



UNIVERSITY OF GUAM  
UNIBETSEDAT GUAHAN  
BOARD OF REGENTS

RESOLUTION NO. 18-12

RELATIVE TO UPDATING THE UNIVERSITY OF GUAM'S  
INTELLECTUAL PROPERTY POLICY

**WHEREAS**, the University of Guam (UOG) is the primary U.S. Land Grant institution accredited by the WASC Senior College and University Commission (WSCUC) serving the post-secondary needs of the people of Guam and the region; and

**WHEREAS**, the governance and well-being of the University is vested in the Board of Regents (BOR); and

**WHEREAS**, the creation and dissemination of intellectual property is one of the primary activities of UOG to ensure that the public receives the benefit of research and innovation in accordance with its public service mission; and

**WHEREAS**, Article II.I of the BOR-approved Rules, Regulations, and Policy Manual contains a policy on intellectual property that require updating to meet current needs and demands; and

**WHEREAS**, the grants portfolio of the university has tripled in the past 10 years requiring that appropriate steps and policies are put in place to secure and protect innovations developed at the University; and

**WHEREAS**, the Research Corporation of the University of Guam has been created that makes an efficient managerial environment to compete for and manage grants and contracts; and

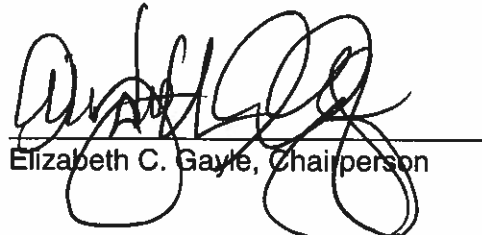
**WHEREAS**, the University is building new public-private partnerships to contribution to the economic well-being of Guam and surrounding region; and

**WHEREAS**, a new policy has been drafted, based on successful models from peer and aspirant institutions, and passed the rigorous review of the Research Council, Administrative Council, Faculty Senate, and Faculty Union; and

**WHEREAS**, the President and the Academic, Personnel and Tenure Committee have reviewed the administration's proposal and recommend it to the Board.

**NOW, THEREFORE, BE IT RESOLVED**, that the Board of Regents hereby approves the updated revised Intellectual Property Policy, which is herein attached.

Adopted this 26<sup>th</sup> day of April 2018.

  
Elizabeth C. Gayle, Chairperson

ATTESTED:



Dr. Robert A. Underwood, Executive Secretary

**UNIVERSITY OF GUAM  
POLICIES AND REGULATIONS CHANGE REQUEST FORM**

**b 5798**

1. Subject: **Intellectual Property Policy**

2. Purpose:

As the University's activities have expanded, a more contemporary, comprehensive, and enforceable policy for intellectual property issues is required. The revised policy improves the Creator's potential share from 33% to 40-45% as an incentive for faculty to create more intellectual property. A comparison with peer institutions (University of Hawaii and University of Puerto Rico) and an aspirant institution (John Hopkins) shows that our new percentages are reasonable, while still improving on existing rates.

The existing policy does not include very specific guidance on how to handle these issues, relying on an overly-large 12 person intellectual property committee to have sufficient expertise to address any situation. The new policy calls for an Intellectual Property Procedures document and empowers the Office of Research and Sponsored programs to manage IP matters.



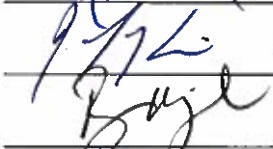
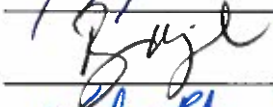

This attached policy is based primarily on the State University of New York's "Patents, Inventions, and Copyright" policy, except for the Copyright section, which is based on the University of Arizona's Intellectual Property Policy.

The policy was created by an ad hoc committee consisting of faculty and administrators. It was reviewed by Research Council and Administrative Council. The RFK Academic Affairs Committee also reviewed the Copyright section.

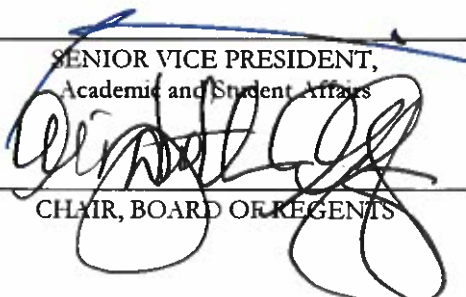


3. Attach Complete Statement of Policy or Regulation (photocopy) and New /Amended Policy (complete), specifying exactly what the changed wording and where it should be inserted in the policy document.

4. Requested Effective Date: May 2018

5. Publication Document (Reference section and/or page number): This is an entire replacement of the Intellectual Property Policy approved in 2000 found on page 29 of the **Rules, Regulations and Procedures Manual**.

UNIT	SIGNATURE (use BLUE pen please)	DATE
Ad Hoc IP Committee	 FOR DAVIE MCKAY	2/13/18
Research Council		2/12/18
RFK Academic Affairs Committee	 FOR COURTNEY MARSHALL	2/13/18
Administrative Council		2/12/18
Faculty Senate		15 March 2018

APPROVED/DISAPPROVED:

	<u>3/23/18</u>		
SENIOR VICE PRESIDENT, Academic and Student Affairs	DATE	PRESIDENT	DATE
	<u>4.26.18</u>		
CHAIR, BOARD OF REGENTS	DATE		

(A) **Purpose**

1. The University of Guam (UOG) fosters the development of Intellectual Property as well as the unrestricted dissemination of research activities. UOG works actively to ensure that its academic community may freely publish the results of scholarly research. In conformance with this principle, all concerned shall cooperate so that essential rights to Intellectual Property shall not be lost.
2. UOG recognizes that the three primary missions of an educational institution are teaching, research, and public service. UOG further recognizes that, in the course of performing its mission, patentable inventions and copyrightable products will be developed under its auspices. UOG encourages such innovation and will take appropriate steps to aid Creators and to ensure that the public receives the benefit of such innovation in accordance with its public service mission. Appropriate steps include securing research support, identifying and encouraging disclosure of the Intellectual Property, securing appropriate protections, marketing Intellectual Property through licensing and other arrangements, and managing royalties and other related income, such as litigation proceeds. These activities are undertaken in a spirit of cooperation with governmental agencies and private industry as part of UOG's contribution to the economic well-being of the island and surrounding region.
3. All Net Proceeds realized from the commercialization or other monetization of UOG Intellectual Property, after payment of the Creator's share as defined in *Section (E)* of this Policy and other appropriate costs associated with the evaluation, marketing, development, protection, maintenance, or enforcement of Intellectual Property, shall be used for the support of UOG research programs in a manner consistent with the *Bayh-Dole Act* and its implementing regulations. Net Proceeds shall be applied in a manner consistent with Intellectual Property Procedures. Upon the request of a Creator, UOG shall provide an accounting of the distribution of royalties earned from Intellectual Property of the Creator.

(B) **Definitions**

1. **Affiliate:** For purposes of this Policy, Affiliates include The Research Corporation of the University of Guam, all campus auxiliary units, and all campus foundations.
2. **Created:** Having conceived, researched, authored, reduced to practice, designed, developed, or otherwise having contributed to the making of Intellectual Property.
3. **Creative and Course Content:** Academic course content and materials Created by Personnel including, but not limited to these examples of Intellectual Property: syllabi, course materials and textbooks; other scholarly or creative works of authorship; instructional, dramatic, musical and artistic works; and manuscripts, articles, poetry, prose, short stories, digital shorts, novels, plays, screenplay.
4. **Creative Content of Grants and Grant Proposals:** The research agendas, applications, proposals, protocols, and/or results of grant proposals submitted and/or awarded.
5. **Creator:** One who has Created Intellectual Property, in whole or in part.
6. **Incidental Use of UOG Resources ("Incidental Use"):** Any use of publicly or routinely-available UOG resources, such as residence halls, common areas, meeting rooms, Research & Education Centers, laboratories, cafeterias, gymnasiums, libraries, office spaces, furnishings, office supplies, photocopiers, telephones, fax machines and other standard office equipment, personal-type

computers, and commercially available software in use on such computers, computer and communications networks, including internet access and data storage, that is nonessential to the creation of Intellectual Property, and any use of UOG resources by a Student in accordance with assigned coursework pursuant to that Student's academic curriculum.

7. **Intellectual Property:** Copyrightable Creative and Course Content and Patentable Inventions such as: tangible research materials, computer software, and any unique or novel innovation in the technical arts or any new and useful improvements thereof, including methods or processes for creating an object or result (a way of doing or making things), machines, devices, products of manufacture, product designs, or composition, layout designs for printed circuit boards or integrated circuits, compositions of matter, materials, any variety of plant, and any know-how essential to the practice or enablement of such innovations and improvements, whether or not patentable or patented.
8. **Intellectual Property Procedures:** A set of guidelines for interpreting and following the Intellectual Property Policy. A supplement to the policy, this document is provided to personnel and students and maintained by the Office of Research and Sponsored Programs. The procedures are periodically reviewed and revised by the Research Council or other duly appointed committee, under the authority of the President
9. **Inventor:** One who contributes to the conception of a Patentable Invention under the patent laws of the United States or other relevant jurisdiction.
10. **Net Royalty:** Royalty less reasonable expenses incurred by UOG and not reimbursed by licensees for the evaluation, marketing, development, protection, maintenance, and enforcement of the subject Intellectual Property.
11. **Partner:** Any entity or individual who is neither Personnel nor Student, who engages with UOG or a UOG Affiliate through a contract or other business transaction that facilitates the research, teaching, or public service missions of UOG.
12. **Patentable Invention:** Any art or process (way of doing or making things), machine, manufacture, design, or composition of matter, or any new and useful improvement thereof, or any variety of plant, which is or may be patentable under the patent laws of the United States or other relevant jurisdiction, and the patent applications or patents that embody them.
13. **Personnel:** All full-time and part-time employees of UOG and UOG Affiliates, Student employees (including, but not limited to, research assistants/associates, teaching assistants, extension assistants/associates, fellows, post-doctoral scholars, and Students providing services under sponsor agreements), and other persons holding any paid appointment or position with UOG. Contract Employees are not Personnel in this case.
14. **Royalty:** Cash, equity, or other value received by UOG as consideration for use of rights to UOG Intellectual Property.
15. **Students:** Individuals enrolled in UOG, including, but not limited to, continuing education, undergraduate, graduate and professional students, non-degree students, and not-for-credit students.
16. **Substantial Use of UOG Resources ("Substantial Use"):** Any use of UOG resources that is more than Incidental Use, including, but not limited to, use of: financial support, funds and grants administered by UOG or a UOG Affiliate; inter-institutional collaborations facilitated by UOG; equipment, facilities, services, laboratories, or space; computers and computer or communications networks not publicly or routinely-available; research, clinical, or other scientific instruments; time

spent by Personnel, including secretarial, clerical, administrative staff, and research/extension assistants/associates and teaching assistants; confidential information; Inventions and other proprietary or intellectual property owned by UOG; and any privileged access as a result of a person's affiliation with UOG.

17. **The University of Guam ("UOG"):** References to "UOG" in this Policy may include Affiliates where appropriate under the contexts, whether or not specifically stated. In addition, at the request of UOG, UOG Ownership of Intellectual Property, *Section (E)1* of this Policy, may include ownership, management, promotion, licensing and other transfers, commercialization, and monetization of certain Intellectual Property by the Research Corporation of the University of Guam.

**(C) Scope**

1. This Policy applies to Intellectual Property Created, in whole or in part, by UOG Personnel, Students, Affiliates, and Partners using UOG resources.
2. This Policy sets forth the rights and responsibilities of UOG and UOG Personnel, Students, Partners, and Affiliates in the development, creation, ownership, protection, maintenance, dissemination, marketing, licensing, and monetization of Intellectual Property.
3. Copyrightable products are covered in *Section (I)* of this policy.

**(D) Ownership of Intellectual Property**

1. UOG Ownership: Subject to the exceptions of *Section (D)2* of this Policy, UOG shall own, and Creator shall promptly disclose and assign to UOG, Intellectual Property Created, in whole or in part:
  - a. Within the scope of the Creator's employment by UOG; or
  - b. Through the Substantial Use of UOG Resources, unless otherwise agreed upon in writing prior to the undertaking of the project.
2. Creator Ownership: Ownership rights to Creative and Course Content shall be governed by *Section (I) of this Policy*. A Creator who is Personnel may retain ownership rights to Intellectual Property that is not Creative and Course Content if:
  - a. The Intellectual Property was Created exclusively outside the scope of the Creator's employment by UOG; and
  - b. The Intellectual Property was Created through no more than Incidental Use of UOG Resources; and
  - c. Creators of Intellectual Property satisfying *Section (D)2.a* and *Section (D)2.b* [above] shall submit a disclosure form as prescribed in UOG's Intellectual Property Procedures.
3. Student Ownership: A Creator who is a Student, and not also Personnel, may retain ownership rights to Intellectual Property Created through no more than Incidental Use of UOG resources, subject to those restrictions that may be required by an external sponsor, if any. A Student shall own the copyright to his or her thesis unless an agreement supporting the underlying work specifies otherwise. Under all circumstances, UOG shall have an unrestricted royalty-free license to reproduce and disseminate Student theses.

For Students who conduct a thesis project that is tied to a faculty member's ongoing research/outreach (through a grant, funded project, or institutional grant or contract) authorship of publications generated as a result of this research/outreach may be subject to institutional and

Principle Investigator (PI) prerogative as well as conditions established by funding agency/agencies. Any thesis project that is supported fully, or in part, by institutional and or federal funds is subject to joint authorship and other conditions. Prior to embarking upon a thesis that is fully, or in part, funded by UOG and or federal grant funds, considerations regarding authorship and other conditions must be agreed upon in writing by the Office of Research and Sponsored Programs, the PI/Thesis Chair, Dean, and the Student.

Students are strongly encouraged to publish their thesis research. However, there may be occasions when a Student who conducts independent research, without any funding from UOG or through federal funds, is not interested in publishing their own research findings. In this case, a Student may, in writing, grant permission to their faculty chair and/or other committee member(s) to publish findings from the research project/thesis. The resulting publication(s) must acknowledge the Student.

4. **Partner Ownership:** Where UOG intends that a Partner engage in Substantial Use of UOG Resources, the ownership of Intellectual Property Created by, or for the Partner, in connection with the use or sponsorship of UOG Resources, shall be formalized in a written agreement between the Partner and UOG or an Affiliate prior to commencement of the project.
5. **Joint Ownership:** Intellectual Property may be subject to exercise of ownership rights by two (2) or more parties, including UOG Affiliates, Personnel, Students, and Partners, in which case joint ownership, may be appropriate.
6. **Questions as to Ownership:** Where any dispute is raised as to ownership of Intellectual Property, patents, or patent applications under these provisions, the matter shall be referred to the Innovation Policy Board in a manner consistent with UOG's Intellectual Property Procedures.

**(E) Royalty Income**

1. **Patentable Inventions:** With respect to any Patentable Invention obtained by, or through, UOG or assigned to or as directed by UOG in accordance with the foregoing provisions, UOG, in recognition of the meritorious services of the Inventor and in consideration of the Inventor's assignment of the Patentable Invention to UOG, will make provision entitling the Inventor and the Inventor's heirs or legatees to share in the proceeds from the management and licensing of such Patentable Invention to the extent of forty-five percent (45%) of the first \$100,000 of Net Royalty received by UOG and forty percent (40%) of Net Royalty thereafter, unless the Inventor and UOG agree otherwise in a written and duly executed instrument, or if these amounts exceed the limits fixed by applicable regulations of the relevant sponsoring agency; which will control in such cases.
2. **Computer Software and Intellectual Property Other Than Patentable Inventions:** With respect to any Intellectual Property that is not a Patentable Invention, including Computer Software that is not a Patentable Invention nor subject to copyright, Created in the performance of academic or research/outreach activities and obtained by, or through, UOG or assigned to or as directed by UOG in accordance with the foregoing provisions, UOG, in recognition of the meritorious services of the Creator and in consideration of the Creator's assignment to UOG, will make provision entitling the Creator and the Creator's heirs or legatees to share in the proceeds from UOG's management and licensing to the extent of forty-five percent (45%) of the first \$100,000 of Net Royalty received by UOG and forty percent (40%) of Net Royalty thereafter, unless:
  - a. The Intellectual Property is a work for hire or subject to a conflicting obligation to a sponsor or a Partner; or
  - b. The Creator and UOG agree otherwise in a written and duly executed instrument; or
  - c. This distribution amount exceeds limits fixed by applicable regulations of the relevant

sponsoring agency; sponsoring agency regulations will take precedent in such cases.

**(F) Release and Waiver**

1. UOG shall make decisions regarding evaluation, marketing, development, protection, maintenance, or enforcement of Intellectual Property in consultation with the Creator(s). At the Creator's (or Creators') written request, UOG may release its ownership rights to the Intellectual Property to the Creator(s), subject to those restrictions that may be required by an external sponsor, if any.
2. UOG shall make an initial determination regarding whether to retain title to Intellectual Property within one (1) year of UOG's acceptance of the Creator's fully disclosed, assigned, and properly executed disclosure statement. UOG shall proceed with patenting, developing and marketing of the Intellectual Property by UOG as soon as practicable thereafter. If UOG elects not to retain title or fails to make such an election within one (1) year, all of UOG's rights to the Intellectual Property shall be released upon written request to the Creator, subject to those restrictions that may be required by an external sponsor, if any.
3. For any Intellectual Property so released to its Creator(s), UOG shall receive ten (10) percent of the Net Proceeds (paid) to the Creator(s), in recognition of the contribution of UOG and the people of Guam to the support of the research that resulted in the Intellectual Property. "Net Proceeds" as referenced in this subpart, *Section (F)3*, means income realized by the Creator from commercialization or other monetization of the Intellectual Property, less reasonable costs incurred directly by the Creator for the evaluation, marketing, development, protection, maintenance, or enforcement of the subject Intellectual Property.

**(G) Innovation Policy Board**

1. The UOG President shall establish and appoint an Innovation Policy Board of the University of Guam and designate the chair thereof in accordance with UOG's Intellectual Property Procedures. The Innovation Policy Board shall have full powers of the organization to undertake periodic review of this Policy and to create, revise and enhance guidelines, procedures, and forms to interpret and implement this Policy.

**(H) Applicability**

1. Intellectual Property which is fully disclosed and assigned in a properly executed disclosure statement before the effective date of these regulations shall be subject to UOG's prior Intellectual Property Policy.

**(I) Copyright**

1. Title 17 of the U.S. Code on copyrights is the foundation for this section. Where jurisdictional disputes arise, private international law may apply. Copyright may be subject to terms and conditions of external funding agencies and those conditions supersede UOG policy.
2. This section shall apply to all publishable materials, including academic course content and materials, as well as materials created for online delivery using technology adopted by UOG. Creators must not copyright items, in whole or in part, in the public domain or for which there is existing copyright owned by another party.
3. In general, UOG *does not* claim copyright (i.e., the tangible expression) of Intellectual Property defined in *Section (D)2*. This means that Creators of scholarly or creative works may research, craft,

publish, reproduce, distribute, perform, and display their works without prior authorization of, or interference by, the University, assuming that any non-UOG use is Incidental and reasonable and does not place an unreasonable burden on UOG resources or the employee's time. Faculty time equivalent to a one-semester load allocation or course release or less would be considered incidental use.

4. UOG *does* claim ownership of said content, as listed above, if a Creator has been paid to produce a specific product, including through "Substantial Use" of UOG resources, unless otherwise stated in writing and approved by the UOG President.
5. Course or other salable materials produced by personnel and commercialized by an outside institution are subject to a 5-percent return to the University on gross sales or as otherwise negotiated with the University. Whenever possible, any commercialization is encouraged via the UOG Press and in-house technologies.
6. The Dean of the respective unit from which the course content or materials arises shall manage intellectual property issues related to this section. The Senior Vice President, or designee, shall serve as the appellate authority.



*Approved by the Board of Regents, February 17, 2000*

The University of Guam encourages and supports the development of intellectual property. The University Research Council will serve as an advisory body on matters pertaining to University intellectual property.

## **1. INTELLECTUAL PROPERTY SUBCOMMITTEE**

### **Membership**

The Intellectual Property Committee shall consist of twelve (12) members. Six (6) shall be faculty members chosen to reflect a diversity of expertise, appointed to three (3) year staggered terms. Three (3) members shall be appointed by the Vice President, Academic Affairs; and three (3) by the Faculty Council. One (1) additional faculty member shall be appointed to a three (3) year term by the President. The remaining five (5) shall be administrators appointed by the President. The Committee shall elect its Chair.

### **Functions**

The Intellectual Property Committee shall represent and act for the University in intellectual property policy matters subject to the approval of the President of the University.

### **INTELLECTUAL PROPERTY POLICY**

Intellectual Property is defined as any original idea or data subject to competing claims and legal protection. It includes patents, copyrights, trade marks, trade secrets and plant protection certificates.

All members of the University including faculty, research associates, staff, students, graduate assistants and research assistants in any combination of study, research and teaching shall be subject to the provisions of this policy.

Members of the University shall retain the right and responsibility to develop intellectual property, and in every case complete freedom of publication by the creator in both time and scope shall be maintained, unless agreements with outside sponsors provide otherwise. Three (3) separate relationships between the creator and the University are recognized.

### **Class I**

If intellectual property is developed wholly with University support in time, personnel, money, materials, or facilities, said intellectual property is the property of the University and the creator is responsible for disclosing in full to the IPC the nature of the invention and for providing documentation as to those who participated in its development. If the author of a manuscript believes that it contains legally protectable material and wishes University assistance in marketing it, a copy of the manuscript should be submitted to the IPC prior to its submission for publication. The IPC may advise deferral of publication to protect intellectual property rights of both the creator and the University, but no prior submission of any manuscript nor any delay of publication shall be imposed by the University.

## **Class II**

If intellectual property is developed under an agreement with an outside sponsor and/or is developed with partial support from the University, the rights with respect to intellectual property created in the course of such work shall be governed by the provisions of that agreement only to the extent the provisions do not conflict with this policy. Unless waived, the University shall have the right to elect whether or not it will retain intellectual property rights for any such invention. Where the University retains intellectual property rights the exercise of those rights will be carried out in accordance with other provisions stated herein, subject to any restrictions imposed by the sponsor.

## **Class III**

If intellectual property is developed without University support or where the University has waived or forfeited its rights to Class I or II intellectual property, all rights belong to the creator. Such intellectual property may be voluntarily submitted for consideration, but the creator is under no obligation to do so.

## **Class I and II Creator Rights**

The University may exercise its right to undertake the registering, patenting, development, and marketing of the intellectual property and shall bear all related costs. The creator shall receive, on an annual basis, 33 1/3% of any royalties or other payments derived directly from the marketing of the intellectual property received by the University after expenses related to the registering, development, patenting, and marketing have been paid. The other two-thirds of the income shall be allocated to the Dean of the college(s), or Director of the Research Unit of the creator(s), for support of research.

## **Class III Creator Rights**

A creator who personally obtains legal protection for his or her intellectual property may nevertheless submit his or her creation to the Committee for consideration of its commercial potential. The Committee and the creator may enter into an agreement whereby the University assists in the marketing of the intellectual property in consideration of the sharing of royalties for such other payments to the University as may be appropriate.

The University shall not enter into any agreement with any outside party which fails to safeguard the rights of the University community members as outlined in this policy.

In situations where the invention is the product of joint creative effort, the IPC shall, upon consultation with the creator, determine an equitable division of any creator's share payable under this policy.

## **Procedures**

After the disclosure to the IPC of the nature of a creation, the Committee shall, within forty-five (45) business days, advise the creator whether it wishes to take initial steps to register, develop, patent, and market the creation. If the creator agrees, the IPC may choose to only register, develop, and market but not patent intellectual property. Within ninety (90) business days thereafter the IPC shall inform the creator of its decision whether or not to register, develop,

patent, market, and otherwise commercially exploit the intellectual property. If the IPC decides not to register, develop, patent, market, and otherwise commercially exploit the intellectual property or if it fails to meet the deadlines outlined here, all intellectual property rights to the intellectual property, save the right of the University to a non-exclusive use of Class I and II intellectual property shall pass to the creator.

The University will promptly make every reasonable effort to promote commercially intellectual property to which the University has acquired rights. To this end the University may employ the services of a qualified intellectual property management organization, business organization experienced and competent in the field of the intellectual property involved, or the University of Guam Foundation with the objective of making available to the public the related processes and products at reasonable prices and of appropriate quality. The University shall be responsible for providing adequate funding, shall provide for the promotional work, and is empowered to enter into negotiations with outside agencies to accomplish this work. If after three years the creator is dissatisfied with or questions the development efforts of the University, he or she may review such dissatisfaction with the IPC. In such cases the Committee shall respond within sixty (60) business days by finding the complaints to be unwarranted, by assuring the creator that corrective steps will be taken or by returning all intellectual property rights to the creator. If the Committee does not meet this deadline, legal rights to the intellectual property, save a non-exclusive use for the University, shall pass to the creator automatically.

Notwithstanding any language contained herein to the contrary, the copyright of all textbooks and scholarly works, including those of pictorial art and music, but excluding computer software other than that produced outside the line of University duty and on the creator's own time and without the use of University facilities, shall be the property of the creator(s). Works specifically commissioned by or through the University, however, will be deemed a work made for hire as defined in 17 U.S.C. § 101.

Professors who create intellectual property and assign the same as required reading for their UOG classes shall assign all royalties earned thereby to the Dean of their college for the support of research.

Notwithstanding any language to the contrary, the time deadlines set forth above may be expanded by the President for the good of the University.