

Intellectual Property in Heriot Watt – A Guide to the Policy

What's this policy all about ?

Heriot-Watt University wishes to encourage, alongside academic growth through education, research, the publishing of work and collaboration with others, the commercial exploitation of intellectual property developed by members of the university community to the mutual benefit of the creators and the university.

By the university community we mean those staff, students, visiting fellows and consultants working with and within Heriot Watt.

What is commercialisation ?

Commercialisation is carried out by taking work, protecting it and trying to sell it, or let others use it, for some sort of fee.

What we want to do is enlarge the scope for commercialisation within Heriot-Watt. UK educational institutions have a reputation for generating great knowledge. However, unlike the US, they don't have a reputation for successful commercialisation.

What we want to ensure is that where the work that you do could have some commercial value over and above its worth as publishable research, this is properly addressed.

Historically within academic circles in the UK, the emphasis has been on receiving funding to research, then publishing the results of that research. We don't wish to stop that, in fact we actively encourage it. Through this, great advances in many fields have been achieved.

However, often new technologies and inventions are not fully developed because development needs investment, and investment needs commercial returns, and to ensure commercial returns you need something to sell, and a freely available idea cannot be sold. That is why, in some cases, it is better for your efforts not to be published immediately, but instead to be protected and then published, for protection gives you something to sell, something to sell can bring in investment, and investment allows further development. Therefore in the interests of advancing the knowledge within the field you work in, it is important that you consider the commercial potential of your work from the outset, and if necessary ensure it is properly protected before you publish.

Commercialisation means making the most of your work.

So please remember - the university's desire to commercialise isn't at odds with the desire of academics to publish, or with principles of developing knowledge - in fact both can go hand in hand. All it calls for is a slightly different approach to things. This approach is what this policy is all about.

How does Heriot-Watt approach commercialisation ?

The approach has three principles:

In order to facilitate commercialisation, the University seeks to own the work done by certain members of the university community.

In order to protect commercialisation, the University seeks to make certain information confidential.

In order to encourage commercialisation, the University seeks to apportion any benefits amongst those who created it, those that made it possible through the provision of facilities and funding and those who commercialised it.

Underlying this policy are basic principles of professionalism in creating, identifying and commercialising intellectual property, and one of the aims of this policy is to ensure a set of clear and

easy to follow rules which form the basis university's approach and a clear and easy to follow process implementing those rules in practice.

What is Intellectual Property ?

What sort of work does this policy cover ?

As mentioned, under this policy the university seeks to own the intellectual property created by its community.

Intellectual property is what you produce when you're at the university. It's the results of learning and research.

It's what you create when you look at a problem and solve it with some new method or invention, or when you write about or research something. It's things like know-how, expertise, techniques, research results, inventions, new methods, computer software and programs, algorithms, laboratory notebooks, books, articles, designs and distance learning material.

It's basically anything that's come from inside your head.

Intellectual property is exploited commercially through intellectual property rights. These include the right to make copies of a product, the right to reproduce printed work, the right to patent an invention, process or method, and the right to use that patented invention, process or method to achieve a result.

By allowing other people to exercise these rights, benefits can be obtained – this is commercialisation. For example, patenting a product or a method, then allowing other companies to use it for money, or writing a piece of work, and allowing people to copy it for a fee, like in the case of distance and e-learning course materials, or designing a new product then allowing other people to produce it from your designs.

Is there anything in particular this policy does not cover ?

The university doesn't seek to own all the intellectual property created by its community.

This policy does not cover published articles in specialist journals and papers and books – they remain the property of the writer.

Also things you do on your own outwith your time at the university are not covered, that is to say if you wrote a fictional book at home then that would not be covered.

Attention is drawn here, though, to the university policy on conflict of interest which may be of relevance to staff concerning work done outwith the university, and the parts of this policy concerning confidential information, which affects what information members of the university community are allowed to publish.

Who does this policy apply to ?

This policy applies to all members of staff, as it is part of their contract of employment, and all visiting fellows and consultants (but only when they agree in writing to observe the intellectual property and confidentiality rules of the university), and certain students.

By visiting fellows we mean really anyone who's visiting the university, be they undergraduate students, PhD students, academics, members of staff from another university or people from various industrial organisations and companies. It's not limited to any level of academic standing or ability in this document, even though it may mean something else elsewhere.

If I'm a student how do I know if it applies to me ?

The students who are covered by this are:

- (a) Research Postgraduate Students who do not pay their own fees.
- (b) Any student funded by a scholarship or doctoral training grant administered by The University.
- (c) Any student undertaking a final year or a vocational project.

What does this policy mean ?

Staff

If you're a member of staff then you're giving the university your intellectual property automatically by working here. This is one of the conditions of working here. This is laid down in statutory rules enacted by the government, and the only way to avoid this is to seek exemption granted by the university.

Work funded by someone outside the university - important notes for staff

Work funded by an outside body now forms an important part of the work done by staff at the university.

Outside bodies include organisations such as the ESPRC, BBRSC, Leverhulme Trust or industrial sponsors such as Shell or Quinetiq.

The rule on employer ownership will not apply if you give your intellectual property to the funding body as a condition of receiving funding.

By giving away the intellectual property in your work your right to profit from it, and the universities right, will be restricted.

Sometimes such agreements may even contain a clause giving away what is called your background intellectual property to the funder. This means the rights in all of the work you have done in the area, not just those in the work you're being funded for, may be given to your sponsor, restricting what you can do in this area outwith the funded project a great deal. A disregard for intellectual property issues at the outset of a project can have huge consequences.

For example, you are funded by a company to do some research, and you've signed a letter of award to get this funding which contains provisions on intellectual property ownership. You invent something fantastic but when the time comes to commercialise it, you find that certain parts are owned by the company, as it was carried out as a consequence of their funding, and certain parts are owned by the university, as you used research results from work you did before you were funded. Now both yourself, the company and the university want to make money, but they can't agree on what each of them is due. They fall out and no agreement is reached, and so the invention is never commercialised and developed, and all you have done goes to waste.

If you are submitting a research funding proposal please address who owns the intellectual property at the earliest opportunity, ideally in the proposal before it is passed to TRS.

If you have to sign a letter of award for funding, then please contact TRS if you know intellectual property ownership hasn't been addressed, or if it has and it looks like the funder will own it.

TRS can only help with intellectual property issues in research funding contracts if they are made aware of these issues before they are finalised.

All TRS will do is:

- (1) Clarify who owns the intellectual property produced.
- (2) If the intellectual property has not been dealt with, make sure that if possible it remains the property of the university.

(3) If it is not, then make sure the university can get as much benefit as possible in other ways through, for example, licensing and further research rights.

This is not a hugely time consuming matter, and will not slow down the processing of your funding, but if you're successful in your work it will be invaluable.

Visiting fellows and consultants – important notes for staff

Visiting fellows and consultants are not automatically subject to this policy.

Staff are reminded that because of this, that when they invite someone to the university for study or research purposes they must get them to assign their intellectual property rights to the university and to agree to preserve confidentiality, or the university will not fully own any intellectual property generated - it will be split between the visiting fellow or consultant and university.

Visiting fellows and consultants will not go unrewarded though, and if anything they help invent is successfully exploited then they will be treated as if a member of staff as regards reward.

If intellectual property is not assigned, this can create problems in who is allowed to exploit the work, and again work can go to waste due to a lack of clarity over who gets what.

Therefore, when you invite them, get them to agree and assign.

An agreement to assign and observe confidentiality can be put in place quickly and easily by TRS. If they can't assign, because, for example they've already given their rights to someone else or they wish to keep their intellectual property, then TRS can advise what is appropriate in the situation.

Students - important notes for staff

As staff members often take a supervisory role to students, it is their duty to make sure that ownership of the intellectual property in the work students carry out is addressed, especially when working on research projects for or collaborating with members of staff, or when funded by outside bodies.

This is normally done by the putting in place of a student assignment, as described in the next section.

Postgraduate Research Students who pay their own fees **Students undertaking a Final Year or Vocational Project**

If you're one of these students then we strongly recommend that you give your intellectual property to the university by signing a Student Assignment.

Student Assignations are available at matriculation and from TRS. Please sign two copies, keep one for yourself, and return the other to TRS.

Please note that you do have the right to keep your intellectual property yourself and not assign it to the university. However we recommend you do, as the university technology team can be invaluable in helping you exploit your work, and if you don't give us your intellectual property then they can't help. We're not asking for something for nothing though, as you will get a share of any income generated from it as if you were a member of staff.

If you've got **any** queries about this then please don't hesitate to get in touch with TRS.

Students funded by a Heriot Watt Doctoral Training Grant or Scholarship

It is a condition of Heriot Watt doctoral training grants and scholarships that your intellectual property is given to the university.

You will have been notified of this at matriculation, where you will have also been given an assignment - please sign this and return it to TRS.

If any of the work you do is commercialised, then you will be treated as if you were a member of staff as regards benefiting from it.

If you've got **any** queries about this then please don't hesitate to get in touch with TRS.

Research Postgraduate Students who don't pay their own fees

If you're a research postgraduate student then we strongly recommend that you give your intellectual property to the university by signing a Student Assignment.

Student Assignations are available at matriculation and from TRS. Please sign two copies, keep one for yourself, and return the other to TRS.

Please note that you do have the right to keep your intellectual property yourself and not assign it to the university. However we recommend you do, as the university technology team can be invaluable in helping you exploit your work, and if you don't give us your intellectual property then they can't help. We're not asking for something for nothing though, as you will get a share of any income generated from it as if you were a member of staff.

If you're a student funded by an outside organisation, such as a company, research council or such like, then it may be a condition of your funding that you assign your intellectual property to the university. For example if you're funded by the EPSRC it is a condition of your funding that you assign your IP to Heriot-Watt.

However, it may also be a condition of that funding that you assign it to someone else, especially in the case of industrially funded work, where in a lot of cases the funding company will look to own the intellectual property in the work it funds. For example, companies such as Quinetic or organisations such as DERA will generally look to own the IP in the work that you do here as a condition of the funding they provide.

If you're a student and you have to sign anything as a condition of receiving funding, then we recommend you still sign the Student Assignment but also seek the advice of TRS, by telephone, email or in person in order to clarify your situation.

If you've got **any** queries about this then please don't hesitate to get in touch with TRS.

Students, Staff, Visiting Fellows and Consultants - Confidential Information

Staff are automatically subject to the university's confidential information policy when they become employed.

However, students, visiting fellows and consultants are not, and if they are coming into contact with confidential information they must sign an agreement or they do not have to keep it confidential.

If a student, visiting fellow or consultant is signing an intellectual property assignment it will be covered in that.

If they are not, though, then they must be asked to sign a confidentiality information agreement separately to make sure the university's interests are safeguarded. These are available from TRS.

Staff are under an obligation to make sure the university's interests are safeguarded, and if they know of any situation where confidential information is being shown to any student, visiting fellow or consultant, or to any person or organisation outside the university they must make sure a confidentiality agreement is put in place.

What is confidential information ?

This is, in short, **anything which, if you told people about, might damage the commercial interests of the university**. It specifically includes information relating to intellectual property that could be protected, but isn't protected yet, and which if you told people about couldn't be protected, and any special know how or clever but non patentable methods of doing things, like trade secrets.

You must be very careful with this sort of information.

This is of particular relevance to something that may be patented, because if other people know about it then it can't be.

Confidential information is also any information that you come into contact with that you're told is confidential.

If you don't keep it confidential then you may destroy rights other people who don't work here hold. They will be entitled to do something about this, which will most likely be sue the university and sue you, so you may have to pay compensation.

However, it is possible to share such information if the need arises, but, as mentioned above, to respect the interests of everybody involved you must make sure this confidentiality is preserved by whoever you tell.

Basically, if you want to disclose any Confidential Information you must have a Confidential Information Agreement in place.

In particular, when publishing information, for example in a poster display in your School or within a thesis or journal article, you must though be careful about what you're publishing.

You must be careful not to jeopardize any of the rights the university holds or may hold, for example by writing an article on something that may be patented, or to disclose any information at a conference that's meant to be confidential, without first seeking permission from TRS.

So if you're dying to tell people about something new you've invented, hold back for a minute and think whether it would be more sensible to wait, and contact TRS to put in motion the process of protection.

What are the benefits to me of the university owning my work ?

You get to share in the rewards from the commercial exploitation of the work generated by the partnership of your knowledge and our facilities.

Since the facilities the university provides helps you to do things, and our commercialisation team help to make money from your work, we this its right we receive part of the income if anything makes money.

However the lions share will still go to you, because you provide the unique knowledge to make it all happen.

Firstly if monies come in, then taxes may have to be paid. We ask that these come off first, as that's what the law says.

Secondly, if you've done work under some sort of grant or joint venture, then either whoever gave the grant to you may want some or all of this repaid, or your partner may want some of the monies under the joint venture agreement. This has to be done, or you wouldn't have been able to do the work in the first place because the grant or joint venture is what made it all initially possible.

Thirdly, if the university has had to spend money to protect intellectual property, then we ask for this to be repaid out of any monies that come in. This can be things like patent registration fees. We think this

is fair as if it hadn't been spent, then there would've been nothing to sell, and nothing would've come in.

After all of these factors have been accounted for then what's left is split up.

You get half, the university gets a quarter and your department gets 15% (this is to help with the costs of running the facilities at the university, like buying equipment and maintaining buildings) and **TRS gets 10%** (this is to help fund our commercialisation team, our IP protection and legal team, our research grants assistance team and our patent protection budget).

Will the university always seek as much protection as it can ?

Unfortunately, obtaining protection for intellectual property can often be a long and expensive process, and without the help of the university in many cases this may be unaffordable. However, this requires the university to make a judgement on whether seeking protection is worthwhile in commercial terms. Often, if intellectual property is non-commercial, then it is very unlikely to be stolen, and therefore does not need as much protection as it could maybe be given. Also it would be stupid to spend more money on it that we could ever receive back.

What happens if the university doesn't want what's protected anymore ?

If the university wants to get rid of any intellectual property it holds, or not to pursue protection in any given case, it will give first refusal to pick up rights or to continue any process to the inventor. If we have already spent money on the invention then we may ask you to pick up some of the costs that were involved. We'll look at what's fair in each situation to decide what these costs are.

What happens if I leave the university to work or study elsewhere ?

1. Any intellectual property owned by the university will be kept by the university.
2. Any confidential information must be kept confidential even after you've left.
3. When you leave the university will carry out an Intellectual Property Audit. This is done to take stock of what you've done whilst at the university, basically to make sure its properly protected, because if it isn't then often its hard to do after you've left, because to protect things the university will need certain information from you, and if you're not there it can be hard to get.
4. Any monies that come in from the work you did whilst at the university will still be split up as if you're still with the university. Don't worry – by leaving, you're not leaving any reward due from any of your inventions.

Is there anything else I should be aware of ?

In the interests of clarity we ask anyone undertaking research within the University should record research results in a hardbound laboratory notebook in accordance with University policy. This helps establish inventive contribution to work don here, and may help ensure that if you help invent something you are appropriately rewarded.

So, in short, when must I deal with TRS ?

If you're one of the listed students - sign two copies of the student agreement, returning one to TRS and keeping the other for your records.

If you're a listed student and you want to keep your intellectual property – let TRS know.

If you're a student or member of staff and working with or funded by anyone from outside the university - let TRS know

If you're a student or member of staff and have signed or have been asked to sign any agreement relating to intellectual property or confidentiality from outside the university, including in particular award letters relating to funding.

If you're a student, member of staff, visiting fellow or consultant and you think you're creating something that could be commercially exploitable, and in particular patentable – let TRS know by completing an Innovation Disclosure Form – available from TRS or on the university website.

If you are a member of staff and a student you're working with is creating something you think could be commercially exploitable – let TRS know.

If you want to publish or give out any information on any work that could be patentable or any information that could be confidential – check with TRS first.