

PATENT REGULATIONS OF THE UNIVERSITY OF PADUA

PART I DEFINITIONS AND SCOPE

Article 1: Aims of the University; purpose and scope of these Regulations

1. The University of Padua (hereinafter referred to as the University) has among its primary aims:
 - a) to promote research within the University, including in conjunction with companies and third parties
 - b) to promote the protection of the University's research results through patenting, registration or other means
 - c) to enhance the University's research results, through the promotion of activities that also generate an economic benefit
 - d) to encourage the transfer of the University's research results to companies operating in the market
 - e) to enable its Employees and Non-Employees to share in the benefits that may derive from such enhancement.

2. These Regulations, referring to the current national, European Union and international rules in force, and, in particular, the provisions of Decreto Legislativo (Legislative Decree) no. 30 of 10 February 2005, as amended and supplemented (the Industrial Property Code, referred to hereinafter as the "IPC"), govern the procedures and activities for the protection of inventions, utility models, plant varieties, topographies of semiconductor products and, more generally, any other form of knowledge, innovation or know-how that may be the subject of an industrial property right, which may have been originated, generated, created and/or developed, for any reason, within the University or within projects, activities, and/or other forms of partnership or collaboration involving the University.

Article 2: Definitions

1. In these Regulations, the following expressions shall have the meaning given to them below:
 - (a) "**Research Activities**" means the activities carried out by Employees and/or Non-Employees and aimed, even only occasionally (e.g. students and/or PhD students involved in any way in such activities), at scientific research, using equipment, facilities or financial means belonging to the University or, in any case, economic resources administered by it
 - (b) "**Patent(s)**" means the industrial property rights through which the rights to the Inventions are acquired, including the application for such rights and the right to file such an application. This includes patents for invention, utility models, rights to a new plant variety and registrations of topographies of semiconductor products
 - (c) "**Employees**" means any kind of person employed (on either a permanent or fixed-term contract) by the University

(d) **“Non-Employees”** means those persons who, although not Employees, have work and/or collaboration relationships of the most varied nature with the University, within the scope of which a Research Activity or, in any case, an activity that may generate an Invention is envisaged. In particular, this definition includes, purely by way of example, contract lecturers, research assistants¹, scholarship holders, contract workers and collaborators of any kind, students, students enrolled in specialisation schools and on PhD courses, with the exception of students on higher-education apprenticeships² and industrial PhD students³

(e) **“Inventor(s)”** means the person(s) who create(s) the Invention

(f) **“Invention”** means any type of innovation and/or useful result deriving from the Research Activity and liable to be the subject of a Patent for invention as stipulated in the IPC

(g) **“External Staff”** means personnel other than Employees and Non-Employees such as industrial PhD students, students on higher-education and research apprenticeships, employees of other entities or companies, including entities controlled by the University

(h) **“Funded Research”** means the Research Activity funded, in full or in part, by Third Parties under commercial contracts (hereinafter “Commercial Funded Research”) or under research projects financed through competitive calls for proposals (hereinafter “Competitive Funded Research”). Funded Research also includes PhD scholarships funded by Third Parties

(i) **“Institutional Research”** means all Research Activities other than Funded Research, i.e. funded entirely with funds from the University

(l) **“Third Party(ies)”** means the private or public entities, other than the University, that contribute, in various ways and using various means, to the Funded Research

(m) **“TTO”** means the Central Administration Office of the University responsible for technology transfer

(n) **“University”** means the University of Padua as a whole, including the entities controlled by it

(o) **“Patent Fund”** means the allocation in the University's financial statements, the amount of which is established annually by the Board of Directors upon approval of the budget, from which expenses relating to the filing and possible international extension of patents and trademarks in the name of the University are paid and into which the proceeds deriving from the enhancement of the aforementioned industrial property rights through assignment or licensing agreements are credited.

¹ As defined by Italian Law 240/2010 (Legge Gelmini) Art. 22

² As defined by:

- Decreto Legislativo (Legislative Decree) no. 81 of 15 June 2015 "Disciplina organica dei contratti di lavoro e revisione della normativa in tema di mansioni, a norma dell'articolo 1, comma 7, della legge 10 dicembre 2014, n. 183" ("Organic framework of employment contracts and revision of the legislation on tasks, pursuant to article 1, paragraph 7, of legge (Law) no. 183 of 10 December 2014") (Jobs act);

- Decreto (Decree) of the Ministry of Labour and Social Policies, in agreement with the Ministry of Education, University and Research and the Ministry of Economy and Finance of 12 October 2015 which defines the educational standards for apprenticeships and the general criteria for the realisation of apprenticeship courses in implementation of article 46, paragraph 1 of decreto legislativo (legislative decree) no. 81 of 15 June 2015 approved by the State-Regions Conference on 1 October 2015;

- Resolution of the Veneto region no. 1050 of 29 June 2016 which ratifies the Agreements between the Veneto region, the Ministry of Education, University and Research and the Regional Education Office for the Veneto region and the social partners for the regulation of educational standards and general criteria for the realisation of apprenticeship courses pursuant to articles 43 and 45 of the Decreto Legislativo (Legislative Decree) no. 81/2015 and the Decreto Interministeriale (Interministerial Decree) of 12 October 2015, signed on 21 June 2016.

- Interconfederal apprenticeship agreement between Confindustria and CGIL, CISL, UIL (trade and labour unions) of 18 May 2016 regarding articles 43 and 45 of legislative decree no. 81 of 15 June 2015. (Accordo Interconfederale Apprendistato Artt. 43 e 45 D.Lgs. 81/2015 tra Confindustria e CGIL, CISL, UIL del 18 maggio 2016)

³ As defined by: Decreto Ministeriale (Ministerial Decree) no. 45 of 8 February 2013 "Regolamento recante modalità di accreditamento delle sedi e dei corsi di dottorato e criteri per la istituzione dei corsi di dottorato da parte degli enti accreditati" ("Regulation laying down the procedures for accrediting the sites and PhD courses and criteria for the establishment of PhD courses by accredited bodies").

Article 3: Subject matter

1. Unless otherwise provided for by specific legislative and/or contractual provisions, these Regulations apply to Inventions made by Employees and/or Non-Employees, including jointly with External Staff. Copyright pertaining to publications and software shall not fall within the scope of these Regulations.
2. In any case, an Invention for which a patent application has been filed within one year of the Inventor's termination of his or her relationship with the University shall be deemed to have been created during the performance of the contractual employment or other relationship with the University.

PART II INVENTIONS

Title I Rights and obligations of the Inventor

Article 4: Rights of the Inventor

1. Any Employee and/or Non-Employee and/or External Staff who creates an Invention within the context of any relationship with the University and, in particular, as part of Research Activities, has the right to be recognised as the Inventor and, therefore, to be acknowledged as the holder of the relevant moral rights.
2. Should the Invention be created during an Institutional Research Activity, pursuant to Article 65, paragraph 1 of the IPC where applicable, the Employee will also become the exclusive owner of the economic rights resulting from the Invention of which he or she is the creator and from the related Patent.
3. Employees have the right to patent Inventions made during the course of Institutional Research Activities in their own name and at their own expense, notifying the University in accordance with the provisions of Article 6.
4. Employees who intend to avail themselves of the technical and/or financial support of the University in the patenting of their Invention must transfer ownership to the University, along with the right to file the relevant patent application and the rights to exploit the Invention, by signing an appropriate contract.
5. In accordance with Article 12, in the case of Inventions created by Non-Employees as part of a Research Activity, the ownership of the Patent and the right to its economic exploitation shall be held by the University, which will be entitled to make use thereof in accordance with Title II.
6. In the case of Inventions created by Employees as part of a Funded Research Activity, the ownership of the Patent and the right to its economic exploitation shall be held by the University, which will be entitled to make use thereof in accordance with Title II.
7. Employees who have transferred to the University the rights referred to in paragraph 4 of this article and Non-Employees are entitled, in accordance with Article 10, to a share of the proceeds from the Patent enhancement activity, net of the expenses incurred by the University for the patenting and enhancement.
8. If the Invention is the result of inventive work of more than one Inventor, the rights deriving from the Invention will be assigned equally to all Co-Inventors, unless, by agreement between them, they indicate a different percentage of participation. All rights and obligations that these Rules assign to the Inventor shall be assigned to all Co-Inventors in proportion to their respective shares.

Article 5: Confidentiality obligations

1. The Inventor is required to conduct him or herself with the utmost transparency during the Research Activity and to act with due care and attention in protecting his or her own interests, and those of any co-inventors, the University and Third Parties. In particular, the Inventor is required:
 - (a) to observe the utmost confidentiality and to take reasonable measures to maintain secrecy with respect to the content of the Invention, where already created and, more generally, with respect to the results (even merely partial) of the Research Activity
 - (b) to refrain from any act and/or behaviour that may lead to advance disclosure of the Invention, or that may otherwise affect its novelty.
2. In particular, for the purposes of paragraph 1, the Inventor, in the event of achieving potentially protectable results, must refrain from their dissemination or publication, in any form and format (including electronic), even partial, including reports and/or communications and/or posters presented at scientific conferences, seminars, etc. In addition, all communications, including verbal ones, with companies and other parties interested in the Invention must be preceded by the signing of a non-disclosure agreement in accordance with the model prepared by the University.
3. Any Non-Employee Inventor who becomes aware of having created an Invention is obliged to promptly notify his or her tutor/supervisor or, failing that, the director of the relevant facility, who, from that moment on, will be bound by the confidentiality obligations set forth in the previous paragraphs and will be obliged to inform the TTO without delay in order to proceed with the evaluation of the results of the Invention and the appropriate safeguarding measures. If the dissertation or PhD thesis contains a description of the Invention, the student or PhD student is also obliged to keep the document secret after discussion, through the so-called 'embargo' procedure, for a sufficient time to allow the University to protect its rights.
4. The tutor/supervisor of the dissertation/thesis and any other Employee, Non-Employee or External Staff who, owing to their position, duties, job and/or relationship with the University, becomes aware of the Invention, shall be bound by the same confidentiality obligations laid down in this article.

Article 6: Internal reporting requirements

1. In the case of results created within the context of Funded Research, as soon as the result of the Invention is created, the Employee, in addition to fulfilling the specific contractual obligations assumed with the financing party, must promptly inform the manager of the scientific facility to which he or she belongs and the TTO.
2. In the case of results created as part of Institutional Research, the Employee:
 - (a) if he or she decides to patent the Invention created personally or together with other Inventors, assuming all the related costs, or decides to transfer the patenting right to third parties, shall give written notice to TTO within thirty (30) days from (depending on the case): (i) the filing of the patent application, indicating the filing number and the date; or (ii) from the deed of assignment of the patenting right to third parties
 - (b) if he or she decides to make use of the technical and financial support of the University in compliance with the confidentiality obligations set forth in Article 5, he or she must promptly notify TTO, in accordance with the letter template prepared by the University, of any results deemed likely to be the subject of patenting.
3. Article 5, paragraph 3, applies to Non-Employees.

Title II

Rights and obligations of the University

Article 7: Rights of the University

1. The University is the owner of industrial property rights giving rise to economic benefits (including the corresponding right to file a patent application) however arising:
 - (a) from Inventions created by Employees and Non-Employees in the context of and/or with Funded Research Activities
 - (b) from Inventions created by Non-Employees in the course of Institutional Research
 - (c) from Inventions created by Employees in the course of Institutional Research whose rights were transferred by the Inventor to the University pursuant to Article 4, paragraph 4.
2. In the event that the Employee has not transferred to the University the economic rights pursuant to Article 4 and obtains proceeds, in any form and/or by any means from the enhancement of the Invention, the University shall, in any case, be entitled to a share of 40% of the proceeds collected by the Inventor, net of the documented expenses incurred by the latter for the patenting, conservation or enhancement of the Invention and as per Article 10, paragraph 1.

Article 8: Acts of disposal of the University's rights

1. The University has the full and unconditional right to determine the methods by which to proceed with the economic exploitation of the Patents it holds (i.e. the rights to file the relevant applications), establishing independently the types of agreements to be signed with interested third parties, as well as the amount of the associated considerations.
2. The University undertakes in any case to involve the Inventor(s), through the Applicant indicated in the Invention disclosure form, in negotiations with third parties for the assignment or licensing of the Patent, without prejudice to the rights referred to in paragraph 1 above. Inventors are also required to make available to any third parties identified for the exploitation of the Invention, in a complete and accessible manner, all confidential information related to the Patent but not included in the Patent application (know-how, raw data, etc.) necessary for making the best possible use of the Invention.
3. The contracts for the disposal of the Patent or the patent application are signed by the General Manager subject to the approval of the Board of Directors, with the exception of the assignment agreements referred to in Article 9, paragraph 1, letter a). Prior to the signing of a Patent licensing or assignment agreement, the University will obtain a specific declaration from the Inventors indicating acceptance of the obligations directly binding upon them.
4. Patent filing shall be entrusted by the University to professional representatives, identified in accordance with the criteria and procedures established by current legislation. The related costs fall within the scope of the patenting expenditure.
5. If the University is the holder of a Patent whose Inventor is the proponent of a spin-off, the rules laid down in the Spin-Off Regulations of the University of Padua will apply.

Article 9: Research Activities Funded by Third Parties

1. The University enters into funding agreements for Research Activities with Third Parties (Commercial Funded Research) regulating the ownership of patentable results on the basis of one of the following options:
 - a) Original co-ownership of the patentable results between the University and the Third Party, with subsequent transfer of the university share to the Third Party at the latter's request. In this case, the patent application will be filed in co-ownership by the University and the Third Party at the latter's expense. The University undertakes to transfer to the Third Party its share of the patent application, if a written request to this effect is made within twelve months of the filing

date, in exchange for the offer of an additional amount over and above the consideration already paid to the University for carrying out the Funded Research Activity.

The consideration envisaged for the transfer of each individual patent application with its possible extensions must be equal to at least 20% of the consideration established for the Research Activity from which the patentable results are derived, with a minimum of 5,000 euro. The appropriateness of such a consideration must be approved by the Patent Commission and the transfer of the University's ownership share shall take place through a transfer agreement signed by the Manager of the Research and Business Relations Area. The individual assignment agreements must be communicated to the Board of Directors at the first meeting after their signature. Should the Third Party not request the transfer within the set term, the University's right over the Invention must be covered by a licensing agreement that the Third Party hereby undertakes to enter into, with the payment of royalties on turnover to be negotiated and for a minimum amount of 5,000 euro/year.

- b) Right of a Third Party to patent exclusively in its name, subject to payment to the University, upon signature of the research contract, of an additional amount equal to at least 40% of the consideration already envisaged for the Funded Research Activity. The appropriateness of this consideration must be approved by the Patent Commission.
 - c) Right of the University to patent exclusively in its own name and with the right to negotiate the license/assignment of the Patent on the market, except for a right of pre-emption for the Third Party. In this case, the University is required to inform the Third Party in writing of its intention to sign the contract accepting the relevant conditions in order to allow the Third Party to exercise this right within ninety (90) days of receipt of the written communication.
2. The University and the Third Party may agree that the Research Activity will not produce an Invention; in this case, paragraph 1 above will not apply.
 3. Whatever option is chosen pursuant to paragraph 1, the agreement may not stipulate any type of 'guarantee of validity' of the Patent at the University's expense and shall specify that, even by way of derogation from Article 77 of the IPC, no sum shall be owed to the Third Party, for whatever reason (including 'fair reimbursement'), in the event of invalidity of the Patent.
 4. In the case of Competitive Funded Research, the rules of the call for proposals or agreement signed with the Third Party shall apply.

Article 10: Allocation of proceeds from acts of disposal of the University's rights

1. The considerations due to the University under the licensing or assignment agreements or other acts of disposal of the Patent shall be used primarily to reimburse the costs incurred by the University for the patenting and enhancement. The calculation of costs must also include any future direct costs already known, but not yet actually incurred, at the time of allocation of the proceeds deriving from the licence or assignment of the Patent or, in any case, arising from acts that require a one-off payment.
2. After reimbursement of the costs referred to in the previous paragraph, the residual amounts will be distributed as follows: 60% to the Inventor, 40% to the University.
3. If there are several Inventors, the 60% share will be distributed among them on the basis of the percentages communicated by the Inventors themselves in the Invention disclosure form. In the absence of such communication, the shares due to the Inventors are presumed to be equal.
4. The 40% share allocated to the University will be divided as follows: 20% to the Central Administration and 20% to the Inventors' facility. If the Inventors belong to more than one facility, the 20% share will be distributed among the facilities in proportion to the distribution share of each of the Inventors as indicated in the Invention disclosure form. In the case of External Staff who have transferred their share of ownership of the Invention to the University in accordance with Article 13, paragraph 2, the aforementioned share will be assigned to the Central Administration. This provision will also apply in the hypothesis provided for in Article 7, paragraph 2.
5. The share due to the Central Administration will be allocated to the University's Patent Fund.

Title III Special provisions

Article 11: Filing of the patent on behalf of the University

1. The request for the filing of a patent application, drawn up according to specific forms prepared by the University, must be sent by the Inventors to the Patent Commission referred to in Article 14, through the TTO.
2. In the Invention disclosure form, Inventors must indicate whether the costs of filing the patent application will be covered in full or in part with funds from their own Department or whether they are applying for use of the University's Patent Fund. Employees who intend to avail themselves of the financial support of the University (both from the Patent Fund and from Department funds) in the patenting of their Invention must sign the contract referred to in Article 4, paragraph 4.
3. In the event of total or partial coverage of costs by the Department, the Inventors must ask the Director to sign the appropriate section of the Invention disclosure form.
4. In the event of an application to use the University's Patent Fund for any act, the decision on the use of the Fund shall be taken by the Commission referred to in Article 14.
5. The filing of patent applications and, in general, measures taken to protect the University's industrial property rights are the responsibility of TTO, subject to the commitment of the Department in the case referred to in paragraph 3 above and the decision of the Patent Commission in the case referred to in paragraph 4 above.

Article 12: Inventions of Non-Employees

1. In compliance with Article 7, paragraph 1 and Article 4, paragraph 5, if a Non-Employee creates or participates in the creation of an Invention, the University, including by way of derogation from the general rules of work contracts concerning inventive activities, shall be recognised as the owner of the industrial property and economic exploitation rights of the Invention, for the share of contribution of the Non-Employee to the creation of the Invention.
2. Without prejudice to the provisions of the previous paragraph, the deed establishing the relationship between the University and the Non-Employee (contract, appointment, assignment, registration, enrolment, etc.) must expressly stipulate, as a condition of validity and effectiveness, that the relationship is fully subject to these Regulations. In particular, each Non-Employee shall: (1) expressly declare that he or she is familiar with the provisions contained in these Regulations (as well as subsequent additions and amendments); and (2) specifically accepts and acknowledges, at the time of establishment of the relationship with the University, that he or she is in a position to enter into a relevant relationship according to paragraph 1 of this Article:
 - (2.1) the University's ownership (without prejudice to moral rights) of the industrial property rights over the Inventions that it has created (or contributed to) as well as the rights over their exploitation, including by way of derogation from any different rules applicable to works contracts concerning inventive activities
 - (2.2) the criteria for the distribution of the proceeds from the Invention of which the Non-Employee may be called the Inventor or Co-Inventor in accordance with these Regulations
 - (2.3) the confidentiality obligations set out in these Regulations
 - (2.4) the reporting obligations set out in these Regulations.
3. In accordance with the provisions of Article 4, paragraphs 5 and 7, the Non-Employee shall be granted, in addition to the moral right to be recognised as the Inventor (or, as the case may be, Co-Inventor), a right to participate in the distribution of the proceeds referred to in Article 10 of these Regulations, on the basis of the contribution made by the same to the Invention.
4. The provisions contained in Articles 4 to 10 shall apply to Non-Employees, insofar as they are compatible and not modified by this Article.

Article 13: Inventions of External Staff

1. The rules of the IPC or other applicable regulations shall apply to External Staff who have created an Invention jointly with Employees and/or Non-Employees, without prejudice to the following paragraphs.
2. External Staff who, pursuant to the IPC or other regulations applicable to them, are pro-rata owners of the Invention, may transfer their share of ownership to the University. In this case, Article 4, paragraphs 4, 6 and 7, Article 5, Article 8 and Article 10 shall apply.
3. Industrial PhD students or students on higher-education and research apprenticeships are required to comply with the internal reporting obligations set forth in Article 6, paragraph 1.
4. External Staff are, in any case, required to comply with the confidentiality obligations set out in Article 5.

Title IV The Patent Commission

Article 14: Appointment and functions

1. The Patent Commission (hereinafter, the "Commission") is established by Rectoral Decree upon proposal of the Board of Directors, remains in office for 3 years and is composed of:
 - a. the Vice Rector for technology transfer and relations with Companies, who acts as Chairman
 - b. the General Manager or a delegate
 - c. a number of experts between 3 and 5, chosen both from among the Employees and outside the University, with proven qualifications and experience in the field of industrial and intellectual property, from a scientific, legal and economic standpoint.
2. The Commission is responsible for:
 - a. checking the correct application of these Regulations
 - b. resolving on requests for the filing of patent applications on behalf of the University pursuant to Article 4, paragraph 4, as well as on the advisability of proceeding with the filing of patent applications held by the University pursuant to Article 11
 - c. resolving on their extension abroad in the event that the Inventors request economic support from the University's Patent Fund, establishing the extent of the participation in the expenses to be borne by the Fund itself, within the limits of its availability
 - d. providing opinions to the Board of Directors on the transfer, licensing or any act of disposal of Patents already filed in favour of Third Parties
 - e. approving the appropriateness of the consideration for the transfer of the patent application referred to in Article 9.1 a) or the patenting right referred to in Article 9.1 b)
3. For the purposes of a more detailed examination of the various patent applications submitted to the Commission for assessment, the Commission may invite experts with specific expertise to participate without the right to vote, subject to an undertaking regarding the confidentiality of the information acquired.
4. By 31 January of each year, the Commission shall send the Board of Directors a statement of the patent applications filed and extensions approved during the previous year, as well as the acts of disposal (licenses and assignments) signed during the period indicated.
5. Members of the Commission shall be bound by the strictest confidentiality and, in any event, shall comply with the obligations laid down in Article 5 with regard to any information which comes to their knowledge in the performance of their duties.

Article 15: Functioning of the Commission

1. The Commission meets periodically, usually once a month, when convened by the Chairman. The meetings are convened through an e-mail notification sent by TTO, listing the topics to be discussed.

2. A majority of the members of the Commission is required for the meetings to be quorate. The Commission's decisions must be adopted by a majority of those present. In the event of a tie, the Chairman shall have the casting vote.
3. In cases where the Chairman, at his or her discretion, deems it appropriate, meetings may also be held electronically.
4. A representative of the Inventors may be invited to attend the session to present the characteristics of the Invention. The Commission may ask the Inventor to supplement the documentation submitted with any document necessary and/or useful for the purposes of making its decision.

Title V

Final and transitional rules

Article 16: Coming into force and transitional regime

1. These Regulations shall enter into force fifteen days after the date of the Rectoral Decree and repeal the previous Patents Regulations adopted through R.D. 186 of 27/01/2014, with the exceptions and clarifications set out in the following points:
 - a) The provisions relating to the ownership of the Patent and the resulting rights of economic exploitation shall apply to Non-Employees for whom the deed establishing the relationship with the University (contract, appointment, assignment, registration, enrolment, etc.) is issued after the coming into force of these Regulations
 - b) The provisions relating to Research Activities Funded by Third Parties (Article 9) shall apply to contracts entered into after the coming into force of these Regulations; contracts implementing framework agreements entered into on a previous date will remain subject to the previous rules
 - c) The provisions relating to the Allocation of proceeds deriving from acts of disposal of the University's rights (Article 10) shall apply to licensing or assignment agreements or other acts of disposal of the Patent entered into after the coming into force of these Regulations
2. Amendments to these Regulations shall be implemented on the basis of the same procedure used for their adoption.
3. To the extent not provided for in these Regulations, the relevant legislative provisions in force shall apply.