

# **TU/e Patents and Inventions Regulations**

Eindhoven University of Technology

# The Gate

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## TU/E PATENTS AND INVENTIONS REGULATIONS

Having regard to the Higher Education and Research Act;

Having regard to the prevailing the Collective Labor Agreement (CAO) of the Dutch Universities;

Having regard to the Dutch Patents Act 1995;

Having regard to the contracts of appointment of the scientific staff, the enrollments of students and the agreements and/or arrangements made with guest researchers and/or other third parties (for example, persons working at TU/e on a secondment basis);

Having regard to the importance that TU/e attaches to the development and valorization of knowledge, know-how and research results, as well as to making these concrete and identifiable; and, where wise, the protection of all this, as well as the exploitation in a responsible manner of this knowledge and know-how and these results;

Having regard to the importance to TU/e, in matters of knowledge valorization, research and education, of inventions by TU/e staff and students;

The Executive Board of TU/e decides to institute the following regulations regarding works and/or inventions by TU/e staff and, where applicable, students, as well as all other parties involved in a research study in which inventions are created and/or where specific knowledge and know-how are developed and acquired and/or where research results are generated;

### **Article 1: Definition of The Gate**

In these regulations The Gate is taken to mean the service within TU/e. This service is authorized to make use of the expertise of third parties, where necessary. Where in these regulations the giving of a mandate to The Gate is referred to, this always refers to the mandate given to the director of The Gate.

### **Article 2: Aim**

The objective of these regulations is to promote the valorization of knowledge through effective management of Intellectual Property (IP). These regulations seeks to ensure the alignment and balance between IP protection and valorization of TU/e IP, and the traditions of performing research, education, academic freedom, open and timely publications, dissemination of research results among partners or through entrepreneurship, as well as TU/e's mission of serving the public interest.

### **Article 3: The Gate**

- a. The application and decisions in the procedure to extend the term of patents, their management and exploitation, assisting the process and the necessary resources/budgets are mandated by the Executive Board to The Gate.
- b. The mandate given to The Gate includes the collection, protection, implementation and exploitation of knowledge, inventions, works, and/or intellectual property rights. The director of The Gate reports on this subject to the Executive Board.
- c. TU/e has set up a patent fund, the management of which has been mandated by the Executive Board to The Gate. Each year The Gate is accountable to the Executive Board for matters relating to the management of the patent fund.
- d. The Gate informs the Executive Board annually of the decisions taken based on the mandate it has been given.

#### **Article 4: Operation of these regulations**

- a. The present regulations apply to all works to be developed and those already developed (whether or not protected by copyright), knowledge and know-how and/or results generated as well as to all inventions created by scientific staff and students of TU/e as part of their employment as well as to all third parties involved in a project. In the event that a written agreement has been entered into, particularly in the case of a project commissioned and paid for by a third party, and where this has been recorded in writing, it is possible to deviate from these regulations for the benefit of the person and/or legal entities named in so many words in the agreement. In that case, the content of the agreement concluded by TU/e with the third party concerned takes precedence and these regulations have only a supplementary function. In the event that no written agreement, as referred to in this provision, has been entered into with a third party, these regulations apply unimpaired to the third party concerned.
- b. Before being involved in a research or other project, the persons below should relinquish any potential intellectual property rights, including patent rights in inventions or parts of inventions:
  - i. employees of TU/e who cannot be designated as scientific staff;
  - ii. parties involved, not being staff of TU/e who cannot be designated as scientific staff;
  - iii. scientific staff of TU/e for whom creating inventions is not among the tasks they are employed to do.
- c. Intellectual property rights of students are regulated by TU/e Policy on Student IP.

#### **Article 5: Confidentiality**

- a. All parties, including students, scientific staff, auxiliary staff and/or third parties are bound to confidentiality with regard to everything concerning the project, the research, an invention and/or a protected work. This applies except where the Executive Board grants an exemption from this duty of confidentiality.
- b. Before publishing a proposed publication, parties involved, including students and/or PhD candidates, should submit this to the Departmental Board of the department to which they belong or are enrolled as a student, wherever publication gives rise to protection in the form of the application for an intellectual property right (such as a patent) pertaining to the knowledge and/or results and/or inventions described in the proposed publication. The Departmental Board informs The Gate immediately. In consultation with The Gate the steps necessary to safeguard the rights of TU/e will be established, which may include the Departmental Board deciding to postpone publication. In response to a request, the Departmental Board can permit the submission of a draft publication to reviewers (e.g. for the purposes of a journal or for conference proceeding), provided that sufficient confidentiality is guaranteed by the reviewers and/or responsible individuals related to the conference for a period to be determined by the Departmental Board. In that case the Departmental Board can partially release a person and/or a legal entity from duties of confidentiality entered into earlier, including duties of confidentiality arising from these regulations. The Departmental Board makes its decision as soon as possible. The Departmental Board informs The Gate immediately.
- c. In the event of a student and/or a member of TU/e's scientific staff wishing to enter for an award, he/she will consult in advance with the Departmental Board of the department to which he/she belongs or is enrolled as a student. The Departmental Board informs The Gate immediately unless the work falls outside the scope of these regulations. In consultation with The Gate the steps necessary to safeguard the rights of TU/e will be established.

#### **Article 6: TU/e holder of the patent, copyright owner**

- a. The intellectual property rights, including the claim to any patent, the name under which the patent is registered and the copyright remain at all times with TU/e. The inventor and/or the joint inventors is/are entitled as inventor to be mentioned in the patent application.
- b. The Gate ensures that standardized and meticulous procedures are followed regarding the recording of inventors' names. Inventors are obliged at the request of The Gate to submit all the information required for this purpose.
- c. In so far as Article 7 of the Copyright Act permits, TU/e is the copyright owner in all copyright-protected works made by employees of TU/e. Where TU/e is not the copyright owner under Article 7 of the Copyright Act, the prevailing the Collective Labor Agreement of the Dutch Universities applies, on the understanding that the employee cannot refuse to transfer copyright where work has been made as part of an assignment for a third party. Third parties include students who have signed a statement relinquishing intellectual property rights, or are obliged to transfer the copyright to TU/e in works they have made on the instructions of TU/e, in so far as TU/e is not already the copyright owner by operation of law. Upon the transfer of copyright, the employee does not lose his or her moral rights as stated in Article 25 of the Copyright Act.

#### **Article 7: Reporting**

Anyone who suspects that he or she has created an invention for which patent protection may be considered wise is obliged to report the invention to The Gate by means of a completed TU/e Invention Disclosure form.

#### **Article 8: Submitting the patent application, extending and maintaining the patent**

- a. As soon as possible, but at the latest within nine months of receiving the report as referred to in the preceding Article, The Gate decides on behalf of the Executive Board whether or not to apply for a patent for the invention in question. In the event that it is decided not to apply for a patent, The Gate, in consultation with the inventor(s) as well as, if necessary, the relevant Departmental Board and/or the manager of the management unit, can request the inventor(s) to observe confidentiality regarding an invention, in order to leave open the possibility that a patent may yet be applied for at a later and more advanced stage.
- b. In the event the interested persons and/or the Departmental Board and/or the management unit wish to submit a patent application, to which The Gate objects, the matter may be submitted to the IP Board.
- c. In its considerations regarding a request to submit a patent application, The Gate will have decided whether the application concerns a standard national or regional patent, a provisional patent application or a PCT patent application, or a combination of these.
- d. The Gate retains at all times the right to take advice from an expert third party regarding the question of whether/how a patent application should be submitted.
- e. Provided confidentiality is observed, both the inventor(s) as well as the Departmental Board and/or the manager of the management unit of a patentable invention continue to be entitled to receive complete information, if they request it.
- f. In the event of a positive decision regarding the request to apply for a patent, The Gate will submit a patent application. The costs involved in the patent application will in that case be charged in full to the patent fund of The Gate.
- g. In the event that The Gate cannot agree to the request, it will not submit a patent application.

- h. At the latest nine months after the reporting of the invention as referred to in Article 7 of these regulations, The Gate should have taken a decision whether or not to apply for a patent or to observe continued confidentiality regarding the invention. In the event that it is decided not to apply for a patent nor to observe continued confidentiality, the inventor is entitled after this period has elapsed to submit his or her own patent application, at his or her own expense, and to proceed to the exploitation of the patent right/application. The stipulations of this Article relate to the provisions mentioned under 1.22 of paragraph 2 of the CAO prevailing at the time at which this rule is introduced. Article 1.22 paragraph 3 of this CAO remains in force. Under conditions later to be agreed, the claim to the patent can be transferred to the inventor or a third party. This is decided by The Gate with the approval of the Executive Board, and, in the event of transfer to a third party, also following consultation with the inventor(s).
- i. In the event that The Gate has applied for a patent initially in only one country or in only a few countries, The Gate decides as soon as possible following consultation with the Departmental Board and/or the manager of the management unit and the inventor(s) whether it will extend the patent application.
- j. In the event that The Gate decides not to submit a patent application and/or not to continue with a submitted patent application, The Gate will communicate this to the parties involved, in particular to the inventor(s).
- k. In the provisions mentioned under 8j, each of the parties involved named there are themselves entitled to submit or continue to pursue a patent. TU/e is entitled at that time to impose additional conditions.
- l. Regarding the extension of the patent application as mentioned under 8i, The Gate also decides to whom the costs will be charged if these cannot be met by the patent fund.
- m. The Gate decides, following consultation with the Departmental Board and/or the manager of the management unit, whether and for how long a patent will be maintained, as well as to whom the costs will be charged if these cannot be met by the patent fund.
- n. The principle underlying the provisions mentioned under both sub 8l and 8m is that for the first 30 months the costs will be covered by the patent fund and thereafter by the department and/or the group from which the invention originates.

#### **Article 9: Cooperation**

The inventor is obliged to cooperate to the best of his or her ability in the realization of a patent application as well as the extension procedure. The inventor is obliged to provide information regarding the invention when this is requested by The Gate.

#### **Article 10: Exploitation**

- a. The Gate makes a plan with the parties involved (including in particular the inventor(s) and any third parties) for the exploitation of the patent application or the patent (or patents) including in the matter of deciding how to exploit the patent and in the matter of the financial possibilities. The Gate will, where necessary, take advice from external third parties.
- b. The Gate, where possible in cooperation with the inventor(s), the Departmental Board and/or the manager of the management unit, will make every effort to interest a party in exploiting the patent application and/or the patent, either by means of granting a license, or by putting it into a new business, or by means of transfer, or in some other way.

- c. All agreements concerning the transfer of the rights in a patent application and/or in patent(s) as well as regarding licenses will be prepared by The Gate, but concluded by the Executive Board. Decisions regarding forms of exploitation other than those mentioned here will be taken by the Executive Board once it has taken advice from The Gate.
- d. The provisions mentioned under 10a through 10c apply explicitly to the exploitation of other intellectual property rights such as copyright (for example, computer software) or databank rights or rights in drawings or models. In which case, instead of the word “patent”, the appropriate intellectual property right should be read.

**Article 11: Compensation structure:**

- a. In the event that The Gate decides to apply for a standard patent in the name of TU/e, irrespective whether the planned later exploitation comes to pass, the inventor(s) are personally paid a (gross) bonus, the amount of which is reviewed annually by the Executive Board, as an incentive to stimulate patent awareness and to reward results achieved in this area. This bonus is not paid out for a provisional patent application, such as a US provisional patent application or a temporary national or regional patent application the primary aim of which is to safeguard a priority date. In such instances, payment of the bonus takes place only if a provisional patent application is followed by a standard patent application.
- b. The amount of the bonus, which is charged to the relevant department or management unit, is at the time of the entry into force of these regulations (gross) 1,500 euros (fifteen hundred euros). If there are several inventors, this amount will be divided by the number of inventors and the bonus will be paid pro rata only to inventors who were employed by the TU/e on the date the invention was discovered or who were enrolled on said date as a student at TU/e.
- c. A bonus as mentioned under 11b is also paid to inventors who are named on a patent application filed by a company provided that:
  - i. The invention is the result of a collaboration or contract research, not being a consultancy or internship assignment, between the TU/e and the company concerned and for which the TU/e receives compensation from the company for performing its activities in the collaboration or the contract research;
  - ii. The invention was reported to The Gate via a completed TU/e Invention Disclosure Form (IDF), before the company filed the patent application.
- d. Without prejudicing the provisions mentioned under 11a, the compensation received by TU/e upon the transfer/granting of a license pertaining to a patent application/patent or part thereof to third parties or the cash revenue from another form of exploitation is divided up as followed:
  - i. The costs (including advisory fees such as those concerning commercial possibilities) related to the application and grant procedure as well as the maintenance of the patent or patents concerned are deducted from the compensation. These costs are payable to the patent fund of The Gate, to which the costs involved were charged or any other budgets used (at that time) to cover the costs.
  - ii. Any surplus of the cash revenues, insofar as these are directly related to the exploitation of a TU/e patent application/patent, will be distributed according to the following principles:
    - 33⅓% goes to the inventor(s) (an individual, or if several inventors are involved, divided equally, unless the group of inventors unanimously proposes another split to The Gate);

- 33⅓% goes to the inventor's or inventors' own capacity group/department/management unit/research institute in order to fund new research activities;
  - 33⅓% goes to the patent fund of The Gate.
- iii. Any surplus of the revenues as referred to under 11d.ii can be paid out and/or settled in several ways. This depends on the chosen commercial/exploitation form. The provisions mentioned under this 11d explicitly do not apply if TU/e receives a nonmonetary compensation (in any case including but not limited to earmarked monies for research activities) upon the transfer or granting of a license pertaining to a patent application/patent or part thereof to third parties.
- e. At the advice of The Gate or at the advice of the Departmental Board or the manager of the management unit, the Executive Board can, if required, deviate from these principles provided the grounds for so doing are stated explicitly and provided due consideration is given to the interests of all parties involved.
- f. In close consultation with the relevant department and/or management unit, The Gate is responsible for the proper execution of the division.
- g. In the event that compensation as referred to under 11d is appropriate, the inventor will ensure that The Gate is kept fully updated of all relevant data, such as name, street address and city (in Dutch: NAW details). If The Gate does not have these details, no payment will follow. The burden of proof that The Gate has these details lies with the inventor(s). If The Gate is unable to make contact with an inventor or entitled person throughout a period of two years, the compensation in question lapses and reverts to TU/e, in so far as is legally permitted.
- h. The provisions mentioned under 11a through 11c do not apply to other intellectual property rights such as copyright (for example, computer software) or databank rights or rights in drawings or models.
- i. The provisions mentioned under 11d through 11g apply explicitly to the exploitation of other intellectual property rights such as copyright (for example, computer software) or databank rights or rights in drawings or models. In which case, instead of the word “patent”, the appropriate intellectual property right should be read.

#### **Article 12: Right to deviate**

Upon producing a reasoned decision for so doing, the Executive Board can deviate from these regulations.

#### **Article 13: Adoption**

- a. These regulations replace the TU/e Patents and Inventions Regulations adopted by the Executive Board in its meeting of June 29, 2006 and amended on September 4, 2008, November 17, 2016, and September 20, 2018.