

PATENT REGULATIONS OF THE UNIVERSITY OF PADUA

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PART I DEFINITIONS AND SCOPE

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

1. The University of Padua (hereinafter also 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 protect the results of the University's research;**
 - 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 the world of companies
 - e) to enable its Employees and Non-Employees to share in the benefits that may derive from such enhancement.
2. These Regulations (hereinafter the “Regulations”), in relation to the applicable national, European Union and international rules, and, in particular, the provisions of Decreto Legislativo (Legislative Decree) no. 30 of 10 February 2005, as amended and supplemented, in particular Legge (Law) no. 102 of 24 July 2023 (the Industrial Property Code, referred to hereinafter as the “IPC”), govern the procedures and activities for the protection of inventions, utility models, drawings and models, plant varieties, topographies of semiconductor products and 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) (a) “Research Activities” means the activities carried out by Employees and/or Non-Employees and, where appropriate, by External Staff 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 and/or know-how belonging to the University or, in any case, economic resources administered by it
 - (b) “Patent(s)” means the industrial property titles that enable the acquisition of the Invention rights, including the patent application and submission. This includes patents by invention, utility models, rights to patent a new plant variety, and registrations of topographies and semiconductor products and **rights over designs and models**.
 - (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 is envisaged **or is actually conducted**. In particular, this definition includes, purely by way of example, contract lecturers, research assistants, scholarship holders, contract workers and collaborators of any kind, students, students enrolled in specialisation schools and on PhD courses without prejudice to letter g) paragraph 2;
 - (e) “Inventor(s)” means the person(s) who create(s) the Invention;
 - (f) “Invention” means any type of innovation and/or result deriving from a Research Activity that is likely to be the subject of an **exclusive right pursuant to** the IPC;
 - (g) “External Staff” means personnel other than Employees and Non-Employees such as employees

of other entities or companies, including entities controlled by the University.

It also refers to industrial PhD students, students on higher education apprenticeships, and Internship students at a host organization limited to the internship period, provided that the activity specified in the internship and orientation agreement and the internship project is not carried out using equipment, facilities or financial resources or, in any case, economic resources managed by the University;

(h) "Funded Research" means Research Activities funded, in full or in part, by Third Parties in the context of research projects through competitive calls or in any case in the context of non-commercial projects. Funded Research also includes PhD scholarships funded in full or in part by Third Parties;

(i) "Commissioned Research" means Research Activities commissioned by Third Parties in the context of commercial contracts;

(j) "Institutional Research" means all Research Activities other than Funded Research **and Commissioned Research**, i.e. funded entirely with funds from the University;

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

(m) "TTO" means the Central Administration Office of the University responsible for technology transfer;

(n) "**University**" means the University of Padua as a whole;

(o) "Patent Fund" means the **fund entered into the University's balance sheet** (managed through an accounting project), 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.

(p) "Internship student(s) at a host organization" a student enrolled in a course at the University of Padua who is involved in a curricular internship with a host organisation based on an internship and orientation agreement and an internship project which specifies the period within the organisation and the planned activities.

Article 3: Subject matter

1. These Regulations apply to Inventions made by Employees and/or Non-Employees, including jointly with External Staff. Copyright, **governed by Legge (Law) no. 633 of 22 April 1941 as amended and supplemented**, does not **fall** within the scope of these Regulations.

2. An Invention for which a **patent application or other form of protection has been filed** within one year of the Inventor's termination for whatever reason of his or her relationship with the University shall be deemed to have been created during the performance of his or her contractual employment or other relationship with the University.

PART II INVENTIONS

Title I Ownership of Inventions

Article 4 Ownership by the University

1. Pursuant to Article 65 of the IPC, the ownership of the rights deriving from an Invention created by Employees and Non-Employees in the performance of Research Activities lies with the University. It includes the right to protect the Invention in any manner suitable for the purpose, and the right to its economic exploitation, in accordance with the provisions of Title IV of the Regulations. This is without prejudice to the right of the Inventor to be recognized as the author of the Invention.

2. The University does not hold rights over Inventions created by Employees in the context of assignments not included in the tasks and duties officially conferred by public or private entities other than the University, provided that such assignments are authorised and carried out in accordance with the "University Regulations on the criteria and procedures for granting professors and researchers authorisation to carry out external assignments".

Title II

Rights and obligations of the Inventor

Article 5: 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. Pursuant to Article 12 of the Regulations, the Inventor is entitled to a share of the proceeds obtained from the enhancement of the Invention net of the expenses incurred by the University for its patenting and exploitation.
3. 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 the Regulations assign to the Inventor shall be assigned to all Co-Inventors in proportion to their respective shares.
4. An Employee may hold rights over Inventions created in the context of assignments not included in the tasks and duties officially conferred by public or private entities other than the University, in accordance with the "University Regulations on the criteria and procedures for granting professors and researchers authorisation to carry out external assignments".

Article 6: Reporting requirements regarding an Invention

1. An Inventor who creates an Invention within the Institutional or Funded Research Activities has the obligation to promptly notify the University of the creation of the Invention according to the procedures referred to in Title III of the Regulations, providing by means of a specific form, available in the personal area of the University website, all useful and exhaustive information that enables that person to exercise their rights over the Invention ("Invention Disclosure").
2. In the case of results achieved within the framework of Commissioned Research Activities, the Inventor is also required to promptly notify the University of the creation of the Invention through a special simplified form available in the personal area of the University website ("Simplified Disclosure"), but the rights deriving from the Invention and the procedures for filing the Patent application are governed by the contractual agreements between the parties. Therefore, Title III of the Regulations does not apply.
3. Article 7.3 applies to Non-Employees.

Article 7: 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, including partial results 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 even after its defence, 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.

Title III

Patenting procedure

Article 8: Invention Disclosure

1. The Invention Disclosure, which must be made using the special form prepared by the TTO and made available in the personal area of the University website, must contain the following information: a) a summary description of the Invention; b) the name of the Inventor/Inventors, their status, whether Employees or Non-Employees or External Staff, and the quantification of the contribution towards the Invention of each Inventor; c) information on the state of the art for the purpose of preliminary checks on the novelty and originality requirements of the invention; d) agreements/contracts with Third Parties involved in the Invention; e) the existence (if any) of any ongoing contacts with Third Parties interested in the Invention; f) possible industrial applications.

2. In the Invention Disclosure, Inventors must indicate whether the costs of filing the patent application will be covered in full or in part with funds from their own research base or whether they are applying for use of the University's Patent Fund. Should the Inventors request the use of the University's Patent Fund, the decision on the use of the Fund shall be taken by the Patent Commission referred to in Article 15.

3. The Invention Disclosure, complete with all the information and documentation required in the form must be sent to the TTO before its formal transmission via protocol registration, so that the TTO can check its completeness and conduct the necessary verifications.

4. At the end of the checks referred to in the previous paragraph, and subject to written approval from the TTO, the Invention Disclosure, signed by all the Inventors and the Directors of the departments or centres that will contribute to future expenses, must be sent to the TTO via confidential protocol registration or other method that will be indicated by the TTO. If the Invention Disclosure is sent to the TTO without the necessary approval, it will be rejected and the term referred to in Article 9.2 will not begin to run.

5. If the Inventor files the Patent application in his or her own name or through an intermediary without having sent the Invention Disclosure, the University may bring a claim action pursuant to Article 118 of the IPC and all related expenses will be borne by the Inventor who filed the application. The provisions of the law on administrative, civil, accounting and disciplinary liability shall apply.

Article 9: Filing of the Patent Application

1. Having examined the Invention Disclosure and completed the assessment procedure, the Patent Commission expresses its opinion on the opportunity to file a Patent application. This opinion must be expressed within 60 days from the protocol registration date of the Invention Disclosure referred to in Article 8.4, unless the Commission deems it necessary to acquire supplementary information or clarification. In this case, the term is deferred for a further 60 days.
2. If the Commission expresses its opinion in favour, the University shall file the Patent application with the utmost urgency and in any case, pursuant to Article 65 of the IPC, no later than 6 months from the date of the protocol registration of the Invention Disclosure that it has received approval from the TTO. This period shall be extended for a maximum of three months and notified to the Inventor, if this is necessary in order to complete the technical assessments initiated by the University.
3. In the calculation of the terms referred to in paragraph 2, any delays that are not attributable to the TTO, the Patent Commission or, more generally, to the University will not be taken into account; these include, by way of example, non-cooperation or delays by the Inventors in performing their relevant actions for the purpose of filing the Patent application and non-cooperation or inertia (including through their Inventors) by those entities who jointly hold the right with the University to file the Patent application.
4. If the University does not file the Patent application within the aforementioned time limit and the hypotheses referred to in paragraph 3 are not met, the Inventor may proceed independently to file the Patent application in his or her own name and at his or her own expense, without any charges to the University
5. The Inventor may also proceed independently with filing the application if the University has notified, pending the aforementioned time limit, its lack of interest in proceeding.
6. In the cases referred to in paragraphs 4 and 5, the University shall, nevertheless, be granted a free, perpetual and irrevocable licence to use the Invention for educational and non-commercial research purposes.
7. If the time limit referred to in paragraph 2 expires without the filing having been completed and paragraph 3 is not applicable, an Inventor who is not interested in filing the patent application in his or her own name may authorise the continuation of the patenting process by the University.
8. The Patent Commission may also decide, within the time limit referred to in paragraph 2, to adopt another form of protection of the Invention other than the filing of a patent application.
9. Patent filing shall be entrusted by the University to patent attorneys, identified in accordance with the criteria and procedures established by current legislation. The related costs fall within the scope of the patenting expenditure.

Title IV Exploitation of Inventions

Article 10: Acts of disposal of the University's rights

1. The University has the full and unconditional right to determine the methods to be used to proceed with the economic exploitation of the Inventions it holds, in compliance with the advertising, transparency and confidentiality principles of the information, 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 proponent indicated in the **Invention Disclosure**, in negotiations with third parties for the assignment or licensing **of the Invention**, 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, **prototypes, software** etc.) required to exploit the Invention in the best possible way.

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 Administration, with the exception of the assignment agreements referred to in Article 11, paragraph 1, letter a). **In all cases of licensing** or assignment of the Patent, the University will obtain a specific declaration from the Inventors indicating acceptance of the obligations directly binding upon them.

4. 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 11: Research Activities Funded by Third Parties

1. The University enters into **Commissioned Research** agreements with Third Parties 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 **Commissioned Research** Activity. The consideration envisaged for the transfer of each individual patent application with its possible extensions **is negotiated by the department or centre to which the research is commissioned and indicated in the agreement and** 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 transfer of the University's ownership share shall take place through a assignment agreement signed by the Head of the Research and Business Relations Area. 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 their own name, subject to **the provision in the initial agreement of the payment to the University** of an additional amount equal to at least 40% of the consideration already envisaged for the **Commissioned Research** Activity.
- 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.

2. The University and the Third Party may agree that the Research Activity may not, **by its very nature**, 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 must 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 **or in the event that the Patent is not granted or is limited after being granted**.

4. In the case of Funded Research, the rules of the call for applications or of the agreement signed with the Third Party shall apply.

5. The model agreements for each of the three options referred to in paragraph 1 are **defined** by the Patent Commission referred to in **Article 15** and then **submitted for approval** to the Board of Administration.

Article 12: Allocation of proceeds from acts of disposal of the University's rights

1. The considerations **collected by** 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 exploitation. 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: **50% to the University, 50% to the Inventors.**

3. If there are several Inventors, the 50% share will be distributed among them on the basis of the percentages **indicated in the Invention Disclosure**. In the absence of such an indication, the shares due to the Inventors are presumed to be equal.

4. **Half of the University's 50% share will be allocated to the University's Patent Fund.**

Title V Special provisions

Article 13: Inventions of Non-Employees

1. In compliance with Article **4, paragraph 1**, 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 Fellow 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 5, paragraph 2**, 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 **12** 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 also apply to Non-Employees, insofar as they are compatible and not modified by this Article.

Article 14: 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 CPI 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, the provisions contained in Articles 4 to 10 and Article 12 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. Inventions and any results generated by Traineeship Students in a host organisation during the traineeship period are governed by the IPC and any agreements between the Traineeship Student and the host organisation.
5. External Staff are, in any case, required to comply with the confidentiality obligations set out in **Article 7.**

Title VI

The Patent Commission

Article 15: Appointment and functions

1. The Patent Commission (hereinafter, the “Commission”) is established by Rectoral Decree upon proposal of the Board of Administration, remains in office for 3 years and is composed of:
 - a. **the Deputy Rector competent for the matter**, who presides over it;
 - 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.

The Commission may invite experts in the field from time to time.

2. The Commission is responsible for:
 - a. checking the correct application of these Regulations;
 - b. passing resolutions on **the** filing of patent applications on behalf of the University;
 - 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 Administration on the transfer, licensing or any act of disposal of Patents already filed in favour of Third Parties;
 - e. **defining** the model agreement for Commissioned Research Activities with Third Parties, pursuant to Article 11, paragraph 5, and **submits them for approval to the** Board of Administration.
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 Administration 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 7 with regard to any information which comes to their knowledge in the performance of their duties.

Article 16: 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. The majority of the members of the Commission is required for the meetings to be quorate.
3. 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.
4. In cases where the Chairman, at his or her discretion, deems it appropriate, meetings may also be held electronically.
5. 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 VII

Final and transitional rules

Article 17: Coming into force and transitional regime

1. **Any amendments to** these Regulations shall enter into force fifteen days after the date of the Rector's Decree, with the exceptions and clarifications set out in the following points:
 - a. the provisions relating to the ownership **of the Inventions** and the consequent economic exploitation rights apply **from 23 August 2023, the date of entry into force of Legge (Law) no. 102/2023 which amended Article 65 of the IPC;**
 - b. the provisions relating to the allocation of proceeds deriving from acts of disposal of the University's rights (**Article 12**) shall apply to licensing or assignment agreements or other acts of disposal of the Patent entered into after the coming into force of **the amendments to** the Regulations.