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General Guidelines on industrial property policy of Universidad San Pablo-CEU

Research Committee,
Universidad San Pablo-CEU.

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General Guidelines on industrial property policy of Universidad San Pablo-CEU.

I. REGULATIONS ON INDUSTRIAL PROPERTY OF THE UNIVERSITY.

It is set in Title III (articles 11 to 14) of the Regulations on the Research Projects approved by the Board of Trustees at its meeting on 21 May 2011:

III. INDUSTRIAL AND INTELLECTUAL PROPERTY

Article 11

1. The university shall be responsible for the ownership and management of the results of research and inventions made by teaching and research personnel, as well as by administrative and service personnel, grant holders and students, as the case may be, as a result of the performance of their duties at the university. The ownership of intellectual property rights, invention patents, utility models, designs, distinctive signs, plant varieties and titles on the protection of topographies of semiconductor products that may be obtained by semiconductor products which may be obtained shall be vested in the university.

2. However, the conditions laid down in respect of such ownership of inventions shall be taken into account in publicly funded projects.

3. In contracts with industry, the ownership of inventions shall be negotiated if such ownership has not been determined in advance in the contract.

Article 12

All potential invention carried out by the personnel associated to the university (Professors, researchers, administration and services personnel, grant holders and students), as a consequence of the development of the functions of it, it must be notified to the Vice-Rectorate for Research, which, if applicable, will carry out the appropriate procedures to patent the inventions or to obtain the corresponding industrial property rights or protection titles.

Article 13

1. In case the procedures of article 12 resulted in the provision of a patent or protection title, the university, as the holder, will be able to choose from:

a) Exploiting the patent directly, including this case, the signature of the agreements for the patent exploitation licence.

b) In those cases in which the direct exploitation is impossible or burdensome, transferring to third parties by agreement of the Governing Council.

2. In both cases, the authors of the patent or invention shall be entitled to receive 50 % of the net profits that the exploitation or transfer generates for the university, except in those cases in which the transfer to third parties are the authors themselves. The Governing council may establish higher percentages in favour to the authors in case of patents or inventions that generate significant income for the university.

Article 14



- 1. Intellectual property (copyrights) of research activities, advisory, consultancy, etc., carried out by the university Professors correspond to the author, except for those cases in which the carrying out of the computer programmes, in case of the exercise of the functions that have been entrusted to him/her or of following the University's instructions, in which case they correspond to the latter.*
- 2. In the case of the abovementioned computer programmes, the author of the programme will notify the Vice-Rectorate for Research, in which he/she will act in a similar manner to what has been established in article 12, with the aim to obtain the protection title that the current legal systems sets for this type of inventions.*
- 3. In case that the described procedures of the previous section resulted in the concession of the title susceptible to economic exploitation, the University as the holder of it, will be able to choose from:
 - a) Exploiting the title directly.*
 - b) In those cases in which the direct exploitation is impossible or burdensome, transferring to third parties by agreement of the Governing Council.**
- 4. In both cases, the authors of the computer programme shall be entitled to receive 50 % of the net profits that the exploitation or transfer generates for the University, except in those cases in which the transfer to third parties are the authors themselves. The Governing council may establish higher percentages in favour to the authors in case of patents or inventions that generate significant income for the University.*



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II. GENERAL GUIDELINES ON INDUSTRIAL PROPERTY POLICY OF UNIVERSIDAD SAN PABLO-CEU.

A. STATEMENT OF PURPOSES

Article 96 of Decree 31/2011, of 2 June, of the Governing Council, approving the Organisation and Functioning Rules of Universidad San Pablo-CEU (OFR) states that the development of the research quality and the social transfer of knowledge and technology are the key objectives of our university.

With the aim of pursuing these 2 objectives, the Research Committee of the University understand that it is necessary to facilitate the application of our industrial property regulations – the rules mentioned in articles 11 to 14 of the Research projects management regulation approved by the Board of Trustees of the University on 21 May 2011 -by the approval of some general guidelines on industrial property policy, which allow a better valorisation and protection of the knowledge generated by our teaching and research personnel, so that we move forward along the path that our university believes it is called upon to follow: to become a source and driving force for the economic development of society.

Furthermore, the University's Research Committee is aware that Spanish Universities are adopting regulations that take into account new legislation introduced by 14/2011 Act, of 1 June, on Science, Technology and Innovation¹ and 24/2015 Act, of 24 July, on Patents, aimed to improve competitiveness, so that it is considered that these rules must inspire our industrial policy criteria in relation to rights and duties of the research personnel and the University's ownership of inventions.

Meanwhile, the Vice-Rectorate for Teaching and Research, regarding to its general objective of promoting Professors research, considered the need for assessing the intangible value of research. And, in this context, the specific objective number 15 for the academic year 2018-2019 specifies the need to develop research rules and, precisely, that the rules for the industrial property management of the USP-CEU is based on the criteria established for this purpose by the Research Committee.

B. OWNERSHIP.

¹ BOE.es - [BOE-A-2011-9617 Ley 14/2011, de 1 de junio, de la Ciencia, la Tecnología y la Innovación.](http://BOE.es)



1. In general terms, the USP-CEU is responsible for the ownership and management of the inventions made by the university's research personnel, the result of their research activity at the university, both in those cases where such results may be susceptible to protection by means of a patent, utility model or any other recognised industrial property title, industrial secret and other knowledge that is not protected².
2. Also, in general terms, the USP-CEU is responsible for the ownership of the computer programmes made by the research personnel of the university in the exercise of their functions that have been entrusted or following the university's instructions.
3. Notwithstanding the above, when inventions and other results result from a USP-CEU project together with a public or private body, under a contract, the terms of the contract will regulate the ownership of these results. Additionally, inventions developed in the framework of financed projects by a, public or private external entities call, the terms of such call will be taken into account.
4. Any of the inventions owned by the USP-CEU may be used, for no profit and without the need for the consent of the authors of the invention, by the rest of the USP-CEU community for teaching and research objectives.
5. In case that a Technology Based Company (TBC), linked to the USP-CEU wanted to exploit an invention owned by the USP-CEU will be necessary the signature of the corresponding agreement, which will set out the terms and conditions of the transfer of the exploitation of the EBT's research results.

C. PERSONAL.

1. The industrial Property regulation is applied to those university's research activities, including the developed ones in the framework of research projects owned by it, in which the following participate:
 - a. Personnel with an employment relationship with the university in the exercise of their functions.

² According to what has been established in art. 21.1 of the new Act on Patents for Public Universities: '1. **The inventions carried out by the research personnel** of the Public Research centres and organisms of the Civil Administration, research centres and organisations of other public administrations, public universities, State's public sector's foundations and trading companies **will belong to the entities whose researchers have obtained in the performance of their duties, whatever may be the nature of the legal relationship by which they are bound to them.** For these purposes, it is considered to be research personnel, those included in article 13 of 14/2011 Act, of 1 June, on Science, Technology and Innovation, technical personnel considered in that Act as research personnel and technical support personnel who, in accordance with the internal regulations of universities and research centres, are also considered as research personnel'.



- b. Personnel with no employment relationship with the university who participate in research projects owned by it.
2. In all invention cases, including those that generate in the framework of the university's research projects or those projects in which the personnel with no employment relationship with the university, either students under the guidance of a university Professor, the university will gather the previous transfer by all inventors of the inventions or other research results rights.
3. These criteria of industrial property does never apply to Bachelor's/Master's/Doctorate degree's students if they are not related to research projects owned by the university in which they have participated under the guidance of university Professors. These students' inventions in the framework of their Bachelor's/Master's/Doctorate degrees' training activity, shall be subject of a specific university regulation.

D. RIGHTS OF INVENTORS: COPYRIGHTS AND RIGHTS TRANSFER IN FAVOUR OF THE UNIVERSITY BY EXTERNAL PERSONNEL.

The research personnel that has carried out the invention will have the right to:

- a. be mentioned as an inventor or author of the corresponding industrial or intellectual property right, if any.
- b. participate in those profits that the University³ obtained due to the exploitation of the invention, its licensing, or the assignment to third parties of its rights in accordance with the percentages established in this regulation.

E. INVENTORS' DUTIES: RESULTS COMMUNICATION.

The research personnel in charge of the research activity in the framework of which the invention is produced, is obliged to:

1. Communicate to the university, through the Vice-Rectorate for Teaching and Research, the obtention of the research results susceptible to protection, providing information enough for the correct identification and evaluation of them, together with the transfer or rights document, filled in and signed by all participants in the invention. For this communication, models and formats implemented by the university will be used.
2. Keep their content confidential, refraining from disclosure and publication in a manner that where appropriate, does not undermine the protection of such inventions.

³ *In accordance with what has been established in article 21.4 of the new Act on patents for public universities: '4. **In all cases, the researchers will have the right to participate in the profits obtained by the entities that offer their services in regard to the exploitation or transfer of their rights on such inventions**, where the patent is applied for in the name of the entity or the decision is taken to the industrial secret. These entities may transfer the ownership of such inventions to their author, keeping the right to a non-exclusive licence, untransferable and free for the exploitation or the participation in the profits obtained from the exploitation of those inventions agreed in sections 6 and 7'.*



F. DECISION ON THE PROTECTION OF THE RESEARCH RESULTS.

1. Once the potential invention has been notified by the person responsible for the research activity, the Vice-Rector's Office for Teaching Staff and Research, having heard the University's Research Committee and taking into account the advice it deems appropriate, shall be competent to decide on the appropriateness of protecting such inventions and, inter alia, to:
 - a. Decide on the protection of a certain research result (type of protection, geographical and time scope) and its extension if necessary. In the case of **patents**, the following policy, in general terms, will be followed:
 - i. Such a decision shall be taken on the basis of the prior State's technical report issued by the Spanish Patent and Trademark Office.
 - ii. On the basis of this report, a decision will be taken as to whether to use the national patent or Patent Cooperation Treaty (PCT) System.
 - iii. In the case of a national patent application: if there is no evidence of a company that may be interested in the patent within the 12 month-deadline since the application, the international route will not be applied for. And, if after 12 months from the grant of the national patent there is no company interested in exploiting it, the patent will be definitively abandoned, in accordance with the provisions set out below.
 - iv. In the case of an international patent application: if, in the 30 months between the application and the entry into the national phases in each of the designated countries, there is no interested company, the patent will be definitively abandoned, in accordance with the provisions set out below.
 - b. Ask for the corresponding property title and decide in which terms the application must be done.
 - c. Present to the Standing Committee of the Governing council of the University, the continuity or the non-continuity of the ownership of their rights in an invention and its assignment to the inventors or authors.
2. The Standing Committee of the Governing council of the university will decide on the basis of the proposal of the competent Vice-Chancellor:
 - a. The transfer of ownership of a specific invention to the inventors or authors, in those cases in which the University is not interested either in protecting a specific research result, or in continuing to hold the rights to a patent, or in extending the protection of a patent territorially. In all these cases, the University must expressly notify the inventors of its waiver and the inventors must expressly agree to accept the University's rights and obligations in relation to the invention. In these cases, the University shall maintain a non-exclusive, non-transferable and free licence of use, except in the event that the invention is assigned to third parties, in which case



the University shall be entitled to receive 20 % of the liquid profits derived from the exploitation or from the right granted.

- b. The licensing to third parties of the title granted in relation to a specific invention or the application for the same, as well as the transfer of the University's ownership of the said title.

E. PROTECTION COSTS AND PROFITS SHARING.

1. In those cases in which the competent Vice-Rector decides on the appropriateness of proceeding with the application for protection of a specific research result, the University shall bear all the costs of processing the applications submitted under the conditions set by the Vice-Rector: type of protection, geographical and time scope, etc.
2. In general, researchers who are the authors of inventions owned by the University shall be entitled to a 50 % share of the net profits generated by such inventions for the University.
3. In the event that the researchers do not agree with the type of protection or with the geographical and time scope thereof, they may propose a different type of protection to the University, assuming the cost⁴ either personally or at the expense of those externally funded research projects owned by the University for which they are responsible, and which can support the new approach. In such cases, the University's percentage of the potential net profits that may arise from the exploitation or licensing of the invention shall be as follows:
 - a. 50 % when the cost has been borne by research projects owned by the University.
 - b. And 20 % if the cost has been assumed personally by the inventors.

⁴ The possibility for researchers to continue with the patent, even in the event that the University decides not to continue with it, is allowed, as happens in other universities; for example, the UPM states that "*if after 2 years from the time of filing the application for registration of the intellectual property, an exploitation contract has not been signed with a third party, the UPM shall cease to bear the costs of protection and international extension and the authors or inventors shall bear the costs from that moment onwards*".