

# INTELLECTUAL PROPERTY POLICY



This document sets out the policy governing the University's ownership of intellectual property.

<b>Version</b>	1.1
<b>Executive Sponsor</b>	Executive Director of Business Engagement
<b>Officer Responsible for Policy/ Procedures</b>	Director of Knowledge Exchange / General Counsel
<b>Consultation Process</b>	RKE
<b>Date of Approval and Committee and/or Executive Officer</b>	Executive Operations Group Executive
<b>Effective Date</b>	1 June 2018

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# 1. INTRODUCTION AND CONTEXT

## 1.1 Purpose and scope of the Policy

This Policy sets out the University's ownership of Intellectual Property (IP) and the steps that must be taken to identify and secure this important asset.

The scope of this Policy is necessarily broad, both in what it covers (Section 3 'Potentially Exploitable Intellectual Property') and to whom it applies (Section 4 'Creators' and Section 8 'Creators', other Employees and Associates).

## 1.2 Breach of this Policy

Any breach of this Policy will be investigated and steps taken in accordance with the relevant disciplinary Policy.

## 1.3 Policy Ownership

The Executive has approved this Policy, the Executive Director of Business Engagement is the Executive sponsor. Unless otherwise stated, the Director of Knowledge Exchange (DoKE) and the General Counsel (GC) are jointly responsible for the Policy.

Any questions about the operation of this Policy or any concerns that the Policy has not been followed should be referred in the first instance to the officer set out below:

Section	Title	Officer responsible
1	Purpose and scope of the Policy	DoKE and GC
2	The Policy Statement	DoKE and GC
3	Potentially Exploitable IP	GC
4	Creators	GC
5	Creators' Obligations	DoKE
6	Teaching Materials	GC
7	Publications	DoKE and Director of Information Resources and Research Services
8	Use of Third Party Materials	GC
9	Third Party Contractors/Commissioned Works	GC
10	Research Collaboration	DoKE
11	Glossary	GC
Appendix 1	Commercialisation	DoKE
Appendix 2	Revenue Sharing Scheme	DoKE
Appendix 3	Forms of IP	GC

## 2. THE POLICY STATEMENT

2.1 Aston University is an exempt charity and as such it has a general duty to develop, and manage its assets, including IP, to further its charitable objectives.

In addition:

- many sources of research funding require the University to pursue and report on the commercial exploitation of IP developed as a result of grants; and
- many collaboration agreements involve transfer of IP rights, requiring the University to secure those rights in order to underpin inter-institutional agreements.

2.2 The University wishes to encourage enterprise and this is reflected in its Policy of sharing the proceeds of exploitation with inventors/creators. However, this wish must be balanced against the University's charitable duties and the risk of unjustifiably enriching (or being seen to unjustifiably enrich) staff through the exploitation of the University's assets. Staff should be aware of and sensitive to the potential for (and perception of) conflicts of interest.

2.3 Many forms of IP (particularly patents, trade secrets and know how) depend on secrecy. For this reason, Employees (defined below) owe a duty of confidentiality to the University and to each other regarding PEIP. This does not contradict the University's mission to teach and disseminate knowledge, but it does mean that these activities should take place in a controlled manner.

## 3. POTENTIALLY EXPLOITABLE IP

3.1 The scope of what can be protected is broad but not continuous nor consistent, meaning there are both gaps and overlaps. The most commonly encountered forms of IP are:

- Patents
- Design rights (registered and unregistered)
- Copyright
- Know how (secrets).

Other forms exist and are included in this definition (see Section 11 'Glossary' and Appendix 3 'Forms of IP' for more detail).

3.2 The University distinguishes between IP which has the potential to be commercialised (Potentially Exploitable IP or 'PEIP'), Teaching Materials and Publications (dealt with in Sections 6 & 7 below).

3.3 PEIP includes all forms of IP, including work in progress which is intended to or may reasonably be expected to emerge into IP which is capable of exploitation. The scope is necessarily broad and includes ideas, discoveries, inventions, know-how and designs. These may be protected by patents, design rights, copyright or confidential disclosure agreements (NDA/CDAs).

3.4 Aston's Employees, students, and Associates who create PEIP, teaching materials and publications ('Creators') should keep:

- themselves informed about IP practices relevant to their industry sector, to be aware of potential Freedom to Operate (FTO) issues and identify PEIP and consider how it might be best exploited;
- proper, contemporaneous records; and
- any PEIP confidential (at least until discussed with their supervisor or the IP Hub).

## 4. CREATORS

- 4.1 This Policy applies to Employees and Associates as defined below:
- **Employees** include both academic and non-academic employees of the University, whether temporary or permanent, full or part time.
  - **Exempt students** are taught students (typically undertaking BSc and MSc courses) and self-funded research students (typically undertaking PhD courses).
  - **Non-Exempt Students** are other students (typically research students funded by the University or third parties).
  - **Associates** include visiting academics, anyone working at the University whilst on sabbatical or any form of secondment from another organisation, emeritus professors, persons on whom the University has conferred an honorary title, sessional lecturers, contractors and anyone else who is engaged in teaching, study, research or otherwise working at the University.
- 4.2 The University will automatically own IP created by Employees:
- In the course of their University duties;
  - When using University facilities; or
  - In the course of duties falling outside their normal duties, but specifically assigned to them.
- 4.3 The University will own all IP created by Associates working in the University and Non-Exempt Students even if these individuals are not Employees or otherwise contracting with the University. Associates and Non-Exempt Students will be entitled to a share of any income resulting from exploitation of the intellectual property on the same basis as Employees (i.e. in accordance with Appendix 2 'Revenue Sharing Summary').
- 4.4 Exempt Students will own the IP they create unless they are employed by the University or that IP is developed jointly with an Employee, Associate or a Non-Exempt Student. In these circumstances the IP will be owned by the University and the student will be entitled to a share of any income resulting from exploitation of the intellectual property on the same basis as Employees (i.e. in accordance with Appendix 2 'Revenue Sharing Summary').
- 4.5 For the avoidance of doubt, the University will not claim ownership of PEIP created by Exempt Students on placements. However, PEIP created while on placements will often be claimed by the Exempt Student's employer or sponsor (in line with the relevant sponsorship, placement training or employment contract).
- 4.6 Associates or Exempt Students who create independent PEIP may approach the University and offer to assign their IP for the University to manage its commercialisation in return for a share of any resulting revenues, which will be negotiated on a case by case basis.
- 4.7 When PEIP results from work carried out at both the University and another organization, the RKE will be responsible for negotiating how the ownership, rights and any resulting revenues will be managed and shared.

## 5. CREATOR'S OBLIGATIONS

- 5.1 Creators must:
- keep proper records, including lab books and notes in whatever form is agreed with their supervisor;

- maintain confidentiality regarding any PEIP they create, and in particular not publish or submit papers for publication, until the PEIP has been discussed with their supervisor or the RKE;
- inform their supervisor or RKE (email ip@aston.ac.uk) as soon as practical; and
- cooperate in completing the formalities required to register, maintain, defend and, if commercialised, license, assign or otherwise exploit PEIP they have developed. In particular they must cooperate with the patent prosecution process, including the completion of assignments and confirmatory assignments, which may be required in some jurisdictions.

## 6. TEACHING MATERIALS

- 6.1 This Policy applies to Commissioned Teaching Materials and Excluded Teaching Materials as defined below:
- **Commissioned Teaching Materials** are those where the University has specifically employed or requested a person (in return for payment or not) to produce teaching materials including lecture notes and preparatory materials; handouts, reading lists or other information to be provided to students; and/or audio or visual aids, or other materials intended for the face to face teaching of students.
  - **Excluded Teaching Materials** are similar materials which a person has generated without being specifically employed or requested (in return for payment or not) to produce.
- 6.2 The University will own the copyright in Commissioned Teaching Materials.
- 6.3 The University will not claim ownership of the copyright in Excluded Teaching Materials, but the Creators will grant the University a perpetual, irrevocable, non-exclusive, royalty-free licence to use such materials.
- 6.4 The Creator will own the Excluded Teaching Materials and be free to use them as they please, provided that:
- such use is not prohibited by his or her terms and conditions of employment; and
  - all references to Aston University and its brand, logos and other distinguishing marks are removed when any Excluded Teaching Materials are used outside the University (unless otherwise agreed in advance in writing).
- 6.5 The University records certain lectures and training sessions to enhance the student experience. The University does not believe that the delivery of the recorded lectures and training sessions by academics are "performances" for the purposes of law and therefore ownership in the recorded lectures and training sessions, broadcast rights and copyright in the arrangement, format, layout and compilation of any audio, visual or multimedia work in Commissioned or Excluded Teaching Materials are owned by the University.
- 6.6 Employees will not be entitled to a share of any income resulting from the exploitation of teaching materials, recorded lectures and training sessions.
- 6.7 Unless the University has specifically employed or requested a person (in return for payment or not) to produce any of the following, they will be regarded as excluded materials: Artistic works, Text or artwork for publication in books, Plays, Theses and dissertations, Lyrics; and Musical scores.

## 7. PUBLICATIONS

- 7.1 The University operates in accordance with the UKSCL and therefore each Employee grants to the University a non-exclusive, irrevocable, sub-licensable, worldwide licence (Creative Commons Attribution Non- Commercial v4 (CC BY NC) licence) to publish his or her Articles. Articles means all scholarly articles, conference proceedings and similar outputs authored or co-authored while the person is an Employee including any third party content.
- 7.2 Each Employee will provide an electronic copy of the accepted manuscript of each Article to the Director of Information Resources and Research Services (DIRRRS):
- no later than 90 days after acceptance for publication;
  - at no charge and in PDF format; and
  - as applicable, will notify the DIRRRS if any rights or permissions are required from any third party.
- 7.3 Following notification from the Employee, the DIRRRS will give consideration to the Article including whether it would be embargoed for any period of time.
- 7.4 Where an Article is co-authored, the Employee will use their best efforts to obtain a licence to the University from the co-authors on the same terms as the UKSCL.
- 7.5 The University automatically sub-licenses the rights granted to it under this Policy to all co-authors and their host institutions, on condition that if the said co-authors and/or host institutions make a co-authored scholarly article publicly available, they will do so on the UKSCL. Consequently, the relevant Employee is not required to seek permission from co-authors employed by institutions that have adopted the UKSCL or other policies that give institutions and/or authors the same or substantially similar rights and obligations.

## 8. USE OF THIRD PARTY MATERIALS

- 8.1 Creators (and all other Employees and Associates) must respect, and must not knowingly or recklessly do anything which would infringe, IP which belongs to any third parties.
- 8.2 Original third party materials, including books, journal articles, newspapers, photographs, graphics, diagrams, sound recordings, films, television and radio broadcasts, music and software are usually protected by copyright.
- 8.3 It is an infringement of copyright in a work to copy the whole or a substantial part of the work, whether manually, electronically or otherwise, without authorisation or licence from the copyright owner. Substantial is measured by reference to quality and therefore copying of even a small part could be an infringement. This is the case even if the work is freely accessible and available in the public domain, including online, unless a licence is clearly provided and the proposed activities fall with the scope of the licence.
- 8.4 Before a Creator (or any other Employee or Associate) copies or uses any third party materials, they should:
- Identify whether the work could be protected by copyright. This is likely to be the case unless the work is sufficiently old that copyright has expired.
  - Identify who might own the copyright.
  - Ensure that the Creator (or relevant Employee or Associate) is allowed to copy or use the materials before doing so. In the majority of cases third party materials can only legitimately be used if one of the following circumstances applies:

- a) The intended use is permitted by the terms of a blanket copyright licence which the University has in place (e.g. a Copyright Licensing Agency (CLA) licence or an Educational Recording Agency (ERA) licence).
- b) The Creator has sufficient permission from the copyright owner and this permission must extend to cover all intended uses of the copyright work; and/or
- c) The use being made of the materials falls within one of the specific circumstances which allow limited use of copyright works without the permission of the owner e.g. the "illustration for instruction" educational exemption\*, in which case the Creator must document the assessment.

8.5 The "illustration for instruction" fair dealing exception allows copying of third party materials in any medium as long as certain conditions apply. The use of third party materials will only fall within this exemption if the following conditions apply:

- the use of the materials must be "fair". In order for the use to be fair the materials must be included to illustrate a teaching point and only so much of the copyright materials can be used as is necessary. Any use of copyright materials which would adversely affect a copyright owner's ability to exploit their work and/or undermine the sales of teaching materials would not be classed as "fair";
- the third party materials must be used by a person giving or receiving instruction and solely to illustrate a point;
- the use of the materials must not be for commercial purposes; and
- the use must be accompanied by a sufficient acknowledgement (i.e. by crediting the original author/copyright owner on slides and/or handouts) unless it would be impractical to do so (e.g. where part of a question is for students to identify the source of an extract, it would be impractical to acknowledge the source).

8.6 If in doubt, Creators should ensure they have express permission to copy and use the materials in the manner proposed or should not include them. For further information on exceptions to copyright see: [Exceptions to copyright - GOV.UK \(www.gov.uk\)](http://www.gov.uk).

## 9. THIRD PARTY CONTRACTORS/COMMISSIONED WORKS

9.1 An area where the ownership of IP is often misunderstood relates to commissioned works. Copyright in a commissioned work belongs to the author of the work, in the absence of an express or implied term/agreement to the contrary. Therefore, any copyright works created by independent contractors, service providers or third party agencies will belong to the authors of the works regardless of the fact the University may have arranged for and paid for the works to be produced.

9.2 When engaging third party contractors or service providers, University Employees and Associates must ensure that the third party shall provide to the University:

- an irrevocable royalty-free non-exclusive worldwide licence to the University to use and sublicense use of the third party's existing ("background") IP in perpetuity for the purposes of the project in which they are engaged and the exploitation of its results; and
- an Assignment to the University of IP generated by the third party in the course of their work for the University.

9.3 Any exception to the requirements of this section 9 would require formal written approval in advance from the GC (or their nominee).



## 10. RESEARCH COLLABORATION

- 10.1 Please refer to the RKE for all matters relating to research collaboration in accordance with the Pre-Award Workflow for Competitive Research Funding and Research-Related Funding.
- 10.2 Research Collaboration agreements as well as providing for ownership and use of IP, should include rights for the University to publish the results and related information for academic and non-commercial research purposes, although a consultation period may be required and publication delayed to allow the IP in the Results to be protected.

## 11. GLOSSARY

**Assignment** means transfer of ownership. Note that all rights can effectively be transferred by means of an exclusive licence (depending on its terms), meaning that sometimes the only practical difference with an assignment is the associated responsibility to pay renewal fees and the potential withdrawal of such rights if the licence conditions are breached.

**Commercialisation** means the process of translating an idea or invention into a product or service that creates value or for which customers will pay.

**Freedom to Operate (FTO)** means the ability to sell a product or service without infringing the patent rights of another party in a particular jurisdiction.

**Intellectual Property (IP) and Intellectual Property Rights (IPR)** IP rights can protect the expression of ideas, the creation of a brand and/or the development of technology and may have commercial value. Depending on the nature of the IP rights, creators may benefit from certain exclusive rights to prevent others using their IP rights without permission. IP rights include patents, utility models, rights to inventions, copyright, registered designs, unregistered designs, moral rights, trade marks, service marks, business names, domain names, rights in get up and trade dress, goodwill, rights in designs, rights in computer software, database rights, confidential information. Further information is set out in Appendix 32.

**Licence/License** means to give formal permission to a licensee to do something that the licensor is in a position to legally prevent, usually in return for a royalty. Licences may be exclusive (allowing only the licensee to exercise the rights in question), sole, (allowing only the licensee and the licensor to exercise the rights in question) or non-exclusive. Each of the above kinds of licence may be limited by parameters such as geography, application, market segment or industry. Sublicensing rights may be permitted, forbidden or subject to further conditions. In common with other Universities, Aston prefers to license technologies (to either spin-outs or third parties).

**RKE** means Research & Knowledge Exchange – Aston's research support and knowledge exchange department.

**Royalties** means Payments made in consideration of a licence. Often include an up-front payment, then a fixed periodic amount, payments related to units made or sold, or a percentage of revenues or profits.

**UKSCL** means the UK Scholarly Communications Licence.

# APPENDIX 1 - COMMERCIALISATION

## 1. Objectives of commercialisation

The University actively supports the use of the results of its research and IP in order to:

- a. Maximise Impact, "Impact" being the effect on, change or benefit to the economy, society, culture, public policy or services, health, the environment or quality of life, beyond academia
- b. Build and protect its reputation
- c. Maximise financial returns

The University does not prioritize the maximization of financial returns where this could compromise the Impact of the University's research and/or IP or damage its reputation.

The commercialisation of IP can be undertaken through several different mechanisms, such as collaborations, licensing of IP to existing companies/entities, or the formation of a new company (a "spin-out" company) from the University.

## 2. Consultation

The University will consult with Creators about the best way to exploit IP that they have created, but reserves the right to pursue commercialisation (or not) in line with its objectives and taking into account risk and budgetary constraints.

When considering the commercialisation of IP, although the interests of the University and Creators will often coincide, Creators may wish to seek independent advice, at their own cost.

## 3. Evaluation

The University will support the development and commercialisation of technologies on an incremental, contingent basis. Opportunities will be evaluated on an ongoing basis by the RKE.

## 4. Process

The path to commercialisation includes the following steps:

- a. Initial discussions
- b. Technology Disclosure
- c. Opportunity Appraisal which may involve the review of the following 5 key areas:
  - i. Patentability (including due diligence to ensure clarity of IP ownership and prior art review)
  - ii. Market Opportunity (e.g. potential customers and target markets)
  - iii. The role of the Creators
  - iv. Technology Development Needs
  - v. Reputation/Impact
- d. IP Protection
- e. Commercialisation (via spin-out, licensing or other means)

f. Revenue &/or portfolio management

The internal processes underpinning these steps are documented in the University's Opportunity Appraisal procedure maintained by RKE.

**5. Return of IP to Creators**

Where the University decides not to pursue the commercialisation of a technology it may, at its sole discretion, offer to license or assign the IP in that technology to the Creator.

**6. Conflicts of interest**

Conflicts of interest relating to the exploitation of IP must be identified and noted

Transactions relating to IP must be conducted at 'arm's length'. The University must take account of the potential value of the IP in all transactions, whether with third parties or with members of staff.

Transactions with trustees (in Aston's case independent members of Council) must be reported in the University's audited accounts as 'related party transactions involving trustees.'

**7. Governance of spin-outs**

In order for the University to consider supporting the formation of a spin-out company the University must be provided with:

- A viable business plan
- An identified route to investment
- Proposed IP licensing terms
- Acceptance/undertaking of appropriate conflict of interest and commitment training provided by the University.

The University will usually appoint directors and/or observers to the boards of spin-out companies. These will be nominated from a pool of those having completed satisfactory training.

Spin-out companies are independent legal entities, controlled by their directors on behalf of their shareholders.

Creators may be shareholders in spin-out companies as a consequence of investing or being offered equity. They may also act as directors, employees of, and/or consultants to a spin-out if agreed with the University, but are not required to do so.

Joining a spin-out in an executive role is a significant commitment and should not be undertaken lightly. An ongoing executive role in a spinout is very likely to be incompatible with an ongoing full-time role at the University.

If the University gives approval for a spin-out company to be formed to commercialise IP owned by the University, as part of the consideration for the commercialisation of the University's IP, and the University's support towards the formation of the spin-out company, the University will normally receive an equity investment of a percentage to be specified by the University. The University will not provide any further consideration/make any payment to the spin-out company for the shares in the spin-out company.

The University's decision regarding its initial equity allocation will take into account factors such as:

- the nature of the IP being licensed to the spin-out company by the University;
- the role of the University in the development of the relevant technology;

- the role of the Creators in the development of the technology and the role they are anticipated to have in the spin-out company;
- the number of Creators;
- proposals for the management of the spin-out company;
- the level of support to be provided by the University to the spin-out company;
- any other relevant factors e.g. any rights of funding bodies, other institutions or third parties.

Table 1 below sets out examples of the different equity levels that may be agreed and the nature of the support the University may provide in each case to the point where the spin-out can raise investment. The University will make the final decision with regard to its level of equity holding on a case by case basis taking account of the factors specified above. Once the spin-out company raises investment additional shares may then be allocated to include recognition of contributions by third parties to reach this point.

Where there is more than one Creator, the Creators' initial shareholding will be sub-divided amongst them in equal proportions, subject to any contrary written agreement between all of the Creators, which must be notified in writing to the University.

Following the incorporation of the approved spin-out company, the University will license the spin-out company the IP owned by the University and relating to the technology to be commercialised by the spin-out company. The University is likely to require royalty payments under the licence of the IP as well as an equity stake in the spin-out company to ensure a fair return to the University for the value of the IP in the success of the spin-out company, ensuring a share of value on an exit and of revenues received. Royalties associated with the licensing of the IP to a spin-out company will be dealt with in accordance with Appendix 2 Table 2 below.

The University will not assign the IP to a spin-out company until certain milestones, including those specified in the business plan, have been met and the University can be confident that the spin-out company is sustainable.

For the avoidance of doubt the support services referred to in Table 1 will only be provided in connection with the initial set up of the spin-out company.

**Table 1: University Equity Ownership and Support to be provided to spin-outs in connection with the setting up of the spin out company**

Support Service	50% University Equity Ownership	20% University Equity Ownership
Intellectual Property	<p>Pay IP registration (e.g. patent) costs beyond seed fundraising round with reimbursement occurring at IP Assignment or as otherwise appropriate on a case by case basis.</p> <p>Assist with prior art searches.</p> <p>Liaise with patent attorneys regarding patent filing.</p> <p>Assist with documents required for patent filing.</p> <p>Manage patent documentation and payments.</p> <p>Manage patent prosecution process.</p>	<p>Pay IP registration (e.g. patent) costs until licensing of IP to spin-out.</p> <p>Assist with prior art searches.</p> <p>Liaise with patent attorneys regarding patent filing.</p> <p>Assist with documents required for patent filing.</p> <p>Manage patent documentation and payments.</p> <p>Manage patent prosecution process.</p>
Financial Investment	May include, by way of example, convertible loan.	Not Applicable.
Access to Facilities	Assistance in resourcing access to business space and digital infrastructure facilities, but Company shall be responsible for the costs of such space and facilities. Company shall not be entitled to use the University's address as its registered office address without written authorisation from the Office of the General Counsel.	Company responsible for resourcing and costs of business space and digital infrastructure and other facilities.
Executive Appointments and Resources	<p>University representative on the Company's Board of Directors as a non-executive director.</p> <p>Senior University staff time contributing a non-director role to the spin-out company.</p>	University representative on the Company's Board of Directors as an observer.
Templates	University may provide template Heads of Terms for the Articles and the Shareholders' Agreement for the Company for discussion and education of spin-out directors, but only on the understanding that these do not constitute legal advice.	University may provide template Heads of Terms for the Articles and the Shareholders' Agreement for the Company for discussion and education of spin-out directors, but only on the understanding that these do not constitute legal advice.

Support Service	50% University Equity Ownership	20% University Equity Ownership
Administrative and Professional Services Support	<p>Advise on practicalities of company formation (e.g. directors' liabilities etc.).</p> <p>Help open bank accounts.</p> <p>Help arrange initial insurance, at the Company's cost.</p> <p>In addition to paying its own legal costs in connection with the incorporation of the Company the University will pay:</p> <p>the Company's reasonable external legal costs for the preparation of legal agreements connected with the initial incorporation of the Company, including the preparation of standard Articles of Association; and</p> <p>the company's reasonable external accountancy costs</p> <p>provided that in each case the University shall nominate and approve the legal and accountancy professionals to provide such support and that their fees are approved in advance and in writing by the University.</p>	<p>Advise on practicalities of company formation (e.g. directors' liabilities etc.).</p> <p>Company responsible for arranging and paying for all professional services support.</p>
Business Plans	University funds development of Company's business plan (based on Company's initial viable business plan referred to above) to a cost cap specified by the University.	Business plan developed and funded by Company and reviewed by University.
Preparing for Funding	<p>Provide support in completing initial grant funding applications.</p> <p>Assist with introductions and discussions with potential future investors.</p> <p>Support writing of applications for Innovate grants.</p> <p>Review of capitalisation tables.</p> <p>Review of grant term sheets.</p>	<p>Provide support in completing initial grant funding applications.</p> <p>Assist with introductions and discussions with potential future investors.</p>

## APPENDIX 2 – REVENUE SHARING SUMMARY

Where IP is licensed to an existing company/entity or a spin-out company and Royalties are received by the University, the allocation of net revenues shall be determined by the following table:

**Table 2**

Net revenue <sup>1</sup>	Allocated to creators <sup>2</sup>	Allocated to the University
First £25,000	100%	-
Next £50,000	65%	35%
Above £75,000	50%	50%

<sup>1</sup> Depending on the terms of a licence, deductions may be made to cover patent costs before Royalties are paid to Creators.

<sup>2</sup> Allocated to all Creators together. The University may deduct tax and NI obligations on payments.

## APPENDIX 3 – FORMS OF IP

The information set out in this Appendix 3 is not an exhaustive list. Further, protection may vary by jurisdiction.

### 1. Copyright

Covers literary, dramatic, musical and artistic works. The works must be original and the intellectual creation of the author (a low hurdle). Ownership of copyright usually belongs to the author, unless the work was created in the course of employment. Copyright comprises separable moral and economic rights.

### 2. Confidential information

Trade secrets are protected by common law and the Trade Secrets Regulations (SI 2018/597).

Breach of confidence in the UK requires the following elements to be present:

- The information must have a quality of confidence to it.
- There must have been an obligation of confidence- express or implied
- There must have been an unauthorised use of the information

Confidential information and trade secrets can be better protected by putting in place Confidential Disclosure Agreements (CDAs, also known as Non-Disclosure Agreements or NDAs) with third parties prior to disclosure of the information, which make the obligation of confidentiality contractual.

### 3. Database right

A sui generis right applying to a collection of independent works, data or other materials depending on a substantial investment of resources in the collection, verification or presentation of the contents. Database rights that existed in the UK and EEA before 1 January 2021 will continue to exist in the UK and EEA for the rest of the relevant rights' duration. Database rights arising in the UK after 1 January 2021 will benefit from a UK sui generis database right but will not be able to rely on the protection of database rights in the EEA.

### 4. Design right

Protects the form of a design (but must be style only - not a functional requirement). In the UK the following forms of design right may apply:

- UK registered design
- UK unregistered design right

Designs which benefited from design rights in the EEA prior to 1 January 2021 may also be protected by the following design rights:

- Continuing unregistered designs (derived from unregistered Community designs)
- Re-registered designs (derived from registered Community designs)
- Supplementary unregistered designs (intended to mimic the protection afforded by unregistered Community designs).

In addition protection of a design might be obtained under trade mark and copyright law



**5. Passing off**

An attempt by a trader to take advantage of the goodwill (positive reputation) established by a second trader by misrepresentation, causing actual or likely damage to the interests of the second trader. Passing off is a form of tort (a civil wrongdoing, not including a breach of contract, for which damages may be claimed by the injured party).

**6. Patents**

The most powerful and expensive form of IP protection, giving exclusive rights to manufacture, use, sell, import or otherwise exploit an invention, which must be novel, inventive and capable of industrial application. The invention must be kept secret before application.

**7. Plant breeders' rights**

Rights can be obtained for new plant varieties, including genetically modified varieties.

New varieties must be:

- distinct – have different characteristics to other plants of the same species
- uniform – all plants in the variety must share the same characteristics
- stable – it remains unchanged after 'repeated propagation', eg reproduction from seeds, cuttings, bulbs or other plant parts.

Registration is obtained from the Plant Variety Rights and Seeds Office (PVS).

**8. Semiconductor mask work right**

In the US "mask work" (the two or three-dimensional layout of an integrated circuit) is protected by the Semiconductor Chip Protection Act of 1984 (SCPA) via registration with the US Copyright Office. In the UK a semiconductor topography right (introduced by the Design Right (Semiconductor Topographies) Regulations 1989 (as amended) is an additional right to unregistered design law, intended to protect the electronic circuit board and the arrangement of semiconductors.

**9. Trade Marks (registered)**

A mark may only be registered if it is distinctive and can be represented in a clear and precise manner. Plain words (word marks), symbols and stylized text (logo text) may be protected.

**10. Trade Marks (unregistered)**

Some rights accumulate from use, even if not registered (see passing off). However, achieving and then proving the required reputation can be onerous.

**11. Utility models**

A form of lesser patent, obtainable in some jurisdictions (not including the UK) offering more limited rights but for lower cost and complexity in filing.



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