



# Queen Margaret University

EDINBURGH

## **1. Intellectual Property Policy and Regulations**

*“QMU aims to be a university of ideas and influence; characterised by translational research that informs policy and practice, making a difference to everyday life.” [University Strategy, 2015 -2020]*

QMU is committed to generating new ideas, supporting their development and translation, and making them widely available for adoption by practitioners to provide solutions addressing real world problems. Our ambition is that QMU research and knowledge is translated by the people and organisations most able to influence policy and inform practice, to make a positive difference to everyday life.

Whilst in UK law the University owns legal title over intellectual property (IP) produced by its staff in their work, QMU recognises that staff and their collaborators are often best placed to develop their research into new products and applications which offer solutions to prospective end-users. Intellectual Property is also an asset class that is valuable to the University and individual researchers in their designated University role, and it may have commercial value. QMU believes that researchers should have free, uninhibited access to the IP they have generated during their research except in specific circumstances which might disadvantage the University – these are set out below in Section 2. The University aims to support both staff and the University’s use of University-generated IP and promote access for other parties use of that IP to help develop practical, user-centric, beneficial applications.

“Intellectual property” covers all IP, including but not limited to all inventions, designs, information, specifications, formulae, improvements, discoveries, know-how, data, processes, methods, techniques and the IP rights therein, including but not limited to patents, copyrights, database rights, design rights (registered and unregistered), trademarks, trade names and service marks and the right to apply for any of the above as recognised in any country in the world. For the avoidance of doubt, IP shall not include any personal data (as defined in the General Data Protection Regulations 2018) of which the University is the data controller (“Personal data”). The University will retain ownership of all Personal data and this Policy is not intended to authorise any other party to process such Personal Data without the consent and authorisation of the University.

## **2. Intellectual Property Ownership**

The general rule in relation to IP created by an employee during the course of their employment is that, in the absence of agreement to the contrary, the first owner is the employer. This position arises due to statutes governing intellectual property. In the case of inventive products and processes, the Patents Act 1977 confers first ownership of an invention

created by an employee to the employer. In relation to copyright works and registered and unregistered design rights (copyright works being literary, musical, dramatic and artistic works), the Copyright Designs and Patents Act 1988, the Registered Designs Act 1949 and the Regulation on Community Designs (6/2002/EC) all operate to confer ownership of copyright works and UK and EU designs created by an employee to the employer. Similarly, the first owner of database rights in a database will be the employer pursuant to the Copyright, Rights in Databases Regulations 1997.

Whilst the de facto legal position is that the University owns the IP arising from work undertaken by its employees, this University Intellectual Property Policy modifies the position of IP ownership at QMU for staff and students as follows.

a. Staff

All IP generated by staff during the course of their employment by the University and/or using University resources (“Staff IP”) will be owned by the inventor (the member of staff who creates the IP), except:

- Where as a condition of support an external funder providing funding or other support requires that Staff IP is assigned to that external sponsor; or
- Where the Staff IP has been developed in the production of a course or teaching materials, in which cases the Staff IP will be owned by the University.
- Exceptionally, and only at the point at which potential IP is disclosed (see Section 5), the University identifies that the commercial opportunity would be best realised by a traditional model of IP exploitation led by the University. *In such cases, after the University has recovered the direct costs incurred by it for any registration of IP rights and all costs incurred for exploitation, remaining revenues will be shared equally between the University and the inventors (50% each)*

In the event where any of the exceptions above are considered by the University to apply, the staff member shall execute and deliver such documents and perform such acts as may reasonably be required in order to ensure that ownership of Staff IP is assigned to the correct party, as set out above. In certain cases, the University may require the staff member to sign an agreement formally assigning IP to the University.

b. Students

All IP generated by students during the course of their studies at the University and/or using University resources (“Student IP”) will be owned by the inventor (the student who created the IP), except:

- Where as a condition of support an external funder providing funding or other support requires that Student IP is assigned to them (for example projects involving 3<sup>rd</sup> parties and work requiring use of pre-existing University-owned IP); or
- Where the Student IP has been developed in the production of an MSc or PhD thesis or in the production of course or teaching materials, in which cases the Student IP will be owned by the University.

In the event where any of the exceptions above are considered by the University to apply, the student shall execute and deliver such documents and perform such acts as may reasonably be required in order to ensure that ownership of Student IP is vested in the correct party, as set out above, and the University may require the student to do so at any time.

c. Joint ownership

Where multiple inventors are responsible for the creation of IP using the University's resources, and at least one inventor is a University staff member or student, the IP shall be owned jointly by the inventors ("Joint IP"), unless the IP falls into one of the exceptions relating to Staff or Student IP in section 2(a) or 2(b) above. Joint ownership requires more ongoing management and should only apply where the contributions of each inventor are not distinct and cannot be separated. Joint inventors are best placed to agree between themselves how Joint IP should be protected and how any revenue generated be shared, and the University would not normally expect to be involved in any negotiations between the inventors on the issues surrounding Joint IP.

### **3. University responsibilities for Intellectual Property**

The University shall not give any warranties or assume liability for any uses of, or dealings in, Staff IP or Student IP which has been created at the University but assigned to any staff member or student under this policy.

The relevant staff member or student shall be solely responsible for any protection, commercialisation and exploitation of Staff IP or Student IP respectively and must make clear that:

- the University has no ownership interest in the relevant IP; and
- he or she is not authorised to act or incur obligations and/ or liability on the University's behalf.

As noted in Section 2, the University will retain ownership of IP in relation to course or teaching materials generated by students and staff. The University will also register its IP where appropriate through trademarks, patents and/or registered designs to protect its IP, trading names and teaching & research objectives where this is deemed appropriate. The University will monitor the use of this and any other IP belonging to the University and reserves the right to defend its IP in circumstances where their misuse or infringement would, or is likely to create reputational, financial or other damage to the University.

The University shall continue to store and make publicly available data generated by research, in line with evolving policy on this issue. The University shall also continue to make research publications by staff accessible to a wide audience through use of the institutional repository of publications and requires that staff place their publications on this repository.

In relation to any grant of rights, licences, warranties or undertakings sought by any person in relation to IP owned by or licenced to the University, these shall only be granted subject to the University's approval procedures. No member of staff or any student is authorised to give or purport to give any such grant, licence, warranties and/or undertakings on the University's behalf.

### **4. Staff and Student's Responsibilities for Intellectual Property**

The University has provided support to staff and students in the development of both Staff and Student IP and has a responsibility to promote new research and knowledge exchange. Therefore, staff and students shall grant to the University a perpetual, irrevocable, worldwide non-exclusive, royalty-free licence to any Staff IP and Student IP for teaching, publishing and research purposes. If Student IP or Staff IP includes confidential information belonging to the inventor, the University shall not unreasonably refuse to enter into a non-disclosure agreement to protect that confidential information if so requested by the inventor.

When undertaking University work from which IP may be expected to arise all persons bound by this policy must:

- keep the nature of and matters relating to IP confidential until the fact and manner of disclosure is agreed with the University;
- assist in protecting the University's rights to the IP by keeping suitable records of creation wherever possible.

## **5. Reporting and Disclosure of Intellectual Property**

All persons bound by this policy are responsible to the University for disclosing to their Head of Division at the outset of the work or as soon as they become aware of it:

- any potentially exploitable IP arising from their work
- the ownership by a third party of any IP referred to or used for their work
- any use to be made of existing University IP during their work
- any IP which they themselves own which is proposed to be used by the University

The Research and Knowledge Exchange Development Unit (RKEDU) will keep a register of reported IP and any decisions regarding ownership covered by Section 2.

## **6. Use of Intellectual Property by University, Staff and Student owners**

The owners of IP property arising from the University have a responsibility to protect, translate and use it for both public good and commercial purposes, whichever is most appropriate.

All persons bound by this policy are responsible to the University for such use, and upon reasonable request from the University will provide the University with such reports and information from time to time e.g. University requests for impact reports, for information for use in University PR, Website and promotional material, and for other University purposes which might arise.

Intellectual Property owners will respond to appropriate University requests in a timely manner.

## **7. Disputes**

Any person disputing the coverage, administration or effect of this policy must address their concern in writing in the first instance to the Director of Operations and Finance who shall within 20 working days of receipt give either an initial ruling or reasons for not so doing together with an indication of process (e.g. further information required, reference to another person/body for decision or opinion) including where a right of appeal would lie.

## **8. On leaving the University**

Persons bound by this policy shall continue to acknowledge and attribute the University's IP rights created during the period of their employment or other contractual obligation at the University in a clear manner and to avoid misleading future employers or collaborators or other material third parties as to the interests in the IP concerned.

## **9. Breach of the Policy**

Breach of this policy is a disciplinary matter for University staff and students under the normal procedures.

The University shall consider all avenues available to it, including legal action by injunction or for damages or otherwise, in respect of persons bound by this policy acting in breach of them.

### **10. Amendments to the Policy**

This policy may only be amended through recommendations submitted for approval by the Research Strategy Committee.

#### **Further Information**

##### **Student and Contractual IP Matters**

Lorraine Kerr, Legal Adviser and Data Protection Officer: [lkerr2@qmu.ac.uk](mailto:lkerr2@qmu.ac.uk)

##### **Externally funded research and grants/contracts**

Research Grants and Contract Unit: [rgcu@qmu.ac.uk](mailto:rgcu@qmu.ac.uk)

##### **Research and Innovation Ideas creation and company formation**

Research and Knowledge Exchange Development Unit: [rkedu@qmu.ac.uk](mailto:rkedu@qmu.ac.uk)

## List of Appendices

Appendix A – Guidance on Copyright in course materials

Further information on Intellectual Property can be found on the UK Intellectual Property Office website at: <https://www.gov.uk/intellectual-property-an-overview>

Template agreement for

1. Assignment - Assignment Agreement (Section 2a) – see attached.

**THIS ASSIGNATION IS DELIVERED ON \_\_\_\_\_ 2019.**

### **ASSIGNATION**

by

**[NAME]**, residing at **[ADDRESS]**, and a staff member of the University (the “**Assignor**”).  
in favour of

**QUEEN MARGARET UNIVERSITY**, a charitable body registered in Scotland under registration number SC having its principal office at (the “**University**”);

### **WHEREAS**

- A. The Assignor has agreed to grant, and the University has agreed to accept, an assignment of the IPRs on the terms and conditions set out below.

### **NOW THEREFORE**

#### **1. Definitions**

- 1.1. In this Assignment (including the Schedule), the following definitions shall apply:

**“Commercialise and Commercialising”** means to make, have made, import, export, use, sell or offer for sale or licence, including to research, experiment, develop, commercialise, file for, obtain and maintain regulatory approvals, manufacture, to have manufactured, hold or keep (whether for disposal or otherwise), have used, export, transport, distribute, promote, market or have sold or otherwise dispose of, and **“Commercialisation”** shall mean the act of Commercialising;

**“Confidential Information”** means any and all:

- (i) commercially sensitive information relating to the affairs and / or business of the University or the Assignee; and
- (ii) trade secrets and information of whatever nature relating to the subject matter of the Technology and

the Intellectual Property Rights assigned under this Assignment

in each case whether or not the same is labelled or marked as confidential;

**“Encumbrance”** means any mortgage, standard security, charge, pledge, lien or assignment or other encumbrance, priority or security interest or arrangement of whatsoever nature over or in the relevant property;

**“Intellectual Property Rights (IPR)”** [INSERT THE TYPE AND FORMAT OF IPR INVOLVED (e.g. means the patents and patent applications set out in the Schedule)]; and

**“Technology”** means [INSERT generic description around the technology].

1.2. The Schedule forms part of and shall be read together with this Assignment.

## **2. Assignment**

2.1. Subject to clause 5, the Assignor hereby assigns to the University for nil consideration free from Encumbrances its whole right, title and interest in and to the IPR, including (insofar as applicable): -

2.1.1. in respect of any and each application in the IPR: -

- a. the right to claim priority from and to prosecute and formally register the IPR; and
- b. the right to file divisional applications based thereon and to prosecute and obtain grants of registered IPR on each and any such divisional application;

2.1.2. in respect of each and any invention disclosed in the IPR, the right to file an application, claim priority from such application, and prosecute and obtain grant of patent or similar protection in or in respect of any country or territory in the world; and

2.1.3. the right to extend to or register in, or in respect of, any country or territory in the world each and any of the IPR, and each and any of the applications comprised in the IPR or filed as aforesaid, and to extend to or register in or in respect of any country or territory in the world any registration, patent or like protection granted on any of such applications; and

2.1.4. the right to bring, make, oppose, defend, appeal proceedings, claims or actions and obtain relief (and to retain any damages recovered) in respect of any infringement, or any other cause of action arising from ownership, of any of the IPR applications, in each case to the extent comprised in the IPR registered or

filed as aforesaid, whether occurring before, on or after the date of this Assignment.

- 2.2. The effective date of this Assignment shall be the last date of execution hereof by the parties (the “**Effective Date**”).
- 2.3. At the University’s expense, the Assignor shall promptly execute and deliver such documents and perform such acts as may reasonably be required for the purpose of giving full effect to clause 2.1.
- 2.4. The University acknowledges and agrees that from the Effective Date the University (to the exclusion of the Assignor) shall be responsible for the preparation, filing, prosecution, and maintenance of the IPR at the sole cost and expense of the University.

### **3. No Warranties**

- 3.1. To the maximum extent permitted by law, the Assignor gives no warranty, representation, covenant or undertaking to the University:
  - 3.1.1. as to the efficacy or usefulness of the IPR; or
  - 3.1.2. as to the scope of any of the inventions or that any of the IPR is or will be valid or subsisting (or in the case of a patent application) will proceed to grant; or
  - 3.1.3. that the inventions comprised within or developed or made utilising the IPR is or will be free from defects or faults; or
  - 3.1.4. that the use of the inventions comprised within the IPR , or the manufacture, sale or use of any licensed products on the basis of the IPR or the exercise of any of the ownership transferred under or rights granted under this Assignment will not infringe the intellectual property rights or other rights of any third party; or
  - 3.1.5. that any information communicated by the Assignor to the University under or in connection with this Assignment will produce Licensed Products of satisfactory quality or fit for the purpose for which the University intended or that any product will not have any latent or other defects, whether or not discoverable.
- 3.2. The University acknowledges that:
  - 3.2.1. the inventions comprised within the IPR is at an early stage of development, that accordingly specific results cannot be guaranteed and any results, materials, information or other items provided under this Assignment are provided “as is” and without any express or implied warranties, representations or undertakings, including, but not limited to, the implied warranties of suitability/merchantability and fitness for a particular purpose; and
  - 3.2.2. the Assignor has not performed any searches or investigations into the existence of any third party rights or claims that may affect any of the IPR.

#### **4. Confidentiality**

- 4.1. The University agrees and undertakes that from the Effective Date and thereafter, it shall: -
  - 4.1.1. keep secret and confidential at all times all and any Confidential Information of the Assignor which comes into its possession at any time either before or after the Effective Date; and
  - 4.1.2. not, and shall each procure that its respective employees shall not, use or copy any Confidential Information and shall not divulge any Confidential Information to any third party,
- 4.2. Nothing in this Assignment shall prohibit the disclosure of Confidential Information to the extent such disclosure is required by law or by a governmental, regulatory or other authority with relevant powers.
- 4.3. The provisions of this clause 4 shall survive the termination or expiry of the Assignment for any reason.

#### **5. Commercialisation**

- 5.1. If the University proposes to Commercialise any of the IPR (whether solely or jointly with the any third party and whether together or in conjunction with any other intellectual property rights, the University shall notify the Assignor in writing prior to the commencement of such Commercialisation and the parties shall seek to agree in good faith a suitable/fair and reasonable level of remuneration or royalty for the Assignee having regard to the nature, scope and extent of the proposed Commercialisation, the costs, fees and expenses incurred by the University in Commercialisation and the preparation, filing, prosecution or maintenance of the IPR.

#### **6. General and Miscellaneous Provisions**

- 6.1. A waiver by either party of a breach or default under any of the provisions of this Assignment by the other party shall not be construed as a waiver of any succeeding breach of the same or other provisions, nor shall any delay or omission on the part of either party to exercise or avail itself of any right, power or privilege that it has or may have hereunder operate as a waiver of any breach or default by the other party. No waiver by a party of any right, breach or default shall be effective unless made in writing and signed by a duly authorised signatory of the party.
- 6.2. Nothing in this Assignment is intended to or shall operate to create a partnership or joint venture of any kind between the parties or to authorise either party to act as the agent for the other, and neither party shall have authority to act in the name or on behalf of or otherwise to bind the other in any way (including but not limited to the making of any representation or warranty, the assumption of any obligation or liability and the exercise of any right or power).
- 6.3. If any provision of this Assignment shall be found by any court or administrative body of competent jurisdiction to be invalid or unenforceable, the invalidity or unenforceability of such provision shall not affect the other provisions of this

Assignment and all provisions not affected by such invalidity or unenforceability shall remain in full force and effect. The parties hereby agree to substitute for any invalid or unenforceable provision a valid and enforceable provision which achieves to the greatest extent possible the economic, legal and commercial objectives of the invalid or unenforceable provision.

- 6.4. The University may not assign or novate (in whole or in part) its rights and/or obligations under this Assignment without the consent of the Assignor.
- 6.5. Where consent, approval or agreement of a party is required in terms of this Assignment and where such consent, approval or agreement is granted subject to any terms or conditions, any breach of those terms or conditions shall be deemed to be a breach of the terms of this Assignment.
- 6.6. This Assignment supersedes any previous agreement between the parties hereto in relation to the matters dealt with herein and represents (together with the documents referred to herein) the entire agreement between the parties hereto in relation to such matters.
- 6.7. No variation of this Assignment shall be valid unless it is in writing and signed by or on behalf of each of the parties.
- 6.8. Both parties shall agree in writing any announcement or information concerning the contents of this Assignment or its termination before it is made or released to the public or to the media (national, provincial, local or trade).

## **7. Third Party Rights**

- 7.1. This Assignment does not create any rights in favour of third parties under the Contract (Third Party Rights) (Scotland) Act 2017.

## **8. Counterpart Execution**

- 8.1. This Assignment may be executed in any number of counterparts and by each of the parties on separate counterparts, in accordance with the Legal Writings (Counterparts and Delivery) (Scotland) Act 2015 (the “**2015 Act**”).
- 8.2. Where executed in counterparts:
  - 8.2.1. this Assignment will not take effect until each of the counterparts has been delivered; and
  - 8.2.2. each counterpart will be held as undelivered for the purposes of the 2015 Act until the parties agree a date (the “**Agreed Date**”) on which the counterparts will be delivered. The Agreed Date will be inserted on the first page of this Assignment.

9. **Governing Law and Disputes**

9.1. This Assignment shall be governed by and construed in accordance with the laws of Scotland.

9.2. Any dispute arising out of the interpretation, validity or performance of, or otherwise in connection with, this Assignment shall be irrevocably submitted to and the parties hereby irrevocably prorogate the exclusive jurisdiction of the Scottish courts: **IN WITNESS WHEREOF** these presents consisting of this and the preceding [●] pages (and the Schedule) are subscribed as follows:-

**SUBSCRIBED** for and on behalf of **QUEEN MARGARET UNIVERSITY**

at

on

by

\_\_\_\_\_  
Print Full name

\_\_\_\_\_  
Signature

before this witness:

\_\_\_\_\_  
Print Full Name

\_\_\_\_\_  
Witness Signature

Address:  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

**SUBSCRIBED** for and on behalf of **[NAME]**

at

on

by

\_\_\_\_\_  
Print Full name

\_\_\_\_\_  
Signature

before this witness:

\_\_\_\_\_  
Print Full Name

\_\_\_\_\_  
Witness Signature

Address:  
\_\_\_\_\_  
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\_\_\_\_\_  
**THIS IS THE SCHEDULE REFERRED TO IN THE ASSIGNATION ENTERED INTO  
BETWEEN THE **[NAME]** AND QUEEN MARGARET UNIVERSITY.**

**Schedule**