



# LONG ISLAND UNIVERSITY

## PATENT AND INTELLECTUAL PROPERTY POLICY

### PURPOSE

The University supports full freedom in research and the publication of said results, and research for pecuniary return shall be based upon the institution's general principles connected to Patent and Intellectual Property (PIP) policies.

### STATEMENT OF POLICY

The University supports full freedom in research and the publication of said results, and research for pecuniary return shall be based upon the institution's general principles outlined below:

The Patent and Intellectual Property (PIP) policies of Long Island University ("LIU" or the "University") are designed to accomplish the following: 1). Support the goals of LIU's strategic plan; 2). Develop resources that aid and educate faculty on patenting and technology transfer; 3). Maximize opportunities to engage in collaborative and/or sponsored research; 4). Encourage entrepreneurialism by faculty and staff and, 5). Effectively use LIU-generated intellectual properties.

### DEFINITIONS

Ownership of patents follows established guidelines:

- Long Island University has an interest in all inventions of University personnel that are conceived or first reduced to practice as a part of or as a result of: (a) University research; (b) activities within the scope of the inventor's employment by, or in official association with, the University; and (c) activities involving the use of University time, facilities, staff, materials, University information not available to the public, or funds administered by the University.
- Faculty and staff whose inventions are made on their own time, outside the scope of their employment or association with the University and without University facilities, materials, or resources and which inventions are, therefore, their exclusive property, may submit their invention to the University for possible association with patenting and/or commercial exploitation and management under terms to be agreed upon by the inventor and the University.
- The provisions of the LIU Patent Procedures are subject to any applicable laws, regulations or specific provisions of the grants or contracts which govern the rights in inventions made in connection with sponsored research.

- Under the terms of certain contracts and agreements between LIU and various agencies of government, private and public corporations, and private interests, LIU may be required to license patent rights to the contracting party. LIU retains the right to enter into such agreements whenever such action is considered to be in its best interest.
- Should a patentable invention be discovered in research which is not clearly covered by any one of the three categories in the above paragraph 1 (a) — (c) of this Policy, the PDPIP shall determine in the spirit of this Policy where title, rights, interests and equity lie or how they shall be divided.

LIU personnel have the following responsibilities with regard to patents and intellectual property:

- LIU personnel who, either alone or in association with others, make an invention in which LIU has or may have an interest shall promptly disclose such inventions to the President's Designee for Patents and Intellectual Property (PDPIP).
- For any invention in which the University has an interest, the inventor, upon request of the PDPIP shall promptly cause the University to execute all contracts, assignments, waivers or other legal documents necessary to vest in the University or its assignees any or all rights of the invention, including complete assignment of any patents or patent applications relating to the invention.
- LIU personnel may not: (a) sign patent agreements with outside persons or organizations that may abrogate the University's rights and interests either as stated in the Patent Policy or as provided in any grant or contract funding the research which led in whole or in part to making the invention, or (b) without prior authorization, use the name of the University or any of its units in connection with any invention in which the University has an interest.

*Disclosure of Inventions:* When faculty or staff members create an invention, it shall be their responsibility to discuss their discovery or invention with the PDPIP, at which time the possibility of exploring patenting should be considered.

*Royalty:* LIU shall share with the inventor(s) revenue it receives from patents or inventions. As noted above, specific provisions of grants or contracts may govern rights and revenue distribution regarding inventions made in connection with sponsored research; consequently, revenues the University receives from such inventions may be exclusive of payments of royalty shares to sponsors or contractors.

*Inventor Requests for Waiver of University Rights:* If an inventor believes that the invention was made outside the general scope of his or her University duties, and if the inventor does not choose to assign the rights in the invention to the University, he or she shall, in the invention disclosure, request that the PDPIP determine the respective rights of the University and the inventor in the invention.

Regarding publication and public use of intellectual property:

- Long Island University strongly encourages scholarly publication of the results of research by faculty. Though this Patent Policy does not limit the right to publish, except for short periods of time necessary to protect patent rights, publication or public use of an invention constitutes a statutory bar to the granting of a United States patent for the invention unless a patent application is filed within one year of the date of such publication or public use. Publication or public use also can be an immediate bar

to patentability in certain foreign countries.

- In order to preserve rights in unpatented inventions, it shall be the duty of the inventor, or of his or her supervisor if the inventor is not available to make such a report, to report immediately to the PDPIP any publication, submission of manuscript for publication, sale, public use, or plans for sale or public use, of an invention, if a disclosure has previously been filed. If an invention is disclosed to any person who is not employed by the University or working in cooperation with the University upon that invention, a record shall be kept of the date and extent of the disclosure, the name and address of the person to whom the disclosure was made, and the purpose of the disclosure.
- The inventor shall immediately notify the PDPIP of the acceptance for publication of any manuscript describing the invention or of any sale or public use made or planned by the inventor.

Contractual arrangements regarding intellectual property are made according to the following:

- Long Island University will follow Federal Regulations with respect to election of title in contracts and grants with Federal agencies.
- The University normally reserves the right to ownership of patents on inventions arising out of research supported in whole or in part by grants or contracts with non-governmental organizations or firms.

Long Island University recognizes that the evaluation of inventions and discoveries and the administration, development and processing of patents and licensable inventions involves substantial time and expense and requires talents and experience not ordinarily found among its faculty and staff. Accordingly, the University may contract with outside agents for certain services.

**POLICY TYPE:** ACADEMIC AFFAIRS