

INTELLECTUAL PROPERTY

(This policy supersedes PS XX_XX, and PS XX_XX.)

This policy was recommended by the Academic Senate on _____ and
approved by the president on _____.

This policy articulates the intellectual property rights and responsibilities of each member of the campus community with regards to instructional materials, research, scholarly and creative activity, grants, and contracts.

1.0 OBJECTIVES

- 1.1 To provide guidelines and protections for faculty regarding their intellectual property rights with respect to instructional materials, research, scholarly activity, inventions, discoveries, grants and contracts;
- 1.2 To provide guidelines and protections for, and recognition of, the University's interests in supporting instruction, and scholarly and research activity;
- 1.3 To provide administrative guidelines that recognize the interests of creators, the University, and external agencies that support instruction, research, scholarly & creative activity;
- 1.4 To provide guidelines for the generation of revenue for the University and to provide financial and reputational benefits for the creator(s).

2.0 DEFINITIONS

- 2.1 Creator: "Creator" refers to an individual, or group of individuals, who makes, conceives, reduces to practice, authors, or otherwise makes a substantive intellectual contribution to the creation of intellectual property. "Creator" includes the definition of "inventor" used in U.S. patent law for patentable inventions and the definition of "author" used in the U.S. Copyright Act for copy written works of authorship.
- 2.2 Intellectual Property:

2.2.1 The term "intellectual property" is broadly defined to include traditional academic copyrightable works (see Section 2.3 below), research, and scholarly activities including, but not limited to: inventions, discoveries, know-how, show-how, processes, unique materials, copyrightable works, original data, items protectable by statute or legislation such as patents, registered or unregistered copyrights, registered or unregistered trademarks, service marks, trade secrets, mask works, and plant variety protection certificates.

2.2.2 The term "intellectual property" also includes the physical embodiments of intellectual effort, for example: models, machines, devices, designs, apparatus, instrumentation, circuits, computer programs and visualizations, biological materials, chemicals, other compositions of matter, plants, and records of research and experimental results.

2.2.3 Intellectual property is not restricted to inventions that are first conceived, but can also apply to existing inventions or concepts that are first actually reduced to practice, and other creative or artistic works that may have value.

2.3 Traditional Academic Copyrightable Works: "Traditional academic copyrightable works" are a subset of copyrightable works created independently and at the creator's initiative for academic purposes. Examples may include, but are not limited to, class notes, books, theses and dissertations, articles, non-fiction, fiction, poems, musical works, dramatic works including any accompanying music, pantomimes and choreographic works, pictorial, graphic and sculptural works, educational software (also known as courseware or lessonware) that the creators may design for courses they teach, or other works of artistic imagination that are not created as an institutional initiative.

2.4 University Resources Usually and Customarily Provided: When determining ownership and license rights in copyrightable works, "University resources usually and customarily provided" includes office space, library facilities, ordinary access to computers and networks, and salary.

2.4.1 Exceptions are expected in units where the tradition is to provide support to some faculty in the form of graduate assistants to help prepare traditional academic copyrightable works.

2.4.2 Exceptions are also expected in situations where creators use University-provided facilities and resources in the creation of works of artistic imagination, for example: use of studios, pottery wheels, or kilns for the creation of paintings, sculpture or ceramics; use of high end computer hardware and software in the creation of artistic graphical images; etc. Other individual exceptions may be approved on a case-by-case basis in accordance with Section 9.0 below.

2.5 Extraordinary Support: Extraordinary support represents the use of campus resources in the creation of an intellectual property work where those resources are not available or accessible to all members of the university community in a similar employment.

Examples of extraordinary support include, but are not limited to, use of media studios requiring support from campus staff, or significant staff resources used to research or develop elements of a work. External funding for the work or effort is not considered extraordinary support.

2.6 Work for Hire or Commissioned Work: The work to be performed falls outside the normal scope of the creator's University employment and/or for which there is additional remuneration. Also to be included in this definition are stipends, incentives, and other remuneration to create course materials and other research outside the normal scope of work.

3.0 OWNERSHIP

3.1 Creator Ownership

3.1.1 Creators retain intellectual property rights to traditional academic copyrightable works.

3.1.2 University Rights in Creator-Owned Works

3.1.2.1 Traditional academic copyrightable works created using university resources usually and customarily provided are owned by the creators. Creators retain rights to traditional academic copyrightable works as defined above with the University sharing in a royalty-free, perpetual, non-exclusive, and non-transferable license to such works for the purpose of continuing to teach the course of instruction for which the documents were prepared, with the non-exclusive right to revise and update them as required for this purpose.

In the event that the Creator or the University wishes to commercialize traditional copyrightable works, revenue sharing between all parties shall be determined by a negotiated written agreement, and subject to review by the University Intellectual Property Committee (See Section 4.2 below).

3.1.2.2 Traditional academic copyrightable works created with use of University resources over and above those usually and customarily provided shall be owned by the creators but licensed to the University. The minimum terms of such license shall grant the University the right to use the original work and to make use of derivative works in its internally administered programs of teaching, research, and public service on a perpetual, royalty-free, non-

exclusive basis. The University may retain more than the minimum license rights when justified by the circumstances of development.

3.2 University Ownership

The University shall own copyrightable works as follows.

- 3.2.1 Works created pursuant to the terms of a University agreement with a third party.
- 3.2.2 Works created as a specific requirement of employment or as an assigned University duty that may be specified, for example, in a written job description or an employment agreement. Such specification may define the full scope or content of the employee's University employment duties comprehensively or may be limited to terms applicable to a single copyrightable work.
- 3.2.3 Works specifically commissioned by the University. The term "commissioned work" refers to a copyrightable work prepared under an agreement between the University and the creator when...
 - 3.2.3.1 the creator is not a University employee, or
 - 3.2.3.2 the creator is a University employee but the work to be performed falls outside the normal scope of the creator's University employment and/or for which there is additional remuneration (see Section 2.6. above).
 - 3.2.3.3 Contracts covering commissioned works shall specify that the author convey by assignment, if necessary, such rights as are required by the University.
- 3.2.5 Works that may also be patentable. The University reserves the right to pursue multiple forms of legal protection concomitantly if available. Computer software, for example, can be protected by copyright, patent, trade secret and trademark.
- 3.2.6 University-owned works shall be protected by copyright notice in the name of the Board of Trustees. Such copyright notice shall be composed and affixed in accordance with the United States Copyright Law. Registration of the copyright for University-owned works shall be in accordance with the operational guidelines and procedures established by the Provost (or designee). The University may also decide to release a work to the public domain and if so, should so indicate.
- 3.2.7 University organizations that administer activities involving any usage regulated by the Copyright Act are responsible for knowing applicable regulations, monitoring their continuing evolution, and conducting their programs in full compliance with the applicable laws and regulations.

175
176 3.2.8 It is the policy of the University that individuals (including visitors) participating in
177 a sponsored research project and/or making significant use of University-
178 administered resources thereby accept the principles of ownership of intellectual
179 property as stated in this policy unless an exception is approved in writing by the
180 University. University employees who create intellectual property shall execute
181 appropriate assignment and/or other documents required to determine
182 ownership and rights as specified in this policy. Persons not employed by the
183 University who use University resources in the creation of an intellectual property
184 shall disclose the nature of the work and the use of University resources to the
185 Provost in order to clarify the University's interests in the work.
186

187 3.2.9 All other provisions notwithstanding, employees or persons not employed by the
188 University making discoveries and inventions, regardless of whether patentable
189 or not, which are marketed commercially and which produce a taxable income,
190 must assure repayment to the State of California for all costs incurred by the
191 University in support of the research leading to the discovery or invention, patent
192 application filing, prosecution and maintenance, production, marketing, or sales
193 of products incorporating the discovery or invention.
194

195 3.3 Student Works

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197 Unless subject to the provisions of Section 2.4 above or provided otherwise by written
198 agreement, copyrightable works prepared by students as part of the requirements for a
199 University degree program are deemed to be the property of the student. Unless
200 otherwise agreed upon, research records for a graduate thesis or dissertation are the
201 property of the University, but the student-creator may retain a copy of the work.
202

203 204 3.4 Other Intellectual Property (Patents, Inventions, Discoveries, Trade Secrets, 205 Trademarks, etc.) 206

207 Except as otherwise specified in this policy or by the University in writing, intellectual
208 property subject to other protection (ex: patentable) shall belong to the University if
209 made: (1) by a University employee as a result of the employee's duties, or (2) through
210 the use of University resources such as facilities, equipment, funds, funds under the
211 control of or administered by the University, or other resources. The extent of
212 University ownership in the property shall be in proportion to the value of the
213 resources used consistent with California State Law.
214

215 3.4.1 Trademarks

216 Trademarks and service marks are distinctive words or graphic symbols
217 identifying the source, product, producer, or distributor of goods or services.
218 Registration of trademarks or service marks, at the state or federal level, shall be

approved by the Provost (or designee). Proceeds received from commercialization of a registered or unregistered mark that is related to an intellectual property license for associated intellectual property will be shared by the university with all creator(s) of the associated property as specified in Section 5.0 below. For proceeds received from commercialization of a mark that is licensed independently and is not directly related to an intellectual property license, the share that would normally be distributed to the creator(s) will be assigned to the unit(s) from which the trademark or service mark originated. Except as provided herein or subject to prior written agreement between the creator(s) and the University, the University will not share the proceeds from commercialization of a mark with the individual(s) who created the mark.

4.0 PROCEDURAL GUIDELINES

4.1 Administrative Responsibility

The President has ultimate authority for the stewardship of intellectual property developed at the University. The Provost, or designee, in consultation with the University Intellectual Property Committee, shall administer the operational guidelines and procedures set forth in this policy for the administration of intellectual property. This includes, but is not limited to, determination of ownership, assignment, protection, licensing, marketing, maintenance of records, oversight of revenue or equity collection and distribution, approval of individual exceptions, and resolution of disputes among creators and/or unit executive officers.

Detailed operational guidelines, documentation, and procedures for the administration of campus-based responsibilities shall be established by the Associate Vice President for Office of Research and Sponsored Programs.

4.2 University Intellectual Property Committee

The University Intellectual Property Committee shall make recommendations to the Provost regarding procedures, guidelines, and responsibilities for the administration and development of intellectual property and such other matters as the Provost shall determine.

4.2.1 Committee Charge

The charge of this committee may include but is not limited to:

- Interpretation, implementation and proposal of amendments and changes to this policy;
- Review and evaluation of each disclosure of discovery, invention, or copyrightable material submitted under the provisions of this policy;
- For disclosures, formulation of a recommendation to the Provost regarding the University's interest based on the employee's use of University facilities and equipment;

- Evaluation, review and recommendations regarding the allocation of ownership of intellectual property;
 - Where appropriate, recommendation of the waiver of University ownership;
 - Where appropriate, recommendation regarding whether patent or copyright protection should be sought by the University;
 - Assessment of the operations, division and expenditure of intellectual property income;
 - Upon request, review of Material Transfer Agreements;
 - Upon request by the Provost, investigation and resolution of conflicts of interest and disputes between inventors/creators of University Intellectual Property other than appeals related to decisions made by the committee; and,
 - Review of requests for exceptions to this policy and recommendations to the Provost.
- 4.2.2 Committee Membership
- Associate Vice President, Office of Research and Sponsored Programs, or designee
 - Dean of the Library, or designee;
 - Director of Instructional Technology, or designee; and,
 - Four tenured faculty members elected by the Academic Senate, serving staggered two-year terms.
- 4.3 Questions Related to University Ownership
- In the event there is a question as to whether the University has a valid ownership claim in intellectual property, such intellectual property should be disclosed in writing to the University by the creator(s) in accordance with Section 4.4 below. Such disclosure is without prejudice to the creator's ownership claim. The University will provide the creator with a statement as to the University's ownership interest.
- 4.4 Disclosure
- The creator of intellectual property shall promptly disclose to the Provost and the University Intellectual Property Committee the existence and nature of the property when:
- 4.4.1 the property was developed using University resources or funded or developed wholly, or in part, by the creator during the course of normal University duties and activities;
- 4.4.2 the University has an ownership interest under the provisions of this policy and the property has the potential to be brought into practical use for public benefit, or the disclosure is required by law; or

4.4.3 the intellectual property was created as a result of federal government funded research.

The disclosure shall consist of a full and complete description of the subject matter of the discovery or development and identify all persons participating in the creation of the property. The creator(s) shall furnish such additional information and execute such documents from time to time as may be reasonably requested.

4.5 Statement by Creators

The creators of University-owned intellectual property may be required to state that, to the best of their knowledge and due diligence, the intellectual property does not infringe on any existing patent, copyright or other legal rights of third parties; that, if the work is not the original expression or creation of the creators, the necessary permission for use has been obtained from the owner; and that the work contains no libelous material nor material that invades the privacy of others.

4.6 University Review

Upon receipt of a disclosure and statement by creator(s), the Provost, in consultation with the Associate Vice President for Research and Sponsored Programs and with due consideration of the recommendations provided by the University Intellectual Property Committee, will make a determination as to the creator(s) and the University's interest regarding commercialization, exploitation, licensing, external contracting, consultation, conflict of interest, exceptions, and violations of policy.

The Provost will inform principal creators of substantive decisions regarding protection, commercialization and/or disposition of intellectual property which they have disclosed. Specific terms of agreements with external parties may be proprietary business information and subject to confidentiality restrictions.

4.7 Evaluation and Utilization Decisions

After evaluation of the intellectual property and review of applicable contractual commitments, the University may develop the property through licensing, to an established business or a start-up company, may release it to the sponsor of the research under which it was made (if contractually obligated to do so), may release it to the creator(s) if permitted by law and current University policy, or may take such other actions considered to be in the University's interest. The University is not obligated to protect the intellectual property rights of the work through acts such as filing for patent protection, registering the copyright, or securing plant variety certification, but may do so at its discretion. All agreements regarding intellectual property must be executed by the Provost or designee.

4.8 Commercialization

The University may, at its discretion and consistent with the public interest, license intellectual property on an exclusive or non-exclusive basis. The licensee must

demonstrate technical and business capability to commercialize the intellectual property. The license may include clear performance milestones with a provision for recapture of intellectual property if milestones are not achieved. The licensee may be required to assume the cost of statutory protection of the intellectual property.

4.9 Sponsors

4.9.1 Sponsored research agreements shall provide that all intellectual property rights developed by University personnel as a result of the sponsored research project shall belong to the University unless otherwise specified in writing.

4.9.2 The sponsor may receive an option to license the resulting intellectual property on terms to be negotiated, with the option to be exercised within a specified period following the disclosure of the intellectual property. The specific terms of licenses and rights to commercial development shall be based on negotiation between the sponsor and the University at the time the option is executed by the sponsor and shall depend on the nature of the intellectual property and its application, the relative contributions of the University and the sponsor to the work, and the conditions deemed most likely to advance the commercial development and acceptance of the intellectual property.

4.9.3 In all cases where exclusive licensing is appropriate, such license agreements shall be executed apart from the sponsored research agreement and shall require diligent commercial development of the intellectual property by the licensee.

4.9.4 The University may also determine, on a case-by-case basis and only if allowed by law, that it is in the University's interest to assign ownership of resulting intellectual property to the sponsor as an exception to this policy when circumstances warrant such action.

4.10 Conflict of Interest

Commercialization activities involving University employees will be subject to review of potential conflict of interest and commitment issues and approval of a conflict management plan in accordance with applicable University policy.

4.11 Contractual Authority

Licenses, options for licenses and other agreements related to commercialization or exploitation of intellectual property shall be granted in the name of California State University, Long Beach. All such contracts shall be executed in accordance with the policies described in this policy.

4.12 Consultation Agreements

University employees engaged in external consulting work or business are responsible for ensuring that agreements relating to intellectual properties emanating from such work are not in conflict with University policy, with the University's contractual commitments, or with University policies regarding University-owned intellectual property. Such employees should disclose their non-University obligations to the Provost as per Section 4.4 of this policy and should provide other parties to such agreements with a statement of applicable University policies regarding ownership of intellectual property and related rights. When negotiating, entering into, or performing services under an agreement for outside consulting, an employee is acting outside of the scope of his or her employment with the University. For this reason, such agreements are not negotiated, reviewed or signed by the University on an employee's behalf. Care should be taken to avoid conflict with obligations to the University and the ability of a researcher to continue their course of study in an unrestricted manner. Accordingly, when entering into an outside consulting agreement with a company, an employee should avoid: 1) granting rights to intellectual property that is already encumbered or is the property of another; 2) agreeing to limitations on future funding from other sources; 3) agreeing to refrain from research on certain related topics of inquiry; 4) giving assurances regarding any deliverable that may be called for as part of the consulting relationship; and 5) relinquishing the right to publish.

4.13 University's Acceptance of Independently Owned Intellectual Property

The University may accept assignment of intellectual property from other parties provided that such action is determined to be consistent with institutional and public interest. Intellectual property so accepted shall be administered in a manner consistent with the administration of other University-owned intellectual property.

4.14 University Abandonment of Intellectual Property

Should the University decide to abandon development or protection of University-owned intellectual property, ownership may be assigned to the creator(s) as allowed by law and current University practice, subject to the rights of sponsors and to the retention of a license to practice for University purposes. The minimum terms of the license shall grant the University the right to use the intellectual property in its internally administered programs of teaching, research, and public service on a perpetual, royalty-free, non-exclusive basis. The University may retain more than the minimum license rights, and the assignment or license may be subject to additional terms and conditions, such as revenue sharing with the University or reimbursement of the costs of statutory protection, when justified by the circumstances of development.

5.0 PROCEEDS DISTRIBUTION

5.1 Proceeds

For purposes of this policy, "proceeds" shall refer to all revenue and/or equity, as defined below, received by the University from transfer, commercialization, or other utilization of University-owned intellectual property.

5.1.1 Revenue - shall mean cash from payments including, but not limited to, royalties, option fees, license fees, and/ or fees from the sale of the University's equity interest.

5.1.2 Equity - shall include, but not be limited to, stock, securities, stock options, warrants, buildings, real or personal property, or other non-cash consideration.

5.2 Revenue Distribution

When revenue is received by the University, all out-of-pocket payments or obligations (and in some cases, a reasonable reserve for anticipated future expenses) attributable to protecting (including defense against infringement or enforcement actions), marketing, licensing or administering the property may be deducted from such income. The income remaining after such deductions is defined as net revenue. In the case of multiple intellectual properties licensed under a single licensing agreement, the University shall determine and designate the share of net income to be assigned to each intellectual property.

5.2.1 Creator's Share: the creator (or creator's heirs, successors, and assigns) normally shall receive fifty percent (50%) of net revenue. If there are joint creators, the net income shall be divided among them as they shall mutually agree. Should the creators fail to agree mutually on a decision, the University shall determine the division.

5.2.2 University's Share: the University normally shall receive fifty percent (50%) of net revenue. Distribution of the University's share shall be allocated in support of its technology transfer activities and academic and research programs as determined by the Provost.

5.3 Equity Distribution

In any instance wherein the University executes an agreement with a corporation or other business entity for purposes of exploiting intellectual property owned by the University and the University receives or is entitled to receive equity, revenue from the equity shall be shared among the creator(s), and the University in the same proportions as revenue distributions (except as specified in Section 5.4 below).

5.4 Exceptions When the Creator(s) Has No Entitlement

If the University accepts research support in the form of a sponsored research agreement or unrestricted grant as part of the consideration in an intellectual property license in lieu of an option fee, license fee or royalty, the creator(s) shall have no

entitlement to receive a share as personal income. For the subset of equity that is buildings, real or personal property, or other non-cash consideration, the creator(s) shall have no entitlement to receive a share as personal income.

5.5 Special Distributions

Special facts or circumstances may warrant a different distribution of proceeds than specified above and such distributions will be determined on a case-by-case basis by the Provost in consultation with the University Intellectual Property Committee.

5.6 Revenue from Actions for Defense or Enforcement of Intellectual Property Rights

When the University receives revenue from third parties that results from successful actions for the purpose of defending or enforcing the University's rights in its intellectual property, such revenue may first be used to reimburse the University (or the sponsor or licensee, if appropriate) for expenses incurred in such actions. The creator(s) and their originating unit(s) shall be entitled to recovery of lost royalties from the remaining net revenue, in the same proportions as specified in Section 5.2 above. The remaining net revenue shall be allocated in support of the University's technology transfer activities and academic and research programs as determined by the Provost.

6.0 Technology Transfer Activities

6.1 A Material Transfer Agreement (MTA) is a written contract that governs the transfer of tangible research materials. Negotiated terms of such agreements define the rights, obligations and restrictions for both the provider and recipient with respect to the materials and any derivatives, and any confidential information exchanged with the material. Most importantly, the MTA requires the recipient to assume liability which may arise from its use of the transferred material. These agreements may include language related to: rights to intellectual property (actual and potential), liability, confidentiality of provider information, publication of recipient research results, permitted use of the material, and other associated legal issues that the provider and recipient may wish to specify in the transaction. Points of contention in negotiations include preservation of publication rights, preservation of ownership, disposition of liability arising from hazardous materials, and ownership of new Inventions arising from the use of the materials. Material Transfer Agreements protect the rights of both the receiver and the provider and helps prevents misunderstanding or disputes resulting from technology/intellectual property transfer. Materials Transfer Agreements (MTAs) may significantly affect the ability of the faculty to collaborate with or accept funding from unrelated parties. As with funding agreements, it is essential that the researcher carefully examine all commitments made in the MTA in light of past and future obligations relating to funding. If materials received from one company and covered by an MTA are to be used in research funded under a consortium or a grant from another company, access rights to inventions must not conflict. If an invention covered by an MTA was

supported with federal funding the recipient may only receive such rights as are consistent with obligations under federal law.

6.2 Certain MTA's require compliance review and approval. MTAs for live animals must have protocol(s) reviewed and approved by the Institutional Animal Care and Use Committee. MTAs for human tissue must have protocol(s) reviewed by the Committee for the Protection of Human Subjects and may require review under the CSULB exposure control plan for occupational exposure to bloodborne pathogens. MTAs for hazardous materials and/or select agents must follow EH&S compliance procedures. MTAs where the decision to undertake the research is based on receiving access to the material(s) from a nongovernmental provider must follow Conflict of Interest requirements for financial disclosure.

6.3 An employee who is planning to transfer materials outside the United States, that are controlled by the Department of Commerce [Export Administration Regulations](#) or the Department of State [International Traffic in Arms Regulations](#) should contact ORSP and consult with the Director of Research Integrity and Compliance. There are civil and criminal penalties for violating the Export Administration Regulations. For more information, consult the ORSP website.

7.0 EXTERNAL FUNDING AGENCIES

7.1 All Federal grants and contracts require disclosure of inventions and discoveries to the funding agency and convey a restricted right to use the invention or discovery to the U.S. government. The University must have written agreements with persons performing the research, requiring prompt disclosure of inventions and assignment of rights to any disclosed invention conceived or first actually reduced to practice in the performance of work funded in whole or in part by the federal government. To assure the University's ability to comply with obligations arising under federal laws or in extramural sponsor agreements imposed by State, and other public grant and contract funding agencies, University employees may, as a condition of funding, enter (be entered) into agreements to assign inventions to the University or to the funding agency in conformance with the sponsoring agency's policy. If the sponsored research agreement requires the University to grant rights in the invention to a sponsor, then an inventor is required to assign rights to such invention to the University and execute papers necessary to establish the federal government's or other sponsor's rights.

7.2 Industrial Support

In accepting funding from industry for the purpose of research, it is the general policy of the University that the funding be used to serve the mission of the University for educational purposes, public service, and/or the extension of the boundaries of knowledge.

567
568 7.2.1 If the University accepts funding from an industrial corporation for these
569 purposes, it shall be with the following written understandings:
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571 “It is understood by the Sponsor (industry supporting the research) that any
572 inventions, patentable or otherwise, conceived or first reduced to practice
573 in the course of the sponsored activity by University employees shall be
574 governed by University patent policy which requires that title to any of said
575 inventions be vested in California State University, Long Beach or its
576 designee, which designation must be handled specially and in accordance
577 with the aforesaid University patent policies.”
578
579 If an outside industrial sponsor proposes a procedure at variance with that
580 outlined in previous paragraphs, the Associate Vice President for Research
581 and Sponsored Programs is authorized to reach an agreement with the
582 sponsor and University employees which will not violate the general
583 principles set forth here and which will protect the equities and satisfy the
584 requirements of all involved parties.
585
586 7.2.2 Those sponsored projects involving testing of materials, compounds, or
587 apparatus not covered under an MTA should be specially handled. Among
588 the additional special provisions which are recommended for those
589 sponsored projects, in addition to the patent provision as set forth above,
590 the covering agreement should state the following:
591
592 “California State University, Long Beach does not accept any materials,
593 compounds, and/or apparatus hereunder or information with respect
594 thereto under any restrictions whatsoever. It is assumed by the
595 University that to the degree that the Sponsor’s intent is to file patent
596 applications on said materials, compounds, and/or apparatus supplied
597 hereunder, the Sponsor will have done so prior to the delivery of the
598 same to University employees or University property.
599
600 “The Sponsor hereby agrees that he/she shall not use information
601 derived by the University or its employees in pursuance of the work of
602 the sponsored project in the prosecution of a patent application in either
603 the United States Patent Office or that of other jurisdictions without the
604 written permission of the University.”
605
606 7.2.3 In agreements between business firms and the University covering work not
607 of a predominately research nature in which the sponsoring firm bears a
608 major portion of the cost, the patent policy of the University shall apply.
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8.0 Appeals

After following the administrative guidelines and procedures established by the campus, the University creator or unit executive officer may appeal to the Provost (or designee) to seek resolution of complaints or questions regarding the matters addressed in this policy.

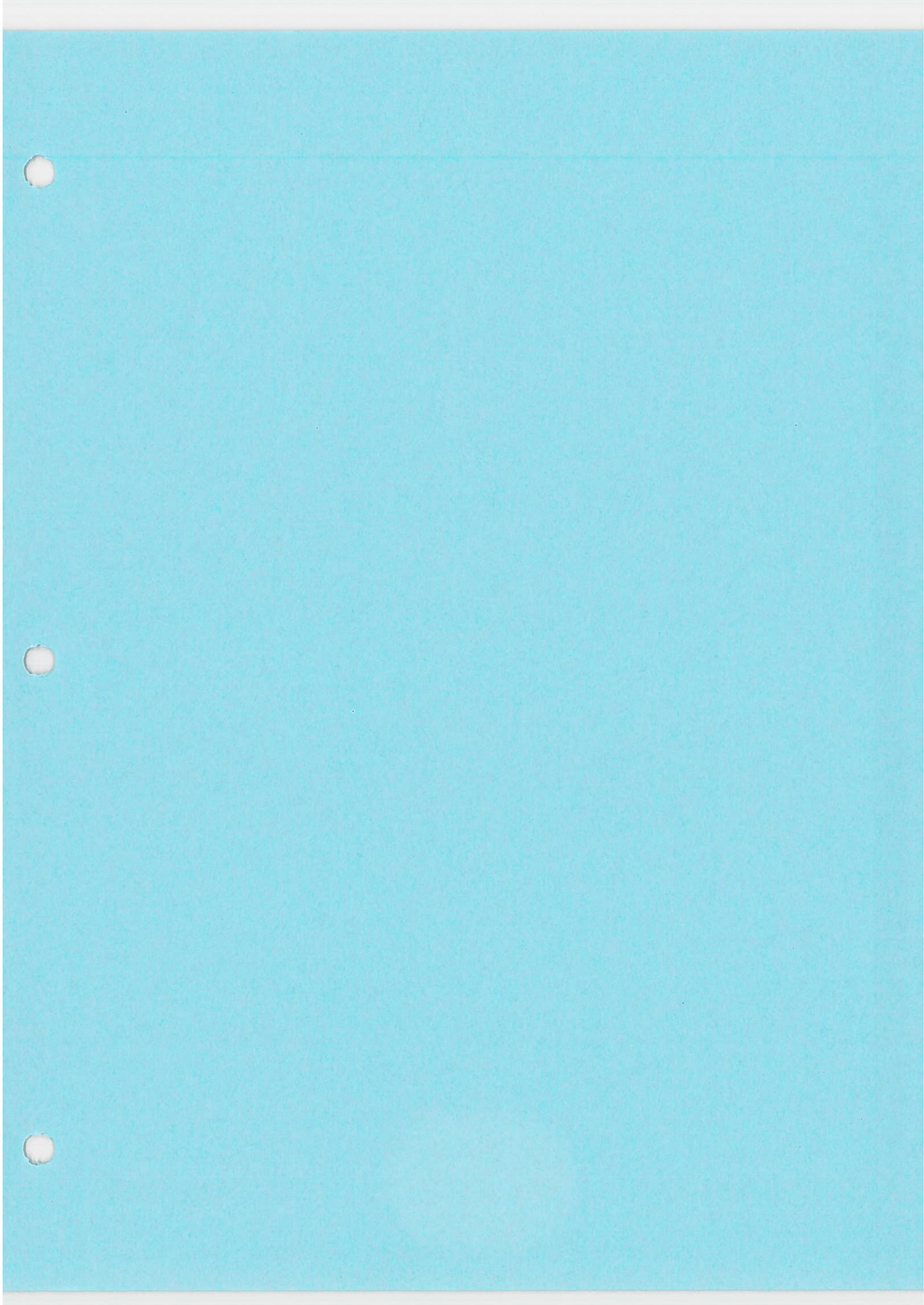
9.0 Exceptions to Policy

Requests for exceptions to this policy may be made to the University Intellectual Property Committee. Recommendations for exceptions to the provisions of this policy shall be made by the University Intellectual Property Committee to the Provost (or designee) for final approval.

10.0 Violation of Policy

10.1 A violation of the Policy on Intellectual Property is considered a violation of the University's principles and code of ethical and professional standards. Accordingly, violators may be referred to the appropriate disciplinary procedure. In addition to compliance with this University policy, compliance with relevant local, state, federal, or international law is expected of all students, faculty, and staff. Depending on the severity of the violation, and in cases involving egregious violations, the University may institute legal action or cooperate with an action brought by applicable authorities or third parties.

10.2 The University will exercise good faith and proper judgment in its enforcement of the Policy on Intellectual Property. It will respect the academic freedom to which users are entitled insofar as the legal rights and responsibilities of the individual user and the University require. Under no circumstance shall the University be liable to any user or third party for any violation including, but not limited to, illegal or improper acts, that any user commits through use of University resources.



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California State University, Long Beach Policy Statement

95-08

June 5, 1995

POLICY ON INTELLECTUAL PROPERTY: INVENTIONS AND DISCOVERIES

This Policy Statement was recommended by the Academic Senate on May 11, 1995 and received the concurrence of the President on May 31, 1995.

This Policy Statement supersedes Interim Policy Statement 88-05.

The primary purposes of California State University, Long Beach (University) are to teach, to expand knowledge through scholarly studies and research, to disseminate the results of such studies and research, and to perform community service consistent with the mission of the University. From time to time in the conduct of these activities faculty members, staff, and students may make discoveries or invent new and useful devices, processes, etc., of a patentable and of a marketable nature. This policy statement describes principles and processes of the disposition of property rights to such forms of intellectual property.

Full protection of the traditional rights of employee scholarship and productivity is intended in this policy. The requirement for scholarly productivity as a requisite for retention or promotion will not be interpreted as the sole necessary factor conveying proprietary rights to the University for the products of that scholarship.

OWNERSHIP OF DISCOVERIES AND INVENTIONS

Ownership rights to discoveries and inventions rest entirely with the inventors, except when the shopright¹ of the University is applicable and establishes proportional rights in the discovery or invention.

The University reserves the right to transfer its rights in discoveries and inventions to the California State University Long Beach Foundation (Foundation) with instructions to the Foundation to patent (or have patented) discoveries and inventions and make (or have made) good faith efforts to reduce concepts to practice and arrange for production and sale.

In the event of a determination that the University has no interest in a discovery, invention, or patent, or only a small interest (typically one too small to justify the expense of pursuing the interest), it will provide the discoverer or inventors with a release of University interest which entitles the employees to pursue patent at their own initiative and expense.

The University shall not relinquish without compensation a majority or other substantial interest in a discovery, invention, or patent to an employee or third parties. However, the inventors and/or the University may wish to declare an invention or discovery to be in the public domain. Both parties must agree to such a declaration. Without such an agreement, the parties will conclude an agreement in which the University is compensated for its interest in the invention or discovery.

Provisions relating to ownership of discoveries and inventions involving external funding agencies, Federal and others, are subject to frequent change. Appendix A to this document discusses these matters.

All other provisions notwithstanding, employees making discoveries and inventions, regardless of whether patented or not, which are marketed commercially and which produce a taxable income, must assure repayment to the State of California for all costs incurred by the University in support of the research leading to the discovery or invention, patent application, production, marketing, or sales of products incorporating the discovery or invention.

¹ University shopright (shop right) establishes the interest of the University in the intellectual property based on the use of University funds (including all research and creative activities grant programs), facilities (including computer time and utilities), equipment, or supplies at any time in the process of discovery or invention or reduction to practice of such a discovery or invention. University shopright may be shared with individuals or external funding agencies.

DISCLOSURE OF DISCOVERIES AND INVENTIONS

Employees are required to disclose to the University all patentable discoveries or inventions made by them while under hire or contract for employment in the University, whether or not in the performance of their regular and special assignments in the University. In the event that University support in the form of financial assistance, the use of physical facilities, or other factors establishing University shopright is provided, the University may have an equity interest in any income derived from such activity.

A formal invention disclosure is a complete description of a discovery or invention, completed by the inventor on the attached form and delivered to the Office of University Research. A formal invention disclosure is most important to an inventor in establishing priority.

Discoverers and inventors should be able to provide proper notebook entries, sketches, descriptions, and be able to demonstrate the exercise of diligence in developing the concepts through successive stages, if possible the eventual reduction to practice of the invention, and finally the preparation of drawings, specifications and claims as a part of the disclosure and preparatory to the filing of patent applications or the making of a request to an appropriate agency to do so. The invention disclosure should be signed and dated.

ADVISORY COMMITTEE FOR PATENTS AND COPYRIGHTS (ACPC)

The review of individual cases with the potential for patents and copyrights² shall be conducted by a six-member Advisory Committee for Patent and Copyrights (ACPC). The Chair of the Graduate Council in consultation with the Dean of Graduate Studies shall appoint three members, at least one of which must be a current member of the Graduate Council, and the Chair of the Scholarly and Creative Activity Committee in consultation with the Director of Research shall appoint three members, at least one of which must be a current member of the Scholarly and Creative Activity Committee.

Employees should consult with the ACPC whenever there is any question about policies or procedures.

Authority

The ACPC is charged to:

- (1) review each disclosure of discovery, invention, or copyrightable material submitted under the provisions of this policy by a University employee;
- (2) formulate a recommendation to the Provost regarding the University's interest based on the employee's use of University facilities and equipment; and
- (3) as necessary, make recommendations concerning University policies on discoveries, inventions, and patent and copyright matters for review by the Scholarly and Creative Activity Committee and Academic Senate.

All ACPC recommendations regarding individual cases of invention, discovery, and other forms of scholarly productivity will be sent to the Provost, who will in turn confer with the President of the University on those items requiring assertion of University rights to intellectual property.

In those matters where action is required as a consequence of a decision to proceed with legal patent or copyright activity, the Vice President for Administration and Finance shall provide a patent business plan. The President may proceed on behalf of the University and where appropriate on behalf of the discoverer or inventor; or he may recommend assignment of the University rights to the University Foundation which will subsequently continue to act on behalf of the University, the author or inventor, and any involved sponsors.

² As referred to in this document, copyright is included as a possible outcome for those situations which may, under the development of legal precedent, now be or become ambiguous, such as computer software. This document is not intended to govern copyright of intellectual property in non-ambiguous cases, like books, films, videos, etc.

BUSINESS AGREEMENTS WITH UNIVERSITY EMPLOYEES

The realization of profits from patents is problematic and occurs over long periods of time. Each patent administered by the University Foundation on behalf of the inventor and the University will have unique circumstances relating to the application, perfection, and extension of the patent as well as the costs of

patenting, reducing to practice, commercialization, and negotiation of royalty rates.

Royalties will be paid to inventors in accordance with the Foundation patent business plan policy and to the extent of inventor's rights in the discovery or invention, taking into consideration the formal advice of the ACPC.

All income in excess of that used to recover costs of patent application and management of defined costs in the business plan shall be assigned to the University and be directed to support of research, scholarship, and creative activities. The Vice President for Administration and Finance will report annually to the Academic Senate concerning such funds.

APPENDIX A -- Involvement of External Funding Agencies
ATTACHMENT -- Disclosure of Discovery or Invention Form

APPENDIX A

INVOLVEMENT OF EXTERNAL FUNDING AGENCIES

Under conditions imposed by Federal, State, and other public grant and contract funding agencies, University employees may, as a condition of funding, enter (be entered) into agreements to assign inventions to the University or to the funding agency in conformance with the sponsoring agency's policy.

All Federal grants and contracts require disclosure of inventions and discoveries to the funding agency and convey a restricted right to use of the invention or discovery to the U.S. government.

Industrial Support

In accepting funding from industry for the purpose of research, it is the general policy of the University that the funding be used for educational purposes, public service, and/or the extension of the boundaries of knowledge. If the University accepts funding from an industrial corporation for these purposes, it shall be with the following written understandings:

Agreements covering such projects shall state the following:

"It is understood by the Sponsor (industry supporting the research) that any inventions, patentable or otherwise, conceived or first reduced to practice in the course of the sponsored activity by University employees shall be governed by University patent policy which requires that title to any of said inventions be vested in California State University, Long Beach or its designee, which designation must be handled specially and in accordance with the aforesaid University patent policies."

If an outside industrial sponsor proposes a procedure at variance with that outlined in previous paragraphs, the Director of University Research is authorized to reach an agreement with the sponsor and University employees which will not violate the general principles set forth here and which will protect the equities and satisfy the requirements of all involved parties.

Those sponsored projects involving testing of materials, compounds, or apparatus should be specially handled. Among the additional special provisions which are recommended for those sponsored projects, in addition to the patent provision as set forth above, the covering agreement should state the following:

"California State University, Long Beach does not accept any materials, compounds, and/or apparatus hereunder or information with respect thereto under any restrictions whatsoever. It is assumed by the University that to the degree that the Sponsor's intent is to file patent applications on said materials, compounds, and/or apparatus supplied hereunder, the Sponsor will have done so prior to the delivery of the same to University employees or University property.

"The Sponsor hereby agrees that he/she shall not use information derived by the University or its employees in pursuance of the work of the sponsored project in the prosecution of a patent application in either the United States Patent Office or that of other jurisdictions without the written permission of the University."

In agreements between business firms and the University covering work not of a predominately research nature in which the sponsoring firm bears a major portion of the cost, the patent policy of the University shall apply.

Conflicts

Conflicts involving patentable inventions and discoveries may arise when employees of the University enter into agreements to do private consulting for firms and organizations outside the University. Such agreements frequently contain provisions as to the licensing or assignment of the consultant's inventions and patents. Unless this provision is narrowly worded, it usually will include areas in which the consultant's University work lies and thus comes into conflict with the obligations of the University employees under the main body of this policy, either with respect to the rights of the University itself, the employee in his/her invention, or the rights of a sponsor of research in the same field of subject matter.

Because of the possibility of such conflicts and of future misunderstanding, litigation, or embarrassment, it is urged that, with this point in mind, University employees carefully examine consulting agreements before they sign them. If problems arise or the issues are not clear, University employees are urged to consult with the Director of University Research.

The contribution of ideas and assistance to University employees from sources outside the University can lead to subsequent problems of equity if patentable concepts evolve.

CALIFORNIA STATE UNIVERSITY, LONG BEACH

Disclosure of Discovery or Invention

TO: Director, Office of University Research

FROM: _____

(address) _____

(telephone) _____

This is to inform you that I (we) have produced/ discovered/ invented: (describe, giving a formal title to the material or concept)

If copyrightable, the materials were completed on _____

If patentable, the discovery or invention was first conceived on _____;

developed during the period _____ to _____;

and reduced to practice on _____.

Description:

Classify the work; if a discovery or invention, please indicate whether the concept is "a new process," "a composition of matter," "a device," "one or more products," "a new use or improvement to an existing product or process."

Describe the basic characteristics: _____

(attach additional sheets as necessary)

Comment on possible uses for the materials, discovery or invention:

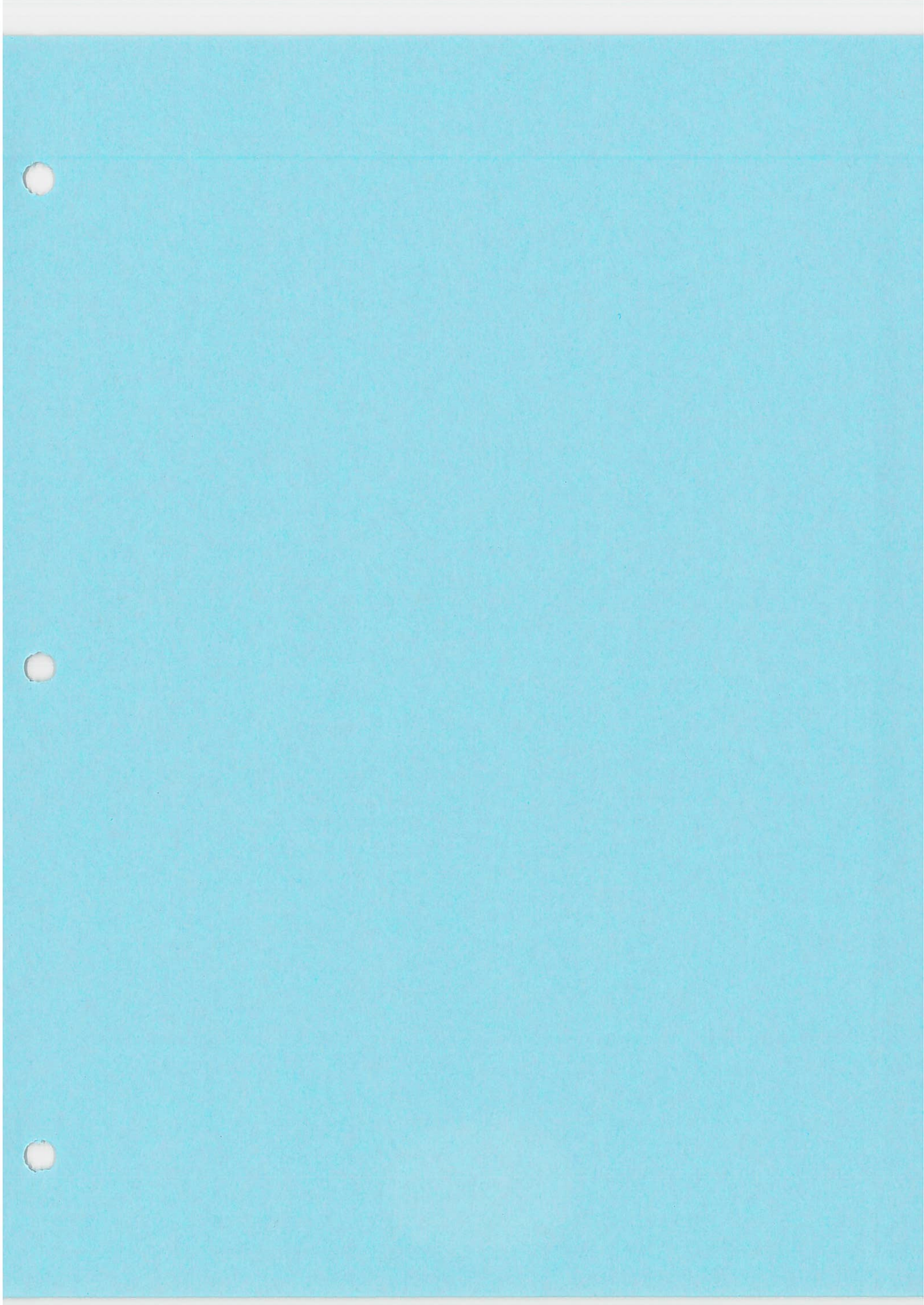
Describe the resources and circumstances of their use in the production, discovery, or invention (including University and third party funds identified by grant, contract, or award).

I understand that additional information may be required by the University to resolve questions of ownership, equity, and to provide for copyright or patent applications.

signature(s) date

EFFECTIVE: Fall 1995

TOP



07-05
March 19, 2007

POLICY ON INTELLECTUAL PROPERTY: INVENTIONS AND DISCOVERIES
(Supersedes University Policy Statement 95-08)

This revised policy was recommended by the Academic Senate on February 8, 2007
and approved by the President on March 8, 2007.

The primary purposes of California State University, Long Beach (University) are to teach, to expand knowledge through scholarly studies and research, to disseminate the results of such studies and research, and to perform community service consistent with the mission of the University. From time to time in the conduct of these activities faculty members, staff, and students may make discoveries or invent new and useful devices, processes, etc., of a patentable and of a marketable nature. This policy statement describes principles and processes of the disposition of property rights to such forms of intellectual property.

Full protection of the traditional rights of employee scholarship and productivity is intended in this policy. The requirement for scholarly productivity as a requisite for retention or promotion will not be interpreted as the sole necessary factor conveying proprietary rights to the University for the products of that scholarship.

OWNERSHIP OF DISCOVERIES AND INVENTIONS

Ownership rights to discoveries and inventions rest entirely with the inventors, except when the shopright¹ of the University is applicable and establishes proportional rights in the discovery or invention.

The University reserves the right to transfer its rights in discoveries and inventions to the California State University Long Beach Foundation (Foundation) with instructions to the Foundation to patent (or have patented) discoveries and inventions and make (or have made) good faith efforts to reduce concepts to practice and arrange for production and sale.

In the event of a determination that the University has no interest in a discovery, invention, or patent, or only a small interest (typically one too small to justify the expense of pursuing the interest), it will provide the discoverer or inventors with a release of University interest which entitles the employees to pursue patent at their own initiative and expense.

The University shall not relinquish without compensation a majority or other substantial interest in a discovery, invention, or patent to an employee or third parties. However, the inventors and/or the University may wish to declare an invention or discovery to be in the public domain. Both parties must agree to such a declaration. Without such an agreement, the parties will conclude an agreement in which the University is compensated for its interest in the invention or discovery.

Provisions relating to ownership of discoveries and inventions involving external funding agencies, Federal and others, are subject to frequent change. Appendix A to this document discusses these matters.

All other provisions notwithstanding, employees making discoveries and inventions, regardless of whether patented or not, which are marketed commercially and which produce a taxable income, must assure repayment to the State of California for all costs incurred by the University in support of the research leading to the discovery or invention, patent application, production, marketing, or sales of products incorporating the discovery or invention.

¹ University shopright (shop right) establishes the interest of the University in the intellectual property based on the use of University funds (including all research and creative activities grant programs), facilities (including computer time and utilities), equipment, or supplies at any time in the process of discovery or invention or reduction to practice of such a discovery or invention. University shopright may be shared with individuals or external funding agencies.

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ADVISORY COMMITTEE FOR PATENTS AND COPYRIGHTS (ACPC)

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Employees should consult with the ACPC whenever there is any question about policies or procedures.

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CALIFORNIA STATE UNIVERSITY, LONG BEACH

Disclosure of Discovery or Invention

TO: Director, Office of University Research

FROM: _____
(address) _____
(telephone) _____

This is to inform you that I (we) have produced/ discovered/ invented: (describe, giving a formal title to the material or concept)

If copyrightable, the materials were completed on _____

If patentable, the discovery or invention was first conceived on _____
developed during the period _____ to _____
and reduced to practice on _____

Description:

Classify the work; if a discovery or invention, please indicate whether the concept is "a new process," "a composition of matter," "a device," "one or more products," "a new use or improvement to an existing product or process."

Describe the basic characteristics: _____

(attach additional sheets as necessary)

Comment on possible uses for the materials, discovery or invention:

Describe the resources and circumstances of their use in the production, discovery, or invention (including University and third party funds identified by grant, contract, or award).

I understand that additional information may be required by the University to resolve questions of ownership, equity, and to provide for copyright or patent applications.

signature(s)

date

EFFECTIVE: Fall 2007