

Siena College

COLLEGE AND ADMINISTRATIVE POLICY

Policy Title:	Policy Title: <i>Patent Ownership and Management Policy</i>
Type or category of Policy:	College Policy: <i>This Policy is an official directive of broad and direct application across schools and other administrative units of the College.</i>
Approval Authority:	Approval Authority: <i>The President or designated representative shall be responsible for final approval of a new or revised Policy.</i>
Responsible Executive:	Responsible Executive: <i>The President charges the Chief of Staff with authority to oversee the Patent Ownership and Management Policy and any revision of existing Policy as required to ensure that appropriate stakeholders (e.g., senior executives, college counsel, vice presidents, deans, administrators, etc.) are appropriately consulted during these processes.</i>
Responsible Office:	Responsible Office: <i>Under the direction of the Chief of Staff, the Intellectual Property Committee develops or updates the Policy and will be accountable for the accuracy of its subject matter, its issuance, and timely review. The President will appoint an Intellectual Property Committee that includes a faculty member from each school, representatives from the library, computing and technology services, and the Vice Presidents for Academic Affairs and Finance and Administration or their designees. The Intellectual Property Committee is also responsible for ensuring that procedures necessary to carry out the Policy are current and available.</i>
Owner Contact:	Owner Contact: <i>The Chair of the Intellectual Property Committee shall be the contact that can serve as a focal point for responding to comments and specific questions about the Policy.</i>
Reviewed By:	President's Cabinet
Reviewed Date:	15 November 2017

Last Revised and Effective Date of Revision:	Approved by vote of the Faculty October 9, 2018
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***=Optional**

****Brief Overview of the Policy***

Generally, an invention created by member(s) of Siena College shall be the property of the inventor(s). The College may assert ownership rights to an invention developed under certain circumstances. A patent for an invention is the grant of a property right that, absent assignment or other transfer of such right, inures to the inventor(s), issued by the United States Patent and Trademark Office and/or the patent office of another nation.

Reason for Policy

The purpose of the Siena College Patent Ownership Policy is to provide a summary of U.S. Patent law regarding a patentable invention and to define ownership and administration of each patentable invention.

Scope of the Policy: Entities or Individuals affected by this policy

This Policy applies to all College members including appointees (academic and non-academic), students, and affiliates of the College or contractors with the College.

The Official Policy

Principles:

1. Introduction:
 - a) The College recognizes that the purpose of academic research is to seek and make available new knowledge for the good of society. When a patentable invention is created in the advancement of that pursuit, it is in the best interests of the College and of the public that patents should be pursued and administered in order that such inventions may be usefully developed.
 - b) The right conferred by a US patent is the right to exclude others from making, using, offering for sale, or selling the invention in the United States or importing the invention into the United States. The right in other jurisdictions is similar. In the language of the statute, any person who invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent, subject to the conditions and requirements of the law.
2. Rules and Obligations, Exceptions, Special Circumstances:

- a) An invention created by College member(s) wholly on his or her own time, without the use of College facilities, and unrelated to his or her college responsibilities, shall belong to the inventor(s).
- b) An invention created by College member(s) with (1) a College appointment related to his or her College responsibilities and (2) the significant use of College resources, including those from an externally funded grant, contract or other award or gift to the College, shall belong to the College.
- c) If the College owns the invention, each inventor shall execute an Invention Assignment form to assign invention to the College, and shall cooperate in the administrative procedures.

Procedures:

- a) The President will appoint an Intellectual Property Committee that includes a faculty member from each school, representatives from the library, computing and technology services, and the Vice Presidents for Academic Affairs and Finance and Administration or their designees.
- b) Any potential invention shall promptly be disclosed in writing to the Intellectual Property Committee. The disclosure shall include (1) information about inventor(s), (2) an enabling description of the invention, (3) timing when the invention was first created, (4) information on any public disclosure, (5) information on any research funding used to create the invention.
- c) The Intellectual Property Committee shall determine ownership consistent with this Policy, and shall make the determination within one (1) month of disclosure. Any dispute regarding ownership rights may be appealed to the Vice President for Academic Affairs, and if requested, any resulting determination may be reviewed by the President or designee, whose decision shall be final.
- d) In the case that it is determined that the College owns the invention, the Intellectual Property Committee shall evaluate the invention disclosure consistent with (1) technical merit and (2) commercial merit to determine the proper means of protecting and promoting the commercialization of the invention. The Committee shall make a determination within three (3) months of disclosure whether to pursue patenting in the name of Siena College or reassign rights to the inventor(s).
- e) The College may negotiate a license to any invention owned by the College to promote the likelihood that the invention shall provide benefit to the public and the College. The license shall typically cover license fees, patent expense reimbursement, royalties, a requirement of diligence on the part of the licensor, and march-in rights.
- f) If the College has an ownership interest in an invention and the College has not pursued commercialization within 3 years of receipt of disclosure, the inventor(s) who intends to pursue commercialization of the invention may request in writing that College's rights be reassigned to inventor(s). College shall consider the request so long as the invention is not subject to any restrictions and all co-inventors (if any) consent to the request. If the College reassigns the patentable invention, the inventor(s) shall agree to reimburse College for direct expenses to-date from the management of such invention.
- g) With respect to any patent obtained by or through the College or assigned to or as directed by it in accordance with the foregoing provisions, the College, in recognition of the meritorious services of the inventor(s) and in consideration of his or her agreement that the invention shall belong to the College, shall make provisions entitling the inventor(s), his or her heirs or legatees, to a non-assignable fifty (50) percent share in any net proceeds from licensing after recovering direct expenses from the management of such invention.

- h) The Intellectual Property Committee shall prepare semi-annual reports about inventions disclosed, evaluated, licensed and/or reassigned and shall submit reports to the Vice President for Academic Affairs and to the President.

Definitions:

- a) Intellectual Property – All products of the mind, including technical innovations, improvements, discoveries and inventions whether or not patentable or otherwise amenable to statutory or common law protection; trade secrets; works of copyright and writings and other information and/or knowledge in various forms, including computer software, and other forms of technology; tangible research property; trademarks and service marks and mask works.
- b) Inventor – Anyone who has made an intellectual contribution to the conception and/or reduction to practice of Intellectual Property. With respect to patent protection, an inventor is one who has made an intellectual contribution to one or more claims of a patent or patent application.
- c) Invention – A novel and non-obvious creation, discovery, and/or idea that may be protected by a utility, design, or plant patent, plant variety protection certificate, plant breeder's right, international treaties, trade secret, or similar U.S. or international intellectual property right.
- d) Direct Expenses – Direct expenses (not including Siena personnel) associated with formal review, protection, and management of Intellectual Property as determined by Comptroller or designee.

*** Exceptions**

*** Resources**

The United States Patent and Trademark Office - <https://www.uspto.gov/>

Adopted: Approved by President's Cabinet 15 November 201, subject to approval by faculty

Reviewed:

Revised: