



Policy on Intellectual Property

(Approved by the President in July 2002)

I. INTRODUCTION

The primary mission of universities is to create, preserve, and disseminate knowledge. When that knowledge takes the form of intellectual property, a university must establish a clear and explicit policy that will protect the interests of both its creators and the university while ensuring that society benefits from the fair and full dissemination of that knowledge.

II. EFFECTIVE DATE

This policy will be effective on July 1, 2002 ("Effective Date"). It will apply to all intellectual property disclosed to the University on or after July 1, 2002. Intellectual property disclosed to the University prior to the Effective Date will remain subject to the UMS Policy on Patents effective May 31, 1990 or the UMS Policy on Copyrights effective May 31, 1990, unless otherwise agreed by the University and all creators of the intellectual property (or the heir or assignee of any creator's share of Revenue).

III. DEFINITIONS

The terms defined in this section are given special meanings in this policy and appear capitalized throughout.

- A. **Personnel.** All University employees, full-time and part-time, including Student Employees acting within their Scope of Employment; non-employee consultants; visitors; and others using University resources.
- B. **Resources Usually and Customarily Provided.** All resources provided unless specified otherwise, in advance and in writing, as a condition of using the resource.
- C. **Revenue.** Consideration paid in cash or equity by a third party in exchange for specific intellectual property rights. Revenue does not include research support in any form (e.g., sponsored research agreements, restricted grants, unrestricted grants, or equity), tuition income, and contract income received by the University including contract income received in lieu of tuition.
- D. **Scope of Employment.** All activities, related to the field or discipline of the faculty member's appointment, including the general obligation of a faculty member to teach, to do creative work, and to conduct research, or related to the employment responsibilities of non-faculty Personnel, and for which Personnel receive compensation from the University, where compensation is any consideration, monetary or otherwise, including but not limited to, title and the ability to use University resources.
- E. **Sponsored Research Agreements.** Grants, contracts, cooperative agreements, and other agreements under which research or development activities will be carried out, or other agreements administered by the University that relate to intellectual property created under the agreement.
- F. **Students.** Persons enrolled in a University, acting within the course of their academic work, including, but not limited to, undergraduates, graduate and professional students,

non-degree students, and not-for-credit students.

- G. **Student Employee.** A Student who is also a University employee, acting within the Scope of Employment.
- H. **University.** University of Maryland Biotechnology Institute except as otherwise stated.

IV. GENERAL PROVISIONS

- A. **Purpose.** The purpose of this policy is to set forth the terms, conditions, and procedures whereby the University Personnel and Students establish and maintain their interests in intellectual property created by or used at the University, taking into account intellectual property laws governing patents, copyrights, trademarks, and other forms of intellectual property. This policy governs the ownership and protection of such property at the University.
- B. **Scope of Application.** All Personnel and Students shall comply with this policy, as amended from time to time. This policy shall be included in the faculty handbook, as directed in Board of Regents Policy II - 1.00, Section I. B.2.
- C. **Protecting University Interests.** Personnel and Students may not (1) sign agreements or take any action on behalf of the University unless they are authorized agents of the University, or (2) make unauthorized use of the name of the University. In cases where Personnel or Students take such actions, the University is not bound to honor those actions or agreements.
- D. **Acquisition.** The University may acquire ownership or use of intellectual property by assignment, license, gift, bequest, or any other legal means. The University shall administer such intellectual property in accordance with this policy unless otherwise required by the terms of the acquisition.
- E. **Administration of Intellectual Property which is not University-owned.** At the request of the owner, intellectual property not owned by the University may be administered by the University. In such cases this policy shall govern that administration unless the University agrees otherwise in writing.
- F. **Sponsored Research**
 - 1. **Ownership.** Sponsored research agreements shall provide that all intellectual property developed by Personnel or Students under such agreements shall belong to the University; however, the University, on a case-by-case basis (as circumstances warrant, and consistent with applicable private use restrictions e.g., under bond covenants), may agree to assign ownership or licensing rights to the sponsor, subject to the University's right to use and reproduce the intellectual property for research and educational purposes. The University's president or designee shall approve any such agreement.
 - 2. **Federal Sponsorship.** Any research project that is funded, in whole or in part, by a federal agency is subject to specific federal statutes and regulations. Those regulations generally allow the University to elect title to any invention that is conceived of or first actually reduced to practice in the performance of federally funded research with the purpose of commercializing the invention, subject to the government's rights which include reservation of a nonexclusive license to use the invention world-wide for government purposes.

- G. **Implementation Authority.** The Chancellor shall have the authority and responsibility for implementation and coordination of this policy. The University's president shall have the authority and responsibility to implement and coordinate this policy within the University. Subject to the other provisions of this policy and applicable law, the University president may enter into agreements with respect to ownership, licensure, disposition of intellectual property, disposition of royalty income, resolution of disputes, and other matters related to intellectual property in which the University has an interest under this policy, and may register intellectual property; seek protection under copyright, trademark, and/or patent laws; and enforce, defend, manage, and take any action relevant to the institution's intellectual property rights that is necessary for the proper administration of this policy.

V. COPYRIGHTS

- A. **Ownership by Creator.** Personnel and Students shall have all rights in copyrights of their work, subject to section V.B. below, with the following exceptions.

1. **Scope of Employment.** The University owns all rights in copyright for work produced by non-faculty Personnel within the Scope of Employment.
2. **Sponsored Research Agreements.** The University owns all rights in copyright for work, which are expected deliverables, produced by Personnel or Students under Sponsored Research Agreements.
3. **Signed agreements.** The University owns all rights in copyright for all work as stated in written agreements.
4. **Computer Programs and Software.** Ownership of copyrighted software and computer programs is addressed in Section VII.

B. Right of Use

1. **University rights.** The University shall have the right to use and reproduce for research and educational purposes scholarly and original works, whether owned by the University, Personnel, or Students, for which it has provided resources.
2. **Additional Rights.** If the University wishes to secure additional rights in copyrighted work, it shall so specify in writing at the time it provides resources beyond Resources Usually and Customarily Provided or other consideration.

C. Responsibilities of Personnel and Students

1. **Assignment.** For work to which the University has or had rights of ownership or use under this policy, Personnel and Students shall, upon request, execute all legal documents designed to assist the University, or its assignees, in proving or benefiting from such rights, as deemed appropriate by the University.
2. **External Collaborations.** See Section IV.C and the Policy on Professional Commitment of Faculty, BOR 41.0 II-3.10.
3. **Use of Copyrighted Materials.** All Personnel and Students are responsible for complying with University guidelines on the fair use of copyrighted material and for complying with the requirements of copyright law, including obtaining required permissions to use copyrighted material (See Appendix A).

D. Responsibilities of the University

1. Agreement Regarding Use of Resources Beyond Resources Usually and Customarily Provided. When the University authorizes or directs efforts to create a work or works using University resources beyond Resources Usually and Customarily Provided, it shall enter into a written agreement addressing the extent of use of resources, the schedule for the project (if appropriate), control over the work and its revisions, and ownership of the work. When the work done by Personnel routinely involves resources beyond Resources Usually and Customarily Provided, compliance with this section may be accomplished by including the required terms in an employment agreement.
2. Sharing of Revenue. The University shall remit to creators or their assignees or heirs, their share of Revenue from copyrights as specified in Section XI.A. of this policy.
3. Use of Copyrighted Materials. The University has developed guidelines for the use of copyrighted materials and guidelines that address library and educational fair use as well as fair use exceptions for research and scholarly work (See Appendix A).

VI. PATENTS

A. Ownership

1. University Ownership
 - a. Within Scope of Employment. The University owns inventions created by Personnel within the Scope of Employment.
 - b. Use of University Resources. The University owns inventions created by Personnel, Graduate Students, or Professional Students with the use of University resources.
 - c. Signed Agreements. The University owns all inventions made by Personnel or Students under Sponsored Research Agreements and as stated in written agreements.
2. Creator Ownership
 - a. Outside Scope of Employment. Personnel, Graduate Students, and Professional Students own patent rights to inventions conceived and first reduced to practice outside the Scope of Employment and without the use of University resources and not subject to Sponsored Research Agreements or other written agreements
 - b. Student Ownership. Undergraduate, non-degree, and not-for-credit Students own inventions they create unless the invention is subject to another provision of this section.

B. Responsibilities of Personnel and Students

1. Disclosure. Personnel and Students shall disclose inventions which are subject to University ownership to the University's Office of Business Development and Technology Transfer Office in a timely manner, fully, and in writing. When

uncertain about the University's rights, Personnel and Students shall disclose.

2. External Collaborations. In accord with Section IV.C., Personnel and Students may not: (a) sign patent agreements or other documents (e.g., invention reports, licenses, assignments, Material Transfer Agreements, or Confidential Disclosure Agreements) which abrogate the University's rights; (b) make unauthorized use of the name of the University; or (c) transfer material relating to intellectual property outside the University, except pursuant to a properly authorized Material Transfer Agreement. See also the Policy on Professional Commitment of Faculty, BOR II-3.10.
3. Assignment. As to an invention in which the University has a right to ownership or use, the inventor, upon request, shall execute promptly all contracts, assignments, waivers or other legal documents necessary to vest in the University, or its assignees, any or all rights to the invention, including assignment of any patents or patent applications relating to the invention.

C. Responsibilities of University

1. Timely Evaluation. The University shall evaluate inventions disclosed in accordance with Section VI.B.1) and shall do so with reasonable promptness and in good faith. The University shall decide whether to seek legal protection of its ownership rights, such as filing for patent protection; the scope of patent protection; and whether and how to pursue, limit, or abandon commercialization. The University may at any time decide not to pursue or to abandon the pursuit of patenting and/or commercialization of any invention in which it has an interest.
2. Timely Information. The University shall inform inventors in a timely manner about substantive decisions regarding protection, commercialization and/or disposition of inventions disclosed in accordance with Section VI.B.1). Terms of agreements which constitute proprietary business information may be treated as confidential by the University in accordance with applicable law. The University shall notify inventors promptly when it decides either not to pursue, or to abandon pursuit of, all efforts to commercialize an invention.
3. Commercialization by Inventors. The University, at its discretion and consistent with the public interest, may license intellectual property to the inventors on an exclusive or non-exclusive basis. Inventors must demonstrate technical and business capability to commercialize the intellectual property. Agreements with inventors shall be subject to review and approval of conflict of interest issues in accordance with applicable University policy.
4. Assignment of Ownership. The University may assign ownership to the inventors as allowed by law, subject to the rights of sponsors and to the retention by the University of a license which at a minimum shall grant the University the right to use intellectual property in its internally administered programs of teaching, research, and public service on a perpetual, royalty-free, non-exclusive basis. The University may retain more than the minimum license rights, and assignment or license may be subject to additional terms and conditions, such as Revenue sharing with the University or reimbursement of the costs of legal protection. The University shall negotiate promptly, upon written request by the inventors, the transfer to the inventors of the University's interest in any invention that it has chosen not to protect or commercialize, subject to any legal obligation to offer its interest to a sponsor, licensee, or

another institution with rights to the invention before it can agree to negotiate the transfer of the University's interest in an invention to the inventors.

5. Sharing of Revenue. The University shall remit to the inventors or their assignees or heirs, their share of Revenue from inventions as specified in Section XI.B. of this policy.

VII. COMPUTER PROGRAMS AND SOFTWARE

A. Ownership

1. University Ownership

- a. Within the Scope of Employment. The University owns computer programs and software created by Personnel within the Scope of Employment.
- b. Use of University Resources. The University owns computer programs and software created by Personnel, graduate Students, or professional Students with the use of University resources.
- c. Signed Agreements. The University owns all computer programs and software created or made by Personnel or Students under Sponsored Research Agreements and as stated in written agreements.

2. Personnel Ownership

- a. Outside Scope of Employment. Personnel, graduate Students, and professional Students own software and computer programs conceived and first reduced to practice, and/or authored, outside the Scope of Employment and without the use of University resources and not subject to Sponsored Research Agreements or other written agreements.
- b. Student Ownership. Undergraduate, non-degree, and not-for-credit Students own computer programs and software they create unless the computer program or software is subject to another provision of this section.

B. Responsibilities of Personnel and Students

1. Disclosure. Personnel and Students shall disclose computer programs and software (according to UMBI guidelines on submission of computer programs and software) that are subject to University ownership to the president or designee in a timely manner, fully, and in writing. When uncertain about the University's rights, Personnel and Students shall disclose. Disclosure may include deposit of a digital time-stamped copy of the software program, with appropriate annotations.
2. External Collaborations. See Section IV.C. See also the Policy on Professional Commitment of Faculty, BOR II-3.10.
3. Assignment. As to a computer program or software in which the University has a right to ownership or use, the creator, upon request, shall execute promptly all contracts, assignments, waivers or other legal documents necessary to vest in the University, or its assignees, any or all rights to the computer program or

software, including assignment of any patents, copyrights, patent applications, or copyright applications, relating to the work.

C. Responsibilities of University

1. **Timely Evaluation.** The University shall evaluate computer programs and software disclosed in accordance with Section VII.B.1) and shall do so with reasonable promptness and in good faith. The University shall decide whether to seek legal protection of its ownership rights, such as filing for patent protection, the scope of patent protection, and whether and how to pursue, limit, or abandon commercialization. The University may at any time decide not to pursue or to abandon the pursuit of patenting and/or commercialization of any computer program or software in which it has an interest.
2. **Timely Information.** The University shall inform creators in a timely manner about substantive decisions regarding protection, commercialization and/or disposition of computer programs or software disclosed in accordance with Section VII.B.1). Terms of agreements which constitute proprietary business information may be treated as confidential by the University in accordance with applicable law. The University shall notify creators promptly when it decides either not to pursue, or to abandon pursuit of, all efforts to commercialize computer programs or software.
3. **Commercialization by Creators.** The University, at its discretion and consistent with the public interest, may license intellectual property to the creators on an exclusive or non-exclusive basis. Creators must demonstrate technical and business capability to commercialize the intellectual property. Agreements with creators shall be subject to review and approval of conflict of interest issues in accordance with applicable University policy.
4. **Assignment of Ownership.** The University may assign ownership to the creators as allowed by law, subject to the rights of sponsors and to the retention by the University of a license which at a minimum shall grant the University the right to use intellectual property in its internally administered programs of teaching, research, and public service on a perpetual, royalty-free, non-exclusive basis. The University may retain more than the minimum license rights, and assignment or license may be subject to additional terms and conditions, such as Revenue sharing with the University or reimbursement of the costs of legal protection. The University shall negotiate promptly, upon written request by the creators, the transfer to the creators of the University's interest in any computer program or software that it has chosen not to protect or commercialize, subject to any legal obligation to offer its interest to a sponsor, licensee, or another institution with rights to the intellectual property before it can agree to negotiate the transfer of the University's interest in intellectual property to the creators.
5. **Sharing of Revenue.** The University shall remit to the creators or their assignees or heirs, their share of Revenue from computer programs or software as specified in Section XI.B. of this policy.

VIII. TECHNOLOGY-MEDIATED INSTRUCTIONAL MATERIALS

Section V, Copyrights, shall apply to any materials that may be considered technology mediated instructional materials.

IX. OTHER TYPES OF INTELLECTUAL PROPERTY

- A. **Tangible Research Property.** The principles in Section VI. that apply to inventions and patents also apply to tangible research property.
- B. **Mask Works.** The principles in Section VI. that apply to inventions and patents also apply to mask works.
- C. **Plant Varieties.** The University owns and may protect or commercialize plant varieties according to the principles of Section VI.
- D. **Trademarks, Service Marks, and Trade Dress.** Trademarks, service marks, and trade dress may be created in association with an underlying license for another form of intellectual property, such as a patent or a plant variety (“associated with other intellectual property”), or independently, such as a university logo or symbol (“independently created”).
 - 1. **Associated with Other Intellectual Property.** The University owns a trademark, service mark or trade dress if it is associated with other intellectual property owned by the University.
 - 2. **Independently Created.** The University owns trademarks, service marks, and trade dress that are independently created by Personnel within the Scope of Employment unless the University agrees otherwise in writing.
 - 3. **Commercialization.** The University may commercialize or license its trademarks, service marks, and trade dress.
 - 4. **Registration.** The president or designee shall approve registration of trademarks or service marks, at the state or federal level.

X. INTERINSTITUTIONAL AGREEMENTS

For the purposes of this Section, University shall mean any one of the following: a constituent institution of the University System of Maryland, the University of Maryland Biotechnology Institute, the University of Maryland Center for Environmental Science, or the University System of Maryland Office.

- A. **Joint Appointments and Affiliations.** This section applies when an individual has an appointment in and receives support for research or creative work from two or more Universities and when a Student or Student Employee is earning a degree in one University but doing research or creative work in another.
 - 1. **Ownership.** When more than one University can claim ownership to intellectual property under this policy, they own it jointly.
 - 2. **Management Agreements.** Universities that are or may become joint owners of intellectual property shall enter into agreements stating which University will be responsible for management of the intellectual property. Universities are encouraged to negotiate standard agreements whenever possible.
 - a. **Terms to be Addressed.** The agreements shall state which institution will be responsible for prosecution of patent applications or other forms of intellectual property protection, which institution will license the intellectual property, how expenses and deductions from Revenue will be

allocated, and how institutional net Revenue will be shared. The distribution of each University's share of Net Revenue, Project Specific Costs, and General Costs shall be addressed in the management agreement.

- b. **Student Requirements.** With regard to Students and Student Employees, agreements shall specify whether the degree-granting University or the supporting University will be responsible for managing intellectual property they create when that property is subject to University ownership.
 3. **Responsibilities of Managing University.** The University managing intellectual property under an agreement shall promptly inform the other University or Universities about steps taken with regard to ownership. Such information shall include at minimum copies of the invention disclosure form, documents associated with filing for statutory protection, assignment of rights, and license agreements. If the managing University decides not to proceed, the other owning University or Universities shall have the right to assume responsibility as the managing University.
 4. **Distribution of Revenue.** The managing University shall distribute Revenue to the creators and share net Revenue in all cases according to Section XI.
 5. **Disputes.** A president may ask the Chancellor to intercede if the Universities are unable to reach agreement or differ in their interpretation of an agreement. The Chancellor's decision shall be final and binding on all parties.
- B. **Joint Creators.** This section applies when Personnel or Students from two or more Universities collaborate.
1. **Early Notification.** As soon as collaborators from different Universities recognize that their efforts have resulted in, or are likely to result in, the creation of intellectual property subject to this policy, they shall inform their respective Universities that an agreement is needed.
 2. **Agreements Govern.** Signed agreements between Universities shall determine ownership of intellectual property, responsibility for managing it, and distribution of expenses and Revenue resulting from its development. Universities whose Personnel or Students are engaged in frequent collaboration are encouraged to negotiate standard agreements within the framework of this policy.
 3. **Disputes.** A president may ask the Chancellor to intercede if the Universities are unable to reach agreement or differ in their interpretation of the agreement. The Chancellor's decision shall be final and binding on all parties.

XI. REVENUE SHARING

Unless otherwise agreed to in writing by the creators of a work or inventors of an invention, each named creator or inventor shall receive equal shares of net Revenue.

- A. **Copyrights.** The University shall share with creators Revenue it receives from copyrights of their work, subject to certain exceptions.

1. Exceptions
 - a. Scope of Employment. Revenue generated from work produced by non-faculty Personnel within the Scope of Employment is excluded from sharing. However, the University may elect, by written agreement or University policy, to pay up to fifty percent of net Revenue to such non-faculty Personnel.
 - b. Contract. When a third party contract dictates apportionment of Revenue different from that specified in this policy, the terms of the contract govern.
 - c. Equity. Equity shall be distributed in accord with Section XI.G.
 - d. Technology-mediated Instructional Materials. University policy adopted to fulfill Section VIII may exclude some or all Revenue from sharing.
2. Deductions from Revenue. The University shall make the following deductions from Revenue before distributing net Revenue (Section XI.A.3).
 - a. Creators' Share. First, ten percent of Revenue shall be distributed among the creators of the work until the cumulative total reaches the limit set pursuant to this paragraph that was in effect during the fiscal year in which the University first received Revenue. The limit in FY2007 is \$11,280 to be shared among the inventors. The Chancellor shall establish a new limit for each succeeding fiscal year by adjusting the previous year's limit by an amount reflecting the change in the Consumer Price Index during the last calendar year completed, rounded to the nearest \$100.
 - b. General Costs. Second, the University will deduct 30% of Revenue to cover the general cost of developing, obtaining, managing, and defending creative works, unless otherwise agreed to by the University and creators, in writing.
 - c. Project Specific Costs. Third, the remaining 60% of the Revenue received from a work shall be applied to reimburse any specific, incremental expenses incurred by the University in obtaining and maintaining the copyright, and in developing, marketing, licensing, and defending the work. After reimbursement of the University's expenses, Revenue may be used to reimburse costs incurred by creators on behalf of their own works but only if the University had authorized such expenses in advance in writing.
 - d. Residual Creators' Share. Fourth, after project specific costs have been paid in full, any remaining Revenue shall go to the creators until the threshold dollar amount has been paid, as specified above in Section XI.A.2)a).
3. Distribution of Net Revenue. Net Revenue is the Revenue remaining after deductions under XI.A.2.
 - a. Creators' Share. The University shall distribute among the creators fifty percent (50%) of the net Revenue it receives from their creative work unless applicable laws, regulations, provisions of grants or contracts, or

signed agreements with creators provide otherwise.

- b. **University's Share.** The University shall receive 50% of the net Revenue. Net Revenue received on account of copyrighted work shall be dedicated to research, scholarship, creative work, and related academic activities. The University's Share shall be distributed as follows:
 - 1.) **Center's Share.** 85% of the University's Share shall be distributed to the creator's Center or analogous unit.
 - 2.) **Remaining University Share.** The remaining Net Revenues shall be allocated as directed by the President, or designee.
 4. **Timely Distribution.** The University shall distribute accrued Revenue due creators under this policy at least annually. Distribution will be made along with a statement of related income and expenses.
- B. Patents and Computer Programs and Software.** The University shall share with inventors or creators Revenue it receives from their inventions or creations as provided in this section.
1. **Exceptions**
 - a. **Contract.** When a third party contract dictates apportionment of Revenue different from that specified in this policy, the terms of the agreement govern.
 - b. **Equity.** Equity shall be distributed in accord with Section XI.G.
 2. **Deductions from Revenue.** The University shall make the following deductions from Revenue before distributing net Revenue (Section XI.B.3).
 - a. **Creators' or Inventors' Share.** First, ten percent of Revenue shall be distributed among the creators or inventors until the cumulative total reaches the limit set pursuant to this paragraph that was in effect during the fiscal year in which the University first received Revenue. The limit in FY2007 is \$11,280 to be shared among the inventors or creators. The Chancellor shall establish a new limit for each succeeding fiscal year by adjusting the previous year's limit by an amount reflecting the change in the Consumer Price Index during the last calendar year completed, rounded to the nearest \$100.
 - b. **General Costs.** Second, the University shall deduct 30% of Revenue to cover the general cost of developing, obtaining, managing, and defending inventions or creative work, unless otherwise agreed to by inventors or creators and the University, in writing.
 - c. **Project Specific Costs.** Third, the remaining 60% of Revenue received from a creative work, patent, or invention shall be applied to reimburse any specific, incremental expenses incurred by the University in obtaining and maintaining the patent and in developing, marketing, licensing, and defending the patent or licensable invention or creative work. After reimbursement of the University's expenses, Revenue may be used to reimburse costs incurred by inventors or creators on behalf of their own works but only if the University had authorized such expenses

in advance in writing.

- d. Residual Creators' Share. Fourth, after project specific costs have been paid in full, any remaining Revenue shall go to the creators until the threshold dollar amount has been paid, as specified above in Section XI.B.2)a).
3. Distribution of Net Revenue. Net Revenue is the Revenue remaining after deductions under XI.B.2.
 - a. Creators' Share. The University shall distribute among the inventors or creators fifty percent (50%) of the net Revenue it receives from their inventions or creations unless applicable laws, regulations, provisions of grants or contracts, or signed agreements with inventors or creators provide otherwise.
 - b. University's Share. The University shall receive 50% of the net Revenue. Net Revenue received on account of an invention shall be dedicated to research and to the promotion of patenting and patents. The University's Share shall be distributed as follows:
 - 1.) Center's Share. 85% of the University's Share shall be distributed to the creator's Center or analogous unit.
 - 2.) Remaining University Share. The remaining Net Revenues shall be allocated as directed by the President, or designee.
 4. Timely Distribution. The University shall distribute Revenue due creators under this policy at least annually. Distribution will be made along with a statement of related income and expenses.
- C. Tangible Research Property, Mask Works, and Plant Varieties.** When tangible research property, mask works, or plant varieties are licensed, Revenue shall be distributed in the same manner that Revenue is distributed under Section XI.B.
- D. Trademarks, Service Marks, and Trade Dress**
1. Creators' Share
 - a. Associated with Other Intellectual Property. Revenue received from commercialization of a trademark, service mark, or trade dress that is related to an intellectual property license shall be shared with creators of the trademark, service mark, or trade dress, as specified in Section XI.B.
 - b. Independently-created trademark, service mark, or trade dress. Except as provided herein or unless subject to prior written agreement between the creators and the University, the University will not share the Revenue from commercialization of a trademark, service mark, or trade dress with the individuals who created the trademark, service mark, or trade dress.
 2. University Ownership. Revenue received from commercialization of a trademark, service mark, or trade dress licensed independently and not directly related to another form of intellectual property license shall not be shared and shall belong to the University.

UMBI Policies and Procedures

- E. **Joint Appointment.** In situations covered by section X., the University's share of net Revenue shall be divided equally among the Universities or as otherwise provided by written agreement.
- F. **Joint Creators.** If joint creators are from different Universities, the University's share of net Revenue shall be divided equally unless determined by signed agreements as provided in Section X.B.2.
- G. **Equity**
 - 1. **Issuance of Shares.** Equity may be issued separately to the University and the inventors or creators.
 - 2. **Distribution of Shares.** Equity in a commercial venture received as consideration for intellectual property rights shall be shared equally between the University and the creators, unless a different distribution is negotiated in an agreement signed by the University and the creators of the relevant intellectual property.
 - 3. **Timely Distribution.** When the University receives all shares directly, as soon as practicable after the University receives equity, and subject to the creators receiving any conflict of interest exemptions that must be granted and complying with any conditions for those exemptions, the University shall transfer equity shares to the creators. The University and creators shall have independence in their exercise of equity holder privileges within the constraints of law, policy, specific exemption under Maryland law from the State Ethics Law, and contractual agreements.
 - 4. **Unqualified Persons.** Personnel or Students not qualified to hold the equity under applicable law shall designate a qualified person to receive the equity. If no designee is named within thirty days of a written request by the University to do so, the right to a share of the equity shall be forfeited to the University.

XII. ADMINISTRATION

- A. **Implementation.** This policy has been developed pursuant to the university System of Maryland Policy Framework approved by the Board of Regents on February 8, 2002 and includes all of the procedures and policies required therein. Any revisions to this policy shall not go into effect until approved by the Chancellor in writing.
- B. **Point of Contact.** The Director of Technology Transfer will be the University's initial point of contact for intellectual property issues.
- C. **Authority to Subcontract.** The University may enter into contracts with third parties in connection with the development, administration, and protection of its intellectual property.
- D. **Special Cases.**
 - 1. **Issues not addressed.** The Board of Regents recognizes that special cases will arise that are not specifically covered by this policy. In such cases, the Presidents may make a decision on how to proceed and report that decision to the Chancellor.

Alternatively, the President may submit such cases to the Chancellor or

designee for resolution. All decisions on such cases shall be reported to the Intellectual Property Committee, which will take them into account in its annual review of this policy.

E. **Policy waivers.** Only the Chancellor may waive any provision of the USM Policy or this policy. All decisions concerning waiver shall be reported to the Intellectual Property Committee and to the Board of Regents.

F. **Special Cases.**

1. Issues not addressed. The Board of Regents recognizes that special cases will arise that are not specifically covered by this policy. In such cases, the Presidents may make a decision on how to proceed and report that decision to the Chancellor. Alternatively, the President may submit such cases to the Chancellor or designee for resolution. All decisions on such cases shall be reported to the Intellectual Property Committee, which will take them into account in its annual review of this policy.
2. Policy waivers. Only the Chancellor may waive any provision of the USM Policy or this policy. All decisions concerning waiver shall be reported to the Intellectual Property Committee and to the Board of Regents.

G. **USM Intellectual Property Committee**

1. Membership. The Chancellor shall appoint one representative from each institution from nominees submitted by the presidents. The Chancellor will assure that faculty members constitute a significant proportion of the membership and that representatives of technology transfer offices shall routinely meet with the Committee. Members shall serve a three-year term. No voting member may serve more than two consecutive terms. The Vice Chancellor for Academic Affairs shall chair the Committee, without a vote.
2. Responsibilities. The Committee shall advise the Chancellor on intellectual property matters. It shall convene at least once each academic year to review this policy and may recommend revisions to the policy. The Committee shall also meet at the call of the Chair. A University president or the Chancellor may refer to the Committee for its recommendations to the Chancellor matters relating to this policy, including relevant matters not addressed by the policy, and suggestions for revisions. The Chancellor may ask the Committee for advice on the resolution of disputes over intellectual property.
3. Creator's Right to Participate. Whenever the Committee considers this policy's application in order to advise the Chancellor about a specific work, Personnel or Students who created the work or their representative may make a written presentation and an oral presentation to the Committee.

XIII. REPORTING

The President shall report annually to the Chancellor and the Board of Regents on intellectual property activity at the University. The report, in a format to be determined by the Chancellor, shall include data for the preceding year on disclosures, patent applications, patent awards, licenses, and start-up companies, distinguishing when appropriate between Maryland-based companies and those outside of the State. The report shall also include data on revenue and expenditures associated with the University's technology transfer function.

UMBI Policies and Procedures

Glossary

(This section is provided for information only. It is not part of the policy.)

Commercial venture - a start-up company, limited partnership, joint venture or any other entity that has obtained an option or a license to university technology.

Confidential Disclosure Agreement - An agreement or section of an agreement that prevents parties to the agreement from releasing knowledge or information without the other's permission.

Copyright - The intangible property right granted by statute for an original work fixed in a tangible means of expression. A copyright provides the owner with the following exclusive rights over a work: to reproduce, to prepare derivative works, to distribute, to perform publicly, and to display publicly. Copyright comes into existence immediately at the time the work is fixed in a tangible means of expression.

Creative works - "Original works of authorship" that are fixed in a tangible form of expression that may be protected by copyright. The fixation need not be directly perceptible so long as it may be communicated with the aid of a machine or device. Copyrightable works include the following categories: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works.

Creator - Refers to an individual or group of individuals who make, conceive, reduce to practice, or otherwise make a substantive intellectual contribution to the creation of intellectual property. "Creator" follows the definition of "inventor" used in U.S. patent law and the definition of "author" used in the U.S. Copyright Act.

Disclose - Formally record the essence of a potentially patentable concept, the circumstances in which it was conceived, the persons participating in the invention, and the steps taken to reduce it to practice, if applicable, in accord with the requirements of U.S. patent law for establishing precedence

Equity or equity shares - Shares of common or preferred stock, warrants, options, convertible instruments, units of a limited partnership, or any other instruments conveying ownership interest in a commercial venture, or options or rights to purchase an ownership interest.

First sale - The principle that gives the purchaser of a copyrighted work the right, among other things, to lend it to others.

Intellectual property - The intangible value developed by human creativity that is protected by the legal mechanisms of patents, trademarks, copyrights, service marks, trade secrets, mask works, and plant variety protection certificates. Rights derived from legislation include ownership and disposition, including commercialization. Intellectual property encompasses inventions, discoveries, know-how, show-how, processes, unique materials, copyrightable works, original data, and other creative or artistic works that have value. It also includes the physical embodiments of intellectual effort such as models, machines, devices, designs, apparatus, instrumentation, circuits, computer programs and visualizations, biological materials, chemicals, other compositions or matter, plants, and records of research.

Invention - any discovery which is or may be patentable or which may be commercially licensable.

License - A contract in which an intellectual property owner grants permission to exercise one or more of the rights that an owner holds.

Mask work - A series of related images representing a predetermined, three-dimensional pattern of metallic, insulating, or semi conducting layers of a semiconductor chip product.

UMBI Policies and Procedures

Material Transfer Agreement - A contract covering transfer of physical possession and use of tangible research property into or out of the university.

Patent (U.S. only) - The intangible property right to exclude others from making, using, offering for sale, or selling the invention in the United States or importing the invention into the United States. In order to obtain patent protection, an invention must be useful, novel and unobvious.

Plant variety protection certificate - Registration under the Plant Variety Act of 1970 that protects sexually propagated cultivars that are distinctive, uniform and true-breeding.

Royalty - Payment made to an owner of intellectual property for the privilege of practicing a right held by the owner of the intellectual property under applicable law

Tangible research property - Includes the physical embodiments of intellectual effort such as models, machines, devices, designs, apparatus, instrumentation, circuits, computer programs and visualizations, biological materials, chemicals, other compositions of matter, plants, and records of research. Tangible research property is distinct from intangible properties such as patents, trademarks, copyrights, service marks, trade secrets, mask works, and plant variety protection certificates. Individual items of tangible research property may be associated with one or more intangible properties.

Trade dress - Distinctive and unique packaging, color combinations, building designs, product styles, and overall presentations identifying the source, product, producer, or distributor of goods and services where the appearance distinguishes the product or business from other similar products or businesses but is not distinctive or specific enough to be considered a trademark.

Trademarks and service marks - Distinctive words or graphic symbols identifying the source, product, producer, or distributor of goods and services

UMBI Policies and Procedures

APPENDIX A

(This section is provided for information only. It is not part of the policy.)

UMBI GUIDELINES FOR THE USE OF COPYRIGHTED MATERIAL

PURPOSE

The purpose is to provide Personnel and Students working at UMBI with guidelines for reproduction of copyrighted materials for use in research, instructions, or publications.

COPYRIGHT

Copyright is an intangible property right granted by statute for an original work fixed in a tangible means of expression. A copyright provides the author or creator of an original work with the following exclusive rights in a work: to reproduce, to prepare derivative works, to distribute by sale or otherwise, to perform publicly, and to display publicly. Copyrightable "works" include literary and instructional materials, audiovisual materials, photographs, computer software, and sound recordings.

The 1976 Copyright Act provides that under most circumstances copyrighted materials cannot be reproduced in whole or in part without the consent of the person who owns the copyright. The 1976 Copyright Act formally recognizes that under the concept of "fair use" the general public has the right to make very specific use of the copyrighted material for educational purposes without the permission of the author.

Any exercise of the exclusive rights of copyright without explicit permission of the owner constitutes an infringement. Legal action by the owner can enjoin the infringer from any further unauthorized use and, if the copyright has been registered, may result in awards for damages, loss of profits, and recovery of attorney's fees.

COPYRIGHT REGISTRATION

Copyright protection is immediately available to the author of an original work once it is set down in a tangible form. In order to file suit against a copyright infringer and collect monetary damages, however, formal registration of a work with the U.S. Copyright Office is necessary. Moreover, for an author to recover reasonable attorney's fees associated with infringement litigation, the published work must have been registered before the alleged infringement.

"FAIR USE"

The 1976 Copyright Act, Section 107, provides that the "fair use" of a copyrighted work, including such use by reproduction in copies or phonorecords for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a "fair use," the factors to be considered shall include:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for, or value of, the copyrighted work.

THE "FAIR USE" GUIDELINES

The Guidelines are specific guidelines for classroom use copying in not-for-profit educational institutions such as the University with respect to books and periodicals. The Guidelines were incorporated in the

UMBI Policies and Procedures

House Committee Report on Section 107 of the 1976 Copyright Act. The Guidelines state the minimum and not the maximum standards of educational "fair use." There may be instances in which copying which does not fall within the Guidelines may be permitted under the criteria of "fair use." The House Committee has stated that the guidelines are not intended to limit the types of copying permitted under the standards of "fair use" to those expressly mentioned. Conversely, the Guidelines may describe copying, which is not allowed by the 1976 Copyright Act. Ultimately, federal courts interpreting the 1976 Copyright Act will determine what uses constitute "fair use." More information regarding "fair use" Guidelines is available from UMBI's Office of Technology Transfer.