



National
College *of*
Ireland

INTELLECTUAL PROPERTY POLICY AND PROCEDURES

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1. Introduction

As part of the National College of Ireland’s Institutional Strategy, it has committed to ‘developing an active research and enterprise culture which supports the growth and development of Ireland’s knowledge economy’. The College is aware of national objectives for research and wishes to play a full part in helping to achieve these while recognising the important role that research has to play in informing the teaching and learning strategy of the institution.

Appendix 11 describes a summary of the IP principles as approved by the NCI executive board in conjunction with solicitors at Gallen Alliance.

As a small institution at the early stages of research development, NCI has a number of strengths both in terms of its flexibility due to its relatively small number of staff and its ability to create true multi-disciplinary teams to address issues of academic and national interest.

Research at National College of Ireland is regarded as a core activity which is embedded in the academic culture and which contributes to the overall mission of the College. The vision for research at the National College of Ireland is one which sees it as contributing to the realisation of Ireland’s full potential as a knowledge-based economy. The delivery on this vision is through the development of a number of research active clusters. In doing so the Research Strategy is directly linked to and informs the Teaching and Learning and the Knowledge Transfer Strategies. The College is also committed to ensuring that learners from a diversity of backgrounds have access to education, at all

levels including postgraduate research opportunities. The new Institutional Strategy reflects this commitment.

This document contains the updated policy and procedures relating to NCI's intellectual property. In accordance with accepted International Best Practice, it sets out the policy and rules that govern the creation, ownership and commercialisation of intellectual property developed by NCI staff, students and others participating in educational programmes carried out for NCI or undertaken using NCI facilities, know-how, confidential information or intellectual property. This policy does not apply to companies that use NCI facilities on a commercial basis for example a company that uses the usability lab using Enterprise Ireland innovation vouchers is exempt from this policy. The Policy is intended to actively support the commercialisation of Intellectual Property in a manner which ensures maximum benefit to society and the Irish economy, while providing significant financial reward and recognition for the creator of the intellectual property, NCI and where appropriate, the sponsor of the research.

NCI encourages the commercialisation of Intellectual Property through a support programme and a share of the resulting income to the creators of such intellectual property.

This document builds on the National College of Ireland's Research and Knowledge Transfer Strategy and the Intellectual Policy as described in the National College of Ireland's Research Strategy, 2007-2014. In addition this document strives to take account of the changes in legislation including the Copyright and Related Rights Act, 2000 and related policies such as National Codes of Practice and the Funding Agency guidelines for management and commercialisation of intellectual property (Annex VI) as follows:

- Irish Council for Science, Technology and Innovation (ICSTI) National Code of Practice for Managing Intellectual Property Arising from Publicly Funded Research, published in 2004.
- Advisory Science Council National Code of Practice for Managing and Commercialising
- Intellectual Property Arising from Public-Private Collaborative Research, published in 2005.
- Funding Agency Requirements and Guidelines for Managing Research-Generated Intellectual Property, February 2006.

2. Definitions

For the purposes of this document the following definitions apply

Intellectual Property Advisory Committee represents a sub-committee of the Research Committee.

3. Scope of Policy

The policy is applicable to NCI intellectual property that is owned by the college. The policy is applicable to NCI intellectual property that is created by NCI personnel. The policy is applicable to all schools, centres, and institutes affiliated to NCI.

Visiting lecturers, students and other personnel at NCI who have a prior existing and conflicting intellectual property arrangement with another employer or third party must enter into an agreement with the college (and their employer or relevant third party) (Appendix 3) to abide by the conditions of the policy in the course of their activities in NCI.

The college also welcomes the opportunity to consider for inclusion under this Intellectual Property Support Programme intellectual property which does not come under the definition of NCI intellectual property. In such cases the ownership of the intellectual property must be assigned to NCI.

4. Definition and Ownership

The Irish statutory provisions governing the ownership of intellectual property rights are described in Appendix 1.

As a general rule (and subject to the exceptions set out in the Policy) the rights to NCI Intellectual Property is the property of and vests solely and absolutely in NCI. NCI Intellectual Property includes any intellectual property in any materials and/or inventions created by academic, research and other NCI staff (full-time or part-time) in the course of their employment or by students in the course of their education by NCI or by consultants or others in the course of research, development, teaching, consultancy and other intellectual activity carried out for NCI. These personnel are collectively referred to as NCI personnel in this document. NCI Intellectual Property includes rights in any material, including any copyright (including rights in computer software and moral rights but subject to the exception set out below), patent, design right, trademark rights, brand rights, database rights, know how, trade secrets, confidential information, rights in design, or other intellectual property rights or other property rights, whether vested, contingent or future anywhere in the world. (A full definition of intellectual property is contained in Appendix 2). The Policy applies particularly but not exclusively to any intellectual property rights in materials and/or inventions which are created in whole or in part or caused to come into existence by NCI personnel:

- While undertaking normal or specifically assigned duties either when intellectual property could be reasonably expected to result from the carrying out of those duties and/or, at the time the intellectual property was developed, there was a special obligation on the creator of the intellectual property to further NCI's interest;
- When using NCI's equipment, supplies, facilities or NCI's Assets.
- Using NCI's confidential information, trade secrets, know how or any of the intellectual property of NCI; or
- In relation to any work performed for NCI (including pursuant to any third party funded research programmes).

Under the terms of the Copyright and Related Rights Act, 2000 NCI owns all copyright in works created by its employees in the course of their employment. In recognition of the unique position of NCI and in accordance with long-standing academic tradition, NCI does not and will not assert ownership of copyright in pedagogical works, scholarly

publications, books or artistic works of its employees, regardless of the form of expression, unless there is a written agreement to the contrary.

This exception to NCI ownership of intellectual property does not extend to copyright in software or to database rights. NCI will not assign rights to the usage of teaching materials to any third party without the prior agreement of the author/creator. If there is an opportunity to exploit those materials/works with a party independent of NCI, then the commercial value of that exploitation will be shared between NCI and the author/creator in accordance with the policy on shared royalties.

5. Aims of Intellectual Property Policy and Procedures

The aim of the IP Policy and procedures are:

- To create an environment that supports and encourages staff, faculty and students to generate new knowledge and commercialise their research.
- To encourage the recognition and identification of IP within NCI and promote an entrepreneurial culture among its staff and students.
- To maximise the commercialisation of intellectual property arising from NCI research for the benefit of the economy and society.
- To encourage public use and commercialisation of NCI's Intellectual Property by facilitating its transfer from NCI to industry and business.
- To establish principles and procedures for the protection and commercialisation of NCI Intellectual Property and for sharing of royalty and other income.
- To provide genuine incentives/rewards and recognition for creators of intellectual property.
- To foster the general awareness of staff of this policy through dissemination and information campaigns, and to provide specific training to research active staff.
- To provide an incentive for NCI personnel and students to become involved in technology transfer.

6. Support Programme

6.1. *Director of Research*

The Director of Research in NCI will be responsible for supporting the development and commercialisation of NCI Intellectual Property. All NCI Intellectual Property including inventions, software and other intellectual property that has commercial potential must be disclosed by NCI personnel on a timely basis to the College through the Director of Research. This function will be supported by the Intellectual Property Advisory Committee. The Director of Research is in charge of the administration of the activities set out in this IP Policy. The Director of Research shall:

- Be responsible for the day-to-day management of the IP Policy.
- Process IP applications.
- Have authority to externally communicate on matters of IP on behalf of NCI; and

- Manage internal communications regarding IP within NCI.
- Raise awareness of policy among researchers and staff
- Provide support to researchers on the NCI IP Policy and processes.

6.2. *The Intellectual Property Advisory Committee*

The intellectual property advisory committee shall be a sub-committee of the Research committee and shall consist of the following members:

- Director of Research/Chair of the Research Committee
- School of Business representative
- School of Computing representative
- Commercial Manager

The IPA Committee members will be required to sign a confidentiality agreement regarding proposals submitted and regarding the IP produced at NCI and passed to the Committee. This will ensure that new ideas are protected. NCI reserves the right to alter the composition of this Committee.

The relevant NCI academic supervisor/project manager may be required to put forward a proposal to the IPA Committee regarding the IP on a project and may be requested to attend a Committee meeting, were appropriate.

Members of the IPA Committee will be required to declare their interest in a proposal if such exists and to absent themselves from any discussion pertaining thereto.

The commercial manager will be responsible for liaising with the technology transfer office to fulfil the duties of the technology transfer office in relation to each of the activities set out in this IP Policy including (without limitation) putting the decisions of the IPA Committee into effect.

6.3. *Role of the IPA Committee*

Members of the IPA Committee will be involved in:

- Identification of intellectual property and evaluation of commercial potential.
- Appoint experts to review the IP.
- Determining IP agreements with industry regarding collaborative research projects.
- Facilitating a fair and equitable return to those involved in commercialisation of their research/work.
- Nominating negotiators with third parties and ensuring a reasonable financial return to the personnel involved (where appropriate) and to NCI.
- Protection of intellectual property including processing of patent, registered design and trade mark applications with the assistance of patent attorneys and other professionals where appropriate.

- The formulation and implementation of strategies for commercialisation in a timely manner and in partnership with the inventor(s).
- Negotiating assignments and licences, options for licences or other commercial arrangements with third parties to assist in producing a financial return to the creators of the intellectual property and NCI. In this regard, consideration will be given to the need for NCI to retain access to know-how and research material for on-going research purposes.
- Assist in the marketing and business support of NCI Intellectual Property for commercialisation.

6.4. Role of the Commercial Manager and the Technology Transfer Office

The technology transfer office shall be outsourced and as such the commercial manager will be responsible for managing the relationship with the technology transfer office.

The Commercial Manager and the Technology Transfer Office is in charge of putting the decisions of the IPA Committee into effect. The Commercial Manager and the Technology Transfer Office shall:

- Provide information to researchers on potential funding avenues and appropriate business development programmes.
- Provide information on incubation facilities, advice and support for establishment and development of campus companies.

Subject always to the IPA Committee to which the Commercial Manager and the Technology Transfer Office will report as reasonably required by the IPA Committee and to which it will remain accountable.

7. General Provisions of NCI IP Policy

As a general rule subject to the exceptions set out in this IP Policy, any IP rights in or to any material/works created by Personnel in the course of their employment or education by NCI or in relation to work carried out for NCI is the property of and vests solely and absolutely in NCI or such companies or organisations as NCI may nominate for such purposes. Such material/works include, but are not limited to any:

- Copyright (including rights in computer software and moral rights);
- Patents;
- Design rights;
- Trademark rights;
- Brand rights;
- Database rights;
- Know how;
- Trade secrets;
- Confidential information rights in design;

- Or other intellectual property rights or other property rights, (whether vested, contingent or future anywhere in the world).

This applies to any IP developed by personnel which they cause to come into existence:

- During their time in NCI or if related to the College personnel's job responsibilities, even if he or she is not specifically requested to create it;
- When using NCI's equipment, supplies, facilities or NCI Assets;
- During an individual's use of their personal time or own facilities if the basic nature of the work created is related to the individual's job;
- Using NCI's confidential information, trade secrets, know how or any NCI IP; or
- In relation to any work performed for NCI (including pursuant to any third party funded research programmes).

At NCI's reasonable cost, Personnel also agree at any later time to execute any documentation or otherwise provide assistance to NCI to secure, protect, perfect or enforce any of NCI's rights, title and interests in and to NCI IP.

This IP Policy is applicable to IP that is owned by NCI, for (without limitation) any of the reasons outlined below:

- It is developed by personnel in the course of their normal or specifically assigned duties either when IP could reasonably be expected to result from the carrying out of those duties and/or, at the time the IP was developed, there was a special obligation on the relevant personnel to further the interest of NCI.
- Under the 2000 Act (as defined in Appendix 1 of this IP Policy), NCI is the first owner of any copyright in the work created by staff in the course of their employment unless precluded by a prior agreement between NCI and a third party (or as covered by section 7 of this IP Policy).
- The IP arises out of funded or non-funded research where such research has, in the opinion of NCI, made use of the equipment, facilities, NCI Assets and/or other resources of NCI (except where ownership of such IP was provided for in a prior agreement between NCI and third parties).
- If it is a condition of the appointment of a student to perform research, that NCI should have ownership of the IP arising from the research performed by such student.
- If it is a condition of the appointment of another Relevant Party to perform research that NCI should have ownership of the IP arising from the research performed by such Other Relevant Party.

IP arising from research or other work sponsored by an external organisation shall be subject to the IP provisions that are stipulated in the related agreement between NCI and the external organisation. Where such an agreement requires all new IP rights to be assigned to a private company, the entry level (or "background") NCI IP should be defined so that it is not inadvertently assigned to the private company as part of the new

IP (also described as “foreground IP” or “results”) but is retained as NCI IP. All such research agreements should be reviewed by a legal person representing NCI.

For the avoidance of doubt, where IP is generated from research that is 100% funded by monies provided directly by the State, or by any not-for-profit financial instrument which has been established by an organisation or individual, and awarded through a public service organisation charged with the granting and dissemination of research funds, this IP will be exclusively and absolutely owned by NCI and subject to the terms of the granting body.

The IP Policy also extends to Other Relevant Parties such as non-employees who participate in research projects at the college including visiting academics, industrial personnel etc. unless a specific waiver has been approved. Other Relevant Parties at NCI who have a prior existing and conflicting intellectual property agreement or arrangement with another employer or third party must enter into an agreement with NCI (and their employer or relevant third party) (see Appendix 10) to abide by the conditions of this IP Policy in the course of their activities in NCI. Other Relevant Parties should contact the IPA Committee to clarify any existing IP arrangements.

For the avoidance of doubt, NCI, in its sole discretion, may assign to inventor(s), by written instrument only, any IP owned by NCI, which NCI has determined not to be of commercial interest to it. Further, it is understood if NCI does not find a means of exploiting such IP within a three (3) year period after filing, then NCI has the right, but not the obligation, to assign ownership rights to the inventor(s). Requests for assignment to the inventor should be made to the Director of Research.

In order to enable the achievement of the aims and goals of this IP Policy, the IPA Committee will, through dissemination of information and the holding of general information sessions for personnel, foster the general awareness of personnel of this policy. In addition, the IPA Committee will provide specific training on this IP Policy and its day to day application and relevance to research active personnel.

8. Consultancy

Staff are permitted to engage in consultancy projects for third parties subject to compliance with NCI’s Consultancy Policy and their contract of employment and subject to written approval by the President of NCI. Any such approved consultancies must be disclosed to the IPA Committee. This NCI Consultancy Policy is currently under development.

9. Intellectual Property Assignments and Patent Assignments

Intellectual property assignments and patent assignments apply to all the Colleges, Schools, Centres, Institutes, academic, research and other College staff (full time or part time), students, college consultants or any third party conducting research or other intellectual activity using NCI’s supplies, facilities, NCI Assets, confidential information, trade secrets or existing intellectual property of NCI. This clause may continue after the individual ceases to be an NCI employee, student or consultant.

As a condition of employment as a college employee and as a condition of admission of every student, each staff member or student (as the case may be) shall comply with the

Intellectual Property Policy and shall agree to assign to NCI (or a person or company designated by the College or an agency which provided the funding for the relevant research) any and all Intellectual Property created and produced or otherwise developed while the person was an employee or a student of the College.

When required by the specific circumstances of a project and on the request of the IPA Committee, a member of personnel will agree:

- a) To sign an Intellectual Property Assignment Agreement (see Appendix 8);
- b) To execute such documents of assignment or other documentation required to assign or transfer IP and any moral rights to ensure, protect, perfect and enforce NCI's rights, title and interest in NCI IP;
- c) To do anything that may reasonably be required to assist any assignee of any patent application or other IP to obtain, protect and maintain its rights, title and interest; and
- d) Shall use all reasonable endeavours to do or procure to be done all such further acts and things and to execute or procure the execution of all such other documents as may be reasonably required from time to time for the purpose of giving each party hereto the full benefit of the provisions of this IP Policy.

10. Research Financed by Third Parties

Any research which is partly or wholly financed by any third party agency shall be subject to the specific provisions of the grant or contract covering that research. In the event of any inconsistency between this IP Policy and the terms of any such grant or contract the provisions of the said grant or contract shall prevail provided that the IP clauses in such grant or contract have been reviewed by the Technology Transfer Officer (who may seek external advice if necessary) and, in the case of a contract, such contract has been properly executed by NCI.

11. Administration of the IP Policy

At NCI, the Director of Research will be responsible for supporting the development and commercialisation of NCI IP and this will be supported by the Technology Transfer Officer.

The Technology Transfer Officer will ensure that appropriate IP education and training is carried out with respect to staff and students, in particular final year undergraduate students (and as required other relevant personnel) of NCI.

12. Disclosure and Evaluation

It is a condition of employment or engagement by NCI as staff; admission by NCI as a student; or engagement by NCI as an Other Relevant Party such as a collaborating research partner; that the results of all research or projects should be fully, promptly and completely disclosed to NCI.

All researchers, staff and students must disclose any IP arising from such research to NCI through the IPA Committee in the form of an Invention Disclosure Form (IDF) as soon as

possible after such IP is apparent. The IPA Committee should assess it and get professional advice etc. in a timely manner.

No publication should be made prior to disclosure. However, it is possible to commercialise and publish providing there is no damaging disclosure and the disclosure schedule is agreed. In the context of a collaborative research, a partner who wishes to publish results must first obtain permission from the other partner(s).

Confidentiality agreements and/or non-disclosure agreements should be used where appropriate.

12.1. Procedures to Protect IP

I. Staff member or student (with supervisor) contacts the IPA Committee

- They will inform IPA Committee of their intention to complete an Invention Disclosure Form (see Appendix 5). The IPA Committee may consult with commercialisation experts regarding the completion of the Invention Disclosure Form.

II. Submission of Invention Disclosure Form:

- This form should be promptly submitted (and in any event no later than within 30 days of the discovery or invention of the discovery or invention in question) to the IPA Committee.

III. Commercial Evaluation of IP:

- Any IP reported in an Invention Disclosure Form shall be submitted to the IPA Committee for assessment under the guidelines of the IP Policy and for recommendations to NCI regarding the patentability and/or potential commercialisation.
- The IPA Committee may recommend that other suitably qualified advisors or external consultants be engaged to advise on the assessment of the IP.
- As far as practicable, the relevant inventors or researchers should be involved in the evaluation (and where relevant protection) process by the IPA Committee.
- The criteria to assess the commercial value of the IP should include (without limitation):
 - A literature review to establish if the idea is innovative.
 - Assessment that the IP has a potential commercial benefit.
 - Technical and commercial feasibility.
 - Proof of concept (business plan, access to finance etc.).
 - Potential for sale or licensing of technology or consultancy.
 - Demonstrates a competitive advantage based on differentiated or innovative product or service.
 - Development stage of the subject matter.

- Commercial focus and profit motive.
 - Study of comparable existing subject matter, licences and commercialisation practices.
 - Proximity to market.
 - Market valuations
 - Barriers to entry into markets.
 - Estimated projected sales based on market research.
 - Third party assistance including for example input from industry and state agencies.
 - Estimated cost of patent process.
- Whilst the criteria listed above are not exhaustive, it provides guidance to persons submitting an application as well as to those determining the commercial value. As it is a complex decision, the IPA Committee may refer to other expertise (internal or external) where necessary and further criteria may be applied.
 - A decision will be made by the IPA Committee and the originator of the IP will be notified in writing of the decision made.
 - Should the Committee decide to pursue the project; the staff member will be required to complete an IP Assignment Form (see Appendix 8).
 - The IPA Committee may decide in appropriate circumstances, to offer the opportunity to the originator of the IP to pursue exploitation independently if this is deemed appropriate under agreed written terms. NCI will have no rights to commercial revenue resulting from IP, if it subsequently proves successful, subject to any agreed terms.

IV. Submission of a patent application or an application for other protection:

- NCI shall have the right, but not the obligation, either directly or through an outside agent, to seek patent or other protection of the IP and to undertake efforts to introduce the invention into public use.
- Where a decision is made by the IPA Committee to proceed with an application for protection of the IP, the process below shall be carried out in a timely manner.
- Where a decision is made by the IPA Committee to proceed with a patent application, the originator of the IP is required to cooperate in every reasonable way, to execute all necessary documents and to assist the IPA Committee in completing the patent application form. The application should remain confidential until such time as the process is complete. Confidentiality agreements will be used where appropriate.
- Commercialisation activities should recognise specific terms and conditions in appropriate funding contracts including any Collaborative Research Agreements.

- The cost of the submission of the application shall be paid by NCI. The originator may be required to assist NCI and/or its advisors with the preparation of a claim for appropriate support for IP protection. Any expenses incurred will be reimbursed to NCI prior to the distribution of any royalty or other income (if any) from the IP.
- The originator of the IP and NCI shall take all reasonable precautions to protect the integrity and confidentiality of the IP in question. The originator of the IP should be aware that publication prior to the filing of patent applications may prevent the granting of certain patents.
- NCI may decide at any stage to withdraw from the process of exploiting a particular piece of IP. This may arise where:
 - Concern exists regarding the technical or commercial feasibility of a particular piece of IP,
 - Costs of exploiting the IP are excessive, or
 - External sponsorship of the process is no longer available.
- The originator of the IP will be notified in writing of the intention of NCI to withdraw from the process and the withdrawal will apply from immediate effect.
- Where a decision is not made about the commercialisation of the IP within the determination period or where it is determined that NCI does not wish to commercialise the IP, the IP may, at NCI's entire discretion, be assigned or licensed to the originator, offering the opportunity to the originator of the IP to pursue exploitation independently.
- No patent application, assignment, licensing or other agreement may be entered into or will be considered valid with respect to NCI IP except when properly and lawfully executed by NCI.

13. Commercialisation

The IPA Committee will assist, provide advice, or procure the provision of outside professional advice in relation to the various options for commercialisation and technology transfer that may be appropriate in order to best meet the aims of this IP Policy, including:

- Licensing the IP to a third party for a fixed sum or a royalty related to future sales.
- Assigning the IP to a third party for a fixed sum or a royalty related to future sales.
- Developing the commercial potential of the IP through a campus company.
- Developing the commercial potential of the IP through a joint venture with a third party.
- Any other arrangement that may be considered appropriate.

A separate NCI Campus Company Policy outlines NCI's position on spin-off companies and the division of income from such enterprises. This NCI Campus Company Policy is under development.

In providing this advice and assistance, the IPA Committee will give due consideration to the retention of the right to use and access know-how and research materials for the purpose of continuing and further research as well as options which may provide most benefit to the Irish economy.

14. Distribution of Commercialisation Income

The College shall share a proportion of net royalty and other net income generated by the college from the commercialisation of NCI Intellectual Property with the approved creators or authors of the said intellectual property. This sharing of income is subject to the terms of the policy being met by the creator of the NCI Intellectual Property, including the execution of all appropriate documentation to assign to the College all NCI Intellectual Property that may arise from a particular project or research. The aim is to achieve an equitable distribution of the income that arises from the commercialisation of NCI Intellectual Property between the college, the creator of the intellectual property and, where appropriate, a third party sponsor. The procedure for distribution of the actual net income outlined in this clause does not relate in any way to income earned by the college from equity in campus companies.

All direct expenses incurred by the college in the protection and commercialisation of NCI Intellectual Property that arises from a particular project or research (including legal and other costs involved in seeking patent protection for an invention and any subsequent investigation, development and promotion) will be recouped first by the college from the initial royalty or other income or lump sum before calculating the amount of income which can be shared with the relevant creators of the intellectual property in question.

Subject to the foregoing, the following guidelines (which may be amended from time to time by NCI) will be used in determining the distribution of net income received by NCI from the commercialisation of a particular piece of NCI Intellectual property:-

- 75% of net income actually received by NCI will be paid (subject to deduction as outlined above of applicable taxes and reimbursement of college costs associated with the protection and exploitation of NCI Intellectual Property ("Net Income")) to the creators of the intellectual property that are classified as NCI personnel by the policy in such proportions as agreed between the relevant NCI personnel.

If more than one party is involved in the creation of the particular piece of NCI Intellectual Property, the division of payments between the parties will be based on their relative intellectual contributions as outlined in the Invention Disclosure Form. The division of payments will be agreed by the parties concerned and notified to NCI before a patent application is filed by the college. The college shall not distribute the Net Income unless the relevant parties have agreed the proportions between themselves. If the parties cannot agree the proportions then the college will determine the matter and the decision of the college shall be final (see Appendix 4).

It is essential that good research records are prepared during the course of each project. In the event of a dispute, the research records will be of prime importance in making an apportionment between the parties concerned.

The division of royalty and other income will generally be carried out within a reasonable timeframe upon receipt of such income. The college shall make commercially reasonable efforts to ensure where possible that creators of the intellectual property benefit from any income tax concessions on income from patents which may be available. For the avoidance of doubt none of the creators of the intellectual property shall be entitled to any share in royalty or other income from commercialisation of research unless NCI has received actual income or royalty payments from such commercialisation.

14.1. Non-Financial Rewards

It is recognised that the development of NCI Intellectual Property is dependent on the existence of satisfactory and equitable agreements on the division of income to provide meaningful rewards to creators of NCI Intellectual Property. However, the college may at its discretion provide non-financial rewards for such activities including academic recognition, improvement in the colleges, schools, centres and institutes facilities and funds for research.

15. Organisations and Companies Collaborating with NCI on Research Projects

As an educational institute, NCI has an obligation to ensure the maximum public benefit from the exploitation of IP created from both publicly funded research and collaborative co-funded research. This is usually best maximised when IP is commercially exploited.

The NCI IPA Committee will conduct a commercial evaluation on the IP created/to be created in a research project and will seek information from the collaborating organisation on how it intends to commercialise the IP, and also determine the IP ownership rights they require from the project. The evaluation to determine the commercial value and IP ownership rights will include an examination of the criteria listed in paragraph 11 of this policy. All such information requested and provided will be treated in strict confidence.

Upon above assessment, the IPA Committee will decide on the IP ownership rights NCI requires and will agree the sale/assignment/option, licensing (exclusive or non-exclusive), or joint venture agreements or otherwise with the collaborating company to ensure maximum commercial benefits. A legal agreement will be executed between the

parties, setting out the rights, entitlements and obligations of each party prior to the commencement of work on the project.

When making decisions regarding management and commercialisation of intellectual property arising from research which is wholly or partly funded by third parties, the College will take account of the following guidelines:

- Irish Council for Science, Technology and Innovation (ICSTI) National Code of Practice for Managing Intellectual Property Arising from Publicly Funded Research, published in 2004.
- Advisory Science Council National Code of Practice for Managing and Commercialising Intellectual Property Arising from Public-Private Collaborative Research, published in 2005.
- Funding Agency Requirements and Guidelines for Managing Research-Generated Intellectual Property, February 2006.

16. Publication of Research Results

It is college policy to encourage staff and students to place the results of their research in the public domain either through publication in Academic journals or presentation at conferences. This is a vital factor for academic recognition. In accordance with long-standing academic tradition, NCI does not and will not assert ownership of copyright in scholarly publications, books or artistic works of its employees unless there is an agreement to the contrary or patent pending. This exception to NCI ownership of intellectual property does not extend to copyright in software or to database rights. NCI will not assign rights to the usage of teaching materials to any third party without the prior agreement of the author/creator.

However, it must be recognised that premature publication or disclosure except on a confidential basis may make it impossible to obtain valid patent protection. The library will provide advice and assistance in relation to confidentiality agreements. The placing of a thesis in the college library without ensuring that accessibility is restricted constitutes publication. A typical arrangement for publication of a patentable invention is described in Appendix 7.

It is important to ensure that the intellectual property remains confidential and is not published for a limited period to enable adequate arrangements to be put in place for its protection where this is feasible. Publication that is in violation of the terms of any agreement between the college with the sponsor of the research or other third party must be avoided.

17. Conflict of Interest and Ethical Issues

It is the policy of the college that its management, staff, and others acting on its behalf have an obligation to avoid ethical, legal, financial, or other conflicts of interest and to ensure that their activities and interests do not conflict with their obligations to the college or its welfare. NCI requires full disclosure of potential areas of conflict and open discussion at the earliest possible opportunity. NCI will endeavour to alert staff and Other Relevant Parties to recognise where conflicts may occur and to manage and resolve these conflicts in line with its Conflicts Policy, which is currently under development. Any

questions in relation to research ethics should be referred to the Technical Transfer Officer.

18. Dispute Resolution/Arbitration

Any dispute in relation to the policy or its effects will be dealt with as provided for in Appendix 4. Expenses incurred by the college in resolving disputes shall be deducted from royalty income before distribution unless an arbitrator is appointed. The costs of the arbitrator shall be borne by the Parties as outlined in Appendix 4.

19. Monitoring and Evaluation of Policy

This IP Policy will be monitored by the IPA Committee on an on-going basis. The IP Policy and related research, commercialisation and technology transfer will be monitored and evaluated on an annual basis and may be amended by NCI from time to time. All amendments to this IP Policy shall be posted on the NCI staff portal and such amendments shall be fully valid and effective from the date of posting.

Appendix 1. Irish Statutory Provisions Governing Ownership of IP Rights

Copyright and Related Rights ACT, 2000 (“2000 Act”)

First ownership of copyright

Section 23 (1) of the 2000 Act provides that: “The author of a work shall be the first owner of the copyright unless the work is made by an employee in the course of employment, in which case the employer is the first owner of any copyright in the work, subject to any agreement to the contrary”.

Maker of database

Section 322 (2) of the 2000 Act provides that: Where a database is made by an employee in the course of employment, his or her employer shall be regarded as the maker of the database, subject to any agreement to the contrary”.

PATENTS ACT 1992 (“1992 Act”)

Right to a patent

Section 16(1) of the 1992 Act provides that: “The right to a patent shall belong to the inventor or his successor in title, but if the inventor is an employee the right to a patent shall be determined in accordance with the law of the state in which the employee is wholly or mainly employed or, if the identity of such state cannot be determined, in accordance with the law of the state in which the employer has his place of business to which the employee is attached.”

NOTE ON OWNERSHIP OF PATENTS UNDER IRISH LAW

Irish Law comprises Statute Law (legislation) and Common Law (legal principles developed through judicial decisions over time). The ownership of inventions discovered by an Irish employee working for an Irish employer is not specifically set out in any statutory provision but is covered by the Common Law principle that an employer owns the product of his employee’s work where that work was done in the course of the employment unless there is an agreement to the contrary.

Appendix 2. Definition of Intellectual Property

Intellectual Property (IP)

Intellectual property as the tangible or intangible results of research, development, teaching, or other intellectual activity which is manifested in the form of copyrights, patents, trademarks, industrial designs and confidential/proprietary information. Intellectual property allows creativity and innovation to be captured and owned in the same way as physical property can be owned. Intellectual property includes individually and collectively all technical innovations, inventions, improvements, and/or discoveries, information, writings and software, whether or not patentable or otherwise susceptible to intellectual property protection, including technology and materials in their tangible form. This is the general term for intangible property rights which are a result of intellectual effort.

Patent

A patent grants, for a limited period, the right to exclude others from making, using, selling or importing the subject matter described by the claims of the patent except with the consent of the patentee. A patent contains a narrative description of the subject matter covered by the patent called the specification. It also contains one or more claims that describe the subject matter covered by the patent in highly technical and specific terms. A patent, as a form of 'industrial property', can be bought and sold, licensed or used by the owner either in whole or in part.

There are three basic criteria required to patent an invention. The invention must be novel, have an inventive step (i.e. it should not be obvious to someone skilled in the state-of-the-art) and it should have an industrial application. All three criteria must be met.

Trade Mark

A trade mark is the means by which a business identifies its goods or services and distinguishes them from the goods and services supplied by other businesses. The Trade Marks Act, 1996 defines a trade mark as "any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking from those of other undertakings."

A trade mark may consist of words, (including personal names), designs, logos, letters, numerals or the shape of goods or of their packaging, or of other signs or indications that are capable of distinguishing the goods or services of one undertaking from those of others.

Design

A design means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colour, shape, texture or materials of the product itself or its ornamentation. A registered design is a form of 'industrial property', which can be assigned, transferred, licensed or used by the owner. Design protection is territorial; in effect a design registered in Ireland is only valid in Ireland. Some aspects of the "design" may also be protected by copyright.

Copyright

Copyright is the legal term, which describes the rights given to authors/creators of certain categories of work. Copyright protection extends to the following works:

- original literary, dramatic, musical or artistic works;
- sound recordings, films;
- broadcasts, cable programmes;
- the typographical arrangement of published editions;
- computer programmes;
- Original databases.

The owner of copyright is the author, meaning the person who creates the work. However, as copyright is a form of property, the right may be transferred to someone else, for example, to a publisher. Copyright is a property right and the owner of the work can control the use of the work, subject to certain exceptions. The owner has the exclusive right to prohibit or authorise others to undertake the following:

- copy the work;
- perform the work;
- make the work available to the public through broadcasting or recordings;
- Make an adaptation of the work.

Copyright takes effect as soon as the work is put on paper, film, or other fixed medium such as CD-ROM, DVD, Internet, etc. No protection is provided for ideas while the ideas are in a persons mind; copyright law protects the form of expression of ideas, not the ideas themselves.

Confidential Information and Know How

Protection for confidential information and know-how arises from the law of confidentiality. The confidential information may be know-how associated with a Patent or a Patent Application, or material in existence before, for example, a Patent Application is filed, or material already protected by another form of intellectual property, for example, copyright.

Domain Names

A domain name is a unique address on the Internet. There are various generic top level domains (“TLDs”), such as .com and .biz, as well as, ccTLDs (Country code), such as “.ie”.

Other Forms of Intellectual Property

Other forms of intellectual property include, but are not limited to, database right for certain types of database (under Copyright and Related Rights Act, 2000); protection for semi-conductor topographies; plant breeders’ rights in certain plant varieties; and protection against unfair competition under “passing off” law.

The IP Policy is applicable to *NCI Intellectual Property* that is owned by NCI for any of the reasons outlined below:

It is developed by NCI Personnel in the course of their normal or specifically assigned duties either when intellectual property could be reasonably expected to result from the carrying out of those duties and/or, at the time the intellectual property was developed, there was a special obligation on the relevant NCI Personnel to further the interest of NCI.

Under the 2000 Act (as defined below), NCI is the first owner of any copyright in the work created by NCI Personnel in the course of his/her employment unless precluded by a prior agreement between NCI and a third party (or is covered by section 8 of this IP Policy).

The intellectual property arises out of funded or non-funded research where such research has, in the opinion of NCI, made use of the equipment, facilities, NCI Assets and other resources of NCI unless such action was precluded by prior agreement between NCI and third parties.

If it is a condition of a research contract with a third party that NCI should have ownership of the intellectual property arising from the contract.

Appendix 3. Intellectual Property Agreement

Intellectual Property Agreement for personnel at NCI who have a prior existing and/or conflicting Intellectual Property Agreement or arrangement with another employer or a third party.

I understand that, consistent with applicable laws and regulations, National College of Ireland (NCI) is governed in the handling of intellectual property by its official policy titled Intellectual Property Policy and Procedures, (a copy of which I have read), and I agree to abide by the terms and conditions of this policy in the course of my NCI activities.

As a general rule (and subject to the exceptions set out in this policy) any intellectual property rights in any material, (including any copyright (including rights in computer software and moral rights), patent, design right, trademark rights, brand rights, database rights, know how, trade secrets, confidential information rights in design, or other intellectual property rights or other property rights, whether vested, contingent or future anywhere in the world), created by me in the course of my work or study with NCI is the property of and vests solely and absolutely in NCI (“NCI Intellectual Property”).

Pursuant to this policy, and in consideration of my participation in projects administered by NCI, access to or use of facilities provided by NCI and/or other consideration, I hereby agree as follows:

- I will disclose to NCI all potentially patentable inventions and other NCI Intellectual Property conceived or first reduced to practice in whole or in part in the course of my NCI responsibilities, my participation in research projects at NCI or with use of college resources. I further assign [jointly] to NCI [and to my non-NCI employer] all my right, title and interest in such patentable inventions and other NCI Intellectual Property created in connection with NCI and to execute and deliver all documents and do any and all such things necessary and proper on my part to effect such assignment. Such assignment is not inconsistent with the terms of my continuing employment outside of NCI or with any other agreement I have entered into.
- I will not use any information defined as confidential or proprietary by my non-NCI employer in the course of my NCI responsibilities and I will not do consulting or research work for my non-NCI employer while at any facility owned or leased by NCI.
- I am free to place my inventions in the public domain as long as in so doing neither I nor NCI violates the terms of any agreements that governed the work done or my agreements with my non-NCI employer.
- I will not enter into any agreement creating copyright or patent obligations in conflict with this agreement.

This agreement is effective on date of my NCI hire, enrolment or participation in projects administered by NCI, and is binding on me, my estate, heirs and assigns.

SIGNED SEALED and DELIVERED

by [NAME]

in the presence of:-

signature

Witness name

Witness description

Witness address

Acknowledged and accepted:

Non-NCI Employer: _____
(Insert name)

Signature

Title

Date

Appendix 4. Dispute Resolution

1. Informal Dispute Resolution

Prior to the initiation of formal dispute resolution procedures, the parties shall first attempt to resolve any dispute, controversy or claim arising under or in connection with this Policy informally, as follows:

- I. First, the parties to the dispute shall meet as often, for a duration and as promptly as the parties deem necessary to discuss the dispute and negotiate in good faith in an effort to resolve the dispute;
- II. If the parties are unable to resolve the dispute within 30 days after the referral of the dispute to them, the dispute will be referred to the President of NCI. The President shall nominate a person who shall use reasonable efforts to resolve such dispute.

2. Alternative Dispute Resolution

If a dispute cannot be resolved as provided above, then prior to resorting to litigation, the following shall apply:

- I. Either of the parties may refer such matter for determination to such person as may be appointed by agreement between the parties or, in default of agreement, nominated on the application of either party by the President for the time being of the Law Society of Ireland.
- II. Any person to whom a reference is made under Clause 2.I shall act as an arbitrator (“the Arbitrator”) and shall be entitled to appoint such technical expert or experts as he considers necessary to assist him in determining the matter referred to him. The decision of the Arbitrator (which shall be given by him in writing stating his reasons therefore) shall be final and binding on the parties. The arbitration shall be conducted in accordance with the Arbitration Acts 1954-1998.
- III. The parties shall provide any Arbitrator with such information as he may reasonably require for the purposes of his determination. The Arbitrator shall be entitled to order discovery of documents where he considers expedient to do so in the interests of justice and to reduce costs.
- IV. The costs of any Arbitrator (including the costs of any technical expert appointed by him) shall be borne in such proportions as the Arbitrator may determine to be fair and reasonable in all the circumstances or, if no such determination is made by the Arbitrator, by the parties in equal proportions.

3. Exceptions to Dispute Resolution Procedure.

The provisions of Clauses 1 and 2 will not be construed to prevent NCI from:

- I. Seeking a temporary restraining order or injunctive or other equitable relief with respect to a breach (or attempted breach) of the policy; or

- II. Instituting litigation or other formal proceedings to the extent necessary (i) to avoid the expiration of any applicable limitations period or (ii) to preserve a superior position with respect to other creditors.

Appendix 5. NCI Invention Disclosure Form

NCI INVENTION DECLARATION FORM

1. Title of Invention

--

2. Inventors

Name	School/Research Institute	Affiliation with Institute (i.e. department, student, staff, visitor)	Address, contact phone no., e-mail	% Contribution to the Invention

3. Contribution to the Invention

Each contributor/potential inventor should write a paragraph relating to his/her contribution and include a signature and date at the end of the paragraph.

--

4. Description of Invention

(Please highlight the novelty/patentable aspect. Attach extra sheets if necessary including diagrams where appropriate). What is novel, the ‘inventive step’? For more information on patents, please look at <http://www.patentsoffice.ie/en/patents.aspx>

5. Why is this invention more advantageous than present technology?

What is its novel or unusual features? What problems does it solve? What are the problems associated with these technologies, products or processes? Explain how this invention overcomes these problems (*i.e.* what are its advantages).

6. What is the current stage of development / testing of the invention?

--

7. List the names of companies which you think would be interested in using, developing or marketing this invention

--

8. Funding Partner(s)

Government Agency & Department	
% Support	
Contract/Grant No.	
Contact Name	
Phone No.	
Address	

Industry or other Sponsor	
% Support	
Contract/Grant No.	
Contact Name	
Phone No.	
Address	

9. Where was the research carried out?

10. What is the potential commercial application of this invention?

11. Was there transfer of any materials/information to or from other institutions regarding this invention?

If so please give details and provide signed agreements where relevant.

12. Have any third parties any rights to this invention?

If yes, give names and addresses and a brief explanation of involvement.

13. Are there any existing or planned disclosures regarding this invention?

Please give details.

14. Has any patent application been made? Yes/No

If yes, give date: _____ Application No.: _____

Name of patent agent: _____

Please supply copy of specification.

15. Is a model or prototype available? Has the invention been demonstrated practically?

I/we acknowledge that I/we have read, understood and agree with this form and the Institute's *Intellectual Property and Procedures* and that all the information provided in this disclosure is complete and correct.

I/we shall take all reasonable precautions to protect the integrity and confidentiality of the IP in question.

Inventor: _____
Signature Date

Inventor: _____
Signature Date

Inventor: _____
Signature Date

Inventor: _____
Signature Date

Appendix 6. Non-Disclosure Agreement

This AGREEMENT dated this **type here** 2010 (the “Effective Date”)

BETWEEN

National College of Ireland, located at Mayor Street, Dublin 1, Ireland, of one part and

Type here [*insert company/university name and address*] of the other part.

1. AGREEMENT

Preparatory to, at, or arising from a meeting on **type here**, the parties are prepared to disclose to each other certain technical and commercial information relating to their research activities, for the purpose of exploring a possible **type here** (the “Purpose”) [*insert the most appropriate purpose, e.g. research collaboration, technology, evaluation, licensing of technology etc.*].

- 1.1 “Confidential Information” shall mean any of the following, whether (i) disclosed by or on behalf of the Disclosing Party to the Receiving Party orally or in writing or (ii) learned by the Receiving Party through observation or examination of any documents, licences, contracts, books, records, data, software, source codes or products of the Disclosing Party or (iii) learned by the Receiving Party through observation or examination of the Disclosing Party’s offices, processes or procedures or (iv) otherwise learned by the Receiving Party in any manner except as set forth in paragraph 5 hereof:
- 1.2 any information relating to the products or services of the Disclosing Party in which the Disclosing Party claims a proprietary and/or confidential interest;
- 1.3 all confidential matters of the Disclosing Party including, without limitation, technical know-how, design rights, trade secrets, technical data, analyses, compilations, concepts, technical processes, formulae, specifications, inventions, research projects, customer lists, pricing policies, operational methods, financial information, actuarial information, marketing information, market opportunities and other business affairs of the Disclosing Party;
- 1.4 any information of a confidential nature concerning the Disclosing Party’s customers, suppliers, employees or consultants; and

1.5 Any information the Disclosing Party has received from others which the Disclosing Party is obliged to treat as proprietary and/or confidential.

2. **CONFIDENTIALITY**

Since the information to be disclosed is considered to be confidential by each party, the disclosure to the other party shall be made on the basis that the Receiving Party shall maintain the Confidential Information received in confidence, and shall not, without prior written consent of the Disclosing Party, disclose the Confidential Information or use the Confidential Information other than for the specific Purpose noted above.

The Receiving Party acknowledges that irreparable injury and damage may result from disclosure of any Confidential Information to third parties or utilisation of Confidential Information for purposes other than connected with the Purpose. The Receiving Party agrees to treat the Confidential Information in the strictest confidence and to undertake the following additional obligations with respect thereto:-

2.1 The Receiving Party shall not, at any time hereafter, without the Disclosing Party's prior written consent: (i) disclose any Confidential Information to any third party or (ii) disclose the existence of any of the Disclosing Party's products or services or any information relating thereto to any third party or (iii) use any Confidential Information except pursuant to and in connection with the Purpose.

2.2 The Receiving Party shall not make or use any copies, synopses or summaries of oral or written material, photographs or any other documentation or information made available or supplied by the Disclosing Party to the Receiving Party except such as are strictly necessary for the Receiving Party's internal communications in connection with the Purpose or as are strictly necessary to accomplish the purposes of the Purpose.

Neither the Receiving Party nor any of its employees or agents shall disclose to any third party or make any public announcement with respect to the Disclosing Party's products or Confidential Information without the prior written consent of the Disclosing Party.

3. **EMPLOYEES**

The employees of the Receiving Party shall be informed of the obligations under this Agreement with respect to the Confidential Information and shall have agreed to hold the Confidential Information confidential and not to disclose it or use it other than for the specific Purpose of this Agreement.

4. **NOTICE**

In the event of the Receiving Party, under any applicable law, being required (by oral questions, interrogatories, requests for information or document subpoenas, civil investigative demand, governmental investigations or similar processes) to disclose any Confidential Information, the Receiving Party will provide the Disclosing Party with prompt notice of such request or demand so that the Disclosing Party may seek an appropriate protective order and/or consider granting a waiver of the Receiving Party's compliance with the provisions of this Agreement.

5. **EXCEPTIONS**

The obligations of the Receiving Party set out in this Agreement shall not apply to any part of the Confidential Information:

- 5.1 which at the time of disclosure by the Disclosing Party is already in the possession of the Receiving Party; or
- 5.2 which at the time of disclosure by the Disclosing Party is, or thereafter becomes through no fault of the Receiving Party, public knowledge; or
- 5.3 which after disclosure by the Disclosing Party is lawfully received by the Receiving Party from a third party who has the right to disclose such information to the Receiving Party; or
- 5.4 which becomes part of the public domain through no fault or action on the part of the Receiving Party; or
- 5.5 Which is required to be disclosed by law or court order.

6. **SCOPE**

This Agreement shall not be construed to grant the Receiving Party any licence or other rights, except as expressly set forth above. This Agreement constitutes the full and complete agreement in this matter between the parties. Any amendment to this Agreement must be made in writing and such amendments are valid only upon the mutual consent of both parties.

7. **DURATION**

The obligations of this Agreement shall be in effect for a period of five (5) years from the effective date of this Agreement.

8. **ASSIGNMENT**

This Agreement is specific to the parties hereto and the rights and obligations hereunder may not be assigned in whole or in part by either party without the prior written consent of the other party.

9. **GOVERNING LAW AND JURISDICTION**

This Agreement shall be construed and governed according to the laws of Ireland and shall be subject to the exclusive jurisdiction of the Courts of Ireland.

IN WITNESS WHEREOF the parties hereto signed this Agreement or caused this Agreement to be duly executed by their duly authorized representatives.

Signed by Date

Director of Research,

For and Behalf of National College of Ireland,

Signed by type here

Date

An authorised signatory of type here

Appendix 7. Typical arrangement for publication of a patentable invention.

Every effort shall be made to ensure that intellectual property protection causes a minimum delay to the publication of related research. Where possible the delay in publication to enable a patent application to be filed should be for an agreed limited period, typically less than 60 days. In the case of research funded by third parties a typical arrangement is as follows:

- The third party would be informed at least 30 days before submission of a publication
- The third party would be given 30 days to decide whether publication should be delayed
- Upon the request of the third party the submission for publication may be delayed for up to a further 30 days to enable the parties to secure adequate protection of the IPR that would be affected by publication.

In the event that the protection of IPR is not feasible and where publication may jeopardize commercialisation, the submission for publication may be delayed for up to an additional period to enable an approach to commercialisation to be agreed.

Appendix 8. IP Assignment Form

National College of Ireland (“NCI”)

Intellectual Property Assignment Agreement for Staff, Students and Other Relevant Parties¹

Research Project(s) Title: _____ (the
“Project(s)”)

Research Project(s) Number: _____

I understand that, consistent with applicable laws and regulations, NCI is governed in the handling of intellectual property by its official IP Policy entitled *Intellectual Property Policy and Procedures*, (a copy of which I have received), and I agree to abide by the terms and conditions of this IP Policy in the course of my NCI activities and in the work that I carry out on the Project.

As a general rule (and subject to the exceptions set out in this IP Policy) any intellectual property rights in any material, (including any copyright (including rights in computer software and moral rights), patent, design right, trademark rights, brand rights, database rights, know how, trade secrets, confidential information rights in design or other intellectual property rights or other property rights, whether vested, contingent or future anywhere in the world), created by me in the course of my work with NCI (and in particular in the course of my work on the Project) are the property of and vest solely and absolutely in NCI (“NCI IP”).

Pursuant to the IP Policy, and in consideration of my participation in projects (and the Project(s)) administered by NCI, access to or use of facilities provided by NCI and/or other consideration, I hereby agree as follows:

¹ As the terms Staff, Students and Other Relevant Parties are defined in the NCI IP Policy.

I will disclose to NCI all potentially patentable inventions and other NCI IP conceived or first reduced to practice in whole or in part in the course of my NCI responsibilities, my participation in the Project(s) at NCI or with more than incidental use of NCI resources. I further assign to NCI all my right, title and interest in such patentable inventions and other NCI IP created in connection with NCI and/or the Project(s) and to execute and deliver all documents and do any and all such things necessary and proper on my part to effect such assignment. Such assignment is not inconsistent with the terms of my continuing employment outside of NCI (if any) or with any other agreement I have entered into.

I will not use any information defined as confidential or proprietary by any non-NCI employer (if any) in the course of my NCI responsibilities and I will not do consulting or research work for any non-NCI employer (unless such work is approved of in writing in advance by NCI).

I will not enter into any agreement creating copyright or patent obligations in conflict with this Agreement. I hereby waive any moral rights to which I may be entitled under any legislation now existing or in future enacted in any part of the world and for the avoidance of doubt this waiver shall extend to the licensees and successors in title to the copyright in the NCI IP and the Project(s).

This Agreement is effective on date of my NCI hire, enrolment or participation in projects administered by NCI, and is binding on me, my estate, heirs and assigns.

[I hereby agree and acknowledge that in respect of the Project and in respect of my assignment of IP to NCI in this Agreement, my full and final entitlement to payment, royalty or other income arising therefrom is set out in the Schedule to this Agreement and I further agree and acknowledge that I shall have no other entitlement or claim against NCI or any party to whom NCI assigns or licences this IP in respect of payment, royalty or other income arising therefrom.²]

Signed this _____ day of _____, 20●●

Signature

Printed or typed name

² In the event that this document is to be signed by an Other Relevant Party (as that term is defined in the Introduction of the IP Policy), it may be appropriate to include this provision and the Schedule. To be considered on a case by case basis.

NCI title

NCI School/Research Institute

[Schedule]

[Insert details of payment, royalty or other income

OR

I agree and acknowledge that I have no right to any payment, royalty or other income in respect of the Project and in respect of my assignment of IP to NCI in this Agreement.]

**Appendix 9. Data Protection and Confidentiality Undertaking
(DATA PROTECTION AND CONFIDENTIALITY UNDERTAKING FOR
EMPLOYEES, CONTRACTORS OR STUDENTS TAKING PART IN A
PROJECT INVOLVING NCI AND AN OUTSIDE PARTNER:)**

DATA PROTECTION AND CONFIDENTIALITY UNDERTAKING

Name: _____

Employee/Student ID Number (if applicable): _____

Function: _____

Project Title: _____

Project Number: _____

In consideration of my appointment by the National College of Ireland (NCI) as a [research assistant] in the performance of services (“Services”) under the [research agreement] (“Agreement”) between NCI and [NAME OF PARTNER] (“Partner”) and the related opportunity to gain experience in the Services, I hereby acknowledge that I will acquire certain confidential information (“Confidential Information”) relating to NCI’s intellectual property, products and strategies and the intellectual property, products and strategies of the Partner.

I hereby undertake to use the Confidential Information only as may be necessary to perform the Services under the Agreement and not to disclose it to any person other than those who have agreed to the same confidentiality undertaking.

I shall use all precautions necessary to protect the Confidential Information from unauthorized disclosure.

I hereby acknowledge that the Confidential Information is a trade secret of NCI and/or the Partner and that NCI and/or the Partner may claim damages from the undersigned for loss of business in the event of any unauthorized disclosure.

For the purposes of the Data Protection Acts 1988 and 2003, I hereby consent to the processing of all personal data that I provide to NCI in connection with the performance of the Services and the Agreement.

This undertaking will continue indefinitely until

- (a) the Confidential Information is published or otherwise made public by NCI; or
- (b) I am expressly released, in writing, from this undertaking by NCI,

And is not conditional on my being or remaining an employee, student of NCI or Other Relevant Party

I hereby acknowledge that this undertaking will also benefit the successors and assigns of NCI together with its related bodies corporate.

Dated:
undertaking

Signature of person giving the

Signature of Witness

Name of Witness:

Appendix 10. Intellectual Property Assignment Agreement

(Intellectual Property Assignment Agreement for Staff, Students and Other Relevant Parties³ who have a prior existing and/or conflicting Intellectual Property Agreement or arrangement with another employer or a third party)

I understand that, consistent with applicable laws and regulations, NCI is governed in the handling of intellectual property by its official IP Policy⁴ entitled *Intellectual Property Policy and Procedures*, (a copy of which I have received), and I agree to abide by the terms and conditions of this IP Policy in the course of my NCI activities.

As a general rule (and subject to the exceptions set out in the IP Policy) any intellectual property rights in any material, (including any copyright (including rights in computer software and moral rights), patent, design right, trademark rights, brand rights, database rights, know how, trade secrets, confidential information rights in design, or other intellectual property rights or other property rights, whether vested, contingent or future anywhere in the world), created by me in the course of my work with NCI are the property of and vest solely and absolutely in NCI (“NCI IP”).

I will inform the NCI IPA Committee of any pre-existing IP arrangements with other organisations.

Pursuant to the IP Policy, and in consideration of my participation in projects administered by NCI, access to or use of facilities provided by NCI and/or other consideration, I hereby agree as follows:

1. I will disclose to NCI all potentially patentable inventions and other NCI Intellectual Property conceived or first reduced to practice in whole or in part in the course of my NCI responsibilities, my participation in research projects at NCI or with more than incidental use of NCI resources. I further assign [jointly] to NCI [and to my non-NCI employer]⁵ all my right, title and interest in such patentable inventions and other NCI Intellectual Property created in connection with NCI and to execute and deliver all documents and do any and all such things necessary and proper on my part to effect such assignment. Such assignment is not inconsistent with the terms of my continuing employment outside of NCI or with any other agreement I have entered into. [I will not use any information defined as confidential or proprietary by my non-NCI employer in the course of my NCI responsibilities and I will not do consulting or research work for my non-NCI employer while at any facility owned or leased by NCI.]
2. I will not enter into any agreement creating copyright or patent obligations in conflict with this Agreement.
3. This Agreement is effective on date of my NCI hire, enrolment or participation in projects administered by NCI, and is binding on me, my estate, heirs and assigns.

³ As the terms Staff, Students and Other Relevant Parties are defined in the NCI IP Policy.

⁴ This Intellectual Property Assignment Agreement forms Appendix 10 of the NCI IP Policy.

⁵ To be considered on a case by case basis

4. [I hereby agree and acknowledge that in respect of the Project and in respect of my assignment of IP to NCI in this Agreement, my full and final entitlement to payment, royalty or other income arising therefrom is set out in the Schedule to this Agreement and I further agree and acknowledge that I shall have no other entitlement or claim against NCI any party to whom NCI signs or licences this IP in respect of payment, royalty or other income arising therefrom.⁶]

Signed this _____ day of _____, 20●●

Signature

Printed or typed name

NCI title
Acknowledged and accepted:

NCI School/Research Institute

Non-NCI Employer (Insert name)

Signature

Title

Date

⁶ In the event that this document is to be signed by an Other Relevant Party (as that term is defined in the Introduction of the IP Policy), it may be appropriate to include this provision and the Schedule. To be considered on a case by case basis.

[Schedule]

[Insert details of payment, royalty or other income

OR

I agree and acknowledge that I have no right to any payment, royalty or other income in respect of the Project and in respect of my assignment of IP to NCI in this Agreement.]

Appendix 11. NCI IP Principles

Gallen Alliance solicitors recommended that NCI Board be in agreement with some 'Principles in IP policy' before recirculating policy document to Research committee. They have suggested NCI Board agree following Principles.

Principle- IP Management Strategy: It is intended that the written NCI IPP explains how IP management supports and relates to the overall mission of NCI, and how the IPP will benefit the NCI (see Introduction and Aims of Policy). The IPP should include a confirmation that the NCI Board is in full agreement with these introductory Principles (for example, the IPP Principles, as approved by the NCI Board, might be placed at the commencement of the detailed Policy and used as a shortened version for NCI to include, for example, on its Internet and Intranet websites).

Principle- Technology Transfer Office and IP Advisory Committee: It is intended that a Technology Transfer Office and an Intellectual Property Advisory Committee will be established and the roles and responsibilities are outlined in the IPP (*see Section 6 Support Programme of Policy*).

Principle – Disclosure and Evaluation of new IP: It is intended that a formal invention disclosure process will be set up. (*see Section 12 Disclosure and Evaluation*) In certain circumstances NCI may decide not to pursue commercialisation and it may instead decide to offer the opportunity to the inventor to pursue exploitation independently (under appropriate terms).

Principle – Protection of new IP: It is intended that if the decision is taken to proceed with formal IP protection (such as patenting or other forms of formal IP protection) then this will be carried out in a timely manner, with the NCI TTO obtaining professional advice and involving the inventors/researchers (*see Section Disclosure and Evaluation*)

Principle – Commercialisation: It is intended that Technology Transfer activities should be pursued in a timely manner through partnership between the TTO and the relevant inventors/researchers and with the industrial/commercial partner as appropriate. Various options for commercialisation will be considered⁷ and the strategy devised to meet the aims of the IP Policy and to fit in with the terms and conditions of relevant sponsors of research as appropriate. (*See Commercialisation Section*)

Principle – Research Materials: During Technology Transfer involving research materials, due consideration should be given to the retention of know-how and research materials for on-going research purposes.

⁷ There is a requirement for a Campus Policy

Principle- Ownership: It is intended that the IP Policy will clearly state that the ownership of IP generated by staff and students will be vested in NCI (*Section on General Provisions of NCI Policy*). Having regard to the legal position regarding ownership, the IP policy will be supported by appropriate written agreements, which are acknowledged and agreed by all individuals involved in research. Institute ownership of arising IP is a requirement of all state funding agencies in Ireland where projects are 100% publicly funded. In accordance with long-standing academic tradition, NCI does not and will not assert ownership of copyright in scholarly publications, books or artistic works of its employees unless there is an agreement to the contrary or patent pending (Publication of Research Results Section). *This exception to NCI ownership of intellectual property does not extend to copyright in software or to database rights. NCI will not assign rights to the usage of teaching materials to any third party without the prior agreement of the author/creator.*

Principle - Sharing of Commercialisation Income: It is intended that the IP policy will include an incentive policy that explains policy on sharing of commercialisation income⁸ with inventors/creators of commercialised IP. See Section Distribution of Commercial Income.

Principle Conflicts of Interest: It is intended that procedures will be developed and implemented to address conflicts of interest⁹.

Principle Monitoring & Evaluation: It is intended that the TTO will have clear systems for monitoring and evaluation and keep routine records of IP management measurement indicators (*Section Monitoring and Evaluation of Policy*)

IP and other parties

IP and other organisations: IP arising from research or other work sponsored by an external organisation shall be subject to the IP provisions that are stipulated in the related agreement between NCI and the external organisation.

Externally funded research: For the avoidance of doubt, where IP is generated from research that is 100% funded by monies provided directly by the State, or by any not-for-profit financial instrument which has been established by an organisation or individual, and awarded through a public service organisation charged with the granting and

⁸ Please note that this means that NCI retains IP and will share a proportion of net royalty or other revenue generated by IP **not** that they will share in general revenue generated by company. E.g. If company made 100,000 and royalty payable was 10,000 (NCI and inventor would share income 10,000 not 100,000), the other 90,000 would remain within the company. Inventors may own the company.

⁹ There is a need for a conflicts policy which is highly recommended by TTO officer network

dissemination of research funds, this IP will be exclusively and absolutely owned by NCI and subject to the terms of the granting body.

Non-employees: The IP Policy also extends to Other Relevant Parties such as non-employees who participate in research projects at the college including visiting academics, industrial personnel etc. unless a specific waiver has been approved.

Consultancy: Staff are permitted to engage in consultancy projects for third parties subject to compliance with NCI's Consultancy Policy and their contract of employment and subject to written approval by the President of NCI. Any such approved consultancies must be disclosed to the IPA Committee. This NCI Consultancy Policy is currently under development.