

## **OXFORD BROOKES UNIVERSITY**

### **INTELLECTUAL PROPERTY POLICY AND REGULATIONS**

#### **INTELLECTUAL PROPERTY POLICY**

##### **PREAMBLE**

**Intellectual Property is an asset that may have commercial value. The University has a responsibility to ensure that it is managed effectively**

**It is the University's policy that:**

- 1 the product of work carried out with the benefit of the University environment (which includes facilities, resources, expertise and intellectual assets) constitutes intellectual property that should be owned, protected and used by the University for the general good of the whole University community
- 2 the University should make provision to recognise and reward persons who
  - a) create work within the University that may have commercial value or
  - b) bring into the University for its benefit already created work which they own
- 3 the University should not infringe the rights of others who own and control Intellectual Property
- 4 the University should meet its obligations to the funders of research including where required the management and commercialisation of the results of the research.

The following regulations are designed to implement the policy by allowing the University to acquire, protect and use the Intellectual Property (IP) generated within the University environment, to recognise and reward the creators of IP and to avoid infringement of third party IP rights.

Separate brief guides on intellectual property rights and on Copyright in course materials are attached (*APPENDICES A and B*)

# INTELLECTUAL PROPERTY REGULATIONS

## 1 Responsibility

The Director of the Research and Business Development Office is responsible for development and implementation of the University's Intellectual Property (IP) management strategy and for directing the management and commercialisation of IP for the University.

## 2 Coverage of the Regulations

2.1 These Regulations cover IP in all material concerning any of the University's activities whether research, consultancy, academic, professional or other including IP created using university facilities and resources. For the avoidance of doubt, the University owns IP if:

- a) the IP was created by a person then employed by the University in circumstances where the law presumes ownership to the employer or
- b) b) the IP owner has in writing assigned his/her rights to the University

2.2 These Regulations cover all persons

- a) bound by the University's regulations in general by virtue of their employment or
- c) under a contract (such as a contract for services or a student contract) binding the signatories to abide by these Regulations or
- d) otherwise agreeing to abide by these Regulations specifically (which agreement may be by written contract or by conduct or by verbal indication)

2.3 Where a person is bound to these Regulations by virtue of their employment by the University, that person continues to be bound in respect of IP created during their University employment and as described at 10 below

## 3 Exceptions to the Regulations

3.1 IP created by undergraduate students and taught postgraduate students is exempt save where the University specifically negotiates and agrees otherwise (for example in relation to final year projects, projects involving 3rd parties and work requiring use of pre-existing university-owned IP).

3.2 Postgraduate students will be asked to disclose any relevant IP, which they or their employer (if relevant) owns to enable their Postgraduate Research Tutor to determine whether an assignment or licence agreement is needed. See Appendix C for sample letters to new and current students. Unless otherwise agreed in writing between the postgraduate student and the University, the University claims ownership of all IP arising from their studies (excluding thesis copyright). An inventor's revenue-share agreement may be negotiated in the event of the commercialisation of arising IP.

3.3 Generally, scholarly works produced solely in the furtherance of an academic career, being articles in journals, papers for conferences, study notes not used to deliver teaching and books not commissioned by the University, are not subject to these Regulations.

3.4 The Director of Research and Business Development will be pleased to consider any particular case raised by those exempt from the regulations with a view to admitting it,

by agreement, to the coverage of the Policy and Regulations but will not be bound to admit any case. This would be subject to verifying the factual basis of generation and ownership and to agreeing a share in the value of any successful commercialisation. The Research and Business Development Office will be pleased, where practicable, to provide support and guidance in the shape of information, contacts and examples but on a strict "no liability" basis and on the understanding that any individual IP owner would always be best served by taking independent advice on their own position

- 3.5 Where those exempt from the policy and regulations jointly generate IP with staff an agreement between the Research and Business Development Director and those exempt may be sought to determine if and how the IP may be exploited and how the value of any successful commercialisation would be shared. It should be noted that in this case neither the University nor the exempt person may exploit the joint IP without the agreement of the other party.

#### **4 Responsibility to identify and protect IP (including duty of confidentiality)**

- 4.1 When undertaking University work from which IP may be expected to arise all persons bound by these regulations must:
- a) keep the nature of and matters relating to IP confidential until the fact and manner of disclosure is agreed with the University's Research and Business Development Office
  - b) assist in protecting the University's rights to the IP by keeping suitable records of creation wherever possible drawing on guidance provided in APPENDIX D

#### **5 Disclosure**

- 5.1 All persons bound by these Regulations are responsible to the University for disclosing to the Dean (or nominee) or Director of RBDO at the outset of the work or as soon as they become aware of it (by completion of the University Invention Disclosure Form -see APPENDIX E):
- a) any potentially commercialisable IP arising from their work
  - b) the ownership by a third party of any IP referred to or used for their work
  - c) any use to be made of existing university IP during their work
  - d) any IP which they themselves own which is proposed to be used by the University

#### **6 Securing the University's rights in relation to use of IP**

- 6.1 All persons bound by the Regulations must co-operate with The Research and Business Development Office to ensure all of the following:
- a) that project/work outcome is, wherever possible, owned by, assigned to or licensed for the University's use and/or commercialisation on adequate and advantageous terms
  - b) that those terms are agreed and made clear in any bid or proposal or collaboration document relating to the project/work prior to the commencement of the work

- c) before the start of any collaboration with 3rd parties who are not bound by these regulations (including students, visiting academics as well as other universities and companies) from which IP may arise or for which University IP may be used or disclosed that RBDO secure appropriate agreements for the University relating to confidentiality and IP issues.
- d) that the University may procure from the individual or third party owner or controller of any IP referred to or used for their work within the University an appropriate licence, assignment or consent for the University's use of the IP at the outset of the work to avoid infringement
- e) that no work is conducted for the benefit of or using material owned by a third party before the terms of ownership and use of project/work outcome are agreed
- f) that the University's ownership is asserted in relation to trademarks and its copyright interest in paper or electronic materials. See APPENDICES A AND B for guidance

## **7 Reward for creation**

- 7.1 The Director of the Research and Business Development Office shall administer a system of reward for and adjudication between creators to which all persons bound by these Regulations shall have the right to apply, whether as individuals or as a team, where they can warrant and demonstrate their creation of IP which has been of value to the University. Persons offered a reward under this system may be required to execute a formal agreement to enshrine the terms of the reward and their obligations. For details of the University's revenue share arrangements see APPENDIX F
- 7.2 Where IP is generated jointly by staff, or by staff and undergraduates or postgraduates, they are each responsible for informing the University of their individual contributions to its generation. For the purposes of distribution of compensation or reward in respect of IP generated jointly among staff it shall be their responsibility to agree their pro rata shares and to inform the University in writing by completion of the University Invention Disclosure Form. Where there is no agreement the Director of RBDO shall make an initial ruling.

## **8 Notification of Infringement**

- 8.1 Any person bound by these Regulations must alert the University's Research and Business Development Office immediately on suspecting or becoming aware of an infringement of IP rights being either
- a) infringement of IP rights owned by the University or
  - b) the University's infringement of IP rights owned by a third party
- 8.2 In the case of actual or suspected infringement of third party IP rights, any person bound by these Regulations must comply with the instructions of the University's Legal Services Department in order to minimise the impact and extent of the infringement. Any action will be entirely at the discretion of the University.

## **9 Applications to use the University's materials**

- 9.1 The University is willing to consider requests from its staff and students for a licence to use specific IP owned by the University for their use although the terms and decision to grant any such licence is wholly a matter of discretion for the University.
- 9.2 Applications for a licence under paragraph 9.1 should be made in writing to the Director of Research and Business Development who shall within 20 working days of receipt give either an initial ruling or reasons for not so doing together with an indication of process (e.g. further information required, reference to another person/body for decision or opinion) including where a right of appeal would lie.

## **10 On leaving the University**

- 10.1 Persons bound by these Regulations shall continue to acknowledge and attribute the University's IP rights created during the period of their employment or other contractual obligation at the University in a clear manner and to avoid misleading future employers or collaborators or other material third parties as to the interests in the IP concerned. Usually it will be the intention of the University that entitlements and obligations arising under these Regulations continue after employment at the University ceases. This is providing that the commercialisation of the Intellectual Property is not hindered and that the inventor continues to support the commercialisation as necessary after employment ceases. This may require a negotiation with a future employer involving a sharing of overall revenues with the new employer and clarification that no conflicts of interest exist.

## **11 Breach of the Regulations**

- 11.1 Breach of these Regulations is a disciplinary matter for University staff and students under the normal procedures.
- 11.2 The University shall consider all avenues available to it, including legal action by injunction or for damages or otherwise, in respect of persons bound by these Regulations acting in breach of them

## **12 Discretion to Assign/licence back**

- 12.1 If the University decides that it does not wish to pursue the commercialisation of any Intellectual Property or that it does not wish to maintain an interest in Intellectual Property it has the discretion to assign its rights to the inventors of the IP or to enter into an agreement to enable the IP to be used by the inventors. This will generally only be granted where there is clear evidence that the IP provides no other benefit to the University and is not related to other IP which the University has an interest in. The University will not assign its interest if it considers that the commercialisation of the IP could potentially bring the name of the University into disrepute through previous association.
- 12.2 Requests for any transfer of rights from the University to another party with rights should be made in the first instance to the Director of the Research and Business Development Office.

## **13 Amendments to the Regulations**

13.1 These Regulations may be amended by the Vice Chancellor on the recommendation of a Deputy Vice Chancellor, Director of Research and Business Development and Legal Services after consulting with Centre for e-Learning and/or Research and Knowledge Transfer Committee.

## **14 Disputes**

14.1 Any person disputing the coverage, administration or effect of these Regulations must address their concern in writing in the first instance to the Director of the University's Research and Business Development Office who shall within 20 working days of receipt give either an initial ruling or reasons for not so doing together with an indication of process (e.g. further information required, reference to another person/body for decision or opinion).

## **15 Appeals**

15.1 Any person dissatisfied with the application of or a decision made under these Regulations must appeal in writing to the Director of Research and Business Development Office who will forward the appeal for the attention of the Commercialisation Review Panel chaired by the University's Deputy Vice-Chancellor and Registrar save where the Commercialisation Review Panel or its Chair has a conflict of interest in which case the Director of Research and Business Development Office shall arrange an alternative forum for review after consultation with the person making the appeal.

15.2 The University reserves the right to delay or refuse an appeal under 15.1 where it is satisfied that the subject-matter of the appeal has been referred to and is being progressed under another suitable process, such as the University's Student Complaints Procedure, including an external process where the University is content to recognize the outcome of that external process.

## **16 List of Appendices**

- A. Brief guide to Intellectual Property Rights
- B. Guidance on Copyright in course materials
- C. Sample IP letters to new and current postgraduate students
- D. Guidance on recording the creation of IP
- E. Invention Disclosure Form
- F. Revenue Share Arrangements

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OXFORD BROOKES UNIVERSITY  
INTELLECTUAL PROPERTY POLICY AND REGULATIONS

**BRIEF GUIDE TO INTELLECTUAL PROPERTY RIGHTS**

**(for guidance on copyright in course materials see Appendix B)**

**1. What is intellectual property?**

Intellectual Property (IP) is the term used for any inventive product of the human mind i.e. all IP has a human creator, although the wider question of whether something occurring in nature (DNA for example) can be claimed as IP is not certain. IP can either be tangible such as a physical work of art or intangible such as a scientific process.

**2. How is IP used?**

The ownership and control of IP is expressed in terms of IP rights (IPR) such as copyright. The system of ownership and licensing means that a right to use IP can be distinct from the ownership of that IP; for example the author of a novel can license a film company to make a film of the book. Obviously, the IP owner usually wants to be paid for allowing someone else (the licensee) to use the IP.

**3. Who is the owner of IP in law?**

Generally the creator of IP is its legal owner (often described as the "first owner"). From the University's point of view, the most important exception to this is the general rule that IP is owned by a person's employer where the IP is created as part of, or through the auspices of, the person's employment.

Ownership rights can be assigned by the first owner; this assignment is often made, for example, as a condition of a researcher's funding (i.e. the funder is prepared to pay for the research provided that ownership of any IP is assigned from the researcher to the funder).

**4. How is ownership of IP protected?**

Legally recognised IPR can arise automatically, as with copyright, or can arise through registration, as with patents. Other rights are capable of enforcement either as unregistered or registered rights, as with design rights. It is beyond the scope of this guide to analyse the difference in enforcing unregistered and registered rights.

Where there is no legally recognised right of ownership in a particular type of inventive or creative asset, the only way to protect the value of the ownership is to keep the nature of the asset secret. This means that trading with or discussing the asset must be done under terms of strict confidence, usually emphasised by the parties entering into a formal confidentiality agreement. For example, there is no legally recognised way of protecting "know-how" so it is prudent to disclose valuable know-how only when the person to whom it is disclosed has been placed under an obligation of confidence. The law recognises obligations of confidence and offers remedies for a breached obligation.

Even where a legally recognised system of protection exists for a type of IP, some owners still choose to rely on secrecy rather than take advantage of protection offered

where, as with a patent, disclosure is a condition of the protection. Once IP is disclosed, the "keeping it secret" option has gone.

## **5. Summary of the main classes of IPR.**

### Patent

A registered patent provides a time-defined (up to 20 years) geographically defined monopoly right to exploit a new commercially valuable invention or process. The basis of the permission to exploit is that the invention's working is disclosed, although as noted in 4 above, patenting is not possible if there has been ANY prior disclosure of the invention (governed by the Patents Act 1977).

### Copyright

This time-limited (varies between 25 and 70 years according to the material) right arises automatically on the physical creation (not the idea) of software, original literary, dramatic, artistic or musical work, and in recorded (e.g. film) or published (e.g. layout) derivations. Use of the © mark and owner's name and date is the internationally recognised way of alerting the public to the copyright ownership but the protection (the right to preventing unauthorised copying) exists regardless. (governed by the Copyright Designs and Patents Act 1988).

Copyright may be assigned to a third party, but until that point or until a licence is agreed it remains the property of the creator, unless s/he creates the work 'in the course of his/her employment', in which case it is the property of the employer.

Appendix B provides guidance on copyright in course materials including courseware.

### Moral rights

In addition, all European countries (including the UK) recognise an author's moral rights. There are four – paternity, integrity, false attribution and privacy. These rights relate to the reputation or standing of the creator in the eyes of fellow human beings. To infringe a moral right involves denigrating or harming the author's reputation. The right of paternity has to be asserted in writing: it is the right to be identified as the author of the work. The right of integrity means the copyright owner has the right to object to derogatory treatment of his/her work. Basically, this means changing it in any way without permission. Moral rights can be waived: by this, the author chooses not to exercise the rights – or they can be bequeathed. They cannot be assigned.

### Performing rights

Creators of copyright works have the right to protect the physical form in which those works are created – words on the page, pigment on a canvas, or the clay or metal of a sculpture. Performers such as actors, musicians and dancers also enjoy protection of their performance, especially when recorded on film, video, tape, CD, or in other form. Performing rights may affect the multimedia elements of online courseware, as well as the creator's copyright in the material itself.

### Database Right

This time-limited (15 years) right arises without registration to protect the compilers of non-original information from losing the benefit of their work through unauthorised copying or re-use. (governed by the Copyright and Rights in Databases Regulations 1997).

### Industrial Designs

There is automatic time-limited (15 years) protection (the right to prevent unauthorised copying) for unregistered designs, provided authorship can be proved, under the Copyright Designs and Patents Act 1988. This design right covers functional shape or configuration.

On registration under the Registered Designs Act 1949, the designer of the new pattern or shape which has aesthetic appeal (can be 2 or 3 dimensional) acquires a monopoly right of commercialisation for 25 years.

### Domain Names

Registering a domain name for Internet use gives a right to use the domain name typically for a period of two years. (Registered with bodies like ICANN and NOMINET). Owners of trade marks can have established rights to domain names.

### Trade Marks

Registering a trademark under the TradeMarks Act 1994 gives a monopoly right for the use of graphically distinct trading identification signs. Unregistered trademarks have some protection through court actions against "passing off" (piracy), provided that their use has not lapsed for a period of 5 years.

## **6. Some of the main problem areas for IP creators and owners:**

- incorporating background IP which belongs to someone else
- joint ownership (where there is more than one creator)
- proving the date of creation (e.g. where two inventors contest priority over the same invention/discovery)
- failing to define/prove what was created
- inadvertent disclosure

OXFORD BROOKES UNIVERSITY  
INTELLECTUAL PROPERTY POLICY AND REGULATIONS

## **GUIDANCE ON COPYRIGHT IN COURSE MATERIALS (INCLUDING E-LEARNING)**

This appendix provides guidance on establishing and protecting copyright in course materials including content in 'courseware' developed for distance learning and e-learning.

### **1 Background**

The distribution of content in any form involves questions of intellectual property. The interests of both the creators of content in course materials and the users of content need to be met. These guidelines focus largely on creators' needs, whether within or outside the university, and attempt to establish principles of good practice for all.

### **2 Courseware**

- 2.1 Courseware may be created or distributed as print on paper, but it is anticipated that it is more likely to be created and distributed in digital form, either on the Internet or (more probably) on the Extranet.
- 2.2 Oxford Brookes University is a service organisation that delivers education. The development of courseware is an essential adjunct to the service provided, but is not an end in itself.
- 2.3 In this context, it is essential that the University can develop and maintain courseware to the highest international standards. The University must be confident that it either controls or has authority to use all the intellectual property rights that are necessary for it to be able to achieve this aim.
- 2.4 At the same time, the University has no wish to curtail the academic freedom of its staff to publish within the framework of scholarly communication. These guidelines are intended to strike an appropriate balance between the needs and rights of the University and the needs and rights of the individual members of staff.
- 2.5 This draft policy document has been prepared in accordance with the University's Contract of Employment with members of its staff.

### **3 Challenges of convergence, interdependence and re-use**

- 3.1 Courseware has till now largely focused on conventional print on paper format and mainly on the use of text and graphics. Different IPR issues arise the further we move into a digital and online environment. These issues include performing rights, moral rights, and rights in applicable software. IPR issues affect text, graphics, still and moving images, music, sound recordings, multimedia, and other copyright forms.
- 3.2 Convergence between different media types – text, pictures, audio-visual, software – produces an environment in which rights management becomes potentially complex. This complexity increases as the content becomes more interdependent – and more difficult to deconstruct into its constituent parts.
- 3.3 Multiple formats and multiple delivery mechanisms mean that copyright may subsist in a wide variety of elements owned by many different individuals. Identification of rights ownership is a key part of the process of developing courseware.

- 3.4 Courseware may have a long lifetime, and be subject to constant revision. The need to re-use and re-edit courseware may outlast the tenure of any individual member of staff. The university must continue to have the necessary rights to re-use and to update the material.

#### **4 Content specifically commissioned to be included in courseware**

- 4.1 For content commissioned from members of academic staff in the normal course of their duties for inclusion in courseware, the University will depend on Clause 16.4 of the University's Contract of Employment and on Clause 11 of the Copyright Designs and Patents Act (CDPA) 1988 (works produced in the course of employment). All IPRs will belong to the University.
- 4.2 Although under Clause 79 (3) (a) of CDPA 1988 it is clear that the author's moral rights do not apply to works produced in the course of employment, nevertheless the University will so far as is practicable identify the original author(s) of all items of courseware.
- 4.3 For works commissioned from a member of staff which is to be produced outside the normal course of their duties, or from someone who is not a member a staff, the University will use a form of contract which makes it clear that all IPRs in the work belong to the University and that all moral rights are waived.
- 4.4 The University will in principle always be prepared on request to licence re-use of such content developed by an author in other contexts. The University reserves the right to refuse such a licence for the reuse of the same content in courseware developed for a subsequent employer (in competition with the University). This should not be seen as implying that the University is claiming any rights over the ideas contained in the courseware – simply over their precise mode of organisation and expression.

#### **5 Copyright – Extract from the academic contract of employment**

- 5.1 Subject to the following provisions, the University and you acknowledge sections 11 and 215 of the Copyright, Designs and Patents Act 1988.
- 5.2 All records, documents and other papers (including copies and summaries thereof) which pertain to the finance and administration of the University and which are made or acquired by you in the course of your employment shall be the property of the University. The copyright in all such original records, documents and papers shall at all times belong to the University.
- 5.3 The copyright in any work of design compiled, edited or otherwise brought into existence by you as a 'scholarly work' produced in furtherance of your professional career shall belong to you, 'scholarly work' includes items such as books, contributions to books, articles and conference papers, and shall be construed in the light of the common understanding of the phrase in higher education.
- 5.4 The copyright in any material produced by you for your personal use and reference, including as an aid to teaching shall belong to you.
- 5.5 However, the copyright in course materials produced by you in the course of your employment for the purposes of the curriculum of a course run by the University and produced, used or disseminated by the University shall belong to the University, as well as the outcomes from research specifically funded and supported by the University.

- 5.6 The above sub-clauses (3) - (5) shall apply except where agreement to the contrary is reached by you and the University. Where a case arises, or it is thought that a case may arise, where such agreement to the contrary may be necessary, or where it may be expedient to reach a specific agreement as to the application of the above sub-clauses to the particular facts of the case, the matter should be taken up between you and your Head of Department/School and the Director of Research and Business Development Office. By way of example, this sub-clause would apply where any question of assignment of copyright or of joint copyright may arise.

## **6 Rights owned by third parties**

- 6.1 The University respects the Intellectual Property Rights of third parties, and staff should at all times respect them.
- 6.2 If content for courseware is taken from any source where the ownership of the IPRs belongs to someone other than a member of the University's staff or the University itself, it should always be assumed that it is necessary to obtain a licence to use that content, whether or not payment is to be made.
- 6.3 The responsibility for ensuring that such licences are obtained lies with the member of staff who has been commissioned to develop the specific piece of courseware. If that member of staff has any doubts about whether a licence is required, they should consult the Legal Services Department.
- 6.4 Licences for use of third party material should be obtained on behalf of the University not on behalf of the individual member of staff, using a form of licence that can be provided by the Legal Services Department.
- 6.5 It is unlikely that third parties will grant rights to the University that are sufficiently broad to allow repeated or perpetual re-use of material. Applications should specify the use for which rights are being sought. Individuals should be careful to ensure that applications for re-use, when required, are made promptly and accurately.
- 6.6 Licences for use of third party material will normally require that licensees adhere to the rights owner's moral rights of paternity and integrity. This means the author must be fully credited, and that editorial or other changes must be approved by the third party.
- 6.7 Licences from third parties will often require payment for any substantial use of their copyright material, and they are free to ask for whatever they think their material is worth. The Research and Business Development Office should be consulted.
- 6.8 Staff should not expect the process of permission clearance to be instantaneous or even prompt: the process can take weeks rather than days.
- 6.9 The University's membership of HERON [Higher Education Resources Online] may provide help with permissions clearance in some cases. HERON is a copyright and digitisation service.

## **7 Policy and practice to protect Brookes material**

- 7.1 New material produced specifically for use in the university (whether courseware or in any other form) is itself subject to copyright protection, and members of staff must play their part in ensuring the university's IPR interests are protected as far as possible.
- 7.2 Contents or title pages, metadata or other descriptions of such material should carry a copyright line which reads "© (year, e.g. 2006) Oxford Brookes University". This material is protected by copyright and may not be copied, re-used, downloaded, or

otherwise appropriated, except in accordance with terms or exceptions of the 1988 Copyright, Designs and Patents Act, or with licences issued by the Copyright Licensing Agency, without the express permission of the University. Applications for permission should be made in the first instance to the Copyright Executive Officer, Oxford Brookes University”.

- 7.3 Securing and protecting the copyright of material generated in any form (whether conventional print, CD-ROM, or online) by the university will remain a long-term commitment on the part of all academic staff.
- 7.4 Misuse or apparent infringements of University copyright material by third parties should be notified immediately to the Research and Business Development Office (see paragraph 8 of the University IP Regulations).

Dear [ student's name ]

**Terms of participation - confidentiality and intellectual property**

I am pleased to welcome you as a Postgraduate student and am writing to formalise your participation in the University's research or project activities, as agreed with your supervisor [ supervisor's name ] from time to time. Your participation in any agreed project and your access to the University facilities required is conditional on certain terms which are set out in this letter; you are asked to sign the duplicate copy to indicate your acceptance of these terms and to return the duplicate to the Head of the Graduate Office without delay.

The terms of your participation and access are:

- 1 that you are bound by and observe the University's Intellectual Property Policy and Regulations and in particular:
  - a) that you keep secure and confidential all information and property relating to or acquired through the project and
  - b) that you identify to your supervisor any intellectual property that you introduce to the project and which is not owned by you

and

- 2 that you hereby assign unencumbered to the University by way of future assignment the intellectual property which you create during your participation, together with an unlimited licence for the University to use any background intellectual property which you own and which becomes incorporated in the intellectual property arising from the activity.

In consideration of your agreement to these terms and in addition to the benefits of participation and access, you will be able to apply for a share of any net commercialisation benefits which might accrue to the University from products of the project if these are commercialised; the revenue-sharing arrangements are set out as an appendix to the attached draft Intellectual Property Policy and Regulations.

Please sign where indicated below and return your signed copy to me.

Yours sincerely

Director Research and Business Development Office

***I have read and understood the University's Intellectual Property Policy and Regulations and agree to the terms set out in this letter:***

.....  
***Student's signature***

**Print full name:**.....

**Home address:**.....

**DATE:**.....

Dear [ student's name ]

**Terms of participation - confidentiality and intellectual property**

I am writing to formalise your participation as a postgraduate student in the University's research or project activities, as agreed with your supervisor [ supervisor's name ] from time to time. Your participation in any agreed project and your access to the University facilities required is conditional on certain terms which are set out in this letter; you are asked to sign the duplicate copy to indicate your acceptance of these terms and to return the duplicate to the Head of the Graduate Office without delay.

The terms of your participation and access are:

- a) that you are bound by and observe the University's Intellectual Property Policy and Regulations and in particular:
- b) that you keep secure and confidential all information and property relating to or acquired through the project
- c) that you identify to your supervisor any intellectual property that you introduce or have introduced to the project and which is not owned by you and
- d) that you hereby assign unencumbered to the University both existing and by way of future assignment future intellectual property which you have created or do create during your participation, together with an unlimited licence for the University to use any background intellectual property which you own and which has been or becomes incorporated in the intellectual property arising from the activity.

In consideration of your agreement to these terms and in addition to the benefits of participation and access, you will be able to apply for a share of any net commercialisation benefits which might accrue to the University from products of the project if these are commercialised; the revenue-sharing arrangements are set out as an appendix to the attached draft Intellectual Property Policy and Regulations.

Please sign the duplicate where indicated below and return your signed copy to me.

Yours sincerely

Director - Research and Business Development Office

***I have read and understood the University's Intellectual Property Policy and Regulations and agree to the terms set out in this letter:***

.....

***Student's signature***

**Print full name:**.....

**Home address:**.....

**DATE:**.....

**OXFORD BROOKES UNIVERSITY**  
**INTELLECTUAL PROPERTY POLICY AND REGULATIONS**  
**GUIDANCE ON RECORDING THE CREATION OF IP**

## **1. Background**

This note explains how to use and keep notebooks properly to record the creation of IP in order to facilitate proof of invention. This is particularly important for patents in the USA, but the same notebook records can be used for establishing creation dates for other forms of intellectual property.

For all forms of Intellectual Property (IP), the onus is on the creator to prove ownership and date of creativity or inventiveness. The onus is rarely on the infringer to prove innocence. This is particularly true for naturally occurring rights such as Copyright and (unregistered) design rights. However, even for rights that require registration such as patents, registered designs and registered trademarks the onus is still on the creator – just at an earlier stage.

It is generally considered good practice by researchers, developers and engineers to keep a notebook to log their activities, and many already do this – but they often do not do it in a way that will stand up in court.

Establishing good practice with respect to the recording of R&D will help to ensure that the intellectual property that is created is not inadvertently lost, and any potentially valuable intellectual property identified at an early stage.

## **2. How to keep the Notebook**

It should be possible to keep records in reasonably complete and clear form without becoming too time-consuming and burdensome.

The following is intended as a general guide on how to keep a notebook. From a legal standpoint, a laboratory notebook entry should be sufficiently competent to prove certain facts, such as the conception of an idea, the testing of a model, and the results of the test.

### **2.1 The Notebook itself**

- It is important to use a notebook that has a permanent binding. Loose-leaf, spiral-bound or other temporarily bound books allow for page removal, insertions and substitutions, and are therefore not suitable.
- The pages of the notebook should also be numbered. Such a system helps to reduce the possibility of any successful challenge to the validity of the notebook entry.
- Notebooks should never be mutilated, for example by tearing or cutting out pages.
- The permanence of the records is a prime consideration and it is therefore important that good quality paper should be used.

## **2.2 Ink quality**

- Use black permanent ink that is not water or solvent reactive, and does not smear. The ink should be light stable.

## **2.3 The Entries in the Notebook**

- As a general guideline, there should be enough information in the notebook to enable someone working in the field to duplicate the work.
- All data should be identified with respect to the project to which it relates, for example, by a project or experiment number or by a descriptive heading.
- Do not use slang, abbreviations and unduly technical jargon. The notebook must be understandable to others, not only patent attorneys, but judges and sometimes to jurors and potential licensees.
- Entries should be consecutively dated.
- Any subsequent data added to the notebook, for example results of analysis, should be entered on a separate page with reference to the original entry.
- Don't leave blank areas on a page. Draw lines through unused pages or parts of pages.
- The entries in the notebook should be legible and factually complete.
- It is important to describe experimental procedures in as full detail as possible. This should include all conditions of experiment and all apparatus, sketched if necessary. Full details of the apparatus used should also be given.
- If an invention is made, the dates of "conception" and "reduction to practice" are very important in the USA. The record must show that there has been no "abandonment" between these dates. Diligence in the reduction to practice of an invention means that, as far as possible, generally steady, uninterrupted and constant work occurred following the conception of an invention.
- Avoid making negative notes such as "No good", "Doesn't work " which might be later construed as indicating you were abandoning the idea.

## **2.4 Facts not opinions**

- Do not express opinions in notebooks. This could lead to misinterpretation.
- The notebook should be limited to factual, quantitative and qualitative results. Statements like "the idea is obvious", "I think it is unpatentable", "perhaps would infringe patent X" should be avoided.

## **2.5 Inserts and supporting information**

- If a record needs to be kept of computer-generated output - or other inserts such as graphs, drawings, photographs or other loose pages - each insert should be dated and attached in a permanent way (e.g. glued, stapled) onto successive numbered pages of the permanently bound notebook. The witness should write and sign across the join.

- If support records cannot be added to the notebook itself (e.g. large engineering drawings, computer source code, related reports, theses, etc), then reference to them should be made in the notebook in a consistent way and they should be stored in an orderly, readily retrievable manner.

## **2.6 Errors, Changes and Additions**

- Errors should not be erased or obliterated beyond recognition. Neither should liquid paper be used. Simply cross out an error so that it is apparent what the error was.
- Explain all errors and mistakes as they occur and initial them.
- Never remove pages from the notebook.
- Entries should never be changed or enlarged at a later date. It is better to make a new entry, pointing out the change.
- Pencil diagrams or sketches should never be retraced in ink.

## **2.7 Signing off**

- The US Patent Office has ruled that another witness who is independent must corroborate an inventor's testimony. For example, if the worker is a PhD student then the witness should not be his or her supervisor, since the supervisor is likely to become a co-inventor, and therefore not independent. A witness should sign the notebook on a regular basis.

## **2.8 Safe keeping**

- The notebook should be regarded as a confidential legal document and as such its use should be controlled. When completed, it should be stored in a safe place. It should not be treated as a freely available publication

CONFIDENTIAL

 <b>INVENTION DISCLOSURE FORM</b>	Date Received (RBDO Stamp)          Ref No:
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In order to protect the rights of all members of staff involved it is important for the University to fully determine the facts relating to the invention, design or production of copyrightable material (including software and semi-conductor topography). This Invention Disclosure Form is intended to record the invention and should be lodged with the University's Research and Business Development Office as soon as possible.

The information in this form may be used to assist the University's patent agents and is the basis of a statement of inventorship in respect of a patent (or other registration). Incorrect or incomplete information may therefore lead to the patent failing or being invalidated.

The information provided in this form will be treated as confidential and will be used for the sole purpose of assessing and seeking protection of the disclosed invention.

<b>A. TITLE OF THE PROJECT:</b>		
<b>For office use only:</b>		
Possible IPR	Patents <input type="checkbox"/> Trade Marks <input type="checkbox"/> Designs <input type="checkbox"/> Copyright <input type="checkbox"/> Know-how <input type="checkbox"/> Confidential Information <input type="checkbox"/>	Comments:

**B. CONTRIBUTOR**

1	Name	Post
School/Research Institute/Centre		
Home Address		
Post Code		Nationality

Contributors completing this form will not necessarily be named as inventors on any patent application(s) arising. A person is only a legally defined inventor if he or she conceives the idea underlying the invention.

**C. PROJECT DATES**

First recorded date of the invention	
Date your employment commenced with Oxford Brookes University	

#### D. OTHER STAFF and EXTERNAL CONTRIBUTORS

Please list all individuals whom you consider to have made an active contribution to the creation of the invention. (Each contributor will be asked to complete this form individually).

Names:		
1.		
2.		
Home addresses:	1.	2.
Telephone:		
Email:		
Nationality:		
School/External Organisation		

#### E. STUDENTS INVOLVED

Please list all students whom you consider to have made an active contribution to the creation of the invention.

Names:		
1.		
2.		
Home addresses:	1.	2.
Telephone:		
Email:		
Nationality:		
School:		

#### F. EXTERNAL RESOURCES

Please give a detailed account of:

- i) ALL external funding or equipment which has been used in connection with this or related work, including, grants, contracts, studentships and
- ii) ALL specific material or data (this covers both physical and electronic media) owned by a third party which has been used in the process of invention and without which the invention would not have been possible

Activity code (if available):

**G. CONFIDENTIALITY**

Please provide details of any Confidentiality/Non-disclosure or Material Transfer Agreements entered into with reference numbers / dates (please supply copies if available) :

**H. DESCRIPTION**

Brief description of Invention (circa 150 words):

**I. PRIOR ART**

Please give details of any earlier work of the same kind of which you know (Prior Art)  
(Please included details of and/or attach copies of relevant publications with publication dates)

**J. PUBLICATIONS / DISCLOSURE**

Please provide details of any publications relating to the invention that you have or intend to make, or any other forms of public or confidential disclosure (both written and verbal) with dates:

## K. THE INVENTIVE STEP

Please give details of the inventive step taken in the invention/technology.

**Attach 2-3 typed A4 pages giving a full technical description of the invention/design (to assist in the possible briefing of a patent agent) and include a sketch or sketches.**

Was the invention/design recorded in lab books?

Yes/No

## L. COMMERCIALISATION

In which markets do you think the invention/design will find most success?

List the three key commercial benefits of the invention/design:

1.

2.

3.

Any other relevant information e.g. potential route for commercialisation, companies that may be interested, alternative markets that the invention may be used in, etc.

## M. DECLARATION

The information which is provided on this form will be used by the University to assess the ownership of the intellectual property rights, potential third party claims to those rights, and obligations to external sponsors. Incorrect or incomplete details could lead to litigation, the reduction or loss of commercialisation revenues, or the invalidation of patent applications.

*I declare that the information which I have provided in this form is, to the best of my knowledge and belief, correct and complete and that the contributors named are all the original creators of this invention/design. I also agree to cooperate with Oxford Brookes University in seeking patent or other legal protection in the name of Oxford Brookes University and in the commercialisation of this invention/design. I also confirm that I have notified the University of any conflicts of interest which may exist in relation to the invention.*

Signed by \_\_\_\_\_ Dated \_\_\_\_\_

Signature of the Director of School/Research Institute/Centre \_\_\_\_\_

**Upon completion please forward this form to the Research and Business Development Office, Room BG03 Buckley Building, Gipsy Lane Campus, Headington. If you have any queries regarding the completion of this form please contact the Director of Research and Business Development on: 4441 (Fax: 3477).**

OXFORD BROOKES UNIVERSITY  
 INTELLECTUAL PROPERTY POLICY AND REGULATIONS  
**REVENUE-SHARE ARRANGEMENTS**

## 1 Net Benefits

1.1 Subject to any agreements with external collaborators net benefits are the remainder of all licence fees, royalties and any other monies received by the University from commercialisation of the Invention after deduction of the following:

- tax
- costs of travel outside the United Kingdom on business connected with the Invention
- costs of raw materials and production
- costs of development including the principal costs and any premiums on repayable awards such as Proof of Concept Funding
- the University's expenses of applying for and obtaining protection of the Invention
- costs associated with renewing and maintaining such protection
- costs of resisting any petitions or applications for revocation of such protection and bringing proceedings for infringement of such protection including fees paid and payable in respect of such matters and legal fees
- costs of external lawyers and other professional advisors used to set up agreements with external collaborators
- additional expenses incurred by the University in paying additional PAYE income such as employer's contribution to National Insurance or pension costs. Note that revenue sharing benefits are not normally pensionable.

1.2 The University reserves its right to negotiate terms in special circumstances: for example if IP is shared with third parties or where multiple elements of IP are combined for commercialisation.

## 2 Payments

2.1 The University shall pay to the Inventor(s) once a year a proportion of the Net Benefits on the following scale

Net Cumulative Benefit	Inventor's Share	University/ School Share
£1 to £75,000	66%	34%
Over £75,000	33%	67%

2.2 The University share is usually split 50:50 between the University and the School.

2.3 The Inventor's share of the Net Benefits is cumulative. For example, if the Net Benefit was £5,000 in year 1, 10,000 in year 2, 15,000 in year 3 and £50,000 in year 4, cumulative total £80,000, the Inventor's share would be as shown in the table below.

Net Benefit			Inventor's Share				
Year	Annual net benefit	Cumulative net benefit	Year 1	Year 2	Year 3	Year 4	Cumulative
1	£5,000	£5,000	£3,300				£3,300
2	£10,000	£15,000		£6,600			£9,900
3	£15,000	£30,000			£9,900		£19,800
4	£50,000	£80,000				£31,350 (£29,700 + £1,650)	£51,150

- 2.4 Where there is more than one Inventor, the Inventor's share is divided between the Inventors in a proportion which reflects their respective contributions as provided for under Regulation 7.2
- 2.5 For the purpose of identifying the cumulative income, income from one invention is counted together irrespective of whether the same IP is commercialised through one or multiple agreements.
- 2.6 The share of the Net Benefit to the Inventors gives Inventors more benefit early on in the lifetime of the invention and the single step in % share simplifies the administration of benefits.