

The University of Padova's Patent Regulations

Art. 1 - Right to patent

- 1.1. These regulations govern – together with Legislative Decree No. 30 dated 10 February 2005 (Code of Industrial Property, hereinafter referred to as CIP) – the management of research results carried out by the employees of the University of Padova (hereinafter referred to as University) that may give lead to patentable inventions, utility models, models and ornamental designs, software, databases, *know-how* and any other innovation susceptible of protection. Copyright does not fall within the scope of these present Regulations.
- 1.2. In terms of intellectual property, relations between the University and the grant holders or research staff under contract of collaboration are governed by their respective contracts. As for relations between the University and the PhD students and students, it will be the responsibility of project's supervisor to communicate these commitments to the grantee and collect their commitment to transfer the patent rights to the University itself.
- 1.3. University employees have the right to patent, in their own name and at their own expense, inventions and innovation as any other protectable intellectual property, made during performance of their duties, by giving notice to the University in accordance with Par. 1 of Art. 65 of the CIP and Art. 3.6 of these Regulations. The University, on the basis of this communication, may propose the inventor to transfer all or part of the patent rights.
- 1.4. Inventors wishing to make use of the University's technical and financial support in the patent filing process can transfer the right to file a patent application, free of charge, to the University by subscribing to a specific contract.
- 1.5. If the right to submit a patent application is transferred to the University, this will be without prejudice and within the inventor's moral rights to be recognised as authors of the invention.
- 1.6. These Regulations shall also apply to inventions made by employees of the University working jointly with others who are not employed by the University.

Art. 2 – Inventions within the scope of research activities financed by third parties

- 2.1. In accordance with Paragraph 5 of Art. 65 of the CIP, the University has the right to patent an invention created by its employees and as part of research activity that was financed by third parties.
- 2.2 Under a contract or funding for research activities, the University may provide for the transfer of the patent application of the invention. In that case, the patent application shall be filed jointly by the University and funder and at the expense of the funder. The University will enter into a contractual agreement to transfer to the funder his share of the patent application, if requested within one year from the filing date, in return for a fixed fee.
- 2.3 The aforementioned payment will be in addition to the payment made to the University for performing research activities and must be not less than 10% of the same.

- 2.4 In special cases, and properly justified by the research department that signed the contract, the share for the payment of the patent application may be less than the minimum stated above. In this case the contract must receive a favourable opinion from the University Patents Commission referred to in paragraph 4.3 and, before being signed by the Department, must be approved by the Board of Directors.
- 2.5 If the payment of the patent application is transferred from the University to the funder, this will be made formal through a contract that will respect the conditions agreed in the research contract. This transfer agreement will be signed by the legal representative of the University without the need for approval by the Board of Directors.
- 2.6 In the event of transfer of ownership referred to in this article, the funder cannot unreasonably deny the right to use the patent for scientific and educational purposes for more than 18 months after the end of the contract.

Art. 3 – Duties of inventors

- 3.1. If inventors create an invention they consider patentable, they are obliged to confidentiality regarding the research and its outcomes. In particular, in order to allow for valid patenting of the invention, inventors must refrain from publications of all kinds, including communications and posters presented at scientific conferences. Also every verbal communication with industry and other stakeholders about the invention must be preceded by the signing of a non-disclosure agreement (*Secrecy Agreement* or *Non-Disclosure Agreement*). Failure to comply with the provisions of this paragraph makes the invention non-patentable.
- 3.2 Inventors interested in transferring patent rights to the University in order for it to file a patent application on their behalf, must send a "Patent Proposal" to the University as stated in the form attached (Attachment no. 1).
- 3.3 In the event that non-University employees participate in the invention, they may assign their patent rights to the University and participate in the distribution of profits (see art. 6) in the same way as the employees of the University.
- 3.4 The transfer of patent rights to the University by the inventors may be total or partial. If it is partial, the inventors must indicate on the patent proposal as to which other parties they intend to transfer the patent rights and what the percentage of ownership of the patent will be.
- 3.5 In the Patent Proposal, every inventors must also specify the percentage of their original contribution. In the absence of a declaration, it is assumed that all inventors contributed to the invention in equal measure.
- 3.6 If the inventors choose to file the patent application in their own name or to sell to third parties the right to patent their invention, they must notify the University within 30 days of filing the patent application or the stipulation of the sale contract to third parties.
- 3.7 All communications with the University should be addressed to the head of the University's Central Administration in charge of technology transfer.

Art. 4 - Patent filing on behalf of the University

- 4.1. In the Patent Proposal as mentioned in the previous article, the inventors should specify whether the patent application filing costs will be covered with their own department's funds or if they require use of the University's patent fund.
- 4.2 If the costs are to be covered by the Department, the inventors must attach to their Patent Proposal a statement issued by the Department's in support of this.
- 4.3 If University funds are required, the Commission for University Patents, comprising experts appointed by the Rector, will vote on whether to proceed with the patent filing process on behalf and at the expense of the University. Members of the Commission are bound to strict confidentiality regarding the information they become aware of in the evaluation phase of the Proposed Patent.
- 4.4 The Commission for University Patents will also decide on whether to cover the cost of an international extension (PCT or other procedures) to a national patent application and on any other course of action that may impact the use of the University's patent fund.

Art. 5 - Economic terms of the patent

- 5.1. The University has the right to transfer to third parties the right to industrial exploitation of the patented invention, through licensing or transferring of the patent or of the patent application, which must be approved by the University Board of Directors, after consulting the Commission for University patents.
- 5.2. The University is committed to involve the inventors in negotiations with third parties for the sale or license of the patent, while keeping its aim of maximizing the proceeds from the sale of the patent, in terms of financial compensation and financing research activities conducted by the inventors.
- 5.3. In the event that the University authorises a spin-off company, set up by the inventors and aimed at the industrial exploitation of the invention, the University will sell or confer or transfer the license patent to the spin-off.

Art. 6 – Profit Distribution

- 6.1. In the event that an employee of the University files a patent in his own name and has an income through the sale of the patent or the grant of licence to third parties, the University is entitled to a share of the profits after patenting expenses. According to Par. 2 Article 65 of the CIP, it is established that a share must be of 40%.
- 6.2 In the event that a patent application has been filed by the University, revenues from contracts for the sale, license or option must, first, reimburse the costs incurred by the structure for patenting. In the cost calculation, future costs should also be included, even if not yet actually incurred at the time of entering into the agreement or assigning of a patent license.

- 6.3. The University may make use of specialised consultants and licensed professional specialized in filing patent applications. The costs of the professional services of consultants / agents must be included in the costs of patenting.
- 6.4 After repaying the costs of patenting and the assignment of any shares to others outside the organization, the profits will be distributed as follows:
- 60% to inventors
 - 40% to the University.
- 6.5 The portion allocated to the University will be divided as follows:
- 30% to the Central Administration, and 10% to the department the inventors are affiliated with, if the patent application has been paid by the University Patents Fund;
 - 10% to the Central Administration, and 30% to a part of the the department the inventors are affiliated with, if the patent application has been paid by the department;
 - 20% to the Central Administration Department and 20% to the department the inventors are affiliated with, if the patent costs were not incurred patent by the University.
- The fee payable to the Central Administration is intended to fund the University Patents.

Article 7 Exemptions

- 7.1 The University may sign specific cooperation and research agreements (for example for projects financed by public or private institutions), or framework agreements (as part of multi-year research projects in collaboration with public or private entities and industries) that provide for agreements on the patenting of inventions not according to these Regulations. Such agreements will be submitted to the Board of Directors.

Art. 8 - Reference to the current legislation

- 8.1 For anything not specified within these present regulations, reference shall be made to current law.