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Intellectual Property Guideline

This Guidelines sets out the University's position regarding the ownership of intellectual property (IP) developed by staff, students and certain others, together with the procedures in place for commercialization of University owned IP. It covers all University related activities, including research and innovation and student education.

Status of this Guideline

This Guideline is specifically incorporated into all employees' contracts of employment and any legal relationship between the University and its students.

Intellectual Property (IP)

There are numerous definitions of IP. In essence, IP may be regarded as 'knowledge and its creative application'. In practical terms all material generated by staff should be regarded as potentially having IP. Examples of IP include:

- **Patents,**
- **Copyright,**
- **Performance rights,**
- **Design rights and**
- **Trademarks.**

The University's General Approach

Subject to certain conditions referred to below:

- Where a member of staff or students creates IP during the course of their employment/studying the University will own that IP.
- Where a student creates IP as part of their academic programme the student will own the IP.
- The wide dissemination of IP is fundamental to the work - and indeed the idea of – a university. Subject to conditions referred to below the University has in this context granted members of staff and students freedom to publish academic publications.
- The University encourages active identification of commercially-valuable IP, suitable protection and robust exploitation to the mutual benefit of the University staff and students. It should be noted in this context that commercial exploitation (for example, on the basis of patents) need not be

incompatible with academic activities such as the publication of academic papers.

Ownership of IP and the sharing of benefits

Staff

- Although the legal position is inevitably complex, the University's position reflects the general law, in that, unless there are specific agreements to the contrary, the University will normally be regarded as owning all intellectual property generated by University staff during the course of their employment.
- However, not all IP generated by staff during the course of their employment necessarily belongs to the University. There are two exceptions to the general rule set out in above:
 - The University may, as a matter of Guideline, determine that particular categories of IP should be vested in the staff who produce them. Nonetheless, the University's capacity to waive its claim to IP is limited:
 - Partly for financial reasons, but also because it is a charitable body (and therefore obliged by law to own IP),
 - The University has to take all reasonable measures to seek to maximize the returns on its assets (which, of course, include IP).
 - The University has decided not to make any claim over income generated by staff or students from academic publications, for example received through the publication of a book or article.
 - Some IP is generated on research or other third-party contracts the terms of which may give third parties (usually the funding body in question) rights over some or all of the IP. (In practice, such third-party rights will be negotiated between the University and the funding body before the research contract in question is signed).

Students

Primarily, students who are not employed by the University will own any IP they create. Where a student is being sponsored by a third party, the student may be required to assign any IP to the University or to the sponsoring body, in accordance with the terms and conditions which apply to the studentship. The same may apply if the student is working in an area where the University has valuable IP and/or where arrangements are in place with commercial companies in relation to the results of funded research. In other cases, students will be given the option to assign any IP to the University. Any student who chooses to assign their IP to the University will then be granted the same rights as any employee inventor as set out in this policy and should follow the same procedures as set out in this policy. Regardless of ownership of the IP, the University requires access to all data generated using University resources and will retain the original data when a student leaves.

- Where any student generates IP as part of their academic programme they will have sole ownership of this IP unless:
 - The IP was generated as part of an activity where a third party requires ownership (e.g. where on a student placement a host requires ownership or where research is sponsored and the sponsor requires ownership).
 - The student generated IP builds upon existing IP generated by University staff.
 - The student generated IP is jointly created with University staff.
 - The student is recruited on a specific understanding that due to the particular commercial or IP sensitive environment their IP position is varied.
- Where the exceptions 7.2 to 7.3 above apply the University will be the sole owner. However the University is committed to sharing the benefits from the exploitation of this ownership with the student in accordance with the framework described below under the heading "Commercial Exploitation and Process".

- For the avoidance of doubt where a student generates IP outside of their academic programme but has used University resources in the generation of the IP, the University will also be the sole owner. Where the University is to be the sole owner of the IP the student:
 - May not outside of necessary use of their academic programme use, license or transfer any of the IP they have generated without the agreement of the University. Any agreement to be given through the University's Research and Innovation Service (RIS).
 - Will complete all necessary further steps to ensure the University can fully enjoy its rights.
- Where a student is to be the owner of the IP the student grants the University a free, irrevocable non-exclusive license to allow the University to complete its commitments to the student e.g. relating to the supervision and assessment of the student's work.
- Whilst the University will retain ownership rights over publications where containing University owned IP in line with the above, the University will not make any claim over income generated by the student from academic publications.

Conditions of ownership, use and ownership of IP

- The University's conditions on the ownership, use and exploitation of IP are designed to reflect the general position under the law: the University asserts its right to ownership and use of all IP generated by staff during the course of their employment, and it likewise asserts its right to ownership and use of all IP generated by staff outside the course of their employment where substantial University resources have been used. Where the University has ownership it is committed to sharing with the staff and students concerned the rewards derived from successful commercial exploitation of IP which they have generated.
- Against this background, the following specific conditions apply to the ownership, use and exploitation of IP:
 - Except as may be provided in a contract with a third party (for example, a funding body), except in cases where an individual has been employed specifically for the purpose of producing a particular academic publication, and except where publication might result in the loss of an opportunity for commercial exploitation, the University freely allows members of staff and students to publish University IP in academic publications and to keep all income from those publications. (Cases of doubt or cases requiring interpretation should be referred to RIS).
 - Subject to 13.1 above, the University owns and therefore has the right to use without limitation all material that is generated by staff during the course of their employment and any IP that is generated by staff outside the course of their employment but which is based upon substantial use of University resources.
 - The University when publishing IP generated by staff and students will wherever practicable give due acknowledgement to the authorship of material.
 - Where the University commercially exploits IP generated by members of staff or students it will share a percentage of the income it derives from such commercial exploitation with the authors/inventors in accordance with below.
 - If a member of staff or student is in dispute about IP issues e.g. wishes to claim ownership of IP and that is not accepted within their School they should in the first instance approach RIS. RIS will then consult with others where necessary, such as the relevant Pro-Dean for Research and Innovation. Any dispute that cannot be resolved will then be referred for resolution to a panel consisting of the Deputy Vice- Chancellor for Research and Innovation; either the Pro-Dean for R&I of the relevant Faculty or the Pro-Dean for Student Education of the relevant Faculty; a nominee of the Leeds UCU; and a lay member of the University Council appointed by the Council.

Commercial Exploitation and Process

- For the purposes of this Guideline commercial exploitation is where the primary purpose of an activity falls outside the education and core academic research missions of the University.

- The protection and exploitation of commercially-valuable IP is undertaken on behalf of the University by RIS. All invention disclosures, formal IP protection and the review and approval of all transactions that grant third parties rights and/or access to University IP must be reviewed and managed by RIS who will obtain all appropriate University approvals.
- Where the University and members of staff wish to seek the commercial exploitation of any IP owned in whole or in part by the University, they must do so through RIS who will obtain the appropriate consents as per the University's Scheme of Delegation. The precise mechanism for exploitation will vary: in some cases it may be through a new company, licensing, or through revenue share or assignment of IP to a third party.
- Decisions on the sharing of any benefits from the exploitation of IP will be made within the following framework:
 - The individuals concerned (hereinafter referred to as the 'inventors') will be required at the outset to warrant that they and only they have contributed to the generation of the IP in question (i.e. the specific IP that will form the basis for any subsequent licence, IP sale or spinout company), and to agree between themselves the distribution of the inventors' share of any income or capital gain arising from the exploitation of that IP. Those who are identified as inventors may include academic and related staff, support staff and postgraduate and other students of the University.
 - Where a financial return is generated through licensing, assignment or revenue share agreements the inventors will receive a proportion of the net proceeds from exploitation (after meeting any costs, including University overheads), the residue accruing to the University. The maximum proportion paid to the inventor is 40% of net proceeds. Where a third party (e.g. a funding or research/commercial partner organisation) has the right to receive a proportion of proceeds from exploitation, unless otherwise specified, the third party proceeds will be deducted prior to the University and inventor distributions.
 - In cases where a new company is formed to exploit the IP in question, the inventors, will receive a fair economic interest in that company (in most cases through a shareholding). The initial split of interests prior to external investment will be:
 - IP based spinout (i.e. based upon defined IP whether formally protected or not): the inventors will receive no more than 40%. Where a formal commercialization partner is involved in the development of the opportunity the University may allocate a proportion of its interests to that partner.
 - Service based spinout (testing, analysis and consultancy based businesses) the inventors will receive no less than 40% and no more than 60 %.
- Where the University makes further investment into a spinout, either through cash or contribution of facilities or discounted services, and this will convert solely in to additional University equity.
- The University's share of the net revenue and any capital gain arising from the exploitation of IP will, in general, be shared with the resource area (Faculty/School) in which the IP was generated. The share will be determined by the guidelines laid down from time to time by the University's Executive Group, but revenue and capital gains arising from the exploitation of IP will in any event be subject to a contribution to the University's Enterprise Fund and other central funds designed to facilitate the exploitation of IP.
- Any disputes about the sharing of benefits that cannot be resolved by RIS will be referred for resolution to a panel consisting of the Deputy Vice-Chancellor for Research and Innovation; either the Pro-Dean for R&I of the relevant Faculty or the Pro-Dean for Student Education of the relevant Faculty; a nominee of the Leeds UCU; and a lay member of the University Council appointed by the Council.
- With the consent of the Dean or nominee members of the University are entitled to use IP for the purposes of carrying out consultancies in accordance with current University Guideline on consultancy.

- Members of staff are expected to take all reasonable steps to ensure that the University's IP is properly protected, working with the Research Innovation Service.
- For the avoidance of doubt, the University acknowledges and accepts that in the case of any inconsistency, it is bound by its legal responsibilities and obligations to staff contained within the general law that cannot be varied by these conditions.

Visiting Academics

- Unless agreed to the contrary visiting academics or researchers will be treated as members of staff, in terms of any intellectual property that they develop whilst at the University i.e. the University claims ownership of IP and rewards inventors in the same manner as University members of staff.
- Many researchers or academics who are visiting the University have access to University facilities and research information that may be confidential to a third party collaborator, or during the course of a research project where the IP arising from it is committed to a collaborator or funding body. The University needs to ensure that it acts in compliance with any terms to funding and any other agreements (such as confidentiality agreements) that have been signed with a collaborator or funder. Faculties should have more formal procedures for visiting academics to deal with these issues. Contact the RIS contracts team for further information and advice.

Intellectual Property Agreement

Between:

* _____, located at * _____ (“the Owner”)

AND

* _____, located at _____ * (“the Recipient”)

AGREE AS FOLLOWS:

BACKGROUND:

..... The Owner owns or has rights to the _____
 The Recipient has asked the Owner to provide a sample of the _____ to the Recipient.

**Article 1
 MEANINGS**

In this Agreement:

Investigator means * _____

“Material” means * _____

New IP means inventions (whether patentable or not); discoveries; facts; data; ideas; manner, method or process of _____; method or principle of _____; - techniques; products; prototypes; processes; know-how; routines; specifications; drawings; trade secrets; technology methods; works in respect to which copyright subsists; and other knowledge, arising from the Recipient’s use of the _____

Purpose means research purposes.

**Article 2
 PROVISION OF _____**

The Owner will provide the _____ to the Recipient.

2.2 If the Owner requires reimbursement of the out of pocket expenses of _____ of the _____ to the Recipient, the Owner will provide an invoice for those out of pocket expenses, and the Recipient will pay that invoice within _____ days.

Article 3
POSSESSION OF _____

3.1 The Recipient warrants that it has any regulatory approval, license or consent necessary or required by any law, or any government agency or other body to receive and possess the _____.

3.2 The Recipient agrees that only the _____, and persons supervised by the Investigator, will have access to the _____.

3.3 The Recipient warrants that the Investigator is an employee of the Recipient.

3.4 The Recipient agrees not to transfer or permit the transfer of the _____, or any part of the _____, to another person without the Owner's prior written consent.

Article 4
SAFETY

4.1 The Recipient acknowledges that the _____ may be _____ or may contain _____, or other substances that are hazardous, dangerous, or harmful to persons or property.

4.2 The Recipient shall safely handle and store, and cause its employees to safely handle and store, the _____ in a manner reasonably designed to prevent any harm to any person or property.

4.3 The Recipient warrants that it is aware of all requirements for the safe handling and storage of the _____ and has all facilities that are required for the safe handling and storage of the _____.

Article 5
USE OF MATERIAL

5.1 The Recipient may use the _____ only for the Purpose, and must not use the _____ for any other purpose.

5.2 The Recipient shall be responsible for use of the _____ by its employees or agents.

5.3 The Recipient, for itself and its agents, assumes all risks associated with use of the _____.

5.4 The Recipient may not use the _____ for any commercial purpose.

5.6 The Recipient may not use the _____ on human subjects.

5.7 The Recipient must comply with all laws, and with all applicable codes of conduct, in relation to the use of the _____.

5.8 Where any ethics approval of any person or body is required to use the _____, the Recipient must:

- (a) Obtain that ethical approval, and
- (b) Comply with all conditions of that ethical approval.

5.9 The Recipient may not file any patent application or any other application for the statutory protection of the _____, without the prior written consent of the Owner.

Article 6
NEW IP

6.1 Any New IP shall be owned by the Recipient.

6.2 The Recipient is not obliged to disclose the New IP to the Owner, but may do so.

** In consideration for permitting the transfer to and use by Recipient of the _____, Recipient will disclose to Owner any New IP on which Recipient has filed a patent application and hereby grants Owner a non-exclusive, royalty-free license under such New IP for research purposes only.

**Article 7
PUBLICATIONS**

7.1 The Recipient may publish a paper which refers to the _____ without the prior consent of the Owner.

7.2 Any such publication must acknowledge the Owner's ownership of the _____, and that the Owner provided the _____ to the Recipient.

**Article 8
GOVERNING LAW**

This Agreement is made and entered into in _____ and this Agreement will be construed and applied under the law thereof. The parties agree to submit themselves to the non-exclusive jurisdiction of the courts in that place.

**Article 9
NO LICENSE**

Nothing in this Agreement grants Recipient any right or license to use or practice any intellectual property owned by Owner, provided, however, that Owner will not enforce its intellectual property against Recipient's use of Material as permitted by this Agreement.

SIGNATURES OF PARTIES

SIGNED on behalf *

Signature _____

Print Name _____

Date _____

SIGNED on behalf *

Signature _____

Print Name _____

Date _____