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2011-2012 Regular Sessions

I N   A S S E M B L Y

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Introduced by M. of A. MORELLE, DESTITO, LUPARDO, MAGNARELLI -- Multi-Sponsored by -- M. of A. BOYLAND, CANESTRARI, GOTTFRIED, HEASTIE, LAVINE, V. LOPEZ, ROBINSON, SWEENEY -- read once and referred to the Committee on Economic Development

AN ACT to amend the public authorities law, in relation to creating the intellectual property asset management advisory council; and providing for the repeal of such provisions upon expiration thereof

THE PEOPLE OF THE STATE OF NEW YORK, REPRESENTED IN SENATE AND ASSEMBLY, DO ENACT AS FOLLOWS:

1     Section 1.     Legislative intent. The legislature finds and declares  
2     that the intellectual property generated by state-funded research  
3     represents a great opportunity to return social and economic value to  
4     the New York taxpayer in return for public investment in research. It is  
5     further found and declared that the public interest in research outcomes  
6     needs to be protected both by the state and by the beneficiaries of such  
7     awards, including research bodies who are the grant recipients. It is  
8     further found and declared that the dissemination, application and  
9     utilization of the results of research grants can play a significant  
10    role in the development of new consumer and industrial products, of new  
11    industrial processes, and in the enhancement of the productivity and  
12    competitiveness of business involved in the production of existing  
13    products. The legislature further finds that the state needs to manage  
14    its intellectual property effectively so that it is best utilized for  
15    the benefit of the state, the taxpayers, and the private sector. It is  
16    further found and declared that state agency and public authority poli-  
17    cies should be appropriately formed and upheld in practice to ensure all  
18    participants in research and in commercialization of research discover-  
19    ies understand their obligations and responsibilities. Therefore, the  
20    legislature hereby declares the creation of the New York state intellec-  
21    tual property asset management advisory council.

EXPLANATION--Matter in *ITALICS* (underscored) is new; matter in brackets  
[ ] is old law to be omitted.

LBD04990-01-1

1 S 2. The public authorities law is amended by adding a new section  
2 3154-a to read as follows:

3 S 3154-A. INTELLECTUAL PROPERTY ASSET MANAGEMENT ADVISORY COUNCIL. 1.  
4 DEFINITIONS. AS USED IN THIS SECTION, THE FOLLOWING TERMS SHALL HAVE THE  
5 FOLLOWING MEANINGS UNLESS OTHERWISE SPECIFIED:

6 (A) "PATENTABLE INVENTIONS" SHALL MEAN INVENTIONS THAT FALL WITHIN THE  
7 SCOPE OF PATENTABLE SUBJECT MATTER UNDER THE LAWS OF THE UNITED STATES  
8 BUT ARE NOT YET THE SUBJECT OF AN ISSUED PATENT.

9 (B) "PATENTED INVENTIONS" SHALL MEAN THOSE RIGHTS REFLECTED IN  
10 SUBSISTING PATENTS ISSUED BY ANY GOVERNMENT, INCLUDING THE UNITED  
11 STATES.

12 (C) "STATE-OWNED INTELLECTUAL PROPERTY RIGHTS" SHALL MEAN ANY AND ALL  
13 INTELLECTUAL PROPERTY THAT IS OWNED BY THE STATE, INCLUDING ALL TRADE-  
14 MARKS AND SERVICE MARKS, COLLECTIVE MARKS AND CERTIFICATION MARKS, ALL  
15 COPYRIGHTS, ALL TRADE SECRETS, ALL PATENTABLE INVENTIONS, AND ALL  
16 PATENTED INVENTIONS.

17 2. THERE IS HEREBY CREATED THE INTELLECTUAL PROPERTY ASSET MANAGEMENT  
18 ADVISORY COUNCIL TO DEVELOP RECOMMENDATIONS TO THE BOARD ON HOW THE  
19 STATE SHOULD TREAT STATE-OWNED INTELLECTUAL PROPERTY CREATED UNDER STATE  
20 CONTRACTS, GRANTS AND AGREEMENTS. THE ADVISORY COUNCIL SHALL CONSIST OF  
21 ELEVEN MEMBERS AS FOLLOWS: ONE SHALL BE THE COMMISSIONER OF ECONOMIC  
22 DEVELOPMENT; ONE SHALL BE THE PRESIDENT OF THE NEW YORK STATE ENERGY  
23 RESEARCH AND DEVELOPMENT AUTHORITY; ONE SHALL BE A TRUSTEE OF THE STATE  
24 UNIVERSITY OF NEW YORK; ONE SHALL BE A TRUSTEE OF THE CITY UNIVERSITY OF  
25 NEW YORK; ONE SHALL BE A MEMBER OF THE BOARD OF GOVERNORS OF THE COMMIS-  
26 SION ON INDEPENDENT COLLEGES AND UNIVERSITIES; AND SEVEN SHALL BE  
27 MEMBERS OF THE PUBLIC WITH THREE APPOINTED BY THE GOVERNOR WITH THE  
28 ADVICE AND CONSENT OF THE SENATE, WITH TWO APPOINTED BY THE SPEAKER OF  
29 THE ASSEMBLY, AND WITH TWO APPOINTED BY THE TEMPORARY PRESIDENT OF THE  
30 SENATE. THE SEVEN PUBLIC MEMBERS SHALL BE INDIVIDUALS WITH OUTSTANDING  
31 KNOWLEDGE AND LEADERSHIP IN ONE OF THE FOLLOWING FIELDS: HIGH-RISK  
32 VENTURE INVESTMENTS IN NEW SCIENTIFIC OR TECHNOLOGICAL BUSINESSES OR NEW  
33 SCIENTIFIC OR TECHNOLOGICAL PRODUCT DEVELOPMENT; PROFESSIONAL AND BUSI-  
34 NESS SERVICES WITH MORE THAN TEN YEARS OF EXPERIENCE IN THE LICENSING OF  
35 INTELLECTUAL PROPERTY; PATENT, TRADEMARK, COPYRIGHT, AND TRADE SECRETS  
36 LAW OF THE UNITED STATES; INTERNATIONAL PATENT LAW INCLUDING PATENT  
37 COOPERATION TREATIES; OR UNIVERSITY TECHNOLOGY TRANSFER AND COMMERCIALI-  
38 ZATION. THE GOVERNOR SHALL APPOINT A CHAIRPERSON FROM AMONG THE MEMBERS  
39 OF THE ADVISORY COUNCIL.

40 3. ALL MEMBERS OF THE ADVISORY COUNCIL SHALL SERVE FOR A TWO-YEAR  
41 TERM OR UNTIL SUCH TIME AS THE ADVISORY COUNCIL HAS COMPLETED ITS RECOM-  
42 MENDATIONS TO THE BOARD.

43 4. THE MEMBERS OF THE ADVISORY COUNCIL SHALL RECEIVE NO COMPENSATION  
44 FOR THEIR SERVICES, BUT SHALL BE REIMBURSED FOR THE ACTUAL AND NECESSARY  
45 EXPENSES INCURRED BY THEM IN THE PERFORMANCE OF THEIR DUTIES UNDER THIS  
46 ARTICLE.

47 5. NOTWITHSTANDING ANY INCONSISTENT PROVISION OF LAW, ORDINANCE,  
48 RESOLUTION OR CHARTER, NO OFFICER, MEMBER OR EMPLOYEE OF THE STATE OR OF  
49 ANY PUBLIC CORPORATION SHALL FORFEIT HIS OR HER OFFICE OR EMPLOYMENT BY  
50 REASON OF HIS OR HER ACCEPTANCE OF APPOINTMENT AS A MEMBER OF THE ADVI-  
51 SORY COUNCIL, NOR SHALL SERVICE ON SUCH ADVISORY COUNCIL BE DEEMED  
52 INCOMPATIBLE OR IN CONFLICT WITH SUCH OFFICE OR EMPLOYMENT.

53 6. THE ADVISORY COUNCIL SHALL MEET REGULARLY AND AT LEAST FOUR TIMES  
54 PER YEAR. SPECIAL MEETINGS MAY BE CALLED BY THE CHAIRPERSON OF THE ADVI-  
55 SORY COUNCIL AND SHALL BE CALLED BY HIM OR HER AT THE REQUEST OF THE  
56 EXECUTIVE DIRECTOR OF THE FOUNDATION.

1 7. THE ADVISORY COUNCIL SHALL SUBMIT ITS RECOMMENDATIONS IN WRITING TO  
2 THE BOARD WITHIN TWO YEARS AFTER THE FIRST MEETING OF ALL ELEVEN  
3 MEMBERS. THE ADVISORY COUNCIL'S RECOMMENDATIONS SHALL INCLUDE, BUT NOT  
4 BE LIMITED TO, THE FOLLOWING:

5 (A) WHETHER ALL, NONE OR SOME OF THE RIGHTS ARISING OUT OF THE  
6 CREATION OF INTELLECTUAL PROPERTY SHOULD BE DEDICATED TO THE PUBLIC  
7 DOMAIN.

8 (B) HOW THE STATE SHOULD MAXIMIZE THE PROTECTION OF INTELLECTUAL PROP-  
9 ERTY THAT IT OWNS.

10 (C) HOW STATE EMPLOYEES AND OFFICIALS SHOULD BE MADE AWARE OF THE  
11 OBLIGATIONS, RESTRICTIONS, REQUIREMENTS AND OPPORTUNITIES REGARDING THE  
12 PROTECTION AND MANAGEMENT OF STATE-OWNED INTELLECTUAL PROPERTY.

13 (D) HOW STATE EMPLOYEES AND OFFICIALS SHOULD BE INFORMED ON DISCLOSURE  
14 AND WHETHER A UNIFORM SYSTEM OF DISCLOSURE SHOULD BE DEVELOPED AND  
15 IMPLEMENTED.

16 (E) WHAT ACTIONS ARE BEING TAKEN BY STATE AGENCIES, AUTHORITIES,  
17 DEPARTMENTS, BOARDS AND COMMISSIONS TO MANAGE STATE-OWNED INTELLECTUAL  
18 PROPERTY.

19 (F) HOW OWNERSHIP RIGHTS SHOULD BE DETERMINED WHEN INTELLECTUAL PROP-  
20 ERTY IS CREATED BY STATE EMPLOYEES IN THE COURSE OF THEIR STATE EMPLOY-  
21 MENT.

22 8. BASED ON THE RECOMMENDATIONS OF THE ADVISORY COUNCIL, THE BOARD  
23 SHALL SUBMIT A REPORT TO THE GOVERNOR, THE SPEAKER OF THE ASSEMBLY AND  
24 THE TEMPORARY PRESIDENT OF THE SENATE PROVIDING GUIDANCE ON HOW TO:

25 (A) PROMOTE THE UTILIZATION OF INTELLECTUAL PROPERTY ARISING FROM  
26 STATE-SUPPORTED CONTRACTS, GRANTS AND AGREEMENTS.

27 (B) ENCOURAGE MAXIMUM PARTICIPATION OF SMALL-BUSINESS FIRMS IN LICENS-  
28 ING STATE-OWNED INTELLECTUAL PROPERTY.

29 (C) PROMOTE COLLABORATION BETWEEN COMMERCIAL CONCERNS AND STATE ENTI-  
30 TIES IN COMMERCIALIZING STATE-OWNED INTELLECTUAL PROPERTY.

31 (D) ENSURE THAT THERE ARE MECHANISMS IN PLACE THAT ALLOW THE STATE TO  
32 OBTAIN CERTAIN MINIMAL RIGHTS IN STATE-SUPPORTED INTELLECTUAL PROPERTY  
33 TO MEET THE NEEDS OF THE STATE AND PROTECT THE PUBLIC AGAINST NONUSE OR  
34 UNREASONABLE USE OF SUCH INTELLECTUAL PROPERTY.

35 S 3. This act shall take effect on the one hundred twentieth day after  
36 it shall have become a law; provided, however, that effective immediate-  
37 ly, the addition, amendment and/or repeal of any rule or regulation  
38 necessary for the implementation of this act on its effective date are  
39 authorized and directed to be made and completed on or before such date;  
40 provided, further, that this act shall remain in effect until one  
41 hundred twenty days after the New York state foundation for science,  
42 technology and innovation board submits the report required by subdivi-  
43 sion 8 of section 3154-a of the public authorities law to the governor,  
44 the temporary president of the senate and the speaker of the assembly,  
45 at which time this act shall expire and be deemed repealed and;  
46 provided, further, that the New York state foundation for science, tech-  
47 nology and innovation board shall notify the legislative bill drafting  
48 commission upon the submission of the report required by subdivision 8  
49 of section 3154-a of the public authorities law in order that the  
50 commission may maintain an accurate and timely effective data base of  
51 the official text of the laws of the state of New York in furtherance of  
52 effectuating the provisions of section 44 of the legislative law and  
53 section 70-b of the public officers law.