

Sonoma State University Policy

Intellectual Property

Recommended by: Academic Senate
Approved: Ruben Armiñana, President
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Policy #2011-1

I. Scope

This policy covers the many forms of intellectual property associated with the creative and scholarly activities of faculty, students, administrators and staff. This document sets forth a statement of policy regarding the ownership of, and procedures for, the exploitation of this intellectual property. Intellectual property created before the effective date of this policy is subject to the policies/understandings in place at the time of the project's undertaking. The policy outlined in this document will be reviewed in no fewer than two years from the date it has been adopted as University policy. This will ensure that it continues to effectively serve the needs of SSU faculty, students, administrators and staff.

II. Governing Principles

The following principles should guide the application and interpretation of this Policy and Procedures:

- A. *Encouragement of Intellectual Property Development.* The faculty, students, administrators, and staff of SSU recognize that all members of the University community benefit from the development of intellectual property, and the creation of such materials and products is encouraged and supported.
- B. *Reasonableness and Fairness.* This policy sets forth general principles and procedures, and is not designed to address every conceivable circumstance. Under the principle of fairness, if the need for corrections or exceptions to this policy is identified, appropriate recommendations shall be made by the Chief Research Officer to the President.
- C. *Disclosure and Transparency.* SSU promotes both the disclosure and avoidance of actual and apparent conflicts of interest associated with external commercial activities.
- D. *Consistency with CSU Collective Bargaining Agreements.* Nothing in this policy is intended to be inconsistent with CSU Collective Bargaining Agreements.

III. Definitions

- A. According to the United States Patent and Trademark Office, *Intellectual Property* refers to "creations of the mind," creative works or ideas embodied in a form that can be shared, or can enable others to recreate, emulate, or manufacture them. This document addresses the following three ways to protect intellectual property: *copyright*, *patents*, and *trademarks*.
- B. *Copyright* is a form of protection available to both published and unpublished works, provided by the laws of the United States [Title 17, U.S.C., § 102(a)] to the authors of original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of

authorship include the following categories: (1) literary works¹; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works. Copyright is generally owned by the creator and is secured automatically when the work is created; a work is “created” when it is fixed in a copy or phonorecord for the first time.

- C. A *patent* for an invention is a grant to the patentee, his/her heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States, or importing the invention into the United States, and, if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof [Title 35 U.S.C., § 154(a) (1)]. A patent is granted to the inventor of a new and useful machine, design, or plant after submitting an application and paying appropriate fees. The right conferred by a patent extends throughout the United States. International patents exclude others from making, using, or selling the invention in other countries.
- D. A *trademark* is a word, name, symbol, or device, or any combination used, or intended to be used, in commerce to identify and distinguish the goods of one manufacturer or seller from goods manufactured or sold by others, and to indicate the source of the goods. In short, a trademark is a brand name. A *service mark* is any word, name, symbol, device, or any combination, used, or intended to be used, in commerce, to identify and distinguish the services of one provider from the services provided by others, and to indicate the source of the services. The terms “trademark” and “mark” are commonly used to refer to both trademarks and service marks.
- E. *Creator(s)* are individuals or a group of individuals, singly or as a group, who make a substantive contribution to the creation of intellectual property. These individuals may include faculty (including lecturers), staff, or students (undergraduate, graduate, or postdoctoral).
- F. An *invention* as referred to in this policy, is any invention or discovery which is or may be patentable. Patentable inventions include any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof [Title 35 U.S.C., § 101]. A novel plant which is or may be protectable under the Plant Variety Protection Act (7 U.S.C. 2321, et seq.), [Title 35 U.S.C., § 201(d)] is also subject to patent rights.
- G. *Inventor(s)* are individuals or a group of individuals singly or as a group, who contribute to the conception of an invention. These individuals may include faculty (including lecturers), staff, or students (undergraduate, graduate, or postdoctoral). See Title 35 U.S.C., § 116 for more information.
- H. *Sponsors* are individuals, public/private agencies, or public/private companies that provide funding or have a contractual relationship with the creator or inventor.
- I. *Scholarly and Instructional Works* embody substantive educational, creative, and scholarly work, thought, or research. All rights in copyright of scholarly and instructional works shall belong to the creator, originator or author whether an employee or associated with the University in any other capacity, and shall not be considered works for hire unless there is a written contract or agreement to the contrary.
- J. *Administrative works* are those generally created by University employees in the regular course of their employment and relate to the administration of the educational mission of the University and are generally not the result of scholarly work or research. For

example, an administrative work may be a spreadsheet or software tool developed and improved over time by multiple administrators, faculty, staff, or students where authorship is not appropriately attributed to a single or defined group of authors. However, an administrative work may have one originator, creator, or author.

- K. *Institutional works* are works supported by a specific allocation of University funds or are created at the direction of the University for a specific University purpose.
- L. *Commissioned Works* are works produced for University purposes by individuals not employed at the University or by University employees outside their regular job duties.
- M. *Sponsored Works* are works first produced by or through the University in the performance of a written agreement between the University and a sponsor or outside funding source.
- N. *Works for Hire*, as defined in the U.S. Copyright Act, is “work prepared by an employee within the scope of his or her employment.”
- O. *Fair Use Doctrine*, as embodied in Section 107 of the U.S. Copyright Act, exempts limited uses of materials from copyright infringement liabilities. Under the statute, the right of fair use is specifically applicable to teaching, research and scholarship, and that its scope depends on four factors: 1) the purpose and character of the use; 2) the nature of the copyrighted work; 3) the amount and substantiality of the portion used; and 4) the effect of the use upon the potential market for or value of the copyrighted work. The specific facts of each use or proposed use should be analyzed in light of these four factors.
- P. *Full Commission or Assignment of Rights*. Intellectual property shall be commissioned or assigned when there exists between SSU, acting through any of its agents or auxiliaries, and the creator(s) or inventor(s), a contractual agreement to develop that specific intellectual property. For a commission or assignment, the contractual agreement shall specify the terms applying to ownership of the intellectual property and the distribution of royalties between the creator(s) or inventor(s) and SSU.
- Q. *Ownership* is defined as party or parties who own or control rights to an invention, whether patented or not.
- R. *Facilities* is defined as any resources available to a creator as a direct result of the creator’s affiliation with SSU or its auxiliaries. These may include SSU-owned or SSU-leased offices, research facilities or stations.
- S. *Ad Hoc Intellectual Property Oversight Committee* is defined as the Committee responsible for deliberating and making formal recommendations regarding matters related to SSU intellectual property rights and policy. A Committee will be convened, on a case-by-case basis as needed, by the Chief Research Officer. This Committee will deliberate and make recommendation(s) to the President and/or the President’s designee for resolution of ownership and policy matters related to intellectual property. Ad Hoc Committee members will be determined on a case-by-case basis depending on the property under consideration, but will always include the creator (and/or their representative), SSU Administrative representative(s), an academic senate representative, and legal, technical or other representatives as needed upon request.

IV. Ownership of Intellectual Property

The SSU President or his/her designee, the Chief Research Officer, is responsible for overseeing policy matters relating to intellectual property and affecting SSU’s relations with inventors and creators, public agencies, private research sponsors, industry, and the public. Determinations or disputes regarding ownership will be deliberated by an Ad Hoc Intellectual Property Oversight Committee to be convened as needed by the Chief Research Officer, and a

recommendation will be made to the President or the President's designee, the Chief Research Officer, for resolution of policy matters relating to the Intellectual Property.

A. *Copyright Ownership.* Creators own their traditional academic copyrightable, "scholarly and instructional works" (books, articles, dissertations, papers, study guides, syllabi, lecture materials, online course materials, tests or similar items, novels, poems, musical compositions, art works, and other creative expressions). SSU recognizes that faculty and students should benefit from the results of their work. Below is an outline of the SSU policy regarding ownership and use of copyright material(s):

1. **Course Material(s):** In all cases of course material development, SSU retains exclusive right to course number and description as listed in SSU catalogs. The creator(s) retains the rights to distribute the work and is not obligated to share any part of the revenue from the sale or licensing of the content with SSU, except as provided otherwise in this policy or state or federal law, with any office or organization within SSU. The creator(s) has sole responsibility for the copyright registration of the material for which SSU has no proprietary interest.
2. **Administrative, Institutional, and Commissioned Work:** Copyrightable material(s) developed as Administrative, Institutional or Commissioned Work shall be owned solely by the University, both in copyright and distribution. SSU has responsibility for the registration of these works. In the absence of a written agreement (for example, an assignment of rights or licensing agreement), ownership of these work (s) shall remain the property of the University.
3. **Sponsored Work:** Copyrightable material created as a deliverable on a sponsored contract shall be the property of the University unless the sponsored agreement or grant contract provides otherwise. However, academic or scholarly works *derived* from sponsored works, including journal articles, lectures, books, videos, or other copyrightable works created through independent effort (even though based on the findings of the sponsored project or derived from sponsored work) shall reside with the creator, originator or author of the derivative work.
4. **Joint Ownership of Copyrights:** The University and its faculty and staff shall avoid joint ownership of copyrights as joint owners have legal obligations to one another potentially over many years.
5. **Use of Copyrighted Works Owned by Others:** The University may make use of copyrighted works owned by others under the fair use doctrine. What constitutes fair use of copyrighted material owned by another is a legal determination. Administrators, faculty, staff, and students are encouraged to review the educational materials on fair use provided by the California State University Chancellor's Office, and to seek the advice of the Office of the General Counsel to determine if a proposed use potentially falls outside the limits of fair use or other exemptions under copyright law.

B. *Trademark Ownership.* Because trademarks are generally created during the commercial exploitation of intellectual property, ownership of the trademark shall be held by the entity responsible for commercial development of the intellectual property. The trademark owner is responsible for maintaining and defending the trademark. If the trademark is developed as part of work commissioned by the University, ownership rights for that trademark shall remain with the University, in the absence of a written agreement to the contrary.

C. *Patent Ownership*. Sponsored program agreements (including, but not limited to, those projects sponsored by federal or state government, private foundations, and private individuals, industries or public companies) often contain provisions with respect to patents and licensing of inventions. Government sponsors, under the Bayh-Dole Act, would generally assign ownership of an invention to SSU, with typical requirements of federal agency disclosure of such inventions, and occasional requirements of public sharing of publications resulting from such support. Under SSU policy, title to inventions resulting from sponsored research from any source outside of SSU or its auxiliaries shall be held in full (100%) ownership of the University. The inventor (or inventors) shall receive 50% of any net royalties generated from a licensed invention, with each inventor sharing equally in the inventors' share of royalties when there are two or more inventors. In the rare instance that the sponsoring agency or party may regulate the distribution of royalty income, the regulations of the sponsor shall apply, rather than those in the above paragraph. The inventor(s) shall promptly disclose to the Office of Research and Sponsored Programs (ORSP) all inventions by means of an Invention Disclosure Form which is posted at the ORSP website. At the discretion of the Chief Research Officer, in cases of private or public industry sponsorship, ownership rights of inventions may be deliberated by the Ad Hoc Intellectual Property Oversight Committee which will be convened by the Chief Research Officer in a timely manner. Thereafter, a formal recommendation shall be made regarding respective ownership rights and interests, prior to execution of any ownership, royalty, or licensing agreement.

V. **Exploitation² of Intellectual Property**

It is in the interest of SSU and of creators that intellectual property created as a result of the educational mission of the University be widely distributed for the benefit of the broader community of scholars. When dealing with the commercial exploitation of intellectual property, the intent of this policy is to ensure the costs of commercial exploitation and the financial benefits of commercial exploitation are distributed equitably. SSU may, after evaluation, actively pursue development of intellectual property in which it has an interest. Should SSU decide not to exploit property in which it has a shared interest, the creator shall be given the right to exploit the property.

1. *Assignment of ownership rights for copyrighted material.*

As stated in the section regarding **Ownership of Intellectual Property** above, creators own their traditional academic copyrightable works, and SSU will generally release its proprietary interest to the creator(s) unless it falls under the guidelines of administrative, commissioned, or sponsored work as set forth above

¹“Literary works” are works expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied. Note that a “computer program” falls under this rubric, as it is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result (Title 17, U.S.C., §102). For more information regarding copyright registration for computer programs, see United States Copyright Office Circular 61. **Important Note: Computer software can also be subject to patent rights. In defining intellectual property rights for computer software, patent rights must be analyzed on a case-by-case basis.**

²Exploitation for the purposes of this document is a legal term which refers to the process by which a form of intellectual property will be commercialized or brought to market.

Updated August 18, 2011 by SSU.policies@sonoma.edu