

Regulations for TU/e patents and inventions

Taking into account the Higher Education and Research Act (*Wet op het Hoger Onderwijs en Wetenschappelijk Onderzoek*);

Taking into account the prevailing Collective Labour Agreement (*CAO*) of Dutch Universities;

Taking into account the employment contracts of academic staff members, taking into account the enrolment of students as well as taking into account the agreements and/or arrangements with guest researchers and/or other third parties (e.g. people working on secondment at the TU/e);

Taking into account the importance the TU/e attaches to the development and valorisation of knowledge, know-how and research results, as well as making these issues tangible and identifiable, protecting them when possible, and exploiting this knowledge, know-how and results in a responsible manner.

Taking into account the importance to the TU/e of inventions by TU/e staff and students, both in respect of research and education, the Executive Board of the TU/e decides to arrive at the arrangement hereafter concerning work and/or inventions by TU/e staff members and students as well as all other parties involved in a research project which will lead to inventions and/or the development and acquisition of specific knowledge and know-how and/or the generation of research results.

Article 1: Definition TU/e Innovation Lab

TU/e Innovation Lab will be defined as the administrative management unit of the Technische Universiteit Eindhoven, in these regulations. When reference is made in these regulations to giving a mandate to TU/e Innovation Lab, this always relates to a mandate given to the administrator of TU/e Innovation Lab.

Article 2: Aim

These regulations aim to stimulate the transfer of knowledge to third parties, the business community in particular, as well as to acquire income for the TU/e and/or parties involved including inventors, departments and third parties. The regulations serve to increase the marketability of knowledge by protecting recently acquired knowledge.

Article 3: TU/e Innovation Lab management unit

- a. Applications and decisions in the procedure of granting, managing and exploiting patents, the assistance of the procedure and the resources / budgets required have been mandated to TU/e Innovation Lab by the Executive Board
- b. The mandate of TU/e Innovation Lab includes, among other things, the collection, protection, implementation and exploitation of knowledge, inventions, work, and/or intellectual property rights. The administrator reports on this to the Executive Board in the normal course of business.
- c. The TU/e has set up a patent fund, the administration of which has been mandated to TU/e Innovation Lab by the Executive Board. Every year, TU/e Innovation Lab gives account for the administration of the patent fund to the Executive Board.

- d. TU/e Innovation Lab informs the Executive Board of decisions that have been taken on the basis of the mandate given to it. Furthermore, it brings these decisions to the notice of the Department Board, in this case the administrator of the management unit and/or the inventor(s).
- e. TU/e Innovation Lab does not take decisions pursuant to the mandate unless it has consulted explicitly with the Department Board or the administrator of the management unit.

Article 4: Patent Advisory Board

- a. The Executive Board shall set up a Patent Advisory Board comprising a minimum of three and a maximum of five members on the recommendation of TU/e Innovation Lab. The Patent Advisory Board shall consist of persons appointed by the Executive Board. Third parties which are not employed at the TU/e may be members of the Patent Advisory Board.
- b. The Patent Advisory Board shall be set up by the TU/e Executive Board for an indefinite period of time.
- c. Patent Advisory Board members shall be appointed for a period of three years after which membership will end by right. Reappointment by the Executive Board is possible. The Executive Board may prematurely dismiss one or several members of the Patent Advisory Board provided that they do so in writing and with valid arguments.
- d. The Patent Advisory Board shall appoint a chair person from among themselves for a period of at least one year. The Patent Advisory Board will also be secretarially assisted by the TU/e Innovation Lab (being a staff member of the department for contracts, subsidies and patents). The TU/e Innovation Lab administrator will be present at the Patent Advisory Board meetings.

Article 5: Tasks of the Patent Advisory Board:

- a. The Patent Advisory Board is tasked with counselling TU/e Innovation lab on all subjects concerning the protection of knowledge, know-how and/or the protection of research results, as well as on subjects concerning the exploitation of these issues. The counselling task by the Patent Advisory Board is not limited to all subjects concerning patent applications and/or their exploitation, but also extends to other rights of intellectual property such as copyright, protectable know-how and designs and models rights.
- b. The Patent Advisory Board is responsible for promptly applying the right to hear and be heard for all parties involved as part of its counselling tasks described in clause 5a. It shall report on this in writing, and present this to the Executive Board, if requested, through TU/e Innovation Lab.
- c. Counsel offered by the Patent Advisory Board to TU/e Innovation Lab is in writing and public, unless its nature and/or special circumstances require confidentiality. If the counsel of the Patent Advisory Board is deviated from, TU/e Innovation Lab shall state the grounds for the deviation in writing on behalf of the Executive Board.

Article 6: Operation of these regulations

- a. These regulations apply to all the work that is or will be developed (which may or may not be copyrighted), knowledge and know-how and/or generated results, as well as all inventions by academic staff members and students of the TU/e as part of their assigned tasks, as well as all third parties involved in a project. In the event of a written agreement, and, more specifically, in the event of a project commissioned and paid by a third party, these regulations may be deviated from for the purpose of persons and/or legal bodies explicitly stated in the agreement insofar as this has been stated in writing. In this case, the content of the agreement signed by the TU/e and the respective parties will apply primarily, whereas these regulations

will be supplementary. If no written agreement such as stated in these regulations is/has been concluded with a third party, these regulations shall be fully applicable to the respective third parties.

- b. The following persons must relinquish any possible rights of intellectual property, including patent rights to inventions or parts of inventions, before they are involved in a research project or other projects:
 - i. TU/e employees who cannot be regarded as scientific staff members;
 - ii. parties involved, who are not TU/e staff members, and who cannot be regarded as scientific staff members;
 - iii. TU/e scientific staff members whose assigned tasks do not include the creation of inventions.
- c. Insofar as students have not signed a (still valid) written waiver of their rights to intellectual property (including patent and copyrights), for example by registering as student at TU/e, students must sign an agreement in which they relinquish any rights of intellectual property such as patent rights and copyright, insofar as students may be granted any rights, before they are involved in a project.

Article 7: Confidentiality

- a. All parties, including students, scientific staff members, support and management staff members and/or third parties have a confidentiality obligation in respect of all that concerns the project, the research, an invention and/or a protected work. This is subject to a decision of the Executive Board to grant an exemption to this confidentiality obligation.
- b. Parties involved, including students and/or PhD students, must submit an intended publication to the Department Board of the department they belong to or are enrolled at as a student, before making it public, insofar as this ensures protection in the form of the application for an intellectual property right (such as a patent), for the knowledge and/or results and/or inventions described in the intended publication. The Department Board will inform TU/e Innovation Lab forthwith. In consultation with TU/e Innovation Lab, it will be determined what actions need to be taken to safeguard the rights of the TU/e, and, if required, the Department Board may decide to postpone a publication. The Department Board may, on request, allow the submission of a draft publication to reviewers (for example, for the purpose of a journal or conference proceedings), provided that during a term which will be determined by the Department Board the confidentiality is sufficiently guaranteed by the reviewers and/or the person responsible for the conference. In this case, the Department Board may partly release a person and/or legal body from confidentiality obligations taken on previously, including confidentiality obligations resulting from these regulations. The Department Board will decide as soon as possible. The Department Board will inform TU/e Innovation Lab forthwith.
- c. If a student and/or a member of the TU/e scientific staff wishes to enter a competition, he/she must consult with the Department Board of the department he/she belongs to or is enrolled at as a student in advance. The Department Board will inform TU/e Innovation Lab forthwith, unless the work concerned is outside the scope and aim of these regulations. In consultation with TU/e Innovation Lab, it will be determined what actions need to be taken to safeguard the rights of the TU/e.

Article 8: TU/e patent holder, legal copyright holder

- a. The intellectual property rights, including patent rights, the patent ascription and copyright, lie with the TU/e at all times, even if the invention has been created by a professor. The inventor and/or joint inventors has/have the right to be registered as inventor in the patent application.

- b. TU/e Innovation Lab is responsible for standardised and correct procedures in respect of registering the inventors' names.
- c. Insofar as Article 7 of the Copyright Act permits this, the TU/e is the copyright holder of all copyright work created by TU/e employees. In case the TU/e is not the copyright holder according to Article 7 of the Copyright Act, the prevailing Collective Labour Agreement (CAO) is applicable, provided that employees cannot withhold the transfer of copyright if the work has been created as part of an assignment commissioned by a third party. Third parties, including students (insofar they have not when registering as a student of TU/e signed a (still valid) written waiver of rights to intellectual property), are obliged to transfer copyright to the TU/e on work created by them under the authority of the TU/e, insofar as the TU/e is not already copyright holder. Employees do not forfeit their moral rights ('persoonlijkheidsrechten') upon transfer of copyright, as stated in Article 25 of the Copyright Act.

Article 9: Reporting

- a. Persons who suspect that they have created an invention which may be patentable are obliged to report this, through the Department Board and/or the administrator of the management unit, to TU/e Innovation Lab.
- b. If persons report to the Department Board or the administrator of the management unit as stipulated in the previous clause, they are obliged to inform TU/e Innovation Lab in writing forthwith. The Department Board and/or the administrator of the management unit have a confidentiality obligation, except with respect to TU/e Innovation Lab and/or the Patent Advisory Board and the inventors who, in their turn, have a confidentiality obligation.

Article 10: Filing of a patent application, expanding and maintaining patents

- a. As soon as possible but not later than six months after the reporting as stipulated in the previous Article was received, TU/e Innovation Lab takes a decision on behalf of the Executive Board on whether or not to file a patent application for the respective invention, after hearing the Patent Advisory Board. The decision must be accompanied with a valid statement of grounds and all relevant documents.
- b. If the parties concerned and/or the Department Board and/or the management unit wish to submit a patent application to which TU/e Innovation Lab objects, the Department Board and/or the administrator of the management unit may request the Executive Board to reconsider the application.
- c. Considering a request for filing a patent application, TU/e Innovation Lab has made the choice whether the application concerns a Dutch patent, a European patent, a [PCT] patent application, or a combination.
- d. At all times TU/e Innovation Lab has the right to ask advice of a third-party expert concerning the question of whether and/or how a patent application should be submitted. The advice of the third party is accessible to the parties involved as stipulated in Article 5a and 5c, insofar as this does not oppose the required confidentiality until after the submission of the patent application. After the submission of the patent application, the advice of the third party is fully available to the parties involved.

- e. Provided that confidentiality is maintained, the inventors as well as the Department Board and/or the administrator of the management unit of a patentable invention always have the right to all the information available.
- f. If the request for filing a patent application is granted, TU/e Innovation Lab will file the patent application. The costs related to the patent application, a novelty study (if required), and the granting procedure will in this case be fully for the patent fund of TU/e Innovation Lab.
- g. If TU/e Innovation Lab does not approve the request, it will not file a patent application. The Patent Advisory Board, the Department Board and/or the administrator of the management unit as well as the inventor will be notified of this decision and provided with the reasons.
- h. Not later than six months after the reporting of the invention as stipulated in Article 9 of these regulations, TU/e Innovation Lab must have filed the patent application(s). If this term expires, the inventor has the right to file a patent application him/herself at his/her own expense and to proceed to exploitation of the patent right or patent application.

The stipulations stated in this Article observe the stipulation of article 1.22 clause 2 of the CAO. Article 1.22 clause 3 of this CAO remains valid at the moment that these regulations take effect. Further conditions may be agreed whereby the claim to the patent can be transferred to the inventor or a third party. This will be a decision of the Executive Board, after consultation with TU/e Innovation Lab and if necessary after having consulted the Patent Advisory Board and in the event of transfer to a third party after consultation with the inventor(s).

- i. In the event that TU/e Innovation Lab has applied for a patent in only 1 country or in just a few countries, TU/e Innovation Lab decides whether to extend the patent application within the priority period following any consultation with the Patent Advisory Board and with the Department Board or administrator of the management unit and the inventors. The recommendation of the Patent Advisory Board will contain the justified possibilities and recommendations, including financial insight into the costs.
- j. In the event that TU/e Innovation Lab decides not to apply for a patent or pursue a patent application, TU/e Innovation Lab will inform those involved in writing, especially the inventors (including scientific staff members).
- k. As stipulated in 10j each of the respective parties therein stated has the right to apply for or pursue a patent. TU/e has the right to set further conditions in such case. TU/e will in such case, and insofar as this is required for the patent application and the validity of the patent, observe confidentiality.
- l. Concerning the extending of the patent application (European application with the countries stated therein and/or PCT application with countries stated therein), TU/e Innovation Lab will also decide in this respect who will bear the costs thereof if these cannot be covered by the patent fund. Basic principle is that the costs for the first 30 months can be covered by the patent fund.
- m. TU/e Innovation Lab will decide following advice from the Patent Advisory Board and/or the Department Board or administrator of the management unit whether and for how long a patent will be kept valid as well as who after the period of 30 months will bear the costs of maintaining the validity.

Article 11: Cooperation

The inventor must cooperate to the best of his ability on the procedure for acquiring a patent application as well as on the extension procedure. The inventor must provide information concerning the invention whenever requested to do so by the TU/e Innovation Lab and/or the Patent Advisory Board.

Article 12: Exploitation

- a. Once the patent has been filed, TU/e Innovation Lab will ensure that the Department Board, the administrator of the management unit and/or the inventors and/or the third parties designated by the Executive Board receive a copy of the confirmation thereof. By the same token this stipulation also applies to the granting of the patent.
- b. TU/e Innovation Lab will draft a plan together with those involved (including explicitly the inventors and third parties) for exploiting the patent (or patents) including matters pertaining to the selected exploitation and financial possibilities. TU/e Innovation Lab will, if necessary, allow itself to be advised by the Patent Advisory Board and external third parties if required.
- c. Following receipt of the confirmation as stated in 12a of this Article, TU/e Innovation lab must try in cooperation with the inventors, Department Board and/or administrator of the management unit to interest a party to exploit the patent application and/or patent, whether through transfer, granting of a licence, as part of a start-up in exchange for participation or in another way.
- d. All agreements concerning the transfer of the rights to a patent application and/or patents as well as licences will be prepared by TU/e Innovation Lab but be effected by the Executive Board. Decisions regarding other forms of exploitation than those stated above will be taken by the Executive Board following advice from TU/e Innovation Lab.
- e. The stipulations in 12a to 12d do not apply to copyrights and other intellectual property rights such as rights to designs and models.
- f. In respect of possible exploitation of copyrights, data bank rights or designs or models rights, more especially of computer programming or data files, agreements on exploitation can be made with the makers and/or designers.

Article 13 Fee structure:

- a. In the decision of TU/e Innovation Lab (in compliance with the Patent Advisory Board) to file a patent application and irrespective of any subsequent exploitation, a bonus amount will be paid personally to the inventor(s) of a (gross) fee that will be adjusted each year by the Executive Board as an incentive to stimulate patent consciousness and to reward results in this aspect. The level of this fee is at the time that this regulation takes effect (gross) € 1,500.-. In the event of there being more than one inventor, this fee will be shared amongst them.
- b. Without prejudice to that stipulated in 13a the fee (in euros) that TU/e receives upon transfer/ licence provision of a patent application/patent or part thereof from third parties or (cash) revenues from other forms of exploitation will be distributed as follows:

- i. The amount of the costs (including advisory costs such as for commercial possibilities) linked to applying for, granting and maintaining the respective patent (Dutch patent, international patent or any PCT application in various countries) will be deducted from the fee. This amount will be paid into the patent fund of TU/e Innovation Lab or other budgets which has/ have covered these respective costs
- ii. Any extra (cash) revenues will be distributed based on the following basic principles:
 - 33 ⅓ % for the inventor(s) (individually or jointly, to be divided by mutual consent)
 - 33 ⅓ % to the department / management unit/ research institute / research group of the inventor(s) to fund new research
 - 33 ⅓ % to the university or patent fund of TU/e Innovation Lab
- iii. Any additional revenues as stated in 13b.ii may be paid out or settled in a variety of ways, depending on the selected commercial/exploitation forms. In the event, for instance, of the use of patents from TU/e for commercial exploitation in a start-up company in exchange for acquiring part of the shares or right to shares, the option may be exercised, on the advice of TU/e Innovation Lab, for partial allocation (and purchase) of the shares to the individuals involved in line with an representative formula as indicated above.

That stipulated in 13b does not apply if TU/e receives a fee in kind upon the transfer, granting a licence or providing a patent application/patent or part thereof to third parties.

- c. The Executive Board may if it wishes deviate from this principle on the advice of TU/e Innovation Lab and/or the Patent Advisory Board or the Department Board or the administrator of the management unit provided that this is expressly well founded and provided it complies with the interests of all parties involved.
- d. TU/e Innovation Lab is responsible, in close consultation with the respective Department/ management unit, for properly executing the distribution.
- e. In the event of a fee as stipulated in 13 b. the inventor will ensure that TU/e Innovation Lab is kept fully informed of all relevant data such as name and address details. If TU/e Innovation Lab does not have these, no payment will be made. It is the responsibility of the inventor to provide TU/e Innovation Lab with these details.
- f. That stipulated in 13a to 13d does not apply in respect of the exploitation of other intellectual property rights like copyrights (such as computer programs) or database rights or designs or models rights.
- g. In respect of the possible exploitation of other intellectual property rights (including copyrights, database rights or designs or models rights) TU/e Innovation Lab can enter into specific agreements regarding a fee to the department, makers and/or designers.

Article 14: Right to deviate

- a. The Executive Board may deviate from these regulations based upon a well-founded decision.

Article 15: Enactment, Regulations

- a. These regulations replace the “Regulations for inventions by TU/e staff members and students (CvB 99/2915” enacted by the Executive Board in its meeting of 30 August 1999.

- b. These regulations come into force with retrospective effect on 1 January 2006. For old patents prior to 1 January 2005 and for all patent applications and procedures relating to patent and which began after 1 January 2005, the old regulations of 1999 apply but will be subject to transitional regulations in the light of the new regulations whereby (specifically for the distribution of revenues) on the one hand as much as possible will be transacted in the light of the new regulations but on the other hand old agreements and principles will be respected as much as possible. Each case will be individually reviewed by the Executive Board, advised by TU/e Innovation Lab, and be agreed with those involved and the respective Department Board or administrator.
- c. The Dutch version of this regulation is the official version.

As enacted by the Executive Board dated June 29th 2006 and updated on September 4th, 2008.