

SUNY Upstate New Technology Disclosure (“NTD”) Procedure

2/9/2009

It is understood that SUNY Upstate scientists develop new ideas during the course of their research and that the scientist reports this new idea (“Invention”) on an existing form called the NTD to his/her Vice President for Research (“Vice President”), Dr. Steven R. Goodman.

The Vice President for Research will send a copy of NTD to the Research Foundation Central Technology Transfer Office (“TTO”).

1. TTO receives the NTD from the Vice President 's office.
 - The NTD is reviewed for completeness which includes ensuring that the scientist included his/her sponsorship information and RF SUNY award number in the correct fields on the NTD.
 - TTO and Vice President's office will work together to gather any missing information. Once both parties agree that the NTD is complete, the NTD will go through the formal TTO docketing process. Once the TTO receives an NTD it must be entered into the TTO docket in order to be in compliance with its federal, state, and contractual obligations. The followings are compliance issues that must be followed by TTO.
 - Federal Sponsorship: Any NTD with a government sponsor must be reported to the respective government agency within sixty (60) days.
 - Industry Sponsor: For any NTD with industry sponsorship, the sponsor agreement is reviewed for compliance obligations. This includes, but is not limited to, offering the technology to the sponsor for a period of time designated by the terms of the agreement to exclusively license the technology from RF SUNY.
 - Once the NTD is complete it will be forwarded back to SUNY Upstate for final approval by the Vice President.
2. NTDs reviewed by TTO will be submitted to the SUNY Upstate Institutional Patent Committee (“Committee”) by the Vice President for a scientific review of the technology/invention disclosed.
 - The Committee will consist of Upstate scientists, one of whom will serve as Chair, selected by the Vice President. A member of the TTO and the Vice President will serve as ex-officio members.
 - The Committee will meet and discuss the scientific merit of the Invention. Each inventor will have the chance to make a 3-5 minute presentation of his/her Invention to the committee.

3. The Committee will recommend which Inventions SUNY Upstate should consider supporting, should resources be available, to move forward with filing patent applications.

- The NTDs disclosing inventions that are not approved by Committee will be signed and the “no” box will be checked on the last page of the NTD. The original documents will be forwarded to the TTO for return to the sponsor or inventor. The Vice President’s signature on these NTDs will serve as a campus acknowledgement of receiving the document. The Vice President will clearly indicate to the TTO that the intention of SUNY Upstate is not to pursue patent protection for these NTDs.

4. Approval to continue consideration of any NTD will come from the Vice President, after receiving the Committee’s recommendation, by signing the last page of the NTD and checking the “yes” box. No NTD will receive any further action by the TTO without the signature of Vice President and checked “Yes” box.

5. The Vice President will forward originals of approved NTDs to the TTO.

- The TTO will send the information from these NTDs to an external law firm for an estimation of costs.
- The TTO will develop a high level patent prosecution strategy with projected costs for each disclosure.
- Estimates for the first phase of the patent application process will be forwarded to the Vice President along with the projected costs of prosecution/maintenance for the life of patent.

6. The Vice President will meet with the Upstate Chief Financial Officer (“CFO”) Steven Brady to discuss financing the patent strategy proposals.

- Based on the campus budget, the Vice President and CFO will decide which patent strategies will be supported.
- The Vice President will notify the TTO of Upstate’s decision.

7. A Request for Authorizations (RFAs) will be forwarded, by the TTO, to the Vice President for approval of the first phase of the patent prosecution costs.

8. Based on the patent prosecution strategy, selected by Upstate Medical University, the TTO will work with its patent counsel to stay on course. Depending on the patent protection strategy selected the campus should expect to receive new RFAs for estimates and bill payments regarding any USPTO or any international patent office action item that needs to be attended to in order to maintain the prosecution strategy that was earlier selected by campus. Before moving forward with any patent action item the TTO must receive approval from the Vice President by signing the RFA.