APPENDIX F: STUDENT INTELLECTUAL PROPERTY

Purpose and scope

1. This policy applies to all GSM London employees, academic and non-academic, including visiting and temporary/casual employees and research assistants.
2. It also applies to consultants and secondees from third-party organisations unless specified differently in the contract governing their appointment. A separate guide is available for students.

Definitions

3. Intellectual Property (IP) is a general term describing the outputs of creative endeavour in literary, artistic, industrial and scientific fields that can be protected under legislation. It also refers to know-how.

Background

4. This policy aims to help employees identify and make the best use of creations arising from their work at the College.
5. In brief, it is College policy to make all reasonable efforts to identify potential practical applications arising from work at the College and to be business-like in the process of protecting and exploiting (or not) IP.

Ownership

6. IP is in principle like any other form of property. It is a valuable asset that underpins the basis of innovation, so it should be protected. The College takes the protection of IP very seriously.
7. College policy is to claim ownership of all IP created during the normal course of employment or where College resources and facilities have been used in its creation.
8. IP may arise as a result of employees carrying out their day-to-day activities. For example IP rights may arise in:
   (a) work generated by computer hardware or software owned or operated by the College;
   (b) films, videos, performance works, multimedia works, notebooks and other presentations;
   (c) patentable and non-patentable inventions;
   (d) registered and unregistered designs;
   (e) books, articles or other material to be published in an individual capacity; and
   (f) know-how and information associated with the above.
9. The College is committed to the continued development of programme and course materials and modes of delivery that enable distributed and remote learning. Employees creating teaching materials, including e-learning materials, in the course of their College employment do not own the IP rights in what they create. However, they will be granted a non-exclusive, royalty-free licence to use them for non-commercial purposes.
10. Teaching materials, including e-learning materials, are normally protected through copyright. As stated in paragraph 7, the College as the employer holds the copyright in work produced by employees in the course of their employment.
11. The College does not lay claim to the copyright of teaching materials produced by employees in any previous employment. However, similarly, employees must have obtained the appropriate permissions from former employers to continue to use any

copyright material during their employment with the College. If such permissions have not been obtained, the material must not be used.

12. The College, in consultation with the relevant employee(s), may exploit teaching materials as it sees fit.
13. On leaving the College's employment, former employees are not entitled to use any materials in which the College owns the IP rights, unless they have first got the College's written permission. All enquiries about this should first go to the Central Finance Office (CFO).
14. Where work is supported by external bodies, the terms of the grant or contract will normally prescribe the terms of ownership and commercialisation of any IP arising from the work and the arrangements for commercialisation and revenue sharing. Employees are responsible for ensuring that the College's rights regarding IP are preserved. The College will ensure it provides support and advice on appropriate contractual arrangements. Enquiries about this should go to the CFO.

Identifying and evaluating IP

15. Premature disclosure of work can prevent IP protection. Members of staff should therefore be vigilant about preserving confidentiality.
16. To take appropriate action to protect IP, employees must promptly report any work – including work created by their students in the course of their College studies – with potential for commercialisation. These are the steps for protecting work and commercial potential:
    (a) The employee must promptly report to the CFO any work that could be exploited.
    (b) A Disclosure Form must be completed (copies are available from the Central Finance Team).
17. The College uses an assessment framework to examine commercial potential. If the initial assessment leads to a recommendation to protect and exploit the work, the College may arrange with a Patent Agent or other professional adviser as to the most appropriate method to specify and protect the IP.
18. Initial protection provides a period of time in which the statement of claim can be refined and commercialisation possibilities explored. Employees must co-operate as required to fully maximise the potential commercial revenue that can be got from any IP rights. Employees must not do anything to jeopardise this.
19. If the commercialisation potential arises from work supported by external bodies, the terms of the grant or contract will say what must be done. However, the grant or contract holder must still take the action described above so that the College can arrange for any formal negotiations needed.

Commercialisation of IP rights

20. IP can be commercialised in various ways. Here are some examples:
    (a) A licensing agreement involving the granting of rights from one party ('the licensor') to another ('the licensee'). A licensing agreement commonly controls the use (for copying, manufacture, sale etc.) of an IP right (e.g., a patent, design right, copyright material). This can be the most effective way of controlling IP and generating royalty income from its use by industry. Licensing agreements must be drafted carefully and must get the CFO's approval.
    (b) Setting up a new company to develop and exploit IP. This direct method of commercialisation requires more resources than licensing but can bring

substantial rewards. It is unlikely that the College will wish to set up a company to market a new product unless a well-researched business plan shows it is capable of making a reasonable profit annually within the medium term. Spin-out companies require the Board of Directors' approval.

(c) A collaboration agreement with an existing company that can take the idea or product to market. This is where employees work jointly with a company to pursue a commercial development objective that is mutually beneficial and jointly managed under a collaborative agreement. This kind of arrangement can provide the basis of an ongoing relationship between the College and a company. It may also be eligible for support from one of a number of funding schemes designed to aid collaboration between companies and Higher Education institutions (e.g., knowledge transfer partnerships). Collaboration agreements must be drafted carefully and must get the CFO's approval.

Revenue sharing

21. The College operates a revenue-sharing scheme to share any revenues arising from the successful commercialisation of IP.

22. The basis of exploiting any form of IP is that the College and the employee(s) involved will act in partnership and will jointly seek to pursue the IP's commercialisation potential.

23. Normally agreements about splitting the net income from commercialisation will be on the scale set out below (but this is only guidance and the College reserves the right to vary this if it regards it as appropriate):

Total net revenue ('TNR')	**Employee**	**Academic Department**	**College**
100%	1/3 of TNR	1/3 of TNR	1/3 of TNR

Worked example: If the total net revenue is £30, the employee(s) will be entitled to £10, the academic Department will be entitled to £10 and the College will be entitled to £10.

24. The IP the employee creates may be in conjunction with one or more students, employees or independent College contractors. If so, the employee must agree with the others what revenue share each will take. However, the total revenue share of all these parties may not exceed a third of the total net revenue.

25. The College may deduct from the gross revenue from commercialisation all expenses incurred by the College and any College subsidiary in connection with the registration, marketing and commercialisation of the relevant IP (including all fees of patent agents and lawyers and costs of regulatory approvals) or any taxes or charges that the College must deduct by law.

Breach of policy

26. Any misconduct or breach relating to this policy may lead to disciplinary action. The College also reserves the right to seek legal redress and compensation if failure to follow policy and procedures results in the loss of money or any other damage to the College.

IP rights and sources of information

What are intellectual property rights?

27. Intellectual property rights (IPRs) are the legal rights that may exist in certain types of creative work. Some of these rights exist automatically and others need to be registered to be effective. Several of these rights may exist simultaneously in one type of work.

28. There are several main categories of IPRs, as follows:

(a) Patents

Patents protect inventions. Inventions relate either to a product or a process to make a product. These products and processes should deal with new functional and technical aspects and so mainly relate to:

- how things work;
- what they are made of;
- how they are made;
- what they do; or
- how they do it.

An invention must be new and inventive to be protected by a patent. This means the invention must not have been made available to the public anywhere else in the world and must not be an obvious product or process to have been invented.

A patent gives an absolute monopoly right. Protection is only available if registration is obtained. It then lasts for 20 years starting from the date the patent application was filed.

As the invention must be new, it is essential that the details of the invention developed are kept secret until the application for the patent is made. Earlier disclosure of the invention will result in the patent being refused or becoming open to challenge if granted. Disclosure can mean making it available to the public in any form.

So, for instance, disclosure includes:

- publishing in a journal;
- giving a presentation to students; or
- even informing a colleague who is not a College employee.

Practical tips

- Keep all details of the invention secret.
- If you need to disclose details, you should do so only after obtaining permission from the CFO.
- Submit details of the invention to the CFO.
- Keep both originals and copies of all notes, reports, drawings, lab books, etc. in a secure place.
- Ensure all notes, reports, drawings, lab books, etc. are dated and sufficiently detailed to identify the invention and how it works.

(b) Copyright

Copyright protects a vast array of different work. Copyright only protects the form in which the ideas are expressed and not the idea or concept itself. However, ideas and concepts can often be protected as confidential information (see the Know-how section below).

Copyright can arise separately in each of the following:

- Books, articles, theses, presentations, lecture notes, course materials, test results, research notes, computer software and exam papers.
- Diagrams, drawings, blueprints, charts, artwork and photographs.
- Performance work, artistic work, videos and films.

Copyright also exists in music, broadcasts, sound recordings and typographical arrangements of published editions. Generally copyright does not protect against 3-D reproduction of items portrayed in industrial drawings or plans (e.g. models created from blueprints). They are instead protected by design right or as registered designs (see the section on designs below).

All the above types of work are protected by copyright as soon as they are created, e.g. written down, drawn, filmed. Registration is not required. All that is required is that the work be original, i.e. not copied from another source.

There are different periods of duration of copyright depending on the type of work. For instance, copyright in drawings (such as those of a surgical instrument) would last for the life of the 'author' (i.e. the person who made the drawings) plus another seventy (70) years.

As copyright is an unregistered right, it is harder to prove ownership of it than a registered right. So, here are some practical tips to protect the copyright.

Practical tips

- Keep all originals of the copyright works such as notes, drafts, sketches, drawings, videos etc. in a secure place.
- Record the date of creation of the copyright work – this is crucial.
- It also helps where practicable to clearly identify materials with a copyright notice on them such as: '© [year] [insert name of owner]. All rights reserved.'

(c) Moral rights

Personal rights (which attach to the author of a copyright work), called moral rights, exist alongside copyright work. They do not apply to work created as an employee or to computer software. These rights cannot be transferred but they can be waived. These are:

- Right of paternity – the right to be identified as the author or director of a work. This right must be asserted by the author for it to be effective.
- Right of integrity – the right not to suffer any derogatory treatment of a work (i.e. not to have it amended or changed by others).
- Right of false attribution – the right not to have a work falsely attributed to someone who did not create it.
- Right of privacy – in relation to photographs and films commissioned for private and domestic purposes, the right not to have the work issued to or shown in public.

(d) Database rights

Information presented in a database format can be protected separately by a database right. The database right protects the collection of independent works, data or other materials that are arranged systematically or methodically. A database can be accessible by electronic or other means. As well as the obvious types of database, it has been suggested it could cover such things as collections of biological materials.

It is similar to copyright, in that this right arises automatically on its creation. There is no requirement for registration. The database right lasts for 15 years from when it is made. Like copyright (because the database right is unregistered), creators need to take steps to safeguard the database.

Practical tips

- Keep records of all information, materials and data that are used to assemble the database to clearly show the date the database was created or updated.
- Keep all such materials and information in a secure place – please refer to the CFO for guidance.

NOTE: Be careful not to extract materials or information to create or populate your database from other database sources – this could infringe database rights in that other database.

(e) Designs

Designs of 3-D objects can be protected by unregistered design rights or by registered designs. These are explained more fully below.

UK design right

Any 3-D object can, in principle, be protected by design right. This right generally applies to industrial designs in place of copyright. The design must be original and it is automatic (like copyright) in that it is effective from the moment the design is created. It can exist in any aspect of the shape or the configuration of the object whether the design relates to an internal or external aspect in the whole or even part of the object. However, the design must not be a common design in the design field of that object at the time of its creation. For example, a design for a surgical instrument such as a scalpel would probably be commonplace in the surgical field.

There are exceptions to protection, though. Using a surgical instrument as an example, UK design right would not apply to:

- decoration on the surface of an object – e.g. any etchings or decoration on the surgical instrument would be excluded from protection;
- a method of constructing the object – e.g. if the way the instrument is made dictates its design, that would be excluded from protection; or
- any features of the object that enable it to fit with or match with another object to be able to perform its function – e.g. an interconnecting aspect of the surgical instrument that meant it could fit into another instrument would be excluded from protection.

UK design right protection lasts for 10 years from when the object was first marketed or 15 years from when it was created.

As it is an unregistered right, it is very important to safeguard the creation of the design.

Practical tips

- Keep all originals of the design drawings, sketches, samples, models and prototypes, etc.
- Keep all these materials in a secure place – please refer to the CFO for guidance.
- Record all dates of creation.

EU registered designs

Protection under this right does not start until registration is secured. Like patents and registered trade marks, registration gives an absolute monopoly protection.

A registered design protects more of the design of an object than UK design right. It covers the appearance of the whole or a part of an object resulting from its features, e.g. the lines, contours, colours, shape, texture or materials of the object or its ornamentation – such as packaging, get-up, symbols and even typographic type-faces. Using the example of a surgical instrument, e.g. any decoration, etching or engraving on the instrument and even the material of the instrument could be protected by registered design.

A registered design must:

- be new, in that it must not have been previously made available to the public through registration, publication, exhibition, trade use or any other disclosure; and
- have individual character that means if the object produces a notion of 'dejà vu' it cannot be protected because it will be regarded as too similar to another object.

There is a 12-month 'grace period' for disclosures by the designer to enable a designer to exhibit and market the object, and apply for design registration if the object is then worth protecting.

However, such disclosure should still be made subject to confidentiality obligations to safeguard against potential abuse of the design.

There are certain exceptions to protection that are similar to UK design rights, such as where the design is dictated solely by the object's function – for example, there would be no protection for the design of a surgical instrument if it had to be a certain shape for its use in surgery.

As secrecy is key to protecting registered designs as it is for patents, here are some practical tips to safeguard the design.

Practical tips

- Keep all details of the design secret.
- If you need to disclose details, you should only do so after obtaining the CFO's permission.
- Submit details of the design to the CFO.
- Keep all original drawings, sketches, prototypes, plans, etc. and keep them in a secure place – please refer to the CFO.

A registered design can last for up to twenty-five (25) years if renewal fees are paid every five (5) years.

<u>European design right</u>

This right is a hybrid between the design right in the UK and the EU registered design. However, it only applies to designs created after 6 March 2002. It is a European-wide right, so the design is protected throughout the EU.

Like registered design, it covers the appearance of the whole or a part of an object resulting from its features, i.e. the lines, contours, colours, shape, texture or materials of the object or its ornamentation.

This right is unregistered. It arises automatically from when the design is made available to the public. This means from when it is published, exhibited or used in trade. However, this right must satisfy the same criteria for protection as with registered designs. It must be:

- new (in the same way as with registered designs – see above); and
- have individual character (in the same way as with registered designs – see above).

Also, the same exclusions apply to this right as with registered designs. So, for example, if a surgical instrument satisfies the criteria for registered design protection, it would also be protected by EU design right as well.

As this right is unregistered, inventors need to consider the same factors for its protection as with design rights.

<u>Know-how</u>

Know-how is not IP as such, but can be just as valuable. Know-how is effectively technical information, i.e. a procedure, a process, a knowledgeable way of doing things. Therefore, research and development projects and course projects can create very valuable technical information. Potentially anything that is not public knowledge (including information scattered across several public sources but not drawn together) can be worthy of protection.

Protection only arises if before disclosing the confidential information, you inform its recipient that is it is secret and confidential. As the value is in the secrecy of the information, it is crucial to handle it properly.

The most practical way to secure protection is through a written contract that stipulates what the information is, that it is to be held in confidence, and how it is permitted to be used. This is commonly called a confidentiality agreement. Please refer to the Secretary to the Board of Directors.

A confidentiality agreement should be used whenever any disclosure is to be made. In this way, any information that relates to a potentially patentable invention or registrable design or even a brilliant idea or concept (which may not be protected by any IP) can be protected and its value can remain secure.

Trade marks

Trade marks can be registered or unregistered. The registered variety confers a monopoly right that is only effective once the trade mark is registered. Protection will then start from the date the application (for registration) was filed.

Registered trademarks protect, among other things, a word, logo, sign, shape, colour, sound or smell that is capable of being represented graphically on paper. A registered trade mark needs to be able to distinguish the goods or services of one person from those of another person.

A trade mark cannot be registered if there is already an existing identical or similar trade mark registered for identical or similar goods or services.

A registered trade mark can last indefinitely if renewal fees are paid. The initial period of protection is ten (10) years, with renewals every ten (10) years.

Useful sources of information

The initial point of contact in the College is the CFO.

Information can also be found at:

http://www.patent.gov.uk

http://gb.espacenet.com

http://www.intellectual-property.gov.uk

For information on sources of funding, look at:

http://www.bvca.co.uk	http://www.nesta.org.uk
http://www.evca.com/	http://www.nvca.com/
http://www.nbia.org/	http://wwwventuresite.co.uk