

Policy Document

Reference: G03

Intellectual Property

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| Policy Author: | Academic Development Manager |
| Executive Lead: | Director of Research & Development |

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Statement on Trust Policies

The latest version of 'Statement on Trust Policies' applies to this policy and can be accessed [here](#)

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1. INTRODUCTION

All employees of the University Hospitals of North Midlands NHS Trust have the potential to generate significant valuable intellectual property (IP) from both within and outside research and development activities. In some cases it will be necessary to protect this IP, to ensure that it benefits the health of our patients, the interests of the inventor, the terms and conditions of research funders, and the financial position of the Trust.

Intellectual property can be defined as the product of intellectual or creative activity in the form of novel ideas, innovation or research and development (R&D). Like most commodities IP has the potential to be exploited through licensing or sale.

Acquiring legal recognition in the form of intellectual property rights (IPR) is an important part of protecting the exploitation process. IPR can be held as a patent, design, copyright, trade mark, database or as confidential "know how". These are further defined under section 4. Definitions.

Given the potential value of IP to the NHS, it is essential that the Trust instigate a policy to facilitate its protection. The NHS executive has adopted a Policy Framework for the management of intellectual property within the NHS (HSC1998/106) which will ensure that IP is owned and exploited in the best interests of the NHS. The NHS policy framework and guidelines place a duty on the Trust to audit, protect and exploit its intellectual property (IP) and its intention to be at the forefront of these initiatives.

2. STATEMENT

University Hospitals of North Midlands NHS Trust is committed to supporting and facilitating staff in the development and implementation of innovations. The purpose of this policy is to enable the Trust to identify, protect and manage all intellectual property that involves its employees, by clearly defining the responsibilities of all those involved.

3. SCOPE

The Trust recognises that its staff from all disciplines or activity can generate new ideas, innovations or new inventions, which might lead to improvements in the delivery of healthcare.

Persons covered by this policy include:

- All staff that are full or part time employees of UHNM NHS Trust.
- Staff with Trust contracts of employment who are undergoing further education or are involved with joint academic research with another organisation or who have an honorary research appointment at an academic institution.
- Staff with Trust contracts of employment whose payroll costs are partially or wholly funded by another party (e.g. a medical charity, a university, a government department) unless the contract between the Trust and that party assigns ownership of any IP to that party.
- Trainee professionals hosted by the Trust who generate IP in the course of their training.
- Trust staff seconded to another organisation or employees of another organisation hosted by the Trust under contract are subject to the arrangements for the ownership of IP agreed between the Trust and that organisation.
- Staff who generate IP outside normal working hours and/or away from the place of work, where the IP relates to their area of employment or their normal duties within the Trust.

4. DEFINITIONS

TRUST

Where it is appropriate the Trust is used as meaning University Hospitals of North Midlands NHS Trust.

COPYRIGHT

Copyright covers written information (such as leaflets, articles, assessment tools and training packs), databases, computer software and films/videos, which can all be protected by copyright. Copyright is attained automatically when IP is created. However, it is advisable to attach a statement for additional protection, such as,

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PATENTS

Patents can be used to protect inventions that embody a new idea and are capable of being manufactured or used by industry (such as devices, processes or methods of operation). Examples of exclusions would be methods of treatment of the human/animal body by surgery or therapy, or diagnostic methods. An invention must not have been made public anywhere in the world prior to the patent filing date (journals, internet, meetings, posters, etc.) and must not be an obvious development, with regard to what is already common knowledge to someone who is experienced in the relevant field.

DESIGN RIGHTS

Design rights may be registered or unregistered and protect against deliberate copying of the shape or configuration of an object. Registering a design right protects unique aspects of the object's aesthetic appearance but does not cover its function. Design rights may exist in addition to other forms of protection such as a patent or copyright.

TRADEMARKS

A trademark is a sign or symbol that is used to distinguish a product or service from that produced or supplied by another business. The terms "sign" and "symbol" include logos, slogans, words, colours and 3-D shapes.

Registering a Trademark protects the owner from competitors also trying to use that sign or symbol to promote their own products. Trademarks can be very valuable in protecting the market position of an organisation or product.

KNOW-HOW

Confidential information or "know-how" is information which may be commercially or technically valuable and which is regarded as secret. It may, for example, include information on industrial processes.

In all cases, the "know-how" will only retain its value if it is managed effectively. All exploitation partners, business partners and collaborators should be bound by conditions of confidentiality through a Confidentiality and Non-disclosure Agreement (often referred to as a CDA or NDA). This may be a reciprocal agreement whereby confidential information is both disclosed and received. A Confidentiality and Non-disclosure Agreement may be obtained from the Trust's Research & Development Directorate .

Know-how and confidential information can be bought, sold and licenced like any other form of IP and persists indefinitely, as long as it remains "secret".

5. ROLES AND RESPONSIBILITIES

It is the responsibility of the Research & Development Directorate to manage and protect IP for the Trust. For information and advice on any matter regarding IP and its protection please speak to the Academic Development Manager in the first instance.

It is the responsibility of the employees to, at the earliest opportunity, inform the Trust using the Innovation Disclosure Form (see Appendix 2), about identified or potential IP arising from their activities and should not unilaterally sell, assign, licence, give or otherwise trade the IP since this is likely to compromise its subsequent value.

Any IP with the potential to be exploited must not be disclosed to anyone outside the Trust (including presenting papers or posters at conferences, abstracts, chapters in books and any other verbal or written communication) until IP advice has been sought from the Research & Development Department. IP cannot normally be protected (especially in the case of filing patents) once prior informal disclosure has occurred.

The Research & Development Directorate is responsible for maintaining a register of all the IP owned by the Trust, including the date it was reported to the Research & Development Directorate. Records will also be kept of arrangements entered into by the Trust for the protection and subsequent use of the Intellectual Property, including any disclosures made to a third party.

It is the responsibility of the Research & Development Directorate to ensure that the originator of any IP is kept fully informed as to progress in relation to its protection, exploitation and commercialisation. This will be done through regular correspondence and meetings.

All commercial exploitation activity is co-ordinated by the Research and Development Directorate. Members of staff who are the originators of IP are expected to co-operate with those responsible for its exploitation so that the maximum possible benefit is obtained.

The Trust is not obliged to seek protection for IP in all cases. Protection will be sought where a viable commercial case is demonstrated.

6. EDUCATION/TRAINING AND PLAN OF IMPLEMENTATION

IP issues will be included in general R&D training initiatives as and when these take place in the Trust. All new employees with an interest in in R&D will have the Trust Policy for Intellectual Property brought to their attention.

All training should be recorded within the personal staff record, ideally within ESR. For help and advice around Training and Education please contact the Academic Development Manager.

7. MONITORING AND REVIEW ARRANGEMENTS

7.1 Monitoring Arrangements

| Aspect of compliance or effectiveness being monitored | Monitoring method | Individual department responsible for the monitoring | Frequency of the monitoring activity | Department which will receive the findings/monitoring report | Department responsible for ensuring that the actions are completed |
|---|-------------------|--|--------------------------------------|--|--|
| Disclosure of IP | Audit | Research & Development Directorate | Annual | R&D Directorate Board | R&D Directorate Board |

7.2 Review

This policy will be reviewed in three years by the R&D Commercialisation and IP Oversight Group.

APPENDIX 1 - INTELLECTUAL PROPERTY GUIDELINES

6.1 OWNERSHIP OF INTELLECTUAL PROPERTY

Generally speaking, UK law provides that (unless otherwise agreed) any intellectual property produced by employees in the course of their employment or normal duties belongs to their employer. Therefore, in cases where an employee of a Trust is engaged in activities at that Trust, IP ownership rests with the Trust that employs the person at the time that any IP is originated.

In the case of joint appointments where part of a Trust employee's payroll costs are partially or totally funded by another party (for example a university, a medical charity or a commercial sponsor and including where a Trust employee is seconded to another organisation) then, in accordance with UK law, normally the Trust holding the employment contract will own the IP generated by that employee. This position is, however, subject to agreement between the parties.

Any IP produced by Trust employees outside normal working hours and/or away from their place of work, that is outside the scope of, and/or unconnected with their normal duties, will belong to the employee. 'Normal duties' are those duties defined by the employee's contract of employment. This distinction is in legal accordance with the Patents Act 1977 and the Copyright, Designs and Patents Act 1988.

IP exploitation is an expensive and time consuming process. When a member of staff assigns IP to the Trust, this financial and operational commitment is taken up on their behalf. The originator is entitled to receive recompense in the form of a share of derived net revenue as detailed in section 6.3.

If work or research is conducted by an employee in partnership with another organisation then under UK law each organisation will normally own the intellectual property that its own employees generate. As this position can often result in uncertainty over intellectual property ownership, a formal agreement stating ownership (or sharing) of generated IP is required. The Research & Development Directorate will have primary responsibility for developing IP sharing agreements with collaborating institutions.

If the relative ownership of IP is disputed, dated written records relating to the IP in question will be assessed to establish the inventor(s) and their proportionate contribution. If such material is not available, the Chief Executive Officer of the Trust will make a final decision, taking professional advice as necessary.

Wherever possible, commercially funded research contracts should provide for the Trust to hold the resulting Intellectual Property to enable it to benefit from its exploitation.

In pricing commercially funded research contracts, regard must always be given to the value of the resulting Intellectual Property and the rights to the Intellectual Property which are granted to the sponsor, as well as the value of existing background Intellectual Property (especially software or patented inventions) which may be used in furtherance of the research project.

7.2 INTELLECTUAL PROPERTY MANAGEMENT

It is the Trust's policy to actively encourage employees to publish their work and the Trust will not normally object to an employees' right to be named as an author of copyright material. However, if IP is to be exploited, all work needs to be kept confidential until it is correctly protected. Advice should be sought from the Research & Development Directorate before publicly disclosing work.

Despite the statutory provision whereby the copyright in any work produced by an employee in the course of employment belongs to the employer, the Trust normally grants the originator a free licence to the copyright in any work to be published in a recognised scientific, technical, professional or management journal or book.

In dealing with an external organisation, it is not always possible to ensure all contact is through the Research & Development Directorate. When staff are contacted directly by a third party company, it is important to keep full records, including copies of all correspondence and notes of telephone conversations and meetings, and to supply these to the Research & Development Directorate in order to provide detailed accounts of the progress of discussions relating to any Intellectual Property. All records and notes must show the relevant date(s) and action(s) agreed.

In the event of a suspected infringement of the Trust's Intellectual Property by a third party, the Director of Research and Development should be informed. The suspected infringement will be investigated and, where appropriate, external professional advice will be sought. Depending on the nature of any such infringement, the Trust will take appropriate action including litigation against the infringing party.

It is essential that staff working on projects which generate IP keep written, dated records of their activities and results. This is especially significant for subsequent patent applications in the US, since precedence is awarded to the first to invent, rather than the first to file the patent. It is imperative that all correspondence, including emails, telephone conversations and meetings are logged to provide a detailed account of any discussions relating to the IP. Besides maintaining optimum clinical practice, this diligence is in accordance with clinical and research governance guidelines.

Audits will be periodically carried out by or on behalf of the Trust. This process is essential to identify potential IP arising from R & D and to ensure that the correct action is taken to protect any IP that may later be exploited.

7.3 DECISIONS ON EXPLOITATION

Any IP that is licensed, sold or otherwise transferred to another organisation will be negotiated in the best interests of the Trust by the Research and Development Directorate, supported by professional advisers including MidTECH (the regional NHS Innovation and IP Hub), patent attorneys and legal representatives.

Decisions on whether to protect and commercially exploit IP generated from research and innovation activity will be taken by the Research & Development Directorate.

The Trust is the vehicle for holding patents and other IP but may engage another organisation to exploit such IP on its behalf.

In cases where the Trust declines to proceed with the exploitation of an opportunity, ownership of the IP will normally be reassigned by the Trust back to the inventor(s)

Staff are reminded that no steps should be taken to exploit Trust IP without the approval of the Trust. Staff are required to co-operate with the Research and Development Directorate in the undertaking of its duties under this Policy.

7.4 REVENUE-SHARING WITH INVENTOR

The Trust wishes to encourage full participation of employees in the creation and commercial exploitation of IP

The policy rewards staff that have contributed substantially to the generation of IP which has subsequently provided exploitation revenue. Such revenue will be shared between the Trust, the inventor(s) and the department(s) in which the IP was developed, according to the origin of the IP and the relative contribution to the creation and development of the IP. The default position for revenue share is one third to the inventor(s); one third to the department(s) and one third to the Trust.

Where a number of departments have supported the development of the IP, the departmental (one third) share will be split according to the relative contribution of each department to the development of the IP. Similarly, in cases where several staff have been involved in generating the IP, the proportion of income allocated to inventors will be divided between them on the basis of relative inventive contributions. In all cases the shared revenue will be the net of any protection and exploitation costs (e.g. patent costs).

This policy for revenue sharing with the inventor will survive the inventor leaving the employment of the Trust and will pass to the inventor's heirs and successors in the event of the inventor's death for such time as revenue from the commercial exploitation of the IP is received by the Trust.

Innovation Disclosure Form

All ideas disclosed to us will be considered for further development and support. Please complete all sections of the form, return it by email, along with any accompanying material, to innovation@uhnm.nhs.uk

We will treat the information you disclose to us as confidential.

TEAM DETAILS

Principle Contact/Innovator

Department

Position/Job Title

Other Team Members (if any)*

*please indicate if any team members are external to UHNS.

LEAD CONTACT DETAILS

Tel:

Mobile:

Email:

Address:

YOUR INNOVATION

Do you have a name or project tile for your innovation?

Type of Innovation:

Other:

Please provide a description of

your idea in lay terms*

*Please attach any supporting information on additional pages

What problem does the innovation solve?

[Click here to enter text.]

What do you think will be the benefits of your idea over any Are there any existing products, solutions of services? How does it differ?

[Click here to enter text.]

What impact has this innovation had (or is likely to have) on patients, your organisation and/or health care in general?

[Click here to enter text.]

How would you like to take this innovation forward; does it have the potential to be used by other Trusts, can you see it being a commercial product sold by companies, etc.

[Click here to enter text.]

PUBLICATION

Has your discovery been or are there plans to describe the discovery in any way? If so, please provide dates and details.

[Click here to enter text.]

Has the innovation been disclosed to any colleague or collaborator outside of UHNS? If yes, please give details

[Click here to enter text.]

FUNDING

Have you received or identified any funding streams to develop/test your innovation?

[\[Click here to enter text.\]](#)

Do you need help to identify funding?

Yes

No

OFFICE DETAILS – To be completed by R&D Office

Reference Number

[\[OFFICE USE ONLY\]](#)

Added to database?

Yes

No

Date Registered

[\[OFFICE USE ONLY\]](#)