Patent Review Board Charter

Pursuant to the State University of New York’s Patents, Inventions and Copyright Policy (8 NYCRR Part 335.28 and 335.29) (“IP Policy”), and the State University of New York Guidelines for the Management of Patents and Inventions (“Guidelines”), Intellectual Property[[1]](#footnote-1) created by staff of The Research Foundation for The State University of New York (“Foundation”), The State University of New York Polytechnic Institute (“SUNY Poly”) faculty, staff, and students, and certain other individuals, must be disclosed to Foundation. To facilitate the rapid transfer of such Intellectual Property into the marketplace for public use, Foundation, on behalf of SUNY Poly, has established the Patent Review Board (“Board”) to assess each new invention and to provide guidance to the Foundation Technology Transfer Office (“TTO”) and Operations Manager on such matters.

Although Intellectual Property disclosed to Foundation may have intellectual merit, available resources are limited and Foundation cannot pursue patent protection unless there is evidence of strong commercial potential or financial support from either a sponsor or licensee for the invention. Foundation must evaluate each invention to determine whether it can and should be protected with a patent and must provide the inventor(s) with the results of such an evaluation in a timely fashion, consistent with the IP Policy and sponsor requirements, if any. Additionally, a similar commercial and technology review may be performed on issued patents when issue fees or maintenance fees become due to determine whether or not Foundation should continue to make such payments and/or release the technology to the inventor(s).

To facilitate this process, the Board will undertake an assessment of Intellectual Property disclosed to Foundation and provide guidance to the TTO and Operations Manager on whether the underlying invention could be protected under U.S patent law, the potential for commercialization of the invention, and make recommendations for pursuing (i) a provisional patent, (ii) a non-provisional patent, (iii) improvements by inventor(s) for commercialization potential, or (iv) an offer to release the invention to the inventor(s).

# **Membership and Meetings**

## The Board will consist of no less than three (3) total voting members with representation, to the extent possible, from the nanoscience constellation, the nanobioscience constellation, and the nanoengineering constellation, and one ex-officio member from the TTO. Any member of the Office for Policy and Regulatory Affairs may serve as the ex-officio member from the TTO. One of the voting members shall be designated as the Chair of the Board by the TTO in consultation with the Operations Manager.

## Members of the Board shall be selected by the TTO as the result of consultation between the prospective Board member, the Operations Manager, and the TTO, taking into account the interest of individuals in serving, their availability to attend regular meetings, and the range of expertise needed on the Board. Members shall serve indeterminate terms and will serve without additional compensation.

## In the event that a member is unavailable, a member contributed to the invention to be assessed, a member otherwise has a conflict of interest, or the assessment of a particular invention requires expertise not then present on the Board, the Chair, in consultation with the TTO, shall identify one or more alternate members to serve as a voting member of the Board. In the case of an invention being assessed where a member contributed to the invention or otherwise has a conflict of interest, such member will be recused from review of the particular invention and any portion of the Board meeting involving such invention.

## The Board shall meet regularly, as required, dependent on the volume of technology disclosures and/or issued patent reviews. The Chair, in consultation with the TTO and the Board, may schedule additional meetings in the event that such meetings are necessary to address the number of inventions to be assessed by the Board. A quorum of the Board shall consist of two (2) voting members.

# **Review of New Disclosures and Determination Regarding Patent Prosecution**

## The TTO shall review each Technology Disclosure Form and Technology Assessment Form to determine whether the inventor(s) has been responsive to all elements of the forms. Completed versions of the Technology Disclosure Form and Technology Assessment Form (collectively, the “Forms”) for each new disclosed technology shall be forwarded to the Chair for preliminary review.

## The Chair will review each Form to identify the individual member(s) of the Board with appropriate expertise for additional review and forward the Forms to that Board member.

## The individual member of the Board shall review the invention and the information provided in the Forms and other materials. If a Form is found to lack sufficient detail for review, the Board member may contact the inventor(s) directly, with a copy to TTO, or request that the TTO solicit more information from the inventor(s).

## The individual Board member shall assess the invention based on his or her expertise. Such assessment may encompass an initial examination of prior art, other patentability issues, and commercialization potential. The individual Board member may complete the Patent Review Board Technology Review Form or Technology Assessment Score Card, as applicable, to assist in such assessment.

## Upon completion of the assessment by the individual Board member, he or she shall submit the Forms, his or her assessment of the invention, including the Patent Review Board Technology Review Form and Technology Assessment Score Card, as applicable, and any other materials the Board member considers relevant to the Chair for consideration by the Board.

## If the Board desires in connection with its consideration of the invention, the TTO will request that the inventor(s) prepare a short paper (three to five (3-5) pages) and a presentation to the Board (no more than five (5) slides) on the invention. The Chair or the TTO will inform the inventor(s) of the date of the meeting at which they will be scheduled to present the invention to the Board and request that the paper be submitted five (5) days before the meeting for distribution to the entire Board.

## Presentations by the inventor(s) at a meeting of the Board shall be followed by opportunity for questions from the members of the Board and for discussion of, as applicable to the particular review, the merits of the invention, the likelihood that it can receive patent protection, whether it can be developed into a practical product that can be commercialized, and financial support for the invention.

## After presentation to the Board by the inventor(s) or separate consideration by the Board (without an inventor presentation), and outside the presence of the inventor(s), the Board will discuss the invention and shall vote on whether to recommend that Foundation (i) proceed with the process of filing a provisional or non-provisional patent, (ii) seek further improvements by the inventor(s) for commercialization potential, or (iii) offer to release the invention to inventor(s) pursuant to subpart (f) of the IP Policy.

## TTO will provide the Board’s recommendation to the Operations Manager for decision. Once the Operations Manager makes their decision, TTO will inform the inventor(s) promptly, in writing, of the action Foundation intends to pursue with respect to the invention and will implement the decision of the Operation’s Manager.

# **Continued Review of Patent Portfolio**

## Approximately six (6) months, or as soon as reasonably practicable, before an issue fee or maintenance fee is due on a patent application or issued patent, the TTO shall review all records on file (including the original Forms) and review current funding sources, if any, for upcoming fees and related expenses. When determined by the TTO and the Operations Manager that a patent application or issued patent merits review by the Board, the TTO shall forward a summary update, the Forms, and any other relevant records (e.g., the patent application or issued patent) to the Chair for preliminary review.

## The Chair will review the summary, the Forms, and the other materials forwarded by the TTO to identify the individual member(s) of the Board with appropriate expertise for additional review and forward the materials to that Board member.

## The individual member of the Board shall review the invention and the information provided in the materials. If the Board member has any specific questions, the Board member may contact the inventor(s) directly, with a copy to TTO, or request that the TTO solicit more information from the inventor(s).

## The individual Board member shall assess the invention based on his or her expertise. Such assessment shall focus on any prior commercialization efforts, future commercialization potential, if any, and any other considerations as to value to Foundation of continued maintenance of the patent. The individual Board member may complete/update the Patent Review Board Technology Review Form and Technology Assessment Score Card, as applicable and determined necessary, to assist in such assessment.

## Upon completion of the assessment by the individual Board member, he or she shall submit the Forms, his or her assessment of the invention, including the Patent Review Board Technology Review Form and Technology Assessment Score Card, as applicable, and any other materials the Board member considers relevant to the Chair for consideration by the Board.

## If the Board desires in connection with its consideration of the invention, the TTO will request that the inventor(s) prepare a short paper (three to five (3-5) pages) and a presentation to the Board (no more than five (5) slides) on the invention. The Chair or the TTO will inform the inventor(s) of the date of the meeting at which they will be scheduled to present the invention to the Board and request that the paper be submitted five (5) days before the meeting for distribution to the entire Board.

## Presentations by the inventor(s) at a meeting of the Board shall be followed by opportunity for questions from the members of the Board and for discussion of, as applicable to the particular review, the merits of the invention, past efforts at commercialization, whether it can be developed into a practical product that can be commercialized, and financial support for the invention or continued maintenance fees, as the case may be.

## After presentation to the Board by the inventor(s) or separate consideration by the Board (without an inventor presentation), and outside the presence of the inventor(s), the Board will discuss the invention and shall vote on whether to recommend that Foundation (i) continue or discontinue payment of issue fees and/or maintenance fees on issued patents, or (ii) offer to release the invention to inventor(s) pursuant to subpart (f) of the IP Policy.

## TTO will provide the Board’s recommendation to the Operations Manager for decision. Once the Operations Manager makes their decision, TTO will inform the inventor(s) promptly, in writing, of the action Foundation intends to pursue with respect to the invention and will implement the decision of the Operation’s Manager.

1. “Intellectual Property” is defined in the IP Policy as “patentable Inventions, tangible research materials, computer software, and any unique or novel innovation in the technical arts or any new and useful improvements thereof, including methods or processes for creating an object or result (a way of doing or making things), machines, devices, products of manufacture, product designs, or composition, maskworks or layout designs for printed circuit boards or integrated circuits, compositions of matter, materials, any variety of plant, and any know-how essential to the practice or enablement of such innovations and improvements, whether or not patentable.” [↑](#footnote-ref-1)