

## **Intellectual Property – NCIUL**

Within its Intellectual Property Policy and following the Intellectual Property Act, NCIUL defines Intellectual Property as patents, utility models, rights to inventions, copyright and related rights, trademarks and service marks, trade names and domain names, rights in get-up and trade dress, rights to goodwill or to sue for passing off or unfair competition, plant variety rights, rights in designs, rights in computer software, database rights, semiconductor topography rights, rights in confidential information (including know how and trade secrets) and any other intellectual property rights, in each case whether registered or unregistered and including all applications (or rights to apply) for, and renewals or extensions of, such rights and all similar or equivalent rights or forms of protection which subsist or will subsist now or in the future in any part of the world.

It may happen that a specific Intellectual Property (such as, for example, patents, trademarks or designs) is protected by registration. While not having yet registered such IP does not prevent its owner from asserting rights of ownership, failure to register it can however potentially impact the IP owner's ability to commercially exploit IP.

### **WHO OWNS IP?**

IP rights are owned by different individuals and/or organisations according to their status.

#### **Employed staff**

Under intellectual property laws (including the Registered Designs Act 1949, the Patents Act 1977, Copyright, Designs and Patents Act 1988, and Copyright and Rights in Databases Regulations 1997) Intellectual Property created by employees in the course of their employment is owned by their employer.

This means that IP created by NCIUL staff in the normal course of their duties is owned by NCIUL. The definition of NCIUL staff includes all those employed by NCIUL through a formal employment contract and includes academic, professional services and research staff.

#### **Employees working at other institutions**

NCIUL staff is encouraged to held honorary academic appointments at other institutions. In such circumstances, before NCIUL employee commences an honorary appointment, it is fundamental that an agreement is in place between NCIUL and the other institution in which should include terms establishing the ownership of any arising IP.

## **Employees working at partner NHS trusts**

NCIUL employees with clinical duties may also hold honorary contracts of employment with the relevant NHS partner trust. In such circumstances the ownership of IP will remain with NCIUL, unless specific arrangements with partner trusts for IP identification, ownership and exploitation have been agreed.

## **Individuals with honorary, visiting or emeritus status**

NCIUL awards honorary, visiting and emeritus status to some individuals. Such individuals are not formally employed by NCIUL and will normally, therefore, own any IP they create. They may, however, be required under certain circumstances to transfer to NCIUL any IP they create as if they were an NCIUL employee. This would include, for example, IP created jointly with a member of NCIUL staff in the course of his or her employment, created using NCIUL facilities or resources or created in the course of undertaking research or other activity for which NCIUL is formally responsible.

## **Third parties**

NCIUL frequently enters into agreements with third parties which specify ownership of IP generated by NCIUL staff and students in research collaborations. In such cases IP may be owned by NCIUL the third party or jointly depending on who creates the IP and what the terms of agreement are.

## **Taught Students**

Students registered on a taught degree programme at NCIUL will normally own any IP they create. Where students generate IP in the course of their academic studies they will normally own that IP in their own right. This includes all students registered on and undertaking a taught course at undergraduate or postgraduate level.

Exceptions to this may apply where, for example, the student:

- has specifically agreed otherwise in writing with to NCIUL;
- has a sponsored studentship under which the sponsor has a claim on the IP arising as part of the terms of the sponsorship;
- participates in a research programme or 'live' external company project where any arising IP is to be owned by the sponsor of the research or project.
- generates IP using NCIUL facilities and/or resources and is required to assign IP as a condition of use;
- generates IP jointly with an employed member of NCIUL working in the course of his or her normal employment.

For questions or clarification please email [student.office@nciul.co.uk](mailto:student.office@nciul.co.uk).

## **Research Based Degrees**

Students registered for research-based degrees (including PhD, ProfDoc and mPhil) may claim ownership of IP generated in the source of their studies only if they can clearly demonstrate that such IP has been created solely by themselves.

Typically, postgraduate students studying for research-based degrees use NCIUL facilities and work closely with NCIUL staff, including their Director of Studies, other supervisors, or other employees of NCIUL. IP from their projects will often, therefore, have been created jointly by the student and NCIUL employees.

NCIUL may therefore require that students undertaking research-based degrees assign any IP they create in the course of their studies to NCIUL.

Where the student's programme is funded by an external organisation the student may be required, if (but only if) there is a contractual arrangement with that organisation to this effect, to transfer ownership of IP to that organisation.