

INTELLECTUAL PROPERTY POLICY FAM 500.8

Historical Background

In November of 1993, the Copyright Compliance Committee (now the University Copyright/Fair Use Committee) was formed when the division Vice Presidents and college Deans named representatives to the committee. This Committee was charged with creating campus policies on the issues of copyright and intellectual property. The document was revised in February of 2001. This document, the third to be produced by this committee, serves as the Intellectual Property Policy of the CSUSB (California State University, San Bernardino) campus community.

1. Purpose

The purpose of this document is to state the CSUSB (hereafter referred to as the University) policy regarding ownership and technology transfer (commercialization) of intellectual property as it pertains to the University and its constituents (faculty, staff, administrators, and students, including employees of the University Enterprises Corporation (UEC)). This policy acknowledges that issues of intellectual property are complex and that individual circumstances may affect establishment of ownership. Three factors have been identified by the Consortium for Educational Technology for University Systems (C.E.T.U.S.) as important for determining ownership: creation, control, and compensation. This policy provides a framework for assigning ownership in situations where intellectual property rights would not reside solely with the creator. This policy is consistent with existing law and collective bargaining provisions and will be re-examined periodically and revised by the University as necessary.

2. General Policy on Intellectual Property Rights

Our first principle is that works produced by faculty at CSUSB in the course of normal faculty bargaining unit work remain the intellectual property of faculty and will not be considered work-for-hire. Normal work is defined by the bargaining agreement. These works may be copyrightable or patentable, and include, but are not limited to, scholarly papers, works of art, syllabi, course contents and material. This policy does not diminish the right and obligation of faculty members to disseminate the results of research and creative activity for scholarly purposes. The University does not claim

ownership of books, articles, course materials, and similar works that disseminate research and scholarly results or works derived from preparation for classroom teaching; nor does the University claim ownership of popular nonfiction, fiction, poetry, musical compositions or other works of artistic imagination, which are not institutional works. A faculty member's general obligation to produce scholarly works does not constitute a basis for University interest. Unless there is a specific assignment (see Section 3), content of on-line courses also belongs to the faculty.

Faculty may enter into an agreement with the University to use their copyrighted course materials in future courses and for use by other faculty.

Thus, intellectual property rights for works produced under normal faculty bargaining unit work assignment will reside solely with the creator of the work except in specific circumstances:

- 1) where the creator has been given a specific assignment to develop work beyond normal work expectations,
- 2) where the university has provided to the creator extraordinary support or compensation, and
- 3) where the UEC and an outside sponsor enter into agreement (grant, contract, cooperative agreement) to carry out research or other creative activity involving faculty, staff or students. In these cases, intellectual property may be solely owned by the University or jointly owned by both parties as specified in an agreement reached before the project work is begun. Definitions and guidelines for these three circumstances are described below.

3. Specific Assignments

Specific assignment refers to work produced by a faculty member who is paid by the University to produce that particular work and for which facilities and compensation are provided beyond those provided to other faculty members in the course of their normal duties. In these cases, copyrights or patents may be owned by CSUSB or jointly owned with the faculty member. In cases of specific assignments, ownership of intellectual property rights shall be determined before the work begins and documented in a standard Intellectual Property Rights agreement form. This agreement will be completed and filed with the Associate Provost for Research before work begins.

4. Extraordinary Support or Compensation

The words "extraordinary support or compensation" refer to support provided for the creative efforts that represent resources beyond those available to members of the University community in the course of performing their normal work. The following

examples are usually not considered products of extraordinary support or compensation:

- Use of university office space, laboratory space, studio space, university computers and networks, library materials,
- Works resulting from reassigned time, mini-grants, summer research fellowships, TRC grants, sabbatical and difference in pay leaves,
- Use of clerical or technical staff.

All affected parties are advised to consider the matter of copyright ownership before work begins or before extraordinary support is provided and to develop a written agreement. All affected parties should disclose potential products of the work before the negotiation of a contract. The rationale for this advisement is to avoid disputes over ownership at a later date.

5. Sponsored Programs

When there is a sponsored program funded by an external sponsor (grant, contract, cooperative agreement) involving faculty, staff or students, the University (UEC, faculty, staff and students) must comply with the conditions of the agreement regarding ownership, protection and licensing of any intellectual property resulting from the research or creative activity. Unless otherwise stated in the agreement with the sponsor, the intellectual property resulting from sponsored activities will be owned by the originator of the intellectual property.

Federal government sponsors, under the Bayh-Dole Act, would generally assign ownership of an invention to the recipient of the award (UEC), with typical requirements of federal agency disclosure of such inventions, and occasional requirements of public sharing of publications resulting from such support. The intellectual and creative endeavors of faculty and staff will be recognized and rewarded through development of a memorandum of understanding in the event of commercialization of the intellectual property.

In general, philanthropic gifts are not sponsored programs. In the case of a philanthropic gift, the wishes of the donor will be followed. If the gift is unrestricted, the general conditions of this Intellectual Property policy will be followed.

6. University Ownership and Joint Ownership of Copyright/Patent

In cases where the university is the sole or joint owner of works created at CSUSB, the individual designated by the university to negotiate intellectual property rights with

creators will develop a written agreement with the creator(s) of the work the possibility of licensing certain rights to the creator, including, but not limited to, a determination of the distribution of royalties and other compensation. As suggested by C.E.T.U.S., examples may include:

- The right to make reproductions of the work to use in teaching, scholarship, and research;
- the right to make derivative works, such as translations, videotaped versions, film scripts, etc.

If the University, by either written policy or specific act, chooses not to act upon the right of intellectual property licensure or patent or similar methodology for assertion of rights within two years after disclosing the intellectual property, ownership passes wholly to the inventor or creator.

7. Administrator, Staff, and Student Rights

This policy also applies to works created by administrators, staff, and students when done so under the conditions described above in this policy.

In the case of student research, either undergraduate or graduate, the copyright to completed works resides with the creator, the student. In the case of faculty-student research projects it is recommended that the parties develop a written agreement describing shared rights when work is begun, when possible, but before work is completed.

In the case of work done by students for the university using university data or equipment, parties will discuss shared rights when work is begun (or as soon as possible into the project) and an Intellectual Property Rights Agreement form will be completed and filed per Section 3 above.

IMPLEMENTATION

8. Procedures

The University will disclose this policy via a posting on the Faculty Senate Policies Web page. The Office of the Provost, through the Associate Provost for Research, and in coordination with the UEC if appropriate, shall implement and administer this policy, including negotiation of intellectual property terms in agreements with sponsors, evaluation of patentability or other forms of intellectual property protection, filing for patents, negotiation of use rights, and the pursuit of infringement actions. The Office of

Academic Research will develop a web-site with materials to assist faculty, staff and students during the technology transfer/commercialization process. The web-site will include information on copyright procedures, Disclosure of Inventions, an Intellectual Property Rights Agreement and information on patents and licensing of inventions.

9. University Commercialization Committee

The purpose of the University Commercialization Committee is to handle inventions/creations in which the intellectual property was developed as a special assignment or extraordinary support and therefore is owned by the University (see Sections 2-5). If the intellectual property is owned by the creator, as in the normal course of work duties (see section 2 and 7), the creator may ask the University to assist with commercialization of the invention/creation, for example, to develop a provisional or full patent and/or license. In this case the University Commercialization Committee will determine whether to proceed with this specific invention/creation. In order to pursue commercialization of the invention/creation (patent, license, trademark), it will be necessary to assign the intellectual property rights to the University with specification of royalty distributions paid to the inventor/creator determined in a written mutual agreement. If the University Commercialization Committee chooses not to act in support of the commercialization, the inventor/creator retains all rights of ownership and commercialization of the intellectual property.

The University Commercialization Committee will be composed by Associate Provost for Research, ex officio (Chair), the Executive Director of the UEC, ex officio, and three Faculty appointed by Senate Executive Committee. The faculty appointees would serve 3-year revolving appointments (one faculty member replaced each year). The committee will review intellectual property to determine whether the University shall commercialize the invention/creative work through a patent, copyright, and/or license agreement. The Committee may solicit advice/analysis regarding the technology from outside individuals. The inventor/creator must be present at the meeting in which their invention/creation is discussed and must be allowed to speak on their own behalf. In making its assessment, the Committee will rely on information provided by both the inventor/creator and the University. Committee deliberations will be in closed session to protect proprietary information. Similarly, committee records will be kept confidential and committee members will sign a Non-Disclosure Agreement. If the University, by either written policy or specific act, chooses not to act upon the right of intellectual property licensure or patent or similar methodology for assertion of rights, ownership passes wholly to the inventor or creator.

When necessary, the Committee shall review invention disclosures and other information to evaluate the University's contribution to the development of particular

intellectual properties. In many cases the inventor/creator will reach an agreement with the University concerning ownership rights and equity interest without the need for review by the Committee. The purpose of the review will be to help the parties reach agreement within the framework of this policy. The final resolution of any disagreement concerning the application or interpretation of this policy will be governed by applicable law and collective bargaining agreements.

DEFINITIONS

10. Creator

The creator(s) is the author(s), inventor(s) or developer(s) who puts the intellectual property material into a fixed tangible medium of expression. The creator may also have originated the intellectual property material.

11. Intellectual Property

"Intellectual property" means inventions, discoveries, innovations, and copyrightable works. There are four ways to protect intellectual property - **patents, trademarks, copyrights** or **trade secrets**. "Inventions," "discoveries," or "innovations" include tangible or intangible inventions, whether or not reduced to practice and tangible research products whether or not patentable or copyrightable. Such research products include, for example: computer programs, integrated circuit designs, industrial designs, databases, technical drawings, biological materials, and other technical creations. These materials include scholarly and literary works, creative and artistic works, software, data and databases, multimedia works, electronic media and communications, and as otherwise defined by federal law. Certain discoveries and inventions, including trade secrets and know-how, may not be patentable but may have material commercial value or potential as revenue producers. These accomplishments are subject to the same policy as any patentable invention.

12. Invention

Any art or process (*way of doing or making things*), machine, manufacture, design, or composition of matter, or any new and useful improvement thereof, or any variety of plant, which is or may be patentable under the patent laws of the United States.

13. Copyright

Copyright is a form of statutory protection granted to the developer of certain types of works fixed in a tangible medium of expression as an incentive for that creator and/or author to disseminate the work to the public. The copyright owner holds a set of *exclusive* rights: the right to make reproductions of the work; the right to distribute copies of it; the right to make derivative works that borrow substantially from an existing

copyrighted work; and the right to make public performances or displays of most works. Copyright is applicable to computer software, artwork, music, articles, books, and other literary works. Copyright protects the expression of the idea but not the idea itself. Registration of a copyrightable work creates additional protection and is sometimes advisable. Registration is accomplished by completing the necessary forms and filing them with the U.S. Copyright Office in Washington, D.C.

14. Patents

The Patent Act of 1952 gives inventors the right to exclude others from making, selling or offering for sale, or using their inventions for a specified length of time in exchange for full disclosure of their patented inventions. This bargain serves to promote the progress of science and useful arts specified in the Constitution. Patents must be applied for with the Patent and Trademark Office. Patents may be granted to applicant(s), including faculty, staff, administrator or student, who “invent or discover any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvements thereof.” Applications must be filed by or on behalf of the person or entity who is claiming ownership of the potential patent. The term of a new patent is 20 years from the date on which the application for the patent was filed in the United States or, in special cases, from the date an earlier related application was filed, subject to the payment of maintenance fees. US patent grants are effective only within the US, US territories, and US possessions.

15. Software

The proprietary protection available for software is unique in that both copyright and patent are available. Copyright protection may cover the expression of the software ideas in a tangible medium, while patent protection may cover algorithmic inventions.

16. Trademark

Trade and service marks are distinctive words or graphic symbols. They generally identify the sources, product, producer, or distributor of goods or services. Symbols and logos of CSUSB are trademarks and they may not be used by third parties without proper license and specific approval from the university. Doing so may subject the unlicensed user to civil and/or criminal penalties. Education Code 89005.5.

17. Trade Secret

Trade secret refers to financial, business, scientific, technical, economic, or engineering information, including patterns, plans, compilations, program devices, formulas, designs, prototypes, methods, techniques, processes, procedures, programs or codes, whether tangible or intangible, and whether or how stored, compiled, or memorialized physically, electronically, graphically, photographically, or in writing if (A) the owner thereof has taken reasonable measures to keep such information secret; and (B) the information derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable through proper means by the public.

WHO SHOULD BE NOTIFIED?

If the request is coming from a media outlet, it's likely that their fishing for a story – everyone wants the next Bell scandal.

The management of Public Records request is a team effort.

Send it to your campus PRA coordinator (10 day window so we want to get the process started as soon as possible). That person will share it with OGC here.

Typically if you are receiving a request it's for information specific to the president, but if not also include the department head that houses the information (ex. if it's a budget request, then your VP of Finance should be notified because they're likely to have the info).

Also it can be helpful if notify public affairs so they can start to think about what might happen in terms of reputation management after the release of the information. Sometimes the PRA coordinator is also the Public affairs contact (Chico, Bakersfield and Maritime).

By looping in these members of the staff – if it's **not** a simple request – you can take a look at the big picture and see what kinds of effects the release of information might have on the university – **will this be a story that runs on the 11 o'clock news or the front page of the LA Times?**

WHO RESPONDS?

The majority of time it will be the PRA coordinator. If it's a request that comes from a media outlet, then it could be the Public Affairs team. That would be based on the relationship that the public affairs team has with the requestor and if it makes sense strategically to have them serve as the point of contact.

Project Management

NARROWING “AN IMPOSSIBLE REQUEST”

Depends on your level of familiarity with the requestor.

Goldstein example: He wanted to “see how the foundations were spending their money” - requested documents related to 990 forms that are posted on the campus website.

Grant funding is often run through the foundations so campuses were concerned about the volume of documents that were going to be turned over. Initial indications were that responsive documents could be several thousand pages for each campus.

We reached out to the requestor and explained the situation and provided an alternative – we would create spreadsheets that he could review and then determine which actual expenses and supporting he wanted to review.

This narrowed the responsive documents by about 90%. So even though we are not obligated by law to create a document to respond to a request, sometimes it might be in our best interest to do so.

The caveat here is that we were dealing with a request from a media outlet who we had experience with. Most times you might have little or no insight on who is requesting the documents and what the purpose is.

CONSISTENCY IS KEY

Requests can be sent to multiple campuses or the entire system so it’s important that we respond consistently. We need to turn over the same information to minimize follow up questions.

PROACTIVE APPROACH TO MEDIA RELATIONS

Here's why it's especially important to loop in your Public Affairs team. If the information is sensitive, they are the ones who are going to have to respond to both the outlet requesting the information and any follow up (other media outlets, student media, etc.)

Getting in front...

There should be two paths – the production and release of the documents and the media relations around sensitive documents.

Can the information damage the reputation of the university?

What kind of context needs to be provided (give CSUN town car service example)?

Teamwork...

If time permits, allow multiple people to review the documents prior to providing. This will allow for other people to provide input on "red flags" as well as additional context that can help to explain the information.

For the Goldstein story, there were multiple people on the campuses who reviewed, Marlene Jones and I reviewed and there were several other staff members who reviewed some of the documents that we had flagged to allow us to ultimately brief the chancellor.

This leads to Talking Points...

Put together talking points about what is contained within the responsive documents. **This is your context.** It can be used to either explain the difference between \$2,700 spent on banana splits vs. \$2,700 spent on an all-employee picnic.