

F98-3 Intellectual/Creative Property

Legislative History:

At its meeting of October 5, 1998, the Academic Senate approved the following policy recommendation presented by Patrick Hamill for the Curriculum and Research Committee.

Replaces: F92-3, S92-13, F91-5

ACTION BY THE UNIVERSITY PRESIDENT:

"Accepted as University Policy " signed by Robert Caret, Nov. 5, 1998

POLICY RECOMMENDATION INTELLECTUAL/CREATIVE PROPERTY

Replaces: F92-3, S92-13, F91-5

Whereas, San Jose State University is the potential source of intellectual property having great value,
and

Whereas, The current Copyright Policy (F92-3) and Patent Policies (S92-13, F91-5) neither provide good protection for that intellectual property, nor useful options that could support intellectual property commercialization, nor do they acknowledge technology-mediated instruction as intellectual/creative property, now therefore be it

Resolved, That the Academic Senate adopt the attached Policy on Intellectual/Creative Property.

Financial Impact: None

SAN JOSE STATE UNIVERSITY POLICY ON INTELLECTUAL/CREATIVE PROPERTY

1.0 Introduction

The primary goals of San Jose State University (hereafter SJSU or University) are to teach, to expand knowledge through scholarly studies and research, to fully disseminate the results of such studies and research, and to perform community service consistent with these goals and the mission of the University. Discovery and dissemination of knowledge represent the core of the academic mission at SJSU; these activities have inherent and essential value to the University and to society. From time to time in the conduct of these activities faculty members, staff, and students may create information products, make discoveries or invent new and useful devices, processes, compositories, and compounds of a marketable nature. The University supports these efforts and seeks to create an environment that:

- a) protects the primary educational goals of SJSU by establishing this policy to guide the

development of inventions/discoveries of a marketable nature;

b) encourages research efforts and suitable commercialization by equitably allocating ownership rights among inventors, the University, and research sponsors; and

c) provides appropriate campus agency to assist bringing inventions to the public market place and promote their greatest public benefit. SJSU recognizes that ownership rights in intellectual property should remain with the creator whenever possible. At the same time, the University also recognizes there are situations where the University has a vested interest in certain intellectual property rights due to the nature of the creation of the work, use and cost of facilities and/or equipment available to someone because of their relationship with SJSU, or specific contractual agreements.

This policy governs the relationship between SJSU and its faculty, staff, and students in identifying intellectual/creative property and the assignment of ownership rights, such as a copyright or a patent, to either the creator(s) of the work, the University, or joint ownership. The policy of the University with regard to copyrights and patents is intended to foster the traditional freedoms of the University's faculty, staff, and students to do research and publish without sacrificing rights justly due the University and its sponsors and supporters through a fair and reasonable balance of the equities among authors or inventors, sponsors, and SJSU. At the same time, the policy is intended to ensure that copyrightable and patentable materials in which the University has a legitimate interest and obligation to protect and disseminate are utilized in a manner consistent with the University's mission. [Note: Intellectual/creative property may also involve trademarks or trade secrets. Because of the nature of the University, these are less likely to occur than copyrights or patents. At such time as needed, the University will address trademark or trade secret concerns through individual agreements with the appropriate parties. Those agreements will be consistent with the policy set forth in this document.]

An employee's obligation to teach and/or pursue scholarship or creative work, or to carry out obligations accepted in sabbatical or difference-in-pay leave proposals shall not be interpreted as a specific contractual agreement, nor as extra or "substantial support" unless specified in advance and in writing by all parties involved.* *

2.0 Copyright Ownership

Ownership of copyrightable works produced by authors who are SJSU faculty, staff, or students shall remain with the authors as defined by federal copyright law, except in the following situations where such rights of ownership shall be shared or be vested entirely with the University:

- - 1) The terms of a University agreement with an external party require SJSU to hold or transfer ownership in the copyrightable work. These terms shall be made known to faculty, staff, and students who will be involved with work of this nature.
 - 2) Intellectual property resulting from works created with "substantial support" from the University (e.g., development of materials for technology-mediated instruction) shall normally be owned jointly by the authors and the University, and the division of rights and responsibilities for each shall be specified in writing prior to the start of a collaboration between the authors and any University office or personnel. "Substantial support" provided by the University can take any or all of the following forms: financial support from external grants sought by the University, faculty released time, and/or assignment of personnel,

facilities or equipment significantly in excess of the normal and customary uses of University resources from any University department to assist the authors in the development of their materials. If this intellectual property becomes a commercial venture, the agreement between the author(s) and the University shall specify the precise limits to the uses of that property beyond SJSU.

3) Works created as a specific requirement of employment or as an assigned University duty are "works for hire" and are University property. Such requirements or duties may be contained in a job description or an employment agreement which designates the content of the employee's University work. If such requirements or duties are not so specified, such works will be those for which the topic or content is determined by the author's employment duties and/or which are prepared at SJSU's instance and expense, that is, when the University is the motivating factor in the creation of the work. However, SJSU may invite faculty, staff or students to produce specific works for which they are directly compensated by contract. These products are also "works for hire."

In a particular employment situation, if an author is uncertain about the ownership of the works referred to in this section, before undertaking the drafting, design, creative, or authoring assignment the author shall be entitled to request in writing and to receive a clarifying written statement from the author's department head or supervisor.

When SJSU commissions the creation of a copyrightable work by an author who is not a University employee, the contract with such author shall specify that the author convey by assignment such rights as are required by the University.

With respect to copyrightable works owned by the University pursuant to this section, the authors may be required to execute such documents as are necessary to vest ownership in such works to SJSU or its designee. Authors who create works for which ownership vests in the University pursuant to this section shall warrant that such works are their independent creativity and to their knowledge do not infringe any preexisting copyright.

2.1 Copyright Contractual/Licensing Agreements

As provided above, copyrightable works developed by SJSU faculty, staff or students using University resources usually and customarily provided (such as office space, standard office equipment, or library and lab facilities, and such equipment as appropriate to the discipline in question) are owned by the authors. Nothing in the specifications regarding contractual agreements, "works-for-hire," "substantial support," or third-party sponsorship shall prohibit a decision by the University or its auxiliaries to transfer its copyrights solely to the creator. When authors own the copyright for works created with the use of significant University resources beyond those usually and customarily provided, such works will be licensed under separate agreement to the University and shall grant SJSU the right to use the works in all its programs of teaching, research, and public service on a royalty-free, nonexclusive basis.

A sponsor's right to use or own a work created under its sponsorship will be determined by the provisions of its contract with SJSU.

2.2 Copyright Administration

Matters related to copyright at SJSU shall be administered by the Associate Vice President, Graduate Studies and Research (AVP/GS&R) in conjunction with the Office of Intellectual Property

Development, a unit of the San Jose State University Foundation. Inquiries pertaining to copyright and/or negotiations regarding the sharing of copyright, proper use of the SJSU name in copyright notices, determination of "substantial support," and the right to any income resulting from the sale of copyright products shall be addressed to the AVP/GS&R. As needed, the AVP/GS&R shall convene a Copyright Advisory Committee consisting of at least one college dean, and two members of the faculty with copyright experience, and such outside expertise as needed; advice on legal issues shall be obtained from appropriate counsel. Agreements between the University and the creator of copyrightable materials shall be drawn by the AVP/GS&R and approved by University counsel. When copyrighted material created at the University becomes a commercial venture (i.e., sold, licensed, etc.), the minimum royalty to the author(s) whose intellectual property is not "work-for-hire" shall be 50% of the net income. All royalty income from University copyrights shall be maintained in a special SJSU account and applied to institutional support of activities leading to scholarship and creative work. Authors who hold exclusive copyright under this policy may offer their work through appropriate formats for instructional and other use either at SJSU or elsewhere. The copyright owner(s) may make separate financial arrangements to receive payments. At the copyright owner's request, revenues generated from this effort may also be administered through the Office of Intellectual Property Development. Fees for this service should be negotiated on an individual basis between the copyright owner(s) and the Office of Intellectual Property Development.

3.0 Patent Ownership

Inventions typically come about because of activities of SJSU faculty, staff or students who have been assisted wholly or in part through use of facilities or equipment of the University. These activities may result from a sponsored project, usually a contract or grant to investigate a specific topic, or result from non-sponsored work, usually faculty research, independent student projects, or master's theses where University facilities/equipment are used or faculty guidance is received. **Ownership of discoveries resulting from sponsored activities is established by the agreement between the University and the sponsor. With regard to non-sponsored work, all discoveries are the property of the inventor(s) unless it is clearly demonstrated in the disclosure process described in section 3.1 below that "substantial support" has been provided by the University in any or all of the following forms: financial support from external grants sought by the University, faculty released time, and/or assignment of personnel, facilities or equipment significantly in excess of the normal and customary uses of University resources from any department to assist the authors in the development of their materials. Resources usually and customarily provided by the University include office space, standard office equipment, library and lab facilities, and such equipment as appropriate to the discipline.**

3.1 Invention Disclosure Process

When an invention or discovery has been made, an Invention Disclosure describing the invention and including other related facts (such as the amount of University time, personnel, facilities, and/or equipment used) shall be prepared and forwarded to the Associate Vice President for Graduate Studies and Research (AVP/GS&R). An Invention Disclosure is a confidential document which provides information about what was invented in such clear and complete terms that a person skilled in the art can fully understand or reproduce the results and practice the invention. The document also identifies the inventor(s), circumstances leading to the discovery, and facts concerning subsequent activities (e.g., publication). It provides the basis for determination of patentability. When inventions result from coursework, laboratory assignments, or independent research, all contributions by faculty, staff and students shall be stated in the Invention Disclosure form so that inventor status can be established, acknowledged and credited by the University. The Invention Disclosure form can be obtained from the Office of the AVP/GS&R or from the SJSU Foundation.

In reviewing information provided in the Invention Disclosure, the AVP/GS&R, with such consultation as may be needed, determines SJSU's ownership interest in the invention. The results of their review shall be made known to the inventor(s) within two weeks of the submission of the Invention Disclosure. In cases where SJSU chooses not to exercise any ownership rights, as well as in those instances where ownership of the invention rests entirely with the inventor(s), the University is willing to assist the inventor(s) to find appropriate means for the development of their work. This shall occur on a case-by-case basis under separate agreement between SJSU and the inventor(s). This results in four options for patenting and marketing an invention:

- - o 1) patent ownership rests entirely with the inventor(s), who may proceed independently from the University;
 - 2) patent ownership rests entirely with the inventor(s), who requests assistance from the University and negotiates an agreement with the University for that purpose;
 - 3) joint patent ownership between the University and the inventor(s) is determined from the beginning of the process and the procedure described below in section 3.2 Patent Administration is followed; or
 - 4) patent ownership is assigned by the inventor(s) to the University in return for specific benefit to be established by agreement between the inventor(s) and the University.

Sponsored project agreements (including but not limited to those projects sponsored by the federal government, state government, private foundations, and private individuals, industries or public companies) often contain provisions with respect to patents and licensing. Government sponsors normally assign inventions to the university, but sponsors from the private sector normally retain the rights to inventions conceived with their support. In all cases, sponsorship agreements will stipulate that any inventions conceived during the course of the agreement must be fully and promptly disclosed. SJSU faculty, students or staff working under a sponsored project agreement are required to complete the Invention Disclosure information form described above. The terms of sponsored project agreements are part of and fall within the guidelines established by this policy.

3.2 Patent Administration

When an inventor requests assistance or the University claims ownership right, the AVP/GS&R shall forward the Invention Disclosure, supporting documents and notice of ownership status to the Office of Intellectual Property Development, a unit of the San Jose State University Foundation, who shall act as the agent for the University in the administration of patents, licensure and commercialization. The Office of Intellectual Property Development shall establish a Patent Review Board with essential expertise to evaluate the patentability of each invention. Where appropriate SJSU faculty shall be invited to serve on a Patent Review Board. Receipt of the disclosure and ownership statements by the agent starts the evaluation process and ensures that in the event of a coincident claim of discovery the inventor has dated documentation in support of the prior discovery assertion. Invention Disclosure shall be supported by full documentation, and all faculty, staff and students involved have an obligation and duty of full cooperation in the patentability review and evaluation. The Office of Intellectual Property

Development shall conduct the patentability review and shall notify the AVP/GS&R and the inventor(s) within 30 days of receipt of documents from the AVP/GS&R. If the review finds the invention not to be a viable candidate for patentability, and the AVP/GS&R agrees with the evaluation, the inventor is free to pursue a patent independently from the University.

If a positive assessment of patentability is made, then the AVP/GS&R, the inventor(s), and the Office of Intellectual Property Development will develop and execute an agreement which includes the following terms:

- - o 1) recognition of the rights of the inventor(s);
 - 2) assignment of those rights to the University for patent prosecution and invention commercialization;
 - 3) enumeration of specific duties of the Office of Intellectual Property Development in the patent prosecution and invention commercialization including costs thereof; and
 - 4) division and distribution of licensing fees, royalties, and other forms of income from the commercialization of the invention.

After reimbursement of out-of-pocket costs borne by the University and the Office of Intellectual Property Development which are directly related to the commercialization effort, the normal distribution of net income resulting from the successful commercialization of an invention shall be 50% to the inventor(s), 30% to the home department of the inventor(s) and 20% to the University. Out-of-pocket costs usually include, but are not limited to, fees for the patent itself, patent research fees, and the costs of administering this process. If a corporation or some other entity is created to take the product to market, additional costs will be involved. Funds to the department and University shall be used to enhance future invention potential.

The University's decision on split of ownership, and division of royalty proceeds after reimbursement of costs to the University, shall be binding on all parties.

3.3 Confidentiality

Patent law allows one year from invention publication (in print or public presentation) for the filing of a U.S. patent application; any publication eliminates the opportunity to apply for a non-U.S. patent. In order to avoid circumstances that defeat, adversely impact or destroy creative rights, University authors and inventors agree to maintain confidential all proprietary information and creativity owned in whole or in part by others, including co-workers, faculty, staff, students, the University and sponsors pending patentability review under section 3.2. This obligation of confidentiality survives the inventor's separation from the University, but does not extend to information in the public domain, information which is provided by others not obligated to or by the University, faculty, staff, students or sponsors to be maintained confidential, or which is released for publication by proper authorization of the University, staff, students, faculty or sponsors.

4.0 Sample Agreements

The Office of Graduate Studies and Research will maintain a file of sample intellectual property agreements. Parties to prospective agreements are urged to examine this file.

****[University policies S96-7 and S96-8 establish that the purpose of sabbatical leaves and difference-in-pay leaves is to benefit the University, its students and its programs through the professional development of its faculty as teachers and scholars. In compliance with California Administrative Code, Title V (43000-43008, 43050, 43051), Collective Bargaining Agreement Article 27 and Article 28, and University Policy S96-7 and S96-8 faculty are required to make application for these leaves with pay. These applications must provide details of the applicant's plan of study, research, or travel and service together with a statement of the benefits which would accrue to the campus and students from the proposed study, research, or the travel and service. The application review criteria focus on the value of the proposed professional development activities to the University; specific outcomes or products are not required as a condition for support. Therefore, such application does not constitute a contract for the purposes of this policy, nor are approved proposals equivalent to specific contractual agreements or "work-for-hire." Furthermore, extra or special support from the University is not present since the support to the faculty member would continue to exist, regardless of his/her assignment.]**