

## **MORGAN STATE UNIVERSITY POLICY ON PATENTS**

### **I. Objectives**

The objectives of this policy are to encourage and aid research at Morgan State University, to provide financial compensation as well as professional recognition to inventors, and to protect and best serve the public interest. To these ends, this policy encourages disclosure of inventions and discoveries and their evaluation for possible patenting and licensing and establishes principles for determining the rights of the University and inventors. Morgan State University encourages scholarly publication of the results of faculty and student research.

### **II. Applicability**

- A. The Morgan State University Patent Policy applies to all personnel. As used in this policy, "personnel" means all paid and unpaid full-time and part-time faculty members and staff, and all paid employees (including those on approved leaves); students, volunteers and fellows.

### **III. General Policy**

- A. Morgan State University has an interest in all inventions of personnel which are conceived or first actually reduced to practice as a part of or as a result of: a University administered program of research; activities within the scope of the inventor's employment by the University; or activities involving the use, to a substantial degree, of University time, facilities, or materials or of University information not available to the public. "Invention" means any invention or discovery which is or may be patentable or which may be commercially licensable. At the time of appointment of visiting faculty and personnel a signed acknowledgment of this policy will be required. An invention shall be considered as resulting from activities "within the scope of the inventor's employment" whenever the inventor's duties include research or investigation or the supervision of research or investigation and the invention is relevant to the general field of inquiry to which the inventor was devoted or assigned. "Time, facilities and materials" paid for from funds administered by the University shall be considered University time, facilities and materials whether the funds arise from federal or state appropriations, student fees, donations, grants, contracts or other sources.
- B. The University has a right to ownership of any invention in which it has an interest. Unless otherwise agreed, this Policy also applies to any inventions in which the University has an interest under the terms of contracts, grants or other agreements. An invention in which the University does not have a legal interest may be offered to the University and, if

accepted, the University will administer such invention in accordance with this Patent Policy or as otherwise agreed.

- C. Except under special circumstances the University will not assign rights in future inventions to private corporations or businesses.

#### IV. **Responsibilities of the Morgan State University and Delegations of Authority**

- A. The University shall: (1) notify the inventor promptly whenever it decides not to pursue or to abandon the pursuit of patenting or commercialization of an invention, (2) execute, upon request, all contracts, assignments, waivers or other legal documents necessary to transfer to the inventor the University's interest in any invention which it has so chosen not to pursue, (3) act with reasonable promptness and in good faith on all inventions disclosed to it, and (4) remit to the inventors their shares of income from inventions as specified in Section VI of this policy. Subject to these responsibilities, the University may, at any time, decide not to pursue or to abandon the pursuit of patenting and/or commercialization of an invention in which it has an interest.
- B. Authority and responsibility for Patent Policy is delegated to the President (or his designee). The President shall develop procedures for implementing this policy.

#### V. **Responsibilities of Personnel**

- A. Personnel who, either alone or in association with others, make an invention in which the University has or may have an interest shall disclose to the President or designee such invention reasonably promptly. As to an invention in which the University has an interest, 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 complete assignment of any patents or patent applications relating to the invention.
- B. Personnel: (1) may not sign patent agreements with outside persons or organizations which may abrogate or otherwise conflict with the University's rights and interests as stated in this Policy, nor (2) without prior authorization use the name of the University in connection with any invention.
- C. At the time of appointment, visiting faculty and personnel shall sign an acknowledgment of this policy.

#### VI. **Revenue Sharing**

- A. The University shall share with the inventor revenue from a patent or invention. 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, the University 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 net revenues from a patent or invention will be applied first to reimburse the University for expenses in obtaining and maintaining the patent and in marketing, licensing and defending the patent or licensable invention. After reimbursement of such expenses, such revenues shall be shared as follows: (1) the first \$5,000 shall be paid to the inventor or inventors; (2) thereafter the inventor(s) shall receive fifty percent of such revenues. Applicable laws, regulations or provisions of grants or contracts may require that a lesser share be paid to the inventor.
- C. To the extent consistent with State and University policies, any net revenue received on account of an invention, after sharing with the inventor, will be dedicated to research and to the promotion of patenting and patents. If practicable, eighty-five percent of the University's share of new revenue from each invention will be designated for research in the inventor's department or unit up to \$100,000 in a fiscal year. The remaining part of the net revenues shall be devoted to research and the promotion of patenting and patents as directed by the President, or designee.
- 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.

## VII. **Administration**

- A. The Intellectual Property Committee consists of the Vice President for Academic Affairs or designee as an ex officio member and chair and no more than fourteen other members selected and appointed by the President. Members are appointed for three-year terms with non-concurrent expiration dates and may serve successive terms.
- B. The Intellectual Property Committee convenes at the call of the Vice President or designee, who determines when implementation or interpretation of the University Patent Policy requires consideration by the Committee. Among the matters which may be referred to the Committee for recommendation to the Committee are: whether the University has an interest in an invention; questions not covered by policy; and whether some part of the policy should be waived.
- C. When the Committee is considering a particular invention, the inventor

and/or the inventor's representative may examine all materials submitted to the Committee, may make written and oral presentations to the Committee, and may be present during oral presentations of others.

- D. The evaluation of inventions and discoveries and the administration, development and processing of patents involves substantial time and expense and requires talents and experience not ordinarily found in University staff. Therefore, the University may enter into a contract with third parties in connection with the administration of identified inventions, disclosures of invention, and developed patents.
- E. Disputes on patent matters, including the interpretation of this Patent Policy, shall be referred for resolution to the President or designee.

#### VIII. **Special Cases**

The University recognizes that a special case may arise which is not specifically covered by this policy or which may justify waiver of this policy. Only the President or designee has authority to waive the provisions of this policy.