



INTELLECTUAL PROPERTY POLICY

History:

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California State University, East Bay (CSUEB) faculty, students, and staff shall observe all laws pertaining to intellectual property, including patents, copyrights, trademarks, and software and the protection of the same.

OWNERSHIP

Those who engage in scholarship and creative endeavors have specific privileges and responsibilities associated with the products of their efforts. Unless extraordinary university resources or support were used to develop the intellectual property, CSUEB shall observe the general principle that creations are the property of the creators and that the creators, whether faculty, staff, or students, have the right of ownership or final disposition of their intellectual property.

Each intellectual property scenario is unique, however, because of the varied circumstances surrounding creative endeavors, resources and support may take different forms. For example, the University facilitates creative activities among its faculty, staff, and students, makes its facilities and resources available for such purposes, and in some instances, ownership may be governed by contracts in which parties have made specific agreements. In addition, CSUEB and its faculty, staff, and students shall comply with intellectual property clauses in employment contracts established with bargaining units and with external granting agencies and observe CSU documents on intellectual property developed in consultation with faculty.

This policy addresses the most common areas of intellectual property.

COPYRIGHTS

It is the policy of CSUEB that all rights in copyright shall remain with the creator(s), whether faculty, students, or staff, (hereinafter referred to as “creators”) unless one of the following conditions applies.

- a. The material is prepared by specific contractual agreement in writing with the university or an external agency.

If the copyrightable material is prepared as a result of a specific contract/agreement between the creator(s) and the university, its auxiliaries or grantors, the contract will specify the product(s) expected, the terms of copyright ownership, and advance distribution of royalties. The University and the creators, will establish ownership terms

as part of the contract.

b. The University makes the enterprise possible through extraordinary support directly for that purpose.

If the copyrightable material is prepared with extra or special support by the University, the product is considered “substantially supported” by the institution because there is additional cost to the institution. That support includes costs which would not have been incurred by the institution otherwise. In those cases, the University and the creators will establish ownership terms as part of the arrangements for additional or special support at the time the support is requested.

c. The effort leading to copyrightable material is sponsored in whole or in part by a third party, but only as may be contractually required by the third party.

If obligations to third-party sponsors are incurred as part of the activity that generates copyrightable material, prior agreement regarding copyright ownership is essential and must be negotiated before that sponsorship is accepted by the University, its faculty, staff or students, and/or its auxiliaries.

The intellectual property terms are determined by the contract signed between the creators and the third party.

An employee’s obligations regarding teaching, scholarship, or creative work, or obligations related to sabbaticals, difference-in-pay, RSCA leave proposals, or other assigned time shall not be interpreted as a specific contract nor as extraordinary university support, unless specified in advance and in writing by all parties. In addition, materials customarily created within and for teaching assignments are not subject to university claim of copyright unless all parties agree in advance and in writing.

As stated in this policy, unless extraordinary university support and resources were used to develop the intellectual property, CSUEB shall observe the general principle that creations are the property of the creators and not works for hire and that the creators, whether faculty, staff, or students have the right of ownership or final disposition of their intellectual property.

In cases where the University retains ownership, the university name will be specified as follows: Copyright [year], California State University, East Bay. All rights reserved.

In cases of joint ownership, the specification will be as follows:

Copyright [year], California State University, East Bay and [name(s) of other owner(s)].

As a general principle, CSUEB advises individuals and organizations to clarify conditions and clauses prior to beginning work.

PATENTS

While in the majority of instances it may be determined that CSUEB faculty, staff, and students own the intellectual property resulting from their research and their scholarly and creative activity, there will be instances when the University has directly requested and directed the work or has provided

extraordinary resources and support that led to the development or discovery of the invention. The latter situations may warrant an alternative ownership, licensing agreement, or shared equity.

When a potentially patentable invention is conceived or first reduced to practice in whole or in part by members of the faculty, staff, or students of the University in the course of their University responsibilities or with extraordinary use of University resources and support, such potentially patentable inventions shall be disclosed on a timely basis to the University. All patents must be disclosed to the University using [the CSU East Bay Invention Disclosure form](#). As described within this policy, the IP Ad Hoc Advisory Committee will review the disclosure to provide a concurrence or recommendation of ownership, equity, or licensing provisions. Determinations and recommendations made by the IP Ad Hoc Advisory Committee shall be collaborative and designed to protect the interests of the inventor as well as the University.

Even when a determination is made that the University does not own intellectual property under this policy, if the University provides extraordinary resources and support toward the creation of intellectual properties, it enjoys an equity interest in the net proceeds derived from those properties. The University's equity interest is determined by the extent of use and the value of extraordinary resources and support. The amount of the University's equity interest in a particular intellectual property will be agreed upon before pursuing protection/commercialization. In no case, unless an agreement has been made that the patent is a work for hire for the university, will the University's share be greater than 50%. The specific percentage of equity interest that an individual creator/inventor will render to the University in such instances may be proposed by the inventor or by the University for review and concurrence by the IP Ad Hoc Advisory Committee.

It is understood that inventors have fundamental rights to direct and control their own research and to make decisions about their intellectual property (IP), including, but not limited to invention management, IP licensing, commercialization, dissemination, and public use. It is also understood, however, that inventors may choose to not retain their rights and instead may wish to transfer partial or whole patent ownership rights to CSUEB if they so choose, or they may wish to enter into agreements with CSUEB to use additional university support and resources in their invention or invention management endeavors. Requests by inventors for alternative ownership will be reviewed by the IP Ad Hoc Advisory Committee.

In reviewing invention disclosures, the ad hoc committee and subsequent appropriate administrators will consider the following guidance, which is separated by categories of faculty, staff, and student inventions.

Faculty have ownership of intellectual property resulting from their scholarly activities, but may share the right to ownership with the University. The University's equity interest is determined in accordance with the circumstances listed below.

The University shall own all intellectual property rights in works created by University staff in the course and scope of their employment.

Students enrolled at the University may create valuable intellectual property while fulfilling course requirements, in conjunction with University employment, and/or through the use of University resources. The ownership interests in such intellectual property depend on the particular circumstances surrounding the creation as shown below.

Faculty Inventions

- a. If the University provides extraordinary resources and support to the creation of intellectual property, then the faculty will own the intellectual property rights, but the University will be entitled to an equity interest in the profits derived from the commercialization of the intellectual property.
- b. If the University initiates a creative project, solicits voluntary faculty participation in the project, and provides funding for the project, possibly including compensation/release time for the faculty member, the University will own the intellectual property rights developed through the project unless the University agrees to shared ownership. A written document, signed by the faculty member prior to initiation of the project, will be executed to acknowledge the University's ownership, or sharing arrangement, and the faculty member's commitment to cooperate with the University, at the University's expense, to protect and commercialize the intellectual property. Should the parties agree, the University may opt to share with the faculty involved any profits that result from the intellectual property created on the project. Such agreement, and the details of profit-sharing arrangements, shall be recorded in a written document, signed by both parties, which shall supersede this policy to the extent that any provisions conflict.
- c. If the University or the CSUEB Foundation and an outside sponsor enter into an agreement to carry out research or other creative activities involving faculty, the faculty who participate in the project shall comply with the conditions of the agreement pertaining to the ownership, protection and licensing of intellectual property developed, and may be required to agree in writing that they will so comply. The intellectual property terms of such agreements, even when they deviate from the provisions of this policy, with the consent of the faculty involved and the appropriate dean(s), will be negotiated with the sponsor—by the Director of Procurement in the case of the CSUEB or with the Chief Research Officer/Institutional Official (AVP Office of Research and Sponsored Programs) in the case of the CSUEB Foundation. Such agreement(s) shall supersede this policy to the extent that any provisions conflict.

Staff Inventions

- a. The University has no equity interest in any proceeds derived from intellectual property that is created by staff without the use of University resources and support and that is developed outside the course and scope of employment. Staff persons are advised to notify the Chief Research Officer/Institutional Official about their external activities if they have concerns that the University might claim ownership interests in any intellectual property that results from those activities.
- b. The University, its Auxiliaries or grantors may employ or engage individuals under specific contractual terms that allocate intellectual property rights between the parties in a different manner than specified above.
- c. There may be occasions when University staff also serve as faculty for the University. Under these circumstances, written agreements should be entered into in advance of undertaking any research or creative activity to clarify whether the individual is acting in their staff or faculty capacity in carrying out the activity. Unresolved questions on ownership may be directed to the ad hoc committee and a recommendation regarding ownership rights will be made to the President. Such agreement(s) shall supersede this policy to the extent that any provisions conflict.

Student Inventions

Students must be careful to differentiate their own creative contributions from those of their faculty instructors and mentors. The following parameters apply.

- a. The student is not paid for the work that results in the creation and does not receive significant University resources or support for their work. In these circumstances, the student owns the intellectual property interests in the creation. This is true even if the intellectual property is created to fulfill course requirements or other academic requirements. Nonetheless, by enrolling at the University, the student grants the University a nonexclusive, royalty-free license to mark on, modify, publicize and retain the work as may be required by the faculty, department, the University, or the System. The University is not entitled to an equity share in any ownership profits, except in the circumstances covered below.
- b. The student is employed by the University and the creation falls within the scope of employment. In these circumstances, either the University or the supervising faculty owns the intellectual property, according to the same standards that apply to staff creations or faculty within this policy.
- c. The student receives extraordinary University resources and/or support that further the creation or development of the intellectual property. In these circumstances, the student owns the intellectual property, but the University retains an equity interest, using the same standards that govern faculty creations.
- d. If the student works on a sponsored project or under a special intellectual property agreement and the creation falls within the scope of that work, then the student is bound by the written agreements governing the allocation of intellectual property rights.
- e. The student is employed by an outside entity (not the University or its auxiliaries) and the creation falls within the scope of that employment. Under these circumstances, the student normally will be bound by a contract with the outside entity, including provisions intended to protect and allocate intellectual property rights, and the University will have no rights to the intellectual property developed. University resources may not be used unless a prior special intellectual property agreement is in place (see d. above).

TRADEMARKS

Creators wishing to trademark and license their work should consult the university's [Licensing Guidelines](#).

SOFTWARE

Software is unique in that it can be both patented and copyrighted. Copyrights protect the creative expression in a software program or its underlying code; however, newer versions and/or updates to the software are typically considered derivatives of the original.

All software is protected by copyright. Patents are usually not necessary for software to have commercial potential. However, some software may be patentable. If this is the case, then the software should be considered under the patent policy to disclose algorithms present in the software that are patentable and/or hold commercial value.

Absent a specific agreement to the contrary, the University favors the copyright and publication of source code as well as its underlying object code. This is in contrast with the common commercial practice that utilizes trade secrecy for source code in order to prevent the dissemination and discussion of any innovative ideas it reveals. As with the underlying algorithms that, if patented,

must be published so that they may be studied and discussed by other researchers, the University believes that source code should be published in a form that is amenable to research and will promote scientific progress. The object code is similarly subject to copyright.

ADMINISTRATION OF POLICY

The Office of the Provost and Vice President for Academic Affairs, or their designee, will administer the policy and will respond to queries regarding intellectual property issues, particularly as regards negotiations and income rights. When an invention disclosure form is received, an IP Ad Hoc Advisory Committee will review the form within three weeks. The committee will be made up of the following individuals or their designees.

- The Provost (chair)
- The Library Dean
- The Information Security Officer
- The Chief Information Officer
- The AVP of the Office of Research and Sponsored Programs
- The Academic Senate Chair and one member of the Executive Committee
- A student representative recommended by ASI

Disputes, including those involving the interpretation of “extraordinary resources,” will be reported to the Provost’s office and referred to the IP Ad Hoc Advisory Committee for review prior to a decision. Advice on legal issues will be sought from university counsel. Agreements between the University and creator(s) of intellectual property will receive final approval from the Office of the Provost and Vice President, Academic Affairs.

This policy shall be reviewed every five (5) years by the Committee on Research, the Academic Senate, and the Office of the Provost.

DEFINITIONS

Contract - A legally binding agreement involving two or more people or businesses (called parties) that sets forth what the parties will or will not do. See: <https://www.nolo.com/dictionary/contract-term.html>

Copyright - A bundle of exclusive rights granted to the author of a creative work that is fixed in a tangible medium of expression. These rights include the right to make copies, authorize others to make copies, make derivative works, sell and market the work, and perform the work. See: <https://www.nolo.com/dictionary/copyright-term.html>

Creator - One or more individuals, singly or as a group, who produce Intellectual Property.

Extraordinary resources and support - “Extraordinary resources and/or support” means, in the case of faculty, the resources of the University and its auxiliaries that would normally not be available to them or easily available to them outside the University, as well as resources that would not normally be available to most faculty at the University, including the hiring or use of attorneys to assist in the establishment of patents In the case of students, “extraordinary resources” means

resources that are not available to the majority of CSUEB students in the course of their programs of study.

Institutional support - Support provided by either California State University, East Bay and/or California State University, East Bay Foundation, Inc.

Intellectual property - Property that is created by the human mind. Intellectual property is typically protected by patent, copyright, trademark, and trade secret laws (jointly called intellectual property laws) See: <https://www.nolo.com/dictionary/intellectual-property-term.html>

Inventor - The person, or persons in United States patent law, who contribute to the claims of a patentable invention

License - A contractual relationship in which the owner of Intellectual Property grants permission for use of the Intellectual Property. See: <https://www.nolo.com/dictionary/license-term.html>

Owner - One who has legal title or right to something. See: <https://www.nolo.com/dictionary/owner-term.html>

Patent - A grant by the U.S. Patent and Trademark Office (USPTO) that allows the patent owner to maintain a monopoly for a limited period of time on the use and development of a new innovation. See: <https://www.nolo.com/dictionary/patent-term.html>

Trademark - A word, phrase, logo, graphic symbol, or other device that is used to identify the source of a product or service and to distinguish it from competitors. See: <https://www.nolo.com/dictionary/trademark-term.html>

The/the University - refers to California State University East Bay in this policy

Work for Hire: A work provided as a service based on a contractual relationship or a specific job assignment. Work for hire terms indicate ownership belonging to the contracting/hiring entity rather than the creator.

POLICY REVIEW

This policy will be reviewed every five (5) years or at more frequent intervals if needed.

The Frequently Asked Questions (FAQs) below are not part of the policy, but helpful information, which will be amended to meet changing conditions.

FAQs TO ACCOMPANY CSUEB POLICY ON INTELLECTUAL PROPERTY

(to be amended to meet changing conditions)

Where can I learn more about intellectual property?

Intellectual property encompasses copyright, patents, and trademarks. For faculty, students and staff, the primary focus is usually on copyright, but if you are an inventor or working with multimedia, patents may come into play. If you engage in technology transfer or some other commercialization of your creation, both patents and trademarks may be a consideration.

- See: https://www.law.cornell.edu/wex/intellectual_property
- See: <https://library.csueastbay.edu/copyright>

I've created something (e.g. book, article, paper, artwork, etc.) as part of my responsibilities at Cal State East Bay. Who owns my work?

In the United States, authors/creators own the work they created unless they agree to a “work for hire” arrangement prior to the creation of the work. The contract or agreement by which they work for hire determines the ownership of the creation. Often, as a condition of employment, works created as part of one’s job duties or assignment are owned by the person, institution, or company that hires the creator. In the case of CSUEB, employees should check their contracts or other written memoranda or agreements of understanding to determine the conditions of their hire. For example, the California Faculty Association contract includes a clause on Intellectual Property Rights. The CSU Employees Union contract contains no equivalent clause.

- See: <https://www.calfac.org/contract/#article-39>
(Collective Bargaining article on “Intellectual Property Rights”)

Should I register my copyright?

Your work is under your copyright the moment you create it. You do not need to register your work to retain copyright. However, your work does need to be registered if you want to take someone to court over a copyright issue. You can register your work on the U.S. Copyright Office’s website: <https://www.copyright.gov/>.

I'm thinking about putting my created work on the campus learning management system (LMS) or another university website. What does that do to my rights?

Posting your material on the campus LMS or any other campus website doesn’t transfer copyright to the institution. However, for scholarly articles in which the publication agreement was signed prior to May 19, 2021 (see Open Access Policy for more detailed information on this

policy), you may need to review your publishing agreement to confirm that you did not transfer your copyright to the publisher and whether you retained the right to publicly post it if you did transfer copyright.

What is a reasonable contract / publishing agreement for something that I've created?

Contracts vary by publisher and are generally negotiable before you sign them. Ultimately, you and the publisher have to agree to something to publish the work and you may need to make compromises. Regardless, make sure you understand the terms to which you are agreeing and make sure that you can live with them. There are few absolutes in the copyright world, but one of them is that *contracts take precedence over copyright*. Note that scholarly articles for which the publication agreement is signed on or after May 19, 2021 are protected by the Open Access Policy.

Additional resources to consult are listed below.

- See: National Writers Union; <http://www.nwu.org/>
(for freelance writers working in U.S. markets)
- See: American Society of Journalists and Authors; <http://www.asja.org/>
(for freelance writers writing books and articles)
- See: Text and Academic Authors Association; <http://www.taaonline.net/>
(check out their news pages)
- See: Music: Copyright law; <https://www.copyright.gov/engage/musicians/> (Music law, contracts and deals)
- See: Poets & Writers; https://www.pw.org/literary_agents
(list of agents)

What is open access and how does the CSUEB Open Access Policy apply to my publications?

Open access is the “free, immediate, online availability of research articles coupled with the rights to use these articles fully in the digital environment” ([SPARC](#)). Open access can be attained via two primary paths: publishing in an open access journal or retaining author’s copyright and posting a copy of the article to an institutional repository or subject repository. Some of the benefits of open access include greater visibility and retrievability of research; increased impact of scholarship; increased likelihood that results will be taken up, extended, applied, and cited; and increased readership outside the academy, including policy-makers, journalists, non-profits, the general public, *etc.*

The Academic Senate unanimously passed Cal State East Bay’s Open Access Policy on April 13, 2021 and it was made effective by signature of President Cathy A. Sandeen on May 19, 2021. This policy provides collective coverage for all CSUEB faculty members for scholarly articles for which the publication agreement was signed on or after May 19, 2021. By default, faculty retain their copyright unless they choose to opt-out of the policy on an article-by-article basis. Faculty then make their work open access by depositing it in an open access repository, such as CSU’s [ScholarWorks](#).

- See: Cal State East Bay's Open Access Policy; <https://library.csueastbay.edu/OA/Policy>

Who do I call for copyright advice?

If you need personal legal advice on a creative work, call an intellectual property lawyer.

If you need legal advice on a creative work as it relates to your CSUEB employment, the campus has access to a lawyer in the Chancellor's Office. Contact Academic Affairs for assistance.

If you need information about copyright or to discuss copyright options and your need does not require legal interpretation, contact the Library Administration Office at libadmin@csueastbay.edu.

If you need information about copyright as it relates to grants, contact the Office of Research and Sponsored Programs at orsp@csueastbay.edu.