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Owner: Vice President for Research, Office of the Vice President for Research

Related University Documents: QA413 Conflict of Interest Policy, Code of Conduct for Staff, Code of Good Conduct in Research

Related National Policies and Protocols: National IP Protocol, Code of Governance, EU State Aid Rules

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1. Introduction

- 1.1 The Policy provides for the effective management of Intellectual Property created by University Personnel, including when working with any other Entity. It establishes the rules governing the ownership, disclosure, protection, and commercialisation of University Intellectual Property. The Policy also provides for the distribution of income arising from the commercialisation of University Intellectual Property.
- 1.2 An Intellectual Property Group (IPG), chaired by the OVPR comprised of senior executives appointed by the OVPR, the Bursars Office, and Oifig an Rúnaí. The IPG will provide oversight and guidance for the interpretation and implementation of this Policy. The group meets quarterly or as called upon by the chair and provides an annual IP management report to the UMT.
- 1.3 This policy applies to all University Personnel and any Entity involved in any way with the creation, management, or commercialisation of University Intellectual Property
- 1.4 This document supersedes and replaces all previous policies.

2. Definitions

"Code of Governance" means the HEA/IUA "Governance of Irish Universities 2012" and its revisions;

"Contributor" means University Personnel or an Entity that significantly advances the Intellectual Property but is not an Inventor;

"Dual Appointees" means any person who is employed by and has entered into and signed an employment agreement with the University and another Entity

"Entity" means any company, organisation, institution, establishment, body, operation, structure, system, or individual which is not the University;

"Equity Income" means cumulative payments received by way of dividend, or realised on disposal of the University shareholding in a Spin-out;

"Intellectual Property" or "IP" means patents, trademarks, service marks, registered designs, drawings, utility models, design rights, business ideas, concepts, inventions, discoveries, breeders' rights, trade secrets, copyright (including the copyright in software in any code), database rights, know-how and other confidential information, technology, business or trade names, goodwill and all other rights of a similar or corresponding nature in any part of the world, whether registered or not or capable of registration or not, and including all applications and the right to apply for any of the foregoing rights;

"Inventor" means a member of University Personnel who invents, discovers, or otherwise creates Intellectual Property;

"Invention Disclosure Form" or "IDF" means the record of an invention, the inventors, the contributors, and the circumstances under which the invention was made. It provides the basis for a determination of patentability, the data for drafting a patent application, and the relative contribution of the inventors and contributors;

"IP Expenses" include all patent, legal, insurance, and professional fees associated with patent protection and exploitation;

"IP Income" means cumulative payments received by the University from royalties, option fees, license fees, the sale of UIP, and any other payments that are made to the University in consideration of the grant or transfer of the commercial rights of UIP;

"Lessee" means a company that is located on campus that has entered into a facilities lease agreement with the University but is not utilizing any UIP;

"National IP Protocol" means Ireland's National IP Protocol 2019 which provides a framework for best practice, guiding on the expected norms for research-related engagements between industry and State research performing organisations (RPOs).

"Net Equity Income" means Equity Income after the deduction of all IP Expenses;

"Net IP Income" means IP Income after the deduction of all IP Expenses;

"OVPR" means Office of the Vice President for Research;

"Policy" means the Intellectual Property Policy of the University;

"Previous Policy" means the "National University of Ireland, Galway Intellectual Property Policy and Procedures" published August 2, 2007;

"Research Student" means any undergraduate or postgraduate student of the University, who is in receipt of University-administered stipend, scholarship, grant or salary which is intended to enable the student to carry out research, or is engaged in a research project that is being carried out for a party with which the University has a contract (including but not limited to a funding agency, industry partner or charity), or which is for the express purpose of securing a contract with an external party and the student has been advised and has consented to the inclusion of the student's research;

"Spin-out" means a company established by University Personnel for the purpose of developing and commercialising University Intellectual Property;

"TTO" means the Technology Transfer Function of the Innovation Office at the University;

"University" means the National University of Ireland, Galway;

"University Assets" means all facilities, materials, and University Intellectual Property;

"University Intellectual Property" or **"UIP"** means any Intellectual Property generated by University Personnel;

"University Personnel" means all employees and Research Students of the University, Visiting Researchers, adjunct staff, consultants, emeritus staff, Dual Appointees, and all others participating in research programmes carried out for the University or undertaken using University Assets;

"Visiting Researcher" means an individual who is visiting the University for the purposes of undertaking any work or research for or at the University.

3. Conflicts of Interest and Conflicts of Commitment

Pursuant to the University's policies and procedures for the disclosure and management of conflicts of interests and conflict of commitment, University Personnel shall:

- 3.1 Avoid ethical, legal, financial, or other conflicts of interest and shall ensure that their activities and interests do not conflict with their obligations to the University or its welfare.
- 3.2 A conflict of interest arises when an individual holds a personal interest, whether direct or indirect, which in the opinion of a reasonably informed and well-advised person is sufficient to call into question the independence, impartiality and objectivity the individual is obliged to exercise in the performance of his/her duties. Conflicts of interest may be financial or non-financial or both.
- 3.3 The existence of an actual, perceived or potential conflict of interest does not necessarily imply wrongdoing on anyone's part. However, any private, personal or commercial interests which give rise to such a conflict of interest must be recognised, disclosed appropriately and either eliminated or properly managed.
- 3.4 Conflicts of interest that may arise in connection with IP commercialisation include, but are not limited to, the following:
- 3.5 An individual using his/her University position to:
- 3.6 Influence a contract or other favourable terms for a company in which he/she, or a relative or friend, had a financial interest.
- 3.7 Obtain financial or non-financial benefits for him/herself or for a relative or friend in return for providing advantage, or potential advantage
- 3.8 Use University resources or confidential information for personal financial or non-financial benefit, or benefit to a relative or friend
- 3.9 Conduct business, employment or activity outside of the University, which adversely affects the individual's ability to perform his/her duties
- 3.10 An individual compromising research objectivity or independence in return for financial or non-financial benefit for him/herself or for a relative or friend
- 3.11 Examples of these kinds of conflicts (this is not an exhaustive list):
- 3.12 A researcher having a financial interest in the company sponsoring research, this being exacerbated if the value of the researcher's interest may be affected by the outcome of the research.
- 3.13 An individual is an inventor of patents or creator of other IP whose value may be affected by the outcome of research in which they are involved.
- 3.14 An individual holds a position in an enterprise (e.g. as director) that may wish to restrict (or otherwise manage) adverse research findings for commercial reasons or not wish to publish the results of the research.
- 3.15 An individual having a financial interest or other personal interest in a Spin-out or may have personal IP with which they are intending to create a start-up company.
- 3.16 An individual having a financial interest in the licensee (or proposed licensee) of University intellectual property.
- 3.17 An individual taking part in the negotiation of a contract between the University and a company, where the individual or his or her family or a close personal friend has a financial or non-financial interest (e.g. a directorship) in that company.
- 3.18 In the event that the University identifies a potential, actual or perceived conflict of interest related to IP commercialisation, it shall make the individual(s) concerned aware of the conflict and advise them to follow the process outlined in the Conflict of Interest policy.
- 3.19 Ensure that any arrangements made personally with another Entity do not conflict with their intellectual property obligations as set out in this Policy.

4. Ownership of University Intellectual Property

- 4.1 Subject to the exemptions set out in this Policy at section 4.4, all University Intellectual Property is the property of and vests solely and absolutely in the University. The TTO is responsible for the management of the University's Intellectual Property. As such, the TTO is responsible for all negotiations, evaluation, marketing, licensing, assignment, and disposal of the University's Intellectual Property.
- 4.2 The Policy applies particularly but not exclusively to any University Intellectual Property arising from the work of:
- 4.2.1 University Personnel in the course of their employment; and
 - 4.2.2 University Personnel in the course of their employment whilst on the premises of another Entity; and
 - 4.2.3 University Personnel creating IP outside the course of their employment with *significant use of University Assets; and
 - 4.2.4 University Personnel in the performance of any work for the University including work performed under another agreement.
- *Decisions with respect to what constitutes significant use of University Assets is at the discretion of the TTO.
- 4.3 University Personnel who have a prior existing and conflicting intellectual property arrangement with another Entity must enter into an agreement with the University (and the relevant Entity) to abide by the conditions of this Policy.
- 4.4 Exemptions to University ownership of Intellectual Property created by University Personnel include:
- 4.4.1 IP that the TTO deems to be of a non-commercial nature; and
 - 4.4.2 IP that is unrelated to an individual's University duties provided he or she does not make significant use of University resources or University information or University Intellectual Property or University Assets; and
 - 4.4.3 IP arising from the research of unpaid students under the direction of University Personnel (with the exception of cases where that work is subject to the terms and conditions of any other agreements); and
 - 4.4.4 IP arising from the activities of a Lessee.

5. Disclosure of University Intellectual Property

- 5.1 University Personnel must disclose all University Intellectual Property on a timely basis to the TTO. This is achieved by completing an Invention Disclosure Form as soon as possible after the creation of the University Intellectual Property and in any event, prior to any disclosure of information relating to the University Intellectual property to another Entity, or the submission of abstracts or manuscripts for publication containing University Intellectual Property.
- 5.2 In making such a disclosure, University Personnel must declare the names of all Inventors and Contributors and specify their relative contributions to the University Intellectual Property.

6. Assignment of Intellectual Property to the University

- 6.1 All Inventors and Contributors of University Intellectual Property must assign all rights in the respective University Intellectual Property to the University.

7. Protection of University Intellectual Property

- 7.1 The effectiveness of the University's Intellectual Property management depends on University Personnel being aware of and complying with this Policy.
- 7.2 The Inventors and the Contributors are required to provide assistance and to perform all obligations necessary to enable the University obtain protection for University Intellectual Property.
- 7.3 It is crucial to maintain the confidentiality of University Intellectual Property prior to evaluation thereof. University Personnel must not publish or otherwise disclose University Intellectual Property until appropriate protections are in place. The TTO will notify University Personnel when publication can take place.
- 7.4 University Personnel who wish to disclose unprotected confidential information (relating to University Intellectual Property) to another party must first contact the TTO. The TTO arranges for a suitable confidentiality agreement to be in place prior to any discussions taking place.
- 7.5 University Personnel who intend to provide, receive or exchange materials with other parties should first consult the TTO. The TTO arranges for a suitable material transfer agreement to be in place before the exchange of any materials.
- 7.6 All UIP disclosed to the TTO is evaluated for its commercialisation potential. If that evaluation concludes that the UIP is patentable and has strong commercial potential, then the TTO, in consultation with the Inventor(s), files a patent application.
- 7.7 The TTO, in consultation with the Inventor(s), and where appropriate, the licensee is responsible for all decisions concerning the continued prosecution and maintenance of patents. In making such decisions, consideration is given to factors such as the commercial potential of the UIP, contractual obligations to any other Entity, the maturity of the technology, the availability of further research or funding, and the views and support of the Inventor(s).
- 7.8 All notebooks and records maintained by University Personnel are subject to legal scrutiny in the application for UIP protection. Therefore, all University Personnel are obliged to maintain accurate and contemporaneous records of the steps leading to their invention/discovery. University Personnel are obliged to retain data generated in the course of their research in accordance with the NUIG Laboratory Notebook Policy. The University requires that such data is securely retained upon completion of a project.

8. Commercialisation of University Intellectual Property

- 8.1 The commercial value of University Intellectual Property is generally realised through licensing or, in exceptional cases, an assignment of the University Intellectual Property to an Entity. The University may approve the creation of a Spin-out by University Personnel to develop and commercialise the University Intellectual Property.
- 8.2 The TTO is responsible for the commercial exploitation of University Intellectual Property and selects commercial partners based on their ability to exploit the University Intellectual Property for the benefit of society.
- 8.3 The TTO is responsible for the negotiation of the final commercial agreements on a case-by-case basis. The final commercial agreements shall conform at all times to this Policy, the National IP Protocol, the Code of Governance, and EU State Aid Rules.
- 8.4 The commercial terms vary depending on factors such as the type of technology, the stage of its development, contractual obligations to funding bodies or industry parties as relevant, and the nature and extent of the contributions (if any) of the respective industry party.
- 8.5 In commercialising University Intellectual Property, the TTO considers international best practice, the National IP Protocol and other relevant codes and guidelines. The payment terms negotiated typically include royalties on sales, and other payments such as upfront payments and development milestone payments. The TTO negotiates licence and assignment terms on a case-by-case basis.
- 8.6 University Personnel do not have any right to license University Intellectual Property to any other Entity without the prior written authorisation of the TTO.
- 8.7 In the event that the University decides not to commercialise or otherwise exploit University Intellectual Property, the University may assign such University Intellectual Property to the Inventor(s) upon request.
- 8.8 If the University agrees to assign University Intellectual Property to an Inventor, such assignment will be contingent on the University receiving a fair consideration arising from such assignment. For the avoidance of doubt, once the University assigns Intellectual Property to the respective Inventor(s), he/she will be subsequently responsible for the management and costs associated therewith.
- 8.9 The University encourages and supports the formation of Spin-outs to promote new jobs and to develop University Intellectual Property.
- 8.10 The University permits University staff to organise and assist in the running of Spin-out in accordance with University Code of Conduct for Staff on work outside the University.
- 8.11 In consideration of public investment in research, leading to the development of University Intellectual Property, and the benefits bestowed on a Spin-out by association with the University and support from its start-up programs, the University is allocated shares in the issued share capital of the Spin-out Company.
- 8.12 Where the University receives equity in a Spin-out the University through the IPG has discretion in the disposal of that equity.

9. Formation of a Spin-out

The TTO, in consultation with the appropriate College Dean(s) is responsible for the approval of University designated Spin-outs. In order to request approval the applicant must:

- 9.1 Incorporate as a limited company with the Companies Registration Office; and
- 9.2 Provide a business plan including but not limited to information and evidence of: Inventors and contributors equity share, management team, commercial opportunity, UIP to be licensed, sources of funding, and any proposed research collaborations with the University; and
- 9.3 Provide a letter of endorsement from the appropriate head(s) of school.

The University will permit research sponsored by companies in which faculty have equity holdings or any other financial interests under appropriate circumstances:

- 10.1 University contracts with spin out licensees must be negotiated by the appropriate University office and not directly by the Inventor; and
- 10.2 Any association of the Inventor(s) with the spin out licensee will be subject to disclosure, including compensation, prior approval, and annual reporting. ; and
- 10.3 Appropriate procedures outlined in the conflict of interest and commitment policy must be adopted to ensure clear separation of allegiance and duties.

10. Conditions for licensing or assigning University Intellectual Property

To protect the academic freedom of the University and University Personnel, the University will incorporate, inter alia, the following terms into commercial agreements:

- 10.4 Grant-back of licensed University Intellectual Property to the University for research and education purposes; and
- 10.5 All University Intellectual Property is provided on an "AS IS" basis without any warranties.

When licencing to a spin out company, the University will incorporate, inter alia, the following terms into commercial agreements:

- 10.6 The University will normally be allocated no less than ten percent (10%) equity in recognition and support of the environment which produced the invention; and
- 10.7 The University will normally require royalties on sales, and other payments such as upfront payments and development milestone payments.

11. Net IP Income Distribution

11.1 The University shares Net IP Income with the respective Inventor(s) and Contributor(s). The University distributes Net IP income in accordance with Table-1.

Net IP Income(€)	¹ Inventor(s) Contributor(s)	² School	³ University
< €125,000	75%	15%	10%
€125,001 - €200,000	50%	30%	20%
€200,001 - €500,000	40%	30%	30%
€500,001 - €1,000,000	35%	30%	35%
>€1,000,001	30%	30%	40%
Average Distribution	46%	27%	27%

Table 1: Distribution of Cumulative Net IP Income

¹ The distribution of Net IP Income or Net Equity Income to Inventor(s) and/or Contributor(s) is to reward the development of research and the respective allocations are based on relative intellectual contributions as set out in the IDF.

² The respective schools share of Net IP Income or Net Equity Income is to recognise, support, and encourage research that generates University Intellectual Property with meaningful impact.

³ The University's share of Net IP Income or Net Equity Income supports, firstly, technology transfer, secondly, innovation programs as determined by the OVPR, and thirdly core university activities.

11.2 Where an Inventor or a Contributor holds a shareholding in a Spin-out which has received access to University Intellectual Property, then such Inventor(s) and/or Contributor(s) are not entitled to a share of Net IP Income as they have already received a benefit arising from their respective shareholding.

11.3 For the avoidance of doubt, the University recovers all IP Expenses incurred in the protection and management of University Intellectual Property before distributing the Net IP Income or Net Equity Income.

12. Dispute Resolution

12.1 Any dispute will be referred to the IPG in the first instance followed by the Vice President for Research.

12.2 In the event that the dispute has not been settled internally, it shall be submitted for mediation by a mediator or other appropriate independent third-party expert agreed by the Parties or, in default of agreement, appointed by the Centre for Dispute Resolution in Dublin. The cost of any such mediator or expert shall be borne equally by the Parties.

13. Contact

Direct all queries on content and implementation of this Policy to the NUI Galway TTO.