June 25, 2015

Elise Rosen Puzio, Esq.
Secretary of the SUNY Patents & Inventions Policy Board
State University of New York
SUNY Plaza
353 Broadway
Albany, New York 12246

Dear Ms. Puzio,

I am in receipt of the SUNY Patents and Inventions Policy Board recommendation to consider three exceptions to the provisions of the Patents and Inventions Policy of The State University of New York. These exceptions include a request for the assignment of royalties to a trust, a request to disclaim a portion of royalty shares for the benefit of a particular department, and a request to approve the “SUNY IP Landscape for Student Activities” document.

Pursuant to the authority vested in me under the Patents and Inventions Policy of The State University of New York at Section (g), I hereby accept the advisory recommendation of the Patents and Inventions Policy Board and approve the above three exceptions.

I appreciate the members’ time and effort in reviewing and interpreting the Patents and Inventions Policy in furtherance of SUNY’s strategic goals.

Sincerely,

[Signature]
Nancy L. Zimpher
Chancellor

cc: Alexander N. Cartwright, Chair of the SUNY Patents and Inventions Policy Board
June 25, 2015

Chancellor Nancy L. Zimpher
State University of New York
SUNY Plaza, S405
353 Broadway
Albany, New York 12246

Dear Chancellor Zimpher:

As you know, the SUNY Patents and Invention Policy Board is empowered to consider requests for exceptions to the Patents and Inventions Policy of the State University of New York, approved by the Board of Trustees on September 19, 1979 and amended on November 16, 1988. Section (h) of the policy requires that the “board shall advise the chancellor in (ii) exceptions to these policies in unusual circumstances.” Pursuant to section (g) of the policy “[t]he decision of the chancellor on the findings and recommendations of the patents and inventions policy board shall be final.”

In the Board’s meeting on June 8, 2015, the Board voted to recommend several exceptions for approval. They are as follows:

1. Director of the Office of Technology Licensing and Industry Relations at Stony Brook University, Peter Donnelly, requested a determination as to whether a faculty member may assign her royalty rights to a trust designated for the benefit of her heirs and legatees. After discussion, the Board determined that assignment to a trust for the benefit of the heirs and legatees was consistent with the intention of the policy and, accordingly, voted to recommend such an exception.

2. Director of the University at Buffalo Office of Science, Technology Transfer and Economic Outreach, Jeffrey Dunbar, requested a determination as to whether a faculty member may disclaim a portion of shares distributed to him under a license and direct those shares to the UB Department of Chemistry. After discussion, the Board determined that disclaiming a portion of shares for the benefit of the department was consistent with the intention of the policy and, accordingly, voted to recommend such an exception.

3. Director of the Office of Technology Licensing and Industry Relations at Stony Brook University, Peter Donnelly, requested an exception to the current policy entitled “SUNY IP Landscape for Student Activities.” This is a document describing the rights, expectations, and responsibilities of students participating in taught courses, experiential learning, and entrepreneurship programs at SUNY relating to any intellectual property developed in the course of these activities. The document allows the university to waive ownership of IP in certain circumstances, so as to provide clear title to the student. After discussion, the Board determined that this exception is appropriate and consistent with the overall intention of the policy and, accordingly, voted unanimously to recommend such an exception. The “SUNY IP Landscape for Student Activities” document is attached.
On behalf of Chair Cartwright and the entire the Board, I request that you accept these advisory recommendations and approve the above exceptions.

Sincerely,

Elise Rosen Puzio
Secretary of the Patents & Inventions Policy Board
State University of New York

Enclosure

cc: Alexander N. Cartwright, Chair of the SUNY Patents and Inventions Policy Board
SUNY IP Landscape for Student Activities

Summary

The State University of New York ("SUNY") is committed to providing valuable educational and practical opportunities for students. While SUNY is proud to empower its students to pursue entrepreneurial and experiential activities, determining the rights to intellectual property ("IP") created by SUNY students can be a complex process. In all circumstances, SUNY students are encouraged to avail themselves of the university's services and seek the assistance of a university technology transfer office, where available. This document describes the rights, expectations, and responsibilities of students participating in taught courses, experiential learning, and entrepreneurship programs at SUNY relating to any intellectual property (referring to inventions) developed in the course of these activities.

1. Taught Courses

Under SUNY's current Patents & Inventions Policy, inventions created by a student in a taught course will be owned by SUNY if made using "university facilities." However, consistent with the spirit of SUNY's policy and commitment to rewarding students for their entrepreneurial thinking and action, all campuses may affirmatively disclaim any student invention created or developed in a taught course. To do this, the chief academic officer of the SUNY campus should coordinate with the SUNY Office of General Counsel to execute a waiver and release form for the individual course. SUNY's proposed Intellectual Property Policy contemplates student ownership of inventions created by them in a course of study.

2. Experiential Learning

Student experiential learning is an increasingly important part of the higher education experience. Through experiential learning, students are able to gain essential skills and knowledge outside the traditional academic setting. Some examples of experiential learning include internships, externships, co-ops, professional work, and sponsored research, just to name a few. During the course of experiential learning, a student may develop, create, invent, or author certain IP related to that experiential learning. In experiential learning situations that qualify as collective or collaborative projects where an industry or external sponsor is engaged, that sponsor will usually expect to own any IP created within the course of that project/internship/research/etc. When sponsors have such a requirement, the SUNY Research Foundation and the student will be required to execute a Student Participation Agreement whereby students assign all right, title, and interest to all IP over to the

---

1 For those SUNY campuses without a dedicated local technology transfer office, students and their instructors may contact SUNY’s Office of General Counsel or The Research Foundation for SUNY’s Office for Innovation & Partnerships.

2 The SUNY Research Foundation has template agreements on hand and offers assistance to any campus collaborating with an external entity. The RF encourages all campuses engaging with industry sponsors to seek its support and advice. In some cases, it may be appropriate for the student to contract directly with the external entity.
Research Foundation. The Research Foundation, in turn, will execute a Project Agreement\(^3\) between itself and the external company/sponsor, whereby any IP created by the student will be owned by the sponsor. The idea here is to encourage more opportunities for students to gain practical and applied experience enhancing their competitiveness in the job market.

### 3. Student Entrepreneurship Programs

Student entrepreneurship programs and dedicated student entrepreneurship space are offered by the campus in order to nurture and develop the original ideas of students in a collaborative fashion. In these programs, it is understood that the university waives any ownership interest in any IP developed within the course of the program. The university is encouraged to issue a statement of purpose in connection with the program, such as the following:

> “One of the goals of the SUNY [Campus Name] [Name of Entrepreneurship Program] is to have a central campus location where students can bring their ideas, in order to nurture and develop them in a collaborative fashion. SUNY [Campus Name] recognizes the value of invention and entrepreneurship in the educational experience and is proud to empower its students to pursue entrepreneurial activities. If the conception and reduction to practice of student IP is done in the [Name of Entrepreneurship Program], the university will waive any ownership interest in such IP provided that the invention was not made with support from an external entity or as part of a collaborative program facilitated by the university. SUNY [Campus Name] does recognize that the process of disseminating or commercializing an invention is complex. In all circumstances, students are encouraged to avail themselves of the university’s services and seek the assistance of a university technology transfer office.”

Such a statement should be issued at the onset of each program so that students are aware of their rights. These programs generally involve a minimal use of university facilities (or designated use for these purposes, for example: Stony Brook Innovation Lab) and entrepreneurship without corporate/industry sponsorship. They allow students to be creative and collaborative among themselves, and are solely meant to benefit the student. Thus, the campus should adopt a practice whereby students own any IP developed within the course of the program, and are made aware of this upon the start of participation in the program.

Effectively, the university disclaims any IP ownership interest in favor of student ownership. SUNY recommends that campuses encourage students to disclose any IP to their local technology transfer office or appropriate authority on campus in order to confirm the circumstances under which the IP was developed. The campus may then formally waive any ownership interest so as to provide clear title to the student. If IP is developed collaboratively among several students, those students should consult their own attorney to establish the disposition of ownership rights. Since neither SUNY nor the RF would be a party to that agreement, we will not provide a contract nor advise on an existing contract in any way.

\(^3\) See fn 2.
4. IP Developed Outside Use of SUNY Facilities

This final category of circumstances in which students may develop IP is referred to in the current policy as an “own time” invention, whereby an invention is made by an individual wholly on such individual's own time, and without the substantial use of university facilities.

Guidance and Supplemental Resources:

- SUNY Patents & Inventions Policy
- Upstate Medical University Technology Transfer
- University at Buffalo STOR
- Buffalo State Technology Transfer
- University at Albany Technology Transfer
- Binghamton University Technology Transfer
- SUNY Polytechnic Technology Management
- Stony Brook University Technology Licensing
- SUNY Downstate Office of Technology Commercialization