



# **Intellectual Property Policy**

**September 2023**

The revised Intellectual Property Policy (2023) replaces the previous policy dated 2016. The policy has been approved by Research & Enterprise Committee on 13<sup>th</sup> November 2023.

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### 1. Introduction

This policy covers the management and exploitation of SGUL’s Intellectual Property. It is a term of employment at SGUL that the Intellectual Property Rights (“IP”) in projects which arise from or during employment are owned by SGUL subject to the right of the Creator to be recognised as the author of the IP and to publish in their own name. Joint Research and Enterprise Services (JRES) have responsibility for IP protection and management in SGUL, specifically the Enterprise and Innovation Team within JRES. Employees have a continuing duty to inform the JRES of developments which may have commercial potential at the earliest opportunity.

### 2. Types of IP and related terms

This policy applies to all IP created through employment at SGUL or by Students who may contribute to the creation of IP. Relevant terms and types of IP may include but are not limited to the following:

**Intellectual Property** (IP) means inventions, Copyright Material (as defined below), Patents and patent applications, design rights, trademarks, trade names, service marks, database rights, plant breeders’ rights, topographies, utility models, know-how, confidential information, protected test data and other intellectual property rights, in each case whether registered or unregistered and including applications, the rights granted under licences and licence options and benefit-sharing rights to any of the foregoing and all rights or forms of protection in any jurisdiction.

**Copyright Material** means copyright IP in all literary, dramatic, musical and artistic works, sound recordings, films or broadcasts and typographic arrangements of published editions such as lecture notes, laboratory notebooks, research reports, research questionnaires, information on websites, digital teaching tools, including computer generated works and program source codes, smart phone apps, and similar material.

**Patents and patent applications:** Applications for a patent may be submitted for any new technical concepts or inventions which may qualify for protection if the invention is deemed to be novel, inventive and commercially applicable.

**Database rights:** these may protect against the extraction and re-utilisation of the content (applies in Europe only).

**Trademarks:** indicate the source of a product or services and gives the customer assurance of the originating quality and value.

**Registered & unregistered design rights:** the design of a product or object, including its appearance, form or decoration may be protected and may include either the whole or part of a product or object and may include packaging or parts assembled into a complex product or object.

**Know how:** this is specialist knowledge. Third parties may pay for access to know-how, as long as it has previously been kept confidential.

**Materials:** includes blood samples, vectors, bacterial strains, plant varieties, human or animal tissue, etc.

Further information about all types of IP and IP rights can be obtained from the JRES and from the UK Intellectual Property Office web-site: <http://ipo.gov.uk>

### 3. Other Definitions

**Assignment** is an outright transfer of IP rights.

**Associate(s)** means individual(s) who are affiliated to SGUL but who are neither employees nor Students (for instance honorary staff and visiting academics).

**Commercial Revenue** means the revenue received from third-party licence fees, royalties, IP assignments, fees for services or any other payments received in respect of commercially exploited IP.

**Costs** means all of those costs incurred in the creation, development, protection and commercialisation of the IP, which may include payments to third parties and expenses, such as patent prosecution and protection fees, legal and commercial advice and proof-of-concept funding or any funding provided by SGUL in direct support of an invention with the express purpose of developing it for commercial exploitation.

**Contributor** means any member of SGUL (including Students) or Associates who were involved in the development of the IP but did not provide an Inventive Contribution

**Creator** means any Member of SGUL (including Students) or Associate who creates, devises or invents an item of IP, not merely a person providing assistance in the realisation of an invention.

**Cumulative SGUL Net Receipts** refers to SGUL's Net Receipts received in respect of the specific piece of IP since its first commercialisation.

**Faculty Staff** means all Staff of the Faculty of Health, Social Care and Education, whether substantively employed by SGUL or by Kingston University and employed pursuant to the terms of the Joint Venture Agreement between SGUL and Kingston University.

**JRES** is the Joint Research and Enterprise Services, responsible for the commercialisation of IP within SGUL.

**Inventive Contribution** means creative effort by an individual that in type and scope qualifies such individual for inventorship status under European patent law

**Licence** is a formal agreement granting rights from one party (the Licensor and owner of the IP Rights) to another party (the Licensee), who thereby is able to exploit the IP through the Rights granted under the terms of the Licence.

**Members of SGUL** are defined in the SGUL Statutes and includes all academic Staff and Students.

**Net Receipts** are the Commercial Revenues received in respect of the IP minus the direct Costs incurred and minus any payments that SGUL is obliged to pay to any external organisation, other than as a share of the Commercial Revenues.

**Normal duties** refer to all lawful duties assigned to employees and any other duties arising out of their employment. For the avoidance of doubt employees who are employed to undertake research are expected to create inventive IP.

**SGUL's Net Receipts** is the Net Receipts held by SGUL which remain after any share is distributed to collaborators outside of SGUL and/or to funding bodies who may be entitled to a share of the Net Receipts.

**Spin-out companies** are new companies that are formed by individuals (who were and still may be employees of a parent organisation) together with the parent organisation, utilising core IP that originated at the parent organisation and that was then transferred to the new company.

**Staff** means all employees of SGUL, including all staff who are jointly employed with other employers including but not limited to NHS Trusts (except for clinical academics employed jointly with NHS Trust).

**Start-up companies** are companies set up by individuals independently of a parent organisation.

**Student(s)** are defined in the Statutes as any person currently registered to receive instruction or supervision in or by SGUL or any other similar arrangements and may apply to any registered student(s) of SGUL whether undergraduate, postgraduate (including whilst writing up a thesis or dissertation) or those on an exchange scheme.

## 4. Exceptions to this policy

- 4.1. Where IP is generated jointly with St George's University Hospitals NHS Foundation Trust, each Creator shall be obliged to adhere to the IP policy of his/her own substantive employer. In the case of a Creator employed by both SGUL and St George's University Hospitals NHS Foundation Trust ("SGFT"), it may be necessary for SGUL and SGFT in consultation with the Creator to identify what work was undertaken on behalf of which organisation and to comply with the IP policy of each organisation in respect of the work done for each. JRES will support the Creators to facilitate the identification of IP ownership and to establish arrangements for IP exploitation.
- 4.2. Where IP is generated jointly with other organisations (apart from St George's University Hospitals NHS Foundation Trust), such as other universities, NHS Trusts or research institutes, the arrangements for exploiting the IP will be negotiated by the Head of Enterprise & Innovation or their nominee within the JRES on a case-by-case basis with the other organisation, taking into account any pre-existing agreements covering the IP generated.
- 4.3. Where research which leads to IP generation is funded by external research funders, any IP conditions in the contract which SGUL has with the research funder shall apply to the IP generated.

## 5. Ownership of IP

### 5.1. Staff

Section 39 of the Patents Act 1977 (as amended) and the Copyright, Designs and Patents Act 1988 (as amended), with any related IP subordinate legislation, make it clear that all forms of IP generated by an employee, made in the course of the employee's normal duties, belong to their employer. Hence, as prescribed by law, any IP created by Staff in the course of their Normal Duties shall be the property of SGUL, whether the IP is developed at SGUL or elsewhere.

Notwithstanding the above, to ensure that due-diligence is applied to IP created by Staff particularly if it is to be commercially exploited, the Creator will formally assign their IP rights to SGUL, including any ownership rights of others (which may include co-Creators and/or the funders of IP generated under research or other agreements), and provide any details of the IP and its creation that may be reasonably required by SGUL to assist in any future commercial exploitation. Where more than one Creator is involved, the Creators themselves shall determine and agree the appropriate share of the IP that they have jointly created.

In the event of a dispute amongst multiple SGUL Creators as to the division of their percent share, the Vice Chancellor of Research and Enterprise will decide, and their decision will be final and binding on the SGUL Creators. The Creators shall have the right to appeal to the Vice Chancellor. Where some Creators are external to SGUL, JRES will work with the SGUL Creators to seek an agreement with the external Creators and their employment organisation.

For the avoidance of doubt, where Staff are assigned by SGUL to carry out projects outside of their Normal Duties those Staff will also be required to assign their rights (including retrospectively if necessary) to any IP created in the course of such projects to SGUL.

## **5.2. Associates**

All Associates shall be required to assign the rights to any IP they create in the course of their SGUL activities to SGUL. This includes where Associates lead or participate in SGUL research projects. SGUL may have obligations to organisations which are funding the research in question which it will not be able to honour without such an assignment of rights being in place.

Associates are treated as if they were Staff for the purposes of revenue sharing. SGUL recognises that, in a limited number of cases (such as Honorary Academics or Visiting Academics who remain employees of another organisation whilst at SGUL), special arrangements may need to be negotiated regarding the ownership and use of IP which they may generate. Such arrangements will be negotiated on a case-by-case basis, generally by the Head of Enterprise or their nominee on behalf of SGUL and with a duly authorised representative of that individual's employer. Any individual who believes that he or she falls within such a category should contact the JRES for advice at the earliest opportunity.

## **5.3. Students**

Where Students generate IP in the course of their study or research, they will own that IP in their own right unless one of the following applies:

- (i) they generate IP which is subject to external agreement; or
- (ii) they generate IP which builds upon existing IP generated by Staff or Associates; or
- (iii) they generate IP jointly with Staff or Associates or under their direct instruction; or
- (iv) they are, or have the status of, Staff (in which case they are treated by SGUL and the law as employees), provided that their inventive contribution was made during their time as a Staff member.

In the above listed circumstances Students will be required to assign IP they have created to SGUL and to comply with, and have the benefits of this policy on the same basis as Staff. In the case where a Student may own a share of the IP beforehand and the further development of that IP is required to be assigned to SGUL, agreement will be made between the Student and the Head of Enterprise or their nominee on behalf of SGUL as to the per cent. Generally, ownership will be retained by the Student and SGUL separately.

Students who wish to benefit by using the expertise of, or funding (whether internal or external) administered by the JRES to protect and commercialise their IP, must agree in consideration for these services to assign such IP to SGUL and to comply with this policy on the same basis as Staff.

#### 5.4. Copyright Material

SGUL owns copyright of all works created in any form by Staff in the course of their employment, or where such works have been specifically commissioned by SGUL, subject to the right of Staff to be recognised as its authors and to freely publish and be paid for contributions to learned books, journal articles, conferences, etc.

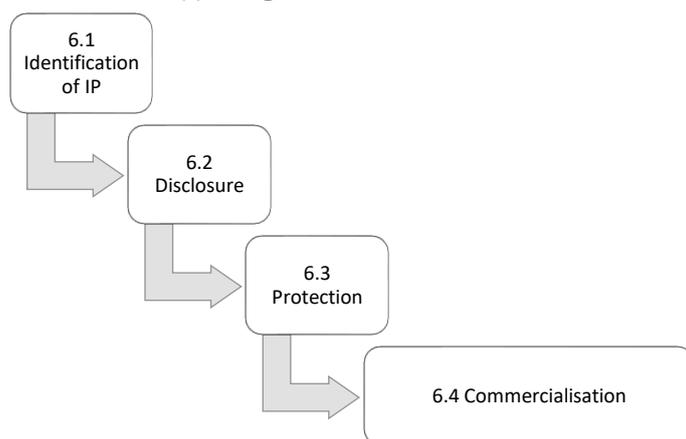
Notwithstanding the above, where efforts are made by SGUL in relation to the commercialisation of such Copyright Material, especially, for example, exploitable software, smart-phone apps and health-related questionnaires, or where more than incidental use of SGUL's resources are used for the generation of the IP, it will be necessary for their Creator(s) to assign their IP rights to SGUL and the revenue share terms under 6.5.1 of this Policy shall take effect.

#### 5.5. Teaching Material

Teaching material, lecture notes, course summaries, examination and test questions belong to SGUL and Staff are not permitted to use these materials outside of SGUL, whether currently employed by SGUL or not. For avoidance of doubt, the revenue share terms under 6.4.1 of this Policy do not apply to Teaching Material.

### 6. Responsibilities and procedures for protecting IP Rights & Commercialising IP

SGUL expects Staff to take all possible steps to ensure that the University is able to maximise the potential impact of any IP by ensuring early identification, retaining confidentiality, facilitating protection and supporting commercialisation.



#### 6.1 Identification

SGUL expects Staff and Students to take all possible steps to ensure that the University is able to maximise the impact of any IP by ensuring early identification and confidentiality. It is expected that the Creator brings the IP to the attention of the JRES as early as possible and cooperates with the JRES in formalising ownership, registering and commercialising the IP. In order to facilitate protection

of the IP, it may be necessary for JRES to request a delay to any publication or public presentation (Public Disclosure) of the research related to the IP (See 6.2.3 Publication).

#### **6.1.1.Record keeping**

Members of SGUL who are carrying out research are required to keep good records of their work in a bound notebook where pages are numbered, and work is dated in accordance with Good Laboratory Practice (GLP). These records can be called upon to show the date of conception of the invention, which may be required to validate a patent or to confirm the rights and ownership in the IP for licensing.

#### **6.1.2.Material Transfer Agreements**

Material Transfer Agreements (MTAs), (available from the JRES) should always be used when transferring material to third parties. All MTAs (including those provided by other institutions and companies) must be agreed (and negotiated if necessary) by the JRES before being formally signed by JRES. When receiving material from another institution or providing material, Members of SGUL should be aware of the implications of the clauses covering IP.

#### **6.1.3.Consultancy Agreements**

All consultancy agreements, whether SGUL-managed or Institutional, should be reviewed by the JRES. The JRES will negotiate the contract on behalf of the member of Staff. In the case of private consultancy arrangements, the JRES must agree the contract to ensure that there is no leakage of institutional IP or obligations on the institution. Consultancy is managed as per the Consultancy Policy 2018.

#### **6.1.4.R&D contracts**

Research and development contracts usually contain a clause which covers IP ownership. All R&D contracts must be agreed by the JRES before being officially signed by JRES. Where possible, SGUL will retain the ownership of any foreground IP developed by SGUL Staff resulting from the contract and may agree commercial terms to a commercial partner for exploitation, consistent with the terms of the underlying contract. The negotiation of such commercial agreements is conducted by the JRES in co-operation with the Principal Investigator and the Creator of the IP.

## **6.2 Public Disclosure**

SGUL encourages publication and dissemination of research by Members of SGUL. However, Members of SGUL wishing to publish or present in a public forum should first consider if any of the work may be patentable or otherwise protectable and if any other IP rights are impacted. For avoidance of doubt, Public Disclosure includes, but is not limited to, academic publications, abstract submissions, poster presentations, conference presentations, PhD Thesis (unless under embargo). If there is doubt as to the commercial value or potential of the research the Members of SGUL involved are expected to discuss with JRES prior to any Public Disclosure. Public Disclosure prior to filing a patent application in most cases will prohibit the protection of the IP and prevent successful commercialisation. Therefore, the timing of any publication related to IP must be agreed by the JRES prior to the submission.

#### **6.2.1 Confidentiality**

Any new IP, inventions and associated information should be kept confidential until after a full evaluation by the JRES for its exploitation potential and, if appropriate, protection. Standard form Confidentiality Agreements (CDAs) (available from the JRES) should be put in place as soon as possible after initial contact with third parties, and before any IP is disclosed. All CDAs (including those provided by other institutions and companies) must be agreed (and negotiated if necessary) by the JRES before being formally signed by JRES.

#### **6.2.2 Publication**

It is important to recognise that filing a patent application and publishing are not mutually exclusive. However, once a patent application has been filed it is usually safe to publish. Publishing prior to filing a patent application in most cases will render the patent application invalid. However, secrecy may be

desirable for commercial reasons; therefore, the timing of any publication related to IP must be agreed by the JRES prior to the submission.

### **6.3 Conflict of Interest**

Creator(s) shall notify the JRES of any actual or potential Conflict of Interest relating to any IP either in their own circumstances or in connection with any other third party and to ensure compliance with SGUL's Conflict of Interest policy.

## 6.4 Protection

### 6.4.1 Patents and other forms of IP requiring registration

Following discussions with the JRES, the Creator must complete a technology disclosure form. The JRES will then review the information provided in discussion with the Creator to ensure that SGUL is the owner of the IP, that the invention is novel and that there is a suitable market for the invention. The JRES will then look at the avenues available for commercial exploitation. Following this review, the JRES will decide whether to:

- (i) protect the IP and exploit it, or
- (ii) where SGUL does not wish to take the invention forward the IP may be assigned to the Creator for the Creator to exploit at his/her own risk and cost and subject to certain terms and conditions to be agreed with the JRES.

Once the initial application has been filed, the appointed patent agent and the JRES will hold a copy in their files. The JRES will keep a record of the status of each Patent application and granted Patent. This will include (a) the title of the Patent; (b) the date of the priority filing, the dates of the International filing, the National Phase filings and the dates of any related divisional applications, examination deadlines, etc.; (c) the full names and contact details of all individuals with a financial interest in the Patent or having an inventive contribution; (d) the names of all organisations that have a financial interest in the Patent and documents which confer these rights; and (e) details of who the IP has been assigned or licensed to or who may have been granted option rights or other access to the IP.

### 6.4.2 Copyright

The Copyright legend (© St George's, University of London, date) should be used on the bottom of all copyright material owned by SGUL, including databases and websites.

### 6.4.3 Agreements

Authority to enter into agreements, including the licensing of IP or other commitments with third parties, or accept obligations on behalf of SGUL is set out in the Financial Regulations and accompanying Schedules of Delegation as varied from time to time. Creators must not enter into agreements or licences which have not been approved in advance by the Head of Enterprise or their nominee. For guidance, advice may be sought from the JRES.

### 6.4.4 Portfolio Management

Each item of IP will be reviewed by the JRES at regular intervals. If it is considered that the IP is unlikely to bring any significant return, then the protection may be allowed to lapse. Before the lapse occurs the Creator(s) will be informed in writing by the Head of Enterprise or their nominee. If the Creator(s) decide that they wish to support the ongoing protection of the IP at their own risk and expense, SGUL may formally assign its interest to the Creator(s) by prior written agreement of the Head of Enterprise or their nominee. The standard terms of such an assignment will be that once Commercial Revenues are received by the assignee, the assignee shall first pay back to SGUL SGUL's Costs (up to the value of the Commercial Revenues) and then 5% of any remaining or future Commercial Revenues.

## 6.5 Commercialisation

JRES is committed to generating impact from research undertaken at SGUL. This may be achieved through licensing IP or supporting the set-up of a spin-out company. After reviewing the commercial value of any IP, JRES will engage the Creator in determining the correct route to market. JRES will manage the commercialisation process, including seeking potential licensors and negotiating contracts. However, projects are likely to be more successful if the Creators remain engaged in the process.

### 6.5.1 Revenue share & Rewards

Payments received for the successful commercialisation of IP through licensing or assignments are treated as commercial revenue. They may take a number of forms, including one-off lump-sum payments, up-front payments, option fees, milestone payments, royalties or other forms. SGUL may on occasion receive shares or other assets instead of money. On the occasions where such gross revenues are received, SGUL will distribute any income/capital receipts in the proportions defined in the table in clause 8.3 below and may hold non-monetary receipts in its own name.

SGUL's Net Receipts will be shared amongst the Creator(s) and SGUL up to £200,000 as follows:

Cumulative SGUL Net Receipts	Creator(s)	SGUL
Up to £10,000	100%	0%
£10,001 - £50,000	80%	20%
£50,001 – £150,000	60%	40%
£150,001 - £200,000*	33 <sup>1</sup> / <sub>3</sub> %	66 <sup>2</sup> / <sub>3</sub> %

\*SGUL will have complete discretion in respect of any sum over £200,000 and will not necessarily repatriate any funds to the Creator(s) Institute(s).

Where more than one Creator is involved, the distribution of their share of the income amongst themselves shall be in accordance with their agreed share of the IP, as described in clause 5.1.

If a Creator leaves SGUL's employment there shall be no consequential change to the share which the Creator receives. When a Creator leaves SGUL's employment, he/she shall have an obligation to leave any physical embodiments of the IP, including data, notebooks, prototypes and equipment in the safe custody of SGUL and shall not make or retain any copies of such material whether physical or digital nor allow any other person to do so.

In the event of the Creator's death, entitlement to royalties shall transfer to the Creator's estate.

### 6.5.2 Calculation of amounts available for distribution

The first claim on the gross Commercial Revenue received will be the Costs incurred. The amount distributable within SGUL will then be reduced by any share which is distributed to Creator(s) outside of SGUL and/or to funding bodies who may be entitled to a share of the Net Receipts. The remaining SGUL's Net Receipts will then be distributed in accordance with the scheme described in 6.5.1 .

### 6.5.3 Staff/Student Start-up Formation

It is permissible for SGUL staff/students to establish a start-up without SGUL becoming a partner. These companies differ from spin-outs in that no access to university IP is required, the company does not rely on any University resources or facilities (for the avoidance of doubt including Staff), and the University will not take any shareholding in the company. However, any Staff/Student that intend to set up a start-up are required to engage with JRES early on in order to ensure that any formal

contractual relationships with the University are put in place. Founders of staff/Student start-ups must refer to and comply with the Conflict of Interest and Financial Dealing Policy 2018.

#### **6.5.4 Spin-out Formation**

The Creator(s), in partnership with the University, may wish to found a company to commercialise the IP. Start-up companies founded by employees/students in which the University has a shareholding are known as 'spin-outs'. The shareholding is given to the University in return for access to University-owned IP, and/or access to University equipment and facilities.

#### **6.5.5 Arrangements for setting up Spin-out companies**

The 'St George's Spin-Out Guidelines' document sets out guidance for the formation of Spin-out companies. In all cases, the shareholdings for the Creators and SGUL will be negotiated according to the circumstances and in line with the Guidelines. Approval of Spin-out arrangements require approval from the Research and Enterprise Committee.

The agreed future arrangements regarding the ownership of the company's shares will be formalised in the Shareholders' Agreement for the Spin-out company which shall be entered into by and between the Head of Enterprise or their nominee on behalf of SGUL and other parties as applicable including the Creator.

Both SGUL and the founder(s) will be represented on the company's board of directors as either a Non-Executive Director or with observer roles (subject to the requirements of any third-party investor or collaborator) for so long as they hold shares in the company.

The arrangements above will also apply to joint ventures where a number of parties other than SGUL and the founders may be involved.

Through the process of setting up a Spin-out, the JRES and Founders will collect a document package that will (at a minimum) contain:

- A memorandum of understanding (MOU) detailing the proposed equity split between institution and founders, what services are required from the TTO and a description of the Company and a summary of its planned activities.
- Company formation documents including articles of association and shareholders agreements based on SGUL approved templates.
- IP holding letter (if applicable)
- Licence or IP Assignment term sheet by which IP is transferred to the Spin-out.
- Information on HMRC academic researcher's tax safe harbour arrangements, as appropriate

## **7. Implementation**

- This policy shall apply to all IP with effect from the date of its adoption at which date this policy shall replace the previous IP Policy dated 18<sup>th</sup> October 2016.

## **8. Related Policies**

- St George's, University of London, Policies and Procedures, Conflicts of Interest and Business Dealings.
- St George's, University of London, Policies and Procedures, Private Earnings including Consultancy and Private Clinical Practice.
- St George's, University of London, Policies and Procedures, Public Interest Disclosure.
- St George's University of London, Consultancy Policy 2018
- St George's University of London, Financial Regulations