
Patent and Copyright Procedures

The NJIT patent policy and copyright policy applies to all full-time and part-time faculty and staff, including visiting professors, and all other employees and students.

The University Patent Committee has established procedures to encourage the timely disclosure by investigators of their inventions to NJIT to enable the inventions to receive consideration for patent protection, to prevent premature disclosure or publications of such inventions that would possibly cut off potential patent rights, and to obtain additional funds to support research activity.

The following are important points inventors should consider.

1. Laboratory notebooks are necessary. Under U.S. patent law, the first to conceive and reduce to practice will receive a patent if the record bears out the claim. Entries should be made in ink in a bound notebook and should be signed and witnessed at the time they are made.
2. A disclosure form must be completed. It is important that the disclosure explain the benefit or use of the technology. If the invention can be illustrated with sketches, drawings or photographs, they should be provided. Copies of articles and reports pertaining to the invention are essential because they may impose a publication bar date on the inventor. Included with the invention disclosure should be copies of papers submitted for publication, theses, abstracts or oral presentations, reports to sponsors and reprints of articles.
3. Disclosure of a new discovery by prior publication can act as a bar to obtaining a valid patent. In order not to impede faculty and students from publishing, it is suggested that when all empirical data have been analyzed and when the first draft of the manuscript has been prepared, an invention disclosure should be submitted to the patent committee for its review and possible patent application.
4. A preliminary patent search is required to determine whether there is any "prior art." This is a technical term generally referring to publications by others before the date of the invention (or by the inventor more than one year prior to filing his/her application). This search can be done at the Robert W. Van Houten Library and the librarians will assist you.
5. The patent committee will review disclosures after the disclosure form and patent search has been completed. The inventor is invited to the committee meeting where a decision will be made regarding funding, patenting, etc.
6. In most cases, if the patent was developed under a government contract, title to inventions made in the course of government

sponsored research belongs to the university. The terms and conditions usually require that we provide the federal government with a non-exclusive, non-transferable, irrevocable, royalty-free license to use the inventions throughout the world. The agency must be informed in writing of the status of all inventions.

7. For governmental and unsponsored technology the following steps may be taken. The disclosure will be sent to one of several technology management firms. They will evaluate the disclosure with the inventor, conduct various marketing activities to identify and reach manufacturing firms, government funding agencies, and venture capital intermediaries and try to commercialize inventions.
8. For technology developed with funds received from industrial companies, negotiations on research funding and licensing for full-scale commercialization will be conducted.
9. Emphasis will be placed on obtaining research dollars to fund conceptual ideas which may lead to patentable inventions.
10. If specific details of an invention are to be discussed, the inventor should seek protection by first securing a confidential disclosure agreement from a responsible person at an industrial company who is seeking the information or from the Office of Intellectual Property.
11. Inventions, on which little immediate return is foreseen, are sometimes patented to protect the inventors' rights. In that case the office will secure the services of outside patent counsel to process the patent application.
12. A patent application consists of a summary of the invention, a discussion on prior art, claims that describe the boundary of the invention, drawings, declaration by the inventor that he/ she is the true inventor and filing fee.
13. Copyright is a form of protection to the authors of literary, dramatic, musical, artistic, and certain other intellectual works such as computer software programs. The copyright in the work of authorship becomes the property of the author who created it. In the case of works made for hire, the employer not the employee is considered the author.
14. To register a work, the properly completed application form, a \$20 fee and a copy or partial of the document to be copyrighted (depending upon the nature of the material) is sent to the Copyright Office, Library of Congress, Washington, D.C.
15. Since patenting costs can be substantial, the Office of Intellectual Property will seek funding from a variety of sources to cover these costs.

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16. In certain instances, NJIT may determine that it wishes to relinquish the rights to an invention or to a patent obtained thereon. This decision may, for example, be based on a lack of commercial success with the invention or patent. In such cases the ownership of the invention or patent may be relinquished and turned back to the inventor(s).
 17. Special situations will arise that are not specifically covered by this policy or which may justify waivers of this policy. Such cases, for example, charges of infringement made against NJIT, may be submitted to the President or his designee.

For information and assistance, contact the Office of Intellectual Property, ext. 5825.

Patent Policy

Objectives

The Patent Policies of New Jersey Institute of Technology (NJIT) have been established for the following purposes:

- A. To define the rights of individual inventors and NJIT in inventions and discoveries that may be made by the inventors during their affiliation with NJIT.
- B. To encourage timely disclosure by inventors of their inventions to NJIT to enable the inventions to receive consideration for patent protection, and to prevent premature disclosure or publication of such inventions that would possibly cut off potential patent rights.
- C. To coordinate and accommodate the pursuit of a patent policy by NJIT with the general academic objectives of encouraging the free exchange of information between academic personnel and universities.

This patent policy has been approved and adopted by the Board of Trustees on March 15, 1985.

University Patent Committee

The President of NJIT shall appoint a University Patent Committee. The Committee shall perform the following functions:

- A. The Committee will oversee the technical administration of the patent policy of NJIT as it relates to faculty, employees, fellows, students, associates and outside agencies.
- B. The Committee shall review invention disclosures and make recommendations to the President as to whether NJIT may have commercial interest in particular inventions.
- C. The Committee may seek the advice of people with specific expertise as to patent and related matters to assist in the performance of its function.
- D. The Committee shall consist of five (5) members, as follows:
 - (i) Permanent Members – The Vice President for Economic Development, University Counsel and the Director of the Office of Intellectual Property shall be permanent members of the University Patent Committee.
 - (ii) Rotating Members – Three (3) faculty members shall be chosen from different departments of NJIT to serve on a staggered basis for a term of three (3) calendar years.

The faculty members may be the department heads. The placement of the faculty members serving on the Committee on temporary membership status enables a rotation of personnel to offer to each of the departments of NJIT an opportunity for equal representation on the Committee.

Policy Guidelines

- A. The NJIT patent policy applies to all full-time and part-time faculty and staff, including visiting professors, and all other employees and students. Visiting professors must have a written agreement between their institution and NJIT concerning patent rights prior to receiving an NJIT appointment.
- B. All individuals employed, appointed, or otherwise in affiliation with NJIT are bound by this patent policy as a condition of their affiliation, by virtue of the adoption of this patent policy by the Board of Trustees of NJIT.

Those individuals who do not fall within these guidelines will be required to sign an AGREEMENT RELATING TO INTELLECTUAL AND INDUSTRIAL PROPERTY, defining the ownership and treatment of inventions and other creative developments, trade secrets and technical know-how considered confidential and secret in nature by NJIT which are disclosed to them upon commencement of their special affiliation with NJIT, or are developed pursuant to such affiliation. A sample form of AGREEMENT is included in Appendix A.

- C. NJIT has an interest in all inventions which are developed within the course of the employment of faculty and staff, or the term of matriculation of students, relating to ideas developed within the course of such employment or course study, or which are conceived as a result of university administered research programs (funded or unfunded), or other activities, involving the use of university time, facilities, materials or information.

For the purposes of this provision, "university time" shall mean that time devoted to normal and assigned functions in teaching, university service, direction and conduct of research on or off university premises, utilizing university facilities. The term "university facilities" shall mean any facility available to the inventor as a direct result of the inventor's affiliation with NJIT, and which would not be available to a non-affiliated individual on the same basis.

- D. The individuals affiliated with NJIT as defined in Paragraph III. B. above, who make an invention during their affiliation, shall disclose such invention to the Director of Intellectual Property.
 - (i) While the invention is being considered by NJIT for possible commercial interest, the inventor(s) shall not publish or otherwise disclose the invention to anyone other than the Director of Intellectual Property or the University Patent Committee.
 - (ii) In return, NJIT agrees within 1 month to conduct an evaluation of the invention and to act promptly to apply for patent protection, if appropriate, to enable the inventor(s) to publish or otherwise disclose the inventive subject matter in accordance with academic practices, pursuits and obligations.

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- (iii) In the event that a thesis is to be submitted covering the inventive subject matter, NJIT shall make an expedited review thereof. The timely submission of such thesis, however, shall take precedence over the evaluation and pursuit of patent protection on the inventive subject matter.
- (iv) The Director of Intellectual Property shall oversee developmental activity and assist inventors in the preparation of invention disclosures. The inventor may meet with the Director of Intellectual Property to make and prepare the formal disclosure of the invention. In all instances, a written disclosure form must be completed.
- E. Upon completion of the presentation of the disclosure of the invention to the Director of Intellectual Property, this information shall be forwarded to the University Patent Committee, which shall meet with the inventor to review and witness the invention disclosure.
- F. In the event that the invention is commercially viable and is successful, and results in the generation of income, this income shall be distributed between NJIT and the inventor(s).

For the purposes of this provision, "income" shall include royalty payments made pursuant to a licensing agreement, or periodic or lump sum payments made to NJIT for the sale of the entire right of ownership and use of the invention.

- (i) From the net profits received from the sale, license, etc. of the invention, the inventor(s) shall receive 35% thereof;
- (ii) NJIT shall receive the remainder of such net income.

The above distribution is employed in the situation where NJIT pursues the invention and is unaffiliated with any outside organization. In the instance where NJIT pursues an invention for which a patent is sought and obtained, and a technology transfer organization is enlisted to aid in the commercialization of the invention, the distribution of income will differ, depending upon the terms of the contract between NJIT and the technology transfer organization. It is the goal of the university that the distribution of income to the inventor shall be approximately the same percentage whether the invention is patented and commercialized through the efforts of a technology transfer organization or through the direct efforts of NJIT.

- G. Inventions Developed on Sponsored Research Projects: Inventions subject to the terms of governmental or privately sponsored research agreements are handled in accordance with the terms of those agreements, and normally become the property of the sponsoring agency or party. Sometimes such agreements provide that all rights and title to the invention belong to the sponsoring agency, which may at its discretion (a) apply for patents in the name of the

inventor at its expense, or (b) receive from NJIT a license to use the invention. In the second instance the license may be nonassignable, royalty-paying or royalty-free, non-exclusive or exclusive, for a limited period of time.

- (i) In order that NJIT fulfill its obligations to industrial and governmental sponsors of research, all faculty, staff and students who are to participate in such sponsored research will, if required by the sponsoring party, sign an invention and patent agreement. This agreement would require the disclosure of all inventions and discoveries for the sponsored research, and the assignment of all rights, title and interest in these inventions and discoveries to NJIT. In the instance where all rights belong to the sponsoring agency, NJIT would in turn assign its rights accordingly.
- (ii) Before a particular sponsored research project is accepted by NJIT, an assessment will be made as to the impact that the acceptance and participation in this project will have on the ability of NJIT to continue to fulfill its objectives as an academic institution. If it is then determined that the participation in a specific sponsored research project will unduly impair the ability of NJIT to fulfill its academic objectives, the project will not be accepted.
- (iii) In the event that the research project is accepted and that patentable inventions are developed, and further, that the governmental agency or private party agrees to relinquish its rights in any patents that issue therefrom, NJIT will assume full ownership of such patents and inventions, and the administration of such patents and inventions, including income distribution, which will be determined by the guidelines expressed above with regard to inventions held and pursued by NJIT on an independent basis.

H. Waiver of Ownership Rights in Invention: In certain instances, NJIT (or a governmental or private sponsor) may determine that it wishes to relinquish the rights to an invention or to a patent obtained thereon. This decision may, for example, be based on a lack of commercial success with the invention or patent. In such instance, the ownership of the invention or patent may be relinquished and turned back to the inventor(s), at the discretion of NJIT.

Before the ownership of the invention or patent is relinquished, NJIT shall consider the desirability of retaining any rights in the invention or patent, including the royalty-free right to use the inventive or patented subject matter, arising from its common law "shop rights." Even these "shop rights" may be relinquished by a formal Assignment if a decision to do so is made.

In the instance where the rights to the invention or patent are relinquished to the inventor(s), the inventor(s) shall make no use of the name of NJIT in any efforts to commercialize the invention, without first obtaining the written approval of the President of NJIT.

- I. Disputes: Disputes on patent matters shall be referred to the President or the President's designee for final resolution. The President may delegate authority to interpret, apply and administer this policy, including the resolution of disputes.
- J. Special Situations: NJIT recognizes that special situations will arise that are not specifically covered by this policy or which may justify waivers of this policy. Such cases may be submitted to the President or his designee. Examples of special situations falling within this paragraph are:
 - (a) infringement of patents owned by NJIT by third parties.
 - (b) charges of infringement made against NJIT.