



Bowling Green State University

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BOWLING GREEN STATE UNIVERSITY  
PATENT POLICY & REGULATIONS OF BGSU

**PREAMBLE**

As a nonprofit educational institution devoted to teaching, research, and other scholarly activities in the public interest, Bowling Green State University encourages faculty, staff, and graduate students, as part of their assigned duties and scholarly activities, to conduct research which may result in useful inventions. The respective rights and obligations of the University, research sponsors, and inventors relative to inventions resulting from research at the University are defined by this policy.

(Passed by the Bowling Green State University Board of Trustees, March 13, 1987.)

## THE PATENT POLICY

1. Pursuant to Section 3345.14 of the Ohio Revised Code and as a condition of university employment, all right, title and interest in discoveries or inventions, including patents thereon resulting from any research or investigation conducted in whole or in part in any laboratory or facility of the Bowling Green State University, (hereinafter BGSU) shall be the sole and exclusive property of BGSU. Assignments or waivers of such rights, titles and interests may be made by Bowling Green State University to external sponsoring agencies or others, as provided in subsequent clauses of this policy.
2. Promptly upon the conception of a potentially patentable invention or discovery and before either filing for patent or reducing the invention or discovery to practice, the inventor shall disclose to BGSU such invention or discovery and shall assign, in writing, all rights to the invention or discovery to Bowling Green State University. Such disclosure shall contain a general description of the field of the invention or discovery, a specific disclosure of the invention or discovery, any prior art of which the inventor(s) is aware, a general statement (if possible) of the economics of the invention or discovery, a listing of the notebooks or other records containing the first description of the invention or discovery, the name of the person to whom the invention or discovery was first disclosed and the date of such disclosure. Such disclosure shall also contain an election as to the method for payment of patenting and/or licensing and related costs and schedule of distribution of net income received, as provided in subsequent clauses of this policy.
3. All information which may reasonably be related to inventions or discoveries shall be held confidential by the inventor and shall be disclosed only to BGSU or others directed by the Officers and agents of BGSU.
4. All information as described in paragraph 3 above shall be maintained in confidence unless such information is, or becomes, publicly available through no fault of the inventor or unless written permission is obtained from an authorized officer or agent of BGSU to disclose such information.
5. Whenever requested by BGSU, the inventor shall make, sign, execute and deliver all applications, assignments and other papers which, in the opinion of BGSU or its counsel, is deemed necessary, proper or desirable for obtaining Letters Patent of the United States and any other countries, and for transferring all such discoveries, inventions, improvements, patentable ideas, methods, processes, trade secrets and Letters Patent and applications therefore to BGSU, its successors and assigns.
6. An inventor must select a method for payment of costs to obtain patents and/or licenses and a related schedule for distribution of net income, for any such inventions or discoveries selected by BGSU for patenting and/or licensing. An inventor must choose at the time of disclosure of the discovery or invention whether to (a) pay all costs of obtaining patents and/or licenses or (b) request the University to pay all costs. If the inventor elects option (a), then net income from the invention or discovery will be shared by BGSU and the inventor(s) (or heirs or legatees of the inventor(s)) according to Schedule A below; if the inventor elects option (b), then net income from the invention or discovery will be shared by BGSU and the inventor(s) (or heirs or legatees of the inventor(s)) according to Schedule B below.

## Schedule A

All costs are paid by inventor(s) prior to distribution of income. No University funds may be used to pay costs.

Cumulative Net Income Category	Distribution between	
	<u>Inventor(s)</u>	<u>University</u>
Up to \$50,000	90%	10%
\$50,001 - \$100,000	75%	25%
\$100,001 or More	50%	50%

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## Schedule B

All costs are paid by BGSU prior to distribution of income.

Cumulative Net Income Category	Distribution between	
	<u>Inventor(s)</u>	<u>University</u>
Up to \$2,000	100%	0%
\$2,001 - \$50,000	50%	50%
\$50,001 - \$100,000	40%	60%
\$100,001 or more	25%	75%

7. Net income from any invention or discovery shall be earnings received by BGSU from the invention or discovery after payment of all costs incurred by the BGSU or the inventor(s) as applicable in connection with the invention or discovery and beginning at the moment of invention. Such costs shall include the cost of pursuing patent protection, developing the invention, marketing the invention and licensing the invention. If there is a plurality of joint inventors, that part of the net income accruing to the inventors will be distributed equally among the inventors unless some other distribution is specifically requested in writing by the inventors. If a plurality of institutions is involved in an invention, an agreement will be negotiated by the institutions in consultation with the inventors.

8. All income received pursuant to an invention or discovery shall be deposited in a separate University account from which shall be deducted an amount equal to the sum of all BGSU or inventor (whichever is applicable) costs paid or billed for obtaining a patent, license, or related activities. After such deductions have been made and distributed, net income distribution according to the elected schedule shall be made on an annual basis.

9. The President or designee shall appoint a Patent Advisory Committee consisting of three or more faculty members and two or more administrative staff of BGSU. Such Committee will:

a. Review all applicable inventions and discoveries and determine and advise in each individual case whether a discovery or invention resulted from research, investigation, or activity conducted in any laboratory or facility of BGSU and is the property of BGSU.

b. Determine and advise the President whether the discovery or invention which is the property of BGSU has a sufficient value or is of a sufficient interest to BGSU to warrant its retention; or, whether the same should be relinquished to the inventor or otherwise dealt with.

c. Advise the President about acquiring on behalf of BGSU, by agreement, on such terms and conditions as it deems appropriate, an interest in such patentable discoveries and inventions in those situations in which it shall have been determined that the discovery or invention does not otherwise belong to BGSU.

d. Determine and advise the President whether to pursue the patentability and development of a discovery or invention which is the property of BGSU.

e. Recommend to the President appropriate courses of action, including prospective purchasers or licensees of inventions or discoveries and to advise the President on the terms and conditions of any agreements.

10. The President of BGSU is hereby empowered and authorized, after receiving the advice of the Patent Advisory Committee, and after reporting to the Board of Trustees, to act on or reject the Patent Advisory Committee's determinations, and to sell, assign, convey, or grant on behalf of BGSU any such discoveries and inventions or any rights or shares in such discoveries and inventions, including patent rights, to such persons, firms, or governmental agencies for such consideration or upon such terms and conditions, including dedication to the public, as shall be deemed by him after consultation with the inventors to be in the proper and best interest of BGSU.

11. Within six months after disclosure of an invention, the President of BGSU shall: (a) Elect whether to apply for a United States patent and shall initiate the patent search; (b) Relinquish all rights to the invention to the inventor(s); or (c) Indicate how the invention shall be otherwise dealt with.

12. The President or designee is authorized by the Board of Trustees to make arrangements with external sponsors of research to obtain research funding from such sponsors. Such arrangements may include, but are not limited to, assigning all rights to inventions or discoveries to the sponsor, or granting an exclusive or non-exclusive license to the sponsor with or without royalties to be returned to BGSU. Any such agreement must be in writing and signed by an authorized officer or agent of BGSU. Such agreements will be in consultation with the investigator(s).

# BOWLING GREEN STATE UNIVERSITY

## Procedure and Regulations Governing Invention Disclosures to be Submitted to the Patent Advisory Committee

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### I. PURPOSE AND AUTHORITY

By regulations adopted by the Board of Trustees, the Patent Advisory Committee is charged with the responsibility for advising the President in carrying out the Patent Policy of Bowling Green State University (hereinafter BGSU). Pursuant to that goal, the Patent Advisory Committee has adopted the following procedure governing the disclosure and submission of inventions to the Patent Advisory Committee.

### II. BOWLING GREEN STATE UNIVERSITY'S RIGHTS IN CERTAIN INVENTIONS

As required by Ohio statute and as further defined in the PATENT POLICY & REGULATIONS of BGSU, any invention or discovery developed through the use of BGSU facilities is the property of BGSU. Bowling Green State University will develop legal protection and utilize such inventions which may benefit the public or BGSU. Under the PATENT POLICY & REGULATIONS, the net income received by BGSU on any invention or discovery will be shared with the inventor(s) according to options selected by the inventor(s) and approved by the President shown in Schedules A and B.

If BGSU determines that it has no interest in such inventions, it may assign or release all rights therein to the inventor or inventors. In order to protect the rights of both BGSU and the inventors, the prompt submission or disclosure of all such inventions or discoveries to the Patent Committee is necessary.

Certain research contracts with private industry and particularly with the federal government contain patent ownership clauses which may grant patent rights to or take patent rights from BGSU or its students, faculty and staff. The contracts should be evaluated for consistency with the PATENT POLICY & REGULATIONS of BGSU. Accordingly, the early submission of such contracts to the Patent Advisory Committee for its review and approval is necessary.

### III. THE PATENT ADVISORY COMMITTEE

#### A. DUTIES:

The Committee shall evaluate inventions submitted to it to determine:

(1) If the invention is such that BGSU has no rights there under. For example, the committee shall consider whether or not the invention was developed under a sponsored research contract in which the grantor is given all rights or whether or not the invention was made without using BGSU facilities.

(2) If the invention, as the property of BGSU, requires further legal protection and can be licensed or otherwise used to produce royalty or other income to BGSU and the inventors.

The inventor(s) shall ordinarily be given an opportunity to present all relevant information and recommendations to the Committee in writing or in person.

After making the above determinations, the Patent Advisory Committee shall make its recommendations to the President of BGSU. The President is empowered and authorized to act on or reject such determinations.

Through its Chair, the Patent Advisory Committee shall maintain liaison with the University Patent Counsel or other agents in making patentability searches, securing proper legal protection for the selected inventions and in obtaining the maximum benefit therefrom.

#### B. PROCEDURES:

Recognizing that time is of the essence in securing legal protection for inventions, the Patent Advisory Committee shall meet expeditiously as required to carry out its defined duties. In its evaluation of inventions pursuant to subparagraph A above, the Patent Advisory Committee shall normally communicate its decisions and recommendations in writing to the President of BGSU within three months of the receipt of the disclosure. The inventor(s) will be informed of the decision of BGSU with respect to the submitted invention within six months of the date of receipt of the disclosure.

#### C. LIAISON WITH ATTORNEYS AND PROSPECTIVE LICENSEES, ETC.:

The Office of the Associate Vice President for Research shall provide liaison among the inventor(s); Patent Advisory Committee; Legal or Patent Counsel; external sponsors of research; prospective licensees; developers, promoters and other persons having an interest in acquiring or developing rights in inventions or discoveries from BGSU. The Associate Vice President for Research shall convey significant matters to the Patent Advisory Committee for review, policy guidance, and recommendations to the President.

#### D. RECORDS, ETC.:

The Patent Advisory Committee shall keep appropriate records of all such submitted inventions, patent application, patents and agreements, etc., as is necessary to perform its functions.

### IV. THE INVENTOR'S RESPONSIBILITIES

#### A. SUBMISSION OF DISCLOSURES AND ASSIGNMENT OF EXCLUSIVE LICENSE:

Any faculty member, student or staff member who has made or participated in the conception of an invention or discovery using BGSU facilities shall submit to the Associate Vice President for Research, an Invention Disclosure Form completed to the fullest extent possible. At the same time, a copy of the completed Invention Disclosure Form shall be submitted, for informative purposes, to the head of the appropriate administrative unit (Department Chair, Program Director, Area Head, Supervisor, etc.). Use of the standard Invention Disclosure Form, attached hereto, is recommended to assure that the Patent Advisory Committee receives all necessary information. Additional drawings, photos, reports, etc., may be attached to the Invention Disclosure Form as necessary to complete the disclosure.

Because the completed Invention Disclosure Form may be the first complete written record of the invention, it should be signed and dated by the inventor(s) and by at least one witness who is competent to understand the invention.

B. At the same time that the Invention Disclosure Form is filed, the inventor shall assign all rights to the invention or discovery to Bowling Green State University and shall elect a patent expense payment and income distribution option as provided in Schedule A or Schedule B.

## Schedule A

All costs are to be paid by inventor(s) prior to distribution of income. No University funds may be used to pay costs.

<u>Cumulative Net Income Category</u>	<u>Distribution between</u>	
	<u>Inventor(s)</u>	<u>University</u>
Up to \$50,000	90%	10%
\$50,001 - \$100,000	75%	25%
\$100,001 or More	50%	50%

## Schedule B

All costs are paid by BGSU prior to distribution of income.

<u>Cumulative Net Income Category</u>	<u>Distribution between</u>	
	<u>Inventor(s)</u>	<u>University</u>
Up to \$ 2,000	100%	0%
\$ 2,001 - \$50,000	50%	50%
\$50,001 - \$100,000	40%	60%
\$100,001 or more	25%	70%

Each faculty member, student or staff member who participates in patent activities with business, industry, governmental agencies or individuals in conjunction with consulting, research or other professional activities (commensurate with BGSU personnel policies) must inform the Associate Vice President for Research when patent activities are initiated.

### C. COOPERATION WITH THE PATENT ADVISORY COMMITTEE:

Each inventor shall cooperate with the Patent Advisory Committee to the extent required to assist in evaluating the invention and to enable the Patent Advisory Committee to secure optimum legal protection on selected inventions.

### V. CAVEAT

Under the provision of the patent laws of the United States and the patent laws of many foreign countries, a published description (publication) or public use of an invention by the inventor or anyone else, if made more than one year prior to the official filing date of a patent application for that invention, will make the invention unpatentable and will cause the forfeit of all patent rights in the invention. In some foreign countries, patent rights are lost upon publication or public use of the invention at any time before the filing date of the patent application for the invention. A "publication" has been interpreted to include a typewritten thesis deposited in a library, oral presentations at professional meetings, etc. Accordingly, any questions regarding publication, public use or disclosure of an invention which may ultimately be considered for patent protection should be referred to the Patent Advisory Committee for its consideration and guidance.