

Guidance note from the Research Office and Cambridge Enterprise IP Policy in practice – how it works, who to approach and when?

This guidance was approved by the Research Policy Committee 24 June 2010

This guidance note to University staff summarises the University's current intellectual property (IP) rights policy (the 2005 Ordinance on Intellectual Property Rights) and clarifies how it operates on a day to day basis. In particular, the guidance sets out the respective responsibilities for managing IP for all involved. The guidance begins with a brief summary of the Policy¹.

Summary of the IPR Policy

The Policy addresses IP generated in two distinct situations:

- A) IP generated in research projects governed by agreements with third parties (including research grant terms), and
- B) all other IP.

A) IP subject to third party agreed terms

Sponsors or other third parties with whom an agreement is put in place may have ownership, licensing or other rights to IP created during the term of that agreement. Such rights override the Policy's default position on IP ownership (as set out for type B IP below).

B) IP not subject to third party agreed terms

Who owns what?

Where results arise from a staff member's normal course of University employment, and those results are registrable, the University has the initial right to apply for an invention patent or other IP right. The University or its nominee, currently Cambridge Enterprise Ltd (CE), will become the owner of such IP right and the creator(s) will be named on the application. But note:

- Creators of the IP may decide to make their research public, but if they wish to patent and commercialise their results, public disclosure must be delayed until a patent is filed otherwise the patent will be invalidated.
- If any IP rights exist without need for formal application, for example copyright², then such rights belong to the creator, with the exception of works created for University administrative and managerial purposes.
- The University owns any registered trademark which would associate the University with the exploitation of a product or service.
- The Head of Department or their authorised delegate may authorise the release of copyright so-owned by the University under Open Source rules or similar arrangements.

¹ For the full IPR Policy see Chapter XIII of the University's Statutes and Ordinances:

http://www.admin.cam.ac.uk/univ/so/pdfs/cso_4_ordinance13_964_993.pdf

² For further information about copyright see <http://www.admin.cam.ac.uk/cam-only/offices/legal/copyright/>

Who should be informed of new IP?

Creators who wish to commercialise results are obliged to disclose IP that could be registrable to the University through CE and are also obliged to notify their Head of Department.

What happens next?

CE and the creators will jointly decide whether or not to pursue commercialisation of the idea and the type of IP protection required. If the creators choose, or it is otherwise agreed, to exploit the IP independently of CE, and there is no third party agreement to prevent this, they may require the University to assign its rights to them subject to a share of royalty income, or other financial consideration where commercialisation proceeds.

Any revenue received from commercialisation of IP, whether through CE or otherwise, shall be distributed in accordance with the revenue-sharing tables of the Schedule to the IP Policy. Where there are multiple creators, they shall agree amongst themselves the split of the inventor share and inform CE.

What about students and other non-University employees?

Although students are not University employees, they own their own IP except in the following cases:

1. There is an overriding third party agreement governing their work, for example through direct sponsorship of their studentship or through their involvement in an existing externally funded research project;
2. The IP is jointly created with other researchers or its creation is dependent on other University IP, in which case they may be required to assign the IP to the University or place the results in the public domain.

In both cases, the supervisor of the student must advise the student as early as possible about the relevant circumstances and third party funding terms. Where IP is assigned to the University or a sponsor, or licensed to a sponsor, the student will be treated as a University employee with respect to the sharing of any revenue income received by the University from commercialisation of the IP.

The Principal Investigator must ensure that any visitors or other non-University employees working on a project do not compromise any obligations to third parties and consider putting in place appropriate agreements. If College Teaching Officers or College Research Fellows work on University projects, they must agree to be bound by the IP Policy.

What happens in cases of disagreement?

Any disputes concerning implementation of the IP Policy may be referred to a University Technology Referee, the full process for which is set out in the Policy.

Summary of responsibilities

Certain responsibilities are inherent in the IP Policy and for smooth operation of the policy these responsibilities are best undertaken by key parties as summarised below.

Principal Investigator's responsibilities

- To ensure that all research staff and students working under a third party agreement know about, understand and agree, if appropriate, in writing, to comply with the terms of such agreement.
- To further ensure that any visitors or other non-University employees working on a project do not compromise any obligations to third party funders or collaborators and if needed ensure separate agreements are put in place. The Research Office (RO) will be happy to advise.
- To disclose any new IP to their Head of Department or their authorised delegate (or to the Head of School if the PI is the Head of Department) and to CE. To notify CE of an invention, an invention disclosure form is available here: <http://www.enterprise.cam.ac.uk/resources/documents-downloads/>. University employees are encouraged to discuss their invention idea with CE before completing the disclosure or to request a CE contact help them complete the disclosure.
- To help identify all creators of the IP and any relevant funding or third party agreements governing ownership or exploitation of the IP. Note that these may include not just research collaboration agreements but Material Transfer Agreements, Confidentiality Agreements, Visitor's agreements and others, which may have been put in place by the RO, Cambridge University Development Office, the Legal Services Office, or other offices.
- Where the creators decide to exploit IP through CE, to discuss and agree with CE the appropriate exploitation route and corresponding IP protection. Where the creators decide to exploit independently of CE, to facilitate this process in consultation with all the creators.
- To ensure the creators agree a fair split of the inventor revenue share and inform CE of this.

Research staff responsibilities

- Prior to commencing a research project that is governed by a third party agreement, to ensure they agree to and comply with the terms (and if they do not, not to get involved in the project).
- To inform the PI or student supervisor of the creation of the IP if these persons are not themselves a creator.
- To help the PI identify all relevant creators of IP as set out above for the PI.
- To cooperate with the PI in agreeing a fair split of the inventor revenue share.

Head of Department's responsibilities

- To ensure PIs and research staff understand and practise their responsibilities.
- To help identify all relevant creators of IP and any relevant funding and third party agreements.

- To ensure there is oversight of the management of arising IP from research carried out in their department and good academic practice on attribution of contribution.
- To maintain a register of third party agreements in which IP is assigned to the third party, noting the third party title, duration of agreement, researchers involved and the IP provisions. The RO can provide a template for such a register.
- To be satisfied that IP disclosures or filings do not conflict with other third party agreements in their departments or, where there is a relationship or potential relationship, all interested parties are aware of the disclosure subject to confidentiality terms.

Cambridge Enterprise's responsibilities

- To inform the Head of Department when an initial disclosure of a potential patent or other registerable right is made to CE.
- The decision to commercialise the IP (type B IP) is a mutual decision between the creators and CE taking into account the desires of the creators, commercial viability and expense. Any decision by CE not to pursue commercialisation will be communicated to the creators in a timely fashion. For type A IP, CE will act on behalf of the University to commercialise IP in accordance with the provisions of the third party agreement.

Research Office's responsibilities

- To ensure the PI is consulted during the negotiation of the terms of any third party agreement and agrees to the terms. The starting position for negotiation is similar to Research Council policy which provides for ownership of IP by the University or its nominee.
- To seek, through the PI, the agreement of all research staff involved to the terms when IP is assigned to a third party.
- To seek the Head of Department's approval prior to signing an agreement where IP is assigned to a third party.

Further information and useful links

Who to contact at Cambridge Enterprise:

<http://www.enterprise.cam.ac.uk/company-information/people/>

Who to contact at the Research Office:

<http://www.admin.cam.ac.uk/offices/research/contact/default.aspx>

For the University's full 2005 Intellectual Property Ordinance:

http://www.admin.cam.ac.uk/univ/so/pdfs/cso_4_ordinance13_964_993.pdf

For Guidance from the RPC and a Q&A summary of the Policy:

<http://www.enterprise.cam.ac.uk/university-community/inventions-ip-licensing/policies/>

For information about the negotiation of research agreements, the different types, the terms they contain, and who to contact:

<http://www.admin.cam.ac.uk/offices/research/negotiating/default.aspx>

For advice on consultancy arrangements: <http://www.enterprise.cam.ac.uk/university-community/consultancy-services/>