

SAN FRANCISCO STATE UNIVERSITY INTELLECTUAL PROPERTY POLICY AND PROCEDURES

Rationale

At present, SF State does not have an Intellectual Property Policy, leaving the University vulnerable to a number of potentially serious problems. Such a policy is needed to specify the ownership of inventions and copyrights, and the manner in which royalties are allocated when a commercial license is obtained. In addition, the federal government, through the Bayh-Dole Act, requires that institutions that receive federal grants post an Intellectual Property Policy to protect ownership of inventions resulting from such funding. Currently, SF State is out of compliance with this regulation.

At the end of spring 2008, the Strategic Issues Committee (SIC) under the leadership of its Chairs, Genie Stowers (Public Administration) and Bruce Robertson (Marketing), placed a proposed SFSU Intellectual Property Policy before the Academic Senate in First Reading. The policy evoked a lengthy discussion, which made clear that it needed vetting with a larger group of SF State stakeholders and extensive revisions. Rather than return the Intellectual Property Policy to SIC, SIC through the Academic Senate Executive Committee, helped form an Intellectual Property Policy Taskforce, headed by Jaylan Turkkan (AVP for Research and Sponsored Projects), and including Mark Ciotola (Design and Industry), Ramón Castellblanch (Health Education and SF State CFA President), Barry Rothman (Biology and SIC Chair) and Don Taylor (Dean, Health and Human Services and SIC member). After a number of meetings, the Intellectual Property Policy Taskforce submitted to SIC and the Academic Senate Executive Committee the revised policy shown below.

Scope

1 This policy covers the many forms of intellectual property associated with the creative and
2 scholarly activities of faculty, students, administrators, and staff. This document sets forth a
3 statement of policy regarding the ownership of, and procedures for, the exploitation of this
4 intellectual property. Intellectual property created before the effective date of this policy is subject
5 to the policies/understandings in place at the time of the project's undertaking.

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7 **Governing Principles**

8 The following principles should guide the application and interpretation of this Policy and
9 Procedures:

10 1. *Encouragement of Intellectual Property Development.* The faculty, students, administrators, and staff of
11 San Francisco State University (SF State) recognize that all members of the University community
12 benefit from the development of intellectual property, and the creation of such materials and
13 products is encouraged and supported. Moreover, SF State as a public agency shall evaluate
14 whether inventions should be reduced to practice.

- 15 2. *Reasonableness and Fairness.* This policy sets forth general principles and procedures, and is not
16 designed to address every conceivable circumstance. Under the principle of fairness, if the need
17 for corrections or exceptions to this policy is identified, appropriate recommendations shall be
18 made by the Academic Senate to the President.
- 19 3. *Disclosure and Transparency.* SF State promotes both the disclosure and avoidance of actual and
20 apparent conflicts of interest associated with external commercial activities.

21 **Definitions**

- 22 1. According to the United States Patent and Trademark Office, *Intellectual Property* refers to
23 “creations of the mind” - creative works or ideas embodied in a form that can be shared, or can
24 enable others to recreate, emulate, or manufacture them. This document addresses the
25 following three ways to protect intellectual property: *copyright*, *patents*, and *trademarks*.
- 26 2. *Copyright* is a form of protection, available to both published and unpublished works, provided
27 by the laws of the United States [Title 17, U.S.C., § 102(a)] to the authors of “original works of
28 authorship fixed in any tangible medium of expression, now known or later developed, from
29 which they can be perceived, reproduced, or otherwise communicated, either directly or with the
30 aid of a machine or device. Works of authorship include the following categories: (1) literary
31 works; (2) musical works, including any accompanying words; (3) dramatic works, including any
32 accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and
33 sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8)
34 architectural works.” Copyright is owned by the creator and is secured automatically when the
35 work is created; a work is “created” when it is fixed in a copy or phonorecord for the first time.
- 36 3. A *patent* for an invention is a grant to the patentee, his/her heirs or assigns, of the right to
37 exclude others from making, using, offering for sale, or selling the invention throughout the
38 United States or importing the invention into the United States, and, if the invention is a
39 process, of the right to exclude others from using, offering for sale or selling throughout the
40 United States, or importing into the United States, products made by that process, referring to
41 the specification for the particulars thereof [Title 35 U.S.C., § 154(a)(1)]. A patent is granted to
42 the inventor of a new and useful machine, design, or plant after submitting an application and
43 paying appropriate fees. The right conferred by the patent grant extends throughout the United
44 States. International patents exclude others from making, using or selling the invention in other
45 countries.

- 46 4. A *trademark* is a word, name, symbol, or device, or any combination used, or intended to be
47 used, in commerce to identify and distinguish the goods of one manufacturer or seller from
48 goods manufactured or sold by others, and to indicate the source of the goods. In short, a
49 trademark is a brand name. A service mark is any word, name, symbol, device, or any
50 combination, used, or intended to be used, in commerce, to identify and distinguish the services
51 of one provider from the services provided by others, and to indicate the source of the services.
52 The terms “trademark” and “mark” are commonly used to refer to both trademarks and service
53 marks.
- 54 5. *Creator(s)* are individuals or a group of individuals, singly or as a group, who make a substantive
55 contribution to the creation of intellectual property. These individuals may include faculty
56 (including lecturers), staff, or students (undergraduate, graduate, or postdoctoral).
- 57 6. An *invention* is any invention or discovery which is or may be patentable or otherwise protectable
58 under this title or any novel variety of plant which is or may be protectable under the Plant
59 Variety Protection Act (7 U.S.C. 2321, et seq.), [Title 35 U.S.C., § 201(d)]. Patentable inventions
60 include any new and useful process, machine, manufacture, or composition of matter, or any
61 new and useful improvement thereof [Title 35 U.S.C., § 101].
- 62 7. *Inventor(s)* are individuals or a group of individuals, singly or as a group, who contribute to the
63 conception of an invention. These individuals may include faculty (including lecturers), staff, or
64 students (undergraduate, graduate, or postdoctoral). See Title 35 U.S.C., § 116 for more
65 information.
- 66 8. *Sponsors* are individuals, public/private agencies, or public/private companies that provide
67 funding or have a contractual relationship with the Creator or Inventor.
- 68 9. *Full Commission or Assignment*. Intellectual property shall be commissioned or assigned when
69 there exists between SF State, acting through any of its agents or auxiliaries, and the Creator(s)
70 or Inventor(s), a contractual agreement to develop that specific intellectual property. For a
71 commission or assignment, the contractual agreement shall specify the terms applying to
72 ownership of the intellectual property and the distribution of royalties between the Creator(s) or
73 Inventor(s) and SF State.
- 74 10. *Ownership*. Party or parties who own or control rights to an invention, whether patented or not.
- 75 11. *Facilities*. Any resources available to a Creator as a direct result of the Creator’s affiliation with
76 SF State or its auxiliaries. These may include SF State-owned or -leased offices, research facilities
77 or stations.

79 **Ownership of Intellectual Property**

80 The SF State President or his/ her designee is responsible for overseeing policy matters relating
81 to intellectual property and affecting SF State's relations with Inventors and Creators, public
82 agencies, private research sponsors, industry, and the public.

83 1. *Copyright.* Creators own their traditional academic copyrightable works (books, articles,
84 dissertations, papers, study guides, syllabi, lecture materials, online course materials, tests or
85 similar items, novels, poems, musical compositions, and other creative expressions). SF State
86 recognizes that faculty and students should benefit from the results of their work.

87 a) In all cases of course material development, SF State retains exclusive right to course
88 number and description as listed in SF State catalogs. The Creator(s) retains the rights to
89 distribute the work and is not obligated to share any part of the revenue from the sale or
90 licensing of the content with SF State or, except as provided otherwise in this policy or state
91 or federal law, with any office or organization within SF State. The Creator(s) has sole
92 responsibility for the registration of material for which SF State has no proprietary interest.

93 b) Intellectual property developed by faculty as a "work for hire" and Fully Commissioned by
94 SF State, or developed by a non-faculty employee within the scope of his or her employment
95 and/or specifically ordered or commissioned for use by SF State, shall be owned solely by
96 SF State, both in copyright and distribution. SF State has responsibility for the registration
97 of works for which it has exclusive ownership.

98 2. *Trademarks.* Because trademarks are generally created during the commercial exploitation of
99 intellectual property, ownership of the trademark shall be held by the entity responsible for
100 commercial development of the intellectual property. The trademark owner is responsible for
101 maintaining and defending the trademark.

102 3. *Sponsored Research.* Sponsored program agreements (including, but not limited to, those projects
103 sponsored by federal or state government, private foundations, and private individuals,
104 industries or public companies) often contain provisions with respect to patents and licensing of
105 inventions. Government sponsors, under the Bayh-Dole Act, would generally assign ownership
106 of an invention to SF State, with typical requirements of federal agency disclosure of such
107 inventions, and occasional requirements of public sharing of publications resulting from such
108 support. Under SF State policy, title to inventions resulting from sponsored research from any
109 source outside of SF State or its auxiliaries shall be held in full (100%) ownership of the

110 University. Furthermore, the inventor (or inventors) shall receive 50% of any net royalties
111 generated from a licensed invention, with each inventor sharing equally in the inventors' share of
112 royalties when there are two or more inventors. The inventor(s) shall promptly disclose to the
113 Office of Research and Sponsored Programs (ORSP) any prior inventions by means of an
114 Invention Disclosure form. In cases of private or public industry sponsorship, ownership of
115 inventions shall be determined on a case-by-case basis by ORSP, and in advance of execution of
116 a sponsored agreement.

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118 **Exploitation of Intellectual Property**

119 It is in the interest of SF State and of Creators that intellectual property created as a result of
120 the educational mission of the University be widely distributed for the benefit of the broader
121 community of scholars. When dealing with the commercial exploitation of intellectual property, the
122 intent of this policy is to ensure the costs of commercial exploitation and the financial benefits of
123 commercial exploitation are distributed equitably. SF State may, after evaluation, actively pursue
124 development of intellectual property in which it has an interest. Should SF State decide not to
125 exploit property in which it has a shared interest, the creator shall be given the right to exploit the
126 property.

127 1. *Assignment of ownership rights for copyrighted material.*

128 a) As stated in the section regarding **Ownership of Intellectual Property** above, Creators
129 own their traditional academic copyrightable works, and SF State will release its proprietary
130 interest to the Creator(s) unless it falls under the guidelines of "work for hire" (see 1b in the
131 above-referenced section).

132 2. *Disclosure and ownership rights for patented material.*

133 a) To protect the inventor's and SF State's interests, each inventor shall disclose to the ORSP at
134 the time of employment any inventions conceived, reduced to practice, developed, or being
135 developed by the inventor.

136 b) Such disclosures shall be made in writing as soon as possible, but no later than 30 days
137 before the date of first publication of the invention.

138 3. *Development, Promotion and Licensing of Media, Products and Other Intellectual Property.* With consent of
139 the intellectual property owner, the Associate Vice President for Research and Sponsored
140 Programs or his or her designee shall evaluate all intellectual property for potential development,
141 promotion and licensing of each creation.

- 142 a) In promoting the distribution of any intellectual property, SF State is free to enter into
143 agreements with any outside agent which it deems will successfully aid SF State in promoting
144 the product. If a particular creation is to become subject to such an agreement, this shall be
145 made known to the Creator(s), who will also be consulted about any rules governing the
146 relationship among the outside agent, SF State and the Creator(s) due to such agreement.
147 The Creator(s) or his/her representative shall be a member of the committee selecting the
148 licensing agent and shall participate in the development of the licensing agreement if the
149 Creator(s) so chooses.
- 150 b) SF State is free to enter into any licensing agreements that it deems beneficial to the
151 University, the Creator(s) and the public in general, provided such agreements are not
152 prohibited by a sponsoring agency's rules or regulations. Any terms governing the
153 relationship among the licensee, SF State, or the Creator(s) due to such licensing agreements
154 shall be disclosed to the Creator(s), the Dean of the College, the Provost, the Vice President
155 for Administration and Finance, and the President.
- 156 c) Any commercial license or assignment for any intellectual property shall include the reserved
157 right for SF State to use the intellectual property for research or educational purposes free of
158 royalty.
- 159 d) Creators of intellectual property owned wholly by the creator may, at their option, refer their
160 property to SF State for commercial exploitation. If the Provost recommends such a
161 disposition, and upon execution of an assignment of rights with the SF State, costs and
162 royalties resulting from this exploitation would be shared as described in this policy.
- 163 4. *Allocation of Costs and Revenues.*
- 164 a) In the absence of any contract to the contrary, and where there is a shared proprietary
165 interest, any net royalty income from intellectual property will be split equally (50%-50%)
166 between the University and the inventor(s). All income received by SF State from the
167 commercialization of University-owned intellectual property will be used to support research
168 functions at the University.
- 169 b) If the intellectual property creation is the result of sponsored research, and in the rare
170 instance where the sponsoring agency or party may regulate the distribution of royalty
171 income, such regulations shall apply rather than those in the above paragraph.