

University of the West of England, Bristol
Intellectual Property Policy and Regulations
(including the UWE policy relating to physical materials)

INTRODUCTION

This document sets out the Intellectual Property Policy of the University of the West of England, Bristol (UWE). The policy paper outlines the rights, responsibilities and procedures of the University and its staff and students in relation to intellectual property and material(s) created, to which UWE resources, e.g. time, funds, facilities or expertise, have contributed. It also underlines the importance of University staff and students respecting third party intellectual property rights.

Intellectual property, or IP, and the rights associated with them, *intellectual property rights*, or IPR, underpin the relationships and contracts that UWE is able to enter into with third parties (including businesses, organisations, charities and funding bodies, *et al.*) including the arrangements it makes as part of its Knowledge Exchange agenda.

Any lack of clarity over the ownership of rights at any time may inhibit UWE's legal involvement in future projects and its right to use the outcomes of research or development projects as no body will enter into an agreement with the University if the IPR position is not clear.

This Paper sets out the IPR procedures and processes of due diligence with regard to ownership and the rights to use intellectual property. It is intended to help to protect UWE and its employees from potential legal action by third parties relating to any IP associated liability.

There might be a number of tax considerations (whether UK or overseas tax) to be dealt with in respect of the exploitation of IP, IPR and the formation of businesses and/or companies. Any such tax consequences will depend on the specific details of each case. Accordingly this policy does not address these issues and therefore specific advice will need to be taken by all parties involved in such matters at the appropriate time.

The Legal Position

Under the *Patents Act 1977*, *Copyright, Designs and Patents Act 1988*, and *Copyright and Rights in Databases Regulations 1997* (the **Acts**), there is a presumption that ownership of copyright, database rights, designs and patents produced in the course of employment belongs to the employer. The Acts also confirm that in the case of designs produced under a commission the person commissioning the design is the first owner. The legal ownership of any rights can be varied by relevant legal agreement and documentation.

Protection of UWE intellectual property may be relevant in order to allow commercial exploitation or to encourage further funding of academic activity. Protection may involve keeping information confidential for a period, and where appropriate, undertaking patenting or other legal forms of protection. It is the aim of UWE to ensure individuals are supported in their entrepreneurial endeavours and rewarded through the policy for the creation and legal exploitation of intellectual property and intellectual property rights. It is also important to UWE that individuals do not infringe third party IPR in their work.

The policy and procedures as set out will be reviewed by UWE from time to time and any queries on the policy should be referred in the first instance to the Director of *Research, Business and Innovation (RBI)*.

INTELLECTUAL PROPERTY POLICY

1. Policy Principles

- The product of work carried out with the benefit of UWE resources and/or UWE assets (including, but not limited to, facilities, resources, assets, materials, funding, staff and staff time, confidential information and confidential background intellectual property rights, know-how and expertise, intellectual assets) constituting Intellectual Property (IP) and the associated Intellectual Property Rights (IPR) should be owned, protected and used by UWE for the general good of the whole UWE community.
- UWE should not infringe any third party IP and IPR.
- UWE should meet its contractual obligations to third parties including those associated with the dissemination, management and exploitation of IP and IPR and obligations of confidentiality.
- UWE should make provision to recognise and reward persons who:
 - a) create work within UWE that may have commercial value; and/or
 - b) bring into UWE, for its benefit, work already created which they own.

2. Policy Regulations

The following Regulations are designed to implement the UWE IP Policy.

2.1 Oversight of UWE's IP Policy and Regulations

- a) The Director of RBI is responsible for the day to day implementation of the UWE IP Policy and Regulations.
- b) The Intellectual Property Management Group (IPMG), a body appointed by the University Management Group and including the Director of RBI, under the direction of the Vice Chancellor is responsible for advising the governors on issues relating to:
 - i) the formation of businesses to exploit IP and IPR;
 - ii) changes to the UWE IP Policy and Regulations;
 - iii) any IP issues falling outside the UWE IP Policy; and
 - iv) to hear appeals made by staff and students in relation to unusual or special cases involving IP or IPR.

3. Scope of the UWE IP Policy and Regulations

3.1 The UWE IP Policy and Regulations normally covers any and all forms of IP and IPR and all materials relating to all of UWE's activities, including the following;

- a) patentable and non-patentable inventions,
- b) all copyright in confidential information belonging to UWE,
- c) databases and associated rights, computer software, source code, firmware,
- d) trade marks,
- e) e-learning materials and content,
- f) registered and unregistered designs, plant varieties, and topographies and geographical indicators,
- g) all confidential information, trade or business secrets,
- h) films, TV productions, videos, CD ROMS, DVDs, multimedia works, broadcasts,

performing rights, typographical arrangements, field and laboratory notebooks and research notes,

- i) original artistic works such as paintings, drawings, engravings, sculptures, photographs, diagrams, maps, works of architecture and works of artistic craftsmanship,
- j) administrative, financial, teaching materials and course materials (including all copyright and design rights),
- k) all materials placed on the UWE web-site or presented by other electronic, audio or audio/visual means,
- l) physical material including prototypes, physical models, physical designs, electronic devices, biological materials, chemical compositions,
- m) other works and materials created with the aid of UWE facilities or resources,
- n) know-how and information associated with the above.

3.2 UWE owns IP, IPR, products and materials:

- a) if they are created by employees of UWE either directly, or indirectly as a result of their employment by UWE, in circumstances where the law presumes ownership by the employer (ownership is not limited to activities or specific times e.g. hours of work, and applies to IP, IPR and materials created by part-time and casual employees which arise directly or indirectly from their employment); or
- b) where the legal owner of the IP and IPR has assigned his/her rights to UWE.

3.3 The IP Policy and these Regulations normally cover all persons:

- a) bound by the UWE IP Policy by virtue of their employment; or
- b) who as a signatory to a contract is bound to the UWE IP policy (such as a contract for services or a student contract); or
- c) who agree to abide by the policy specifically in writing, by conduct or by verbal agreement.

3.4 The IP Policy and Postgraduate Study

- a) UWE claims ownership of all IP, IPR, products and materials arising from research and/or project outcomes arising from postgraduate study (including IP, IPR, products and materials produced by part-time post-graduate students), unless specifically excluded under 4.3., or otherwise agreed in writing between the postgraduate student and UWE, following a recommendation by the Executive Dean (or their nominee) and the Director of RBI (see section 4.4, below) to waive these rights.
- b) Except for post-graduate theses, publication of works (whether such publication arises during or after the student's study at UWE) derived from research, or projects, conducted at, or on behalf of UWE, or involving the use of UWE's IP, or physical or intellectual assets, will require the permission of the Executive Dean (or nominee), or the Director of RBI.
- c) Publication of works involving the use of the IP, or physical or intellectual assets (whether such publication arises during or after the student's study at UWE), which are owned by the student will require the permission of the student.
- d) When a thesis contains confidential information (commercial or legal), eg. where;

- i) the disclosure would compromise UWE's ability to conform to its legal obligations to a third party (e.g. business, funding body, charity etc) to maintain confidentiality, or
- ii) the disclosure would compromise UWE's ability to protect IP or IPR that UWE wishes to exploit, e.g. by patenting,

The thesis will be kept in confidence in accordance with the UWE policy on research ethics and for the length of time necessary to allow UWE to comply with the conditions of i) and ii) above to their full extent.

- e) It is the responsibility of the student to disclose any relevant IP and IPR, which they or their employer (if relevant) own to enable their Director of Studies to determine whether an assignment or licence agreement is needed, before such IP or IPR is used in research or project work.
- f) Postgraduate students will be asked, as part of the registration process, to confirm in writing their consent to abide by the UWE IP Policy and Regulations.

4. Exceptions to the Regulations

4.1 IP and IPR which pre-date an individual's employment, paid association or registration as a post-graduate student as referred to in 3.4 are excluded from the scope of the Policy.

4.2 Normally, scholarly works which are produced by UWE staff and students and which are non-commercial and solely intended for academic purposes, such as articles in journals, papers for conferences, study notes (but not those used to deliver teaching), books or contributions to books including editing (which are not commissioned by UWE), and works of art, performance art and music (which are created without use of UWE assets or UWE resources and are not commissioned by UWE) are not subject to these Regulations except where;

- a) the disclosure would compromise UWE's ability to conform to its legal obligations to a third party (e.g. business, funding body, charity etc) to maintain confidentiality, or
- b) the disclosures would compromise UWE's ability to protect IP or IPR that UWE wishes to exploit.

It is the responsibility of UWE staff and students producing scholarly works to ensure that they are not covered by points a) and b), in this section 4.2.

4.3 IP created by undergraduate students and postgraduate students on taught courses is exempt, except where:

- a) UWE specifically negotiates and agrees otherwise with the agreement of the student (this may apply for example in the case of final year projects, or projects involving 3rd parties, external funding, or works requiring use of pre-existing UWE-owned IP); and
- b) where the student is employed by UWE and the IP, IPR and material arises from that employment.

4.4 Where an Executive Dean (or nominee) and the Director of RBI recommend that, before an individual starts a course or starts work on a specific project, UWE should waive its

rights to any resulting IP and IPR in favour of that individual, UWE will waive its rights using the UWE IP WAIVER AGREEMENT pro forma, which will be registered and stored with RBI.

- 4.5 The waiving of rights under section 4.4 may only be considered if UWE does not have obligations to a third party (e.g. business, funding body, charity etc) that would otherwise inhibit UWE legally entering into the waiver. The Agreement needs to be signed by the individual and by the Director of RBI, and also to confirm that UWE has a continued right to use such IP and IPR for the purposes of research (including third party funded research) and education.
- 4.6 Where IP and/or IPR are created/owned jointly by UWE and by parties exempt from the UWE IP Policy and Regulations, agreement may be sought between UWE (represented by the Director of RBI) and the exempt party to determine if, or how, the IP may be exploited and how the outcome of any successful commercialisation would be shared. It should be noted, however, that in such a case neither UWE nor the exempt party may exploit the jointly owned IP without the authorised, written agreement of the other party.

5. Responsibility to identify, disclose and protect IP, IPR and materials covered by the UWE IP Policy and Regulations

- 5.1 When undertaking work from which IP, IPR and materials covered by the UWE Policy and Regulations arise or may be expected to arise, all persons bound by the UWE IP Policy and Regulations must:
- a) notify the Director of RBI and Executive Dean, in writing, of any innovation, invention, IP, IPR, exploitable technology or material created, as soon as they become aware of it, by completing the UWE “INVENTION AND MATERIAL DISCLOSURE FORM”, seeking advice from RBI, when needed;
 - b) keep the nature of and matters relating to IP, IPR and material confidential (through proper use of confidentiality agreements etc) until the fact and manner of disclosure is agreed by the Director of RBI and Executive Dean;
 - c) assist with the protection and exploitation of IP and IPR developed and keep suitable records of creation; and
 - d) co-operate fully with UWE and its agents (e.g. external patent agents and lawyers);
 - e) co-operate with UWE to ensure that assignments or confirmatory assignments to IP and IPR are executed, where appropriate; and
 - f) support negotiations in relation to IP, IPR and Materials conducted by persons approved by the Director of RBI or IPMG.

6. Disclosure of IP to be used in research, project work or other UWE activities

- 6.1 All persons bound by the UWE IP Policy and Regulations are responsible to UWE for:
- a) ensuring that all bids and contracts are approved through relevant research, project and contract approval processes; and
 - b) complying with project contractual obligations binding on UWE (it is the responsibility of the faculty Project Manager to ensure that all staff and students to be engaged on the project are aware of and have agreed to be bound by the terms of the contract before commencing work on it); and

- c) complying with the Export Control Act 2002 ("Export Act") and Export of Goods, Transfer of Technology and Provision of Technical Assistance (Control) Order 2003 ("the Order") and inform the Director of RBI if they have reason to believe that they, UWE or a third party intends to use Technology in circumstances where it will or may become necessary to apply for an export licence under the Export Act or the Order
- d) disclosing to the Executive Dean (or nominee) or the Director of RBI at the outset of the work, or as soon as they become aware of it:
 - i) the ownership by a third party of any IP referred to or used for their work; and
 - ii) any use to be made of existing university IP during their work; and
 - iii) any IP which they themselves own which is proposed to be used by the University.

7. Responsibility to respect third party IPR

UWE students and staff are advised that any use and copying of third party materials (e.g. books, journals and images in print or electronic form including internet sources, third party research studies, databases, artistic works including all recorded musical or audio works, software, designs, trade marks, photographs, specifications etc), are subject to the law of copyright and other intellectual property rights and also, in many cases, to the terms and conditions of licences to which UWE is a party.

Infringement of copyright, patents, trade marks or related rights or licence terms and conditions places the University at risk of legal action, withdrawal of access to resources by information providers and/or damage to its reputation.

- 7.1 All persons bound by these Regulations must observe the law of copyright and related rights and licences to which UWE is party in their use of copyright materials, including but not limited to books and journals (whether print or electronic), databases, artistic works and software and should familiarise themselves with the *Guidelines on respect of copyright* provided as University Financial Regulation 18 and with the guidance available from Library Services.
- 7.2 All persons bound by these Regulations must ensure as far as reasonably possible that any use by them of materials, inventions or any IPRs in materials created or used by them does not infringe the rights of third parties.

8. Securing UWE's rights in relation to IP, IPR and materials

- 8.1 All persons bound by the UWE IP Policy and Regulations must co-operate with RBI to ensure:
 - a) that research and project/work outcomes are, wherever possible, owned by, assigned to or licensed for UWE's use and/or commercialisation on adequate and advantageous terms; and
 - b) that such terms are agreed and made clear in any bid or proposal or collaboration document relating to the research or project/work prior to commencement of the work; and

- c) before the start of any collaboration with third parties who are not bound by these regulations (including students, visiting academics as well as other universities, businesses and organisations) from which IP may arise or for which UWE IP may be used or disclosed, that RBI is informed in good time to secure appropriate agreements for UWE relating to confidentiality and IP issues; and
- d) that where there is an intention for students (including postgraduate students) to be engaged on research, projects or activities involving any of the following;
 - i) collaborations involving third parties (e.g. businesses, government, organisations, etc) where UWE has an obligation to maintain confidentiality and/or obligations relating to the use of and access to IP and IPR,
 - ii) where conditions of funding require UWE to exploit any resultant valuable IP or IPR (e.g. some funders, government, EU, some charities, etc),
 - iii) where UWE wishes to continue to use the outputs of such projects or activities after the student leaves UWE,
 - iv) where potentially valuable IP and IPR may be created or has been created; that students are informed by the Faculty at the time of advertising the post and before being engaged on the project or other activities that they will be required to sign an agreement conferring all right title and interest in IP and IPR to UWE, agreeing to abide by the UWE IP Policy and Regulations and agreeing to maintain confidentiality in relation to the project or activity.

It is the responsibility of the Faculty representative, project manager or tutor, as the case may be, (with assistance from RBI) to ensure that the students give informed consent by signing – using the STUDENT “ASSIGNMENT OF INTELLECTUAL PROPERTY RIGHTS AGREEMENT” before being engaged by UWE on the research, project or other activity.

- e) that UWE procures, where necessary, an appropriate consent (licence or assignment) to use any IP or IPR owned or controlled by a third party where such IP or IPR is referred to or used in UWE work, at the outset of the work to avoid infringement, and
- f) that no work is conducted for the benefit of or using material owned by a third party before the terms of ownership and use of project/work outcome are contractually agreed by an authorised signatory for UWE.

9. Reward for creation of IP, IPR or materials under the UWE IP Policy and exploited by UWE

9.1 Prior to the distribution of gross revenues received by UWE, UWE may deduct the following costs to calculate Net Revenues:

- a) Royalties due to third parties including funders;
- b) Costs and professional fees associated with the protection, maintenance, renewal and prosecution of the IP and IPR;
- c) Costs associated with undertaking due diligence on the IP, IPR or materials;
- d) Costs and professional fees associated with the defence of the IP and IPR;
- e) Legal costs and professional fees associated with negotiation, legal agreements and advice;

- f) Costs associated with marketing the IP and IPR (including travel costs); and
- g) The costs of any development work that is not externally funded or recoverable by UWE;
- h) Any tax payable in the UK or overseas.

9.2 The sharing of Net Revenues from the exploitation of IP and IPR will be:

Net Revenue	Inventors' share	Faculty share	University share
Any sum	50%	25%	25%

9.3 Exceptions

- a) UWE will not pay a royalty to employees for core activities undertaken within normal course of duties relating to teaching activities, or CPD activities.
- b) UWE will not pay a royalty on monies received from a third party by UWE to undertake research, consultancy or further development work.
- c) UWE will not pay a royalty from monies received from the sale of shares associated with the exploitation of IP, IPR or material, and this will be confirmed in the shareholders agreement for any spin-out company. It is expected that inventors/creators would have shares themselves as part of such exploitation in accordance with section 10 of the Regulations.
- d) UWE will normally wait until the amount of royalty to be distributed is greater than £100 (one hundred pounds sterling) in any one lot before undertaking royalty distribution.

9.4 Where IP is generated by more than one inventor or creator, they are each responsible for informing UWE of the proportion of their individual contributions to its generation. For the purposes of distribution of Inventors' shares in respect of Net Revenues received from exploitation of IP, IPR and material generated jointly it shall be the responsibility of the inventors/creators to agree their relative apportionment and to inform UWE in writing by completion of the "INTELLECTUAL PROPERTY / MATERIAL INCOME DISTRIBUTION FORM". This document is an important part of the due diligence process and should be completed prior to the exploitation of any IP, IPR or materials.

9.5 Income from one invention (including exploitation of material relating to such invention) which is exploited is counted together irrespective of whether the same IP, IPR or material is commercialised through one or multiple agreements.

10. Duration of Obligations under the UWE IP Policy and Regulations

10.1 Persons bound by the IP Policy shall remain bound to all such terms for the length of time necessary for the terms to have their full meaning and effect, including obligations of confidentiality. Persons leaving UWE shall continue to acknowledge UWE's IP rights created during their employment or other engagement with UWE and shall continue to abide by the UWE IP Policy and the IP Regulations in regard of such rights and continuing obligations.

10.2 Materials, files (in whatever form including electronic, audio, or visual storage formats)

and laboratory books that contain records of UWE owned IP shall be left with the Executive Dean of the faculty, or with the Director of RBI, as respectively appropriate, when employees or other persons bound by the IP Policy leave UWE employment, or UWE, as the case may be.

11. Infringement

11.1 All persons bound by the UWE IP Policy and Regulations must alert RBI immediately on becoming aware of a suspected infringement of IP rights being either:

- a) infringement of IP rights owned by UWE: or
- b) UWE's infringement of IP rights owned by a third party.

11.2 All persons bound by the UWE IP Policy and Regulations must comply with UWE's instructions in relation to any actual or suspected infringement of third party IP rights, in order to minimise the impact and extent of the infringement. Any action taken will be entirely at the discretion of UWE.

12. Setting up a Business or Company

A Start-up or Spin-out Company or Business is a useful vehicle through which to further develop and exploit services or products which result from research, innovation and educational endeavour. For the purposes of the IP Policy a Business should be regarded as a Company but may alternatively be established as a Partnership or by a Sole Trader as it is possible to have a tax status as both an employee of UWE and as a Business owner.

A Company or Business falling under the IP Policy includes one that involves an employee of UWE or a third party who intends to use the product of work carried out with the benefit of UWE resources and/or UWE assets (including but not limited to facilities, resources, assets, materials, funding, staff and staff time, confidential information, IP and IPR, know-how, and intellectual assets)

12.1 Permission to set up a Business or incorporate a Company under the UWE IP Policy and Regulations requires the permission of the Board of Governors on the recommendation of the Vice-Chancellor who is advised through the University Management group by the IPMG.

12.2 Permission will not usually be given until a viable business plan, relevant legal agreements and equity positions have been approved by RBI, and in some cases until sources of investment have been identified.

a) Relevant legal agreements may include:

- i) Memorandum & Articles of Association (not needed in the case of a Partnership or Sole Trader):
- ii) Shareholders' Agreement (not needed in the case of a Partnership or Sole Trader):
- iii) Licence Agreement(s) (for use with a Company or Business):
- iv) Collaboration Agreement with UWE (for use with a Company or Business)

normally including terms relating to:

- Research, consultancy, or education services provided by UWE, and UWE Employees and defining the terms under which UWE employees may participate in the Company's work, and
- Supply of services, defining the terms under which UWE and the Company use each other's resources, staff, premises and equipment and the financial and other terms for this;

v) Deed of Partnership (for a partnership):

vi) Service/Employment Agreements for key employees: where required, these agreements relate to the terms of engagement by the Company or Business of the CEO/Managing Director and of other non-UWE key employees and consultants.

12.3 Permission from the Vice Chancellor, or alternatively the Director of RBI acting on his behalf, and the Executive Dean is required for any UWE employee to take a Directorship in a Company, or Business. Normally such a position will be non-executive.

12.4 UWE expects to be a shareholder in spin-out Companies which involve UWE employees, UWE resources or UWE assets. Normally UWE will take an equal shareholding to the UWE founder(s). Any subsequent dilution of equity (e.g. due to investors, non-UWE based Company managers, CEO etc) shall normally be pro-rata between UWE and the UWE founder(s).

12.5 UWE will normally transfer its IP and IPR to such Companies or Businesses in the form of licences (exclusive or non-exclusive).

12.6 RBI, on behalf of UWE, will negotiate with stakeholders (including funding bodies, joint owners with UWE of Intellectual Property and any previous sponsors of work undertaken at or with UWE) to which the Company/Business wishes to have access. The UWE Founders and Founding Team may need to assist in this process.

12.7 Staff and/or students are advised to seek their own independent legal and financial advice (including accountancy and tax) in relation to the formation of a Company or Business or any payment under this policy.

12.8 It is recommended that any such Company or Business formed takes out insurance to cover a number of factors including but not limited to; public liability insurance, professional indemnity insurance, employer's liability insurance, directors and officers insurance, buildings and contents insurance and product liability insurance, as appropriate.

13. Conflicts of Interest

By engaging in Knowledge Exchange activities with all the positive benefits for UWE, or through other activities, employees may find they place themselves in a difficult position with regard to their duties (e.g. as a Company Director) where the outside interest/engagement may conflict or appear to conflict with the interests of UWE or with their duties as employees.

Conflicts of Interest also have the potential to bring the name of UWE and the employee into disrepute where there is a conflict over legal requirements to both UWE and another organisation (e.g. the fiduciary duties of a company director may conflict with terms of employment by UWE).

These Regulations are not meant to discourage the many valuable outside activities of UWE faculty and staff members as the majority of the outside activities and financial interests of faculty and staff members are compatible with their obligations to UWE.

The requirement to declare and register such interests is designed to benefit both the employee and UWE from disclosure and discussion of possible problems concerning outside activities and interests.

13.1 A potential *Conflict of Interest* will include the following;

- a) conflicts to the mission of UWE or to research or teaching integrity,
- b) conflicts of loyalty or commitment (having contractual relationships with third parties such as being a trustee, having a personal consultancy or being a member of external committees),
- c) financial conflicts (especially relating to financial interests, personal consultancies, having ownership of or being a partner in another organisation),
- d) conflicts between legal obligations as a company director or trustee and duties as an employee of UWE,
- e) being an employee of UWE together with being an employee and/or director of another organisation or self-employed, where the roles undertaken in both positions present competing or conflicting interests for the individual concerned.

13.2 Faculty and staff members are primarily responsible for determining and disclosing their own possible Conflicts of Interest by completion of the “*REGISTRATION OF POTENTIAL CONFLICT OF INTEREST FORM*”, and submitting this to the Director of RBI.

13.3 RBI will maintain a register of potential Conflicts of Interests.

13.4 In the event that the Executive Dean or Director of RBI believe that the potential Conflict of Interest needs discussing further they will set up a meeting with the employee, and will advise IPMG of any recommendations for action where appropriate.

14. Discretion to assign/licence back IP and IPR

14.1 In the event that UWE decides that it does not wish to pursue or continue to pursue the protection and/or exploitation of any IP or IPR it may at the discretion of the IPMG assign or licence its rights back to the inventors/creators of such IP or IPR on terms (including the sharing of any future economic benefit from any subsequent exploitation) to be negotiated. This will only generally be considered where there is clear evidence that the IP and IPR is not related to other interests UWE may have and in general the terms will confirm that UWE has a continued right to use such IP and IPR for research (including third party funded research) and teaching purposes. Any such requests should be made in the first instance to the Director, RBI.

15. Breach of Regulations

15.1 UWE reserves the right to regard a deliberate breach of the IP Policy or Regulations as a disciplinary matter for UWE staff and students and will be treated under normal procedures.

15.2 UWE may, at its discretion, consider all avenues available to it, including legal action, seeking injunction and damages or otherwise, in respect of persons bound by the UWE IP Policy and Regulations but who act in breach of them.

RBI 6th August 2008