

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 g

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

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:

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- 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

**[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