

Policy for intellectual property rights (IPR) at the University of Agder

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Replaces 'Reglement for håndtering av immaterielle rettigheter ved UiA' (Norwegian only)

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1. Introduction – the need for, and purpose of, an IPR policy

IPR is an abbreviation of ‘intellectual property rights’, referring to the protection of inventions, authorial, and artistic work, symbols, names, logos, designs and other innovations. IPR includes industrial rights (patents and designs) and intellectual products, domains, business secrets etc.

Both the Act Relating to Universities and University Colleges (1 April 2005, no. 15) and the Act Relating to the Right to Employees’ Inventions (17 April 1970, no. 21), hereafter the Employee Invention Act, make it clear that the universities, as part of their responsibilities towards the community, have a duty to facilitate for the commercial use of research results. The consequence is that the University of Agder needs to have a policy for dealing with immaterial rights resulting from the professional activities of university staff. The rights policy establishes to what degree the university can and should require that rights are transferred. A transfer of rights also entails a transfer of the responsibility to ensure that results are used and the expenses linked to commercial use. To the extent that rights are transferred to the university, the rights policy sets out how net earnings from commercial use of work results should be distributed. The distribution of earnings is based on the tripartite principle, which is presented in section 7 of this document.

The rights policy is based on the principles of the Copyright Act (Act No. 2 of May 12, 1961) and the Employee Invention Act and must be seen in relation to these. The policy is meant to contribute to:

- The preservation of academic freedom for both researchers and institution
- Increased awareness of the significance of the values represented by the research results
- Increased awareness of the significance of maintaining and protecting research results
- Creating an unambiguous and predictable context for internal and external partners
- Increased opportunities for efficient and purposeful use of research results within academia, society and business life.

2. Who is subject to the rights policy?

The rights policy applies to all employees at the University of Agder, both academic and technical-administrative staff. In many cases, the university’s rights concerning results produced by university employees in their professional capacity will be evident from the individual work agreement. However, the principle of the freedom of research and teaching, as set out in the Act relating to universities and university colleges section 1-5, clearly states that general principles of the transfer of rights to the employer are not automatically applicable to academic staff. This group of employees, therefore, has the greatest need for clarification concerning the relationship between employer and employee as regards intellectual property rights.

2.1. Concerning the rights of students

The legal basis here is that students are holders of the right to what they produce as part of their studies, be it intellectual property or patentable inventions. The university’s use of such products therefore presupposes an agreement with the students.

There is an increasing tendency - and this is also a strategic goal - that students get more actively involved in research projects. This actualises the need for a standard agreement on IPR rights with involved students.

In projects which are wholly or partially financed by the Research Council of Norway or EU – institutions, it is a requirement that the participating institutions are able to benefit from the project's results. In connection with such projects, there is a need to enter into special transfer agreements with each individual student.

In other cases too, the university will be able to acquire students' rights for the purposes of commercial use through voluntary transfer. This will be in cases where the student so requests it, or when UIA Nyskaping, after a commercial assessment of the results, deems acquisition to be both expedient and desirable.

However, students who are employed, for instance in a project or as a research assistant, will be treated as other employees as far as their work results are connected to tasks assigned to the position.

For results produced by one or more students and one or more employees in joint ownership, the university is entitled to acquire the employee's share of the ownership in compliance with current legislation, rights policy and possible existing agreements.

3. What is subject to the Intellectual Property Rights policy?

3.1. The legal basis for transferring rights

All the immaterial rights discussed below, apart from the rights to databases (see 3.5) can only be properties of physical persons. If the university is to acquire the rights to such results, these must be transferred from the person in question or those who have brought about the current results at the university.

For patentable inventions, the university is entitled to acquire the rights pursuant to the Employees Inventions Act, section 6, subsection one. However, academic staff at the university still hold the right to publish the invention if the university is so notified when the invention is reported and the rights of any third-party do not prevent publication.

The basic principle in the Copyright Act as formulated in section 1, subsection 1, is that the creator of an intellectual or artistic work also holds the copyright to the work. In order to acquire the rights to an intellectual/artistic work, an agreement to this effect has to be in existence. However, the agreement need not be explicit, but may be inferred from the work agreement between the employee and the university. The general point of view, stated in the non-statutory Knop doctrine, is that the employer *'wins the right to the intellectual work which is necessary and reasonable if the work agreement is to fulfill its purpose, but nothing more'*. This underlines the fact that we rarely observe a complete transfer of copyrights, merely the right of use to the extent that it is necessary for the work to fulfill its purpose.

In the case of computer programs, on the other hand, the basic principle is the opposite. See Copyright Act, section 39g; the general rule here is that unless otherwise agreed, the university as

employer acquires the rights to computer programs developed by employees as part of their professional activities.

3.2. Non-fiction publications and teaching materials

Non-fiction publications and other research – and teaching materials produced as a result of a staff member’s professional activities at UIA - will normally be protected by copyright: See Copyright Act section 1, subsection 1 and 2. The employee(s) who is/are responsible for the product will then, unless otherwise agreed, have exclusive right to produce copies and make the materials available to the public.

3.3. Patentable inventions

Patents can be granted to inventions that are useful for industrial application, for inventions which are new in relation to what was known before the filing date of the patent application, and which also differ essentially therefrom - see The Patents Act section one, subsection 1, see also section 2, subsection 1. The patent holder will have an exclusive right of limited duration to exploit the invention for business or operational purposes.

3.4. Computer programs

The individual who develops a computer program also has the copyright to it: See the Copyright Act, section 1, subsection 1. If the program has been developed in the course of the employee’s professional activities, the main rule is that the university acquires the rights to the program, see Copyright Act, section 39g.

A computer program may be anything from an operating system to an app for mobile phones or tablets. It is the program’s source code/code language which constitutes the intellectual property. Inventions that utilise a computer program may in some situations be patented: See Patents Act section 1, subsection 1 and 2 and section 2, subsection 1.

3.5. Databases

Databases, while not being qualified for protection as intellectual property, have been given special protection in the Copyright Act, section 43, subsection 1:

‘The person who brings about a formula, a catalogue, a table, a program, a database or similar work which places together a major amount of information, or which is the result of a significant investment, has an exclusive right to ownership of the whole or significant parts of the work’s content by producing copies and by making the work available to the public’.

Pursuant to the requirement for ‘significant investment’, database protection may function in relation to both small and large amounts of data if the requirement of significance is fulfilled.

The copyright holder of a database is, according to the Copyright Act, section 43, the person or institution who is behind the financing of the product. In most cases this will be the university, possibly also external parties who have contributed to the development of the database. An employee who has been paid for the working hours spent on developing the database, and who has

taken no financial risks, is not be considered as a copyright holder under the Copyright Act, section 43.

3.6. Physical objects

In some cases, physical objects will be the object of, or the result of, research at the university. The term 'physical objects' in the rights policy must be interpreted broadly to refer to any material product (organic, inorganic, and biological), including substances, organisms, crops and materials. The right to physical objects of this kind is different from the other rights discussed in the university's rights policy in the sense that they involve the right of ownership.

Physical objects as mentioned above will be the property of the university insofar as this does not conflict with the rights of any third party.

3.7. Other rights

In principle, there are some products at the university that may be given protection, such as brands, designs, circuit patterns or improved plant species. However, it is not likely that these intellectual property rights play, or will play, a significant role in the university's activities in the foreseeable future.

All these categories of results of professional academic activities are included in UiA's rights policy and the university may require ownership or right of use. Whether or not the university will seek to acquire the rights will in each case be the subject of an assessment.

For patentable inventions, the university will, as a general rule, require ownership: See Employee Invention Act, section 4. The minimum degree of ownership required by the university in relation to patentable inventions is one third.

4. Rights policy for the various results

4.1. Notification requirement

All employees at UiA have an obligation to notify the university about new inventions. According to the Copyright Law, in some instances a notification requirement for computer programs and databases may also apply. Examples of other results that could be reported to the university include ideas or physical material with a potential for commercial use, for example labels and designs. The notification requirement is fulfilled by filling in a DOFI – form. This form can be found on the webpages of UiA Nyskaping and will also be available in a paper-based version in their offices. UiA Nyskaping will, if necessary, also provide help filling in the form.

4.2. Non-fictional presentations, materials for teaching and dissemination

The basis of the rights policy is that the university as a general rule should not interfere with the employees' access to publishing their own non-fictional production. Nor does the university acquire rights to commercialisation of 'personal' teaching materials, unless otherwise is agreed. 'Personal' teaching materials include for instance lectures with support materials like

manuscripts and handouts. [Concerning UiAs right of use to 'personal' teaching materials used in connection with the teaching at UiA, see information texts on the intranet.]

The university does, however, have temporary right of use to such materials if:

- They are standardised and for general use
- UiA has contributed significant resources in the form of money, technical assistance or working hours
- UiA has made an agreement with a third party for a commissioned work specifically for the teaching in question
- Use has been agreed with the producer or in another way.

The following terms apply to UiA's right of use:

- The right of use may not extend beyond what is justified by the university's assignments.
- The right of use should not limit the right of use for the employee
- The employee should keep his/her ideal rights (the right to be named)
- The employee must be given the opportunity have his/her name removed
- The employee must be able to oppose changes that could be considered offensive
- The employee must be able to withdraw the university's right of use to materials that are professionally outdated

UiA's right of use is especially relevant in relation to digital teaching arrangements, for instance those developed by PULS or as individual projects. To the degree that such materials can be used for commercial purposes outside the university, typically at other higher education institutions, the question of rights must be clarified through a separate agreement between the employer and the employees.

Questions concerning UiA's ownership in these cases must be clarified with the employee. If doubts or disagreements concerning ownership should arise between the employee and the university, the issue is to be reported to the Department of Research Management. If needed, the Department of Academic Affairs will also be involved. All parties will have the opportunity to present their views on the case, and the department will, on that basis, attempt to come up with an out-of-court settlement that can be submitted to the University Director for a decision in the matter.

UiA cannot, by virtue of the employment relationship, require any rights to the oral teaching of the employee, but may facilitate for real-time digital transfer without recording/storage. UiA may also, in certain cases of specially adapted teaching, record a lecture and deposit it in a closed room with access only for selected students for a limited period of time. Facilitation of this kind must be clarified in advance.

Any streaming and publication of lectures on UiA's webpages must take place only on the basis of an agreement between employer and employee.

4.3. Patentable inventions

As employer, the university is, according to the Employee Invention Act, entitled to require transferred to itself *'in this kingdom patentable inventions'* that fall within its range of action. Any kind of invention may be patented if legal requirements are met.

The employee is obliged to notify UiA about patentable inventions. The notification requirement is set out in the Employee Invention Act and is fulfilled by filling in a DOFI – form. As stated above (4.1), the DOFI form can be found on the webpages of UiA Nyskaping and will also be available in a paper-based version in their offices. UiA Nyskaping will, if necessary, also provide help with filling in the form.

After a dialogue with the employee, UiA Nyskaping will submit its proposal concerning ownership to the Department of Research Management. Based on this proposal, the Division of Research Management will prepare case documents which will then be submitted to the University Director for a final decision in the matter.

It is essential that the invention is not publicised before the application for patent has been submitted; publication may prevent a successful outcome of the application. The employee should therefore refrain from making the invention available to others until the university has decided if, and to what extent, it should require ownership. If ownership is required, the employee should not make the invention available until the application for patent has been submitted.

As set out in the Employee Invention Act, section 6, employees may choose to publicise rather than apply for a patent. However, even if the employee chooses this alternative, notification is still required. In the notification, the employee should state explicitly that he/she chooses the option of publishing. The university must then provide a response in writing within 20 working days. If needed, the parties must enter into a dialogue concerning the conditions for publication, including publication channels and a preliminary date of publication.

After the application for patent has been submitted, the employee is free to publicise the invention, for example as a talk or as part of a non-fictional publication, as described in the patent application and in consultation with UiA.

4.4. Non-patentable inventions

The Employee Invention Act does not include inventions that are not legally patentable. The rights to such inventions are held by the employee, unless otherwise is agreed, or should be regarded as agreed, or unless the employee chooses a voluntary transfer of the invention to the university.

However, the notification requirement also applies to non-patentable inventions, see 4.1. This is because it is difficult at an early stage to decide what are, and what are not, patentable inventions. Furthermore, there will also be instances where non-patentable inventions can be commercialised through, for example, license agreements. After a concrete assessment, the university could also require ownership of non-patentable inventions.

4.5. Catalogues and databases

The Copyright Act, section 43, adjusts the rights to databases and catalogues pursuant to the regulation that *'The person who brings about a formula, a catalogue, a table, a program, a database or similar work which places together a major amount of information, or which is the result of a*

significant investment, has an exclusive right to ownership of the whole or significant parts of the work's content by producing copies and by making the work available to the public'.

In most cases, the "significant investment" will come from UiA, thus giving UiA the rights to catalogues, databases etc.

Exercising the "exclusive right" should not come into conflict with the principle of academic freedom or prevent catalogues and databases from being made publicly available, or available for research purposes.

If a database is constructed so that a third party may have rights to parts of its contents, it is important that UiA, prior to the project's commencement, secures the rights to use such parts through agreements with employees and possible third parties.

If an employee finds that a database can be used commercially, the university should be notified by using a DOFI form: See also 4.1.

4.6. Physical objects

The result of research at UiA will, in some cases, also involve physical objects. The rights to such objects are different from the other rights discussed in this document in that they involve ownership rights, not immaterial rights. However, the administration of physical objects used in research or those that appear as a result of research is so connected to the rest of UiA's rights administration that it serves a purpose to include the administration of physical objects in the rights policy.

Physical objects that are a result of UiA investments, and that have come into existence by using UiA resources, are the university's property and may be freely used for teaching, research, and commercialisation purposes, unless this is in conflict with, or may potentially be in conflict with, existing agreements or third-party rights.

If an employee is considering the commercial use of physical objects, the university should be notified by using a DOFI form: See also 4.1.

The person who has brought forth the materials has the right to lifelong access and use. Moreover, he/she has the right to share the materials with others on the following conditions:

- Some of the materials must remain at UiA; i.e. one should normally not empty the source.
- The recipient must not pass on materials to a third party without the consent of UiA
- Physical objects must be shared with others only for research purposes; sharing for commercial purposes requires a special agreement
- A signed agreement concerning the use of the released materials must be obtained before (a) dispatch takes place

4.7. Computer programs

Unless otherwise is agreed, UiA holds the rights to computer programs developed by the employee as a result of the working relationship, or UiA direction: See Copyright Act, section 39g.

The employee is obliged to notify the university about work related to computer programs. If a program turns out to be patentable, it should not be introduced before patenting has taken place.

UiA's rights to computer programs should not in any way be an obstacle to the employee's rights of use, for instance in the case of software licenses (Open Source).

4.8. Other literary and artistic works

The general rule is that it is up to the employee to decide how his/her own literary and artistic works are to be used (e.g. copying, filing, and as regards changes and publication): See Copyright Act, section 1. In special, justified cases, UiA may have a non-exclusive, limited right to use such results. This applies especially where the university has invested considerable resources in the preparation process.

4.9. Returning transferred rights

In cases where UiA, after having gained ownership of an invention/project/work result based on legal authority or agreement as described above, decides to

- not continue with a patent or
- not wish to or be unable to find a commercial basis for continuing with a project, the university will offer a return of the rights to the employee.

In such cases, an agreement should be entered into between the two parties. The employee thereby commits to fulfilling all obligations incurred by UiA in relation to third parties that have financed research leading to the invention. UiA will nevertheless hold the right to use the invention free of charge for teaching and research purposes at the university.

Should the employee not wish to take over the rights, UiA may decide not to hold on to them, the consequence being that the university has no further obligations to support the commercialisation of the results.

Decisions concerning the return of ownership are made by the University Director after precisely defined case processing: See section 6 of this document.

5. Special conditions connected to contracts with external actors

5.1. The need for contractual regulations in research cooperation

All research cooperation with external institutions must be based on written agreements, which includes adjustments of rights issues.

The University Act states that UiA is not entitled to enter into agreements that allow for permanent secrecy concerning research results obtained by employees at UiA. If a postponement of publication is necessary to secure patent rights etc, the parties may agree upon a temporary agreement to this effect. UiA has an unconditional obligation to ensure that research results are available for further research at the institution. In addition to what is mentioned above, ownership and exploitation of rights will be the object of negotiations between UiA and current potential cooperation partners. UiA must in all instances do its utmost to make society reap the benefits of research.

5.2. Results created by an employee with multiple employers

If work results have been achieved partly with a secondary employer and partly in the employee's working hours at UiA, or using UiA resources, UiA will have part-ownership to the work results.

However, UiA's rights policy is intended to promote productive ways of cooperation with external parties. This principle should be applied when entering into cooperation agreements which involve shared employer's responsibilities, and in cases of double employment without a framework agreement. Essentially, the rights to commercial exploitation of work results should be held by the main employer (UiA) when the additional position does not include a research component of a certain extent. If the additional position involves a significant research component, the rights should be held by the institution with the greatest 'inventor's share', or the institution the parties (the employers and the employee) have agreed upon in advance in connection with the double employment situation.

If no adjustment of rights has taken place prior to achieved results, and the results, given the circumstances, are considered to be owned jointly by both employers, an agreement is to be entered into which adjusts commercialisation and the possible transfer of rights to one of the parties with compensation.

6. Commercialisation and distribution of net earnings

All employees at UiA should be treated equally in terms of economy, meaning that both scientific and technical/administrative employees are to receive an equal share of net earnings.

As a main rule, UiA uses the tripartite principle, which is based on ownership and net earnings being equally shared between the participants. In most cases, these will be UiA, the employee, and UiA Nyskaping, and/or an external commercialisation partner.

50% of UiA's share should be allocated to the current Faculty - possibly to the administrative unit of the employee. It is assumed that the Faculty will use these funds for development and research grants for academic environments and for innovation purposes. Net accumulated earnings are allocated to innovation activities at UiA in accordance with possible guidelines from the Board. Earnings allocated to the inventor are paid out in money in connection with the annual settlement. If commercialisation takes place by establishing a limited company as license holder, payment may take place subsequent to a sale of company shares.

If income/earnings accrue by exploitation of work results in cases where UiA has not required a transfer of rights, or if the rights have been returned to the inventor, UiA should, in accordance with the standard norms of distribution, be entitled to two thirds of the net earnings that are generated through commercial exploitation of the work results.

If an employee neglects his/her duty to report a work result to UiA/UiA Nyskaping, and instead chooses to exploit the results personally or through others, UiA shall, in accordance with the standard norms of distribution, be entitled to two thirds of the net earnings that have been generated through commercial exploitation of the work results.

If doubts or disagreements should arise between an employee and UiA concerning ownership of rights or distribution of net earnings from the commercialisation of research results, the situation is to be reported to the Department of Research Management. The department will, after having consulted UiA Nyskaping, give all the parties the opportunity to present their views on the matter.

Based on these presentations, the department will attempt to reach an out-of-court settlement which will then be submitted to the University Director for a decision.

If the University Director's decision does not satisfy all involved parties, the complainant may ask the University Director to establish an ad hoc IPR committee. The composition of the committee must safeguard its independence in relation to both UiA and the employees.

The IPR committee, which is appointed on a case-by-case basis, shall have the following mandate:

“Based on the adopted rights policy of the University of Agder, the committee will consider cases and give advisory statements in disputes between employees and UiA”

Cases that do not fall under the provisions of the Employee Invention Act may, unless they are solved internally between the parties, be brought before the Conciliation Board for Employees' Inventions (Meklingsnemda), pursuant to Section 12 of the Act.

In all cases, disputes about rights and distribution of earnings may also be brought before a court of law.

7. Principles of distribution of earnings linked to shares

An invention or other results of research that can be exploited commercially may give rise to the incorporation of a company. In connection with the establishment of a business enterprise based on the technology of a commercialisation project, the price of the technology is negotiated in the company shares and balanced against other investments in the company. The point of departure for distribution to owners is a one third division between employee(s), UiA and UiA Nyskaping, and/or another external commercialisation party, but this distribution will depend on whether possible partners are invited to become owners.

7.1. Share subscription and share issue

The individual employee and UiA can subscribe for shares and will also be owners of the company, with possible selected partners that are invited in as owners. Over time, the company will need more capital, and the Board and owners will carry out share issues. It is natural that the owners should be asked to participate in the share issue, but also that, with the arrival of new owners, the shareholding of the original owners will decrease in the wake of the share issue. The purpose is to raise necessary capital for further development of the company, and that new owners will be able to contribute with capital and new competence.

Any wish to subscribe for shares, both when a corporate company is established and in case of possible share issues, must be submitted to the University Board. The Board will then decide on the matter based on the current Regulations for Financial Management in the Government Administration.

When a corporate company is established, earnings for owners/shareholders accrue as shares of possible dividends and /or as gains from share issues.

7.2. The employee refrains from share subscription

If the employee does not wish to take part in establishing a corporate company, the idea may be transferred to the University, which may then subscribe to shares, giving the employee a percentage of the annual result as compensation. The compensation rate will be the subject of negotiations, but tentatively the original owner of the idea may receive 10% of the annual result for a specified period, subsequent to the establishment of the company.

7.3. Administration of UiA's proprietary position

UiA will only in exceptional cases become the direct owner and administer the ownership in newly established companies. In a running dialogue with the Director of Finances and within established guidelines set by the University Director, UiA Nyskaping will administer the ownership of newly established companies on behalf of the university until any exit, possibly together with an external partner, and UiA will then have its share of the earnings.

Administrative arrangements as described above are not static and can be changed.

8. General observations about the commercialisation of research and work results

The purpose of commercialisation is to spread and disseminate knowledge that benefits society as well as to contribute to bring forth resources to the research environment where the current result has been achieved.

Commercialisation activities must not come into conflict with the principle of academic freedom. The employee is free to give priority to publication and to choose that the results be made publicly available, even though this may reduce the opportunities for commercialisation.

As described in this document, employees at UiA have a duty to report certain kinds of research results. The University will, through UiA Nyskaping, and in cooperation with the employee, consider whether an attempt should be made at commercialisation. When the commercialisation process begins, the employee should inform his/her Head of Department/immediate superior. In addition to an assessment linked to commercialisation, UiA Nyskaping must, in their examination of the DOFI form, also assess whether to enter into an agreement concerning spin-offs from the reported research results.

Concerning the assessment of whether there is a basis for the commercialisation of an invention, it may be relevant to cooperate with a Technology Transfer Office and/or a Commercialisation Actor (CA). These will then have the task of assessing the potential for commercialisation, and maybe possibly also contribute to the commercialisation of the invention. UiA, represented by UiA Nyskaping, will then enter into an agreement with the current TTO/CA, and make use of the available expertise. UiA Nyskaping functions as a mediator of expertise between the individual researcher and the TTO/CA. Since the areas of expertise of the different TTOs/Cas vary, the function of UiA Nyskaping is to find the most relevant TTO/CA in each case and thereby establish a favourable situation for the researcher and the current commercialisation project.

If UiA chooses not to exploit a research result, or fails to continue with commercialisation within a given closing date, the employee may enter into an agreement with the university and use the results.

9. Attachments and references

This section will include current attachments and references, primarily as clickable links. Examples include current university board decisions and references to UIA Nyskaping with a description of their role in UiA's commercialisation activities. Furthermore, the section will include the DOFI form with guidelines for completion.