



**UNIVERSITAT POLITÈCNICA
DE CATALUNYA
BARCELONATECH**

Regulations on Industrial and Intellectual Property Rights at the UPC

**Governing Council Decision CG/2018/08/05, of 20
November 2018, approving the Regulations on
Industrial and Intellectual Property Rights**

Office of the General Manager

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UNIVERSITAT POLITÈCNICA DE CATALUNYA

REGULATIONS ON INDUSTRIAL AND INTELLECTUAL PROPERTY RIGHTS

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PREAMBLE

In the current edition of its Statutes (published in the *Official Gazette of the Catalan Government* no. 6140, of 1 June 2012), the Universitat Politècnica de Catalunya (UPC) recognises that scientific, technical, artistic and humanistic research and technical and cultural development are essential components of its activity.

In particular, Article 134 states: “As a process that creates new knowledge and therefore an essential requirement for the full exercise of the University’s educational function and the social transmission of knowledge, research is a key component of university activity and a right and duty of the University’s teaching and research staff.”

In addition, Article 166 stipulates that the UPC “shall establish programmes for the protection and exploitation of intellectual and industrial property related to the technology and knowledge transfer activities carried out by its members”.

To this end, Article 166 stipulates that “in accordance with legislation on intellectual property and patents, the UPC shall own and manage the inventions of its teaching and research staff that result from their research work at the University and that fall within the scope of their study, teaching and research activities”.

Under the Statutes, the Governing Council is assigned responsibility for introducing regulations, in line with intellectual property and patent legislation, on the use of results of work carried out within the framework of academic activities; and the Board of Trustees, at the proposal of the Governing Council, is assigned responsibility for approving criteria for apportioning any financial returns derived from such results.

Until now, this matter, which affects teaching, research, administrative and service staff as well as students, has been regulated at the University by various internal regulations on industrial and intellectual property rights at the UPC, approved by successive Governing Councils on 2 October 2008, 26 May 2009 and 2 October 2012.

Reforms introduced in the general regulations on intellectual and industrial property, in particular the new Patent Law (Law 24/2015, of 24 July), and in regulations governing public research, through the Law on Science, Technology and Innovation (Law 14/2011, of 1 July), make it advisable to update the UPC’s internal regulations in this area, a measure that contributes to improving the efficiency and effectiveness of research valorisation processes at the UPC.

The aim of these regulations is to establish a suitable legal framework that provides the necessary legal certainty for the UPC, members of the university community and third parties with whom the UPC collaborates to carry out academic, teaching and research activities, and which, without prejudice to other matters subject to specific regulation, allows research staff to share in any financial returns obtained from commercial exploitation of the results of their activity at the UPC.

PART I. OBJECT AND DEFINITIONS

1. Object and field of application

- 1.1. The object of these regulations is to establish a legal framework to govern the following matters:
- (a) Ownership and management of industrial and/or intellectual property rights in results generated from all academic, teaching and research activities carried out within the framework of the UPC, including both the activities of the UPC itself and those promoted by it, as well as activities carried out in collaboration with or commissioned by third parties or entities.
 - (b) Recognition of moral rights over results and the management and system for attributing associated economic rights.
 - (c) Internal procedures for ensuring that these rights are protected, maintained and exploited in a proper manner.
- 1.2. These regulations apply to all members of the UPC university community within the framework of their academic, teaching and research activities.

2. Definitions

- 2.1. In these regulations, the following capitalised terms have the meanings given below:
- (a) *Profits*: Income obtained by the assignee of exploitation rights in results transferred by the UPC within the framework of Article 10 of these regulations, which, among other things, may consist of a percentage share in income from exploitation.
 - (b) *University community*: UPC students and staff.
 - (c) *UPC students*: Students enrolled in courses delivered by the University.
 - (d) *UPC doctoral students*: UPC students enrolled in a UPC doctoral programme.
 - (e) *Invention*: Results that are protectable by industrial property rights (including patents, industrial designs, utility models, etc.).
 - (f) *Regulations*: These regulations on industrial and intellectual property rights at the UPC.
 - (g) *Work*: Results that are protectable by intellectual property rights (including but not limited to software).

- (h) *Collective work*: A work created on the initiative and under the coordination of a natural or legal person who publishes and disseminates it under their name, consisting of a compilation of individual contributions by various authors, integrated in a single, autonomous creation for which they were conceived in such a way that it is not possible to ascribe to any one of the authors a separate right in the work as a whole.
- (i) *UPC staff*: UPC teaching and research staff and administrative and service staff.
- (j) *Seconded staff*: Teaching and research staff who carry out research activities at another centre or entity within the framework of a secondment agreement.
- (k) *Teaching and research staff*: Staff groups listed in Article 195 of the UPC Statutes.
- (l) *Administrative and service staff*: Staff defined in Article 213 of the UPC Statutes.
- (m) *SGI*: The Innovation Management Service, or the unit responsible for protecting and managing results obtained in UPC research.
- (n) *University, UPC*: Universitat Politècnica de Catalunya.
- (o) *Financial returns*: The difference between the gross income obtained by the UPC from the commercial exploitation of results and any costs borne by the UPC, through the SGI, that are attributable to the protection, management, valorisation and transfer of the results (including, by way of example and without limitation, costs related to the services of intermediaries, lawyers and industrial and intellectual property agents).
- (p) *Result*: Technology, knowledge, know-how, processes and creations that have been generated within the framework of the academic, teaching and research activities of the UPC.

PART II. OWNERSHIP OF RESULTS

3. Ownership of results generated by UPC staff

- 3.1. **Moral rights.** The UPC shall respect the right of UPC staff to be recognised as the inventors or authors, as the case may be, of the inventions and works they have developed, in accordance with the provisions of current industrial and intellectual property regulations, and without prejudice to the system established below.
- 3.2. **Rights of exploitation.** Ownership and exploitation rights in results obtained by UPC staff as a result of their academic, teaching or research duties at the University shall vest in the UPC. In particular, the following system shall apply for results that are protectable by an industrial or intellectual property right:

- 3.2.1. **Inventions.** Ownership and exploitation rights in inventions made by UPC staff shall vest in the UPC, in accordance with the terms set out in current regulations on industrial property.
- 3.2.2. **Works.** The authorship of works created as a result of the academic, teaching or research activities that they carry out at the UPC shall vest in UPC staff, except in the specific cases provided for in Article 7. Ownership and exploitation rights in works created within the framework of the aforementioned activities shall vest in the UPC on the terms and to the extent provided for in intellectual property legislation and in contracts with teaching and research staff.

4. Ownership of results generated by UPC students

- 4.1. **Moral rights and rights of exploitation.** Authorship and exploitation rights in any results that they obtain within the framework of an academic activity shall vest in UPC students, in accordance with the provisions of current legislation on industrial and intellectual property and without prejudice to the system established below.
 - 4.1.1. **Inventions.** Ownership and exploitation rights in any inventions that they have developed within the framework of an academic activity shall vest in UPC students. In the case of inventions made jointly by UPC students and UPC staff, ownership and exploitation rights in the invention shall vest in UPC students and the University in proportion to the significant and original intellectual contribution that each of the inventors has made to their development. In both cases, the UPC reserves the right to use the inventions for academic, teaching and research activities. However, the inventor may revoke this right at any time by submitting a written request to the UPC, in which they must set out reasonable grounds for deciding to revoke this right.
 - 4.1.2. **Works.** Authorship, ownership and exploitation rights in any works that they have developed within the framework of an academic activity shall vest in UPC students. In the case of works resulting from work carried out jointly by UPC students and UPC staff, authorship shall vest in both UPC students and UPC staff, and exploitation rights shall vest in UPC students and the University in proportion to the significant and original intellectual contribution that each of the authors has made to their development. In both cases, the UPC reserves the right to use the work for academic, teaching and research activities. However, the author may revoke this right at any time by submitting a written request to the UPC, in which they must set out reasonable grounds for deciding to revoke this right.
- 4.2. UPC students and the University may agree the transfer of exploitation rights over results obtained by students to the UPC so that the University can assume responsibility for taking steps related to the protection and exploitation of the results. In this case, the UPC student(s) and the University shall sign a transfer agreement in which the compensation to be paid to the UPC student(s) shall be stipulated.

- 4.3. In the case of co-ownership by UPC students and the University, both parties shall sign a co-ownership agreement, which must stipulate the system for protecting and exploiting the results, and the rights and obligations of each party, taking into account their contribution to obtaining the results.

5. Results generated by seconded staff

In the case of results obtained by seconded staff within the framework of research activities carried out at the entity to which they are seconded, in the corresponding secondment agreement, the UPC and the entity concerned shall stipulate the rules that will apply with respect to recognition of authorship and attribution of rights over the results, the system for protecting and exploiting the results, and how any income from exploitation of the results will be distributed.

6. Ownership of results obtained through research activity carried out in collaboration with or on behalf of third parties

- 6.1. When, within the framework of their activity at the UPC, members of the university community carry out a research project in collaboration with or on behalf of a third party, regardless of the branch of knowledge, an R&D collaboration agreement or a contract commissioning scientific, technical or artistic work, or technical support services, as the case may be, shall be entered into beforehand, under the terms set out in the applicable UPC internal regulations.
- 6.2. The system that will apply with respect to ownership of rights over results obtained within the framework of the relevant agreement or contract, and the distribution of exploitation rights derived from the results, shall be provided for in the agreement or contract.
- 6.3. In the performance of such activities and the negotiation of agreements or contracts, any rights of the UPC under these regulations must be respected.

7. Ownership of results in specific cases

- 7.1. *Computer programs (software)*. When the work developed by UPC staff in the performance of their academic, teaching or research duties at the UPC is a computer program, ownership and exploitation rights in the result shall vest exclusively in the UPC. In any event, the moral rights of the author(s) shall be recognised.
- 7.2. *Collective works*. When the UPC publishes and disseminates a collective work under its name, it shall identify the UPC staff involved, and UPC students if applicable, as authors. In any event, exploitation rights in the collective work shall vest in the UPC.
- 7.3. *Databases*. By reason of the selection or arrangement of their contents, databases are deemed to constitute intellectual creations. Pursuant to the applicable regulations, ownership and exploitation rights in databases developed by UPC staff in the performance of their academic, teaching or research activities at the UPC shall vest in the UPC (without prejudice to any rights over the contents of databases that may subsist), except in cases where due to the nature of a database

the Intellectual Property Law provides otherwise. Databases must comply with any applicable regulations on the protection of personal data.

- 7.4. *Doctoral theses.* The authorship of a doctoral thesis vests in the doctoral student who wrote it. Pursuant to Royal Decree 99/2011, of 28 January, which regulates official doctoral courses, when a doctoral thesis has been awarded a passing mark, it is published by the UPC in digital format, with open access, in an institutional repository. The author may only object to this publication in the exceptional circumstances provided for in the applicable regulations.

If a new result has been developed in the course of completing a doctoral thesis, the exploitation rights in that result shall vest in the doctoral student unless UPC staff have actively contributed to its creation, in which case the UPC has a right to share in the exploitation rights in the result in proportion to the contribution that its staff have made to obtaining the result.

If a doctoral student carries out such activities within the framework of an employment relationship with the UPC, the system for results generated by UPC staff (Article 3) shall apply.

- 7.5. *Industrial doctorate students.* The agreements that the UPC enters into with collaborating companies or entities and doctoral students to carry out industrial doctorate projects at a collaborating company or entity must include express provisions on the attribution of any results that may be generated.
- 7.6. *Teaching materials.* As provided in Article 3.2.2, exploitation rights in teaching materials produced by UPC staff for teaching purposes – in particular, presentations, notes and examinations – shall vest in the UPC to the extent provided for in legislation on intellectual property, so that such materials can be used internally in academic, teaching and research activities at the UPC. In any event, the moral rights of the authors shall be respected at all times.

8. Obligation to mention the UPC

- 8.1. Unless the UPC expressly indicates otherwise, in any publication concerning a work or invention that UPC staff are involved in developing as a direct or indirect consequence of their academic, teaching or research duties at the UPC, mention shall be made of their connection to the UPC.
- 8.2. Provided that the medium in which the work is published allows for it, the following mention shall be visibly displayed on all works whose ownership vests in the UPC: “© Universitat Politècnica de Catalunya, year (...). All rights reserved.”

However, if an open access licence is granted for works whose ownership vests in the UPC, the following mention shall be clearly indicated:
“By Universitat Politècnica de Catalunya, year (...).”

PART III. NOTIFICATION PROCEDURE AND PROTECTION OF RESULTS

9. Notification and management of results obtained

- 9.1. Any member of UPC staff who develops or participates in the development of a result that may be protectable by an industrial or intellectual property right shall notify the SGI within three months of the date on which the result is obtained.
- 9.2. When a result that is protectable by an industrial property right has been obtained, failure by UPC staff to notify the SGI within the period stipulated in Article 9.1 shall result in the loss of the rights recognised in these regulations and in general industrial property legislation, in addition to any disciplinary measures that may be warranted.
- 9.3. The SGI may be notified directly by the person concerned or through the relevant department, research group, chair or centre. The notification must include all of the documentation and information concerning the result that the UPC may require to initiate procedures for obtaining legal protection for the result if the University deems it appropriate to do so.
- 9.4. The SGI shall make available a form, which may be in electronic form, for submitting notification that a result has been obtained. On this form, it must be possible to include all of the information and documentation necessary to initiate steps for assessing the possibility of obtaining legal protection for the result. UPC staff shall use this form to comply with the obligation to notify established in Article 9.1.
- 9.5. If the information or documentation provided by UPC staff is not sufficient to adequately assess the result or initiate legal protection procedures, the SGI may request that the UPC staff provide the information or documentation necessary to complete the notification, and the UPC staff shall cooperate as provided in Article 11.
- 9.6. Within three months of receiving the notification, or the information and documentation required in accordance with Article 9.5, the SGI shall notify the authors or inventors as to whether or not it wishes to maintain its rights over the result in accordance with applicable intellectual or industrial property legislation, or whether it deems the result to be a trade secret, reserving the right of exclusive use. If the UPC does not give notification of its intention to maintain its rights over the result within the period stipulated, the authors or inventors may file a patent application.
- 9.7. Results arising from collaborative projects or projects commissioned by third parties shall be protected in a manner that is in accordance with Article 6.

10. Transfer of rights over results

- 10.1. In the event that the UPC is not interested in maintaining its ownership of or exploiting any title of protection or international extension of an industrial or intellectual property right over a result, or in moving forward with an application to establish such rights, it shall notify the inventors or authors that this is the case.

- 10.2. If the inventors or authors are interested, the UPC may transfer ownership of the aforementioned rights to them and reserve a non-exclusive, non-transferable free exploitation licence or a share in any Profits obtained from the exploitation of the results.
- 10.3. In any event, the UPC shall reserve the right to use research results for non-commercial purposes under a non-exclusive, non-transferable free licence that authorises their use for academic, teaching and research activities.
- 10.4. The UPC may establish such mechanisms as it deems appropriate to recover or offset costs incurred in relation to the study, commercialisation, application, processing and maintenance of the relevant industrial and intellectual property title.
- 10.5. In the event that the UPC has entered into a contract with a third party in which that party is granted a preferential right to assume ownership of any results that are renounced or abandoned by the University, the provisions of that contract shall apply.

11. Collaboration of authors and inventors

- 11.1. The members of the UPC university community who have developed a result shall collaborate with the UPC in any way necessary for the University to obtain adequate protection for the results and in their transfer if applicable.
- 11.2. The obligation to collaborate includes an obligation to sign any public or private documents required before any national or foreign office competent in intellectual and industrial property matters (including, but not limited to, patent and trademark offices, intellectual property registries, etc.) so that the UPC, as well as the authors or inventors, are registered as or become, as the case may be, holders of any intellectual or industrial property rights in the result to which they are entitled and are able to exercise their rights as such.
- 11.3. UPC students who have concluded an agreement with the University to transfer the exploitation rights in a result to the UPC so that the latter may take the steps required for its protection and exploitation, in accordance with Article 4.2 above, shall be subject to the same obligation of collaboration provided for in this article.

12. Administrative management of results

- 12.1. In the event that the UPC agrees to initiate procedures to obtain protection for results, the steps required shall be carried out by the SGI, which may engage external professionals to assist in carrying out the work involved.
- 12.2. Protection of results arising from projects carried out in collaboration with other public or private entities shall be managed in accordance with the relevant provisions of the agreement or contract that applies in each case.
- 12.3. The SGI shall keep a register in which all applications, transfers or waivers related to any result or any intellectual or industrial property title for a result shall be recorded.

In the event that the UPC does not own a result for the reasons set out in Article 10 of these regulations, the authors or inventors, depending on the title of the result for which they file an application for protection or registration (and provided that they are members of the university community), shall send a copy of the application to the SGI and keep the Service informed with respect to its status and the granting of the right sought or the recording of the registration.

13. Confidentiality and disclosure of results

- 13.1. Members of the UPC university community and any other persons participating in academic, teaching and research activities at the UPC shall treat information related to any research carried out within the framework of the UPC as confidential and take steps to ensure its confidentiality with a view to preserving the rights of the UPC and those of any third parties collaborating in such activities.
- 13.2. Once the procedure to be followed to protect results has been defined, the members of the UPC university community and, where applicable, entities or natural persons collaborating with the UPC, shall respect the time limits established by the SGI with respect to the disclosure of the results and, in order not to adversely affect their legal protection, shall undertake to refrain from any act of disclosure until the date established by the SGI. In this regard, the UPC may request that the parties sign a confidentiality agreement, which they shall sign to ensure adequate protection of the underlying rights.
- 13.3. Members of the university community, or entities or natural persons collaborating with the UPC, that wish to disseminate, or disclose publicly or to third parties, a protectable result or information about it by any means shall notify the SGI in advance. The UPC may refuse to authorise the act of dissemination or public disclosure for duly justified reasons.
- 13.4. In acts of dissemination or public disclosure by research staff, express mention shall be made of their connection to the UPC and, if applicable, of any rights in the results disseminated or disclosed that may vest in the University.
- 13.5. When research projects are carried out jointly with other entities, the UPC shall endeavour to include its policies regarding confidentiality and the dissemination of results in the agreements and contracts that govern these projects.

14. Management by entities related to or dependent on the UPC

In the event that the UPC delegates the management of results that it owns, developed within the framework of specific research projects or activities, to a related or dependent entity, the management mandate that applies must stipulate procedures and policies for managing the results that are in line with the principles defined in these regulations.

PART IV. EXPLOITATION OF RESULTS

15. Formulas for exploiting results

- 15.1. The UPC may commercially exploit the exploitation rights in the results that it owns in the manner it deems most appropriate to fulfil its purposes with the aim of ensuring that society has the greatest possible access to new knowledge and technologies developed within the framework of the UPC.
- 15.2. The rector of the UPC shall determine the formula for exploiting a result and the consideration that will apply for such exploitation based on proposals made by the SGI, which shall be reported to the Governing Council.
- 15.3. In the event that the UPC decides to exploit a particular result by forming a company or taking a stake in an existing company, the ownership of the results shall be specified in the corresponding technology or knowledge transfer contract. In any event, the status of UPC staff, or UPC students if applicable, as inventors or authors shall be respected. In this case, the transfer procedure established in the regulations governing authorisation to provide services in commercial companies in which the UPC has a stake shall be followed.

16. Distribution of financial returns

- 16.1. As a general rule, any financial returns from the commercial exploitation of results owned by the UPC shall be distributed as follows:
 - (a) Fifty percent (50%) for the UPC staff who are the inventors or authors of the result.
 - (b) Twenty-five percent (25%) for the UPC, which shall allocate half of this percentage share to funding research protection activities.
 - (c) Twenty-five percent (25%) for the research group involved, or alternatively, the structural unit to which the UPC staff member who is the inventor or author belongs.
- 16.2. If there is more than one author or inventor, the UPC shall distribute any financial returns to UPC staff in proportion to the percentage contribution of each inventor or author as reported on the form provided for in Article 9.4 or in the proportion stipulated in any court or arbitral decision.
- 16.3. Financial returns due to UPC staff shall be paid to them together with their salary payment. Authors and inventors who are not contractual or statutory staff of the UPC shall be paid using the mechanism stipulated in applicable regulations. In all cases, tax withholdings shall be applied in accordance with tax regulations in force.
- 16.4. The distribution of financial returns derived from results developed within the framework of collaboration agreements regulated by Article 6, or through collaboration with external researchers in a personal capacity, shall be contractually stipulated before the parties involved in the project commence their collaboration. The UPC shall distribute its share of financial returns in accordance with the rules set out in this article.

REPEALING PROVISION

The following internal UPC regulations are hereby repealed with effect from the entry into force of these regulations:

- (i) The Regulations on Intellectual and Industrial Property Rights at the UPC, approved in Governing Council Decision 137/2008, of 2 October 2008, with the exception of Article 8 (“Exploitation of industrial and/or intellectual property rights in inventions or creations”), which shall remain in force exclusively for results obtained until the date on which Article 16 of these regulations comes into force (stipulated in the Final Provision).
- (ii) The proposal for distribution of royalties derived from technology transfer contracts between the UPC and spin-offs, approved in Governing Council Decision 108/2009, of 26 May 2009.
- (iii) The criteria for applying the Regulations on Intellectual and Industrial Property Rights at the UPC to works submitted for the award of a degree (final, bachelor’s and master’s theses, among others), approved in Governing Council Decision 136/2012.

TRANSITIONAL PROVISION

The rights and duties recognised herein shall apply to all results obtained following the entry into force of these regulations from the date of their entry into force.

The UPC shall endeavour to bring all existing contracts entered into in connection with its activities, such as contracts with its staff and agreements in force with other public or private entities, into line with the provisions of these regulations in the shortest possible time.

FINAL PROVISION

These regulations shall enter into force the day after their approval by the Governing Council of the UPC, with the exception of Article 16, which shall enter into force the day after its approval by the UPC Board of Trustees.