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Resolution No. 80.125 was duly moved and seconded, and carried unanimously.

WHEREAS, the Board of Trustees of the State University of New York has adopted a patent policy, and

WHEREAS, laboratories and other facilities of Suffolk County Community College are used by faculty members for research, which could lead to patentable inventions, be it therefore

RESOLVED, That the patent policy of the State University of New York is hereby adopted, to the extent applicable, for Suffolk County Community College, and be it further

RESOLVED, That all references, in the State University policy, to Chancellor, State University, State Director of the Budget, or Board of Trustees shall be replaced by the appropriate equivalent name or title for Suffolk County Community College. (See Attachment I.)

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# PATENT POLICY
# of
# STATE UNIVERSITY OF NEW YORK

The patent policy of the State University of New York as approved by the Board of Trustees on September 19, 1979, reads as follows:

Title 8, Section 335.28 of the Official Compilation of Codes, Rules and Regulations of the State of New York. (Article XI, Title J, Section 1. of the Policies of the Board of Trustees.)

(a) State University recognizes that the purpose of university research is to seek new knowledge for the general benefit and not to make inventions for profit. It will not, therefore, permit its research programs to be directed intentionally toward inventions for which patents might be obtained except in special instances where authorized by the State University in the public interest. It is also recognized, however, that patentable inventions and discoveries do result from university research activities. In such cases it is deemed to be generally in the best interests of State University and the public that patents should be obtained and administered as hereinafter provided. The university's purpose in securing patents is to ensure the useful development of such inventions for the public benefit and it is the university's policy to devote all net proceeds that it may realize from such patents to the support of State University research programs, subject to the approval authority of the State Director of the Budget. Questions as to patentability and patenting shall not be allowed to delay prompt publication of the results of university research, but all concerned shall cooperate to the end that all patent applications shall be timely made. To this end, all inventions resulting from university research shall be promptly disclosed to appropriate university officials.

(b) All patentable inventions made by faculty members, employees, students, and all others utilizing university facilities at any of the State-operated institutions of State University shall belong to State University and the inventor or inventors shall make application for patents thereon as directed by State University and shall assign such applications or any patents resulting therefrom to or as directed by State University. However, a patentable invention made by an individual wholly on his own time, and without the use of such university facilities shall belong to the individual even though it falls within the

field of competence relating to his university position. For purposes of this provision an individual's "own time" shall mean time other than that devoted to normal and assigned functions in teaching, university service, direction and conduct of research on university premises and utilizing university facilities. The term "university facilities" shall mean any facility available to the inventor as a direct result of the inventor's affiliation with State University, and which would not be available to a non-State University affiliated individual on the same basis. Where any question is raised as to ownership of an invention or patent under these provisions, the matter shall be referred to a committee of five members to be named by the chancellor of State University. At least three of such members shall be members of the academic staff of the university. Such committee shall make a careful investigation of the circumstances under which the invention was made and shall transmit its findings and conclusions to the chancellor for review. If the committee determines that the invention has been made without the use of university facilities and not in the course of the inventor's employment by or for the university, and the chancellor concurs in such determination, the university will assert no claim to the invention or to any patent obtained thereon.

(c) With respect to any patent obtained by or through the university or assigned to or as directed by it in accordance with the foregoing provisions, the university, in recognition of the meritorious services of the inventor and in consideration of his agreement that the invention shall belong to the university, will make provision entitling the inventor and his heirs or legatees to a nonassignable share in any proceeds from the management and licensing of such patent to the extent of 40 percent of the gross royalty paid under the patent, unless this exceeds the limits fixed by applicable regulations of the relevant sponsoring agency, which will control in such cases. The university may make suitable arrangements with non-profit patent management agencies for the purpose of obtaining services and advice with respect to the patentability of inventions, the obtaining of patents thereon and the management and licensing of any such patents. Such arrangements may provide for division of the net income from any patent after payment of the inventor's share between the management agency and the university.

(d) Upon recommendation of the patent policy board, the chancellor may grant exclusive licenses for the marketing of inventions, since it is recognized that in the absence of such a condition some inventions may not reach the market place for the public benefit. Normally, such an exclusive license may be granted for a period not to exceed five years, although a longer period of exclusive license can be granted under special circumstances as determined by the patent policy board. Granting of exclusive licenses for a fixed period may be accepted by the

chancellor as a condition for industrial sponsorship of research programs, within guidelines recommended by the patent policy board.

(e) Grants made available to the university by or through The Research Foundation of State University of New York shall be subject to the policy herein stated except in special instances as hereinafter provided. Nothing in the policy herein stated shall prevent the acceptance of research grants from, or the conduct of research for, agencies of the United States, either directly or through the research foundation, upon terms and conditions under applicable provisions of Federal law or regulations which require a different disposition of patents or patent rights, nor shall anything herein contained prevent cooperative arrangements with other agencies of the State of New York for research. In any cases where receipt of a grant in support of research from any non-profit agency or group may be dependent upon acceptance of terms and conditions of the established patent policy of the donor which differ from those herein stated, the chancellor, acting with the advice of the patent policy board, may specifically authorize the acceptance of such grant upon such terms and conditions.

(f) The chancellor, acting with the advice of the patent policy board or the university's designated patent management agent, may determine not to file a patent application in the case of any specific invention or discovery. The university's final decision shall be made known to the inventor within a period not to exceed six months from the date of first submission of the inventor's properly executed statement of disclosure of invention to the university or its designee. In every instance in which the university determines not to file a patent application, or fails to elect to do so within six months from the date of submission of said disclosure statement, all of the university's rights to the invention shall be released to the inventor, who may then file for a patent, subject only to those restrictions that may be required by an external sponsor, if any. For any invention so released to an inventor, the university shall receive 10 percent of the net proceeds, in recognition of the contribution of the State and people of New York to the support of the research which resulted in said invention. For purposes of this provision, the term "net proceeds" shall mean earnings to the inventor from the patent over and beyond reasonable costs incurred in the process of patent application and management.

(g) In all cases, any person is entitled to request an exception or waiver to the provisions of this patent policy. The person requesting an exception or waiver shall have the right to appear, accompanied by representatives of his choice, before the patent policy board for consideration of his request for an exception or waiver. The patent policy board shall prepare a

report of its findings and an advisory recommendation to the chancellor for his review. The decision of the chancellor on the findings and recommendations of the patent policy board shall be final.

(h) The chancellor shall establish and appoint a patent policy board and designate the chairman thereof in accordance with the following:

(1) The patent policy board shall have no more than 10 members, and shall include one representative of the central 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 science, one from the agricultural and technical colleges, and one from The Research Foundation of State University of New York.

(2) The patent policy board shall have full powers of organization.

(3) The members of the patent policy board shall serve without extra compensation and at the pleasure of the chancellor. The normal term of appointment shall be for three years.

(4) The patent policy board shall meet at least once annually.

(5) The patent policy board shall advise the chancellor in the following matters:

(i) guidelines and procedures for the implementation of these policies;

(ii) exceptions to these policies in unusual circumstances;

(iii) determining the extent of the university's interest in inventions;

(iv) determining whether or not to grant exclusive licenses or to commit the university to the future granting of exclusive licenses as a condition of sponsorship for particular research projects;

(v) such other matters as the chancellor may deem appropriate.

(6) The patent policy board shall undertake continual review of these policies and advise the chancellor and the board of trustees thereto.

(7) The patent policy board shall maintain current information concerning patent activity within the university, disseminate information to the faculty of State University concerning such activities, and encourage general awareness of and interest concerning patents within the university community.

(8) The patent policy board, through the chancellor, shall report annually to the board of trustees concerning its activities and recommendations during the preceding year.

Amended September 19, 1979