

At its meeting of May 11, 1992, the Academic Senate approved the following Policy Recommendation presented by Nancie Fimbel for the Curriculum and Research Committee.

**PATENT POLICY
SAN JOSE STATE UNIVERSITY**

Amends F91-5.

I. PREAMBLE

San José State University, hereinafter referred to as the "University," is dedicated to teaching, research, and the transfer of knowledge to the public. Personnel at the University recognize as two of their major objectives the production of new knowledge and the dissemination of both old and new knowledge. Inherent in these objectives is the need to encourage the development of new and useful devices and processes. Such activities promote the general welfare of the public at large, provide additional educational opportunities for students, contribute to the professional development of the individual staff members involved, and enhance the reputation of the University.

Inventions often come about because of activities of the University's faculty, staff or other employees who have been aided wholly or in part through use of facilities of the University. It becomes significant, therefore, to ensure the utilization of such inventions for the public good and to expedite their development and marketing. The rights and privileges, as well as the incentive, of the inventors must be preserved so that their abilities and those of other employees of the University may be further encouraged and stimulated.

The foregoing considered, the University does hereby establish the following policy with respect to inventions and their subsequent potential patentability and marketability. This policy applies to all University employees and to students who may produce inventions as a result of projects completed as course assignments or master's theses or any activity where University facilities are used or faculty guidance is received.

II. DETERMINATION OF PATENTABILITY

A patent is a grant issued by the U.S. Government giving an inventor the right to exclude all others from making, using or selling the invention within the United States, its territories and possessions for a period of 17 years. When a patent application is filed, the U.S. Patent Office reviews it to ascertain if the invention is new, useful, and non-obvious and, if appropriate, grants a patent - usually two to five years later. Not all patents are valuable or unsusceptible to challenge.

Not all inventions are patentable. Questions relating to patentability are often complex and usually require professional assistance. (1) *General criteria for patentability* - An important criterion of patentability is that an invention must not be obvious to a worker with ordinary skill in that particular field. It also must not have been publicly known or used by others in this country or patented or described in a printed publication anywhere prior to the date of invention. (2) *Loss of patentability* - Inventions that are patentable initially may become unpatentable for a variety of reasons. An invention becomes unpatentable in the U.S. unless a formal application is filed with the U.S. Patent Office within 12 months of disclosure in a publication or of any other action which results in the details of the invention becoming generally available. (3) *Circumstantial impairment of patentability* - Many other circumstances may impair patentability, such as lack of "diligence." For example, unless there is a record of continuous activity in attempting to complete and perfect an invention, it may be determined that the invention has been abandoned by the initial inventor, and priority given to a later inventor who showed "due diligence." (4) *International variation of patentability regulations* - Regulations covering the patentability of inventions and application filing procedures vary considerably from country to country and are subject to change. It is important to note that an invention is unpatentable in most foreign countries unless a patent application is filed before any verbal or written publication occurs.

III. OWNERSHIP

University Research

All discoveries must be assigned by the inventor to the University unless it is clearly demonstrated that no University time or facilities were used. When a discovery has been made which might be patentable, an invention disclosure describing the invention and including other related facts should be prepared and forwarded to the Associate Academic Vice

President for Graduate Studies and Research (AAVP/GS&R). An invention disclosure is a document which provides information about what was invented, the inventor, circumstances leading to the discovery, and facts concerning subsequent activities. It provides the basis for determination of patentability. When inventions result from coursework or any other activity described in the applicability statement from the Preamble above, student and faculty status as inventor(s) shall be established in writing before an invention disclosure is submitted to the AAVP/GS&R. Copies of the invention disclosure can be obtained from the Office of the AAVP/GS&R or the SJSU Foundation. If the University chooses not to file a patent application, then complete ownership rights to the invention revert to the inventor.

Sponsored Research

Sponsored project agreements (including but not limited to those projects sponsored by the federal government, state government, private foundations, and private industries) often contain provisions with respect to patents and licensing. In the majority of cases, these agreements will stipulate that any inventions occurring during the course of the agreement will become the property of San José State University. However, under special circumstances the sponsored agreement may be revised to waive the University's patent rights after negotiation between the Sponsor, the Foundation, the AAVP/GS&R and the Principal Investigator.

Under no circumstances may the sponsor prohibit or interfere with the University's or inventor's rights to publish research results regarding project inventions. The University may agree to a review of proprietary information by the sponsor prior to publication of such information or to a limited waiting period before publication.

IV. IMPLEMENTATION

The University, through the San José State University Foundation, contracts with Research Corporation Technology (RCT), 6840 East Broadway Boulevard, Tucson, Arizona 85710-2815, to evaluate the patentability of inventions, and -- when appropriate -- to file and prosecute patent applications.*

*The University agreement with RCT is considered a part of this policy by reference. The agreement states that RCT will conduct its review of invention patentability within a reasonable time after its receipt. At any time after three months from the date of receipt, the University may notify RCT that it must accept or decline to accept the invention on or before thirty (30) days after RCT's receipt of such notice. Failure to accept the invention within the thirty (30) day period shall be interpreted as RCT's decision to decline.

Under the terms and conditions of the RCT contract, Benchmark Program, patent disclosure statements submitted to the University are sent to RCT. This statement alerts RCT staff that a patentability evaluation is necessary and ensures that in the event of a coincident claim of discovery the inventor has dated documentation in support of the prior discovery assertion. If RCT -- after reviewing the disclosure within a reasonable time period -- chooses not to file a patent application, then the inventor is free to do so on his or her own, or to accept the RCT evaluation and terminate the patent evaluation process.

If a positive assessment of patentability is made, then an agreement will be reached between the University and the inventor(s) concerning rights and responsibilities associated with the prosecution of the patent, the marketing of the product, and the distribution of any patent-related royalties.

V. DIVISION OF PROCEEDS

All costs associated with prosecuting the patent and marketing the invention are paid by RCT. The University's share of any gross royalties resulting from an invention shall be divided as follows: 60% to the inventor(s), 20% to the inventor's department, and 20% to the University. There are no restrictions on the use of the inventor's share of the distribution. The University and the department shares, however, must be used to further promote research at San José State.

VI. SUMMARY

This policy shall become effective as indicated below and shall be reviewed on a bi-annual basis the the University Research Committee.

ACTION BY THE UNIVERSITY PRESIDENT: Approved by President J. Handel Evans on May 22, 1992.

