



KTI

Knowledge Transfer Ireland
Where Research & Business Connect

KTI Practical Guide Managing Intellectual Property & Confidentiality



This publication is one of the **KTI Practical Guide** series. The guides are designed to aid understanding and planning around issues relating to intellectual property and to the negotiation of commercial arrangements between companies and Irish research performing organisations (RPOs).

A catalogue of accompanying Model Agreements has been developed by KTI as a starting point for contract drafting and negotiation.



To find out more and to download copies visit:
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Introduction

This Guide provides an overview of the key issues relating to Intellectual Property (IP) which are likely to arise during your research career. It is applicable to researchers in Higher Education Institutions (HEIs), State research organisations and to researchers in industry.

Your university, institute of technology or other research institution and/or its Technology Transfer Office or Industry Liaison Office or your company and/or its legal department will be able to advise you on these topics and this Guide will act as a prompt for you in these relationships.

It explains:

- The nature of IP, how you may create it, and how to protect it;
- How to use IP belonging to others safely;
- How IP can be commercialised; and
- The importance of confidentiality.

Remember that this is just a guide and not a substitute for you taking your own independent professional advice. It has also to be read in the context of your own institution's or company's published guiding principles, mission, objectives and procedures.

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Section 1 Intellectual Property

Introduction

What is IP? IP is a term used to describe the rights which protect your ideas and other forms of intellectual creation. It is made up of a bundle of different rights. Some rights have to be registered to be effective, others arise automatically. IP can be split into 6 main categories as illustrated below.



Know-How is any secret and technical information, which is valuable and identifiable, including results, experimental techniques, formulae, chemical structures, source code, etc., and which can be as equally important as any other form of IP. Know-how will last for as long as the technical information is kept secret.



Designs protect the visual appearance of objects, or designs applied to them, e.g. the shape or configuration of laboratory equipment, instruments, or facilities; or the pattern on material (such as medical dressings). They can arise automatically or can be registered, and will last for different periods of time depending on whether the design is registered or unregistered.



Patents protect inventions for products or processes. The invention must not have been publicly disclosed before, must be inventive and must be capable of industrial application. You have to apply to the Irish Patents Office to register a patent in Ireland. There are two forms of Irish patents – a full-term patent, which can last up to 20 years; or a short-term patent, which can last for up to 10 years.

IP



Copyright protects items such as original written works, diagrams, charts, computer source code, photographs, or even presentations. Copyright arises automatically, once your work has been expressed and recorded in permanent form, and will last for different periods of time depending on the type of work protected. It must have involved some element of creativity and not have been copied (substantially) from elsewhere.



Database Rights protect compilations of works or data (e.g. results, samples or patient information) where there has been a substantial investment in obtaining, verifying, or presenting the contents of the database. There is no need to register a database, and database rights can last for up to 15 years.



Trade Marks Avonmore, Brennans, Cadbury Dairy Milk, Tayto, and Jacobs are all successful trade marks that represent the best-selling brands in the Irish grocery market. Their value lies in the fact that they denote the origin of the products to which they relate. Trade marks can arise automatically or can be registered, and can last indefinitely.

And in a little more detail...

Patents

Patents protect inventions that relate to a product and/or a process to make a product, certain diagnostic methods, or even the medical or therapeutic use of products. They protect technical developments, particularly from research and development in the medical, science, technology and engineering fields.

If you have developed a new and useful piece of technology from your research — this invention will be patentable if: (1) it has not been disclosed publicly anywhere in the world prior to filing a patent application; (2) it is inventive; and (3) it is capable of industrial application, (essentially any commercial, medical, or other practical use). Once a patent has been granted, it offers the owner a 'monopoly' right. This means that the owner, or someone else with the owner's consent, can exclude others from using the invention for commercial purposes.

If you think your invention is potentially patentable, it is essential that the details of the invention are kept secret until a patent application is filed. Disclosure of the key features of the invention before that could jeopardise the patent application or the granted patent.

Methods of disclosure may include publishing details of the invention:

- in a journal submission, book, poster, or other publication;
- via a website other electronic means;
- in an oral presentation; and/or
- to someone who is not an employee of your organisation (e.g. company or university) or a person who is not bound by confidentiality to keep such information secret.

Demonstration, promotion, and/or use of the invention in a public place can also be considered publication. Confidentiality is considered in greater detail in Section 4.

How do I know if my invention is already in the public domain?

A previous disclosure can be any publicly accessible details of the invention, in any form and in any language, and could include anything from a published patent; any document; information contained in a book, article, or journal; a TV documentary; a demonstration; or even just common practice.

Whilst you cannot expect to find everything, a good starting point is to see if there are any existing patent documents that relate to your invention. It is easier than ever to find patent information as the format of patents has become increasingly standardised and there are many user-friendly patent database websites that you can search.

If the patent/application of interest is published in a foreign language it is possible to check via the internet or other patent databases to see if an equivalent document has been published in English in another country (such as the UK, USA, Canada or Australia, for example) – this is often called “patent equivalent” searching.

If the patent/application of interest has only been published in a foreign language, you can either get a machine translation of the text into English, a formal translation of the relevant part of the patent document, or obtain an English abstract of the patent from a patent database.

It is a good idea to carry out a patent search before you start a project in order to try and ensure that your idea has not been disclosed in the general or patent literature.

If you are not experienced in patent searching, you can obtain advice and assistance online. For example, the Irish Patents Office provides access to an online patent database in the Patent Searching section of its website (<http://www.patentsoffice.ie>); and the European Patent Office provides access to more than 90 million patent documents worldwide through the Esp@cenet website (<http://worldwide.espacenet.com>).

Alternatively, you could consult a patent agent or patent attorney to assist you with designing, conducting, and interpreting a search of patent documents. If you are unsure, consult your supervisor, manager, or technology transfer office.

To obtain patent protection for your invention you will need a patent application to be prepared. This should ideally be done by a qualified patent agent or patent attorney to make sure sound and appropriate patent protection is obtained. Your organisation will have procedures for instructing patent professionals, and you should let the appropriate person in your organisation know if you think you have a patentable invention. This may be your manager, legal office or, in the case of universities and institutes of technology, your technology transfer office. The application will describe the invention and define the desired monopoly (in the form of claims). The cost of preparing and filing a patent application depends on the time and effort on the part of your patent attorney or patent agent in preparing the application, and typical costs can range from €2,000 to €6,000 depending on the nature and the complexity of the invention.

The patent application will usually be initially filed at the Irish Patents Office, and your patent agent or patent attorney can advise on a proposed patent filing strategy, depending on commercial needs and budget. Depending on the market for application of the invention, and other considerations, your organisation may choose to file direct in another country or countries. This will be a commercial decision. An Irish patent will only provide protection in Ireland and, to obtain

patent protection abroad, you will need to file corresponding patent applications in each of the countries that are of commercial importance to you. This normally must be done within the first year of filing your initial application. There are regional patent applications that cover certain geographical areas – for example, a European application covers 38 countries across Europe, and an International (also known as a PCT) application covers 148 countries worldwide – thereby allowing you to enter the patent system in a number of countries by filing a single application in a single language. If a European patent is granted, fees to nationalise and maintain a granted patent in all European countries will need to be paid. The PCT patent application is an entry point for intellectual patent examination and it will subsequently be necessary to file national applications in countries of interest, which will often require translation of the patent application.

The official fees payable to the Irish Patents Office when filing an Irish patent application amount to €60 for a short-term application and €125 for a full-term application, but the official fees payable to the European Patent Office when filing a European application could typically amount to €1,400, and the official fees payable when filing an International application could be in the region of €3,300.

In order to be granted as a patent, an application must be examined and found patentable by the patent office responsible for the application. The cost of examination is dependent on the extent and involvement of the examination procedure, but could typically range from €2,000 to €20,000, generally staggered over a period of a number of years. Short-term Irish Patents (maximum term is 10 years) are granted for an invention which is new, capable of industrial application, and not clearly lacking an inventive step; but you cannot enforce your patent rights until the validity of the short-term patent is established.

A full-term Irish Application (maximum term of 20 years) must be searched and examined to proceed to grant. Search and Examination of a full-term Irish Application can be pursued via two routes:

- A** A search and examination of the patent application by the Irish Patents Office can be requested; or
 - B** A search and examination can be based on the results of a search carried out on a corresponding patent application in the United Kingdom, Germany and the European Patent Office; or the grant of a patent in pursuance of the corresponding Patent Application.
- Patent granted. You can use “Patent No: [NUMBER]” or “Patented” on any relevant literature, publications or products once a patent is granted.

A patent attorney or patent agent will advise on the best strategy in relation to where and what type of application to file to best suit the commercial requirements of your organisation.

Once granted, the patent must be maintained by payment of annual renewal fees.

Know-How

Know-How is technical information, knowledge and skill e.g. a procedure, a process, an identifiable knowledgeable way of doing something. That information must be secret.

R&D projects and other work can result in extremely valuable technical information being created.

The only way you can really protect your valuable Know-How is through confidentiality.

Confidentiality is considered in greater detail in Section 4.

Copyright

Have you ever written a thesis or article, written up an experiment or report, drawn a diagram or even recorded a presentation you have given? All of these works can be protected by copyright.

There is also copyright in music, broadcasts, sound recordings, computer software, photographs, films, and typographical arrangements of published editions. Copyright does not generally protect against 3D reproduction of items from industrial drawings or plans (e.g. models created from blueprints). They are instead protected by design rights or as registered designs (see Designs section).

Copyright protects the form in which you express your idea, but not the idea itself. For instance, the copyright in the written words of a thesis may belong to one person but the invention described in the thesis may belong to someone else.

Unlike a patent, there is no need to register copyright in Ireland; it arises automatically from the time an original work is first written down or recorded in some way. All that is required is mainly that the work resulted from the creator's skill and effort i.e. was not copied from another source.

There are different periods of duration for copyright, depending on the type of work. In respect of a written article (as a literary work), copyright would last for the life of the writer plus another 70 years. In the case of a journal collection (as a typographical arrangement of a published edition), copyright protection expires 50 years after the date it is first made available to the public.

The Irish Patents Office contains a lot of straightforward information about copyright in the Copyright section of the website (<http://www.patentsoffice.ie>).

If I write up an experiment or report, does the fact that the written piece of work is protected by copyright prevent anyone from using the results or other information contained in it?

— No. Copyright only protects the manner in which you have expressed yourself i.e. the text, style, and layout of the written document. It does not protect your ideas, results, or conclusions. Whilst another person would be prevented from copying your write-up word for word or in a manner which was substantially similar to yours, they would not be prevented from using the results or other information. This can instead be protected as confidential information (see Know-How section) but you need to keep the written work secret.

I have been recently asked by a publisher to waive my moral rights in an article I have written. What does this mean?

— Moral Rights are personal rights which belong to the author (e.g. the writer) of a piece of work. They are nothing to do with what is right or wrong! Moral Rights include the right of an author to be identified as such. This right has to be specifically asserted to be effective i.e. just write on the work: “Joe Bloggs has asserted his right, under the Copyright and Related Rights Act 2000, to be identified as the author of this work”.

Other moral rights include the right not to have your work altered in any derogatory manner and the right not to have the work of somebody else falsely attributed to you. These do not have to be asserted. Moral Rights do not exist in computer software or in any work created by an employee.

Whilst Moral Rights cannot be transferred, they can be waived. However, there is no reason why you should automatically agree to waive yours. Always check with the right person in your organisation e.g. supervisor, manager, legal office or technology transfer office.

I have recently compiled a database which holds the location reference numbers for all the cytology samples I have used over the past 6 months. Is this protected by copyright?

— Yes, if it involved skill in creating the text in it or in drawing it. It may also be protected separately by “Database Right” (see Database Rights section).

Designs

The appearance of the whole or a part of an object can be protected by design rights, which can arise automatically or they can be registered. There are different types – Irish registered designs, and Community registered and unregistered designs. Irish registered designs provide protection in Ireland whilst Community registered and unregistered designs offer protection throughout the EU as a whole. Each type is a little different in the criteria required for protection and the level of protection available. A few examples are set out below:

Irish Registered Designs can be registered with the Irish Patents Office and can be used to protect the ornamental or aesthetic aspect of an object resulting from the lines, contours, colour, shape, texture or materials of the object itself or its ornamentation e.g. any etching, engraving or decoration on an instrument can be protected. In order to be registered, the design must not have been previously disclosed to the public before the application for the design registration is made at the Irish Patents Office. The design must also have ‘individual character’. This means that the design must not produce any notion of ‘dépà vu’, whereby the overall impression produced by the design must be different to the overall impression produced by other publicly available designs. Designs which are dictated solely by their technical function e.g. indentations on a plastic container to help with grip will not be registrable, unless of course the indentations take a special eye-appealing form or pattern. Similarly, designs which must be reproduced in an exact form and dimension in order to perform a function cannot be registered. Irish registered designs can last for 25 years, but must be maintained by payment of renewal fees every 5 years.

Community Registered Designs follow much the same criteria as for Irish registered designs. However, any designs made available to the public by the designer can still be the subject of a Community design application up to 12 months after the public disclosure is made. They will also last for up to 25 years and must be maintained by payment of renewal fees every 5 years.

Community Unregistered Design Rights arise automatically so long as no identical design has been previously disclosed to the public and the design has individual character, and require no registration process. However, Community unregistered design rights only last for 3 years and only allow the right holder to prevent acts if it can be proved that the acts result from copying the protected design, unlike a (Community or Irish) registered design, which confers on the holder the exclusive right to use the design, regardless of whether the protected design was copied.

Database Rights

Database Rights protect a collection of independent works, data, or other materials where there has been a substantial investment in obtaining, verifying, or presenting the contents of the database. Any person who permanently or temporarily transfers a substantial part of the contents of the database or makes those contents available to the public by any means, without the consent of the database owner, will infringe the database right. The database right lasts for 15 years from when the database was completed, but there is no need to formally register a database.

Trade Marks

It is difficult to avoid trade marks in day-to-day life. Avonmore, Brennans, Cadbury Dairy Milk, Tayto, and Jacobs are all examples. Trade marks denote the origin of the products or services to which they relate. A well-known trade mark is often the most identifiable element of a successful product or service. They will often make a customer prefer one product over another. Selecting the trade mark can therefore be crucial, and protection of a trade mark to protect a brand is fundamental. The most successful brands are often those that are completely distinctive, e.g. Sony for electronic goods.

Trade marks can generally be registered in individual countries, such as an Irish Trade Mark Registration; in certain regions such as the Benelux region of Belgium, the Netherlands, and Luxembourg; and/or throughout the whole of the EU as a single Community Trade Mark. They can also arise automatically if a mark has been used for a substantial period of time and to a substantial extent, such that it has consequently built a reputation. Unregistered trade marks are, however, more difficult to enforce. If you can, it is always better to register your trade mark.

A registered trade mark needs to be able to distinguish the goods or services of one person from those of another. It must be:

- distinctive, e.g. 'MARS' (the name of a planet) for chocolate bars;
- it must not be descriptive of the goods or services to which it is applied, such as 'BOOTS' for shoes; and
- it must not be deceptive or contrary to public morality.

Objections can be raised to a proposed trade mark on the basis of an existing identical or similar trade mark registered for identical or similar goods or services. Trade marks are registered in different classes, which broadly distinguish different types of goods or services. Once registered it will initially last for 10 years, following which it can be renewed every 10 years.

Set out below is a summary of the types of IP which might typically arise in or be affected by activities within a company, university or other type of research institution:

Activity	Patents	Know-How	Copyright	Design Rights	Database Rights	Trade Marks
Research Information – preparing and collating results/methods		✓	✓		✓	
Publishing or presenting research, academic or technical papers	✓	✓	✓	✓	✓	✓
Using others' research papers or publications		✓	✓		✓	
Market analysis		✓	✓		✓	✓
Industrial design projects	✓	✓	✓	✓		
Contract research	✓	✓	✓	✓	✓	
Consultancy projects	✓	✓	✓	✓	✓	✓
Receiving important confidential information		✓				
Giving out important confidential information	✓	✓				
Using computer software	✓	✓	✓			✓
Developing computer software	✓	✓	✓			✓
Preparing lecture notes		✓	✓			
Responding to technical queries		✓				

Section 2 IP Ownership

Will I own the IP I create?

Whilst there are a number of situations in which you will either create or contribute to the creation of IP, you may not necessarily own the IP in question.

General Position

In most cases, if an employee creates IP during the course of their employment, their employer will own the IP. This is unless anything has been agreed to the contrary. In the case of academic institutions, employees will usually include professors, readers, lecturers, technicians, research staff, support staff and administrators; and employees in private research institutions can include scientists, analysts, technicians, support staff and administrators. If you are working within the HSE, it may not always be clear whether you, as a medical practitioner who creates IP, have done so in the course of your employment, particularly if your main role is that of a patient carer. It is becoming increasingly common for HSE employment contracts to refer specifically to IP, and to deem IP generated by a practitioner or consultant in the course of his/her employment to be in the ownership of the relevant health sector/academic employer. Always check what is relevant.

If you are a student or intern, you will not normally be classed as an employee unless, in addition to your being registered as a student or intern, you also have a contract of employment with your university/institution e.g. as a research assistant/analyst. If you are working on a research project, particularly one carried out with or for industry, you will be expected to agree to assign your IP rights to your host institution prior to commencing the project. You should check with your supervisor, manager, or technology transfer office.

If you are a part-time employee or jointly appointed with an external organisation, there may be honorary contracts in place. The IP arrangements should always be checked.

IP Policies

Most organisations will have IP policies that employees are required to follow.

Many universities or other research institutions have IP policies which specify situations where the university/institution, as an employer, waives its rights to ownership of IP. It may also refer to situations where the university/institution claims ownership of IP created by students or interns. This may vary in relation to undergraduate and postgraduate students, or interns and secondees. It may depend on whether particular facilities have been used or work is related to a specific project. The university/institution may also have different approaches with different types of IP. For example, a university may claim ownership of patentable

inventions but not of copyright in certain scholarly materials. Similarly, a research establishment may acknowledge that a certain proportion of a project vests with the researcher if done outside the specific project for which they are employed to conduct. Take time to familiarise yourself with your university/institution IP policy. Your supervisor, manager, or technology transfer office will have copies, or it may be on your university/institution's intranet.

Originators and Contributors

It is essential in IP law to be certain who was the actual creator of the IP. The person(s) who have made the intellectual contribution are the originator(s). Different specific terms are used for the originator(s) of different types of IP. For instance in the case of patents they are "inventor(s)" and in the case of literary copyright works they are "author(s)".

Other individuals, such as technicians or analysts, may have worked with the originator(s) to develop the original idea or work, but if they have not created anything new in IP terms, then they are not originator(s) but simply contributor(s), insofar as they have been specifically instructed to conduct research, which was actually designed by a supervisor or manager.

Why is it important to distinguish between originator(s) and contributor(s)? In the case of patents, only the originator(s) of the invention are named as inventors on the patent. If people are named incorrectly as inventors, this could be subject to legal challenge particularly in the USA, and the granted patent may be invalidated.

Collaborative/Funded Work

If you are working with or for an industrial sponsor or another university/institution, the terms of the funding arrangements e.g. of the grant, the contract, or the collaboration agreement will specify who will own the IP created and who may benefit from access to the IP, e.g. by way of a licence.

Group Work

If you are working in a company, any collaboration with another research group outside of your organisation should have been covered by an appropriate legal contract that covers amongst other things IP. This applies also if you are in universities or research institutes and collaborating with a company.

Collaborative work between researchers in universities or research institutes may not be covered by legal agreement so it is important to have people consider whether you have produced work on your own or whether anyone else has been involved in its creation. It can be more difficult to establish ownership if a number of other staff/students has been involved in the same project.

Consider individuals who may have created IP from another research institution or any other external organisation. IP contributed may either be owned by the individual, or that individual's research institution or connected organisation. Check any other university/institution IP policies. Consider any individuals who may have created IP but then left your team to go elsewhere. They may have taken IP with them if it belonged to them.

If you write a paper in conjunction with other authors, copyright in that paper may be jointly owned.

Consultants

Consider whether any external consultants have contributed to the development of the materials. Consultants are not classed as employees. IP created by a consultant is likely to be owned by that consultant even if they have been paid to do the work, unless stated otherwise in the individual consultancy agreement. This is particularly relevant in any HSE or government body. A government body may often appoint medical clinicians. The clinician may not be an employee of the government body and therefore IP may belong to the clinician or their employer.

The table opposite summarises some of the different factors which may be used to determine who owns the IP.

Are you a member of staff?	Are you a student?	What type of IP have you created?	How and with whom did you create the IP?	Where did you create the IP?
<p>Are you employed in a company?</p> <p>Are you employed in a HEI or a research institution?</p> <p>If so are you:</p> <ul style="list-style-type: none"> • Academic staff? • Academic-related staff? • Non-academic staff? • Research staff? • Patient carer? • Jointly appointed? 	<p>Undergraduate?</p> <p>Postgraduate?</p> <p>Employed?</p> <p>Sponsored?</p>	<p>Copyright materials, e.g. teaching materials, articles or source code?</p> <p>Inventions?</p> <p>Database right?</p> <p>Design right?</p>	<p>Created on your own?</p> <p>With a group in your organisation?</p> <p>With your supervisor/students?</p> <p>With external funding?</p> <p>In collaboration with any external party?</p>	<p>At a previous employer's?</p> <p>Using your employer's facilities e.g. laboratory equipment, computers?</p> <p>At an external facility.</p>

Section 3 Protecting IP

What can I do to help protect any IP which I create?

Patents

Some practical tips to help protect your inventions, including how to register a patent are set out below:

Practical Tips



If you come up with a new invention, is it patentable? See Section 1. Consider whether your invention has been previously disclosed by someone else — e.g. look at existing patents, academic literature, or conduct key word searches using an internet search engine or a patent database, such as esp@cenet or Google Patents.



Keep both originals and copies of all notes, reports, drawings, lab books etc. relating to the invention in a secure place. You should try to record as much detail as possible. Ensure all originals and copies are dated and are sufficiently detailed (and clear!) to identify the invention and how it works. Get your supervisor or manager to sign and date laboratory notebooks on a regular basis. If you work in a company, formal processes may exist for this.



Keep the invention confidential (see Section 4 for practical tips on confidentiality). If you need to disclose any information, you should first speak to your supervisor, manager, legal department or technology transfer office.



If, having done your initial searches/investigations, you still think your idea is patentable, let the right person know e.g. your supervisor, manager, legal office or technology transfer office.



If it is decided to go ahead, a patent application can be prepared, usually with the help of a patent agent or patent attorney. Once filed, you can indicate on any relevant marketing literature, publications or products “Patent Application No. [NUMBER]” or “patent pending”. Do not do this before you have filed, as it is an offence to do so.



Patent granted. You can use “Patent granted, No: [NUMBER] [2013] [IRELAND]” on any relevant literature, publications or products.

Examination of the patent application is required during which the patent office(s) where the application was filed will decide whether the application can be granted as a patent. This is a long, painstaking process which can take 2 to 6 years, depending on where the application is filed, and the type of application. The inventor(s) will need to support their legal/patent/technology transfer office in prosecution of the application.

Copyright

There are no special registration procedures required to protect your work in Ireland, but this is not always the case in other countries. The good thing about copyright is that it arises automatically once you fix the work in a document. However, as there is no register to refer to, this sometimes makes it difficult to prove ownership. Some practical tips to help overcome this and protect copyright are set out below:

Practical Tips



Keep all originals of your copyright work such as notes, drafts, sketches, drawings, videos, etc. in a secure place.



Record the date you created the copyright work, for example, by saving the series of electronic versions of any works on a computer or storage device to prove the date a work was created.



Alternatively, email the work to yourself or somebody independent, such as an intellectual property attorney. The date of the email can be used to demonstrate the date before which it was created.



Place a copyright notice (for example, © FRKelly 2015 or © University of Knowledge 2015) on the piece of work which will act as a useful reminder to anyone using the work that copyright exists and that action may be taken, if it is copied.



Protection of work on the internet is trickier as it is extremely difficult to police the internet effectively. Therefore, don't publish anything on the internet that you or your university/institution would not wish to be copied. Perhaps just publish excerpts, and leave people to come back to you for the main work.

Designs

Some practical tips to help protect your designs are set out below:

Practical Tips



Keep all originals of your design drawings, sketches, samples, models, and prototypes in a secure location.



Record all dates of creation and the dates when you may have disclosed the design, e.g. at a trade fair or in any publication, as you should with copyright (see above).



Alternatively, email the design to yourself or somebody independent, such as an intellectual property attorney. The date of the email can be used to demonstrate the date before which it was created.



Contact your supervisor, manager, legal department or technology transfer office who can help decide what type of protection is suitable and whether or not to apply for registration.

Database Rights

Some practical tips to help protect your database rights are set out below:

Practical Tips



Keep all your notes, records of telephone conversations and meetings, emails, contact details, and other correspondence that you used to collect and compile the information contained in your database.



Keep all your working drafts and original copies of your database in a secure place. If stored electronically, ensure it is password protected.



Record the date when you created the final database: again, a good way to do this is to electronically save the different versions of your database as you compile it.



Alternatively, email the database to yourself or somebody independent, such as an intellectual property attorney. The date of the email can be used to demonstrate the date before which it was created.



Place a copyright notice (for example, © FRKelly 2015 or © University of Knowledge 2015) at the bottom of the database.

Trade Marks

Some practical tips to help protect trade marks are set out below:

Practical Tips



Consider in which countries you would want to protect your trade mark – i.e. where would the products or services be sold or used?



Consider which goods and services will be sold or used under your brand or your trade mark.



Think about whether you need to protect a word, a symbol, a logo, or even a colour as your trade mark. You can search the trade mark database of the Irish Patents Office to see if there are any similar or identical trade marks already registered.



Contact your supervisor, manager, legal department or technology transfer office – they may be able to contact a Trade Mark Agent or Attorney to help with the process.



Use the TM symbol when your trade mark is unregistered.



Use the [®] symbol when the trade mark is registered. Do not do this before it is registered – it can be an offence to do so!

Section 4 Confidentiality

Could your work or other information or results be useful to someone else if they ever got hold of it? Could any of your work be potentially patentable or registrable as a design? If the answer to any of these questions is yes, it is important to consider confidentiality. Confidentiality is the best way to protect Know-How.

The 'someone else' could be any individual inside or outside your organisation. They could be a member of another research group or someone from another organisation. They could even be a friend or relative. The information may include results, chemical formulae, information from laboratory notebooks, experimental procedures or techniques, information concerning the handling or programming of equipment or source code. It may be personal or commercially sensitive information such as customer lists or results from market research. These are just a few examples.

It does not matter how informal a conversation or meeting may seem. You must always consider the nature of the information you are disclosing and whether, in the circumstances, it is appropriate to disclose. Let's look at a few examples.

Joe has developed the source code for a new computer program. If someone else is able to access the source code they may well be able to write a program to undertake the same task but using different code. This could then be used or developed further into a product which could be extremely lucrative. The source code is therefore highly confidential information and would need to be protected from disclosure.

Mary has invented, in conjunction with her team, a novel technique for protein analysis. This invention is potentially patentable. One of the criteria for the grant of a patent is that the invention must be new and must not have been previously disclosed to the public. If any information relating to the invention is disclosed before filing a patent application, this would completely stop a patent from being granted in most countries.

Aisling is a student who has been working on a summer project. The project has been funded by an industrial sponsor — Inventive Concepts plc. At the beginning of the project, Aisling was asked to sign an acknowledgement to say that she understood and agreed to comply with the terms of the R&D Agreement between her Institute and Inventive Concepts plc. She signed. One of the terms contained in the R&D Agreement stated that any information generated during the project must be kept strictly confidential and not disclosed to anyone else who was not directly involved in the project. Aisling must therefore keep the relevant information confidential, or could be found liable for breach of contract.

Sean has been working under a consultancy contract with Security Finance Limited relating to work on cryptography. The consultancy contract contains a confidentiality clause. Sean needs to be careful not to disclose any of the confidential information which Security Finance Limited supplies when carrying out other work or could be found liable for breach of contract.

Michael is a researcher at a university and has been able to read a thesis, which is subject to restricted access within the university because of a confidentiality agreement with Future Research Limited who funded the project. Michael wants to use some of the information from it as part of some other research. If Michael wants to publish the results of the new research, and this includes information from the restricted-access thesis, he will need consent from Future Research Limited. If Michael quotes from the thesis, consent from the owner of the copyright in the thesis may also be needed.

Undoubtedly, there will be situations where disclosure cannot be avoided. In these circumstances, you will want to ensure that the person to whom you disclose the information, not only keeps it secret but also does not use it improperly. If you show someone confidential information for one project, your agreement should stop them using the information for another project.

To whom can I disclose information?

Employees have duties of confidentiality to their employer. If you are an employee, it is therefore not a problem as such to share your employer's confidential information with colleagues who are employed by the same employer, whether you are employed in a company or HEI. Remember – students, visiting academics, secondees, and consultants will not necessarily be employees. Accordingly, if confidential information is to be disclosed to any of them it is always better to try and have a form of written confidentiality agreement in place. This may form part of their overall Contract of Engagement.

What should I do to protect the information?

You may have heard references made to a 'CDA' or 'NDA'. These are abbreviations for "Confidential Disclosure Agreement" or "Non-Disclosure Agreement". If you have to disclose important information always try and put a written agreement of confidentiality in place. The best thing to do is contact your supervisor, manager, legal department or technology transfer office who will no doubt have a sample confidentiality agreement that can be used and will be able to help with putting it in place. You can also find a Model CDA and a reference guide on the KTI website at <http://www.knowledgetransferireland.com/Model-Agreements/Catalogue-of-Model-Agreements/>.

Remember, you are probably not authorised to sign a confidentiality agreement for your organisation, so check first.

These agreements are all to be taken very seriously. Any information and discussion covered by them must be treated in confidence and not disclosed to anyone else, except as set out in the agreement. If there is any breach of any agreement, the other party may be entitled to seek financial and other compensation (damages) not only from your employer but possibly from you personally. This is obviously a very serious matter. It can be difficult to closely supervise compliance with all the agreements that have been signed, and there is also, of course, a natural desire for researchers to publish and discuss work openly, which may on occasions give rise to individuals not realising the importance or the extent of any agreements that have already been signed. Extra care therefore needs to be taken.

Can I present at a conference?

If you disclose the key information about your invention or design whether at a conference or elsewhere, it can stop you getting IP protection. You may, however, be able to make some general statements without disclosing your invention.

There are some limited exceptions. If you disclose a design, you will have 12 months to register it.

If you disclose an invention, it may still be possible to get patent protection in the USA if the application is filed within 12 months, but anyone will be able to use your invention almost everywhere else in the world.

So if you are considering or intend to publish at a conference or elsewhere, speak to your supervisor, manager, legal department or technology transfer office as early as possible. They will look to file an application for a patent before publication, if the subject material has good business prospects.

You can publish openly once a patent application has been filed. There can be some advantage in waiting a little longer before publishing, in case any claims of your patent are not accepted by the patent office; or in case you need to abandon your first application without your disclosure affecting the novelty of the future application(s).

What else can I do to protect the information?

Practical Tips



Consider whether confidential or sensitive information is accessible by any person not bound by confidentiality in your organisation. Be careful about leaving information visible on desktops. If necessary, keep information in locked cabinets or use password security for electronic storage.



Keep a record of what has been disclosed during any meeting/conversation. If a batch of information is to be passed over, create a list of the information and, if possible, get the recipient to sign the list by way of acknowledgement.



Create some minutes or written record of conversations. This does not have to be overly formal. Something in bullet point form will suffice. A copy of this record can then be sent to the recipient.



If information is confidential then it never does any harm to mark it as such. It has the additional benefit of putting the recipient on notice of the confidentiality of the information and hopefully reminding them to treat it carefully. Don't be afraid to tell the recipient you expect them to treat it carefully.



Never disclose more information than is necessary. If an individual or company has refused to enter into a CDA, instead of disclosing specific details relating to an invention — just refer to the advantages the invention would offer the recipient. Whet their appetite. Hopefully they will then become interested to find out more and enter into a CDA.

Confidentiality Checklist

- With whom am I meeting or speaking?
- Are they members of my team, my research organisation, or employed by my employer?
- What information am I disclosing?
- Is this information sensitive or otherwise valuable – could it be misused by the recipient?
- Is this information potentially patentable or registrable as a design?
- Am I or is my employer under any obligation of confidentiality not to disclose this information?
- Have I asked the other person to sign a CDA?
- Have I marked any of the information as “Confidential”?
- Have I taken notes of the meeting/conversation from which it can be seen what I have disclosed and what has been said?

Remember – if in doubt, always speak to your supervisor, manager, legal department or technology transfer office.

Section 5 Using IP

When should I be careful when using IP belonging to others?

— Always!

In the previous sections we have concentrated on what IP is and when and how you are likely to create it. Don't forget that other people, including collaborators, fellow academics or colleagues you may be working with, may also have IP. Others' IP can be extremely useful, but you must bear in mind what you can and cannot do with it.

Let's take patents and copyright as an example. If you make a product or use a process which has been patented by another person or company, you may infringe the patent rights of that other person or company. Similarly, if you copy a piece of work which is protected by copyright of another person or company, you may infringe that person's or company's copyright. This is very serious because, if you are infringing, the owner of the IP may get an injunction to stop you using the IP anymore and/or may sue you and/or your employer for damages.

There are, however, exceptions, which may allow you to do limited things without infringing the rights of the owner. Some examples are set out below, but you should not rely on these exceptions to avoid infringement. If you think there is a possibility of infringing others' rights, contact your supervisor, manager, legal department or technology transfer office immediately.

Patents

You can make a patented product or use a patented process for research purposes providing it is research on the subject matter of the patent. This means that you can also do this to modify or improve the invention to which the patent relates, provided the research is for non-commercial purposes.

You should and can use patents as a source of information. You may want to look through patents simply for inspiration to prevent you starting to do research on something that has already been done. You can search to see what other research has been carried on in the same sort of field as yours and in addition what progress has been made, on which you might be able to build. Much of the information in patents is never published anywhere else and will often contain sufficient detail in the text and illustrations so that you, as experts, can understand how to recreate the invention in a non-commercial way.

You cannot make a patented product or use a patented process for any commercial purpose unless you have the consent (a licence) to do so from the owner of the patent, nor can you do so for research purposes if the research area does not relate to the subject matter of the patent.

If you are in any way unsure whether the work you are involved in may infringe an existing patent, contact your supervisor, manager, legal department or technology transfer office who may be able to look into obtaining more detailed searches for you.

Copyright

It is only an infringement of copyright to copy a piece of work without the consent of the owner of the copyright. If you are photocopying a journal or book, it is possible that your university/institution may already have obtained the consent from the copyright owner through its subscription to a blanket licence through the Irish Copyright Licensing Agency (ICLA) or other collecting society. This is also common practice within libraries. Have a look to see if there are any notices next to the photocopier or within the publication itself relating to this. If you are unsure, contact the librarian.

You can copy a section of a copyright work, providing it is not a substantial part of it. Be careful with this — there are no hard and fast rules on how much constitutes a substantial part. Substantiality is about the quality (importance) of the part copied, not the quantity. There are also allowances for use of limited sections of work where they are being copied for the purposes of instruction within a university or teaching institution. Again, have a look to see if there are any notices next to the photocopier or within the publication to be copied, which may contain some guidelines.

You can also use a piece of a copyright work for non-commercial purposes if you are using it for personal research or private study or for the purposes of criticism and review. You must clearly acknowledge any reference to the work in question.

Whilst there are other situations in which it may be possible to use copyright work without infringement, these are more limited in use and practical application. If you are unsure, it is always best to contact your supervisor, manager, legal department or technology transfer office for further guidance.

Unless you have obtained the copyright owner's consent or your use falls into any of the categories above, you risk infringing copyright if you copy the work or permit another person to copy the work.

It is important to remember that, in any single web page, there can be dozens of different copyrights. If you want to print out a web page, or copy and paste anything from a web page, the same rules will apply. Check the copyright notice on the web page — it may be that the copyright owner has already offered consent. If the copying is not specifically covered in the page's own notice, then you should obtain specific permission — this can most easily be done by email. If in doubt, always refer to your internet policy information.

I was recently provided with a number of tissue samples from a researcher outside of my organisation. I also received a document referred to as an 'MTA' with the samples. What should I do?

MTAs are Materials Transfer Agreements. This agreement is likely to contain a number of restrictions on what you can and cannot do with the samples, how you must deal with the results and whether, for example, you must return any back to the other organisation. It is important to read through the terms carefully and speak to your supervisor, manager, legal department or technology transfer office. They will let you know whether it is appropriate and who is authorised to sign it. You must remember that when any kinds of materials are provided to you it is possible they may contain confidential information or they may even be protected by a patent. By using materials which are protected by a patent in a manner which the owner has not permitted, you may risk infringement. Some MTAs may even try to take ownership of IP created by you. KTI has a Practical Guide to MTAs and Model MTAs on its website, see <http://www.knowledgetransferireland.com/Model-Agreements>.

Section 6 Commercialisation

What is commercialisation?

Commercialisation is where intellectual property is used or disposed of in return for payment, whether in cash, in kind or in any other form.

In the same way as a house can be bought and sold, IP can also be sold or transferred to another owner. This is referred to as an assignment.

IP can also be licensed. This is similar to a 'lease' of a flat. The IP owner permits someone else (the "Licensee") to use the IP in return for payment. If the IP has been used to make a particular product, payment will often include a "royalty". The royalty may be a percentage cut of the price the product has been sold for by the Licensee.

The table below illustrates some main points to remember:

Assignment	Licence
An assignment transfers ownership.	The owner of the IP remains the same.
Once assigned, the original owner will lose their rights to the IP. If the original owner continues to use the IP after assignment, they may risk infringing the rights of the new owner.	The licence can be limited in time.
You can assign ownership of part of copyright e.g. English language rights.	The licence can also be limited in scope:
	An Exclusive licence means that the owner can only permit one licensee to use the IP and cannot license that same IP to anyone else nor use the IP itself.
	A Non-Exclusive licence means that the owner of the IP can license to more than one licensee.
	The manner in which the IP should be used and the field/research area in which it can be used can be defined and limited.

There is more information on licensing available on the KTI website, see <http://www.knowledgetransferireland.com/Model-Agreements/KTI-Practical-Guides/>

Here are some examples of when a licence or an assignment of IP may be involved:

- writing an article for a publisher;
- permitting another person or organisation to use equipment or a specific technique you have developed;
- permitting another person or organisation access to your results and other data for the purposes of further development/experimentation;
- permitting another person or organisation to incorporate a product you have developed into another product; and/or
- franchising out a set of teaching materials for use by another person, university, or institution, or company.

If you think you have IP which can be commercialised you should first contact your supervisor, manager, legal department or technology transfer office to discuss the options.

Case Study

Seamus has just been contacted by an editor from Irish Semi-Conductors Monthly asking whether he would write an article on his conclusions from a project he has recently been involved in. Seamus is asked to sign an agreement before writing the article. Seamus notices one clause which states “I hereby assign all intellectual property rights in or relating to the Article”. What should he do?

First, Seamus should speak with his supervisor, manager, legal department or technology transfer office.

Together, they should consider whether there are any results, conclusions or other information which could be patentable or valuable to readers for use or further development. Disclosure and publication of the article would prevent any patent being granted.

Once Seamus has written the article, provided it is Seamus' own work, he will be the author of the copyright in the written article. Seamus should also consider his moral rights in connection with the article if he has any (see Section 1). However, Seamus will not necessarily own the copyright in the article and should check whether he or his organisation is the owner, referring to any relevant IP policies or documentation. It may be that his employer (organisation) has to sign the agreement rather than Seamus.

He should also consider if an assignment to Irish Semi-Conductors Monthly should be avoided. A licence should be sufficient for Irish Semi-Conductors Monthly to use the article for the purposes of publishing it in a specific edition. An assignment of all intellectual property rights in or relating to the article would mean that Irish Semi-Conductors Monthly would become the owner of the copyright in the article and neither Seamus nor his organisation would be able to reproduce the article again, even internally, without asking for consent and possibly having to pay a licence fee.

Section 7 IP and Confidentiality Checklist

- Your Library Information Service (for literature and patent database searches)
- Your employer's intranet for its IP and various related policies as well as priorities and guidance notes regarding working with other organisations, agencies, and companies/universities
- Research Funding Agencies for good practice IP reports and guidance on relevant issues
- Your supervisor, manager, legal department or technology transfer office
- Esp@cenet Patent website (<http://worldwide.espacenet.com>)
- European Patent Office website (www.epo.org)
- European IP Helpdesk (www.iprhelpdesk.eu)
- Community Trade Mark Searches (www.oami.europa.eu)
- US Patent and Trademark Office (www.uspto.gov)
- The Irish Patents Office (www.patentsoffice.ie)
- Knowledge Transfer Ireland (www.knowledgetransferireland.com)

Copyright

- Protects items such as writing, music, and software
- Protects the expression of an idea, not the idea itself
- Protects original work
- Arises automatically without registration
- Duration mainly life of creator +70 years

Patents

- Protects technical inventions
- Needs registering
- Must be new, inventive, and capable of industrial application
- Don't disclose before filing an application
- Duration usually 20 years

Registered Designs

- Design is new and has individual character
- Not protected if dictated by function
- Don't disclose more than 12 months pre-application
- Duration 25 years

Community Unregistered Design Right

- Criteria same as for registered design
- Arises automatically without registration
- Duration 3 years

TYPES OF INTELLECTUAL PROPERTY	<p>Database Rights</p> <ul style="list-style-type: none">• Protects collection of independent works, data or other materials arranged systematically or methodically arranged• Arises automatically without registration• Duration 15 years
OWNERSHIP	<p>Trade Marks</p> <ul style="list-style-type: none">• Denote origin and source of goods• Not descriptive/must be distinctive• Not identical or similar to an existing mark for similar or identical goods• Duration 10 years (renewable) <p>Ownership</p> <ul style="list-style-type: none">• IP is generally owned by its creator• Employer usually owns IP created by an employee• Consultants generally own the IP they create• Student IP depends on the student contract• Ownership can be varied by contract• Commissioned designs are owned by commissioner

**Copyright/
Designs/
Database Rights**

- Keep originals of works in a secure place
- Record all dates of creation
- Place a copyright notice on each copyright work
- Don't publish on the internet what you don't want copied

Patents

- Check if your invention is new
- Keep lab notebooks (signed and dated) and other notes secure
- Keep invention confidential for as long as possible

Trade Marks

- Use the ™ symbol for unregistered trade mark
- Use the ® symbol for registered trade mark
- Set up a watching service

**Confidential
Information**

- Use written confidentiality agreements
- Maintain information securely
- Keep notes of meetings
- Mark information as confidential
- Think carefully about what you need to disclose and when

USING IP

Using Others' IP

- Can be a source of information
- Has the period/benefit of protection expired?
- Do you have a licence?
- One item can comprise more than one IP right
- Does an exception apply?
- Are you copying a substantial (qualitative) part?
- Have you given appropriate acknowledgement?

COMMERCIALISATION

Commercialisation IP

- IP is used or disposed of for payment
- IP can be bought and sold (assigned)
- IP can be licensed (like a lease)
- Assignment transfers IP ownership; with licensing IP owner remains the same
- Once assigned, original owner loses all rights in IP
- Copyright can be assigned in part
- Licensing allows someone to use IP, often for a royalty payment
- Licence can be limited in length, scope and use

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