



Code: QA507IP

Title: **INTELLECTUAL PROPERTY POLICY**

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## 1. Introduction

1.1 The Policy provides for the effective management of Intellectual Property created by University Personnel, including when working with other entities. It establishes the rules governing the ownership, disclosure, protection, and commercialisation of University Intellectual Property. The Policy also provides for the distribution of income arising from the commercialisation of University Intellectual Property.

1.2 An **Independent Intellectual Property Advisory Oversight Committee**, chaired independently of University Personnel, provides oversight and guidance on the implementation of the Policy. The Committee meets quarterly and provides reports to both the **Academic Planning and Resource Committee** and the **Finance Resource Committee**.

1.3 This document supersedes and replaces the Previous Policy.

## 2 Definitions

"**Contributor**" means a member of University Personnel who is employed specifically to develop particular IP and who significantly advances the Intellectual Property but is not an Inventor;

"**Entity**" means any company, organisation, institution, establishment, body, operation, structure, system, or individual which is not the University;

"**Intellectual Property**" or "**IP**" means patents, trademarks, service marks, registered designs, drawings, utility models, design rights, business ideas, concepts, inventions, discoveries, breeders' rights, trade secrets, copyright (including the copyright in software in any code), database rights, know-how and other confidential information, technology, business or trade names, goodwill and all other rights of a similar or corresponding nature in any part of the world, whether registered or not or capable of registration or not, and including all applications and the right to apply for any of the foregoing rights;

"**Inventor**" means a member of University Personnel who invents, discovers, or otherwise creates Intellectual Property;

"**Invention Disclosure Form**" or "**IDF**" means the record of an invention and the circumstances under which the invention was made. It provides the basis for a determination of patentability and the data for drafting a patent application;

"**IP Expenses**" include all patent, legal, insurance, and professional fees associated with patent protection and exploitation;

"**IP Income**" means cumulative payments received by the University from royalties, option fees, license fees, the sale of the University's equity interest in a Spin-out Company and any other payments that are made to the University in consideration of the grant or transfer of the commercial rights of University Intellectual Property;

"**Lessee**" means a company that is located on campus that has entered into a facilities lease agreement with the University but is not utilizing any UIP;

"**Net IP Income**" means IP Income after the deduction of all IP Expenses;

"**OVPR**" means Office of the Vice President for Research;

"**Policy**" means the Intellectual Property Policy of the University;

"**Previous Policy**" means the "National University of Ireland, Galway Intellectual Property Policy and Procedures" published August 2, 2007;

"**Research Student**" means any undergraduate or postgraduate student of the University, who is in receipt of University-administered stipend, scholarship, grant or salary which is intended to enable the student to carry out research, or is engaged in a research project that is being carried out for a party with which the University has a contract (including but not limited to a funding agency, industry partner or charity), or which is for the express purpose of securing a contract with an external party and the student has been advised and has consented to the inclusion of the student's research;

"**Spin-out Company**" means a company established for the purpose of exploiting University Intellectual Property;

"**TTO**" means the Technology Transfer Office of the University who operate under the auspices of the OVPR;

"**University**" means National University of Ireland, Galway;

"**University Assets**" means all facilities, materials, and University Intellectual Property;

"**University Intellectual Property**" or "**UIP**" means any Intellectual Property generated by University Personnel;

"**University Personnel**" means all employees and Research Students of the University, Visiting Researchers, adjunct staff, consultants, emeritus staff and all others participating in research programmes carried out for the University or undertaken using University Assets; and

"**Visiting Researcher**" means an individual who is visiting the University for the purposes of undertaking any work or research for or at the University.

### **3 Conflicts of Interest and Conflicts of Commitment**

Pursuant to the University's policies and procedures for the disclosure and management of conflicts of interests and conflict of commitment, University Personnel shall:

- 3.1 Avoid ethical, legal, financial, or other conflicts of interest and shall ensure that their activities and interests do not conflict with their obligations to the University or its welfare.
- 3.2 Ensure that any arrangements made personally with another entity do not conflict with their intellectual property obligations as set out in this Policy.
- 3.3 Disclose to the University all relationships with and/or financial interests in another entity before the University will approve any arrangements between such an entity and the University including but not limited to: UIP licensing, and Spin-out formation.

Advice on conflicts is available from the Conflicts of Interest and Commitment Committee.

### **4 Ownership of University Intellectual Property**

- 4.1 Subject to the exemptions set out in this Policy at section 4.4, all University Intellectual Property is the property of and vests solely and absolutely in the University. The TTO is responsible for the management of the University's Intellectual Property. As such, the TTO is responsible for all negotiations, evaluation, marketing, licensing, assignment, and disposal of the University's Intellectual Property.
- 4.2 The Policy applies particularly but not exclusively to any University Intellectual Property arising from the work of:
  - 4.2.1 University Personnel in the course of their employment; and
  - 4.2.2 University Personnel in the course of their employment whilst on the premises of another entity; and
  - 4.2.3 University Personnel creating IP outside the course of their employment with \*significant use of University Assets; and

4.2.4 University Personnel in the performance of any work for the University including work performed under another agreement.

\*Decisions with respect to what constitutes significant use of University Assets is at the discretion of the TTO.

4.3 University Personnel who have a prior existing and conflicting intellectual property arrangement with another entity must enter into an agreement with the University (and the relevant entity) to abide by the conditions of this Policy.

4.4 Exemptions to University ownership of Intellectual Property created by University Personnel include:

4.4.1 IP that the TTO deems to be of a non-commercial nature; and

4.4.2 IP that is unrelated to an individual's University duties provided he or she does not make significant use of University resources or University information or University Intellectual Property or University Assets; and

4.4.3 IP arising from the research of unpaid students under the direction of University Personnel (with the exception of cases where that work is subject to the terms and conditions of any other agreements); and

4.4.4 IP arising from the activities of a Lessee.

## **5 Disclosure of University Intellectual Property**

5.1 University Personnel must disclose all University Intellectual Property on a timely basis to the TTO. This is achieved by completing an Invention Disclosure Form as soon as possible after the creation of the University Intellectual Property and in any event, prior to any disclosure of information relating to the University Intellectual property to another entity, or the submission of abstracts or manuscripts for publication containing University Intellectual Property.

5.2 In making such a disclosure, University Personnel must declare the names of all Inventors and Contributors and specify their relative contributions to the University Intellectual Property.

## **6 Assignment of Intellectual Property to the University**

6.1 All Inventors and Contributors of University Intellectual Property must assign all rights in the respective University Intellectual Property to the University.

## **7 Protection of University Intellectual Property**

7.1 The effectiveness of the University's Intellectual Property management depends on University Personnel being aware of and complying with this Policy.

7.2 The Inventors and the Contributors are required to provide assistance and to perform all obligations necessary to enable the University obtain protection for University Intellectual Property.

7.3 It is crucial to maintain the confidentiality of University Intellectual Property prior to evaluation thereof. University Personnel must not publish or otherwise disclose University Intellectual Property until appropriate protections are in place. The TTO will notify University Personnel when publication can take place.

7.4 University Personnel who wish to disclose unprotected confidential information (relating to University Intellectual Property) to another party must first contact the TTO. The TTO arranges for a suitable confidentiality agreement to be in place prior to any discussions taking place.

7.5 University Personnel who intend to provide, receive or exchange materials with other parties should first consult the TTO. The TTO arranges for a suitable material transfer agreement to be in place before the exchange of any materials.

- 7.6 All UIP disclosed to the TTO is evaluated for its commercialisation potential. If that evaluation concludes that the UIP is patentable and has strong commercial potential, then the TTO, in consultation with the Inventor(s), files a patent application. The TTO, in consultation with the Inventor(s), and where appropriate, the licensee is responsible for all decisions concerning the continued prosecution and maintenance of patents. In making such decisions, consideration is given to factors such as the commercial potential of the UIP, contractual obligations to other entities, the maturity of the technology, the availability of further research or funding, and the views and support of the Inventor(s).
- 7.7 All notebooks and records maintained by University Personnel are subject to legal scrutiny in the application for UIP protection. Therefore, all University Personnel are obliged to maintain accurate and contemporaneous records of the steps leading to their invention/discovery. University Personnel are obliged to retain data generated in the course of their research in accordance with the NUIG Laboratory Notebook Policy. The University requires that such data is securely retained upon completion of a project.

## **8 Commercialisation of University Intellectual Property**

- 8.1 The commercial value of University Intellectual Property is generally realised through licensing to other entities. The TTO is responsible for the commercial exploitation of University Intellectual Property and selects commercial partners based on their ability to exploit the University Intellectual Property for the benefit of society. The commercial terms vary depending on factors such as the type of technology, the stage of its development, contractual obligations to funding bodies or industry parties as relevant, and the nature and extent of the contributions (if any) of the respective industry party. In commercialising University Intellectual Property, the TTO considers international best practice, the National IP Protocol and other relevant codes and guidelines. The payment terms negotiated typically include royalties on sales, and other payments such as upfront payments and development milestone payments. The TTO negotiates licence terms on a case-by-case basis.
- 8.2 The TTO negotiates appropriate commercial agreements on behalf of the University. University Personnel do not have the right to license any rights in University Intellectual Property to other entities without the prior written authorisation of the TTO.
- 8.3 In the event that the University decides not to commercialise or otherwise exploit University Intellectual Property, the University may assign such University Intellectual Property to the Inventor(s) upon request. If the University agrees to assign University Intellectual Property to an Inventor, such assignment will be contingent on the University receiving a fair consideration arising from such assignment. For the avoidance of doubt, once the University assigns Intellectual Property to the respective Inventor(s), he/she will be subsequently responsible for the management and costs associated therewith.
- 8.4 The University encourages and supports the formation of Spin-out Companies to promote new jobs and to develop University Intellectual Property.
- 8.5 The University permits University staff to organise and assist in the running of Spin-out Companies in accordance with University Code of Conduct for Staff on work outside the University.
- 8.6 In consideration of public investment in research, leading to the development of University Intellectual Property, and the benefits bestowed on a Spin-out Company by association with the University and support from its start-up programs, the University is allocated shares in the issued share capital of the Spin-out Company.
- 8.7 Where the University receives equity in a Spin-out Company the University has discretion in the disposal of that equity.
- 8.8

## 9 Conditions for formation of a Spin-out company

The TTO, in consultation with the appropriate College Dean(s) is responsible for the approval of University designated Spin-out companies. In order to request approval the applicant must:

- 9.1 Incorporate as a limited company with the Companies Registration Office; and
- 9.2 Provide a business plan including but not limited to information and evidence of: Inventors and contributors equity share, management team, commercial opportunity, UIP to be licensed, sources of funding, and any proposed research collaborations with the University; and
- 9.3 Provide a letter of endorsement from the appropriate head(s) of school.

## 10 Conditions for licensing or assigning University Intellectual Property

The TTO, in consultation with the appropriate College Dean(s) is responsible for approval of the commercial terms under which UIP is licensed.

To protect the academic freedom of the University and University Personnel, the following terms are incorporated (inter alia) into all commercialisation agreements:

- 10.1 Grant-back of licensed University Intellectual Property to the University for research and education purposes; and
- 10.2 All University Intellectual Property is provided on an "AS IS" basis without any warranties.

## 11 Net IP Income Distribution

- 11.1 The University shares Net IP Income with the respective Inventor(s) and Contributor(s). The University distributes Net IP income in accordance with Table-1.

Net IP Income(€)	<sup>1</sup> Inventor(s) Contributor(s)	<sup>2</sup> School	<sup>3</sup> University
< €125,000	75%	15%	10%
€125,001 - €200,000	50%	30%	20%
€200,001 - €500,000	40%	30%	30%
€500,001 - €1,000,000	35%	30%	35%
>€1,000,001	30%	30%	40%

Table 1: Distribution of Cumulative Net IP Income

<sup>1</sup> The distribution of Net IP Income to Inventor(s) and/or Contributor(s) is to reward the development of research and the respective allocations are based on relative intellectual contributions as set out in the IDF.

<sup>2</sup> The respective schools share of Net IP Income is to recognise, support, and encourage research that generates University Intellectual Property with meaningful impact.

<sup>3</sup> The University's share of Net IP Income supports, firstly, technology transfer, secondly, innovation programs as determined by the OVPR, and thirdly core university activities.

- 11.2 Where an Inventor or a Contributor holds a shareholding in a Spin-out company which has received access to University Intellectual Property, then such Inventor(s) and/or Contributor(s) are not entitled to a share of Net IP Income as they have already received a benefit arising from their respective shareholding.

- 11.3 For the avoidance of doubt, the University recovers all IP Expenses incurred in the protection and management of University Intellectual Property before distributing the Net IP Income.

## **12 Dispute Resolution**

Any dispute in relation to the Policy or its effects is provided for in the NUIG Dispute Resolution Procedure. Expenses incurred by the University in resolving disputes are deducted from Net IP Income before distribution.

## **13 Contact**

Direct all queries on this Policy to the TTO.

## **14 Related Documents**

All related documents are available from the TTO.