California State University, Long Beach Policy Statement

*XX-XX*

INTELLECTUAL PROPERTY

(This policy supersedes PS 07\_05, and PS 03\_11)

This policy was recommended by the Academic Senate on \_\_\_\_\_ and

approved by the president on \_\_\_\_\_.

**1.0 OBJECTIVES**

1.1 This policy articulates the allocation of intellectual property rights and usage rights at the California State University, Long Beach (University) so as to optimally support the mutual interests of the University, faculty, staff and students.

1.2 This policy, as applied to University faculty is intended to be consistent with the provisions of Article 39 *Intellectual Property Rights* in the collective bargaining agreement between the California Faculty Association and the California State University effective September 18. 2012-June 30, 2014 and subsequent mutually agreed revisions thereto (CBA). Any provisions that are found to be inconsistent shall be superseded by CBAArticle 39 *Intellectual Property Rights.*

1.3 This policy recognizes the intellectual property interests of creators, the University, and external sponsors that support instruction, research, scholarly and creative activity.

1.4 The University makes no claim of ownership or use rights, or obligation between the university and creator(s), regarding any intellectual property except:

* Course catalog descriptions and standard course outlines submitted and approved via the university curriculum process;
* Intellectual property created with “extraordinary support” as defined in section 2.5, and only when, in advance of the creation of the materials, the creator(s) and the university have entered into a written contractual agreement detailing the specifics of the materials under contract, the terms of ownership and use, and the scope of extraordinary support;
* Intellectual property created in a “work for hire” or “commissioned work” situation as defined in section 2.6, and only when, in advance of the creation of the materials, the creator(s) and the university have entered into a written contractual agreement detailing the specifics of the materials under contract, the terms of ownership and use, and the terms of the commission;
* Intellectual property created under the terms of other contractual agreements only when, in advance of the creation of the materials, the creator(s) and the university have entered into a written contractual agreement detailing the specifics of the materials under contract, the terms of ownership and use, and the terms of the commission;
* Intellectual property created as a specific requirement of employment or as an assigned University duty that may be specified, for example, in a written job description or an employment agreement;

**2.0 DEFINITIONS**

2.1 Creator:  "Creator" means an individual, or group of individuals, who makes, conceives, reduces to practice, authors, or otherwise makes a substantive intellectual contribution to the creation of intellectual property. "Creator" includes the definition of "inventor" used in U.S. patent law for patentable inventions and the definition of "author" used in the U.S. Copyright Act for copy written works of authorship.

2.2 Intellectual Property: "Intellectual Property" means intangible rights protecting the products of human intelligence and creation, such as copyrightable works, patented inventions, [trademarks](http://legal-dictionary.thefreedictionary.com/Trademarks), and trade secrets. It includes Traditional Academic Copyrightable Works (see Section 2.3 below), inventions, discoveries, registered or unregistered copyrighted works, registered or unregistered trademarks, service marks, trade secrets, mask works, and plant variety protection certificates.

Intellectual Property also includes the physical embodiments of intellectual effort (for example: models, machines, devices, designs, apparatus, instrumentation, circuits, computer programs and visualizations, biological materials, chemicals, other compositions of matter, plants, and records of research and experimental results).

Intellectual Property is not restricted to inventions that are first conceived, but can also apply to existing inventions or concepts that are first actually reduced to practice, and other creative or artistic works that have value.

Intellectual Property includes both tangible work and work created in the electronic and internet environment.

2.3 Traditional Academic Copyrightable Works:   "Traditional Academic Copyrightable Works" means a subset of copyrightable works created independently and at the Creator's initiative for academic purposes. Examples include, but are not limited to, lecture notes and materials, course syllabi, instructional texts and manuscripts, software, or plans, patterns, and works of art or design or educational software (also known as courseware or lesson ware) that the Creators may design for courses taught in the CSU, and specifically for students who matriculate at CSULB.

2.4 University Resources Customarily Provided:  When determining ownership and license rights in copyrightable works, the term "University Resources Customarily Provided" includes office space, library facilities, student and staff support, ordinary access to laboratories, media studios, computers and networks, sabbaticals and salary. Unless otherwise stated, reassigned time is considered as resources customary provided. This may also include facilities and resources used in the creation of works of art or design such as studios and performance spaces, facilities and equipment.

2.5 Extraordinary Support:   “Extraordinary Support” means University resources used in the creation of Intellectual Property where those resources are not available or accessible to all members of the University community in a similar employment.  Examples of Extraordinary Support include, but are not limited to, use of media studios requiring support from staff, or significant staff resources used to research or develop elements of a work, and significant use of laboratories and equipment.  External sponsor funding for the work or effort is not Extraordinary Support.

2.6 Work for Hire or Commissioned Work: “Work for Hire” or “Commissioned Work” means work performed outside the normal scope of the Creator's University employment or for which there is additional remuneration, including without limitation stipends, incentives, and other remuneration to create course materials and other Intellectual Property outside the normal scope of work.

**3.0 OWNERSHIP OF INTELLECTUAL PROPERTY IN COPYRIGHTABLE WORKS**

3.1 Creator Ownership

3.1.1 Traditional Academic Copyrightable Works

Creators own Intellectual Property rights in Traditional Academic Copyrightable Works, which they create.

The University shall be entitled to a royalty-free, perpetual, non-exclusive, and non-transferable license to use Creator-owned Traditional Academic Copyrightable Works, limited only to course catalog descriptions and standard course outlines submitted and approved via the university curriculum process, for the purpose of continuing to teach the course of instruction for which the works were prepared, with the non-exclusive right to revise and update them as required for this purpose.

The university shall make no claim of ownership or financial interest in course materials prepared under the direction of a faculty member unless the university and faculty member have so agreed in a separate, voluntary agreement. Payment of a financial stipend, use of university resources, or reassigned time to develop course materials shall not be construed by the university as creating a basis for a claim of institutional ownership of such materials, nor shall it be assumed that a work-for-hire relationship exists between the university and the faculty member with regard to the preparation of any such materials.

In the event that the Creator or the University wishes to commercialize Traditional Academic Copyrightable Works, revenue distribution shall be determined by a negotiated written agreement and subject to review by the University Intellectual Property Committee (See Section 4.2 below).

3.1.1 Traditional Academic Copyrightable Works

Creators own Intellectual Property rights in Traditional Academic Copyrightable Works, which they create.

The University shall be entitled to a royalty-free, ~~perpetual~~, non-exclusive, and non-transferable license to use Creator owned Traditional Academic Copyrightable Works for the purpose of continuing to teach the course of instruction for which the works were prepared for a reasonable period, with the non-exclusive right to revise and update them as required for this purpose.

In the event that the Creator ~~or the University~~ wishes to commercialize Traditional Academic Copyrightable Works, and if the commercialization is expected to cause unreasonable financial impact on teaching or taking the courses for which the works were prepared, revenue distribution between the Creator and the University shall be determined by a negotiated written agreement and subject to review by the University Intellectual Property Committee (See Section 4.2 below).

3.1.2 Copyrightable Works Created with Extraordinary Support

Copyrightable works created with use of University Extraordinary Support shall be owned by the Creators but the University shall have a royalty-free, perpetual, non-exclusive, and non-transferable license to use such works and to make use of derivative works in teaching, research, and public service. The University may retain more than the minimum license rights when justified by the circumstances of development as determined by the Intellectual Property Committee.

3.1.2 Copyrightable Works Created with Extraordinary Support

Creators of copyrightable works created with use of University Extraordinary Support shall own intellectual property and use rights for that work. The University shall be entitled to no rights to Copyrightable Works Created with Extraordinary Support beyond those specifically assigned by the Creator(s) of that work. This includes any creative and/or scholarly work created during assigned-time and sabbaticals.

3.2 University Ownership

The University shall own the Intellectual Property rights to copyrightable works as follows:

3.2.1 Works created pursuant to the terms of a written agreement between the University and the Creator(s) only when the agreement specifically grants ownership to the University.

3.2.2 Work for Hire created as a specific requirement of employment or as an assigned University duty that may be specified, for example, in a written job description or an employment agreement. Such specification may define the full scope or content of the Creator's University employment duties comprehensively or may be limited to terms applicable to a single copyrightable work. Any future creative work or course content that the University may claim as its own must be negotiated and specified in the employment contract.

3.2.3 Commissioned Work prepared under an agreement between the University and the Creator when:

3.2.3.1 The creator is not a University employee, or

3.2.3.2 The creator is a University employee but the work to be performed falls outside the normal scope of the Creator's University employment or for which there is additional remuneration (see Section 2.6. above), or

3.2.3.3 Commissioned Work agreements shall specify that the Creator shall convey by assignment, if necessary, such rights as are required by the University.

The creator has specified in an agreement that the attendant Intellectual Propert rights be assigned to the University.

3.2.3.4 In all cases of paragraph 3.2, such Commissioned Work shall be negotiated between the University and the Creator(s), and documented in a written agreement.

3.2.4 The University and the creator(s) reserve the right to pursue multiple forms of legal protection of its Intellectual Property concomitantly ~~if available. (e.g. computer software may be protected by copyright and patent).~~

3.2.5 University-owned copyrightable work shall be protected by copyright notice in the name of the Board of Trustees of the California State University. Such copyright notice shall be composed and affixed in accordance with the United States Copyright Law. Registration of the copyright for University-owned works shall be in accordance with the operational guidelines and procedures established by the Provost or designee. The University may also decide to release a work to the public domain and if so, should so indicate.

3.2.6 Creators of Intellectual Property, regardless of whether patented or not, which produce a taxable income, must repay the State of California for any expenses incurred by the University, including but not limited to expenses incurred in support of the research leading to the creation of the Intellectual Property, to obtain patent or similar protection, or in furtherance of production, marketing, or sales of products incorporating the Intellectual Property.

3.2.6 The University shall be entitled to no rights or ownership for artistic creations, performances, or related creative or scholarly work presented in university spaces or created by university faculty, staff, or students unless there is a preexisting contract stating otherwise.

3.3 Student Copyrightable Works

Unless subject to the provisions of Section 2.4 above or provided otherwise by written agreement, copyrightable works created by a student as part of the requirements for a University degree program are the property of the student. Unless otherwise agreed upon, research records for graduate theses or dissertations are the property of the University, but the student Creator may retain a copy of the work.

3.4 Intellectual Property subject to legal protection other than by Copyright

Except as otherwise specified in this policy or by the University in a written agreement, Intellectual property subject to legal protection other than by copyright (ex: patents, trademarks) shall belong to the University if made:  (1) by a University employee as a result of the employee's duties, or (2) through the use of University resources such as facilities, equipment, or funds under the control of or administered by the University or its research foundation.  The extent of University ownership in the property shall be in proportion to the value of the resources used consistent with applicable law.

3.4 Except as otherwise specified in this policy or by the University in a written agreement, Intellectual property subject to legal protection other than by copyright (ex: patents, trademarks) shall belong to the University if made by a University employee as a result of the employee's extraordinary duties as specified on a case by case basis.,

3.4.1 The extent of University ownership in the property shall be zero percent of the resources used consistent with applicable law.

3.4.2 Within a five year period, the Academic Senate of the California State University Long Beach shall consider the conditions under which 3.4.1 shall be continued, modified, or nullified.

3.5 Repayment of University Expenses

When, in advance of the creation of the materials, the creator and the university have entered into a written contractual agreement indicating so, Creators of Intellectual Property, regardless of whether patented or not, which produce a taxable income, must repay the State of California for any expenses incurred by the University, including but not limited to expenses incurred in support of the research leading to the creation of the Intellectual Property, to obtain patent or similar protection, or in furtherance of production, marketing, or sales of products incorporating the Intellectual Property.

**4.0 PROCEDURE**

4.1 Administrative Responsibility

The President has ultimate authority for the stewardship of Intellectual Property owned by the University. The Provost or designee, in consultation with the University Intellectual Property Committee, shall administer this policy. This includes, but is not limited to, determination of ownership, assignment, protection, licensing, marketing, maintenance of records, oversight of allocation of any net revenue, approval of exceptions, and resolution of disputes.

Detailed operational procedures for the administration of this policy shall be prepared by the Associate Vice President for Office of Research and Sponsored Programs.

4.2 University Intellectual Property Committee

The University Intellectual Property Committee shall make recommendations to the Provost regarding procedures for the administration of this policy and such other matters as the Provost shall determine.

4.2.1 The charge of this committee may include but is not limited to recommendations to the Provost as to:

* Interpretation, implementation and proposal of changes to this policy;
* Review and evaluation of disclosures submitted under section 4.4 of this policy; and, for each disclosure, make a recommendation to the Provost regarding the University’s ownership interest in the Intellectual Property based on the Creator’s use of University resources;
* Where appropriate, regarding waiver of University ownership;
* Where appropriate, regarding whether patent or copyright protection should be sought by the University;
* The allocation of net revenue, if any, from Intellectual Property;
* Upon request by the Provost, review and comment on material transfer agreements;
* Upon request by the Provost, investigate alleged conflicts of interest and disputes between Creators and submit findings to the Provost; and
* requests for exceptions to this policy.

The charge of this committee shall include but is not limited to recommendations to the Provost as to:

* interpretation, implementation, and proposal of changes to this policy;
* review and evaluation of disclosures submitted under section 4.4 of this policy; and, for each disclosure, recommendation to the Provost regarding the University’s ownership interest in the Intellectual Property based on the Creator’s use of University resources;
* waiving University ownership where appropriate;
* decisions on whether patent or copyright protection should be sought by the University where appropriate;
* allocation of net revenue, if any, from Intellectual Property;
* review and comment on material transfer agreements (upon request by the Provost or the Creator(s));
* alleged conflicts of interest and disputes between Creators and submit findings to the Provost (upon request by the Provost or the Creator(s); and
* requests for exceptions to this policy.

4.2.2 Committee Membership shall consist of the following:

* Associate Vice President, Office of Research and Sponsored Programs, or designee
* Dean of the Library or designee (ex officio, non-voting);
* Director of Instructional Technology or designee (ex officio, non-voting); and,
* ~~Four~~ Six tenured faculty members elected by the Academic Senate, serving staggered two-year terms.
* One lecturer representative
* One student representative

4.3 Questions Related to University Ownership

In the event there is a question as to whether the University has a valid ownership interest in Intellectual Property, the Creator(s) shall disclose such Intellectual Property in writing to the University in accordance with Section 4.4 below. Such disclosure is without prejudice to the Creator's ownership claim. The University will provide the Creator with a statement as to the University's ownership interest consistent with sections 3.1.1, 3.1.2, and 3.4.1 of this policy.

4.4 Disclosure

The Creator of Intellectual Property shall promptly disclose to the Provost and the University Intellectual Property Committee the existence and nature of Intellectual Property when:

4.4.1 The Intellectual Property was developed using University resources ~~or funded or developed wholly, or in part, by the Creator during the course of normal University duties and activities;~~

4.4.2 The University has an ownership interest under the provisions of this policy;

4.4.3 The disclosure is required by law; or

4.4.4 The Intellectual Property was created as a result of federal government or external sponsor funded research.

The disclosure shall consist of a full and complete description of the discovery or creation and identify all persons participating in the creation of the property. The Creator(s) shall furnish such additional information and execute such documents from time to time as may be reasonably requested.

4.4 Disclosure

The Creator of Intellectual Property shall promptly disclose to the Provost and the University Intellectual Property Committee the existence and nature of Intellectual Property when:

4.4.1 the University has an ownership interest under the provisions of this policy;

4.4.2 the disclosure is required by law; or

4.4.3 the Intellectual Property was created as a result of federal government or external sponsor funded research.

The disclosure shall consist of a full and complete description of the discovery or creation and identify all persons participating in the creation of the property. The Creator(s) shall furnish such additional information and execute such documents from time to time as may be reasonably requested.

4.5 Statement by Creators

The Creators of University-owned Intellectual Property may be required to state that, to the best of their knowledge, the Intellectual Property does not infringe on any existing patent, copyright or other legal rights of third parties; that, if the work is not the original expression or creation of the Creators, the necessary permission for use has been obtained from the owner; and that the work contains no libelous material nor material that invades the privacy of others.

4.6 University Review

Upon receipt of a disclosure and statement by Creator(s), the Provost, in consultation with the Associate Vice President for Research and Sponsored Programs and with due consideration of the recommendations provided by the University Intellectual Property Committee, will make a determination as to the Creator(s)’ and the University’s interest in the Intellectual Property.

The Provost will inform principal Creators of material decisions regarding Intellectual Property which they have disclosed.

4.7 University Rights

The University may enter into agreements to license rights to use its Intellectual Property on an exclusive or non-exclusive basis, may release its rights to the sponsor of the research under which it was created (if contractually obligated to do so), may release it to the Creator(s) if permitted by law and current University policy, or may take such other actions considered to be in the University’s best interest. The licensee must demonstrate technical and business capability to commercialize the Intellectual Property. The license may include clear performance milestones with a provision for recapture of Intellectual Property if milestones are not achieved. The licensee may be required to assume the cost of statutory protection of the Intellectual Property.

The University is not obligated to protect the Intellectual Property rights through acts such as filing for patent protection, registering the copyright, or securing plant variety certification, but may do so at its discretion. All agreements regarding Intellectual Property in which the University owns an interest must be executed by the Provost or designee in consultation with the Intellectual Property Committee as stipulated in 4.2 above.

4.8 University's Acceptance of Intellectual Property

The University may accept assignment of Intellectual Property from other parties provided that such action is determined to be in the best interest of CSU. Intellectual Property so accepted shall be administered in a manner consistent with the administration of other University-owned Intellectual Property.

4.9 University Abandonment of Intellectual Property

Should the University decide to abandon development or protection of University-owned Intellectual Property, the University may assign its rights to the Creator(s), subject to the rights of sponsors and to the retention by the University of the right to use the Intellectual Property for University and educational purposes on a perpetual, royalty-free, non-exclusive basis. The University may retain more than the minimum license rights, and the assignment or license may be subject to additional terms and conditions, such as revenue sharing with the University or reimbursement of the costs of statutory protection, when justified by the circumstances of development.

Should the University decide to abandon development or protection of University-owned Intellectual Property, the University must first offer assignment of its rights to the Creator(s), subject to the rights of sponsors and to the retention by the University of the right to use the Intellectual Property for University and educational purposes. will then be negotiated with the Creator(s) and specified in a written agreement. Subject to this agreement, the University may retain more than the minimum license rights, and the assignment or license may be subject to additional terms and conditions, such as revenue sharing with the University or reimbursement of the costs of statutory protection, when justified by the circumstances of development.

**5.0 EXTERNAL SPONSOR FUNDING AGENCIES**

5.1 U.S. Government Funded Grants and Contracts

All Federal grants and contracts require disclosure of inventions and discoveries to the funding agency and convey a restricted right to use the invention or discovery to the U.S. government. The University must have written agreements with persons performing the research, requiring prompt disclosure of inventions and assignment of rights to any disclosed invention conceived or first actually reduced to practice in the performance of work funded in whole or in part by the federal government. To assure the University's ability to comply with obligations arising under federal laws or in other external sponsor agreements imposed by state, and other public grant and contract funding sponsors, University employees must, as a condition of funding, agree to assign inventions to the University or to the funding sponsor in conformance with the sponsor’s policy and execute documents necessary to establish the federal government's or other sponsor's rights.

5.2 Sponsored Research Agreement

5.2.1 Unless otherwise specified in the written sponsored research grant or agreement, the sponsored research agreement shall provide that all Intellectual Property developed as a result of the sponsored research shall belong to the University. The University may determine, on a case-by-case basis and only if allowed by law that it is in the University's best interest to assign ownership of resulting Intellectual Property to the sponsor when circumstances warrant such action.

5.2.2 In the event that the sponsor agrees to University ownership of Intellectual Property resulting from the sponsored research, the University may grant to sponsor an option to license the resulting Intellectual Property on terms to be negotiated, with the option to be exercised by the sponsor within a specified period following the disclosure to sponsor of the Intellectual Property. The specific terms of licenses and rights to commercial development shall be negotiated between the sponsor and the University at the time the option is executed by the sponsor and shall depend on the nature of the Intellectual Property and its application, the relative contributions of the University and the sponsor to the work, and the conditions deemed most likely to advance the commercial development and acceptance of the Intellectual Property.

5.2.3 In all cases where exclusive licensing is appropriate, such license agreements shall be executed apart from the sponsored research agreement and shall require diligent commercial development of the Intellectual Property by the licensee.

5.2.4 In all cases of Sponsored Research Agreements, the University must disclose all details of the agreement to the faculty working on the research.

5.3 Agreements by Sponsored Research Program Participants

University employees participating in a sponsored research project administered by the University or its research foundation and making significant use of University resources are governed by this policy unless an exception is approved in writing by the University. University employees who create intellectual property shall execute appropriate assignment or other documents required to determine ownership rights in accord with this policy.

5.4 Other External Sponsor Funded Grants and Contracts

Funding from external sponsors for research shall be used to conduct research that serves the educational mission of the University or extends the boundaries of knowledge.

In agreements between sponsors and the University covering work not of a predominately research nature in which the sponsoring firm bears a major portion of the cost, the Intellectual Property policy of the University shall apply.

**6.0 EXCEPTIONS TO POLICY**

Requests for exceptions to this policy may be made to the University Intellectual Property Committee. Recommendations for exceptions to the provisions of this policy shall be made by the University Intellectual Property Committee to the Provost or designee for final approval.

Requests for exceptions to this policy may be made to the University Intellectual Property Committee. Exceptions to the provisions of this policy shall be made by the University Intellectual Property Committee.

**7.0 COMPLIANCE**

Compliance with this policy is expected and works in conjunction with Senate Policy 00-07 (Policy on Faculty Professional Responsibility).