



# ST. JOHN'S UNIVERSITY



## **INTELLECTUAL PROPERTY (IP)**

POLICY GUIDE - JULY 2014

Revised 09/2023

# INTRODUCTION

St. John's University is committed to the advancement of knowledge through research and innovative developments and recognizes that inventions and discoveries may benefit the public and be of commercial interest. The creation of intellectual property (IP) is complementary to the University's core objectives of teaching and learning, research and discovery, community engagement, and public service. As an institution of higher education and research, St. John's University has a duty to develop, support, and implement policies that create an environment for IP to be cultivated and transferred into practical use for the benefit of humanity.

Combined, the St. John's University IP policy has three central underlying features:

- Evaluate and protect IP in the interest of the inventor(s) and the University.
- Provide decisions and guidance towards the practical use of the IP created.
- Provide a clear framework for revenue sharing between St. John's University, the inventor(s) of the IP, and any third party.

The IP policy describes the protection, ownership, and commercialization of IP developed by faculty, staff, and students and by third parties that may collaborate and/or fund research leading to the creation of IP. If you believe you are in the process of, or have made, a discovery or invention that is both novel and inventive, you are required to disclose your invention to the St. John's University Disclosure Committee.

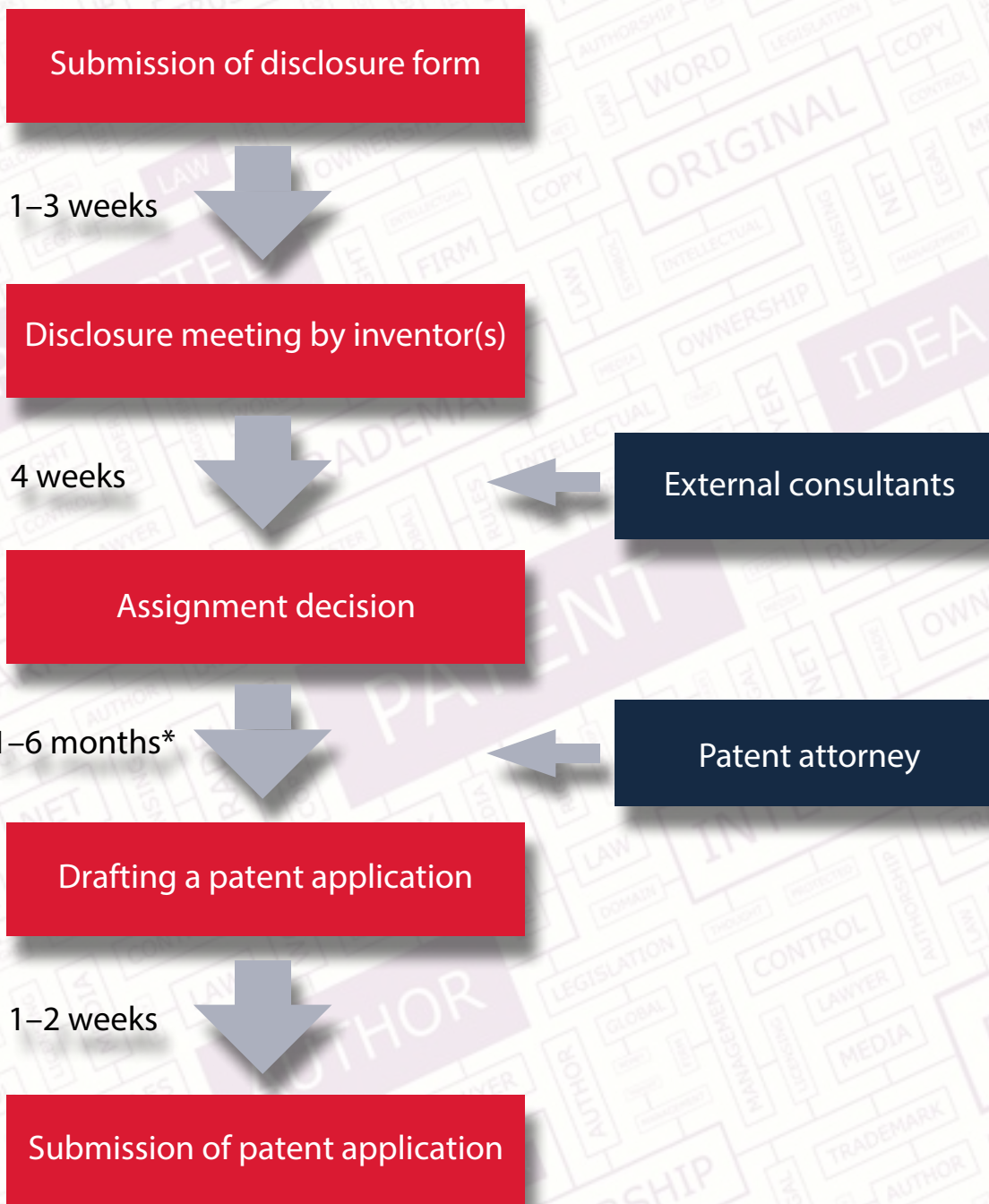
The IP policy is accessible to everyone and can be found at [stjohns.edu/intellectual-property](https://stjohns.edu/intellectual-property). As the IP policy represents an inescapably detailed document, we have created this IP Policy Guide to ensure that you have a general understanding of the policy and how it may affect you in relation to IP you develop, or in relation to IP created in collaboration with others.

We hope you find the *IP Policy Guide* useful and that you will refer to it when you require general guidance on the St. John's University IP policy.



**NEW PATENT APPLICATIONS**

# TIMELINE OVERVIEW



The time needed to draft a patent application varies and may take longer than six months.

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# WHAT IS INTELLECTUAL PROPERTY?

As a general term, IP represents any intellectual idea or products that are protected in law from unauthorized use by others. IP can be further divided into **background IP** and **foreground IP**.

**Background IP** represents IP that existed prior to the start of a project and that may be relevant to the project in question. Background IP may be owned by one or several collaborators or by individuals/institutions/companies not yet associated with the project.

**Foreground IP** represents the IP generated by the project in question and ownership is generally determined by the IP policy alone or in conjunction with a research contract or agreement.



## TYPES OF IP

### Patents

A patent protects an invention for products or processes. A patentable invention must be novel (not thought of before), inventive (not obvious to a person skilled in the art), and most commonly have one or several industrial applications. A patent is not automatic and has to be registered through the United States Patent and Trademark Office (USPTO). A patent gives its owner(s) exclusive rights to decide how or whether others can use the invention. Through the published patent document, the patent owner(s) makes technical information about the invention publicly available. Most patents are valid for up to 20 years, while design patents last 14 years.

### Software

Traditionally, software protection has been through copyright, although software patents are becoming more popular. Patenting is the method of choice for the effective protection of original computer programs, as a patent protects the creation of inventive concepts as well as their reduction to practice.

### Copyright

Copyright is used to describe the rights that creators have over their artistic and literary work. Copyright may cover works such as books, paintings, music, films, sculptures,

databases, computer programs, advertisements, and technical drawings. Copyright occurs automatically if a piece of work has been recorded in a permanent form.

### Trademarks

A trademark is a sign that distinguishes goods and services of one enterprise from those of other enterprises. Trademarks protect brands and generate value through a guarantee of origin and quality of products. Trademark rights are automatic or can be registered through the USPTO.

### Designs

A design constitutes the decorative or aesthetic aspect of an entity. A design may consist of three-dimensional or of two-dimensional features applied to an entity. Design rights may occur automatically or can be registered through the USPTO.

### Database Rights

Database rights protect data or a collection of work (research results, patient information, etc.) that has been systematically organized and that is accessible either through electronic or nonelectronic means. Database rights occur automatically.

# THE PATENTING PROCESS

A patent process, from initial idea to a patent being granted, represents a long and often expensive process. A patent process starts when an idea or invention is disclosed and discussed with a patent attorney. Next, a detailed patent search is usually conducted, followed by an assessment of your invention in terms of market validation and market assessment, i.e., whether a useful patent can be obtained.

The next step is then to file either a provisional patent application or a nonprovisional patent application. A provisional patent application, which is not examined by the patent office, is an attractive alternative, allowing the inventor to further refine the invention. A provisional patent application expires after one year and only establishes a filing date. A nonprovisional patent application establishes a filing date and the patent application will be examined by the USPTO. Once a nonprovisional patent application has been filed and examined, the prosecution process is initiated.

The examiner will issue a First Office Action on the Merit (FOAM), which will contain objections on novelty and inventiveness and detail potential issues with one or several claims in the application. The inventor (and the patent attorney) then files a response to the FOAM and normally, after several rounds of discussions, the patent application is either rejected or granted with modified claims.



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# IP OWNERSHIP

IP ownership is not straightforward. Often numerous individuals are involved in work that eventually leads to the generation of IP. The involvement in a piece of work that develops into IP does not necessarily mean automatic ownership. Legal rules relating to ownership are different for University employees as compared to nonemployees such as students, consultants, or collaborators.

As a University employee, you have a responsibility to ensure that any arrangements with others related to your IP are in accordance with the St. John's University IP policy.

## **Employees: Faculty, Staff, Administrators**

St. John's University has many obligations, one of which is to protect its assets. IP represents an asset and because of this, the University needs to have ownership of IP that it creates. All IP generated by you during your employment at the University belongs to St. John's University. IP also belongs to the University if you have created the invention on your own time but used University resources, including University funds, equipment, and material, other University employees, or even the use of the University name.

There is also another dimension to University IP ownership. Several individuals often generate IP and during a commercialization process, it is simpler if the University holds all IP. Potential clients also view IP held by one entity as being more attractive than having multiple owners. Having one owner (the University) also enables clients to have some degree of exclusivity, as the University would own all relevant IP.

Although the University owns IP generated by its employees, the inventors are generously rewarded through the St. John's University revenue sharing policy (please see IP policy document).

The University is in constant flux in terms of individuals starting their employment at the University or leaving the institution. An individual starting their employment at St. John's University may bring with them IP that was generated elsewhere. By contrast, employees leaving the University may have developed IP that have the potential to be "lost." Provisions for such situations are described in the St. John's IP policy.

## **Students**

As a student, you own any IP generated during your studies. However, if a student receives financial assistance in the form of a stipend or a graduate assistantship/doctoral fellowship from St. John's University, IP ownership is the same as for a University employee. In instances where students are financed through an outside entity, IP ownership should be stipulated in the contract between the student/University and the outside body. In some instances, the outside body will have ownership of IP generated by the student.

If a student generates IP through collaboration with a St. John's University employee (regardless of funding source) the IP will be owned by the University. The transfer of IP ownership to the University allows for a more streamlined process in terms of commercialization and any return to the University from the IP will be shared with the student(s) as for University employees, according to the St. John's University revenue sharing policy (Please see IP policy document).

If a student's IP is generated using University resources (equipment, materials, University funds, University name) outside of a student's course work, the IP must be transferred to the University.

## **Other Stakeholders**

In general, universities collaborate with a diverse range of individuals who are neither employees nor students. These may include visiting scholars, individuals employed by outside organizations, consultants, or individuals with honorary appointments. In such cases, it is important to ensure that an agreement is in place between the other stakeholder(s) and the University. The agreement should stipulate IP ownership and confidentiality issues.

In instances where an individual has a joint appointment between the University and an outside organization, IP ownership is determined based on where it is created.

If an individual is employed by St. John's University and generates IP within an outside organization (for example, as a consultant), the IP will generally be owned by St. John's University. In such cases, an agreement is needed to ensure that both parties are clear on IP ownership.

# THE POTENTIAL OF THE IP CREATED

IP only has value if it is correctly protected and if it can be put to practical or commercial use. The best ideas and inventions are only as good as the commercialization process that ultimately leads to economic value.

St. John's University encourages commercialization of IP as long as the project or contract does not go against its social, ethical, or mission-related values or in any circumstance unfavorably affects its reputation.

Commercialization of IP requires professional management and although financial rewards can be considerable, the process is often extensive. St. John's University, together with external consultants, evaluates and identifies potentially valuable IP with the ultimate aim of transferring IP to the marketplace. St. John's University has access to a wide industry network through both national and international consultants.

## DISCLOSURE

As stipulated in the St. John's University IP policy, all employees have to disclose any potential IP. The required disclosure documents are available at [stjohns.edu/intellectual-property](http://stjohns.edu/intellectual-property) and should be submitted after completion to **Director, Office of Grants and Sponsored Research**. Employees that are unsure whether an idea/invention is commercially viable should consult the IP checklist ([stjohns.edu/intellectual-property](http://stjohns.edu/intellectual-property)) and/or contact Director at [gsr@stjohns.edu](mailto:gsr@stjohns.edu) or 718-990-2920. The disclosure committee, together with relevant external consultants, will provide the inventor with an assessment decision within a month of the disclosure meeting.

In instances where IP is determined not to be of commercial value, an inventor may request in writing a release of the invention. Please see IP policy for further details at [stjohns.edu/intellectual-property](http://stjohns.edu/intellectual-property).

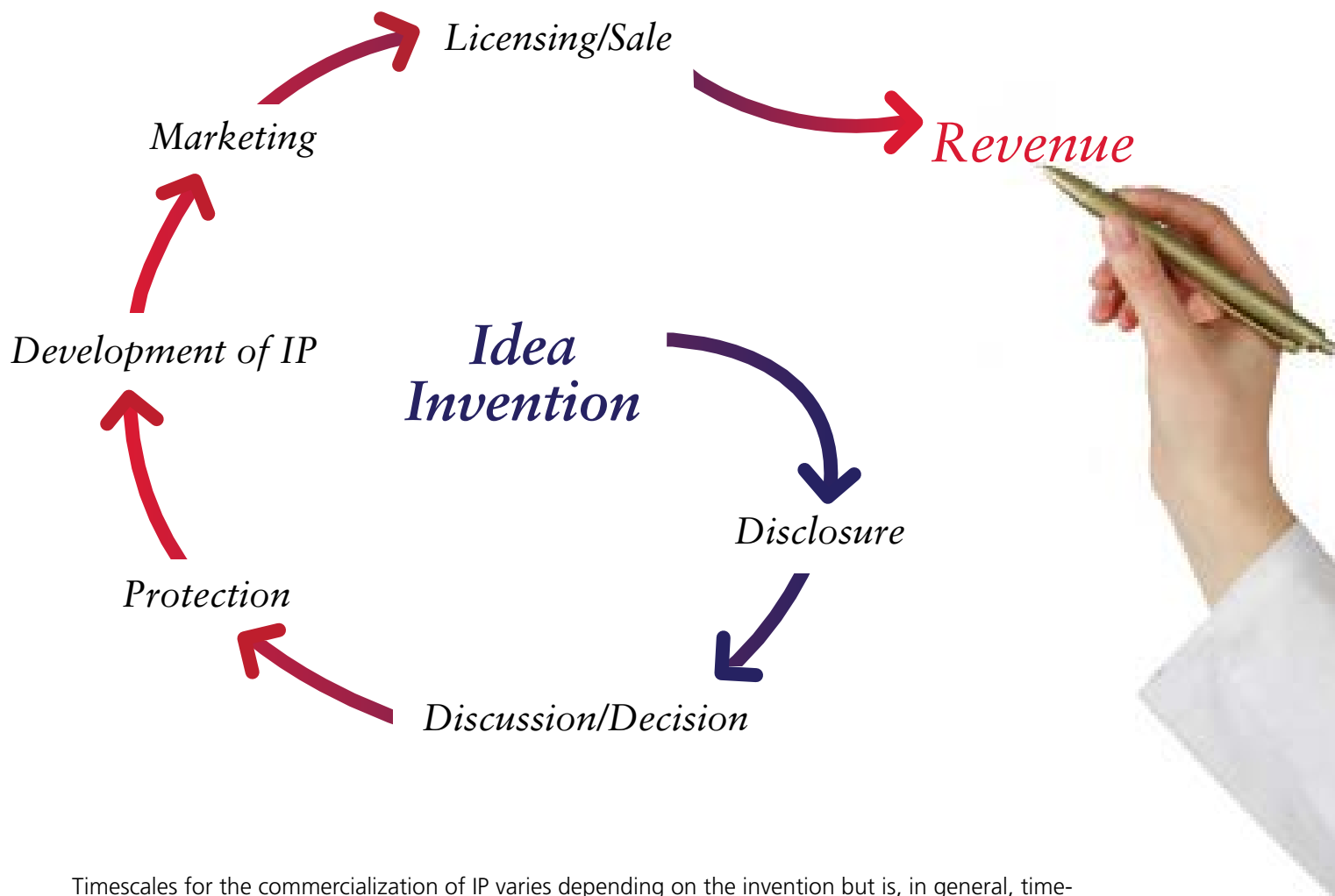
When IP has been disclosed and has been deemed to have potential value, St. John's University will ensure that it is protected through patenting or any other appropriate route.





# THE COMMERCIALIZATION PROCESS

The process for the successful commercializing of an idea/invention/product is usually long and complex. It generally involves extensive research on the markets for the IP in question, identification, and discussions with potential licensees and/or industrial collaborators; the development of a business plan, and ultimately negotiations regarding licensing and/or sale strategies. A schematic diagram of a general commercialization process is shown here.



Timescales for the commercialization of IP varies depending on the invention but is, in general, time-consuming and costly and requires significant input and work from the inventor(s). A successful commercialization process has several review points to ensure that the overall process is on track and that milestones are reached. The involvement of the inventor(s) is also crucial during the commercialization process, as the inventor(s) will be asked to provide additional information and will sometimes attend meetings with potential clients or investors.



# IP CHECKLIST

St. John's University is committed to the advancement of knowledge through research and innovative developments and recognizes that inventions and discoveries may benefit the public and be of commercial interest. The creation of intellectual property (IP) is complementary to the University's core objectives of teaching and learning, research and discovery, community engagement, and public service.

If you believe you are in the process of, or have made, a discovery or invention that is both novel and inventive, you are required to disclose your invention to the St. John's University Disclosure Committee. Further information can found at [stjohns.edu/intellectual-property](http://stjohns.edu/intellectual-property).

The following checklist has been created to assist you through the initial phases of the process. We hope you will find it useful.

## ***The patent process***

A patent process, from initial idea to a patent being granted, represents a long and often expensive process. A patent process starts when an idea or invention is disclosed and ends when a patent has been granted.

## ***From invention to practical use***

It is important to realize that the IP process does not end once a patent has been granted. The road from creating IP and getting a patent granted to commercialization of the invention can be very expensive and time-consuming, requiring extensive workloads from the inventor(s). However, the rewards can potentially be great.

## ***Publication and IP protections patenting***

Protecting research results through patenting and their publication in journals, books, or conference proceedings are not mutually exclusive. With proper planning, inventors can protect their discoveries and publish in the literature.

## ***General guidelines***

1. Create a secure and accurate paper trail of your idea/invention. Date every page in laboratory journals, notebooks, and on electronic documents. Do not erase notes, but place a solid line through notes that are no longer needed. Combined, this ensures that your timeline of events from conception of idea to patent filing can be traced during a due diligence process.

2. Do not disclose any information related to your idea/invention to anyone prior to filing of the patent. This includes family, friends, and colleagues. Information regarding your idea/invention can be disclosed if a nondisclosure agreement (NDA) is in place between the inventor/St. John's University and the individual/entity that you are disclosing to. However, it is advisable to not disclose any information before a patent has been filed.
3. For a patent application to be successful, you need to ensure (to the best of your ability) that your idea/invention is both novel and inventive. For an invention to be novel it must not have been created before. For an invention to be inventive it must not be obvious to a person skilled in the art. At times, the determination of inventiveness is not straightforward; however, a patent attorney will provide guidance prior to filing a patent application.

### ***Example of an invention that is **not** inventive***

An inventor wishes to file a patent application where the invention describes the use of very thin tires for automobiles. The patent claims that very thin tires have not been used before on automobiles (novelty). However, there is a lack of inventiveness, as for a person skilled in the art (for example an automobile company), this would be obvious.

### ***Example of an invention that is novel***

An inventor wishes to file a patent application where the invention describes the use of

# IP CHECKLIST

square tires for automobiles. The patent claims that square tires have not been used before on automobiles (novelty). The invention is also inventive because it is not obvious to a person skilled in the art to use square tires on automobiles.

4. Make sure that there is **no** prior art. Prior art is defined as any public information that describes (and hence discloses) parts or all of your invention. Although the University will assist you in identifying prior art, it is advisable that you as an inventor perform a preliminary prior art search. Any prior art will most probably be found during the search process once you have filed your patent. Prior art will void the novelty of your invention.
5. Perform a patent search to ensure that there are no prior patents in the public domain that would affect your patent application. An existing patent(s) may describe your invention or parts of your invention, in which case your invention may not be novel or you may need to limit your claims in your patent application. Although a detailed patent search is most often conducted by a consultant, you can perform your own initial patent search using Google [google.com/?tbs=pts](https://google.com/?tbs=pts) or USPTO [portal.uspto.gov/pair/PublicPair](https://portal.uspto.gov/pair/PublicPair). The University will assist you in performing a patent search.
6. Avoid patenting too early. In some cases (and sometimes it is avoidable), it is tempting to patent an invention soon after the idea has been created. This is not always an advantage and can sometimes be detrimental to the overall protection of your idea.  
**For example:** You file a patent describing a novel technology, but after the patent has been made public you discover that a small additional step in the process makes the entire technology much more viable and valuable in terms of commercialization. You now wish to file an additional patent that describes this small additional step. However, the patent examiner will most probably reject this second patent application because there is now prior art (your own original patent) that discloses the technology, meaning that your second patent lacks novelty.
7. The best ideas are not necessarily the most valuable ideas in terms of commercialization and revenue generation. As an inventor, you should examine, to the best of your ability, the market and industry space that relates to your invention. Web pages of potential competitors will provide some information on the industry and market space. You can also ask colleagues appropriate questions without disclosing any information regarding your invention.
8. If you have questions, contact **Director, Office of Grants and Sponsored Research**, to discuss your idea/invention/patent strategy (under an in-house NDA) prior to a formal disclosure meeting.

PATENT LICENCE AGREEMENT

entered into this \_\_\_\_\_ day of \_\_\_\_\_ (hereinafter "Recipient"), with

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09/2023