

R23. Regulation on Intellectual Property

1. Introduction

The CITY ULE protects and exploits its intellectual property rights.

These regulations have been formulated to provide a framework for the successful accomplishment of technology transfer, the identification, protection and exploitation of potentially valuable research results and the exploitation of potentially profitable creative and scholastic work. By identifying possible routes of exploitation and providing financial incentives for individuals and departments, the regulations are intended to encourage academic staff to identify and to develop commercial projects.

The regulations also set out the ownership and access rights of intellectual property rights created by students.

Reference to the existence of these regulations shall be made in the conditions of employment of staff. Their existence shall also be drawn to the attention of students of the University.

2. Definitions

In this Regulation the following defined terms have the meanings given below:

“Academic Licence” means a worldwide, non-exclusive, perpetual, irrevocable, royalty-free licence for the purposes of teaching and non-commercial research which includes, without limitation, the right to use, copy, modify, distribute original and modified versions to third parties, perform in public, show in public, play in public, broadcast, and make adaptations and translations, all without attribution to any author.

“Commercial IP” means Staff IP, Joint Staff-Student IP, or Joint Staff-Third Party IP that is to be exploited commercially.

“create” and “created” means broadly authored, coded, collated, composed, created, designed, developed, devised, formulated, invented, made, produced, or written.

“Creator(s)” means one or more members of staff and students that created the Commercial IP.

“IP” and “Intellectual Property Rights” means all types of intellectual property rights throughout the world.

“Joint Staff-Student IP” means Intellectual Property Rights created jointly by one or more students in the course of their studies and one or more members of staff in the course of their employment.

“Joint Staff-Third Party IP” means Intellectual Property Rights created jointly by one or more staff in the course of their employment and one or more third parties who are not students.

“Staff IP” means Intellectual Property Rights created by one or more members of staff in the course of their employment.

“Student IP” means Intellectual Property Rights created solely by one or more students in the course of their studies at the University.

3. Ownership of Intellectual Property rights

Intellectual Property rights created by students

The default position is that students own the intellectual property rights they create while studying at the University. The CITY ULE does not assert ownership in Student IP except in the limited exceptions set out in this section.

Exceptions where the CITY ULE takes assignment of Student created IP are:

1. Intellectual Property created jointly with one or more members of staff. This will be treated as Joint Staff-Student IP. See below.
2. Participation in a staff-led project where there is already substantial CITY ULE IP. This will be treated as Staff IP. In this situation the student will be told in advance about the IP arrangements on the project and be offered an alternative project where these restrictions do not apply.
3. Contracts with third parties. This includes, for example, a studentship agreement where a third party funder requires a different arrangement on ownership of intellectual property rights. In the case of a funded PhD studentship, the CITY ULE would require the funder that the student retains ownership in the copyright in his/her thesis to allow for publication.
4. Where the student is employed by the University. In this case, the student would be treated as a member of staff under this Regulation. Note that students in receipt of studentship funding are not normally employees of the CITY ULE.

4. Intellectual Property rights created by staff

Except as stated below, the CITY ULE shall own all Staff IP. Each member of staff shall do all further acts and execute any further documents reasonably required by the CITY ULE to give effect to this section.

The CITY ULE does not assert ownership of copyright in the following Staff IP unless specifically commissioned by the University:

1. Books and articles (including journalism)
2. Modules Material

In this section: “commissioned” means a situation where the CITY ULE employs a member of staff specifically to create a copyrighted work under any of the above.

The CITY ULE’s rights in relation to staff IP may be waived or modified by agreement in writing with the staff member concerned.

5. Intellectual Property rights created jointly by a student and member of staff

The CITY ULE shall solely own Joint Staff-Student IP.

Any student who contributed to the creation of Joint Staff-Student IP shall be treated as though they were a member of staff for the purposes of exploitation of Intellectual property rights below.

Intellectual Property rights created by visitors

Visitors to the CITY ULE will normally own the Intellectual Property Rights they create while accessing CITY ULE resources unless there is an agreement to the contrary.

6. Intellectual Property rights created jointly by a member of staff and third parties

In the event of Joint Staff-Third Party IP, the CITY ULE shall negotiate ownership arrangements with the third party concerned. Such arrangement shall cover the respective ownership interests of the CITY ULE and the third party, how the IP will be protected, who will pay the costs of protection, and who will be responsible for exploiting the IP.

7. Access to Intellectual Property rights

7.1 Licence in student IP to the CITY ULE

Each student grants the CITY ULE a non-exclusive, perpetual royalty-free licence to use its Student IP for the purposes of examination of that student. This includes sharing the Student IP with third parties, such as external examiners and providers of anti-plagiarism software.

7.2 Licence in staff IP to the CITY ULE

Each staff member grants the CITY ULE an Academic Licence to any Staff IP not transferred to the CITY ULE under regulation "Intellectual property rights created by staff" above.

Each staff member grants the CITY ULE an Academic Licence to their teaching materials and lectures, including the right to put those teaching materials and recordings of lectures on the CITY ULE's virtual learning environment (VLE).

Each staff member grants the CITY ULE a non-exclusive, irrevocable, worldwide, sub-licensable licence to make manuscripts of scholarly articles and conference papers publicly available under the terms of a Creative Commons Attribution licence CCBY (or under an alternative open licence if requested eg by third party funder).

8. Intellectual Property considerations in research contracts

The CITY ULE will seek to retain ownership of new Intellectual Property Rights created by its staff in the performance of a research contract. As a matter of principle, the CITY ULE will normally only transfer ownership of new IP to a third party funder if that funder pays at least the full cost for the work. The CITY ULE may also negotiate royalties for commercial use of the IP. If the CITY ULE transfers ownership of IP to a third party, the CITY ULE will require an Academic Licence back to that IP.

The CITY ULE will as a general rule seek to preserve the rights of staff members to publish material arising from research as they think fit. In commercially sensitive cases however the CITY

ULE will be prepared to agree to a delay on publication for a period of time to allow for filing of a patent application.

9. Disclosure of new Intellectual Property rights

If a member of staff creates IP that might be Commercial IP, he/she shall promptly report the existence of the IP to CITY ULE in writing (including by email) prior to making any public disclosure.

CITY ULE shall consider whether the disclosed IP is Commercial IP in accordance with CITY ULE policy on the disclosure and commercialisation.

10. Assignment of rights to creator(s)

If the CITY ULE declines to protect and commercialise Commercial IP, the CITY ULE shall (subject to any rights of third parties) offer the Creators an opportunity to take assignment of the Commercial IP. In this event:

- the Creators shall be solely responsible for all costs in protecting and exploiting the Commercial IP;
- the Creators shall reimburse the CITY ULE for any external patent costs to date;
- the CITY ULE shall not share in any profit from the exploitation of the Commercial IP; and
- the CITY ULE shall retain an Academic Licence to the Commercial IP.

11. Dispute resolution

11.1 Informal mediation

In the case of a dispute between Creators, or between the Creator and the CITY ULE in relation to a matter under this Regulation, the Vice-Provost (Research and Innovation) shall act as an informal mediator to attempt to resolve the dispute.

11.2 Final determination

In the event a dispute between the Creators cannot be resolved, the matter shall be referred to the Vice-President & Principal (or his/her designate) for final determination.