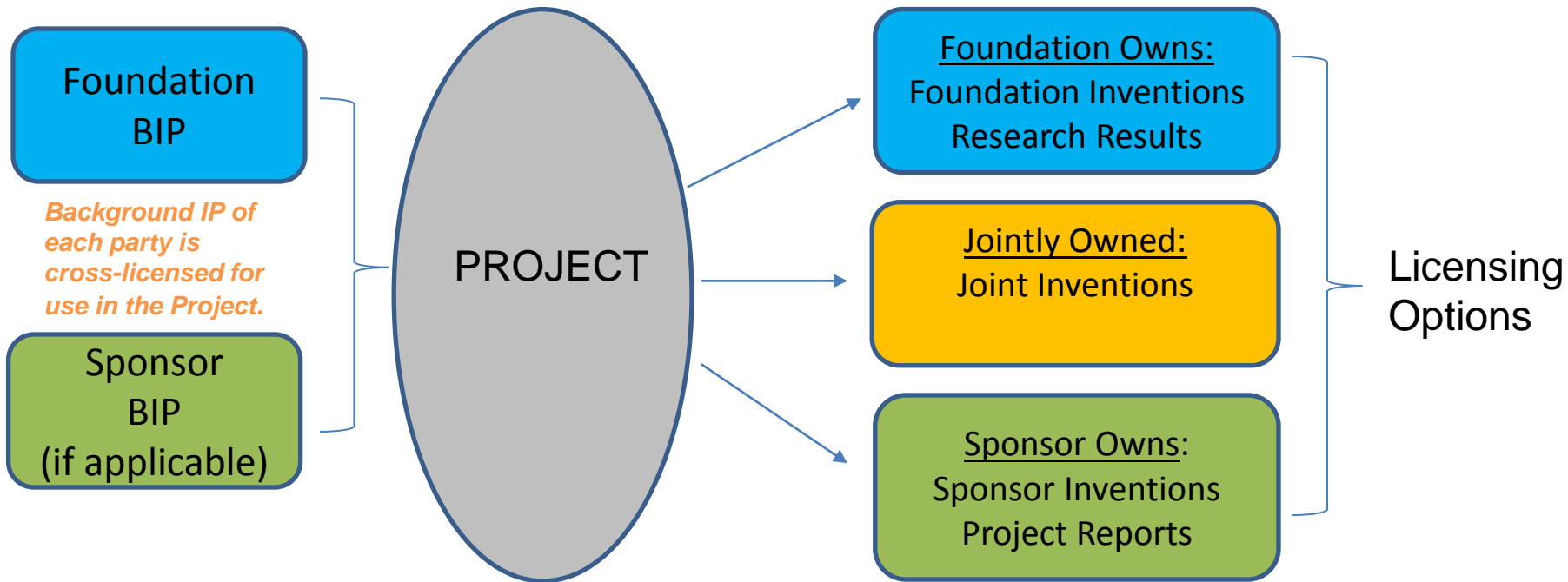
- ❑ Board education
- ❑ Faculty webinars throughout the summer
- ❑ Advocacy with elected officials
- ❑ Direct discussion with union leadership
- ❑ **Updating internal controls**
- ❑ **New tools and agreements**
- ❑ **Training**

# Master Industry Accords

Master Accords is about . . .

. . . a new generation of best-in-class industry dealmaking tools custom-made for SUNY through its Research Foundation.

# Intellectual Property Ownership





# ISRA Models

- ❑ **ISRA Model 1:** Traditional model. Sponsor has an option to commercially license research results.
- ❑ **ISRA Model 2:** Sponsor receives a commercial NERF license to the research results and an option to negotiate an exclusive license.
- ❑ **ISRA Model 3:** Sponsor receives a commercial NERF license to the research results and may elect an exclusive license under pre-negotiated terms.

# ISRA Guidance

- ❑ Foundation patents, patent applications, and copyrighted works *must be licensed separately*.
- ❑ If the Sponsor will own any deliverables other than Project Reports, definition must be modified.
- ❑ Sponsor Inventions – modify if your campus does not want to review sponsor disclosures.
- ❑ Joint Inventions – Sponsor will pay for and control prosecution of patents. Modify if Foundation wants to control patenting.

# Materials Testing Agreement

- ❑ Use when we generate data or results with minimal creativity or inventive steps
- ❑ Neither party has rights to the other's IP
- ❑ Our improvements to our methods belong to us
- ❑ Our improvements to sponsor's materials belong to sponsor
- ❑ If we improve our methods in such a way that is exclusively unique to sponsor's material, we own and sponsor gets an option