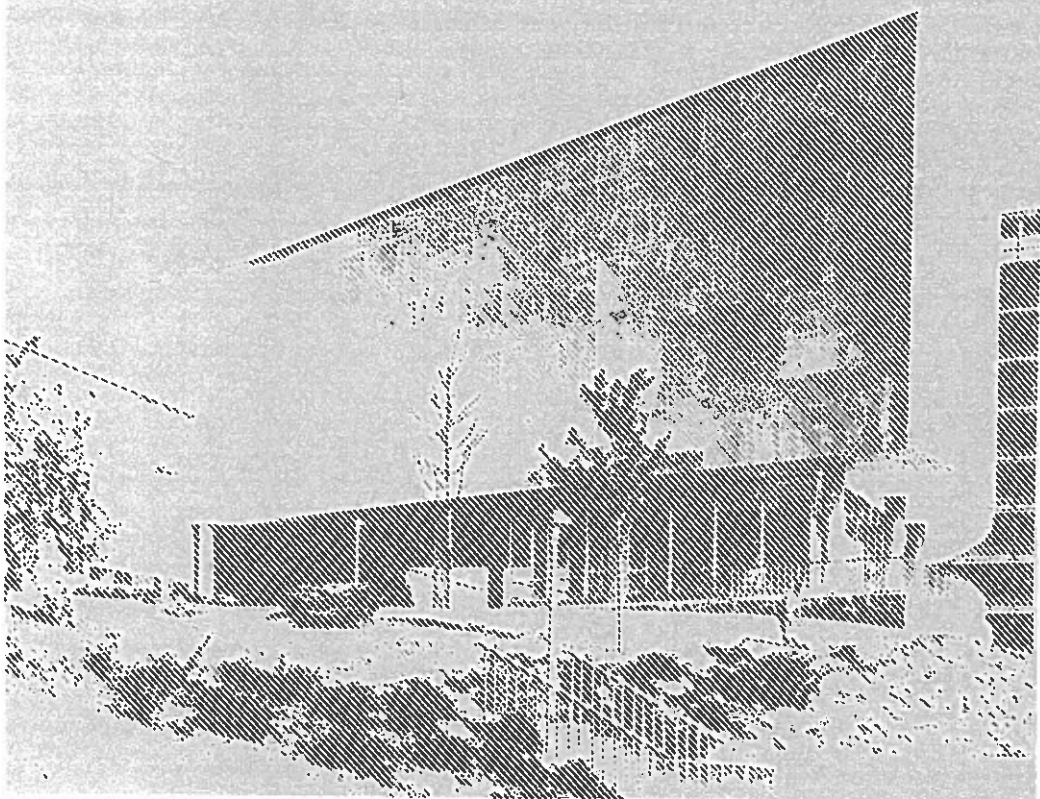


# PATENT POLICY

Albert Einstein College of Medicine  
of Yeshiva University





**THE ALBERT EINSTEIN COLLEGE OF MEDICINE  
OFFICIAL POLICY ON PATENTS**

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**THE ALBERT EINSTEIN COLLEGE OF MEDICINE  
OFFICIAL POLICY ON PATENTS\***

**I. General Policy**

The Albert Einstein College of Medicine of Yeshiva University (hereinafter sometimes referred to as the "College") is interested in research relating to the advancement of medical knowledge and in the publication and the use of the results of such research. It recognizes that the research conducted by its faculty, its technical staff and its students may lead to inventions and discoveries which should be patented for one of the following reasons:

- (1) to protect the public interest;
- (2) to comply with the requirements of research grants, fellowship awards and contracts for research;
- (3) to promote the development of useful apparatus and processes which would not be developed without patent protection;
- (4) to encourage invention and insure rewards for the inventors as herein provided; and
- (5) to support facilities and programs of the College of Medicine for research and education by means of its share of income derived from royalties paid for the use of inventions and patents.

The patent policy of the College is intended to be consistent with these principles and purposes.

**II. Management of Patents**

A. The College shall have the responsibility for the management of patents and may for this purpose employ another agency including the Research Corporation. The Committee on Patents, to be established under this policy (Section VII), shall consult with the inventor(s) who may recommend to the Committee the course of action to be taken in the filing and prosecution of the inventor's(s') patent application. This may include but is not limited to (a) patent management agency other than Research Corporation, (b) a qualified patent attorney or (c) the Yeshiva University Research Foundation.

B. Notwithstanding the terms of II. A, the inventor, at his or her sole discretion shall have the right and option to elect not to have another agency such as Research Corporation, file and prosecute the inventor's patent application. The inventor(s) may select a patent attorney to file and prosecute a patent application, provided that this selection is

\*Adopted by the Board of Overseers May 8, 1973.

approved by the College. This approval, in the opinion of the Patent Committee, shall not be unreasonably withheld.

- C. The College may seek agreements with another agency such as the Research Corporation, New York, New York, a non-profit foundation for the Advancement of Science, to serve as a patent management agent for the College and for members of its faculty, its technical staff and student body. Under the terms of the agreement, the agency shall be asked to handle the patent applications, patent management and commercial exploitation of such patentable inventions and discoveries as the College may offer or cause to be offered to the agency, as are acceptable to it under the terms of its charter, and as should, in its view, be patented either in the public interest or for the sake of revenue. The agreement shall specify that a percentage of all income from each patent so managed by the agency shall be paid to the inventor or inventors as provided in Section V and that the remaining income shall be shared by the College and the agency in such proportion as may be agreed upon, with the agency bearing all patent prosecution and management expenses from its share.
- D. The provisions relating to patents and patent royalties shall also apply to the commercial licensing and the royalties obtained therefrom for inventions which are not patented but which have commercial value or special technology or special art.

### III. Title to Patents

- A. Patent rights resulting from research carried on by faculty members, technical staff members or students in connection with projects supported entirely or partly by College resources shall be assigned to and controlled by the College, its agent and/or Research Corporation which shall pay to the inventor a fixed proportion of the gross financial returns from the sale or exploitation of such patents in accordance with the provisions of Section V. hereof.
- B. Research carried on by a student in fulfillment of course requirements or other requirements for a degree, including the preparation of a thesis or dissertation, shall be construed as making use of College resources and shall be subject to the provisions of Section A above.
- C. Patents resulting from inventions and discoveries made by members of the faculty, the technical staff or by students in connection with government-sponsored research contracts, grants, fellowships or other such arrangements, shall be

controlled by the terms of those arrangements. Faculty or staff members accepting government-sponsored research shall execute such agreements as will enable the College to meet its obligations to the sponsoring agencies.

- D. Since the College carries on research for the purposes of extending medical knowledge and educating students, it accepts research grants or contracts from non-government sources with these purposes primarily in view. If inventions result from such research grants or contracts the College and the inventor or inventors will handle these inventions in accordance with the terms of Section A above, unless the terms of the grant or contract pertaining to the above research are in conflict with Section A, in which case the terms of the grant or contract shall apply.
- E. An inventor may elect to dedicate his/her invention to the Public Domain providing that neither the inventor(s) nor his/her kin shall receive any financial benefit therefrom, subject to the following:
- (a) All co-inventors shall agree to this dedication.
  - (b) There is no conflict with the terms of a sponsoring grant or contract.
  - (c) In cases where the College has contributed its funds and facilities, the College voluntarily relinquishes all its rights to title in the patent.
  - (d) The costs of patenting are to be defrayed by funds obtained by the inventor(s), the inventor's(s') own funds, or voluntary contribution by the College.
  - (e) Prior approval of the Patent Committee is obtained.

If publication disclosing an invention is sufficient to place it in the Public Domain, no filing for a patent may be required. However, in some instances, to protect the public interest, it may be necessary to obtain a patent and non-exclusive, royalty-free licenses will be issued on the basis of said patent.

### IV. Licenses

Licenses for commercial development of patents shall be sought to ensure that useful inventions shall be made available in products or services beneficial to the public at reasonable prices. In cases involving substantial developmental expenditures by the licensee, or for other special reasons, an exclusive license may be given, subject to the terms of any applicable grant or contract. All such licensing agreements shall be executed by the appropriate office of the University.

## V. Use of Income from Patents

- A. If income is received from the sale or licensing of patent rights derived from contracts between a third party and the College, the College, its agents and/or any outside agencies will pay and reward the inventor within 90 days of receipt of the funds by the College in accordance with the provisions below.
- B. If income is received from patents growing out of contracts or support from governmental, charitable or other non-profit organizations, the College, its agents and/or any outside agency involved shall pay to the inventor(s) or his/her estate and/or heirs (1) Fifty percent (50%) of the first Three Thousand Dollars (\$3,000) of the gross income obtained under the patent; (2) Twenty-five percent (25%) of the gross income between Three Thousand Dollars (\$3,000) and Thirteen Thousand Dollars (\$13,000); and (3) Fifteen percent (15%) of the gross income in excess of Thirteen Thousand Dollars (\$13,000).
- C. If income is received from patents growing out of contracts with other organizations or from any other form of support, then the College, its agents and/or any outside agency involved shall pay to the inventor(s) or his/her estate and/or heirs, Fifty percent (50%) of the first \$3,000 of the gross income derived from the patent and Twenty-five percent (25%) of any gross income in excess of \$3,000.
- D. After payment of such sums to the inventor as described above from funds obtained from the patent and the costs of processing the patent, a percentage of the gross royalties will also be granted to the inventor to be spent on research and educational programs at the College. For inventions processed through an outside agency, these percentages shall be 7.5% for the first \$3,000 of gross royalties and 10% thereafter. For inventions not processed through an outside agency, the percentage shall be 20% of gross royalties. The determination of the nature of such expenditures shall be solely the prerogative of the inventor stipulated on an annual basis and approved by the College. In no case may this sum exceed \$100,000 per annum in direct costs. When an inventor leaves the employ of the College, he/she will continue to receive their share of the royalties and if living retain the right to designate the use of a portion of the royalties for special programs at the College as provided above. The expenditure of such funds shall be in accordance with the usual accountability governing other

Restricted Funds administered by the College. No overhead will be charged.

- E. The balance of all other sums received by the College shall be utilized by the College in support of its educational, research and clinical pursuits.

## VI. Publication

The right to publish the results of sponsored research where patents may be involved shall be subject to the following conditions:

- A. The College shall not bar or prohibit publication of disclosures and inventions on which patent applications have been filed consistent with grant or governmental requirements.
- B. An inventor has the obligation to file an invention disclosure statement with the College, and where appropriate or required by grant or contract, simultaneously with or prior to the submission of a paper for publication disclosing the invention. In order to obtain protection for foreign patent rights, which are lost upon publication or public disclosure prior to filing a patent application in the United States, the inventor shall disclose his invention to the College through its Patent Committee a minimum of one month in advance of printed or oral disclosure, so that an application for a patent may be filed before public disclosure.
- C. The College will, if requested, supply to a sponsor any proposed publication before publication.

## VII. Committee on Patents

A Committee on Patents shall be appointed by the Dean of the College and shall have the following responsibilities:

- A. To recommend to the College administration (1) which inventions should be processed in accordance with Section III-A, (2) which ones should be referred to an outside agency, (3) which ones should be returned to the inventor for his/her own disposition and (4) which ones should be processed in other ways. Recommendations shall be made within 90 days after an invention is brought to the Committee's notice.



- B. To determine, when necessary, whether a given invention by a faculty or technical staff member or a student resulted from research carried out in connection with a project supported entirely or largely by College Resources or whether it was a product of personal research.
- C. To make recommendations generally regarding proposals to patent, or proposals which may lead to patent of inventions or discoveries related to the health field.
- D. To make recommendations in regard to patent arrangements requested by non-government sources.
- E. To act in an advisory capacity with regard to patents assigned to the College.
- F. To resolve disputes arising on patent matters in accordance with this Patent Policy.

#### **VIII. Agreement with College**

A form of agreement with the College shall be signed and entered into by all faculty, students and staff acknowledging that such personnel have received and read a copy of this Official Policy on Patents and agree to abide thereby, and, further, that such personnel agree to disclose in writing promptly to the College any invention or discovery made by such personnel and to assign to the College the entire right, title and interest in and thereto of Patent Rights as defined in Paragraph III — Title to Patents — hereof.

#### **IX. Disclosure of Inventions to the College**

Faculty, staff and students are required to report to the Dean of the College and/or the Committee on Patents, all inventions related to their official duties as soon as possible after conception or first actual reduction to practice. Such reports, on standard forms, should be made sufficiently descriptive to permit the invention to be understood and evaluated. Additional information will be added as may be required by a granting or sponsoring agency. In cases of inventions resulting from work not supported by an outside agency, the inventor shall indicate his or her desire as to how application for a patent should be made.