INTELLECTUAL PROPERTY
OPERATIONAL GUIDANCE
**INTRODUCTION**

Intellectual property ("IP") is a collective name for various types of property, recognised by law, that protect creations of the mind.

In a university context, those creations of the mind may include the following:

- literary works, including publications in respect of research results, and associated materials, including drafts, research data and laboratory notebooks;
- teaching and learning materials;
- other original literary, dramatic, musical or artistic works, sound recordings, films, broadcasts, and typographical arrangements, multimedia works, photographs, drawings, and other works created with the aid of university facilities;
- tables or compilations, computer software, preparatory design material for a computer program, firmware, courseware, and related material;
- works generated using computer hardware or software owned or operated by the City;
- patentable and non-patentable technical information;
- functional and aesthetic designs including semi-conductor chip topographies;
- plant varieties and related information;
- know-how and information associated with the above;
- data associated with the above; and
- any other university-commissioned works not included above.

These and other creations of the mind may be protected by one or more types of intellectual property. The main types of IP include patents, copyright, database rights, trade marks and designs (registered and unregistered). Each of the IP types has its own legal rules, mostly derived from legislation, which address issues such as subsistence, validity, infringement, and dealings (such as assignment and licensing). Like physical property, intellectual property is an asset which can have commercial value and can be traded; it can be bought, sold and licensed.

The extent of the protection given to an intellectual creation by IP laws will depend on the type of IP in question. For example, the protection given by a patent is very different to the protection given by copyright. In the absence of a recognised form of IP, or other legal remedy (e.g. under data protection or personal privacy laws, or moral rights) creations of the mind may not be protected from being used or copied by others. In other words, there is no general prohibition on using the intellectual creations of others. This position under IP laws should not be confused with the specific rules and practices of academia in relation to authorship, citation and plagiarism.

For some types of IP, no registration is necessary and the right comes into existence automatically (e.g. copyright, unregistered design right) once the relevant criteria are met. For others registration is required (e.g. registered design, registered trade mark, patent) in addition to satisfying the relevant criteria.

Some of the main objectives of these registerable IP rights are to stimulate innovation, by encouraging the publication of new ideas, by providing a means for the creators to benefit,
and by allowing others to build on new ideas by avoiding secrecy. Obviously, different objectives apply to confidential information, the value of which relies on it being kept secret.

If research results are protected by legal rights, then this can also help to justify commercial investment into further research, development and commercial use.

A patent cannot be granted if the invention has already been disclosed and so care must be taken to avoid premature disclosure before the patent application has been filed. Patents provide protection for technical inventions and there are strict procedures and rules which must be followed when applying for one.

Much of the intellectual property created at the university can be protected by copyright. No registration is required under UK copyright law in order for copyright protection to come into existence; although it is recommended that a copyright notice should be placed on the front page of all works where copyright belongs to the university, including computer software, as follows:

“© The City, University of London 20[xx]. All rights reserved.”

The Academic Enterprise Team is based in Research & Enterprise and is responsible for advising and assisting academics and researchers with commercialising their ideas and innovations. More information can be found in the Business Services webpage.
INTELLECTUAL PROPERTY RIGHTS

Disclaimer: The information contained in this guide is a lay summary of intellectual property rights in the UK and some associated legal issues. It is not intended to be comprehensive and readers are advised to seek independent professional advice before acting upon it. The University does not accept responsibility for the consequences of errors or omissions herein enclosed.

For further information, please contact the Academic Enterprise Team for advice in the first instance.

Intellectual Property Rights (IPR)

- Intellectual property rights (IPR) are legal rights which protect inventions, designs, and other creative works. They allow the owner of the right to prevent others using the intellectual property without their permission. There are different rights for different types of creation. Some rights come into existence without registration (e.g. copyright), whereas others need to be registered (e.g. patents).

- It is important to remember that some intellectual property rights are governed by national laws, and may differ between regions, although some international agreements exist. Other intellectual property rights are international in character, e.g. the EU-wide trade mark and the EU-wide registered and unregistered design rights¹. The examples given below are applicable in the UK, but for protection in other territories it is important to seek professional help to determine the most appropriate form of protection.

- A brief description of the main types of intellectual property rights are given below. This list is not exhaustive; for example, it does not mention rights for semiconductor topologies or plant varieties. There are also different rights in other countries – for example “utility models” or “petty patents”.

- The table below summarises the main types of intellectual property, the rights which can be used to protect them, how to acquire the rights, and some other things to be aware of.

Patents

- A patent can protect technical inventions. A patent must be applied for, it does not come into existence automatically, and there are strict rules and deadlines which must be adhered to.

- A patent gives the patent owner the right for a limited period to stop others from making, using or selling the same invention without the permission of the patent owner. It can be viewed as a deal between the patent owner and the state in which the patent owner is allowed a short-term monopoly in return for allowing the invention to be made public, in order to stimulate innovation and benefit society.

- A patent may be invalidated by public disclosure of the invention before a patent application is filed, so the maxim “think patent before you publish” is worth remembering. In practice, a patent application can be filed in a few weeks and therefore should not prejudice an academic’s ability to publish.

¹ At the time of writing, the future of these rights in the UK is currently in a state of uncertainty given the Brexit negotiations. Another EU-wide right is also contemplated, namely the unified patent, but the UK’s participation in this system is also currently subject to the Brexit negotiations.
• Do not attempt to file a patent yourself; the legal rules governing patents are long and complex and so using a qualified patent agent is essential to obtaining valid and useful protection.

Copyright
• Copyright may protect original literary, dramatic, artistic and musical works, audio and video recordings, broadcasts and cable transmissions, the layout of published editions, and original software code (although the underlying methods used by the software may also be patented if they lead to a ‘technical effect’) and databases.

• Copyright comes into existence automatically on the physical creation (not the idea) of the work (provided the relevant criteria are satisfied) and there are no registration costs involved. Copyright can last up to 70 years after the death of the author, depending on the type of work in question.

• Use of the © symbol, the copyright owner's name and the date the work was created is the internationally recognised way of alerting the public to the copyright ownership, but the protection (including the right to preventing unauthorised copying) exists regardless of whether this symbol is used as long as the criteria are satisfied.

Moral rights
• Moral rights are only available for literary, dramatic, musical and artistic copyright works and film, as well as some performances. However, moral rights do not generally apply to software.

• In general, moral rights are the personal right of an author to be acknowledged as such and to ensure that his or her work is treated in a suitable fashion.

• There are four moral rights – paternity, integrity, false attribution and privacy of certain photographs and films. These rights relate to the reputation or standing of the creator in the eyes of fellow human beings. To infringe a moral right involves denigrating or harming the author’s reputation.

• Moral rights enable an individual to object to derogatory treatment of their work which amounts to distortion, mutilation or otherwise is prejudicial to the honour or reputation of the author.

• This is a personal right and separate from copyright, but relates to a copyright work produced by the author. Moral rights can be waived: by this, the author chooses not to exercise the rights – or they can be bequeathed. They cannot be assigned, sold or licensed.

• The right of paternity has to be asserted in writing: it is the right to be identified as the author of the work.

• The right of integrity means the copyright owner has the right to object to derogatory treatment of his/her work. Basically, this means changing it in any way without permission.

• Please note that there are certain exceptions to certain of the rights, e.g. including in an employment context.
Database Rights

- A database right protects the compilers of information in a database in an organised way from losing the benefit of their work through unauthorised copying or re-use. It provides additional protection to that provided by copyright. If a database qualifies for protection then the owner can enforce their rights against businesses that extract or re-utilise all or a substantial part of the database. It is possible that an extraction of a substantial part can occur through the repeated extraction of parts that would not of themselves be considered substantial.

- A database will qualify for protection if the database is a “collection of independent works, data or other materials arranged in a systematic or methodical way and individually accessible by electronic or other means” and either qualitatively or quantitatively there has been a substantial investment in the getting, checking or presenting of the contents of the database. Note, it does not protect the data itself.

- A database right arises without the need for registration.

- Database rights last for 15 years from the end of the calendar year in which the database was completed, or if the database is made available to the public during that 15 year period, protection will last for a period of 15 years from the date that the database was first made available to the public. However, it is possible for a database to be protected for an indefinite period, since every substantial amendment to the database will cause a new database right to arise.

Registered Design Rights

- A registered design right applies to the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.

- To obtain a registration, the designs must be novel and have individual character.

- Designs are entered on to a public register providing a 25-year term for protection within the UK and EU – provided that the registration is renewed (and the fee paid) at 5-yearly intervals. A six-month period is then made available to file in other territories e.g. USA and Japan. Some countries provide a grace period in which a disclosure of a design does not destroy the novelty of a later application, but best practice is to apply for registration before publication, for example during a marketing campaign, as grace periods are not available in all countries and where available differ widely.

- There are separate EU and UK registered design rights.
Unregistered Design Rights

- Whereas a registered design right applies to the aesthetics of an object, the unregistered design right applies to functional shape or configuration.
- The right comes into existence automatically upon creation of the relevant design without the need for registration.
- The right lasts for a maximum of 15 years.
- There are separate UK and EU unregistered design rights. EU unregistered design just protect the external features of an object.

Trade Marks

- Trade marks are used to protect the brand of a product or service. It is normally a mark (logo) or other distinctive sign.
- Trade marks can be unregistered (when the “TM” mark can be used) or registered (when the ® mark can be used).
- A registered trade mark provides clearer protection, since it gives a monopoly right for the use of the mark, whereas unregistered trademarks have to prove "passing off" (in the UK) or similar wrongdoing (e.g. “unfair competition in some EU countries).
- Trade marks must be used, or the (registered) right will lapse if not used for a period of 5 years.

Confidential Information

- Knowledge which has not been made public can be protected by keeping it secret or by only disclosing it under a non-disclosure/confidentiality agreement.
- Employees should note that they do not have the authority to sign ‘Material Transfer’ or ‘Confidentiality’ Agreements with third parties during the course of their work on behalf of the University when not legally authorised or insured to do so. Details of those delegated to approve financial transactions and contracts are given in the University Ordinances and Financial Regulations.
# Summary of Intellectual Property Rights

<table>
<thead>
<tr>
<th>Intellectual Property</th>
<th>Protection by</th>
<th>How to protect</th>
<th>Guidance &amp; Tips</th>
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<tbody>
<tr>
<td>Any technical or commercial information not covered by other intellectual property rights.</td>
<td>Know-how/Trade secrets</td>
<td>Protected by the law of confidentiality and/or non-disclosure agreements.</td>
<td>Keep secret: inform employees/students of their duty of confidence. Once revealed, know-how cannot be made confidential again. Mark all confidential information as “confidential”. Ensure any transmission of confidential information is via secure means (Note: email is not by default a confidential means of communication.)</td>
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<tr>
<td>Original literary, dramatic, artistic and musical works, audio and video recordings, broadcasts and cable transmissions, and original software code</td>
<td>Copyright</td>
<td>Copyright comes into existence automatically on the physical creation (not the idea) of the work (provided the relevant criteria are met) and there is no requirement to register (i.e. there are no registration costs involved).</td>
<td>Keep evidence of authorship and date of creation (e.g. email/post a sealed copy to yourself or your employer). Mark materials with the copyright symbol, name and date; e.g. “© The City, University of London 20[xx]. All rights reserved.”</td>
</tr>
<tr>
<td>Shape or configuration (whether internal or external) of the whole or part of an article</td>
<td>(UK) Unregistered Design Right.</td>
<td>Automatic right (provided relevant criteria are met); protects for up to 15 years in UK.</td>
<td>Keep evidence of dates of conception and first marketing.</td>
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<td>A technical invention capable of industrial application. Must be novel and not obvious.</td>
<td>Patent</td>
<td>Application must be filed at the Intellectual Property Office (or other national patent office depending on where protection is required) or via the European Patent Office (EPO) or the PCT system. Use a qualified patent agent to ensure best protection.</td>
<td>If you reveal your invention before you file, patenting in most countries will be impossible. Apparently trivial ideas can give valuable patents. Ensure lab notebooks/records are signed &amp; witnessed regularly.</td>
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<td>Description</td>
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<td>A mark to show the brand or origin of goods; may comprise a word, logo,</td>
<td>Trade Mark</td>
<td>Trade Marks can be unregistered (using the “TM” mark), in which case actual use in the market would establish the right. Can also be registered at the Intellectual Property Office (or other national trade mark office depending on where protection is required) and the EU trademark office (OHIM) (after which the ® mark can be used). Can provide perpetual protection if used consistently in the market and, in the case of registered trademarks, the relevant renewal fees are paid.</td>
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<td>smells, jingle, shapes, sounds, etc.</td>
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<td>The reputation or standing of the author</td>
<td>Moral Right</td>
<td>Automatic personal right of the author of a literary, dramatic, musical or artistic copyright works and films, as well as some performances. Enables an individual to object to derogatory treatment of their work which amounts to distortion, mutilation or otherwise is prejudicial to the honour or reputation of the author. The right to be identified as the author of the work has to be asserted in writing.</td>
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RESPONSIBILITIES DURING COLLABORATIVE PROJECTS

Before and during projects or collaborations with third parties, all persons bound by this policy must co-operate with the Academic Enterprise Team to ensure that:

- appropriate, written agreements (e.g. relating to confidentiality and intellectual property issues) are in place before the start of any collaboration or project between City and any third parties, including, where appropriate, before any pre-proposal discussions with third parties. These third parties may include, but are not limited to, other universities and companies.

- The terms of ownership and use (e.g. research, education, commercial) of any intellectual property created during a project are agreed before the start of the project/work.

- all staff and students involved in a research project supported or commissioned in full or in part by a third party have been informed of the contractual issues by the Principal Investigator before the start of the research.

It is essential that a supervisor informs any students that may be involved with the project of any issues concerning intellectual property ownership before the start of any project where assignment of any intellectual property generated by an undergraduate/post-graduate taught student is required. If a student is not willing to assign their future intellectual property to the University (or, if appropriate the funding body), then the university will be free to re-assign the student to another project.

RE-ASSIGNMENT OF IP

- If City decides that it does not wish to pursue the commercialisation of any intellectual property (or that it does not wish to maintain an interest in intellectual property) it may, at its discretion and if it is free to do so, offer to assign the IP back to the creators on certain terms that will be agreed between the relevant parties.

- If the University does not conclude any exploitation deals with third parties or incorporate a spin-out company and subsequently notifies the relevant student or staff member in writing that it has decided not to pursue the IP further, the individual may request (via the Academic Enterprise Team) that the IP be assigned to them so they could pursue its exploitation. If City is not prevented from assigning the IP to the student or staff member (e.g. because of funding or other contract terms or obligations), it will endeavor to execute an assignment agreement in favor of the individual within twelve weeks of receiving their request. In these circumstances, the University will usually expect the student or staff member to:
  a) grant City a non-exclusive, royalty-free, fully paid-up, irrevocable and perpetual licence to use the IP for all research, teaching and publication purposes, and
  b) share any revenues accrued from exploitation with the University.
CONSULTANCY
Any IP generated through consultancy work commissioned by a third party will belong to the university; although usually all rights in the results will transfer to the client, depending on the terms of contract agreed between City and the client. Wherever possible City will try to secure publication rights for staff to use the results for research and teaching purposes, but please note that, in a consultancy setting, this may not always be possible.

Please visit the Consultancy Policy for more information.

SCHOLARLY WORKS
• City waives its ownership rights to any literary copyright that may subsist in any of scholarly works produced by its staff and students solely in the furtherance of an academic career. This includes books, articles in journals, papers for conferences, study notes and dissertations produced for such purposes, **provided the publication does not form part of a course or teaching materials for City, or has not been commissioned by City**, or that another ownership position is required by a contract that the university has concluded.

• The above rule does not apply when scholarly works incorporate third-party-owned information or materials.

• City **does not waive** its rights in the intellectual property in any underlying materials on which the scholarly work is based, including software, data, designs and patentable inventions.

• For inventions of a technical nature, which might be protected by a patent, advice should be sought from the Academic Enterprise Team prior to any publication or other disclosure of the invention to avoid any premature disclosure which may prevent the ability to patent and commercialise the invention.

• Where a patent application is **being contemplated for an invention that will be disclosed in a thesis, regardless of ownership, then external examiners or external subject reviewers must sign an appropriate confidentiality agreement before being sent the thesis**. It may also be necessary for the thesis to be held in the Library on a restricted access basis with readers being denied access or being asked to sign confidentiality undertakings, until a patent application has been filed. For the avoidance of doubt, restricted access may also be necessary under the terms of a contract with a third-party funder to protect third-party confidential information.

• It may be that research contracts and confidentiality agreements often restrict any disclosure, publication or other communications to third parties, without written consent prior to publication. Those bound by the IP Policy and who are involved in such contracts are responsible for checking the terms and conditions prior to any form of publication or other disclosure.

• Where the funder requires that open access should apply to the dissemination of research results, then due consideration will be given to any constraints pertaining to data protection rules, security rules or intellectual property rights.
**TEACHING AND LEARNING MATERIALS**

The University is committed to the continued investment and development of course materials and modes of delivery which take advantage of technological developments allowing for distributed and remote learning. Teaching and learning materials now include many different forms of intellectual property, such as intellectual property in paper-based material, digital media, web-based content, broadcasts, video and audio materials, and software.

- City asserts its ownership rights in any teaching and learning materials that are developed by its employees in the course of their duties; or while using significant university resources in their development such as multimedia materials, visuals or slide shows; video and audio material; presentations streamed or made downloadable over the intranet or Internet; or that are specifically commissioned by the university.

- City does not claim ownership of any intellectual property produced by members of staff in any previous employment. However, adaptations and modifications made as a member of staff of, or commissioned by, the City will be owned by the university.

- City does not claim ownership of intellectual property in teaching and learning materials produced by its staff members for personal use and reference in teaching (for example, as personal notes and annotations to support teaching materials, and which are not provided to students).

- City, in consultation with the relevant members of staff, may exploit (whether for financial gain or not) teaching and learning materials as it sees fit, which may include licensing or assigning the intellectual property in the teaching materials to third parties; or merging teaching materials with other materials created within the university or elsewhere.

- If there is net income generated from the exploitation of the intellectual property beyond the normal teaching activities of the university, then the Revenue Sharing model will apply.

**SOFTWARE**

Software, development tools or applications are widely used in universities for research and teaching. This section highlights some special considerations which should be observed when using or developing software. Original software code itself may be protected by copyright without any form of registration. However, in some situations, the methods behind the code can also be protected by a patent, which needs to be formally registered. There are a number of other types of intellectual property associated with software and which can also be protected by intellectual property rights. These include:

- manuals, which may be protected by copyright in a literary work;
- icons and other pictorial elements which may be protected by copyright in artistic works.
- a logo may be protected by copyright as an artistic work and/or a protected as a
design and/or a registered or unregistered trade mark;

- software fonts, software-related peripherals such as -, and on-screen displays are eligible for design protection as well as possible trademark protection;
- the name may also be protected against passing-off and other restricted uses as a trade mark;
- databases, which may be protected by database rights;
- domain names and web addresses, which although not protected by intellectual property rights can be registered.

When publishing software or making it available to third parties (whether for download from the Internet or otherwise), it must be covered by an appropriate licence agreement arranged through the Academic Enterprise Team. This licence would normally restrict the use to research, teaching or evaluation purposes, but not commercial use.

When using third-party software components or development tools to create new software, the terms of the licence agreements that apply to such third-party software or tools must be checked to ensure that they permit the required use without restrictions or obligations. For example, if a licence is for educational use, the software should not be used in a commercially-funded project such as a consultancy or technical services project. As for other types of agreements, employees must note that they do not have the authority to enter into software licence agreements in the name of the university (whether by signing a written contract or by clicking on an “I accept” button to download software via the internet). All licence agreements should be referred to the Academic Enterprise Team for review and approval.

When using third-party components to develop software for future commercialisation, the terms of the licence that apply to such third-party components must be checked to ensure that it allows the university to commercially exploit. In particular, care should be taken using third-party software covered by Open Source Licences which may restrict subsequent commercial use.

Please note that the author of a computer program is usually the person who writes the lines of code, and the first owner of the copyright in the program is that person or their employer.

Data

- The University also asserts its ownership rights to the data which underpins the intellectual property which it owns. However, research data may have multiple rights holders due to multiple sources. As this is a complex area, please contact the Contracts Managers in Research & Enterprise who will provide advice on a case by case basis.
• Without clear ownership of data, the legal complexities of data rights can impede commercialisation of research, and give rise to controversy and litigation. Ownership of data may be necessary for the protection of intellectual property; for the fulfilment of contractual obligations; for scientific integrity and the evaluation and/or confirmation of research results; for the protection of the privacy of human subjects; for the ethical use of research data; and for clarifying the rights in data access and use by researchers.

• Any researcher who wishes to receive or send research data to another organisation for a research project should contact the Contracts Managers in Research & Enterprise to put an appropriate Data Transfer Agreement in place.

K NOW HOW

Know-how is a valuable asset, which can be protected by a confidentiality agreement. Transfer of any valuable university know-how, which might include pre-project discussions with potential collaborators, should be covered by an appropriate confidentiality agreement. Please contact the Academic Enterprise Team for assistance with this.

For further information and advice on protecting know-how and confidentiality agreements, please contact the Academic Enterprise team.

TANGIBLE RESEARCH MATERIALS

‘include biological materials, engineering drawings, computer software, integrated circuit chips, computer databases, prototype devices, circuit diagrams, equipment and associated research data’\textsuperscript{2}. It is the responsibility of individual researchers to ensure that the storage, use and distribution of tangible research materials made in the course of research activities is subject to the provisions of any contracts governing the research in question. If any such material is to be transferred outside of City for external use – or if a request for any material is made – then it should be done under the terms of a contract negotiated through the Contracts Managers based in Research & Enterprise.

INFRINGEMENT

Any person bound by the IP Policy must alert the Academic Enterprise Team immediately on suspecting or becoming aware of:

• potential infringement of intellectual property rights owned by the university; or
• City potential infringement of intellectual property rights owned by a third party.

\textsuperscript{2} The University of Manchester 2015), Intellectual Property Policy, page 27
**Leavers**

- Cessation of employment, under normal circumstances, will not affect an individual’s entitlements and obligations arising under the IP Policy providing that a) the commercialisation of the intellectual property is not hindered and b) the inventor continues to support the commercialisation as necessary. This may require a negotiation with a future employer involving access to the inventor, and clarification that no conflicts of interest exist. Consultation with Academic Enterprise might be necessary.

- Former employees, students and associates should continue to acknowledge Intellectual Property Rights that were created during the period of their employment, study or under other contractual agreements with City in a clear manner. They should avoid misleading future employers or collaborators or other third parties regarding the intellectual property concerned.

- Before the end of their contract with City, staff should deposit a copy of their scholarly works and any physical representation of their IP (e.g. drawings and diagrams) with the Academic Enterprise Team.

- City allows its staff members to use teaching materials created by them for research and teaching purposes during their period of employment with the university.

- If the staff member leaving has **any ongoing commercialisation activity** they should notify the Academic Enterprise Team of their intention to leave the university as soon as possible to give the Academic Enterprise Team an opportunity to **request an exit meeting with the leaver**.