



UNIVERSITY COLLEGE DUBLIN

INTELLECTUAL PROPERTY POLICY AND PROCEDURES

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1. INTRODUCTION

UCD's vision is "to become a leading international research-intensive University where bold and imaginative teaching programmes and excellence in teaching and learning go hand in glove with a commitment to research, scholarship, innovation and creativity". (*UCD Strategic Plan 2005-2008, Creating the Future* – approved by the Governing Authority, March 22, 2005).

The UCD focus on research and innovation is consistent with the Government commitment to the Lisbon agenda. It plans to increase expenditure in R&D to 2.5% of GNP by 2010 with 2/3rds being contributed by industry. The university research base which is beginning to take shape with the support of PRTL, SFI and other initiatives is no longer regarded solely as a source of knowledge and highly qualified graduates. University research is a national resource which will generate the innovative ideas and new ventures necessary for developing and sustaining competitive indigenous industry and which will attract and encourage indigenous and overseas industrial investment in collaborative research. It is clear that the classical routes of knowledge transfer, through scholarly publications, articles or books are not always the most efficient, particularly when the new knowledge is in the form of intellectual property. In such cases, substantial investment may be required from third parties to achieve successful commercialisation. The protection and professional management of the intellectual property by the University is a pre-requisite for the attraction of such investment. In particular, it is essential that the ownership of such intellectual property is clear and unambiguous.

The goal of research, as stated in the UCD Strategic Plan (2005 – 2008) is creative discovery, from which flow publications, intellectual property and income. A major strategic objective is to contribute to the social, economic and cultural objectives of a knowledge society specifically by:

- Aligning research to social, economic and cultural objectives;
- Realising full value of research programmes;
- Engendering an entrepreneurial culture

NovaUCD, the Innovation and Technology Transfer Centre at UCD, is responsible for the commercialisation and exploitation of intellectual property arising from UCD research. Key actions identified in the UCD Strategic Plan to enhance knowledge transfer through NovaUCD include:

- Initiation of knowledge management programme;
- Identification and protection of UCD's intellectual property;
- Training of UCD staff in knowledge transfer and entrepreneurship (through integration of National Institute of Technology Management NITM and NovaUCD programmes)
- Commercialisation of UCD's intellectual property through licensing to existing companies and to spin-out or other start-up companies;
- Development of strategic partnerships with industry.

The University is in the process of strengthening its structures to support innovation and technology transfer and updating the policies and procedures which govern the ownership and commercialisation of the intellectual property arising from its research programmes. Greater emphasis will be placed on the development of partnerships with industry and on the transfer of technology to existing industry. This document contains the updated policy and procedures (*the Policy*) relating to UCD intellectual property. In accordance with accepted International Best Practice, it sets out the policy and rules that govern the creation, ownership and commercialisation of intellectual property developed by UCD staff, post-graduate students and others participating in programmes carried out for UCD or undertaken using UCD facilities, know-how, confidential information or intellectual property ("*UCD Assets*").

The Policy is intended to actively support the commercialisation of *University Intellectual Property* (as defined in Clause 2 below) in a manner which ensures maximum benefit to society and the Irish economy, while providing significant financial reward and recognition for the creator of the intellectual property, the University and where appropriate, the sponsor of the research. The University encourages the commercialisation of *University Intellectual Property* by offering a support programme and a share of the resulting income to the creators of such intellectual property which is very generous by Irish and international standards. The University's share of income is used to fund further research and development, innovation, technology transfer, commercialisation and related activities.

This document incorporates and replaces the main provisions of the UCD 'Patents Policy and Programme' which was approved by the then Governing Authority in June 1992 (1992 Patents Policy and Programme). The 1992 Patents Policy and Programme has been updated to take account of the developments outlined above and the changes in legislation including the Copyright and Related Rights Act, 2000.

This Policy also takes account of the National Codes of Practice and the Funding Agency guidelines for management and commercialisation of intellectual property (Annex VI) as follows:

- Irish Council for Science, Technology and Innovation (ICSTI) *National Code of Practice for Managing Intellectual Property Arising from Publicly Funded Research*, published in 2004.
- Advisory Science Council *National Code of Practice for Managing and Commercialising Intellectual Property Arising from Public-Private Collaborative Research*, published in 2005.
- *Funding Agency Requirements and Guidelines for Managing Research-Generated Intellectual Property*, February 2006.

Nothing in this Policy is designed to interfere with or compromise the academic principles enshrined in the Universities Act 1997.

2. UNIVERSITY INTELLECTUAL PROPERTY – DEFINITION AND OWNERSHIP

The Policy augments the Irish statutory provisions governing the ownership of intellectual property rights that are mentioned in Annex I.

As a general rule (and subject to the exceptions set out in *the Policy*) the rights to *University Intellectual Property* is the property of and vests solely and absolutely in UCD. *University Intellectual Property* includes any intellectual property in any materials and/or inventions created by academic, research and other UCD staff (full-time or part-time) in the course of their employment or by post-graduate students in the course of their education by UCD or by consultants or others in the course of research, development, teaching, consultancy and other intellectual activity carried out for UCD. These personnel are collectively referred to as *University Personnel* in the *Policy*.

University Intellectual Property includes rights in any material, including any copyright (including rights in computer software and moral rights but subject to the exception set out below), patent, design right, trademark rights, brand rights, database rights, know how, trade secrets, confidential information, rights in design, semiconductor topography rights or other intellectual property rights or other property rights, whether vested, contingent or future anywhere in the world. (A full definition of intellectual property is contained in ANNEX II).

The Policy applies particularly but not exclusively to any intellectual property rights in materials and/or inventions which are created in whole or in part or caused to come into existence:

- while undertaking normal or specifically assigned duties either when intellectual property could be reasonably expected to result from the carrying out of those duties and/or, at the time the intellectual property was developed, there was a special obligation on the creator of the intellectual property to further the University's interest;
- when using UCD's equipment, supplies, facilities or UCD Assets;
- using UCD's confidential information, trade secrets, know how or any of the intellectual property of UCD; or
- in relation to any work performed for UCD (including pursuant to any third party funded research programmes).

Under the terms of the Copyright and Related Rights Act, 2000 the University owns all copyright in works created by its employees in the course of their employment. In recognition of the unique position of a university and in accordance with long-standing academic tradition, the University does not and will not assert ownership of copyright in pedagogical works, scholarly publications, books or artistic works of its employees, regardless of the form of expression, unless there is a written agreement to the contrary.

This exception to University ownership of intellectual property does not extend to copyright in software or to database rights.

The University will not assign rights to the usage of teaching materials to any third party without the prior agreement of the author/creator. If there is an opportunity to exploit those materials/works with a party independent of the University, then the commercial value of that exploitation will be shared between the University and the author/creator in accordance with the policy on shared royalties (see 5.2 below).

3. AIMS OF INTELLECTUAL PROPERTY POLICY AND PROCEDURES

The basic aims of the Policy are as follows:

- To maximise the commercialisation of intellectual property arising from UCD research for the benefit of the economy and society;
- To encourage public use and commercialisation of *University Intellectual Property* by facilitating its transfer from UCD to industry and business;
- To establish principles and procedures for the protection and commercialisation of *University Intellectual Property* and for sharing of royalty and other income;
- To provide genuine incentives, support and recognition for creators of intellectual property;
- To utilise the financial and other returns to the University from *University Intellectual Property* to advance and encourage research and development, innovation, technology transfer and commercialisation, and related activities at UCD.

4. OUTLINE OF INTELLECTUAL PROPERTY SUPPORT PROGRAMME

The UCD office responsible for supporting the development and commercialisation of *University Intellectual Property* is NovaUCD (previously known as the University Industry Programme). All *University Intellectual Property* including inventions, software and other intellectual property that has commercial potential must be disclosed by *University Personnel* (as defined in clause 2) on a timely basis to the University through NovaUCD. (See Clauses 8 and 9)

NovaUCD provides assistance in:

- Formal disclosure and assignment procedures;
- Identification of intellectual property and evaluation of commercial potential;
- Protection of intellectual property including processing of patent, registered design and trade mark applications with the assistance of patent attorneys and other professionals where appropriate;
- The formulation and implementation of strategies for commercialisation in a timely manner and in partnership with the inventor(s);
- Marketing of *University Intellectual Property* for commercialisation;
- Negotiating assignments and licences, options for licences or other commercial arrangements with third parties to assist in producing a financial return to the creators of the intellectual property, their College and the University. In this regard, consideration will be given to the need for the University to retain access to know-how and research material for ongoing research purposes;
- Providing incubation facilities, advice and support for establishment and development of campus companies.

At UCD's reasonable cost, the creator of *University Intellectual Property* must execute any documentation (including appropriate assignments) or otherwise provide assistance to UCD to secure, protect, perfect or enforce any of UCD's rights, title and interests in such intellectual property.

Creators of *University Intellectual Property* wishing to commercialise such intellectual property through companies in which they or their immediate family have a shareholding or other interest must declare that interest to the University through NovaUCD. Under the UCD Campus Company Policy such companies shall be required to allocate an equity stake to UCD if the company concerned is at an early stage of development or the University considers that the commercialisation of *University Intellectual Property* is a major part of the business of the company.

5. GENERAL PROVISIONS OF UCD POLICY

5.1 Scope of Policy

The Policy is applicable to *University Intellectual Property* that is owned by the University for any of the reasons outlined in Clause 2. *The Policy* is applicable to *University Intellectual Property* that is created by *University Personnel*. *The Policy* is applicable to all UCD Colleges, Schools, Centres, Institutes and other organisations affiliated to UCD.

Visiting lecturers, post graduate students and other personnel at UCD who have a prior existing and conflicting intellectual property arrangement with another employer or third party must enter into an agreement with the University (and their employer or relevant third party) (ANNEX III) to abide by the conditions of *the Policy* in the course of their activities in UCD.

The University also welcomes the opportunity to consider for inclusion under this Intellectual Property Support Programme intellectual property which does not come under the definition of *University Intellectual Property*. In such cases the ownership of the intellectual property must be assigned to the University.

5.2 Distribution of University Income from Commercialisation of *University Intellectual Property*

The University shall share a proportion of net royalty and other net income generated by the University from the commercialisation of the *University Intellectual Property* with the approved creators or authors of the said intellectual property. This sharing of income is subject to the terms of *the Policy* being met by the creator of the *University Intellectual Property*, including the execution of all appropriate documentation to assign to the University all *University Intellectual Property* that may arise from a particular project or research. The aim is to achieve an equitable distribution of the income that arises from the commercialisation of *University Intellectual Property* between the University, the creator of the intellectual property and, where appropriate, a third party sponsor. The procedure for distribution of the actual net income outlined in this Clause does not relate in any way to income earned by the University from equity in campus companies. The University procedures for distribution of income from equity in campus companies was approved by the Finance Committee in February 2000.

All direct expenses incurred by the University in the protection and commercialisation of *University Intellectual Property* that arises from a particular project or research (including legal and other costs involved in seeking patent protection for an invention and any subsequent investigation, development and promotion) will be recouped first by the University from the initial royalty or other income or lump sum before calculating the amount of income which can be shared with the relevant creators of the intellectual property in question. The amount recouped shall not exceed 50% of the

total gross income to UCD from the commercialisation of the relevant research project in a given calendar year unless the income is specifically intended to cover expenditures such as patent costs.

Subject to the foregoing, the following guidelines (which may be amended from time to time by UCD) will be used in determining the distribution of net income received by UCD from the commercialisation of a particular piece of *University Intellectual property*:-

- A major proportion of net income actually received by UCD up to €100,000 will be paid (subject to deduction as outlined above of applicable taxes and reimbursement of University costs associated with the protection and exploitation of *University Intellectual Property* ("Net Income")) to the creators of the intellectual property that are classified as *University Personnel* by *the Policy* in such proportions as agreed between the relevant *University Personnel*. Above this level, the proportion paid to the creator of intellectual property will decrease with increasing income. Overall, the share of income distributed by UCD to the creators of *University Intellectual Property* is the most generous among the Irish Universities.
- The University share of Net Income will be divided between the College and the University/NovaUCD.

The following scale will apply in the sharing of net income available for distribution:-

Net Income	Creators of IP	College	University / NovaUCD
Up to €100,000	75%	15%	10%
€100,000 - €200,000	50%	30%	20%
€200,000 - €1,000,000	40%	30%	30%
Over €1,000,000	30%	30%	40%

If more than one party is involved in the creation of the particular piece of *University Intellectual Property*, the division of payments between the parties will be based on their relative intellectual contributions as outlined in the Invention Disclosure Form (see Clause 8). The division of payments will be agreed by the parties concerned and notified to NovaUCD before a patent application is filed by the University. The University shall not distribute the Net Income unless the relevant parties have agreed the proportions between themselves. If the parties cannot agree the proportions then the University will determine the matter and the decision of the University shall be final.

It is essential that good research records are prepared during the course of each project. In the event of a dispute, the research records will be of prime importance in making an apportionment between the parties concerned.

The division of royalty and other income will generally be carried out within six weeks of receipt of such income. The University shall make commercially reasonable efforts to ensure where possible that creators of the intellectual property benefit from any income tax concessions on income from patents which may be available. For the avoidance of doubt none of the creators of the intellectual property shall be entitled to any share in royalty or other income from commercialisation of research unless UCD has received actual income or royalty payments from such commercialisation.

Any royalties or other UCD income relating to sales generated after the date of adoption of *the Policy* by the Governing Body shall be distributed in accordance with *the Policy*.

5.3 Non-Financial Rewards

It is recognised that the development of *University Intellectual Property* is dependent on the existence of satisfactory and equitable agreements on the division of income to provide meaningful rewards to creators of *University Intellectual Property*. However, the University may at its

discretion provide non-financial rewards for such activities including academic recognition, improvement in the Colleges, Schools, Centres and Institutes facilities and funds for research.

6. INTELLECTUAL PROPERTY ASSIGNMENTS AND PATENT ASSIGNMENTS

For the avoidance of doubt the provisions of this Clause 6 apply to all the Colleges, Schools, Centres, Institutes, academic, research and other University staff (full time or part time), post-graduate students, university consultants or any third party conducting research or other intellectual activity using UCD's supplies, facilities, UCD Assets, confidential information, trade secrets or existing intellectual property of UCD. The provisions of this Clause 6 may continue after the individual ceases to be a UCD employee, post-graduate student or consultant.

As a condition of employment as a University employee and as a condition of admission of every post-graduate student, each staff member or post-graduate student (as the case may be) shall comply with *the Intellectual Property Policy* and shall agree to assign to the University (or a person or company designated by the University or an agency which provided the funding for the relevant research) any and all Intellectual Property created and produced or otherwise developed while the person was an employee or a post-graduate student of the University. In addition, all above mentioned employees and post-graduate students agree to execute such documents of assignment or other documentation required to assign or transfer Intellectual Property to ensure protection and enforcement of UCD's rights, title and interest in the *University Intellectual Property*. In addition each post-graduate student and member of staff agrees to do anything that may reasonably be required to assist any assignee of any patent application or other intellectual property to obtain, protect and maintain its rights, title and interest. In making such an assignment the assignors shall declare the names of co-inventors or of anyone known to them who may have a claim on the rights to the intellectual property.

7. RESEARCH FINANCED BY THIRD PARTIES

Any research which is wholly or partly financed by any third party shall be subject to the specific provisions of the grant or contract covering that work. In the event of any inconsistency between *the Policy* and the terms of any such grant or contract then the provisions of the said grant or contract shall prevail provided that the intellectual property clauses in the contract have been reviewed by NovaUCD and the contract has been signed by UCD. When making decisions regarding management and commercialisation of intellectual property arising from research which is wholly or partly funded by third parties, the University will take account of the following guidelines (see also Annex VI):

- Irish Council for Science, Technology and Innovation (ICSTI) *National Code of Practice for Managing Intellectual Property Arising from Publicly Funded Research*, published in 2004.
- Advisory Science Council *National Code of Practice for Managing and Commercialising Intellectual Property Arising from Public-Private Collaborative Research*, published in 2005.
- *Funding Agency Requirements and Guidelines for Managing Research-Generated Intellectual Property*, February 2006.

8. DISCLOSURE

All inventions, software and other intellectual property which has commercial potential must be disclosed by *University Personnel* on a timely basis to the University through NovaUCD.

It is a condition of admission of the post-graduate student to UCD and a condition of the employment of each member of staff that the results of all research or projects should be fully and completely disclosed to the relevant Head of School or project leader.

In order to enable UCD to ensure that it fulfils its obligations to organisations such as Science Foundation Ireland, Enterprise Ireland, companies and other third parties in both the public and private sectors, who are funding research at UCD, all *University Personnel* must disclose any inventions, software and other intellectual property with commercial potential arising from such research to the University through NovaUCD. The creator of the intellectual property shall inform NovaUCD of the existence of the intellectual property at the earliest opportunity, and in any event, not later than three weeks after the observation that new intellectual property may have been created.

The disclosure to NovaUCD shall be made by completing the UCD Invention Disclosure Form which can be downloaded from the NovaUCD website at <http://www.ucd.ie/nova/internal/idf.html>. The disclosure should be sufficiently complete in technical details to convey a clear understanding of the nature, purpose, operation and to the extent known, the physical, chemical, biological, electrical or other characteristics of the intellectual property.

Non-Disclosure Agreements are also available from NovaUCD (See www.ucd.ie/nova/services/protection.htm) and should be executed before any disclosure of University Intellectual Property or potential intellectual property to any third party.

In accordance with the University Policy on Consultancy and External Work, where University employees are engaged in consultancy in a private capacity, any use of *University Intellectual Property* will be subject to the prior written consent of UCD through NovaUCD.

9. PUBLICATION OF RESEARCH RESULTS

It is University policy to encourage staff and post-graduate students to place the results of their research in the public domain either through publication in learned journals or presentation at conferences. This is a vital factor for academic recognition.

However, it must be recognised that premature publication or disclosure except on a confidential basis may make it impossible to obtain valid patent protection. NovaUCD will provide advice and assistance in relation to confidentiality agreements. The placing of a thesis in the University library without ensuring that accessibility is restricted constitutes publication. A typical arrangement for publication of a patentable invention is described in ANNEX IV.

It is important to ensure that the intellectual property remains confidential and is not published for a limited period to enable adequate arrangements to be put in place for its protection where this is feasible. Publication that is in violation of the terms of any agreement between the University with the sponsor of the research or other Third Party must be avoided.

10. CONFLICT OF INTEREST AND ETHICAL ISSUES

It is the policy of the University that its officers, staff, and others acting on its behalf have an obligation to avoid ethical, legal, financial, or other conflicts of interest and to ensure that their activities and interests do not conflict with their obligations to the University or its welfare. Any questions in relation to research ethics should be referred to the University's Research Ethics Approval System. <http://www.ucd.ie/research/ethics>

11. PROCEDURES

Responsibility for implementation and administration of the UCD Intellectual Property Policy rests with NovaUCD.

All inventions, software and other intellectual property which has commercial potential must be disclosed by *University Personnel* on a timely basis to the University through NovaUCD.

NovaUCD will evaluate disclosures according to the following criteria:

- Commercial potential
- Inventor profile
- Scientific/technical merits
- Proprietary position/patentability
- Stage of development
- Financial viability

As outlined in Clause 4, NovaUCD will provide assistance in the protection and commercialisation of *University Intellectual Property*.

Staff, students and others requiring advice or clarification should contact NovaUCD. Contact details are provided in Clause 14 below.

Other policy documents including UCD 'College Procedures for Campus Companies (1989)' should also be consulted.

12. DISPUTE RESOLUTION

Any dispute in relation to *the Policy* or its effects will be dealt with as provided for in ANNEX V. Expenses incurred by the University in resolving disputes shall be deducted from royalty income before distribution unless an Arbitrator is appointed. The costs of the Arbitrator shall be borne by the Parties as outlined in ANNEX V.

13. MONITORING and EVALUATION

Clear systems for monitoring and evaluation of the Intellectual Property Support Programme will be implemented. Indicators will include invention disclosure, patents filed, patents granted, licence agreements, spin-off companies *inter alia*.

14. CONTACTS

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ANNEX I

IRISH STATUTORY PROVISIONS GOVERNING OWNERSHIP OF INTELLECTUAL PROPERTY RIGHTS

COPYRIGHT AND RELATED RIGHTS ACT, 2000 ("2000 Act")

First ownership of copyright

Section 23 (1) of the 2000 Act provides that: "The author of a work shall be the first owner of the copyright unless the work is made by an employee in the course of employment, in which case the employer is the first owner of any copyright in the work, subject to any agreement to the contrary".

Maker of database

Section 322 (2) of the 2000 Act provides that: Where a database is made by an employee in the course of employment, his or her employer shall be regarded as the maker of the database, subject to any agreement to the contrary".

PATENTS ACT 1992 ("1992 Act")

Right to a patent

Section 16(1) of the 1992 Act provides that: "The right to a patent shall belong to the inventor or his successor in title, but if the inventor is an employee the right to a patent shall be determined in accordance with the law of the state in which the employee is wholly or mainly employed or, if the identity of such state cannot be determined, in accordance with the law of the state in which the employer has his place of business to which the employee is attached."

NOTE ON OWNERSHIP OF PATENTS UNDER IRISH LAW

Irish Law comprises Statute Law (legislation) and Common Law (legal principles developed through judicial decisions over time). The ownership of inventions discovered by an Irish employee working for an Irish employer is not specifically set out in any statutory provision but is covered by the Common Law principle that an employer owns the product of his employee's work where that work was done in the course of the employment unless there is an agreement to the contrary.

ANNEX II

DEFINITION OF INTELLECTUAL PROPERTY

1 Intellectual Property

The University defines intellectual property as the tangible or intangible results of research, development, teaching, or other intellectual activity which is manifested in the form of copyrights, patents, trademarks, industrial designs and confidential/proprietary information. Intellectual property allows creativity and innovation to be captured and owned in the same way as physical property can be owned. Intellectual property includes individually and collectively all technical innovations, inventions, improvements, and/or discoveries, information, writings and software, whether or not patentable or otherwise susceptible to intellectual property protection, including technology and materials in their tangible form.

1.1 Patents

Patents are intended to protect new and improved products and processes that have some technical innovation and are capable of industrial application.

A Patent gives its owner the right, for a limited period, to stop others from making, using or selling the invention without the permission of the owner in a particular territory. Patent rights are territorial in that an Irish Patent does not give Patent rights outside Ireland. Most Patents are for improvements in a known technology rather than the devising of a completely new technology.

1.2 Copyrights

Most of the Copyright and Related Rights Act, 2000 came into force on January 1, 2001. This was intended to transpose a number of EU Directives into Irish law and to bring Irish law into conformity with its obligations under various International Treaties.

Copyright gives the right to control use of certain material such as books and other literature, art, music, sound recordings, films and broadcasts. However, copyright does not protect inventions (see Patents) or brand names (see Trademarks). Most, but not all, uses of copyright material will require permission from the copyright owner.

Copyright protection is automatic in Ireland in that there is no official application or recording system.

1.3 Trademarks

Trademarks are intended to protect a brand's identity so as to distinguish the goods or services of one trader from those of another trader. The Trade Marks Act, 1996 defines a trademark as "any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking from those of other undertakings" A Trademark may be a word, logo, slogan, colour, three-dimensional shape and even a sound or smell. The Trademark must be capable of being represented in words and/or pictures.

Until 1st April 1996 the only option open to the proprietor of a trade mark wishing to register the trade mark in Ireland was to apply directly to the Irish Patents Office and the protection obtained by that registration extended to Ireland only. If the owner wished to register his/her trademark in all 15 EU countries it was necessary to apply directly to the relevant offices in all of those countries. OHIM (Office for Harmonisation in the Internal Market) was established to provide owners of trade marks with the option of applying to register their trade marks in all 15 countries of the EU using a single registration procedure.

1.4 Industrial Design and Unregistered Design Right

The Industrial Designs Act 2001, which brings Irish law into compliance with EU Directive 98/71/EC, came into force on July 1, 2002. Designs cover the appearance of a product, either the whole or a part, resulting from such features as lines, contours, colours, shape, texture or materials of the product itself or its ornamentation. The term product embraces any industrial or handicraft item.

The term product has a wide meaning that includes packaging, get-up and graphic symbols (e.g. Desktop icons) etc.

Registration is not available for features of a design which are dictated by the technical function of the product. The new law contains a *must fit* exclusion under which it is not possible to obtain registration for features which are dictated by the need for the product to fit another. However, modular products, i.e., made up of several components which can be fitted together in different ways, are protectable.

Design Registration gives the owner the right, for a limited period (up to 25 years, with renewals every 5 years), to stop others from making, using or selling a product to which the design has been applied, or in which it is incorporated.

From early 2003, it has been possible to obtain a *Registered Community Design* covering all member states of the EU. Registered Community Design Applications are handled by the office (OHIM) which currently handles Community Trade Marks.

An *unregistered design right* is available at Community level and eligibility for protection is the same as for a Registered Design. The right comes into existence automatically by the mere fact of making the product incorporating the design available to the public within the European Community. Protection is limited to 3 years and to preventing the use of copies of original designs. It is important to note that a Registered Design gives exclusivity whereas an *unregistered design right* can only be enforced where copying can be proved.

1.5 Confidential Information and Know How

Protection for confidential information and know-how arises from the law of confidentiality. The confidential information may be know-how associated with a Patent or a Patent Application, or material in existence before, for example, a Patent Application is filed, or material already protected by another form of intellectual property, for example, copyright.

1.6 Domain Names

A domain name is a unique address on the Internet. There are various generic TLDs, such as .com and .biz, as well as, ccTLDs (Country code), such as .ie.

1.7 Tangible Research Property

This includes biological materials such as cell lines, plasmids, hybridomas, monoclonal antibodies and plant varieties; computer software, data bases, integrated circuit chips, prototype devices and equipment, circuit diagrams: and analytical procedures and laboratory methods, whether or not intellectual property protection is available through Patents and/or copyright or otherwise.

1.8 Other Forms of Intellectual Property

Other forms of intellectual property include, but are limited to, database right for certain types of database (under Copyright and Related Rights Act, 2000); protection for semi-conductor topographies; plant breeders' rights in certain plant varieties; and protection against unfair competition under "passing off" law.

ANNEX III

Intellectual Property Agreement for Personnel at University College Dublin who have a prior existing and/or conflicting Intellectual Property Agreement or arrangement with another employer or a third partyError! No index entries found.

I understand that, consistent with applicable laws and regulations, University College Dublin (UCD) is governed in the handling of intellectual property by its official policy titled *Intellectual Property Policy and Procedures*, (a copy of which I have read), and I agree to abide by the terms and conditions of this Policy in the course of my UCD activities.

As a general rule (and subject to the exceptions set out in this Policy) any intellectual property rights in any material, (including any copyright (including rights in computer software and moral rights), patent, design right, trademark rights, brand rights, database rights, know how, trade secrets, confidential information rights in design, semiconductor topography rights or other intellectual property rights or other property rights, whether vested, contingent or future anywhere in the world), created by me in the course of my work or study with UCD is the property of and vests solely and absolutely in UCD ("University Intellectual Property").

Pursuant to this Policy, and in consideration of my participation in projects administered by UCD, access to or use of facilities provided by UCD and/or other consideration, I hereby agree as follows:

1. I will disclose to UCD all potentially patentable inventions and other University Intellectual Property conceived or first reduced to practice in whole or in part in the course of my UCD responsibilities, my participation in research projects at UCD or with use of University resources. I further assign [jointly] to UCD [and to my non-UCD employer]¹ all my right, title and interest in such patentable inventions and other University Intellectual Property created in connection with UCD and to execute and deliver all documents and do any and all such things necessary and proper on my part to effect such assignment. Such assignment is not inconsistent with the terms of my continuing employment outside of UCD or with any other agreement I have entered into.
2. I will not use any information defined as confidential or proprietary by my non-UCD employer in the course of my UCD responsibilities and I will not do consulting or research work for my non-UCD employer while at any facility owned or leased by UCD.
3. I am free to place my inventions in the public domain as long as in so doing neither I nor UCD violates the terms of any agreements that governed the work done or my agreements with my non-UCD employer.
4. I will not enter into any agreement creating copyright or patent obligations in conflict with this agreement.
5. This agreement is effective on date of my UCD hire, enrolment or participation in projects administered by UCD, and is binding on me, my estate, heirs and assigns.

¹ To be considered on a case by case basis

SIGNED SEALED and DELIVERED
by [NAME]
in the presence of:-

signature

Witness name

Witness description

Witness address

Acknowledged and accepted:

Non-UCD Employer: -----
(Insert name)

Signature

Title

Date

ANNEX IV

Typical arrangement for publication of a patentable invention.

Every effort shall be made to ensure that intellectual property protection causes a minimum delay to the publication of related research. Where possible the delay in publication to enable a patent application to be filed should be for an agreed limited period, typically less than 60 days.

In the case of research funded by third parties a typical arrangement is as follows:

- The third party would be informed at least 30 days before submission of a publication
- The third party would be given 30 days to decide whether publication should be delayed
- Upon the request of the third party the submission for publication may be delayed for up to a further 30 days to enable the parties to secure adequate protection of the IPR that would be affected by publication.

In the event that the protection of IPR is not feasible and where publication may jeopardise commercialisation, the submission for publication may be delayed for up to an additional period (60 days) to enable an approach to commercialisation to be agreed.

ANNEX V

Dispute Resolution

Informal Dispute Resolution

Prior to the initiation of formal dispute resolution procedures, the Parties shall first attempt to resolve any dispute, controversy or claim arising under or in connection with this Policy (a "Dispute") informally, as follows:

- 1.1 First, the Parties to the Dispute shall meet as often, for a duration and as promptly as the Parties deem necessary to discuss the Dispute and negotiate in good faith in an effort to resolve the Dispute;
- 1.2 If the Parties are unable to resolve the Dispute within 30 days after the referral of the Dispute to them, the Dispute will be referred to the President of UCD. The President shall nominate a person who shall use reasonable efforts to resolve such Dispute.

2. Alternative Dispute Resolution

If a Dispute cannot be resolved as provided in Clause 1, then prior to resorting to litigation, the following shall apply:

- 2.1 Either of the Parties may refer such matter for determination to such person as may be appointed by agreement between the Parties or, in default of agreement, nominated on the application of either Party by the President for the time being of the Law Society of Ireland.
- 2.2 Any person to whom a reference is made under Clause 2.1 shall act as an arbitrator ("the Arbitrator") and shall be entitled to appoint such technical expert or experts as he considers necessary to assist him in determining the matter referred to him. The decision of the Arbitrator (which shall be given by him in writing stating his reasons therefore) shall be final and binding on the Parties. The arbitration shall be conducted in accordance with the Arbitration Acts 1954-1998.
- 2.3 The Parties shall provide any Arbitrator with such information as he may reasonably require for the purposes of his determination. The Arbitrator shall be entitled to order discovery of documents where he considers expedient to do so in the interests of justice and to reduce costs.
- 2.4 The costs of any Arbitrator (including the costs of any technical expert appointed by him) shall be borne in such proportions as the Arbitrator may determine to be fair and reasonable in all the circumstances or, if no such determination is made by the Arbitrator, by the Parties in equal proportions.

3. Exceptions to Dispute Resolution Procedure.

The provisions of Clauses 1 and 2 will not be construed to prevent UCD from:

- 2.5 Seeking a temporary restraining order or injunctive or other equitable relief with respect to a breach (or attempted breach) of the Policy; or
- 3.2 Instituting litigation or other formal proceedings to the extent necessary (i) to avoid the expiration of any applicable limitations period or (ii) to preserve a superior position with respect to other creditors.

ANNEX VI

National Guidelines for the Management of Intellectual Property

When making decisions regarding management and commercialisation of intellectual property arising from research which is wholly or partly funded by third parties, the University will take account of the following guidelines:

Irish Council for Science, Technology and Innovation (ICSTI) *National Code of Practice for Managing Intellectual Property Arising from Publicly Funded Research*, launched in April 2004.

The Code addresses each aspect of the management and transfer of research and development results from universities, institutes of technology and public research institutions to the commercial market place.

Advisory Council for Science, Technology and Innovation *National Code of Practice for Managing and Commercialising Intellectual Property Arising from Public-Private Collaborative Research*, launched in November 2005.

This Code presents the national policy position regarding Intellectual Property (IP) arising from collaborative research. It provides guidance on IP related issues to be considered by collaborating partners and an overarching framework under which parties to an IP agreement may negotiate.

Funding Agency Requirements and Guidelines for Managing Research-Generated Intellectual Property, February 2006.

With the support of Forfás, the funding agencies have agreed a common approach in relation to their requirements and guidelines for managing research-generated intellectual property. The participating agencies were Science Foundation Ireland (SFI), Health Research Board (HRB), Industrial Development Agency (IDA), the Higher Education Authority (HEA), the Irish Council for Science, Engineering and Technology (IRCSET) and Enterprise Ireland (EI).

See: http://www.ucd.ie/nova/newsandevents/news/management_intellectual_property.htm