

Exploitation of Inventions and Patents Policy

The University's policy is to encourage members of staff to work on new developments and inventions and, specifically in the case of academic teaching staff, the terms and conditions of employment expect a person to advance his or her subject by research or otherwise. 'Inventions' in this policy includes all formally protected intellectual property, other intellectual assets and know-how, created during the course of academic research endeavour.

Kingston University's policy follows the principle that universities should promulgate detailed procedures for all categories of staff and students to govern the patenting and commercial exploitation of research results, and the following other guiding principles:

- a) For the avoidance of any doubt on this matter, all contracts of employment for academic staff should include the clearly stated requirement to undertake research in addition to teaching.
- b) Universities should ensure that all agreements for research under the sponsorship of research councils and other bodies are subject to prior approval by the institution, which should have special regard to detailed mutually acceptable provision for the exploitation of results.
- c) Universities should ensure that no member of staff undertakes private consultancy work without the prior approval of the institution, which should have special regard to disclaiming the institution's liability for such work.
- d) Universities should, where research students are supported by the university's own scholarships, adopt regulations concerning commercial exploitations which are based on those of the research councils.
- e) In the case where a student is a member of a research team whose efforts have resulted in an invention, a university should treat him/her, for the purposes of the patenting or commercial exploitation or the research results, in the same way as the members of staff who comprised the rest of the research team.
- f) If an invention is potentially patentable, care must be taken to ensure the possibility of patenting is not lost by premature publication.

PATENTS and INVENTIONS

1. Ownership of intellectual property is determined by the University's Intellectual Property Policy.
2. Staff shall not enter into agreements with commercial undertakings in respect of any IPR, including patents, without consulting their Dean or Head of Department, Faculty Business Development Manager and having the approval of the Pro Vice Chancellor, Knowledge Exchange and Innovation, who may also seek further expert advice as appropriate.
3. Where a research project that leads to the creation of a patent includes a third party who may have individual rights to the end product, these must be subject to a prior written agreement with regard to the ownership and revenue-sharing from any commercial exploitation of the IPR between all parties.
4. Research projects funded by a third party ('Sponsor') and carried out in the University will normally be done in the name of the University and the University will own all the IPR arising (including copyright in research documentation as this may be required to patent an invention arising from the research), unless the written agreement with the Sponsor states otherwise.
5. The University Stage-Gate processes will be followed to guide decisions on whether or not to proceed with patent exploitation, or other exploitation routes such as spin-out company formation
6. Research results created by Staff when commissioned by the University shall belong to the University unless it is explicitly specified otherwise in writing.
7. The University does not generally seek rights to Inventions made by Students, but in some circumstances (such as in the case of contributions made as a joint Inventor in an Invention in which the University has an interest, or if a Sponsor or provider of a placement opportunity has stipulated that all rights must be transferred to it) the University will require a student to assign all of his or her rights to an Invention
8. All Students involved in research that is likely to lead to a patentable invention, other IPRs or intellectual asset capable of commercial exploitation should assign the IPR in the work that they do to the University prior to commencing the research. In return for such an assignment, the University will give the Student a share of any net income arising from the commercial exploitation arising from their research (alone or with others) on the same basis as Staff (providing the organisation funding their work does not have a prior claim to the IPR) as described in paragraph (4 to 6).
9. The inventor and the University will collaborate to protect the secrecy of the invention at all times before the filing of any initial application to patent. (The Patents Act, 1977, forbids any disclosure before filing with only

- three exceptions, which operate during the six months before filing: the display of the invention at an international exhibition, disclosure following the unlawful obtaining of information and disclosure by breach of confidence.)
10. If, having taken expert advice, the Pro Vice Chancellor, KE and Innovation decides that the University does not wish to take part in the development or exploitation of an invention, other IPR or intellectual asset, the University will assign its rights in the invention to the inventor. Alternatively, arrangements will be made for an interested third party such as a commercial company to take over the rights in terms mutually agreed between the University, the inventor and the company.
 11. Where Staff create IPR that is capable of commercial exploitation – whether patentable or not - it must be reported to their Dean/Head of Department and Faculty Business Development Manager. Staff must keep information on such IPR confidential until the University decides whether or not to patent the invention. After consultation with the members of Staff involved, the PVC KE and Innovation shall determine whether the University wishes to apply for a patent and become involved in the exploitation process, including consideration of spin-out company formation. The university stage-gate processes will be followed to inform this decision.
 12. Where a member of Staff wishes to publish the results of their research work, which may have commercial potential in which the University has an interest, they shall first consult with their Dean and advice shall be taken from the PVC KE and Innovation and Faculty Business Development Manager to avoid premature disclosure that would prevent commercialisation.
 13. Publication by any method (verbal, including internal seminars, written or electronic) of copyright information on research outputs which may be subject to a patent application could forfeit the right to apply for a patent. Where patents are likely to be taken out, Staff must delay publication until a patent application has been filed or a decision not to apply for a patent is made by the University. The University will not delay publication of a paper for this reason by more than 6 months. It should be noted, however, that Sponsor's may place restrictions on the publication of their know how and know how created during research that they fund. In instances where the inability to publish or otherwise publicise research outcomes might conflict with the University's charitable purpose to advance education for the public benefit, advice should be taken from the Pro Vice Chancellor Knowledge Exchange and Innovation and the University Secretary on whether the research activity and/or patent application should be undertaken via a University subsidiary company or other vehicle.
 14. Where it is decided that the University (or a subsidiary company acting on its behalf) will apply for a patent, Staff involved in that research will provide all reasonable assistance to the University in the process, for example, by providing information promptly upon request, attending meetings, advising on further developments and maintaining confidentiality as required.
 15. Under Section 41 of the Patents Act, members of Staff may be entitled to compensation for a patent on an invention made by them. Such compensation will be based on the guidelines in Section 41 of the Act and will depend on the benefit derived by the University.
 16. Where any University -owned Intellectual Property is commercially exploited, the net-income arising from it (that is the income less costs involved protecting and commercialising the Intellectual Property). Net Income will be shared out between the University, Faculty and Staff that developed the invention or know how as follows:

Cumulative Net Income Range	Percentage of net income paid to University	Percentage of net income paid to Faculty	Percentage of net income paid to Relevant Staff
Up to £10,000	10%	10%	80%
Plus £10,001 – £30,000	20%	20%	60%
Plus £30,001 – £50,000	25%	25%	50%
Plus £50,001 – £1,000,000	25%	25%	50%
Plus £1,000,001 - & over	30%	30%	40%

The Staff's share of the Net Income between the Staff involved in the creation of the invention or know how will normally be equally divided between those Staff that made a significant contribution to its creation unless there is a written agreement between the inventors to the contrary at the time disclosing the invention or intellectual property. In the event of dispute between members of Staff as to the division of this percentage

share, the decision of the Vice-Chancellor shall be final and binding.

17. Where it is decided that the University (or a subsidiary company acting on its behalf) will proceed with spin-out company formation, Staff involved in that research will provide all reasonable assistance to the University in the process, for example, by providing information promptly upon request, attending meetings, advising on further developments and maintaining confidentiality as required. The University will always seek to adopt all current recommended good practice expected by Research England and other funders in the fair allocation of equity shares between academic founders and the university, and other third parties, and in the timely drawing up of contracts, agreements and other necessary legal documents in order to facilitate the company formation process. For the avoidance of doubt, this includes adopting the recommendations of the Independent Review of University Spin-Out Companies¹ (November 2023) and associated USIT guides.²
18. If the Pro Vice Chancellor, KE and Innovation having taken appropriate advice, and in consultation with Faculty Dean decides that the University should not pursue commercial exploitation, the Staff involved will be notified as soon as possible and no later than three months after the matter was first raised. These Staff will then have the right to make a patent application or pursue other commercialisation routes themselves at their own expense, subject to the interests of any third parties. Staff must inform their Dean of their intention to make such an application in line with contractual obligations. They may not, however, apply for a patent in circumstances which would be unlawful in disclosing trade secrets or other confidential information belonging to the University or its partners, its Sponsors or others with whom it collaborates.

¹ [Independent review of university spin-out companies - GOV.UK \(www.gov.uk\)](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/103111/independent-review-of-university-spin-out-companies.pdf)

² [TenU \(ten-u.org\)](https://ten-u.org/)