REGULATIONS ON INDUSTRIAL AND INTELLECTUAL PROPERTY RIGHTS AT THE UPC

Agreement no. 137/2008 of the Governing Council ratifying the agreement of the Research Committee in relation to the Patents and Licences Office and regulations on industrial and intellectual property rights at the UPC.

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REGULATIONS ON INDUSTRIAL AND INTELLECTUAL PROPERTY RIGHTS AT THE UNIVERSITAT POLITÈCNICA DE CATALUNYA
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PREAMBLE

Research as a process of creating new knowledge is an essential part of university life and is both a right and a duty of its teaching and research staff. Universities must encourage programmes for protecting and using intellectual and industrial property in all research by university members and research centres, as well as in the technology and knowledge transfer that occurs within the framework of the research.

The research and transfer of research results of the Universitat Politècnica de Catalunya (UPC) is substantial and the University is currently one of the leading universities in number of patents in Spain. To match the currently reality of the University, therefore, the UPC needs a new legal framework for intellectual and industrial property rights stemming from the results of research conducted by members of the university community at the UPC as part of their academic, teaching and research responsibilities.

Article 144.2 of the UPC Statutes lays down the first regulation on intellectual and industrial property, which establishes thus: “The UPC shall own and manage the inventions of its teaching and research staff as a result of their research responsibilities at the University and that lie within the scope of their study, teaching and research activities, in accordance with the legislation on intellectual property and patents”.

Moreover, Article 144.3 states that “the benefits to the University from the exploitation or concession of the patent shall be distributed as follows: 25% for the University, 25% for the basic unit or accredited research group in which the research was carried out and 50% for the inventor or inventors”.

These regulations aim, in accordance with the aforementioned statutory provisions, to support members of the university community in their research responsibilities, to regulate the protection and exploitation of intellectual property rights arising from their research, and to protect the interests of both the University and the members of the university community.
PART I. SCOPE

Article 1. SCOPE

These regulations apply to the R&D activities carried out by members of the UPC university community as a result of their academic, teaching or research responsibilities.

These regulations apply to departments, institutes, research groups and specific research centres.

They also apply to relations with other public or private entities within the framework of research projects, in accordance with the provisions of Article 4 below.

PART II. OWNERSHIP AND EXPLOITATION RIGHTS OF RESEARCH RESULTS

Chapter 1. OWNERSHIP OF RESEARCH RESULTS

Article 2. Industrial property rights

1. Inventions by UPC staff
The UPC shall own the inventions that may be subject to the protection of industrial property rights (hereinafter, "inventions") of its teaching and research staff or staff of any other nature in a public or private employment relation with the UPC and by trainee research staff in a contractual relation with the UPC (hereinafter, "UPC staff") within the scope of their teaching and/or research responsibilities.
2. Inventions by students supervised or coordinated by UPC professors

The UPC is also the owner of the inventions developed exclusively by its students within the framework of an academic activity that has been supervised or coordinated by a UPC professor.

3. Inventions by students not supervised or coordinated by UPC professors

If a professor's participation is limited to requesting and assessing the invention, the student shall own it and the UPC shall reserve the right to use it in academic, teaching and research activities.

4. Rights of inventors

The UPC shall in all cases respect the rights of inventors to be recognised as such, in accordance with the provisions of prevailing legislation on industrial property.

5. Procedure for acquiring the ownership of rights

If a UPC member of staff develops an invention that may be subject to the protection of industrial property rights, he or she must immediately inform the UPC of this result—directly or through the research group or department—and submit all of the information on the invention that might allow the UPC to initiate the procedure for its legal protection, should it consider it appropriate to do so.

The body to which the research result must be reported is the office in charge of such matters, which shall transfer the information to the competent body in accordance with the provisions of the following paragraph.

The decision on whether or not to protect, relinquish or abandon a given industrial property right shall be made by the rector, who may delegate this decision to the vice-rector for research.

In any event, the inventors of the research result shall be obliged to collaborate with the UPC in everything necessary for the adequate protection of their rights.
6. Waiver of the ownership of rights by the UPC

If the UPC has no interest in owning an invention it shall communicate this fact to the inventors, so that they can request that the UPC waive its rights with regard to the invention and initiate procedures to protect their own.

Even if the UPC waives these rights, it reserves a non-exclusive, non-transferable right to use the invention for research at no cost. It shall also have the right to receive part of the financial benefits that the inventors may receive from the commercial exploitation of the invention in the future.

Moreover, if the UPC decides not to apply for or maintain the ownership or international extension of an industrial property right, it shall transfer this right to the inventors, who shall become the owners in accordance with the conditions agreed by the parties.

Article 3. Intellectual property rights

1. Works by UPC staff

The authorship of intellectual works that may be subject to the protection by copyright created by UPC staff within the scope of their academic, teaching or research responsibilities (hereinafter, either “creations” or “intellectual works”, interchangeably) remains with the authors. All exploitation rights belong exclusively to the UPC, and this applies worldwide throughout the period of validity of the intellectual property rights. No limitation may be imposed because of the type of subject or activity.

2. Collective works

In relation to collective intellectual works (including software) developed by members of the university community under the initiative and coordination of the UPC, the UPC shall own the exploitation rights in the event that it publishes or disseminates them under its name.

3. Works by students supervised or coordinated by UPC professors

If the development of the intellectual work has been supervised and/or coordinated by UPC professors, the UPC shall own the exploitation rights to this work and the student and the professor shall be considered co-authors of the work.
4. Works by students not supervised or coordinated by UPC professors
In the case of intellectual works developed exclusively by students in which the participation of UPC professors has been limited to requesting and assessing the work, all rights stemming from the work shall belong to the student.

In any event, the UPC shall have the right to the public communication of these works by making them available through portals or websites belonging to the UPC.

5. Moral rights
The UPC shall respect the authors’ irrevocable and inalienable moral rights at all times in accordance with the provisions of the Intellectual Property Law.

6. Dissemination of intellectual works
The following distinction must be displayed on all intellectual works owned by the UPC: © Universitat Politècnica de Catalunya, (...). All rights reserved.

Chapter 2. RESEARCH RESULTS FROM PROJECTS WITH OTHER ENTITIES

Article 4. Research results from projects with other entities
If the research results have been obtained in the framework of research projects governed by agreements or contracts with other public and/or private entities, the parties involved shall in each case determine the ownership of the industrial and intellectual property rights of the research results and the distribution of the exploitation rights stemming from them.

Chapter 3. SHARED ASPECTS

Article 5. Prior authorisation by the UPC of the dissemination of research development and results
The inventors or creators may not publicly disseminate the development or the results of the research by any means without the UPC's prior authorisation.
Furthermore, any act of disclosure or dissemination of research carried out at the UPC must specifically indicate the UPC’s participation.

**Article 6. Participation in research**

The UPC may require persons seeking to participate in research activities at the UPC to enter into a contract transferring the rights to exploit any research results that arise in favour of the UPC. This transfer shall not be subject to temporal, geographic or material limitations.

**Article 7. Transfer of rights to the UPC by staff not linked to the UPC**

Staff who are not linked to the UPC and who participate in UPC research projects may be previously required to sign a contract or similar document that establishes the transfer of exploitation rights regarding inventions or creations that are developed during the provision of services to the UPC or that use the means, infrastructure and resources of the UPC.

**PART III. EXPLOITATION RIGHTS AND INCOME DISTRIBUTION**

**Article 8. Exploitation of industrial and/or intellectual property rights regarding inventions or creations**

The profits obtained by the UPC from the exploitation of industrial and/or intellectual property rights for the creations and inventions for which the UPC holds the exploitation rights, as described in these regulations, shall be distributed as established in the UPC Statutes and in accordance with the following general criteria:

a) 25% for the UPC. The UPC may cover up to 10.3% of the costs incurred by the authors or inventors in promoting the patent or creation internationally.

b) 25% for the accredited research group that conducted the research. However, in cases in which the intervention of the basic unit of the UPC has been significant, it shall be the responsibility of the Governing Council’s Research Committee to allocate part of the aforementioned percentage to the basic unit as a fair return.

c) 50% for the authors or inventors.
The distribution of profits stemming from the commercial exploitation of creations or inventions developed in the framework of joint projects with other public and/or private entities shall be determined by contract between the entities involved in the project.

PART IV. DECISION-MAKING BODIES AND MANAGEMENT UNIT

Article 9. Technology Transfer Centre

The Technology Transfer Centre (CTT) shall be in charge of the following:

a) Through its IPR Research Advice and Support Office, it shall advise and provide legal support to members of the university community on any kind of agreement or contract with third parties related to research and technology and knowledge transfer, with the aim of protecting the interests of the UPC in the framework of the agreement or contract.

b) The CTT is responsible for carrying out administrative tasks such as issuing invoices and identifying payments for research results that have already occurred.

Article 10. Patents and Licences Office

The UPC Patents and Licences Office shall be in charge of the following:

a) It shall protect the research results that have occurred with the aim of starting the process of transferring the knowledge developed at the UPC (which involves the identification, evaluation, protection, valorisation and transfer of the results). That is to say, it shall support members of the university community during the various stages of the transfer process by advising them and marketing the research results.

b) It shall ensure the protection of results and their transfer by means of licences, contracts, business creation, etc. or any other formula that is deemed appropriate when it develops a business strategy that enables the research results to be transferred to society and that ensures the protection of industrial and intellectual property rights is handled properly in administrative terms.
External agents may be used when the characteristics and complexity of the case so require.

c) It shall work on the process of valorisation\(^1\) to put the technology or industrial and intellectual property on the market and it shall endeavour to establish contacts with public and private stakeholders who may have an interest in the industrial and intellectual property rights.

d) It shall receive progress reports and notifications for tracking payments and it shall reserve the right to request audits in suspect cases.

e) It shall design and negotiate the model for exploitation of the research results.

**Article 11. Costs of registering industrial property**

The UPC shall cover the costs of processing and maintaining the industrial property records in Spain, without prejudice to the provisions of Article 2, Section 6.

The international extension of industrial property before the priority period ends shall depend on the existence of agreements with third parties to cover the costs of the extension or the technical and economic feasibility of its future exploitation.

**REPEALING PROVISION**

These regulations repeal and replace the previous regulations, which were approved on 15 June 2000.

**FINAL PROVISION**

The present regulations come into force the day after they are approved by the Governing Council of the Universitat Politècnica de Catalunya.

**October 2008**

\(^1\) Valorisation is understood to be the adding of value to research results to facilitate their transfer to industry and society as a result of analysing their technical feasibility and economic impact.