



UNIVERSITY SYSTEM
of MARYLAND

Agenda Item 3

USM IP Policy Revisions

SUMMARY OF ITEM FOR ACTION
INFORMATION OR DISCUSSION

TOPIC: USM IP Policy Revisions, T. Sadowski and J. Lenzer (action item)

COMMITTEE: Economic Development and Technology Commercialization

DATE OF COMMITTEE MEETING: November 9, 2017

SUMMARY: The Committee will consider for approval proposed revisions to the USM Policy on Intellectual Property (IV - 3.20). The revisions contain language that would:

1. Permit an institution's policy to include technology-mediated intellectual property in the general provisions of its policy without identifying the technology-mediated IP as such; and
2. Allow an approved institutional policy to provide for a waiver of its provisions through an internally described process, rather than through the Chancellor.

In addition, the Committee will consider a draft resolution to study the threat and recommend appropriate action to guard against patent trolling of USM intellectual property assets by external parties.

ALTERNATIVE(S): This item is for information purposes.

FISCAL IMPACT: This item is for information purposes.

CHANCELLOR'S RECOMMENDATION: This item is for information purposes.

COMMITTEE RECOMMENDATION:

DATE:

BOARD ACTION:

DATE:

SUBMITTED BY: Tom Sadowski (410) 576-5742 / Suresh Balakrishnan (301) 445-2783



IP Policy Changes

Julie Lenzer, AVP of Innovation and Economic Development



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Why did we do this?

- Simplification (29 pages → 9)
- Updates based on recent legal actions, such as risks in lack of assignment of IP to university
- Greater financial incentive to inventors

Key Elements in the New Policy Remain Unchanged from Current Policy:

- Retains flexibility
- Requires an IP Committee to advise on IP issues and policy matters
- Ensures students own all rights for materials they create in performance of their academic work
- The University does not claim copyright in traditional scholarly works of faculty

Key Changes in New Policy

- Scope of Employment – replaced term with work commissioned/directed by UMD
- Copyright – creator owns regardless of on-line or in-person (*some caveats*)
- On-Line Courses – treated same as copyrighted materials
- Software - consolidated into patent / invention section due to same treatment
- Revenue sharing – simplified and increased benefit to inventor(s)

Conflicts with USM Policy

- Delegation of IP Waiver – carry over from previous policy which was waived by Chancellor
- No distinction of “Technology-mediated course and materials”

Request

Approval of proposed modifications to
USM policy to eliminate the conflicts



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Julie Lenzer, AVP, Innovation and Economic Development, and Co-Director, UM Ventures
jlenzer@umd.edu (301) 405-2960

VIII. TECHNOLOGY-MEDIATED INSTRUCTIONAL MATERIALS.

If the University determines that Section VII. is inadequate to cover technology-mediated instructional materials, in whole or in part, the University shall insert its own policy statement in this section. This policy must be consistent with the provisions of Section VII above and must be based on the University's mission and must define technology-mediated instruction and technology-mediated instructional materials, specify ownership rights and responsibilities for reporting by Personnel and Students, describe how materials may be protected and commercialized, specify how costs and Revenue will be allocated, and describe conditions attached to use of work prepared for technology-mediated instruction by Personnel and Students. If the University elects not to have a separate policy statement, this section will say explicitly that Section VII applies to technology-mediated instructional materials. If a University has adopted its own policy on intellectual property which modifies this Policy IV-3.20, as permitted by XII. herein, then technology-mediated instructional materials may, without specific reference, be treated consistently with other intellectual property under the University's approved policy.

XII. ADMINISTRATION

A. Implementation Options. Each University shall elect one of the following options for implementing this policy:

- 1) Adoption. Adopt the USM policy including the requirements in XII.B., below;
- 2) Modification. Modify the USM policy, retaining the requirements in XII.B., below, to reflect the unique needs of the University based on its mission;

B. University Implementation. Each University shall develop procedures for implementing this policy that:

- 1) establish the University's policy on technology-mediated instructional materials, as required in Section VIII. with specific reference to technology-mediated instructional materials, or in the alternative, without specific reference to technology-mediated instructional materials required, the University's policy may treat technology-mediated instructional materials in the same manner as other intellectual property;
- 2) establish guidelines for use of materials protected by copyright, as required by Section V.C.3);
- 3) establish guidelines for use of the University's share of net Revenue within the University, as required by Sections XI.A.3)b) and XI.B.3)b);
- 4) designate an initial point of contact for intellectual

property issues;

- 5) publicize and make available the University policy and implementation procedures;
- 6) provide the Chancellor with a copy of the University's policy for approval prior to initial adoption as well as prior to any subsequent revision (Until such time as the Chancellor provides written approval of the initial University document, this USM document shall apply to the University. Subsequent revisions shall not go into effect until approved by the Chancellor in writing.);
- 7) provide the Chancellor with a copy of the University's implementation procedures for the record.

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, 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.
- 2) Policy waivers. Only the Chancellor may waive any provision of the USM Policy on Intellectual Property. If a University has its own policy on intellectual property which has been approved pursuant to this Article XII. and which includes an alternate process for the approval of waivers under such University policy, waivers may be granted only in compliance with the process provided in such

University's approved policy on intellectual property.

**RESOLUTION OF THE BOARD OF REGENTS OF
THE UNIVERSITY SYSTEM OF MARYLAND
COMMITTEE ON ECONOMIC DEVELOPMENT AND TECHNOLOGY
COMMERCIALIZATION**

WHEREAS, increased attention is being paid to the security of valuable data and intellectual property which may be accessible online; and

WHEREAS, the institutions that comprise the University System of Maryland (USM) are currently engaged in research activities that lead to disclosure and the eventual application, registration, and award of a legal patent; and

WHEREAS, it is incumbent upon the USM to actively address the issue of patent protection as it impacts the system and its institutions,

NOW, THEREFORE, BE IT RESOLVED THAT, the USM shall undertake a comprehensive review of current practices that monitor and protect USM Institutional patents, examine current best practices, and recommended policies for presentation to the USM Board of Regents for consideration and possible action; and

BE IT FURTHER RESOLVED THAT this effort shall be coordinated by the USM's Office of Economic Development and the its Office of Academic and Students Affairs, with findings and any formal recommendations issued prior to the end of Fiscal Year 2019.

DATE

James Brady
Chair, Board of Regents

Robert L. Caret
Chancellor, University System
of Maryland