

Approved by GA 22 September 2008.

# Inventions & Patent Policy

The purpose of this document is to set out for the faculty members, staff and students of the National University of Ireland, Maynooth ("NUI Maynooth") NUI Maynooth policy in relation to the protection and commercialisation of Inventions arising from research undertaken by them and to detail the benefits accruing to and duties owed by faculty members, staff and students under this policy. The NUI Maynooth Inventions and Patent Policy is subject to revision by the Governing Authority of NUI Maynooth.

## 1. Definitions:

a) *Inventions*: The term "Invention" means intellectual property of any kind whatsoever whether complete or incomplete arising in the course of academic research and/or other work at NUI Maynooth including but not limited to devices, products, processes, methods, technologies, discoveries or computer software.

b) *Patents*: The term "Patents" means rights in relation to intellectual property which are, or may in the future be, conferred by law including but not limited to patents, short term patents, registered or unregistered designs, copyright and trademarks.

c) *Inventor*: The term "Inventor" means the person or persons making a significant material innovative contribution to the generation of the Invention.

## 2 Objectives:

The objectives of NUI Maynooth Policy are:

- To provide genuine incentives to NUI Maynooth staff and students to identify and develop commercially viable Inventions arising out of their research and/or other work.
- To obtain Patent protection for such Inventions where this is considered appropriate.
- To facilitate technology transfer for such Inventions, and accord a fair share of the financial benefits of such commercialisation to the Inventor.
- To utilise NUI Maynooth's share of the financial and other returns from the commercialisation of Inventions to advance and encourage research and commercialisation in NUI Maynooth

## 3. Implementation of Inventions and Patents Policy:

NUI Maynooth resources will be available to:

- Evaluate the patentability and commercial viability of Inventions.
- Pay for and prosecute Patent applications where appropriate.
- Locate and negotiate with third parties to develop Inventions to a point where they are commercially viable and/or to take a licence of the Patent/Invention on favourable terms
- Liaise with the Inventor to ensure an equitable return to those involved in the research and/or other work which has been successfully commercialised.

## 4. Ownership of Inventions:

4.1 Staff: The ownership of any Invention arising out of the teaching, research, administrative or other duties of NUI Maynooth employees shall be vested in NUI Maynooth.

Students: It is a condition of the involvement of students in research or their use of NUI Maynooth facilities that they agree to assign their rights to certain Inventions in accordance with NUI Maynooth's standard agreement for research students.

4.2 Inventions or technologies resulting from research or other work sponsored by an external organisation shall be subject to such provisions regarding Intellectual Property Rights as are contained in the related contract between the external organisation and NUI Maynooth

## **5. Procedures**

5.1 Staff and students of NUI Maynooth shall report any and all Inventions developed by them to the Commercialisation Office by completing and submitting the Invention Disclosure Form. Upon receipt of an Invention Disclosure Form the Commercialisation Office will initiate procedures to evaluate the patentability and potential commercial viability of the Invention.

5.2 The Inventor shall have an active role in assisting the Commercialisation Office in its evaluation of the Invention and further development and commercialisation of the Invention shall be conducted by the Inventor in close consultation with the Commercialisation Office.

5.3 Staff members and students shall do everything that may reasonably be required of them to assist NUI Maynooth to protect, maintain and exploit the intellectual property referred to in paragraph 4.1 of this policy document, including executing all documents which may be necessary to prove, confirm or perfect the title of NUI Maynooth to any such intellectual property.

5.4 If the University determines that it has no interest in the Invention and does not wish to Patent or attempt to commercialise it, NUI Maynooth shall upon the Inventor's request, formally assign its rights in the Invention to the Inventor provided that such action is not precluded by third party rights or prior agreement with third parties.

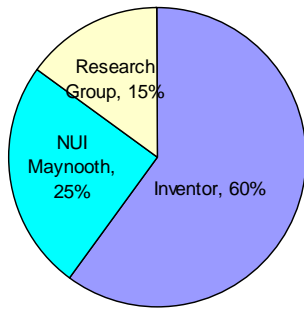
5.5 Any dispute between NUI Maynooth and the Inventor will be forwarded to a special three-person panel consisting of one person representing the Inventor, one person representing NUI Maynooth and a third member agreeable to both parties. The panel shall have full access to any records relating to the matters in dispute in the possession or power of the Inventor or NUI Maynooth

5.6 In all cases the integrity and confidentiality of the Inventions shall be of prime concern. NUI Maynooth and the Inventor shall ensure that such Inventions are not disclosed in such a way as to destroy their patentability, e.g. by premature public disclosure. Inventors shall seek the approval of the Commercialisation Office before making any such disclosure.

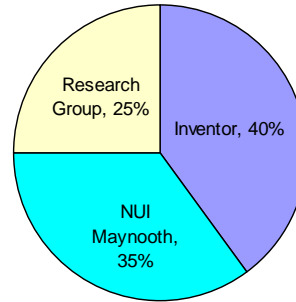
5.7 NUI Maynooth has an absolute discretion to withdraw from the process of evaluating, developing, patenting or commercialising an Invention if it sees fit. In the event of such a withdrawal, NUI Maynooth's rights to the Invention shall be assigned to the Inventor unless there are conflicting third party rights.

## **6. Income from Inventions**

6.1 All direct expenses incurred by NUI Maynooth in the patenting and commercialisation of an Invention (including legal and other expenses and costs involved in patenting an Invention and any subsequent investigation, development and promotion) will be deducted from the initial royalty income or lump sum. No royalty income will be available for distribution until such expenses have been recovered. Subject to the foregoing and 6.2 below, the following scale will apply in the sharing of royalty income available for distribution:



**All net royalty income below €100k**



**Subsequent net royalty income above €100k**

If more than one Inventor or research group is involved, the relevant royalty earnings will be divided in proportion to the material innovative contribution made by the staff members/groups concerned to the development of the Invention. Account shall also be taken of the effort and skill which each Inventor devoted to the project. Other factors taken into account will include:

- Level of responsibility of staff members concerned
- Input of other persons in producing the Invention

It is essential that good research records are prepared during the course of each project. Such records will be of prime importance in making an apportionment between the researchers concerned.

In the case of part-time staff the following factors will be used to determine the distribution of royalty income:

- Contractual time and responsibilities
- NUI Maynooth facilities and materials used
- Costs to NUI Maynooth of developing and marketing the Invention.

Students who are members of research teams involved in the development of Inventions will be subject to the policies covering other research staff and benefit from any Inventions in the same way.

If software is written for an external body which is not patented, or which reduces a patent to code, a default royalty of 10% of the license fee will generally be assumed if no royalty fee is specified in the license agreement and the Inventor will be awarded a share of this royalty according to the above pie chart distribution. This shall be in addition to any patent licence fees as per the above pie chart distribution.

6.2 If the Inventor and NUI Maynooth agree to commercialise the Invention via a Campus Company, then any royalty income from the Invention paid to NUI Maynooth by the Campus Company will go entirely to NUI Maynooth and will not be subject to the distribution in 6.1 above since the Inventor will be incentivised in this case by a founders equity shareholding in the Campus Company.

6.3 Other Financial Considerations: The division of royalty income will be carried out within six weeks of receipt of such income. NUI Maynooth will attempt to ensure that Inventors benefit from any income tax concessions which may be available from time to time.

6.4 Non-Financial Rewards: It is recognised that the development of NUI Maynooth intellectual property is dependent on the existence of satisfactory and equitable agreements on the division of income to provide meaningful rewards to NUI Maynooth Inventors. However, NUI Maynooth is also committed to the provision of non-financial rewards for such activities including academic recognition, improvements in the department's facilities and funds for research.

**7. Date of Initiation**

This policy shall be effective from 1<sup>st</sup> October 2008 and for all commercialization agreements completed after that date.

**8. Review of this policy**

This policy can be amended by a decision of the Governing Authority at any time. A formal review of the policy and any amendments made will be carried out within five years.