



Waterford Institute *of* Technology
INSTITIÚID TEICNEOLAÍOCHTA PHORT LÁIRGE

Intellectual Property Policy

Document Reference and Version No:	GB/OHRI/23022010 Version 1.0
Purpose:	The purpose of this Policy is to describe the Institute's approach to Intellectual Property generated in the context of research in and by the Institute: (a) in such a fashion as to be understandable to the Institute's staff, students and academic and industrial collaborators; (b) in such detail as to provide concrete guidelines in a practical framework; and (c) in sufficient clarity to delineate roles and responsibilities, rights and obligations and to avoid mis-understandings.
Commencement Date:	23 rd February 2010
Date of Next Review:	Document subject to annual review
Who Needs to Know About this Document:	General Public, HETAC, WIT - Governing Body, Academic Council, Executive Board, Heads of School, Heads of Dept., All Staff, Student Union, Students, Visiting staff and Students on Funded Research Programmes.
Revision History:	New Document
Policy Author(s):	Dr. Michael Whelan, Manager, Technology Transfer Office, Ms. Kathryn Kiely, Manager, Industry Services, Ms. Philomena Carton, Senior Administrator, Technology Transfer Office.
Policy Owner:	Office of Head of Research & Innovation

Table of Contents

1.	Summary.....	3
2.	Related Documentation.....	4
3.	Introduction	5
4.	Identification of Intellectual Property.....	7
	4.1 Publication.....	7
5.	Ownership of Intellectual Property.....	8
	5.1 Student Created Intellectual Property.....	9
6.	Protection & Development of Intellectual Property	10
	6.1 Commercial Evaluation Process.....	10
	6.2 Responsibilities of the Principal Investigator	11
	6.3 Protection & Defence.....	12
	6.4 Spin-out Companies.....	12
	6.5 Staff or Student Owned Intellectual Property.....	12
7.	Visitors and Consultants	14
	7.1 Visitors	14
	7.2 Consultants.....	14
8.	Administration.....	15
	8.1 Commercialisation Office.....	15
	8.2 Commercialisation Committee	15
9.	Incentive Program.....	17
	9.1 Equity Holdings in Private Companies	18
	9.2 Distribution of Benefits amongst Creators.....	19
10.	Conflict of Interest.....	20
11.	Dispute Resolution.....	21
12.	Definitions.....	22
Appendix A: Invention Disclosure Form		24
Appendix B: Internal IP Declaration and Assignment Form		27
Appendix C: Visiting Faculty Intellectual Property Worksheet		30
Appendix D: Consulting Intellectual Property Assignment.....		31

1. Summary

Waterford Institute of Technology has developed this Intellectual Property Policy (the “Policy”) in order to clarify the changing role of Intellectual Property (IP) in the activities of the Institute and to take account of recently issued policies and codes of practice related to Intellectual Property.

In preparing this Policy, Institute staff took account of the “National Strategy for Science, Technology and Innovation 2007-2013”, and the “National Codes of Practice for Managing Intellectual Property” as issued by the Irish Council for Science, Technology and Innovation, the “National Code of Practice for Managing Intellectual Property from Publicly Funded Research” from Forfás along with guidelines on Intellectual Property from various research funding agencies and similar policies from a large selection of Higher Education Institutions both in Ireland and internationally.

The goals of this Policy are to:

- Encourage staff and students of the Institute to consider the potential for Intellectual Property arising from their work;
- Promote an entrepreneurial culture within the Institute that fosters the development of potentially commercial Intellectual Property arising from research at the Institute;
- Clarify rights, obligations and procedures with regard to Intellectual Property;
- Describe the Institute’s incentive program related to Intellectual Property;
- Provide an efficient process by which the commercial potential of Intellectual Property can be assessed by the Institute and its advisors and to ensure that the process of Intellectual Property evaluation, protection and commercialisation are carried out in a timely manner;
- Outline the Institute offices and procedures concerned with Intellectual Property; and
- Encourage strategies of commercialisation and technology transfer that provide the greatest benefit to the Institute, the South East region and the Irish economy and to develop and continually improve a long-term strategy that enables the development of Intellectual Property, related commercialisation and technology transfer, together with maintenance of high standards of education.

While it is impossible in such a policy document to completely avoid definitions and formal language, efforts have been made to make the language used in the Policy clear and accessible. To the extent these efforts have been successful; credit is due to the large number of people across the Institute who provided valuable feedback and suggestions in the development of this policy document.

This Policy does not apply to Teaching and Related Materials (see Section 12 for the definition of Teaching and Related Materials).

2. Related Documentation

- Waterford Institute of Technology, Strategic Plan 2007 – 2010
(<http://www.wit.ie/AboutWIT/StrategicPlan/>)
- Anti-Plagiarism Policy, September 2008
(<http://www.wit.ie/exams/Anti-PlagiarismPolicy/>)
- Ethics Policy, 2007
(<http://www.wit.ie/Research/Support/Step-by-Step-Guide/Documents/4EthicalApproval/>)
- Authorship and Data Retention Policy, February 2009
(<http://www.wit.ie/Research/Support/Step-by-Step-Guide/Documents/8ProjectManagement/>)
- Records and the Retention Schedule, March 2007
(<http://www.wit.ie/InformationCompliance/RecordsManagement/>)
- Record Retention Policy, September 2007
(<http://www.wit.ie/InformationCompliance/RecordsManagement/>)

3. Introduction

Inherent in the operation of a higher level education and research institute is the creation of new knowledge or “Intellectual Property”. Waterford Institute of Technology (the “Institute”) is committed to the dissemination of such knowledge in a fashion that respects the traditions of academic freedom and promotes the Institute’s mission to advance the economic, social and cultural development of the South East region of Ireland and beyond.

Proper identification, protection and development, including commercial exploitation where appropriate, of Intellectual Property can play an important contributory role in promoting the Institute’s mission.

The purpose of this Policy is to describe the Institute’s approach to Intellectual Property in such a fashion as to be understandable to the Institute’s staff, students and academic and industrial collaborators, in such detail as to provide concrete guidelines in a practical framework, and in sufficient clarity to delineate roles and responsibilities, rights and obligations and to avoid misunderstandings. Section 12 contains a list of definitions of capitalised terms used in this Policy, while the Appendices contain samples of various forms referred to. Note – the forms in the Appendices are for illustrative purposes and guidance only and will not be appropriate to use in all circumstances, copies of all such forms may be obtained (in electronic or printed versions) by contacting the Commercialisation Office.

By clearly setting out the Institute’s processes for developing Intellectual Property, its incentive program to reward those responsible for generating commercially valuable Intellectual Property, and by putting support functions in place the Institute is emphasising its commitment to its role in the economic life of the community and encouraging its staff and students to be proactive in that role. In commercialising Intellectual Property, the Institute will endeavour to maintain unfettered rights to use such Intellectual Property in its research and teaching activities.

This Policy applies to all Institute staff, students engaged in Funded Research programs, along with visiting faculty or staff, and others participating in programs carried out using Institute resources. To the maximum extent possible, all consultants engaged by the Institute will be required to assign all rights in Intellectual Property that may be created during their engagement to the Institute. Section 7.2 discusses the implications on Intellectual Property with respect to the engagement of consultants and provides guidance on such engagements.

With respect to certain types of Intellectual Property, most obviously in relation to patents and copyright materials, certain groups of individuals have inherent legal recognition-in the case of patents these would be the inventors, while in the case of copyright materials these would be the authors. It is essential in the development of Intellectual Property that such groups be accurately identified since failure to do so can jeopardise the ability to secure and protect the Intellectual Property rights. However, the Institute recognises that in certain cases staff (or students) who might not meet the legal requirements to, for example, be ‘an inventor’ of a patent, nonetheless should be rewarded for development of such a patent; and similarly for other types of Intellectual Property. Section 9 addresses this issue in more detail.

Publication of research results plays a crucial role in academic institutions. The practice of attributing authorship in such publications, as addressed for example in the Institute’s policy on “Authorship and Data Retention” plays a significant role in the career of academic staff. It should be recognised that the legal requirements for Creatorship with respect to Intellectual Property do not necessarily align with academic practices for recognising authorship. As noted above, failure to properly identify the creators of Intellectual Property can jeopardise the ability

to acquire or maintain rights in Intellectual Property. In this Policy, the intent is to meet the legal requirements so the Intellectual Property can be developed to the benefit of all. Questions of creatorship are distinct from those of authorship (with respect to publication). The former are addressed by this Policy in accordance with the appropriate legal requirements while the latter are addressed in the Institute's policy on "Authorship and Data Retention".

4. Identification of Intellectual Property

In the case of certain forms of Intellectual Property, ownership and rights of protection can accrue without the need for any specific action to be taken. In other cases, ownership and the applicable protection only accrue after various applications are made and procedures followed. The former is the case with for example copyright in a literary work while the latter is true in the case of patents. Furthermore, in some cases, premature or inappropriate public disclosure can affect the protection available most notably, in the case of patentable inventions, possibly resulting in the loss of all protection.

In order to ensure that Intellectual Property is identified at a sufficiently early stage to avoid the unintentional loss of available protection, staff and students are requested to disclose to the Commercialisation Office (CO) anything they suspect may have an Intellectual Property component on a timely basis. The role and reporting structure of the CO is further described in Section 8. In cases where the CO believes Intellectual Property that is potentially patentable is identified, he/she will request the Creator(s) to file an invention disclosure (Appendix A contains the Invention Disclosure Form).

4.1 Publication

The Institute is committed to the open exchange of ideas and the publication, dissemination and communication of the results of research and scholarly activities. The Institute also recognises that to best serve its mission there are times when Intellectual Property should be protected before being published so that the Intellectual Property will be valued by commercial partners and hence can be developed to further the goals of the Institute and reward stakeholders.

Premature publication can result in the loss of Intellectual Property rights. In this case 'publication' refers broadly to any disclosure to members of the public. Even publications of limited scope (for example describing an overall approach) and scale (presentation to a small group) can have a significant impact and potentially reduce the ability of the Institute to adequately protect such Intellectual Property.

In the case of Funded Research programs, prior to any publication, guidance should be sought from the Principal Investigator (PI) concerning any requirements for the protection of Intellectual Property that should be complied with prior to publication. Examples of such requirements would be the need to obtain prior approval from collaborating institutions (academic or commercial) prior to submission for publication, or a requirement that documents be approved by the Institute's Commercialisation Office prior to submission for publication.

The CO is available to discuss staff concerns with respect to the potential impact of publication on Intellectual Property rights. In the case of Creator owned Intellectual Property, such discussions will be in confidence.

5. Ownership of Intellectual Property

In Section 12 definitions of several capitalised terms, for example Copyright Materials, categorise various types of material for which Intellectual Property protection may be available. The purpose of this categorisation is to facilitate the explanation of how any Intellectual Property rights the Institute may have in such materials will be handled. The purpose of this section is to describe those situations in which the Institute does have rights in specific Intellectual Property. Note that this Policy does not apply to Teaching & Related Materials.

Except in the situations described below, generally Creators own Intellectual Property which they create and are typically free to disseminate this Intellectual Property, publish or conduct performances based on it, or to pursue its commercialisation. Creators may if they wish pursue commercialisation through the Commercialisation Office based on a mutually agreed, written framework. In such a case the Institute would expect to share in any commercial benefits that might be generated from such commercialisation of the Intellectual Property in question.

In cases where Intellectual Property is created and one or more of the following conditions apply, Intellectual Property ownership is as follows:

- The Intellectual Property is developed under an agreement to generate the Intellectual Property between the Institute and the Creators. Intellectual Property is owned by the Institute unless specifically designated otherwise in the agreement.
- Intellectual Property resulting from the performance of a written contract, agreement or commission in which the Institute and the Creators have agreed to Intellectual Property ownership or in a Funded Research program. This may include, without limitation, products prepared for industry clients and continuous professional development courses or state sponsored programs. Ownership is with the Institute unless specified otherwise in the governing agreement.
- The Intellectual Property which results from the course of the Creator's normal employment, even if he/she is not specifically requested to create such Intellectual Property. Such Intellectual Property is owned by the Institute.
- The Intellectual Property was created making more than Incidental Use of Institute Resources. Such Intellectual Property is owned by the Institute.
- At the Institute's cost, Creators also agree at any later time to:
 - execute documents to assign or transfer Intellectual Property to properly ensure the Institute's rights, title and interest in the Intellectual Property;
 - perform actions as may reasonably be required to assist any assignee of any patent application or other Intellectual Property to obtain, protect and maintain its rights, title and interest; and
 - use all reasonable endeavours to do or procure to be done all such further acts as may be reasonably required from time to time for the purpose of giving the Institute the full benefit of the provisions of this Policy.

With respect to Literary Works created as part of a Creator's normal employment, the Institute shall maintain a non-exclusive, royalty free, irrevocable and perpetual license to use such materials in its teaching and research activities wherever conducted. The Creator(s) will be free to use such materials in other contexts and the Institute will not seek to benefit commercially from such use. In such situations, the Institute should be appropriately acknowledged, but no

other usage of the Institute's name or Marks may be made without written approval. In such situations, the Institute provides neither warranty, representation nor indemnity of any form regarding the content, suitability, use or otherwise of the Literary Works; it is solely the responsibility of the Creator(s) wishing to use the materials they have created in such other contexts to ensure that any such usage does not infringe the rights of third parties.

5.1 Student Created Intellectual Property

For the avoidance of doubt, Intellectual Property created by a student belongs to the student unless:

- it was created while the student was participating in a Funded Research program
- other than Incidental Use of the Institute's Resources were made in its creation.

In any of the abovementioned cases, the Intellectual Property is owned by the Institute or other party as may be required by the Funding Research program, grant or stipend. In case of student created Intellectual Property owned by the Institute, the student would participate in any commercial benefits as described in Section 9 in the same way as would a staff member.

6. Protection & Development of Intellectual Property

In protecting Intellectual Property the goals of the Institute are to maximise the impact development will have on the regional and national economy, to ensure commercial benefits are fairly distributed and to preserve the ongoing rights to use the Intellectual Property freely for teaching and research purposes.

Since the opportunity to acquire certain forms of Intellectual Property protection can be compromised by untimely publication, or dissemination of information concerning the Intellectual property, everyone covered by this policy is requested to consult in a timely fashion with the CO prior to any publication or dissemination of Intellectual Property. The CO shall provide advice and support in a timely fashion.

In consultation with the Creators and other experts as appropriate, the CO will develop a plan for the protection and exploitation of Intellectual Property. The CO, or others as may be designated by the CO, will then pursue this plan keeping the Creators informed as to progress. Creators will provide all reasonable and customary assistance, at the Institute's expense, in ensuring protection is acquired.

In the case of Intellectual Property in which the Institute is a joint or part owner, for example as could result from participation in a collaborative program with other institutions and/or private industry partners, commercialisation and protection of such jointly or partly owned Intellectual Property will be governed by the agreement covering the program under which the Intellectual Property was created.

6.1 Commercial Evaluation Process

Once identified, a process of evaluating the commercial potential of Intellectual property will be pursued. This is an on-going process, in terms of determining the extent and bounds of potential protection available, the costs of acquiring and maintaining such protection and the potential commercial value of the right to make use of the Intellectual Property.

Once it is clear that rights in the identified Intellectual Property are obtainable¹, the process of identifying potential channels for its exploitation will begin. This could involve identifying potential fields of application and potential licensees and/or the opportunity to create a spin-out venture based on the Intellectual property.

The Commercialisation Office, in communication with the Creator(s) will prioritise such opportunities as are identified and pursue them. Resulting license agreements or spin-out proposals (or any other form of commercialisation) will then be presented to the Commercialisation Committee (see Section 8.2) for consideration.

This process must properly address the rights that partners, be they industrial partners or academic organisations, may have in such Intellectual Property, and also any conditions relating to commercialisation contained in any grant or other such agreements pursuant to which Intellectual property was developed.

¹ This may vary by context. In the case of patents, it would likely be the receipt of the European Patent Office search and patentability opinion, or in other cases an effective reduction to practice – demonstrating both that the 'invention' is protectable and realisable.

6.2 Responsibilities of the Principal Investigator

This section describes various responsibilities of the Principal Investigator (PI) on a research project. These responsibilities typically fall to the PI because the PI is often a signatory to agreements undertaken pursuant to Funded Research programs and would also be the person most aware of the terms under which research is being undertaken as well as the people and organisations participating in that research.

The responsibilities of the PI under this Policy may be delegated, in whole or in part, by agreement in writing between the PI and the Head of Research and Innovation in which it is clearly indicated what responsibilities have been delegated to whom. In the absence of any such delegation these responsibilities remain with the PI.

It is the role of the Principal Investigator to inform all participants in a Funded Research program of cases where the terms of funding require any form of prior publication review, or other procedures intended to preserve the rights of partner organisations, to avoid the unintentional loss of Intellectual Property, and to use all reasonable efforts to ensure that appropriate procedures are followed.

While proper record keeping is an integral part of performing research, where Intellectual Property rights are concerned it becomes even more important, particularly in the areas of bio-science where research records may, provided they are properly created and maintained, be used in the regulatory approvals process.

Recognising that documentation standards vary across disciplines, a specific documentation standard is not prescribed. Prior to embarking on a research program, the PI should adopt a specific written documentation policy appropriate to that research program. In deciding on such a policy, the PI should consider the practical implications of complying with the policy over the lifetime of the research project. Once adopted, it is important that the policy be followed. The PI should adopt a policy that complies with the guidelines specified in the Institute's "Record Retention Policy" and "Records and Retention Schedule" and is appropriate to the type of research being undertaken and the context in which it is undertaken.

Grant agreements and research contracts often contain specific commitments with respect to Intellectual Property. The CO will participate in the negotiation of any such contracts or agreements to ensure that the Institute's interests are promoted. At the time of signing any grant agreement or contract, or shortly thereafter, the CO will meet with the PI to ensure that there is a clear understanding of the Intellectual Property protection requirements of the agreement or contract and the procedures followed to comply with them. The PI is thereafter responsible for informing everyone involved in the research project of any confidentiality or other Intellectual Property related obligations of the grant/contract ensuring that appropriate record keeping procedures are instituted and followed; any required Intellectual Property assignment documentation is executed by the relevant parties. The CO can assist the PI in these areas.

To ensure proper compliance with such agreements/contracts, signing an Intellectual Property Declaration & Assignment may be required of everyone intending to participate in certain projects. Appendix B contains an example of this form.

In the case of student participation, in the light of Section 4.1, care should be taken to ensure that such involvement is under terms that do not conflict with the governing contract, and that

all parties are clear on their rights and obligations (notably in respect of Intellectual Property and confidentiality matters). The CO can assist the PI in these areas.

6.3 Protection & Defence

For Intellectual Property owned by the Institute, the Institute shall determine the viability of commercialisation and shall decide whether and in what form to pursue protection or to maintain existing protection. The Institute shall bear the costs of such protection.

Should the Institute choose not to pursue Intellectual Property protection, the Creator(s) will be notified and the basis for the decision communicated. In such a case, upon the written request of the Creator(s), the Institute shall consider assigning all rights to the Creator(s) to allow the Creator(s) to pursue protection at their own expense.

In the case of challenges to the validity and/or enforceability of Intellectual Property, the Institute shall determine whether to defend the Intellectual Property or otherwise and bear such costs as may be incurred. Should the Institute choose not to contest or settle such a challenge, the Creator(s) will be notified and the basis for the decision communicated. In such a case, upon the written request of the Creator(s) the Institute shall consider assigning all rights of the Institute to the Creator(s) to allow the Creator(s) to pursue defence at their own expense, subject to the provision of any appropriate indemnities.

6.4 Spin-out Companies

The Institute encourages staff and students to consider, where appropriate, commercialising Intellectual Property they have created (whether the Institute has an ownership interest or not) through a start-up company. In cases where the Institute has an ownership stake in the IP, such a company would be considered a 'spin-out' company. The CO will assist interested parties in exploring such opportunities.

While each situation will be considered on its merits, and decided by the Commercialisation Committee, as a general guideline the Institute will consider a 15% equity stake to be appropriate in a spin out company in return for access to enabling Intellectual Property at a point where the company is capitalised sufficiently to pursue its business plan for 6 months, or to the amount of €150,000, whichever is greater.

The Institute recognises the invaluable role that the personal involvement of Institute staff in an early stage company can play. This would include such roles as serving as a director, a consultant, an advisor or part-time employee. The Institute recognises that it is appropriate for staff members in such roles to be compensated for their contributions. The Institute will, in a fashion consistent with its other policies, taking into account the specific roles involved within the Institute, endeavour to support staff members wishing to so engage. However, in order to avoid the potential for any conflict of interest, in the case of spin-out companies licensing Institute owned technology, staff receiving compensation, or the potential for compensation should declare their involvement to their direct supervisor and to the Chairperson of the Commercialisation Committee.

6.5 Staff or Student Owned Intellectual Property

In the case of staff or student owned Intellectual Property, if the owners wish, subject to a mutually acceptable written agreement, they may engage the CO to protect and commercialise

this Intellectual Property. The Institute would expect to participate in the commercial benefits, if any arise, in such a situation.

The CO is available to provide advice and answer questions that staff or students may have in relation to Intellectual Property. This resource is available, to a reasonable extent, even in the case of staff or student owned Intellectual Property. In such a case, the CO will maintain such discussions in confidence unless authorised by the Intellectual Property owners to do otherwise. Only if an agreement in writing is entered into by the Institute with the staff/student will the Institute acquire any rights in staff or student owned Intellectual Property, and only to the extent explicitly granted in that agreement.

7. Visitors and Consultants

7.1 Visitors

Visiting faculty and staff enrich the teaching, research and cultural environments of the Institute by providing the opportunity for Institute staff and students to collaborate and exchange views with talented individuals from diverse backgrounds.

While visiting faculty and staff may participate fully in Institute activities, it must be recognised that such visitors may not be employees of the Institute, or may simultaneously be under employment obligations to other institutions or companies (and such obligations are likely to also address issues of confidentiality and intellectual property generation, exploitation and ownership). Without proper agreements in place, participation of a visitor in research programs being conducted at the Institute could cloud and confuse the issue of Intellectual Property rights ownership arising from such programs. The Institute is bound contractually to ensure that it maintains such ownership rights as clearly as practically possible.

Prior to offering a visiting position, the Head of Research and Innovation should be consulted by the visitor's sponsor, to ensure that, if necessary, protections in relation to Intellectual Property rights are incorporated from the outset. An example worksheet for such purposes is attached in Appendix C. This worksheet, or a similar document, should be filled out as agreed with the Head of Research and Innovation. Once approved by the Head of Research and Innovation, the worksheet should be provided to the CO who will ensure that agreements as specified are drawn up and provided to the sponsor for execution by the visitor. The approved worksheet should be submitted to the CO even in cases where no Intellectual Property related agreements will be required of the visitor.

Offer letters should be contingent on acceptance by the visitor of any requirements as directed by the Head of Research and Innovation.

7.2 Consultants

Consultants engaged to perform a specific task may retain rights in Intellectual Property created as part of such engagement unless the engagement agreement or contract explicitly specifies otherwise. This can result in serious issues should consultants be used without a written agreement that properly identifies the expectations with respect to Intellectual Property in the specific engagement.

In all consulting engagements it is recommended that the consultants agree to be bound, for the purposes of the engagement (each engagement separately in cases where the same consultants are used for multiple engagements) by the Consulting IPR Agreement in Appendix D. In cases where this is not appropriate or agreeable, it may be possible to draft a specific agreement that meets all parties' needs. The Commercialisation Office will assist in drafting such agreements.

Consultants should not be engaged without either the general agreement as contained in the Appendix or a specific agreement as appropriate to the case in hand as developed in conjunction with the Commercialisation Office. Copies of all such agreements should be maintained permanently in compliance with the Institute's "Records Retention Schedule" by the Institute sponsor of the engagement.

8. Administration

The administration of this Policy is the responsibility of the Institute's Commercialisation Office, while the Commercialisation Committee is responsible for decisions related to the approval of licensing agreements, spin-outs and other agreements for the exploitation of Intellectual Property and on an ongoing basis for modifications (e.g. disposal of shareholdings) to such agreements or the exercise of rights associated with such agreements (e.g. voting shares, appointment of directors). The Commercialisation Committee may delegate responsibility for such activities from time to time as it sees fit.

8.1 Commercialisation Office

The Commercialisation Office (CO) is the office within the Institute charged with day to day matters relating to the identification of Intellectual Property, securing and maintaining Intellectual Property rights where appropriate and facilitating the exploitation of Intellectual Property in a fashion consistent with the Institute's values and mission.

In furtherance of this role, the CO shall:

- Provide training and support on Intellectual Property matters;
- Assist in formulating invention disclosures, and processing patent applications;
- Evaluate, in cooperation with other Institute staff and outside experts as appropriate:
 - The commercial potential of Intellectual Property;
 - The appropriate form(s) of Intellectual Property protection to be pursued;
- Develop and undertake an appropriate commercialisation strategy for Institute owned Intellectual Property;
- Assist in negotiating those portions of contracts and agreements between the Institute and outside parties concerned with the ownership, protection and exploitation of Intellectual Property;
- Deal with Intellectual Property issues that may arise in the administration of such agreements or contracts.

The Commercialisation Office reports to the Head of Research and Innovation.

8.2 Commercialisation Committee

The Commercialisation Committee will consist of the following:

- Financial Controller (Chair);
- Head of Research and Innovation;
- Industrial Liaison Manager; and
- Additional members as appointed from time to time by the Chairperson.

On a case by case basis, the Chairperson may invite other Institute staff or outside experts to participate in the activities of the Commercialisation Committee. In making such additional

appointments, the Chairperson shall consider the need to have expertise appropriate to the specific matters facing the Committee, the desire to have representation from across the Institute's community and the necessity for the Committee to operate as an executive decision making body. Recognising the fact that personal information may be involved in matters before the Committee, all members of the Committee shall be required to sign a confidentiality agreement with respect to all matters before the Committee. The makeup of this Committee may be changed from time to time at the discretion of the President of the Institute.

Members of the Commercialisation Committee who are, or could reasonably be perceived to be, in a conflict of interest situation with respect to any matter before the Committee shall excuse themselves from all involvement with the Committee on such matters. Any individual who is related to, reports to, or is a business partner of, someone who would be considered to have a conflict of interest with respect to a specific matter may themselves have a conflict of interest with respect to that matter and should also excuse themselves from all involvement with the Committee on such matters.

The Commercialisation Committee will review and approve all licenses, agreements or other contracts involved in the commercialisation of Intellectual Property, including those associated with spin-out companies, in which the Institute is involved.

The role of the CO is to prepare licensing proposals, identify the benefits and potential risks and to present these to the Commercialisation Committee. In the case of spin-out proposals, the CO will assist the sponsor(s) in preparing and presenting a proposal to the Commercialisation Committee. In cases where the sponsor(s) do(es) not include all the Creator(s), those Creators not sponsoring the submission will be notified and have the opportunity to meet with the Commercialisation Committee prior to any decision being made.

The Commercialisation Committee will be responsible for approving licensing or assignment of Intellectual Property in whatsoever form and for approving decisions related to the prosecution or defence of patents and other forms of Intellectual Property. Once approved by the Commercialisation Committee, licenses, contracts and other such documents as necessary which effect the exploitation will be signed by the Chairperson or other such party as may be nominated by the Chairperson, or as may be required to bring into full effect such licenses, contracts or other documents.

Licenses or assignments negotiated by the CO on behalf of the Institute will be presented to the Commercialisation Committee for approval. Creators of Intellectual Property that is the subject of such a license or assignment may if they so wish make a presentation to the Commercialisation Committee during the same meeting at which the CO presents the license of assignment for approval.

The processes and procedures adopted by the Commercialisation Committee shall take into account the Institute's obligations, and general guidance, as may from time to time be addressed in guidance from funding agencies and other relevant State bodies.

9. Incentive Program

The purpose of the Institute's "Commercialisation Reward & Incentive Program" is to fairly reward those responsible for the creation of commercially successful Intellectual Property and to incentivise staff and students to be entrepreneurial in this respect. In this section a brief outline of the program operation is presented. Further details in the program can be obtained from the CO.

Commercial benefits may be derived from the exploitation of Intellectual Property in a number of ways. These include, for example, revenues in the forms of royalties, up front, annual or minimum license fees, dividends related to equity ownership or revenue derived from the sale of equity interests. Commercial benefits are only those benefits that accrue directly as a consequence of agreements between the Institute and outside parties. For the avoidance of doubt, gifts which may be made to the Institute from time to time by outside parties, even when such parties may be signatories to agreements with the Institute, are not considered commercial benefits for the purposes of the Commercialisation Reward & Incentive Program unless they are required under the relevant agreements relating to the commercialisation of the Intellectual Property in question.

The goals of the incentive program are to:

- encourage the development and exploitation of Intellectual Property;
- reward those responsible for the creation of commercially valuable Intellectual Property;
- cover the costs incurred by the Institute in protection and commercialisation activities; and
- provide the Institute with a fair proportion of such commercial benefits.

In the tables below, three beneficiaries for disbursement of revenues from the commercial development of Institute owned Intellectual Property are identified. These include the Creator(s) and the Institute – as already defined. The third beneficiary is indicated as 'Organisation'. The Organisation may be for example the Research Laboratory, Group or other such centre, Department or School as appropriate for the specific Intellectual Property. Where necessary, the Head of Research and Innovation shall designate the appropriate Organisation in a specific case.

Any monies received by the Organisation as a result of this program will firstly be used to reward people other than the Creator(s) who, in its reasonable discretion, the Organisation believes contributed to the development of the Intellectual Property, and secondly to foster the goals of the Organisation.

In the case of Intellectual Property that is owned in its entirety by the Institute, commercial benefits will be disbursed as follows²:

1. The first €10,000 of commercial benefit will be distributed in its entirety to the Creator(s).
2. Thereafter, charges associated with the protection and administration of the Intellectual Property will be deducted. While such costs are deducted from the proceeds at this

² This outline and example take no consideration of taxes. Actual disbursements will be in accordance with applicable tax regulations and guidelines.

point, they do not count as distributions for the purposes of calculating cumulative thresholds.

3. Thereafter, a scale based on the cumulative amount of the commercial benefits, as shown overleaf will be used to distribute revenues between the Creator(s) and the Institute.

Cumulative €	Creators	Organisation	Institute
To €50,000	75%	10%	15%
€50,001 - €100,000	50%	20%	30%
€100,001 - €500,000	40%	25%	35%
€500,001 and above	30%	30%	40%

For example, in the case of the receipt by the institute of €600,000 in relation to a specific piece of Intellectual Property in which case €5,000 was incurred by the Institute in legal fees associated with finalising the license, the distribution would be as follows:

Thresholds	Creators	Organisation	Institute
Initial	€10,000		
Cost recovery			€5,000
Thence to €50,000	€30,000	€4,000	€6,000
Thence to €100,000	€25,000	€10,000	€15,000
Thence to €500,000	€160,000	€100,000	€140,000
Thence	€28,500	€28,500	€38,000
Totals	€253,500	€142,500	€204,000

Charges associated with protection and administration would include, but not be limited to, legal costs associated with the creation and execution of licensing agreements, filing fees (or duties) associated with the registration of license or supporting documents with government agencies, filing, processing and maintenance fees associated with patent rights. However, such charges will only be deducted to the extent they are out of pocket expenses for the Institute and apply specifically to the Intellectual Property in question.

In the case of Intellectual property in which the Institute is a part owner, the process is similar with the gross revenue referring to that revenue attributed to the Institute in accordance with its portion of ownership.

9.1 Equity Holdings in Private Companies

In cases where the Institute receives shares in a company in return for licensing or assigning Intellectual Property, at its sole discretion, the Institute may choose to distribute shares directly to those who would be entitled to participate in the benefits from commercialisation of the Intellectual Property involved. Such distribution to individuals being such that at most one third of the shares that are allocated to the Institute are distributed to the Creators in total. Any decision to distribute shares directly will take into account the number of people entitled to such participation and whether the direct distribution of shares would be likely to cause difficulties for the company including, for example, in obtaining future funding or being sold or acquired.

9.2 Distribution of Benefits amongst Creators

Prior to finalisation of the agreements commercialising Institute owned Intellectual property, reasonable efforts will be made by the CO and those involved in the Intellectual Property to develop an agreed list of Creators. Unless specifically indicated otherwise, and agreed by all Creators in writing, distributions will be made to all listed Creators equally.

10. Conflict of Interest

The Institute recognises that in the pursuit of commercially orientated research or the commercialisation of Intellectual Property, there will be situations in which Institute staff will find themselves in a position that may constitute a conflict of interest. There is nothing inappropriate in such a situation, conflict of interest occurs in all professional environments and are not uncommon with respect to IP commercialisation.

When conflict of interest situations (or their appearance) arise it is imperative that they be acknowledged and handled appropriately. Failure to do so can, in extreme situations, cause serious damage to individual and institutional reputations, incur the loss of support and potentially result in significant costs, legal and otherwise.

Members of the Commercialisation Committee shall be required to declare any interest or potential³ conflict of interest position relative to any matter to be presented to the Committee. If a member has any such interest, or potential conflict, they will absent themselves from any committee discussion pertaining to such matters. Senior Staff members of the Institute are also required to inform the Chairperson of the Commercialisation Committee of situations where they have an interest in, or potential conflict of interest related to any proposed commercialisation and to abide by the Chairperson's guidance with respect to their participation in such commercialisation endeavours. While specific mention is made here of potential conflict of interest issues related to the workings of the Commercialisation Committee, it is important to realise that in exercising their responsibilities under this Policy, all staff members of the Institute must exercise due caution to avoid even the appearance of acting while in a conflict of interest situation.

Should an Institute staff member or student feel they may have a conflict of interest, or be affected by one, the proper action to take is to disclose their concern, in writing if possible. Such disclosure should be made to any of the Heads of School of the Institute. The staff member or student is free to choose whichever Head of School they are wish, not being restricted to the School with which they may be associated. The Head of School will treat such matters in confidence and may, in order to properly address the concerns, draw on advice and expertise from both inside and outside the Institute, including the Chairperson of the Commercialisation Committee.

In many cases, simply disclosing the potential for conflict may be sufficient action. However, in certain cases, at the discretion of Chairperson of the Commercialisation Committee, and subject to consultation with senior Institute management, it may be deemed appropriate to modify responsibilities in order to mitigate any conflict. The reasons for, and extent of, any such guidance shall be documented in writing and provided to those involved.

In certain cases, staff of the Institute may be subject to the terms of the Ethics in Public Office Act of 1995 or the Standards in Public Office Act of 2001. Nothing in this Policy undoes or modifies in any way obligations that staff may have to comply with the provisions of the foregoing acts.

³ For example through having a business, familial, personal or managerial or employment relationship with anyone who does have an interest.

11. Dispute Resolution

Creators may appeal decisions made by the CO concerning Intellectual Property in which they have an interest to the Head of Research and Innovation. Such Creators may further appeal decisions of the Head of Research and Innovation to the President of the Institute. Similarly, decisions of the Commercialisation Committee may be appealed to the President of the Institute.

Any dispute or difference arising out of, or in connection with, the Institute President's decision shall then be referred to mediation by a professional mediator appointed by the Institute. If the mediation is abandoned by the mediator, or is otherwise concluded without the dispute or difference being resolved, then such dispute or difference shall be referred to and finally resolved by arbitration.

In the case of a dispute or difference failing to be resolved by mediation, an arbitrator agreed by both parties, or in default of agreement, appointed by the President for the time being of the Law Society of Ireland or in the event of his or her being unwilling or unable to do so by the next senior officer of the Society who is willing and able to make the appointment provided always that these provisions shall apply also to the appointment (whether by agreement or otherwise) of any replacement arbitrator where the original arbitrator (or any replacement) has been removed by Order of the High Court, or refuses to act, or is incapable of acting or dies.

12. Definitions

The following capitalised terms used in this Policy are defined as follows:

“Confidential Information” – means non public information or knowledge which is used in or otherwise relating to the business, financial or other affairs of the Institute and which may provide a competitive advantage in a commercial setting.

“Commercialisation Office (CO)” – means that office within the Institute charged with day-to-day matters related to Intellectual Property issues.

“Copyright Materials” – means any work for which copyright protection is or may be available. This includes, but is not limited to Literary Works, computer software and databases.

“Creator” – means someone who, alone or in cooperation with others, creates Intellectual Property. A Creator may be a staff member, whether permanent, temporary or visiting, or a student. In the case of patents, creators are those who meet the legal standard for inventorship, and in the case of copyright material are authors of the work in question.

“Funded Research” – means any program under which funding is received from any external source, including State agencies and agencies of the European Union, companies, charities or individuals or provided from the Institute’s own resources, pursuant to a research or development proposal. Funding provided directly to a student in the form of a scholarship shall not be considered Funded Research for the purposes of this Policy even though such scholarships may have Intellectual Property stipulations.

“Incidental Use” – means minor usage of normal office equipment, including on-line or electronic teaching support facilities, and resources that does not interfere with the normal performance of the duties of the staff member initiating the use, nor of any other staff member, nor the normal operations of the Institute.

“Institute Resources” – includes the physical or financial resources, services or personnel of the Institute or Intellectual Property in which the Institute has an interest.

“Intellectual Property (IP)” – means patents, patent applications, inventions, Know-how, trade secrets and other confidential information, rights in design (registered and unregistered), copyright (including, without limitation, rights in computer software), data, database rights and sui generis rights, rights affording equivalent protection to copyright, semiconductor topography rights, trade marks, service marks, logos, domain names, business names, trade names, brand names, certification marks, assumed names and other indicators or origin, rights in any drawings, designs, plans, specifications, manuals, computer software, assets, inventor’s certificates and invention disclosures, writings and other works, whether copyright or not, bills of material, moral rights and all other industrial or intellectual property or other rights or forms of protection of a similar nature or having similar effect in any part of the world and rights in and in relation to them and, where appropriate, applications for any of them in any country or jurisdiction, rights in the nature of unfair competition rights, rights to sue for passing-off, the right to apply for any of them and all other information necessary for the technical exploration of any of the same and all registration, and includes Inventions, Copyright Materials, Physical Materials, Marks and/or Confidential Information.

“Invention” – means any patentable or potentially patentable idea or discovery along with associated technology that is of benefit for development or application of the idea or discovery.

“Know-How” means unpatented, unpublished, technical information (including, without limitation, information relating to inventions, discoveries, concepts, methodologies, models, research, development and testing procedures, the results of experiments, tests and trials, manufacturing processes, materials, formulae, formulations, processes, research or experimental results, techniques and specifications, quality control data, analyses, reports and submissions) that is not in the public domain.

“Literary Works” – include but are not limited to books, articles, manuals, slides, audio-visual materials, multi-media materials, musical and artistic materials and on-line content, but excluding computer software or databases and Teaching and Related Materials.

“Marks” – means trademarks or service marks whether registered or otherwise.

“Physical Materials” – means materials used for commercial or research purposes including, without limitation, chemical compounds, compositions of matter, cell lines, organisms, proteins, etc.

“Principal Investigator (PI)” – means the person so designated upon any research contract or grant agreement and further details on the PI’s typical responsibilities are set out in Section 6.2. Where no such designation is made, the PI shall for the purposes of this Policy mean the Centre Manager for work being undertaken in a research centre, the designated project manager, or the staff member recognised as the leader of the research or development program.

“Senior Staff” – means anyone in a role in the Institute in which they have supervisory authority over other staff members, or who are authorised to approve agreements with third parties for the provision of goods or services to the Institute.

“Teaching and Related Materials” – means materials provided to, or made accessible to, students in association with their participation in educational programs provided by Waterford Institute of Technology in whatever form and materials developed or used by academic staff in the normal course of providing such instruction. For the avoidance of doubt, course syllabi, descriptions, schedules, accreditation related materials are not considered Teaching and Related Materials.

Appendix A: Invention Disclosure Form

Invention Disclosure Form

Invention Disclosure			
Title of the Invention:			
Invention Disclosure No:		Date received:	
Inventor's Full Name:		Employee Status - Permanent (Y/N)? :	
Inventor's Signature:		Date:	
Manager's Signature:		Date:	
When was the invention first conceived?		Date:	
When was first written description of invention done?		Date:	
Expected date for first disclosure without an NDA:		Date:	
Product(s) where it will or could be used? :			
Key words that can be used for searching:			
Brief description of the invention (attach labelled drawings, flowcharts or block diagrams): <i>Explain how the idea works describing the basic design concept and materials used.</i>			

What is the problem to be solved by this invention or what is the need for this invention? :

i.e. Describe the problem and/or explain the need clearly.

What are the closest known technologies, products or processes to the invention? :

i.e. Are there alternative ways of solving the problem?

What are the problems with closest known technologies, products or processes? :

i.e. Why don't they solve the problem, or what are their disadvantages? - e.g. cost, quality, cycle time, repeatability, manufacturability.

Explain how this invention overcomes these problems:

i.e. What are the advantages of this invention compared to known technologies, products or processes?

What are the possible applications for this invention?:

i.e. List applications, including opportunities for future products.

What is the perceived commercial value of the invention?:

i.e. cost savings per unit or increased revenue per annum.

Inventor's and Additional Inventors' Details			
Inventor's Name: Home Address:		Important: You must use your full first, middle and last name.	
Nationality:			
Company Employee Y/N? :		Work Location:	
Inventor's Signature:		Date:	
Inventor's Name: Home Address:		Important: You must use your full first, middle and last name.	
Nationality:			
Company Employee Y/N? :		Work Location:	
Inventor's Signature:		Date:	
Full Name: Home Address:		Important: You must use your full first, middle and last name.	
Nationality:			
Company Employee Y/N? :		Work Location:	
Inventor's Signature:		Date:	
Invention Witnesses			
Witness Name: Witness Signature:		Date:	
Witness Name: Witness Signature:		Date:	

On completion of the form, please return a signed copy to:

Technology Transfer Office
Office of Head of Research & Innovation
Email: pcarton@wit.ie
Tel: 051-845591

Appendix B: Internal IP Declaration and Assignment Form

Internal IP Declaration and Assignment Form

Rationale: In order for WIT to be in compliance with funding contracts from National/International funding agencies, the Institute is required to confirm the following:

1. There is no conflict of interest arising from PI, Research Staff or other involvement in project.
2. There are no prior /pending disclosures to industry, publishers or elsewhere which would jeopardise the exploitation of resulting Foreground IP.
3. WIT has full right to ownership of all Foreground IP and that no other person/organisation/company during the duration of the project has potential claim to ownership.

PROJECT TITLE:

FUNDING AGENCY & PROJECT CODE:

WIT PRINCIPAL INVESTIGATOR:

-
1. Do you, or any of the researchers involved in the project, have a conflict of interest due to your/their participation in the project?

2. (a) Is there an external academic institution or industry collaborators (i.e. non –contracted to WIT) involved in this project. If so, name relevant collaborator and associated organisation:

- (b) If so has an IP agreement been signed with the collaborator? (Provide details)

3. Are there any prior or pending communication with any company or person in relation to the project, including communications in relation to the possible exploitation of the potential Foreground IP and relevant Background IP?

4. Has any disclosure of relevant Background IP occurred? (e.g. External presentation/publication)

5. Is there any pending disclosure of Background IP?

6. Is the relevant Background IP linked in any way to research or services contracts, material transfer agreements or personal consultancies, whether past, present or currently under negotiation?

7. Has any commitment or arrangement of any kind been made to a third party that would provide that party with rights to relevant Background IP?

8. Has any commitment or arrangement of any kind, e.g. an option, been made to a third party that would provide that party with rights to Foreground IP?

Principal Investigator:

Name: _____

Signature: _____ Date _____

Other participants:

Name: _____

Signature: _____ Date _____

Name: _____

Signature: _____ Date _____

Name: _____

Signature: _____ Date _____

(Attach an additional signature sheet as necessary)

Assignment Statement

I acknowledge that with respect to intellectual property developed by me within the above named project, all title and rights rests in WIT, and I shall perform all normal and customary tasks, at WIT's expense, as may be requested by WIT to register, secure and maintain such title and rights.

On completion of this form, please return a signed copy to:

Technology Transfer Office
Office of Head of Research & Innovation
Email: pcarton@wit.ie
Tel: 051-845591

Appendix C: Visiting Faculty Intellectual Property Worksheet

Visitor's Name:

Visitor's Affiliation:

Period of Visit:

Description of the Visitor's Anticipated Activities:

What research or other funded programs may the Visitor participate in?

Is the Visitor subject to my pre-existing agreement or other obligations which may impact the ownership of Intellectual Property generated by the Visitor while in the Institute?

Will the Visitor be employing any pre-existing Intellectual Property while working in the Institute? What party owns the rights to such Intellectual Property?

Intellectual Property Protection Requirements (Check all required)

- None needed.
- Require Visitor to sign an Intellectual Property assignment stating they are free to enter such an agreement.
- Require Visitor's Employer agree to Intellectual Property assignment
- Other : (Specify below)

Signatures:

WIT Head of Research & Innovation

WIT Sponsor

Appendix D: Consulting Intellectual Property Assignment

Consulting Engagement – Intellectual Property Assignment

Waterford Institute of Technology, Cork Road, Waterford, Ireland (“WIT”)

AND

[Enter Consultant’s Name and Address here] (“CONSULTANT”)

(hereinafter referred to as the “Parties” or “Party” as the context may require)

Are preparing to enter a consulting engagement:

[Describe nature/scope of the engagement]

During this engagement, Intellectual Property may be generated.

WHEREAS

WIT, In order to gain the benefits of the engagement, requires that it have unfettered rights to make use of any such Intellectual Property on an ongoing basis.

NOW, THEREFORE, IT IS HEREBY AGREED AS FOLLOWS:

CONSULTANT hereby assigns copyright and all other Intellectual Property rights in all materials created in the course of the engagement to WIT.

Usage of any materials produced in the course of the engagement by the CONSULTANT shall require the written permission of WIT.

IN WITNESS WHEREOF the Parties have caused this Agreement to be executed on the date first written below.

Signed on behalf of WIT	Signed on behalf of
Signature	Signature
Name	Name
Title	Title
Date	Date