



Intellectual Property Policy

November 2016

St George's University of London

Intellectual Property Policy 2016

The revised Intellectual Property Policy (2016) replaces the previous policy dated 2009. The policy has been substantially updated and discussed extensively in SGUL including with the Research Strategy Committee and the Director of Academic Administration & Quality. The policy is simplified and in line with current legislation and best practice, including in relation to IP generated by students. It was approved by Council on 18 October 2016.

1. Introduction

This policy covers the management and exploitation of SGUL's Intellectual Property. It is a term of employment at SGUL that the Intellectual Property Rights ("IP") in projects which arise from or during employment are owned by SGUL subject to the right of the Creator to be recognised as the author of the IP and to publish in their own name. Employees have a continuing duty to inform the Joint Research and Enterprise Office (JREO) of developments which may have commercial potential at the earliest opportunity.

2. Types of IP and related terms

This policy applies to all IP created through employment at SGUL or by Students who may contribute to the creation of IP. Relevant terms and types of IP may include but are not limited to the following:

Intellectual Property (IP) means inventions, Copyright Material (as defined below), Patents and patent applications, design rights, trademarks, trade names, service marks, database rights, plant breeders' rights, topographies, utility models, know-how, confidential information, protected test data and other intellectual property rights, in each case whether registered or unregistered and including applications, the rights granted under licences and licence options and benefit-sharing rights to any of the foregoing and all rights or forms of protection in any jurisdiction.

Copyright Material means copyright IP in all literary, dramatic, musical and artistic works, sound recordings, films or broadcasts and typographic arrangements of published editions such as lecture notes, laboratory note books, research reports, research questionnaires, information on websites, digital teaching tools, including computer generated works and program source codes, smart phone apps, and similar material.

Patents and patent applications: Applications for a patent may be submitted for any new technical concepts or inventions which may qualify for protection if the invention is deemed to be novel, inventive and commercially applicable.

Database rights: these may protect against the extraction and re-utilisation of the content (applies in Europe only).

Trademarks: indicate the source of a product or services and gives the customer assurance of the originating quality and value.

Registered & unregistered design rights: the design of a product or object, including its appearance, form or decoration may be protected and may include either the whole or part of a product or object and may include packaging or parts assembled into a complex product or object.

Know how: this is specialist knowledge. Third parties may pay for access to know-how, as long as it has previously been kept confidential.

Materials: includes blood samples, vectors, bacterial strains, plant varieties, human or animal tissue, etc.

Further information about all types of IP and IP rights can be obtained from the JREO and from the UK Intellectual Property Office web-site: <http://ipo.gov.uk>

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3. Other Definitions

Assignment is an outright transfer of IP rights.

Associate(s) means individual(s) who are affiliated to SGUL but who are neither employees nor Students (for instance honorary staff and visiting academics).

Commercial Revenue means the revenue received from third-party licence fees, royalties, IP assignments, fees for services or any other payments received in respect of commercially exploited IP.

Costs means all of those costs incurred in the creation, development, protection and commercialisation of the IP, which may include payments to third parties and expenses, such as patent prosecution and protection fees, legal and commercial advice and proof-of-concept funding or any funding provided by SGUL in direct support of an invention with the express purpose of developing it for commercial exploitation.

Creator means any Member of SGUL (including Students) or Associate who creates, devises or invents an item of IP, not merely a person providing assistance in the realisation of an invention.

Cumulative SGUL Net Receipts refers to SGUL's Net Receipts received in respect of the specific piece of IP since its first commercialisation.

Faculty Staff means all Staff of the Faculty of Health, Social Care and Education, whether substantively employed by SGUL or by Kingston University and employed pursuant to the terms of the Joint Venture Agreement between SGUL and Kingston University.

JREO is the Joint Research and Enterprise Office, responsible for the commercialisation of IP within SGUL.

Licence is a formal agreement granting rights from one party (the Licensor and owner of the IP Rights) to another party (the Licensee), who thereby is able to exploit the IP through the Rights granted under the terms of the Licence.

Members of SGUL are defined in the SGUL Statutes and includes all academic Staff and Students.

Net Receipts are the Commercial Revenues received in respect of the IP minus the direct Costs incurred and minus any payments that SGUL is obliged to pay to any external organisation, other than as a share of the Commercial Revenues.

Normal duties refers to all lawful duties assigned to employees and any other duties arising out of their employment. For the avoidance of doubt employees who are employed to undertake research are expected to create inventive IP.

SGUL's Net Receipts is the Net Receipts held by SGUL which remain after any share is distributed to collaborators outside of SGUL and/or to funding bodies who may be entitled to a share of the Net Receipts.

Spin-out companies are new companies that are formed by individuals (who were and still may be employees of a parent organisation) together with the parent organisation, utilising core IP that originated at the parent organisation and that was then transferred to the new company.

Staff means all employees of SGUL, including all staff who are jointly employed with other employers including but not limited to NHS Trusts (except for clinical academics employed jointly with NHS Trust), Kingston University, INTO and the University of Nicosia.

Start-up companies are companies set up by individuals independently of a parent organisation.

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Student(s) are defined in the Statutes as any person currently registered to receive instruction or supervision in or by SGUL, on SGUL accredited courses in the Faculty of Health, Social Care and Education (operating jointly with Kingston University), INTO, the University of Nicosia, or any other similar arrangements and may apply to any registered student(s) of SGUL whether undergraduate, postgraduate (including whilst writing up a thesis or dissertation) or those on an exchange scheme.

4. Exceptions to this policy

- 4.1. Where IP is generated jointly with St George's University Hospitals NHS Foundation Trust, each Creator shall be obliged to adhere to the IP policy of his/her own substantive employer. In the case of a Creator employed by both SGUL and St George's University Hospitals NHS Foundation Trust ("SGFT"), it may be necessary for SGUL and SGFT in consultation with the Creator to identify what work was undertaken on behalf of which organisation and where practical to comply with the IP policy of each organisation in respect of the work done for each.
- 4.2. Where IP is generated within the Joint Faculty it will be subject to whichever Institution is identified as the managing Institution for the Creator's employment. The employment of almost all staff in the Joint Faculty is managed by Kingston University whose IP Policy applies as a term of their employment.
- 4.3. Where IP is generated jointly with NHS Trusts other than SGFT or universities other than Kingston University or through funders of the work leading to the creation of the IP, the arrangements for exploiting the IP will be negotiated by the Head of Enterprise or their nominee within the JREO on a case-by-case basis unless a specific agreement covering the commercialisation of jointly owned or developed IP is already in place.
- 4.4. Where work is funded by external funders, their executed terms and conditions relating to IP shall apply and, where none exist or are incomplete, then this IP Policy shall apply.

5. Ownership of IP

5.1. Staff

Section 39 of the Patents Act 1977 (as amended) and the Copyright, Designs and Patents Act 1988 (as amended), with any related IP subordinate legislation, make it clear that all forms of IP generated by an employee, made in the course of the employee's normal duties, belong to their employer. Hence, as prescribed by law, any IP created by Staff in the course of their Normal Duties shall be the property of SGUL, whether the IP is developed at SGUL or elsewhere.

Notwithstanding the above, to ensure that due-diligence is applied to IP created by Staff particularly if it is to be commercially exploited, the Creator will formally assign their IP rights to SGUL, including any ownership rights of others (which may include co-Creators and/or the funders of IP generated under research or other agreements), and provide any details of the IP and its creation that may be reasonably required by SGUL to assist in any future commercial exploitation. Where more than one Creator is involved, the Creators themselves shall determine and agree the appropriate share of the IP that they have jointly created. In the event of a dispute amongst multiple SGUL Creators as to the division of their percent share, the Dean of Research and Enterprise and/or the Director of the JREO will decide and their decision will be final and binding on the SGUL Creators. SGUL Creators may however file a grievance with HR. Where some Creators are external to SGUL, any dispute may be settled by arbitration at the sole cost of the Creators. The seat of arbitration will be London and the law of England & Wales will apply. The number of arbitrators will be one and if the parties are unable to agree on the arbitrator then the President for the time being of the Chartered Institute of Arbitrators will appoint an arbitrator on behalf of the parties. The rules of the Chartered Institute of Arbitrators will apply. If doubts are raised as to the authenticity of the ownership by

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a SGUL Member of the IP, the share of Commercial Net Receipts may be put on hold until the IP rights have been formally resolved. The Dean of Research and Enterprise and/or the Director of the JREO and/or the Principal will decide and their decision will be final and binding on the SGUL members without any rights of appeal. The SGUL members may, however, file a grievance with HR.

For the avoidance of doubt, where Staff are assigned by SGUL to carry out projects outside of their Normal Duties those Staff will also be required to assign their rights (including retrospectively if necessary) to any IP created in the course of such commissioned activities, to SGUL.

In the case of Creators working within a Clinical-Academic Group, each Creator will be required to adhere to the IP Policy of his/her substantive employer. For IP created under any of SGUL's international collaborations, the terms and conditions relating to IP contained in any collaboration agreements of such international collaborations will apply and, if none exist or are incomplete, then the terms and conditions of this IP Policy will apply.

5.2. Associates

Associates who are substantive employees of SGFT are required to comply with the provisions of the Memorandum of Understanding on Joint Research for IP arising from their SGUL activities insofar as it does not conflict with this policy. In the event of a conflict of terms this policy will prevail.

All other Associates shall be required to assign the rights to any IP they create in the course of their SGUL activities to SGUL. SGUL may have obligations to organisations which are funding the research in question which it will not be able to honour without such an assignment of rights being in place.

Associates are treated as if they were Staff for the purposes of revenue sharing. SGUL recognises that, in a limited number of cases (such as Visiting Academics who remain employees of another organisation whilst at SGUL), special arrangements may need to be negotiated regarding the ownership and use of IP which they may generate. Such arrangements will be negotiated on a case-by-case basis, generally by the Head of Enterprise or their nominee on behalf of SGUL and with a duly authorised representative of that individual's employer. Any individual who believes that he or she falls within such a category should contact the JREO for advice at the earliest opportunity.

5.3. Students

Where Students generate IP in the course of their study or research they will own that IP in their own right unless one of the following applies:

- (i) they generate IP which is subject to governing terms or an agreement with an external organisation whereby the IP vests with either SGUL or a third party; or
- (ii) they generate IP which builds upon existing IP generated by Staff or Associates; or
- (iii) they generate IP jointly with Staff or Associates or under their direct instruction; or
- (iv) they are, or have the status of, Staff (in which case they are treated by SGUL and the law as employees), provided that their inventive contribution was made during their time as a Staff member.

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In the above listed circumstances and upon agreement on consideration Students will be required to assign IP they have created to SGUL and to comply with this policy on the same basis as Staff. In the case where a Student may own a share of the IP beforehand and the further development of that IP is required to be assigned to SGUL, agreement will be made between the Student and the Head of Enterprise or their nominee on behalf of SGUL as to the per cent. Generally, ownership will be retained by the Student and SGUL separately.

Students who wish to benefit by using the expertise of, or funding (whether internal or external) administered by the JREO to protect and commercialise their IP, must agree in consideration for these services to assign such IP to SGUL and to comply with this policy on the same basis as Staff.

5.4. Copyright Material

SGUL owns copyright of all works created in any form by Staff in the course of their employment, or where such works have been specifically commissioned by SGUL Subject to the right of Staff to be recognised as its authors and to freely publish and be paid for contributions to learned books, journal articles, conferences, etc. This is standard across the entire higher education sector and is an important and highly cherished employment right of all academic Staff. . Such works owned by their Creator(s) shall include textbooks and academic articles and works of a similar nature and may include resulting IP from projects specifically entrusted to the author by the Institution and specified as such in writing. Exceptions will be that Staff may not take teaching materials, lecture notes, course summaries, examination and test questions with them to another appointment outside of SGUL.

Notwithstanding the above, where efforts are made by SGUL in relation to the commercialisation of such Copyright Material, especially, for example, exploitable software, smart-phone apps and health-related questionnaires, or where more than incidental use of SGUL's resources are used for the generation of the IP, it will be necessary for their Creator(s) to assign their IP rights to SGUL in consideration for this effort. For the avoidance of doubt, such Creator(s) may not benefit from the sharing of SGUL's Net Receipts if their IP was generated entirely in the normal course of their employment or if it was specifically commissioned by SGUL.

6. Responsibilities and procedures for protecting IP Rights

6.1. Identification

In order to make to the most of any IP, early identification and confidentiality is essential. SGUL expects the Creator to take all possible steps to protect the IP (e.g. maintaining good records of their work, maintaining the information in confidence) by bringing the IP to the attention of the JREO as early as possible and to co-operate with the JREO in formalising ownership, registering and commercialising the IP. In addition, where background IP exists or where the IP is a development of existing IP (including that of others), it is important for this to be disclosed to the JREO at the earliest opportunity. In disclosing the IP to the JREO, it is to be expected that a commercialisation plan will be discussed and agreed with the JREO. It is also required that the Creator takes all possible steps to ensure the ethical and fair use of any IP generated.

6.2. Disclosure

Inventions should be disclosed using the disclosure procedure required by the JREO as amended from time to time. The JREO shall conduct a review to determine the ownership of the IP and form a preliminary view of possible commercial potential.

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6.3. Record keeping

Members of SGUL who are carrying out research are advised to keep good records of their work in a bound notebook where pages are numbered and work is dated in accordance with Good Laboratory Practice (GLP). Writing should be in permanent ink and pages should be signed and countersigned. These records can be called upon to show the date of conception of the invention, which may be required to validate a patent or to confirm the rights and ownership in the IP for licensing.

6.4. Publication

SGUL encourages publication by Members of SGUL. However, Members of SGUL wishing to publish should first consider if any of the work may be patentable or otherwise protectable and if any other IP rights are impacted. Such Members of SGUL should contact the JREO to discuss this, as necessary. It is important to recognise that filing a patent application and publishing are not mutually exclusive. However, once a patent application has been filed it is usually safe to publish. Publishing prior to filing a patent application in most cases will render the patent application invalid. However, secrecy may be desirable for commercial reasons; therefore the timing of any publication related to IP must be agreed by the JREO prior to the submission.

6.5. Confidentiality

Any new IP, inventions and associated information should be kept confidential until after a full evaluation by the JREO for its exploitation potential and, if appropriate, protection. Standard form Confidentiality Agreements (CDAs) (available from the JREO) should be put in place as soon as possible after initial contact with third parties about any work where the commercial exploitation of IP may result. All CDAs (including those provided by other institutions and companies) must be agreed (and negotiated if necessary) by the JREO before being formally signed.

6.6. Material Transfer Agreements

Material Transfer Agreements (MTAs), (available from the JREO) should always be used when transferring material to third parties. All MTAs (including those provided by other institutions and companies) must be agreed (and negotiated if necessary) by the JREO before being formally signed. When receiving material from another institution or providing material, Members of SGUL should be aware of the implications of the clauses covering IP.

6.7. Consultancy Agreements

All consultancy agreements, whether private or institutional, should be reviewed by the JREO. In the case of consultancy conducted on behalf of SGUL, the JREO will negotiate the contract on behalf of the member of Staff. In the case of private consultancy arrangements, the JREO must agree the contract to ensure that there is no leakage of institutional IP or obligations on the institution.

6.8. R&D contracts

Research and development contracts usually contain a clause which covers IP ownership. All R&D contracts must be agreed by the JREO before being officially signed. Where possible, SGUL will retain the ownership of any foreground IP developed by SGUL Staff resulting from the contract and may agree commercial terms to a commercial partner for exploitation, consistent with the terms of the underlying contract. The negotiation of such commercial agreements are conducted by the JREO in co-operation with the Principal Investigator and the Creator of the IP.

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6.9. Patents and other forms of IP requiring registration

Following discussions with the JREO, the Creator must complete a technology disclosure form. The JREO will then review the information provided in discussion with the Creator to ensure that SGUL is the owner of the IP, that the invention is novel and that there is a suitable market for the invention. The JREO will then look at the avenues available for commercial exploitation. Following this review, the JREO will decide whether to:

- (i) protect the IP and exploit it, or
- (ii) where SGUL does not wish to take the invention forward the IP may be assigned to the Creator for the Creator to exploit at his/her own risk and cost and subject to certain terms and conditions to be agreed with the JREO.

Once the initial application has been filed, the appointed patent agent and the JREO will hold a copy in their files. The JREO will keep a record of the status of each Patent application and granted Patent. This will include (a) the title of the Patent; (b) the date of the priority filing, the dates of the International filing, the National Phase filings and the dates of any related divisional applications, examination deadlines, etc.; (c) the full names and contact details of all individuals with a financial interest in the Patent or having an inventive contribution; (d) the names of all organisations that have a financial interest in the Patent and documents which confer these rights; and (e) details of who the IP has been assigned or licensed to or who may have been granted option rights or other access to the IP.

6.10. Copyright

The Copyright legend (© St George's, University of London, date) should be used on the bottom of all copyright material owned by SGUL, including databases and web-sites.

6.11. Conflict of Interest

Creator(s) shall notify the JREO of any actual or potential Conflict of Interest relating to any IP either in their own circumstances or in connection with any other third party and to ensure compliance with SGUL's Conflict of Interest policy.

6.12. Agreements

Authority to enter into agreements, including the licensing of IP or other commitments with third parties, or accept obligations on behalf of SGUL is set out in the Financial Regulations and accompanying Schedules of Delegation as varied from time to time. Creators must not enter into agreements or licences which have not been approved in advance by the Head of Enterprise or their nominee. . For guidance, advice may be sought from the JREO.

6.13. Portfolio Management

Each item of IP will be reviewed by the JREO at regular intervals. If it is considered that the IP is unlikely to bring any significant return, then the protection may be allowed to lapse. Before the lapse occurs the Creator(s) will be informed in writing by the Head of Enterprise or their nominee. If the Creator(s) decide that they wish to support the ongoing protection of the IP at their own risk and expense, SGUL may formally assign its interest to the Creator(s) by prior written agreement of the Head of Enterprise or their nominee. The standard terms of such an assignment will be that once Commercial Revenues are received by the assignee, the assignee shall first pay back to SGUL SGUL's Costs (up to the value of the Commercial Revenues) and then 15% of any remaining or future Commercial Revenues.

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7. Arrangements for setting up Spin-out companies

- 7.1. Where it is agreed by the Creator and the Head of Enterprise or their nominee that forming a Spin-out company is the best method of exploiting SGUL's IP, then the IP will be licensed to the company, in return for an equity interest to SGUL and to the company's founders.
- 7.2. In all cases, the shareholdings for the Creators and SGUL will be negotiated according to the circumstances. For example, there may be direct investment by SGUL or funding support for the development of a prototype or there may be participation by collaborating universities or investment from third parties. The agreed future arrangements regarding the ownership of the company's shares will be formalised in the Shareholders' Agreement for the Spin-out company which shall be entered into by and between the Head of Enterprise or their nominee on behalf of SGUL and other parties as applicable including the Creator.
- 7.3. Both SGUL and the founder(s) will be represented on the company's board of directors (subject to the requirements of any third party investor or collaborator) for so long as they hold shares in the company.
- 7.4. The arrangements above will also apply to joint ventures where a number of parties other than SGUL and the founders may be involved.
- 7.5. SGUL's revenue-sharing arrangements shall not apply to Creators who hold shares in a Spin-out company into which their IP has been licensed or assigned.
- 7.6. The Spin-out company will pay a consultancy fee to SGUL for academics' time spent on company business. Consultancy time is limited to 30 days per annum unless otherwise agreed. If this limit is to be exceeded, SGUL's Director of Finance and the Institute Directors will be required to approve the excess time spent on consultancy and decide whether or not the arrangement is appropriate. These arrangements apply once the Spin-out company has been set up and has arranged seed funding. The time spent on setting up the company and getting investment will be considered part of SGUL's contribution to the Spin-out company. For the avoidance of doubt Creators will not receive any financial compensation from SGUL's shareholding in the spin-out company; their own remuneration will derive from their own shareholding or employment in the spin-out.
- 7.7. After a period of time agreed with SGUL, the Staff shareholder will have to decide whether to become an employee of the Spin-out company and no longer be employed by SGUL, or if they will remain as an employee of SGUL with minimal involvement in the spin-out company.
- 7.8. It is expected that where the Spin-out company requires contract research to be carried out on its behalf it shall use reasonable commercial endeavours to place such work with SGUL at standard commercial rates.

8. Rewards

Payments received for the successful commercialisation of IP through licensing or assignments are treated as gross revenue. They may take a number of forms, including one-off lump-sum payments, up-front payments, option fees, milestone payments, royalties or other forms. SGUL may on occasion receive shares or other assets instead of money. On the occasions where such gross revenues are received, SGUL will distribute any income/capital receipts in the proportions defined in the table in clause 8.3 below and may hold non-monetary receipts in its own name.

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8.1. Calculation of amounts available for distribution

The first claim on the gross Commercial Revenue received will be the Costs incurred. The amount distributable within SGUL will then be reduced by any share which is distributed to Creator(s) outside of SGUL and/or to funding bodies who may be entitled to a share of the Net Receipts. The remaining SGUL's Net Receipts will then be distributed in accordance with the scheme described in 8.3.

8.2. Spin-out Companies and licensees

For the avoidance of doubt, any Creator who joins a Spin-out company, either as a paid employee of the Spin-out company or as a shareholder, shall not be able to participate in the sharing of SGUL's Net Receipts for that IP. Where a Creator is an employee or shareholder of any company prior to which his/her IP has been licensed or assigned, that Creator shall not be able to participate in the sharing of SGUL's Net Receipts for that IP.

8.3. Sharing of revenue

SGUL's Net Receipts will be shared amongst the Creator(s) and SGUL which will apply its share of the Net Receipts towards the business of the Creator(s) Institute up to £200,000.00 as follows:

Cumulative SGUL Net Receipts	Creator(s)	SGUL
Up to £10,000	80%	20%
£10,001 - £50,000	60%	40%
£50,001 – £200,000	50%	50%
Over £200,000	33 ¹ / ₃ %	66 ² / ₃ %

SGUL will have complete discretion in respect of any sum over £200,000.00 and will not necessarily repatriate any funds to the Creator(s) Institute(s). Where more than one Creator is involved, the distribution of their share of the income amongst themselves shall be in accordance with their agreed share of the IP, as described in clause 5.1

Save as contemplated by paragraph 8.2. above, if a Creator leaves SGUL's employment there shall be no consequential change to the share which the Creator receives. When a Creator leaves SGUL's employment, he/she shall have an obligation to leave any physical embodiments of the IP, including data, notebooks, prototypes and equipment in the safe custody of SGUL and shall not make or retain any copies of such material whether physical or digital nor allow any other person to do so.

In the event of the Creator's death, entitlement to royalties shall transfer to the Creator's estate.

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Implementation

- This policy shall apply to all IP with effect from the date of its adoption at which date this policy shall replace the previous IP Policy dated 21st April 2009.

Dispute Resolution

- SGUL employees have the right to file a grievance with SGUL HR on any matter relating to their employment by SGUL, including in relation to the application of this policy.

Related Polices

- Partnership Agreement between St George's NHS Healthcare Trust and St George's Hospital Medical School on Intellectual Property generated jointly.
- IPR Agreement between St George's Hospital Medical School and Kingston University.
- St George's, University of London, Policies and Procedures, Conflicts of Interest and Business Dealings.
- St George's, University of London, Policies and Procedures, Private Earnings including Consultancy and Private Clinical Practice.
- St George's, University of London, Policies and Procedures, Public Interest Disclosure.
- St George's, University of London, Protocol for staff members establishing spin out companies or other organisations.