

**THE ADAPT SUPPORT UNIT:  
GUIDANCE NOTE SERIES 2: NO 3**

**GUIDE TO INTELLECTUAL  
PROPERTY RIGHTS**



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NO 3

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PROPERTY RIGHTS

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# Contents

	Page
1. Introduction .....	1
1.1 This Guidance Note .....	1
1.2 Why is IPR important? .....	1
1.3 Structure of the Note .....	2
2. Intellectual Property Rights Framework .....	3
2.1 Definition of IPR .....	3
2.2 Background rights and foreground rights .....	3
2.3 Infringing the IPR of others .....	4
2.4 Legal systems .....	4
3. Outputs and Users .....	5
3.1 Who will be interested in products? .....	5
3.2 Matching outputs and users .....	5
3.3 Which outputs have IPR implications? .....	6
3.4 Who gets the benefit of project results? .....	7
4. Addressing IPR Issues .....	8
4.1 IPR during project development .....	8
4.2 Developing an exploitation strategy .....	10
4.3 Agreements between partners .....	10
4.4 Rights of co-funders .....	11
4.5 Marketing the outputs of projects .....	12
ANNEX 1: Stakeholder Analysis Exercise .....	13
ANNEX 2: Example of Intellectual Property Policy (University of Wales, Swansea) .....	15
ANNEX 3: Analysis of Opportunity Exercise .....	27

# 1. Introduction

## 1.1 This Guidance Note

This Guidance Note has been prepared by the EMPLOYMENT and ADAPT Support Units in conjunction with TOUCAN. It aims to provide information for projects under the EMPLOYMENT and ADAPT Initiatives in relation to Intellectual Property Rights (IPR) and to explore the IPR implications of disseminating the results of projects. It provides points which projects should consider in conjunction with the process of developing and disseminating outputs, including checklists of questions to be covered.

Dissemination of the results of projects is a key criterion in the Initiatives. A separate Guidance Note has been prepared on Dissemination - covering what to disseminate, the audience for dissemination, how and when to disseminate. This is available on request from the Support Units.

Applicants for European Social Fund (ESF) support which expect to generate revenue from activities within the life of the ESF project should declare this at application stage, and any revenue income generated by the project must be deducted from the total cost before the ESF amount is calculated.

## 1.2 Why is IPR important?

EMPLOYMENT and ADAPT projects promote best practice activities to be used by others outside of those involved in the original project, as well as being further developed and maintained by the original promoters.

This means that organisations involved in projects will share their work with the other partners in the project, and more widely. There are implications of sharing within the partnership and with organisations outside of the partnership. For example:

- you may wish to exploit commercially the results of the project e.g. sell CDs, video tapes, training materials, license the use of training courses;
- you may wish for recognition of the project work and/or your part of the project work in future in terms of the ownership of results;
- you may want to protect the quality of products from being changed by others.

Also you have a duty to make sure you have not placed your work at risk by including the Intellectual Property of someone else.

### 1.3 Structure of the Note

This Note is divided into sections as follows:

- Section 2 gives a definition of IPR and the framework of rights in which it operates;
- Section 3 deals with the outputs of projects and gives suggestions for ways to explore the IPR implications in relation to different types of outputs, and the users involved;
- Section 4 gives suggestions for dealing with IPR implications within the project partnership, and provides information for projects in relation to sharing the outputs of projects with a wider audience.

## 2. Intellectual Property Rights Framework

### 2.1 Definition of IPR

According to the World Intellectual Property Organisation (WIPO), Intellectual Property was defined in 1967 as:

**“The rights relating to literary, artistic and scientific works, performances of performing artists, phonograms and broadcasts, inventions in all fields of human endeavour; scientific discoveries; industrial designs; trade marks, science marks and commercial names and designations; and all other rights resulting from intellectual activity in the industrial, scientific, literary and artistic fields.”**

More simply, Intellectual Property relates to any materials:

- inventions
- artistic works
- designs
- trade names and logos
- software
- database information
- know-how and other results of mental effort.

So IPR includes:

- patents for inventions
- copyright
- designs
- trade marks
- know-how including commercially valuable secrets.

### 2.2 Background rights and foreground rights

In ownership of results we refer to background rights and foreground rights.

**Background rights** are existing rights brought into the project by one or more of the partners. These are normally retained by the partner.

**Foreground rights** are rights developed within the project itself, owned by the project consortium partners. Partners must agree, preferably at an early stage how these rights are distributed, including:

- a method of assigning ownership, and publication rights, applying to materials produced during the project;
- confidentiality clauses or restrictions applying to products produced by partners during the project;
- any restrictions on the use of results by partners or others after the end of the project.

Information already in the public domain is exempt from Intellectual Property agreements.

## 2.3 Infringing the IPR of others

You have a duty to make sure you have not included the Intellectual Property of anyone else in your outputs.

## 2.4 Legal systems

Intellectual Property Rights relate to the country in which agreements are made and there are variations between the rules applying in different Member States.

### Brief guide to copyright issues

Copyright law is designed to give Intellectual Property Rights to authors and creators of original materials. Key points to bear in mind are:

- original artistic and written works are automatically copyrighted from when they are created - registration of copyright is not required, although registration does give additional protection (and is a prerequisite of an infringement suit);
- where an author/creator is working as an employee the copyright is automatically owned by the employer;
- where the author is contracted on a freelance basis, the copyright is owned by the author unless a written agreement is made to transfer the right of ownership (just because you pay for a piece (e.g. a photograph) does not mean you own it unless you have a transfer of copyright document);
- an author's copyright lasts for 70 years from their death, and a publisher's copyright lasts for 25 years from the date of first publication of the edition in question.

Copyright law currently focuses on the copying and reproduction of materials using traditional means. With the rapidly increasing use of Internet and IT systems to disseminate information, it is expected that changes will be made to copyright law in the near future to bring it into line with current developments.

The Copyright Licensing Agency Ltd. has responsibility in the UK for licensing users of copyrighted materials and collecting fees. Copywatch hotline - 0171 436 4242 or on-line at <http://www.cla.co.uk>

## 3. Outputs and Users

The first stage is to determine within your organisation, or within your partners, which outcomes from the project will have an IPR implication and which people or organisations within or outside of your organisation will be affected.

### 3.1 Who will be interested in products?

All projects have developed from a need, usually described and defined within the needs of the beneficiaries in terms of the target group the project is working with. However, there is also the need for the outcomes of the project to reach a wider group of potential stakeholders. Stakeholders can be defined as:

- end users - those directly involved in the project and using the project and its services to teach or learn;
- indirect users - those whose interests or activities are affected by the project work in developing new services and applications;
- new users - those whose jobs or tasks are created because of the new services and applications.

Carrying out a stakeholder analysis helps to determine which people within the organisations involved in the project and externally have a stake in what is being developed, and in turn will be supportive or resistant to the uptake of project results.

Annex 1 gives an exercise in the form of a series of questions which can be used to carry out a stakeholder analysis.

### 3.2 Matching outputs and users

The outputs of the project can be described in terms of learning, outcomes and outputs. These are usually defined at the start of the project but as the project develops through the very nature of working with people and organisations, other results will develop. These can be analysed in terms of:

- intended outcomes and outputs/products;
- negotiated outcomes and outputs;
- accidental outcomes and outputs.

Intended outcomes and outputs were defined in the original application. Negotiated outcomes and outputs are developed through interaction with people during project development.

Accidental outcomes and outputs are those that no one was prepared for or could have predicted. A useful evaluation tool is to work within the project to determine how outputs and outcomes are different for the various groups involved, for example:

- project promoter and project staff;
- beneficiaries;
- partner organisations nationally and transnationally.

Diagram 1 shows ways to think about this - as a cubed model which like a 'Rubik's Cube' can be twisted and changed.

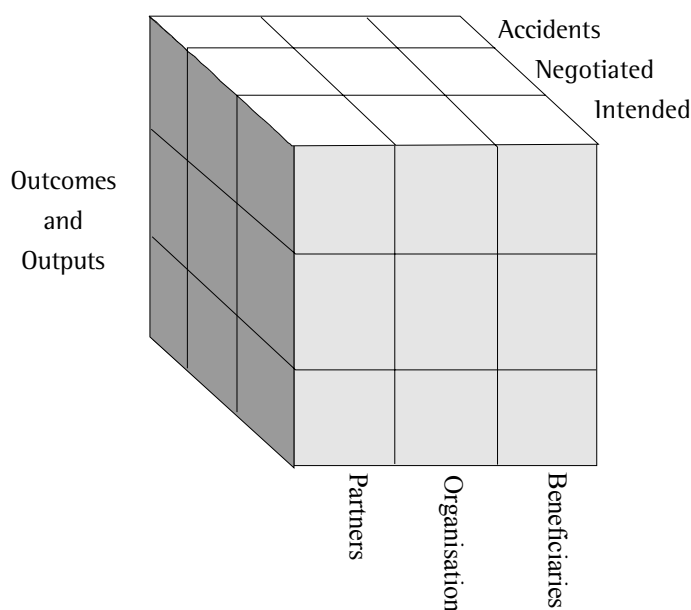


Diagram 1. Analysis of outcomes and outputs

The results will be different for different types of project and different kinds of organisation.

### 3.3 Which outputs have IPR implications?

The results of a project can be determined as:

- know-how e.g. improvements in teaching and learning
- insight and influence e.g. affecting policies and practice, sharing of experience
- intellectual property rights e.g. hard results such as publications
- demonstrations e.g. a new training course for a specific target group
- innovatory and leading edge solutions e.g. improvements in delivery of learning, new methodologies.

IPR usually relates to the 'hard results' from projects which can be described as products in terms of:

*Services*

- training courses
- vocational guidance and counselling
- training materials/packages
- reports on models of good practice.

*Publications*

- training materials/packages
- reports on models of good practice.

*Software Applications*

- CD-ROM
- computer based learning
- assessment tools.

### 3.4 Who gets the benefit of project results?

If the results from the project are thought of as a cake comprised of different slices then the ownership or interest in each slice can be linked to a stakeholder.

Section 4 below provides tips on how to deal with IPR residing with different organisations and individuals, and gives advice on how to protect IPR when disseminating products within and outside of the project partnership.

## 4. Addressing IPR Issues

### 4.1 IPR during product development

The following provides tips on the protection of IPR during the development of products.

#### **Make use of organisational policies on IPR**

This whole area raises the question as to whether your organisation has a policy on Intellectual Property, which determines the ownership rights and responsibilities in your organisation.

Check whether your organisation has a policy on Intellectual Property. Most large organisations involved in research resulting in results will have a policy. Universities in the UK for instance have tended to introduce policies over the last few years to determine ownership rights both for employed staff and from students.

You may want to explore the possibility of developing a policy on Intellectual Property for your organisation. Annex 2 gives the Intellectual Policy of the University of Wales Swansea as an example.

When considering the impact of IPR policies existing within an organisation it is useful to clarify:

- what type of Intellectual Property is being addressed in the policy? Theoretically the policy covers everything that is done but most organisations would narrow this down to encourage creativity;
- what are the implications for existing staff - does the policy only apply to new staff recruited after the date when the policy was implemented?
- what happens when someone leaves the project and takes their knowledge to another organisation and carries out similar work there, which results in new products - where does the IP lie?

#### *Get agreements for the use of images and music*

Ensure that you have people's agreement to use images and music in videos and multi-media products. This may mean incurring a cost.

Where materials contain images or materials from beneficiaries, projects usually get the prior agreement (preferably in writing) for this to be disseminated.

*Use agreements to protect ownership of software developments*

Take extra care in relation to software development since the project will want to protect its inputs by specifying clearly through agreements:

- who owns the code and who owns the content;
- who owns the software technology and the licensing agreement;
- who owns the design and technical information in relation to use and maintenance of the programme;
- who owns the supporting documentation.

*Make sure ownership is specified when testing and trialling materials*

When testing and trialling materials it is important to make sure the organisations and individuals involved are clear as to the extent and purpose for which they have been given products to trial and use. You may wish to consider using signed guarantees not to make use of the products for other purposes than the testing required for the project and sign confidentiality agreements.

*Consider copyright protection*

Consider the need for copyright protection. Registration of copyright is not generally a condition of copyright protection (although the copyright will need to be registered for an infringement suit to be brought). Copyright protection applies to any work of authorship as soon as it is written or recorded. When a work is published it should contain copyright notice: ©, the year of publication and the name of the owner.

Most materials from projects we want other people to use, and are happy for them to copy. A statement added which gives permission to copy and reuse can help to ensure your work is credited in future and can specify any conditions on use for example for educational and training purposes.

Copyright registration is expensive, and needs to be decided on a case by case basis depending on the commercial value that may result from the work. So a training package may be registered although a project newsletter might not.

**Test Your Knowledge**

*You are the producer of a CD-ROM-based learning package. You are using in the CD a video clip of learners that have been involved in your transnational partner's project. There is an advert visible in the background for a brand of chocolate. The video link is introduced by music before the learners can be heard. Do you: Ask the beneficiaries to sign letters of agreement for the footage to appear on the CD, or don't bother because they are beneficiaries of the project and are in another country? Let the chocolate advert remain, because it is not important or relevant to the context of the video? Check out the source of music and if it is a famous group, decide to use it without permission because the music is helping the project?*

## 4.2 Developing an exploitation strategy

As a start to developing a strategy for exploitation of products and results, discussions should be held with both national and transnational partners to consider their position on exploitation, the benefits accruing to each of the stakeholder organisations and the nature of the results.

Ideally, each organisation should complete a proforma related to its work to identify what outputs are related to their development and how they can be applied in the real world in terms of market. These outputs are not necessarily the same as the deliverables defined in the application, as additional unexpected outputs may have arisen.

A suggested proforma for specifying the issues in relation to each organisation is included at Annex 3. In each case it is important to identify:

- hard outputs/products seen by the partners from their work on the project;
- the user/customer profile, strengths and weaknesses in relation to competing products, and the channels for distribution;
- an estimation of the market sectors and their sizes, including ranking the markets and which will give the best return on the investment;
- the possibility of joint ventures to target particular groups.

This will give a basis for developing an exploitation strategy and provide the basis for deciding upon appropriate legal strategies in terms of applying for patents, copyrighting and trade marking. The strategy will evolve as the project develops but should refer back to the original position so that partners and the project are able to monitor changes and developments in ideas, as the results become more concrete.

## 4.3 Agreements between partners

Projects must reconcile between their partners the issues of ownership of developments and products, and methods of assigning ownership. This will be in the context of the workplan for the project as a whole and the agreed dissemination strategy.

It is useful to have a Consortium Agreement covering these issues signed by partners both at a local and transnational level. At the transnational level the transnational workplan is a key vehicle for setting in place consortium agreements.

This agreement would cover:

- co-ordination of project work/activities;
- roles and responsibilities of partners;
- ownership, exploitation and dissemination.

The IPR of outputs/products will be owned by the participants in the project including national and transnational partners. A method of assigning ownership needs to be decided. A common approach would be to agree:

- ownership on the basis pro-rata with their contribution to the work effort;
- all partners agree to use the outputs/products on a royalty free basis but not incorporate them into other products without agreement;
- all partners can have the opportunity to participate in exploiting the results of the project. For example, you may wish to agree that all partners have publication rights within the framework of the dissemination strategy/policy.

A Consortium Agreement will help to ensure that all partners recognise the potential benefits from the collaborative activities of the national/transnational work programme.

#### *Confidentiality*

Agreement must be reached on disclosure of information during the project. For example, you may wish to agree that during the course of the project all work is confidential. This will include information about the consortium, activity, beneficiaries, and sensitive information about individual organisations.

#### *Evaluation Strategy*

Partners should specify the framework resources for evaluation.

#### *Dissemination Strategy*

The dissemination strategy and the roles and responsibilities should be covered in any agreement.

During the course of the project, partners may wish to set up structures to exploit the results jointly in the longer term - for example through setting up a joint European company (EEIG) or using an existing organisation to further develop and exploit the results.

## **4.4 Rights of co-funders**

Projects should check with local co-funders whether any conditions will apply in terms of ownership and Intellectual Property Rights.

The Department for Education and Employment does not usually retain ownership rights unless there is an explicit clause to this effect in the Approval letter given to projects.

Guidelines from the European Commission suggest that the Commission would expect to share in any monies generated through sale of products developed with its support. However, in practice the Commission has tended to waive any rights to royalties that are generated after the submission of the final payment claim of the project where there is a guarantee that partners involved in the project are able to use the product freely, and where the ESF logo is used to acknowledge support.

## 4.5 Marketing the outputs of projects

During the life of the ESF project, any revenue which is generated as a result of marketing products developed as part of the project must be declared as part of the total expenditure at final claims. Revenue generated must be netted off before the calculated of the intervention rate (i.e. used towards the costs of the projects to displace match funding and ESF contributions).

Marketing should not be intentionally deferred to avoid the declaration of revenue. Applicants may be expected to provide justification of the marketing strategy for products as part of verification visits by the Department for Education and Employment, the European Commission or the European Court of Auditors.

## Annex 1: Stakeholder Analysis Exercise

1. Who has been involved in your project in the production of products?

*Nationally:*

*Transnationally:*

2. Did you have an agreement - Consortium Agreement, Partnership Agreement - between any or all of these organisations from the start of the project or since?

3. What kinds of issues did you cover in this agreement?

4. Does this agreement cover collaborative agreements to exploit the project results? If so, what kind of collaboration?

5. Can you list outcomes from the project in terms of the products produced nationally, and products produced with transnational partners?

*National:*

*Transnational:*

6. Do you know the sources of all information used within products? Can you or your partners verify that this information has been produced by them, and has not been obtained from or copied from another person?

7. How do you determine ownership of materials produced during the project? Do you have a methods for calculating or assigning ownership?

8. How have you protected the confidentiality of work undertaken during the project? What are some of the issues you have had to address?

9. What kind of length of time after the project is completed do you think should be used with your partners to protect the results of the work, and why?

## Annex 2:

### Example of Intellectual Property Policy (University of Wales, Swansea)

#### POLICY FOR THE PROTECTION AND EXPLOITATION OF INTELLECTUAL PROPERTY

##### 1 INTRODUCTION

- 1.1 The purpose of this Policy is to set out the principles and procedures governing the protection and exploitation of Intellectual Property Rights in works and inventions to which University resources have contributed.
- 1.2 For the purposes of this policy “Intellectual Property Rights” means all Intellectual Property Rights including but not limited to patents, trade marks, registered designs, applications for and rights to apply for any of the foregoing, unregistered design rights, unregistered trade marks, and copyright (including but not limited to copyright in drawings, plans, specifications, designs and computer software) any rights in invention, discovery or process, confidential information, know-how and any similar rights in the United Kingdom and all other countries in the world.
- 1.3 The ownership of Intellectual Property is governed by the terms and conditions laid down in the contracts of employment of academic and academic related staff, the visiting academic agreements, and student regulations. As a general principle these documents provide for Intellectual Property rights to be owned by the University, but make it clear that the University will not generally seek to assert ownership of copyright in books or articles in learned journals produced by members of staff, visiting academics or students unless the work has been specifically commissioned by the University. The foregoing is a general statement only. Before entering into discussions or agreements relating to Intellectual Property Rights you should refer to the terms and conditions relevant to you which identify fully the position with regard to Intellectual Property Rights.
- 1.4 This policy is intended to help identify those Intellectual Property Rights which are capable of profitable exploitation. Obtaining protection for Intellectual Property Rights such as patent (or registered design) can be a long and expensive process and is not worthwhile unless the invention or work has a strong chance of being developed and marketed, and it has to be recognised that only in a very small percentage of cases does, for example, a patent once granted actually produce any income at all. In this criterion which will determine the University’s attitude to an invention or work, issues such as patentability are virtually a secondary consideration.

- 1.5 A basic principle underlying the procedures in this policy is that all parties (including students where appropriate) who have made a significant contribution to an invention, discovery or work should receive a fair share of the benefits arising from it. The success of this Policy will depend on the member of staff who makes an invention, discovery or work being aware of the issues involved, bringing the design, invention or work to the attention of the University at an early stage and co-operating so that the interests of the University and the colleagues are not jeopardised. The interests of outside bodies, such as sponsors who might be involved must also be borne in mind.
- 1.6 An inventor can normally expect support from the University in applying for the registration of a registerable Intellectual Property Right such as prosecuting a patent or registered design application up to the filing and examination stages, given a reasonable likelihood that the invention can and will be exploited. This support will generally take the form of Patent Agents' fees and other necessary costs from central University funds. If a patent or registered design application is to be filed, the inventor has to accept that there must be secrecy concerning the invention. This would preclude any publication, contributions to conferences, exhibitions and the publication of any specific papers relating to it prior to filing a patent or registered design application.
- 1.7 The creation of an original manuscript for literature, music, the stage and broadcasting, together with still and moving images gives the creator a copyright on the product. Copyright is also afforded to original computer software and in any significant adaptations (e.g. re-writing software in another computer language). This combination of technology and creative work is still a grey area on patenting. Copyright is not registerable but arises automatically on creation of original work. In an attempt to evidence the date of creation many people post a registered package containing the copyright work to themselves and leave it unopened. In the event that there is ever a dispute as to the date of creation of the work this package can then be produced in evidence.
- 1.8 To be patentable an invention must be new and involve an inventive step (i.e. a step not obvious to someone skilled in the subject), and it must be capable of industrial application. To obtain protection as a registered design the design must be new and must be a feature of shapes or configuration, pattern or ornament applied by industrial process being features which in the finished article appeal to and are judged by the eye. The main purpose of granting a patent or registered design is to encourage industrial activity, and the only substantial reason for the University together with the inventor(s) concerned, to prosecute a patent or registered design application is to ensure that the institution and the individual(s) are in the best position to get the full benefits if the invention through its proper exploitation by means of licence agreements or other arrangements. In practice the arrangements for utilising an invention are as important as successful protection from it in the form of, for example, a patent or registered design.

## 2. PUBLICATION

- 2.1 It is vitally important not to reveal details of any invention or design for which an application may be made for a patent or registered design. If details of any invention or design are made available to anyone not directly concerned with the invention other than under an obligation of confidence any patent or registered design subsequently applied for will be invalid. This is because to use terminology of the Patents Act, an invention is only new “if it does not form part of the state of the art”. As far as a registered design is concerned the Registered Designs Act 1949 provides that a registered design will not be regarded as new if it is the same as a design (a) registered in respect of the same or any other article in pursuance of a prior application, or (b) published in the UK in respect of the same or any other article before the date of application, or if it differs from such design only in material details or in features which are variants commonly used in the trade. The crucial point in time is the date of filing the patent or registered design application. Before that date any matter about the invention or design which has been made available to the public becomes part of the “state of the art” and if it reveals what is new or inventive about the invention any patent granted will be invalid. The meaning of “made available to the public” is very wide and includes not only publication in a learned journal but any written visual or oral disclosure to anyone else.
- 2.2 It should also be borne in mind that the timing of publication can be important when considering the exploitation of an invention, even when there is no intention of seeking patent or registered design. Organisations (including the University) may wish to maintain secrecy for obvious commercial reasons, or alternatively may wish to publish deliberately as a tactic to prevent a patent or registered design being granted to a rival. For these reasons, any provisions in an agreement concerning disclosure of information given in confidence must be observed, and publications concerning an invention of commercial value must be treated with care (a Confidential Information Exchange Agreement is shown in Appendix 1). The provisions in this policy relating to publication must be followed scrupulously by inventors in their common interests with the University and their collaborators.

## 3. INVENTIONS INVOLVING THE UNIVERSITY AND A MEMBER OF STAFF

- 3.1 If, during the routine review of a research project, the project supervisor considers that a registerable Intellectual Property Right such as a patentable invention or registered design is likely to arise or has arisen, he/she should inform his/her Head of Department and the Industrial Development Office.

- 3.2 In view of the requirement that an invention must remain unpublished prior to any patent or registered design application, a prospective author wishing to publish any work where there is an invention which might be patentable or protectable as a design, must first obtain the written agreement of his/her collaborators in the research before publishing. The prospective author(s) should then approach the Industrial Development Office which will consult with the appropriate administrative staff.
- 3.3 If any member of staff has an invention for which he/she wishes a patent or registered design application to be filed, then that member of staff shall first inform his/her Head of Department and then either through him/her or independently inform the Industrial Development Office of his/her wish and provide sufficient information (including the names of any collaborators) to ensure an adequate assessment of the likelihood of commercial exploitation. The Industrial Development Office will make a recommendation to the Registrar or his appointed representative as to the degree of support or otherwise the University should give to the exploitation of the invention.
- 3.4 In reaching a decision, the Industrial Development Office shall consider any evidence submitted in writing, or if preferred, in person, by the individual who may choose in the latter case to be supported by the Head of Department or Dean of the Faculty concerned. The recommendation to the Registrar or his appointed representative will also be communicated at the same time to the member of staff.
- 3.5 The exploitation of an invention will normally be undertaken by the Industrial Development Office in conjunction with the inventor and Head of Department or his/her appointed representative, drawing on outside expertise as required. To prevent undermining the exploitation activities and objectives it is important that those involved do not make any arrangements or enter into any commitments which involve the University before referring the matter to the Industrial Development Office.
- 3.6 The University's costs in supporting the application shall be the first claim on any income arising. Thereafter, the net proceeds arising shall be shared between the University, the inventor (including other staff and students who have made a significant contribution to the invention) and the department, in line with the University's Revenue Sharing Arrangements (section 10). From time to time the Industrial Development Office will review all patents and registered designs in which the University has an interest. In particular each patent and registered design will be reviewed when the renewal fees are due, and if considered unlikely to be capable of bringing any sufficient return, the Industrial Development Office will recommend to the Registrar or his appointed representative that the patent or registered design should be allowed to lapse. If the inventor or inventors, designer or designers of the patent or registered design nevertheless wish to continue at their own expense, the University will formerly surrender its interest on mutually acceptable terms.

- 3.7 The University cannot give an absolute assurance to protect any Intellectual Property Rights from every infringement. Such a commitment may be open-ended and attended by a high risk that the cost of protection would greatly exceed any income from Intellectual Property Rights. In order to safeguard the University's position any licensing agreement entered into must provide that the costs of protecting Intellectual Property Rights from infringement will be borne by the Licensee(s).

#### **4. SPECIAL PROVISIONS FOR INVENTIONS INVOLVING THE UNIVERSITY AND ANY OUTSIDE BODY**

- 4.1 The term of contract governing the support given by the outside body must include provisions relating to the protection of Intellectual Property Rights including the patenting of inventions arising from it.
- 4.2 One of the conditions attached to work supported by grants from the Research Councils and Government agencies is that the exploitation of any invention shall be the subject of an agreement, usually on a standard basis, between the University, the member of staff and the sponsoring body. Similar conditions often apply to Industrially supported work, in which case exploitation may be undertaken by the sponsor alone or in collaboration with the University.
- 4.3 Where the agreement with the outside body does not cover the protection of Intellectual Property Rights including patenting of inventions or their exploitation, the member of staff shall first inform his/her Head of Department and then either through him/her or independently, the Industrial Development Office. The Industrial Development Office will negotiate with the outside body, acting in consultation with the individual(s) and the Head of Department, concerning the ownership and protection of the Intellectual Property Rights including without limitation prosecution of a patent, the apportionment of costs and any proceeds, and report accordingly to the Registrar or his appointed representative of the University. The proceeds accruing to the University shall be shared between itself, the inventor(s) and the Department, in line with the University's Revenue Sharing Arrangement. Progress on the prosecution of patents originating in the University will be reported, from time to time, to the Registrar, his appointed representative or the appropriate University committees, whichever route is deemed the most appropriate.

#### **5. INVENTIONS ARISING FROM PRIVATE CONSULTANCY WORK**

- 5.1 Outside consultancies or other paid work may not be accepted other than with the written consent of the Head of Department, or, in the cases of Heads of Department, the Vice Chancellor.
- 5.2 The University makes no claim on inventions arising from wholly private consultancy work which has been approved as such by the University. In applying to his/her Head of Department for approval to undertake private consultancy work, a member of staff must state whether an invention is likely and what University resources will be used, if any. The University will consider whether or not the

work to be undertaken is private consultancy work or work which should be more properly undertaken by the academic on behalf of the University. If University resources are involved, then the ownership and exploitation of any patent arising from such work is a matter to be settled between the University, the member of staff, and the body for whom the work is being done. In such a case the member of staff and Head of Department should bring the matter to the attention of the Industrial Development Office.

## **6. STUDENTS**

- 6.1 Students who make or contribute to an invention whether it be during an undergraduate project, a postgraduate dissertation or research are governed by the IPR regulations contained in the University's Student Regulations. They should immediately draw to the attention of their tutor or supervisor any process or product development, improvement or discovery whether relating directly or indirectly to their work. If an invention with which they are concerned is capable of commercial exploitation, they will be eligible to receive the advice and assistance of the University on the same basis as members of staff under this policy and are bound by the same procedures and obligations contained in this Policy.

## **7. VISITING ACADEMICS**

- 7.1 Visiting Academics who make or contribute to an invention should assign all IPR to the University by signing the University's appropriate letter of assignment prior to starting their research. They should immediately draw to the attention of the Head of the Host school/department any process or product development, improvement or discovery whether relating directly or indirectly to their work. If an invention with which they are concerned is capable of commercial exploitation, they will be eligible to receive the advice and assistance of the University on the same basis as members of staff under this Policy and are bound by the same procedures and obligations contained in this Policy.

## **8. APPEALS PROCEDURE**

- 8.1 Any disputes as to the ownership of Intellectual Property Rights or the distribution of benefits will be subject to an independent arbitrator mutually agreed upon. If no agreement can be reached on the arbitrator to be appointed, then the President of the Law Society will be approached to nominate an arbitrator. His decision on an arbitrator will then be final. Each party in dispute will bear his/her own costs of arbitration. Other disputes would follow an internal appeals procedure, depending on the nature of the dispute, the matter would be reviewed by the appropriate committee or a sub-group of that committee appointed by the committee.

## 9. PATENTS ACT 1977

- 9.1 This policy is not intended to affect any rights which may arise under sections 39 to 42 of the Patents Act 1977 (concerning the rights of employees vis-à-vis employer) and it does not constitute a “relevant collective agreement” within the meaning of the section 40(3) of the Act.

## 10. REVENUE SHARING

Net income (see paragraph 3.6) arising from the exploitation of any Intellectual Property will be apportioned as follows:

Amount	Inventor(s)	Department	University
First £2000	100%	-	-
£2K - £20K	60%	30%	10%
£20K - £100K	50%	35%	15%
£100K - £250K	40%	40%	20%
Over £250K	35%	35%	30%

Normally the University will distribute the revenue assigned to the inventors equally between the inventors. Should the inventors agree to an unequal distribution this should be indicated to the Industrial Development Office as soon as possible in writing, signed by all inventors with each inventor’s signature witnessed by an independent person.

## APPENDIX 1

### CONFIDENTIAL INFORMATION EXCHANGE AGREEMENT

This AGREEMENT is made by the \_\_\_\_\_ day of \_\_\_\_\_ 19\_\_\_\_

BETWEEN 1.....  
of the University of WALES SWANSEA of the one part

AND 2.....  
of.....of the other part

WHEREAS:

- a) Each party possesses valuable information, technical knowledge, experience and data of a secret and confidential nature relating to the FIELD, all of which are acknowledged by the parties to be commercial assets of considerable value, and
- b) Each party is willing to disclose INFORMATION to the other for the purpose hereafter mentioned on the condition that the other does not disclose the same to any third party or make use thereof for any other purpose.

NOW, in consideration of each party disclosing INFORMATION to the other,

IT IS AGREED as follows:

1. FIELD means

INFORMATION means any information, technical knowledge, experience and data disclosed by either party to the other relating to the FIELD declared by the DISCLOSER to be proprietary or confidential.

DISCLOSER means either party hereto in its capacity as a discloser of INFORMATION to the other party.

RECIPIENT means either party hereto in its capacity as a receiver of INFORMATION from the other party.

The PURPOSE for which the INFORMATION is to be supplied.

2. The RECIPIENT undertakes that it shall, and shall procure that its employees, students and agents shall treat as strictly confidential and not to divulge to any third party any of the INFORMATION disclosed by the DISCLOSER and not to make use of any INFORMATION except for the purposes for which it was supplied with the DISCLOSER'S prior written consent.
3. In the event of the RECIPIENT visiting any of the establishments of the ENCLOSER, the RECIPIENT undertakes that any further INFORMATION relating to the FIELD which may come to the RECIPIENT'S knowledge as a result of any such visit (inclusive of the form, materials and design of

the various elements of any relevant plant and equipment which may be seen at such an establishment as well as all plant as whole, the processes and methods of operation thereof and the various applications thereof) shall be kept strictly confidential and that any such INFORMATION will not be divulged to any third party and will not be made use of by the RECIPIENT except for the purposes for which it was received without the DISCLOSER'S prior written consent.

4. The RECIPIENT will restrict INFORMATION to those of its employees, students and agents who need to know and undertake to ensure that all such employees, students and agents are under legally enforceable obligations not to use or disclose INFORMATION.
5. Each party undertakes to the other to keep all INFORMATION at the party's normal place of work, such INFORMATION to be maintained secure and separate from other records, and to give up such INFORMATION either at the request of the other party or at the end of the term of this agreement. Each party undertakes not to make copies of such INFORMATION without consent and to deliver up all copies either at the request of the other party or at the end of the term of this agreement.
6. The above undertaking shall not apply to:
  - a) INFORMATION which at the time of disclosure is published or otherwise generally available to the public.
  - b) INFORMATION which after disclosure by the DISCLOSER is published or otherwise becomes generally available to the public, otherwise than through any act or omission on the part of the RECIPIENT.
  - c) INFORMATION which the RECIPIENT can show by written evidence was not in the possession at the time of the disclosure and which was not acquired directly or indirectly from the DISCLOSER.
  - d) INFORMATION rightfully acquired from others who did not obtain it under a pledge of secrecy from the DISCLOSER.
7. The parties agree that after seven years from the date hereof the RECIPIENT shall be relieved of all obligations under this agreement and that after such period has expired the DISCLOSER will rely on such patents as it may own for the protection of any INFORMATION disclosed to the RECIPIENT pursuant to this Agreement.
8. This Agreement shall be deemed to be an agreement made in Great Britain and subject to English Law.

SIGNED BY \_\_\_\_\_

on behalf of the University of Wales Swansea

SIGNED BY \_\_\_\_\_

on behalf of.....

## INTELLECTUAL PROPERTY CLAUSE FOR ACADEMIC AND ACADEMIC RELATED STAFF

### STANDARD TERMS AND CONDITIONS OF EMPLOYMENT

#### INTELLECTUAL PROPERTY RIGHTS

- 1) The term “Intellectual Property Rights” means all intellectual and industrial property rights including but not limited to patents, trade marks, registered designs, applications for and rights to apply for any of the foregoing, unregistered design rights, unregistered trade marks, and copyright (including but not limited to copyright in drawing, plans, specifications, designs and computer software), any rights in any invention, discovery or process, confidential information, know-how and any similar rights in the United Kingdom and all other countries in the world.
  
- 2) Prima facie the owners of Intellectual Property Rights are the inventors or creators of the works, designs, discoveries or inventions in which the right subsist. However, the law provides that in the following circumstances ownership of rights created by an employee will vest with the employer:
  - (a) Patents:- where an invention is made by an employee if it was made in the course of the normal duties of the employee or in the course of duties falling outside his/her normal duties but specifically assigned to him/her and the circumstances in duties, or the invention was made in the course of duties of the employee and at the time of nature of his/her duties, he/she had a special obligation to further the interests of the employer’s undertakings.
  
  - (b) Copyright:- where drawings, plans, specifications, designs, computer software, literary, dramatic, musical or artistic work is made by an employee in the course of his/her employment his/her employer is the first owner of any copyright in the works subject to any agreement to the contrary;
  
  - (c) Design Right (unregistered design):- where a design is created by an employee in the course of his/her employment his/her employer is the first owner of any design right in the design unless the agreement is reached to the contrary;
  
  - (d) Registered Design:- where a registered design is created by an employee in the course of his/her employment his/her employer shall be treated as the original proprietor of the design unless agreement is reached to the contrary.

- 3) The law does not make any express provision in respect of the ownership of confidential information and know-how. Where confidential information and know-how is generated by a member of staff during his/her normal working hours or as a result of the performance of tasks which fall within a member of staff's normal duties then such confidential information to be held by a member of staff is subject to an implied duty of confidentiality by reason of the employment relationship and should be available for exploitation exclusively by the University.
- 4) In circumstances where the law provides that Intellectual Property Rights are owned by an employer if a member of staff (whether alone or with any other person, firm or company) creates work or design or makes any discovery or invention in which any Intellectual Property rights subsist the Intellectual Property Rights will vest in the University - except:-
  - (a) where a member of staff produces books, articles in learned journals, scholarly monographs, dramas, musical compositions or artistic designs, in which case the University will not assert ownership of the copyright in the work unless the work has been commissioned by the University.
  - (b) where the University chooses to waive its rights in writing in any area not exempted in (l) above, in which case it will enter into any assignment as may be necessary to vest the Intellectual Property Rights in such member of staff.
- 5) If a member of staff creates any work or design or makes any discovery or invention in which Intellectual Property Rights subsist which vest in the University by virtue of the provisions contained in (b) and (c) above, then except as provided in paragraph d(i) above or until such time as the University waives its rights, the member of staff shall treat the work, design, discovery or invention and the Intellectual Property Rights in them and all information relating to them as confidential to the University. The member of staff undertakes and shall not disclose to any person other than an official of the University in accordance with paragraph (f) below any information relating to them without the written permission the University. The obligation of confidentiality shall not apply to information which:-
  - (a) is already in the public domain; or
  - (b) subsequently falls into the public domain otherwise than through a breach of this agreement; or
  - (c) is required by law to be disclosed.
- 6) The member of staff shall promptly disclose to his/her Head of Department, or in his/her absence the Registrar, full details of the work or design, discovery or invention including but not limited to specifications, drawings, models and notations and all or any other forms of media on which the Intellectual Property Rights are recorded or evidenced.

- 7) The member of staff confirms that he/she will comply with the provisions of the University's exploitation of Intellectual Property Policy.
- 8) Notwithstanding the fact that Intellectual Property Rights vest in the University, the University confirms that it will comply with the University's exploitation of Intellectual Property.
- 9) Both during and after termination of employment with the University the member of staff undertakes, except where paragraph d(i) applies or until such time the University waives its rights, to execute such further documents and so all such acts as may be necessary for securing, completing, or vesting absolutely in the University full rights, title and interest in any goodwill or any part thereof and for conferring on the University all rights of action in respect of any claim for infringement of any line by third parties.
- 10) The member of staff irrevocably and unconditionally waives (to the extent that such rights can be waived) in favour of the University any and all moral rights or rights of a like nature which may subsist anywhere in the world in respect of any design or copyright work which is vested in the University by virtue of the above provisions.



# Support Unit Guidance Notes

## EMPLOYMENT

### Series 1

- Guidance Note 1: Information for projects receiving 'Approval in Principle'
- Guidance Note 2: Transnational Workplans
- Guidance Note 3: Visits to Projects by Support Unit Staff
- Guidance Note 4: Project Monitoring
- Guidance Note 5: Information Sources
- Guidance Note 6: Transnational Guidance Note
- Guidance Note 7: Dissemination Guidance Note

### Series 2

- Guidance Note 1: Transnational Guidance Note
- Guidance Note 2: Transnational Co-operation Document: Guidance Note
- Guidance Note 3: Guide to Intellectual Property Rights

## ADAPT

### Series 1

- Guidance Note 1: Information for projects receiving 'Approval in Principle'
- Guidance Note 2: Transnational Workplans
- Guidance Note 3: Assessment Criteria for Resubmitted Projects
- Guidance Note 4: The Operational Role of Intermediaries
- Guidance Note 5: Visits to Projects by Support Unit Staff
- Guidance Note 6: Project Monitoring
- Guidance Note 7: Information Sources
- Guidance Note 8: Transnational Guidance Note
- Guidance Note 9: Dissemination Guidance Note

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