



Science & Technology
Facilities Council

Intellectual Property Rights

Policy and Guide

Edition 2.5

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STFC INTELLECTUAL PROPERTY POLICY AND GUIDE

1. Introduction

The Science and Technology Facilities Council (STFC) is an independent, non-departmental public body of the UK Government Department for Innovation, Universities and Skills, and is one of the seven national research councils in the UK. STFC wholly owns STFC Innovations Ltd. (SIL) which is responsible for managing and commercializing STFC's Intellectual Property.

This policy seeks to lay out STFC's approach to intellectual property, so that this can be applied in a manner which is consistent with STFC's overall objectives.

Intellectual Property (IP) covers a wide range of rights that can be used to define, protect and exploit products of the human mind, human creativity and invention. IP includes patents, copyright (including software and databases), designs, trademarks and know how.

The World Intellectual Property Organisation document "Intellectual Property Handbook Law and Use" gives two reasons why patent legislation exists:

"One is to give statutory expression to the moral and economic rights of creators in their creations and the rights of the public in access to those creations. The second is to promote, as a deliberate act of Government policy, creativity and the dissemination and application of its results and to encourage fair trading which would contribute to economic and social development."

2. Objectives

STFC considers the creation of intellectual property to be an important part of its role as a research council, and seeks to ensure that IP created in the course of its activities should be:

- Developed and exploited to provide a positive economic impact and for the benefit of society
- Available to STFC for present and future research activities.
- Protected and exploited in a manner that recognises the contributions of individual inventors, their organisations and those of any other parties, in cases where that IP is owned by STFC.

In addition, STFC seeks to gather evidence of successful exploitation to demonstrate and quantify the economic impact of its activities

See also the STFC Strategic Framework at <http://www.scitech.ac.uk/About/Strat/Council/council.aspx>

3. IP ownership and exploitation

The ownership and exploitation rights of IP arising from the activities of STFC differ according to the nature of the activity, and are outlined in the sections below.

Wherever possible, STFC seeks to ensure that any potentially valuable IP deriving from its activities (whether patentable or not) should be actively exploited to provide positive economic impact and for the benefit of society. In all cases STFC considers it best practice not to hold patents in joint title with other parties and will seek to avoid this.

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3.1 STFC research grant funding

The ownership and exploitation rights of intellectual property arising from STFC grant-funded research is specified by the terms and conditions of the research grant. STFC will not normally make a claim on intellectual property arising from the research it supports by grant funding. Normally, and unless specified otherwise, the ownership of intellectual property arising from STFC-funded research carried out at the research organisation resides with the organisation that generated it. Where a grant is associated with more than one research organisation and/or other project partners, the ownership of intellectual property and rights to exploitation should be set out in a collaboration agreement before the research begins.

STFC will ask the recipients of grant funding to provide quantifiable economic impact data and case studies related to IP generation, both during the project and after the conclusion of the grant funding.

3.2 STFC Employees & honorary appointments

STFC asserts its rights to IP created by its employees in the course of their employment, and this is reflected in STFC's conditions of employment. This also normally applies to honorary appointments. The ownership of IP created by STFC employees will normally reside with STFC, unless other contractual arrangements apply.

STFC operates an "Awards to Inventors" scheme, which provides a financial return to named inventors employed by STFC for commercialised IP that they have made an intellectual contribution to. This is noted in STFC's conditions of employment.

3.3 STFC Visitors

STFC has a wide range of visitors to its sites. Any visitors who may be involved in the creation of new IP should have signed a letter, agreement or contract that addresses the issue of IP ownership. In the first instance the STFC host of the visitor(s) should agree appropriate documentation with the STFC Commercial Management team.

3.4 Users of STFC's science facilities

STFC provides access to large science facilities mainly, but not exclusively, to the academic research community. The general arrangements for users of STFC's science facilities are:

- Users will own the foreground IP arising from the results
- The foreground IP generated by STFC in providing results to a user will be owned by STFC.

STFC may ask users of STFC science facilities to provide quantifiable economic impact data and case studies related to IP generation, including for a period after the conclusion of the research project.

3.5 Other research and development activities involving STFC

STFC staff work with universities, research organizations and commercial organizations in a variety of ways, and IP arrangements for such interactions should be defined at the outset in appropriate agreements. This documentation should be produced by the STFC Commercial Management team.

The following guidelines apply:

- When STFC provides products or services at a fully commercial rate, the customer will normally own the foreground IP in a specified field, and the exploitation rights.

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- When STFC provides services, products or services at less than the full commercial rate then the rights to the foreground IP are normally retained by STFC.
- The ownership of background IP is not changed by a collaboration (i.e. STFC and collaborator or partner organisations will each retain ownership of their background IP).
- Under normal circumstances the foreground IP jointly created in collaboration with STFC shall be assigned to the party contractually bound to protect and commercialise it.
- STFC will retain a non exclusive royalty-free licence to use foreground IP generated through its projects for its own research and development and for use by its collaborating partners including Diamond Light Source Ltd. This does not include the right to exploit the technology outside the organisation.

3.6 Research organizations part-funded by STFC

STFC provides funding to a number of substantial research organizations on behalf of the UK Government. This includes, for example, Diamond Light Source Ltd. In these cases the provision of funding by STFC does not normally result in any rights of ownership over the IP created in those organizations. In the case of Diamond Light Source Ltd., STFC has certain rights in relation to the exploitation of IP, arising from STFC's shareholding in the company.

4. Commercial exploitation

STFC encourages researchers to create new businesses based on their discoveries and seeks to help established companies make use of STFC research in new or improved products and services.

STFC has allocated to SIL the exclusive right to the commercial exploitation of the IP owned by STFC, and works closely with STFC inventors to develop projects through various business models including commercial licenses, spin-out companies and selling products or services.

When engaging in commercial exploitation the following guidelines apply:

- SIL may grant a license for defined IP in a defined field in return for payment or a shareholding.
- Licenses may be exclusive or non-exclusive depending on circumstances, but in all cases will automatically terminate if the licensee becomes insolvent or certain other circumstances.
- The cost of maintaining exclusively-licensed IP will be paid by the licensee from the date of the license onwards.

In all cases STFC retains a non exclusive royalty-free licence for the licensed IP for:

- Internal research and development and teaching purposes.
- Use by its collaborating partners and to provide services to collaborating partners.

This does not include the right to exploit the technology outside the organisation

5. Further information

The Policy is subject to change, and will be updated periodically. Requests for the current version, and all queries arising from this document should be addressed to Elizabeth Bain at STFC Innovations Ltd elizabeth.bain@stfc.ac.uk.