



# New SUNY Patents & Inventions Policy

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## 1. Background

- The SUNY Patents & Inventions Policy (8 NYCRR § 335.28) was first adopted by the SUNY Board of Trustees in 1959 with subsequent amendments in 1971, 1974, 1977, 1979, and 1988. Since the policy was last amended, there have been significant changes in the ways technology is developed and transferred in university settings; and changes in the law. There has also been tremendous growth in the arena of university-sponsored research programs, as institutions of higher education continue to be major sources of scientific and industrial research breakthroughs.
- Revision of the policy has been the subject of discussions within the past few years as SUNY's policy lags behind those of most other large universities across the country. Recently, members of the Research Foundation and SUNY Office of General Counsel have been working in conjunction with the Office of the Provost to develop a revised policy that is consistent with changing requirements for university intellectual property policies around the country. With this new policy, SUNY is becoming a full and active partner in the innovation economy not only by taking the lead in committing itself to excellence in service to the SUNY community and the public, but also by developing and modeling best practices.
- The revised policy recognizes the changing landscape of technology research, development, and transfer practices in government and industry. It codifies many of the practices that have been in place at SUNY and the RF for over thirty years. It also addresses several timely issues emerging on campuses involving start-up companies in which university faculty play a role. Moreover, it eliminates confusing and ambiguous terminology such as "university facilities" and "inventor's own time" while clarifying ownership rights and increasing transparency in the disclosure process.

## 2. Seven Main Areas of Change

- **The revised policy makes seven (7) key changes:**
  - **1. Clarifies Ownership of Intellectual Property**
    - Current policy creates confusion as to ownership with facilities-based approach and "own time" language
    - New policy offers clarity by eliminating "own time" inventions and substituting with two part test: SUNY owns IP created 1) within the scope of creator's SUNY employment OR 2) through the substantial use of SUNY resources
      - CREATOR OWNS EVERYTHING ELSE (unless subject to sponsorship or other written agreement)

- Current policy creates confusion regarding industry partners and sponsorship arrangements (private companies come in themselves and use facilities to create IP or sponsor faculty to create IP—e.g., START-UP NY)
  - New policy moves away from facilities-based approach and provides for partner ownership of IP
  - Determinations as to ownership will be made locally
  - Provides resolution of conflict of interest (COI) issues as there is currently well-known mass confusion across the system as to navigating COI rules in the area of innovation
- **2. Removes Barriers to Contracting with Industry**
- Current policy is often called inflexible and even a barrier to industry partnerships especially in certain industries
  - New policy allows maximum flexibility in contracting with partners
  - Business judgments will be made locally
- **3. Promotes Student Innovation & Entrepreneurship**
- Under the current policy, students and employees are treated the same
  - This has caused an increase in requests for exception to the current policy for students working in applied learning environments (taught courses, experiential learning, entrepreneurship programs)
  - There is very little logic in treating students and faculty the same when the economics of SUNY's relationships with each of these groups is converse
- **4. Addresses Nonpatentable Research Materials**
- Current policy does not acknowledge the rather commonplace transfers of nonpatentable research materials (e.g., certain antibodies, cell lines, SCID mice) the income from which may be subject to program income requirements for federal awards
- **5. Allows for Assignment of Royalties**
- Under current policy, royalties may not be assigned; this has precluded effective estate planning for faculty with substantial royalties
  - New policy enables creators of IP to assign royalty share
- **6. Shifts Royalty Split from Gross to Net**
- SUNY's well-known division of royalty on gross proceeds prevents the university from being made whole for its investments in the protection and enforcement of IP, in some cases to the very significant disadvantage of other faculty, especially in cases of litigation and monetization
  - This causes incentives for university and faculty to often become misaligned in the cases with the greatest potential for income
  - New policy enables campuses to recover the costs of patenting from gross royalties before distributing proceeds to inventors; this small change contributes substantially to the sustainability of our patent program while preserving SUNY's position as an institution with one of the most generous royalty-sharing policies in the country

- **7. Creates Process for University to Expressly Waive Rights**
  - Creator of IP made outside of SUNY employment and facilities can disclose using a nonconfidential description of IP affirming circumstances under which it was created and secure waiver – transparent and supportive of consulting activities

### **3. Benefits to Faculty**

- **Investing in Faculty**
  - Across academia, less than 1% of university licenses generate more than \$1M
  - Last year, total expenditures for costs associated with the evaluation, marketing, development, protection, maintenance, and enforcement of intellectual property created by SUNY inventors totaled over \$3 million while reimbursements only totaled approximately \$700,000
  - The current policy prevents the university from recovering its expenses, thereby whittling down the pool of funds available to support patents, and therefore fewer faculty are supported
  - Under the new policy, closing the funding gap will enable the university to reinvest in protecting more faculty-created intellectual property
  - For example, if the university were fully reimbursed for its expenses in 2013, it could have filed 100 additional patent applications, supporting more faculty and enhancing the innovation pipeline at SUNY
- **Increasing Opportunities for Faculty to Work With Industry**
  - Current policy is perceived as inflexible and burdensome to potential industry partners
  - New policy gives maximum flexibility for creative IP arrangements
  - Enables faculty to suggest appropriate disposition of IP – almost any option will be acceptable under the new policy
  - New industry partnerships enable new funding streams for university research!
- **Enabling Effective Estate Planning**
  - The current policy requires a board-level waiver for faculty to assign royalties, delaying and, in some cases, obstructing effective estate planning
  - New policy eliminates this requirement and empowers faculty to dispose of income in the most tax-effective manner possible
- **Clarity and Conflict Management**
  - Current policy is confusing and ambiguous regarding ownership of inventions made on an employee's "own time"
  - New policy creates a simple framework to establish ownership and a simple process for the university to waive its interest in inventions made outside the scope of faculty employment and without substantial use of university facilities; this is a big step towards empowering faculty who engage in consulting activity



## DRAFT

### 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.

###### (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, including syllabi and course materials Created for SUNY teaching assignments by Personnel through no more than Incidental Use; textbooks developed through no more than Incidental Use; other scholarly or creative works of authorship initiated and created independently by the author where there is no conflicting obligation to SUNY, a sponsor, or a Partner, including, but not limited to, instructional, dramatic, musical and artistic works; 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 occasional and/or 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 expenses incurred by SUNY 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.

### (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

(c) the Creator complies with the disclosure requirements of SUNY's Procedures for Disclosure and Management of Intellectual Property.

(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 question 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 the procedures accompanying this policy.

#### (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 (40) percent of the Net Royalty received by SUNY, 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) Other Intellectual Property: In the sole discretion of the president of the campus at which Intellectual Property was Created, income generated from the commercialization or other monetization of such Intellectual Property that is not a Patentable Invention may be distributed in accordance with subpart (e)(1) above, or may be reinvested in support of university research programs in a manner consistent with United States Office of Management and Budget's Uniform Guidance, unless there is a conflicting obligation to SUNY, a sponsor, or a Partner.

(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) 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.





## STATE UNIVERSITY OF NEW YORK GUIDELINES FOR THE MANAGEMENT OF INTELLECTUAL PROPERTY

### 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 Intellectual Property Policy and New York State Public Officers Law §74, which governs conflict of interest for state actors.

SUNY's Intellectual Property 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 Intellectual Property, 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 definitions in these Guidelines derive from the Intellectual Property 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 RF adheres to the intent of this policy in its contracting with third parties. Where an industry partner is sponsoring or otherwise supporting research at SUNY, it may be appropriate for RF 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.) 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.

#### 4.) Industry sponsored projects.

SUNY's Intellectual Property 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.

#### 5.) Student Intellectual Property.

SUNY's Intellectual Property 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.

#### 6.) Multiple forms of IP.

SUNY's Intellectual Property 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.

#### 7.) 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.

#### 8.) 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 to 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.

#### 9.) Outside activities.

University employees generally are permitted to engage in outside activities, such as consulting, provided the activities do not pose a 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](#).

#### 10.) Assignability of Royalty Income.

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

11.) 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 herein stated 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.

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## STATE UNIVERSITY OF NEW YORK PROCEDURES FOR DISCLOSURE AND MANAGEMENT OF INTELLECTUAL PROPERTY

SUNY's Intellectual Property 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 Intellectual Property, 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 the Intellectual Property Policy (hereinafter "SUNY's IP 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 three members to be named by and act as the delegate of the Innovation Policy Board ("IPB"). At least two 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)(c)

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)(c) of SUNY's Intellectual Property 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.

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

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**Part C. Identify to whom the invention has been or will be assigned.**\_\_\_\_\_

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**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