

**ST. MARY'S COLLEGE OF MARYLAND POLICY AND PROCEDURES
INTELLECTUAL PROPERTY POLICY**

Effective Date: January 5, 2017

rev. April 2, 2024

While the discovery of patentable processes or inventions and the creation of other intellectual property is not the primary objective of the College, for any discoveries or creations, it is the objective of the Board of Trustees to provide an intellectual property policy that will encourage the development of inventions and other intellectual creations for the best interest of the public, the creator, and the research sponsor, if any, and that will permit the timely protection and disclosure of such intellectual property whether by development and commercialization after securing available protection for the creation, by publication, or both. The policy is further intended to protect the respective interests of all concerned, by ensuring that the benefits of such property accrue to the public, to the inventor or originator, to the College and to the sponsors of specific research in varying degrees of protection, monetary return and recognition, as circumstances justify or require.

Definitions

For purposes of interpretation of this policy, the following definitions shall apply:

- A. **Aesthetic Work.**
A work that is a result of original artistic expression.
- B. **Center Director.**
The Center Director is responsible for shaping the vision of the Center and provides oversight for the Center's operations including fiscal and personnel management, strategic planning development and implementation.
- C. **Commissioned Work.**
A work produced for the institution by others pursuant to a contract at the institution's expense.
- D. **Contracted Work.**
Work produced by and for others at the others' expense, using College facilities pursuant to a contract.
- E. **Copyright.**
The intangible property right granted by statute providing the owner the following exclusive rights over a work: to reproduce, to prepare derivative works, to distribute, to perform publicly, and to display publicly.
- F. **Direct College Assignment.**
Any written or oral instruction or task assigned to an originator.
- G. **License.**
A contract in which a copyright owner grants permission to exercise one or more of the rights under copyright.

- H. Originator.
Any person who produces a work by his or her own intellectual effort, including student employees.
- I. Royalties.
A payment made to an owner of a copyright for the privilege of practicing a right under the copyright.
- J. Scholarly Work.
Work such as, but not limited to, books, articles, other such publications, lectures, and computer software resulting from independent effort.
- K. Software.
A work comprising statements or instructions to be used directly or indirectly in a computer to bring about a certain result and any associated documentation containing operational instructions. (In cases where software is found to be patentable the Patent Policy will govern.)
- L. Sponsored Work.
A work produced by or through college pursuant to a contract, grant, or other agreement.
- M. College Resources.
All buildings, equipment, services, funds (regardless of source), and other facilities under the control of the Board of Trustees. The College will not construe the provision of the usual office, library, laboratory, computing facilities, equipment and supplies that are part of its regular instructional program, or faculty development funds as constituting substantial specific support.
- N. Work.
Any copyrightable expression including, but not limited to writings, lectures, musical or dramatic compositions, sound recordings, films, videotapes, computer software, architectural designs, and works of art.

Policy of Copyrights

- A. Ownership by Category of Work
 - a. Scholarly/Aesthetic. In keeping with traditional academic practice and policy, ownership of copyrights to scholarly or aesthetic works that are prepared through independent effort of college faculty, staff, students or visitors and are not part of a directed assignment, shall reside with the originator except as otherwise provided in this Policy. Independent effort is defined as the product of inquiry, investigation, or research to advance truth, knowledge, or the arts where the specific choice, content, course, and direction of the effort is determined by the individual without assignment or supervision by the College. The general obligation of faculty to produce scholarly works does not constitute such a directed assignment, even if within the scope of employment and even if resources are used, including faculty development funds.
 - b. Personal. The copyright to any work that is prepared by a College faculty or staff member, student, or visitor, outside the scope of employment and without the use of significant institutional resources by an employee, shall be the property of the employee.
 - c. Sponsored/Contracted. If the College initiates sponsorship or enters into a contract for specific work the College may assert its right to copyrightable works created under such a sponsorship or contract. Copyright ownership of sponsored works and contracted works shall be governed by such agreements or contracts. Any sponsored work agreement which provides for ownership by other than the

College shall also provide the College with a free-of-cost, non-exclusive, world-wide license to use and reproduce the copyrighted work for research and education purposes, except where prohibited by law or government regulation.

- d. Commissioned. When the institution commissions the production of a work, title normally should be with the College. In all cases, copyright ownership shall be specified in the written contract. Any commissioned work agreement which provides for ownership by other than the College, shall also provide the College with a free-of-cost, non-exclusive, world-wide license to use and reproduce the copyrighted work for research and education purposes, except where prohibited by law or government regulation.
 - e. Acquired by Assignment or Will. The College may acquire copyrights by assignment or will be pursuant to the terms of the written agreement or testament.
- B. Revenue Sharing for Sponsored/Non-Contracted Work Where the Copyright is Held by the College

The Board of Trustees may assign or license its copyrights to others. The College shall share with the originator(s) revenue which it receives through copyrights. Specific provisions of grants or contracts may govern rights and revenue distribution. Consequently, revenues received from such copyrights may be exclusive of payments of royalty shares to donors or contractors. Moreover, College may contract with outside persons or organizations for the obtaining, managing and defending of copyrights, and any royalty share or expenses contractually committed to such persons or organizations may be deducted before revenues accrue or before the originator's share is distributed.

In conformity with this policy, the president is authorized to enter into agreements with respect to ownership, licensure, disposition of royalty income, resolution of disputes, and other rights related to copyrights under their respective jurisdictions. The president is authorized to register copyrights, accept copyrights from third parties, and to sell or grant licenses or assignments in the name of the Board of Trustees for any rights to copyrights under her/his jurisdiction.

The revenues (net, if applicable per the preceding paragraph) which are received from a copyright will be applied first to reimburse the College for any specific, incremental expenses incurred by it in generating the copyright and in marketing, licensing and defending the rights. After provision for such expenses, such revenues shall be shared as follows: (1) the first \$5,000 will be paid to the originator(s); (2) thereafter the originator(s) will receive fifty percent of such revenues. Applicable laws, regulations or provisions of grants or contracts may, however, require that a lesser share be paid to the originator.

To the extent consistent with State and College budget policies any net revenue received on account of a copyright, after sharing with the originator(s), will be dedicated to research and to the promotion of original works. If practicable, seventy-five percent of the College's share of new revenue from each copyright will be designated for research in the originator's department or analogous unit up to \$100,000 in a fiscal year for a particular department or analogous unit.

If use of such funds for research within the originator's department or analogous unit is not practicable, the funds should usually be designated for research in a related department or unit. The remaining part of the net revenues shall be devoted to research

and incentive for creative works as directed by the president or Center Director, or designee.

Policy on Patents

A. Ownership

- a. **General Statement on Ownership of Patents.** In general, College faculty, staff, students, and visitors shall retain all rights relating to intellectual property developed on their own initiative without substantial use of college facilities and resources. The inventor retains the rights unless the patentable invention was developed as a part of the duties and responsibilities of their position or specific part of a college assignment.
- b. **Cases in Which the College Obtains Entire Right, Title, and Interest.** The College shall obtain the entire right, title and interest in all materials subject to patent when the materials result from an assigned duty of a faculty or staff member, student, or visitor, or when the College provides substantial specific support for the development of the materials in the form of space, facilities, and/or equipment and supplies. The College will not construe the provision of the usual office, library, laboratory, computing facilities, equipment and supplies that are part of its regular instructional program or faculty development funds as constituting substantial specific support except for those situations where the patentable material was developed in response to a specific College assignment. A faculty member's general obligation to maintain a level of professional activity as a scholar does not constitute such a part of the duties and responsibilities of their position or a specific College assignment.
- c. **Intellectual Property in Instances of Outside Consulting and/or Contractual Work.** Materials or inventions developed by College faculty, staff, students, or visitors in the course of contractual or consulting work for outside organizations, or as supported by funds and facilities awarded as grants to the College by governmental, commercial, industrial or other organizations, shall not be considered as having been made or developed with specific College support, except in situations where the College itself is party to the contract or consulting agreement and declares proprietary interest, or the College's proprietary interest is defined and made a specific part of the conditions of the grant. Accordingly, the rights to such materials or inventions shall remain with the individual, subject to any agreement there may be in the actual contract, consulting agreement, or grant.

B. Administrative Responsibilities

- a. **Policy Administration.** Administrative responsibility of this Policy on Patents is vested in the provost.
- b. **Procedures for Notification.** All intellectual property in which the College may claim interest under this policy shall be promptly reported in writing by its creator(s) to the provost. If more than one individual participated in the development, the report shall be signed by all such participants and shall identify the percent of interest of each. The report shall constitute a full and complete description of the intellectual property concerned and identify the source(s) of any funding that has supported its creation. The participants shall furnish such additional information and execute such documents from time to time as the provost may reasonably request. Following receipt of any report of the creation of intellectual property, the provost, after consulting with other College officials as

appropriate, shall within 180 days advise the creator(s), in writing, whether or not the College claims a proprietary interest.

- c. College Ownership of Intellectual Property. The College shall, in a timely manner, obtain (and market), or arrange for some appropriate outside agency to obtain (and market), the copyright or patent to intellectual property in which the College claims a proprietary interest. The College will not, prior to obtaining a patent, disclose the details of an invention to anyone who does not need to know those details, or to anyone who is not under an obligation of confidentiality. The College will have all rights to use, promote, manage, market, sell or in any other way dispose of such intellectual property, on such terms and conditions, and for such consideration, if any, as the College shall determine. If the College fails to make progress toward obtaining a patent (and marketing such) in which the creator(s) have a share within a period of eighteen(18) months after formal disclosure of the invention to the College, the creator(s) may formally make a written request to the president that the ownership of the intellectual property pass to the creator(s).
- C. Dispute Resolution
- Any dispute which may arise over anything within this Policy on Intellectual Property should be presented to the president, who, in resolving the dispute, may convene a committee of three individuals to advise him or her. The committee will consist of one employee of the College named by the creator(s) of the intellectual property in question, a second employee of the College named by the provost, and a third named by the president. Both this committee and the president may seek the advice of the Attorney General's Office.
- D. Revenue Sharing
- a. The College shall share with the inventor's revenue which it receives from patents or inventions. Specific provisions of grants or contracts may govern rights and revenue distribution regarding inventions made in connection with sponsored research. Consequently, revenues received from such inventions may be exclusive of payments of royalty shares to donors or contractors. Moreover, constituent institutions may contract with outside persons or organizations for the obtaining, managing and defending of patents, and any royalty share, or expenses contractually committed to such persons or organizations may be deducted before revenues accrue or before the inventor's share is distributed.
 - b. The revenues (net, if applicable per the preceding paragraph) which are received from a patent or invention, whose rights are held by the College, will be applied first to reimburse the College for any specific, incremental expenses incurred by it in obtaining and maintaining the patent and in marketing, licensing and defending the patent or licensable invention. After provision for such expenses, such revenues shall be shared as follows: (1) the first \$5,000 will be paid to the inventor or inventors; (2) thereafter the inventor(s) will receive fifty percent of such revenues. Applicable laws, regulations or provisions of grants or contracts may, however, require that a lesser share be paid to the inventor.
 - c. To the extent consistent with State and College budget policies any net revenue received on account of an invention, whose rights are held by the College, after sharing with the inventor, will be dedicated to research and to the promotion of patenting and patents. If practicable, seventy-five percent of the College's share of new revenue from each invention will be designated for research in the inventor's department or analogous unit up to \$100,000 in a fiscal year for a particular department or analogous unit. The remaining part of the net revenues

shall be devoted to research and the promotion of patenting and patents as directed by the president.

- d. If use of such funds for research within the inventor's department or analogous unit is not practicable or for an amount in excess of \$100,000 per fiscal year, the president may allocate funds for other use within the institution.