

INSTITUCIÓ CATALANA DE RECERCA I ESTUDIS AVANÇATS

(ICREA)

REGULATION ON INTELLECTUAL AND INDUSTRIAL PROPERTY



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PREAMBLE

The Fundació Institució Catalana de Recerca i Estudis Avançats (hereafter referred to as the “Institution” or “ICREA”) is a private foundation formed in 2001.

ICREA was created in response to the need to seek new hiring formulas that would make it possible to compete with other research systems on a similar if not an equal footing.

ICREA’s aim is to recruit top scientists for the Catalan R&D system, scientists capable of leading new research groups, strengthening existing groups, and setting up new lines of research.

At the same time, approval of the Act 7/2011, of 27 July, on tax and financial measures, which establishes the legal regime of Catalan Research Centers (CERCA) and ICREA, has given a new legal regime for these institutions which allows them to strengthen their activities of support for development and innovation, and to consolidate Catalonia as a reference in the advancement of knowledge.

Therefore, starting from this new legal framework and with the aim of advancing in the Institution’s promotion of research activities in its field, it is considered necessary to define an internal regulation concerning the results of ICREA research.

In consequence, the Board of Trustees of the Institute, acting on a proposal by the Director, has considered it appropriate to approve this Regulation, which embodies the regulation covering the results of research carried out at the Institute, and rules with respect to their exploitation and the distribution of the benefits arising from them.

TITLE I. PURPOSE AND DEFINITIONS

Article 1. Purpose and ambit of application.

The purpose of this regulation is to establish a legal framework which governs the following aspects:

- a) Ownership of the results arising from the Research Activity (hereafter referred to as the "Research") developed under the aegis of the Institution.
- b) The procedures for proper protection of the aforesaid results of Research by the Institution.
- c) The financial rights resulting from exploitation of these results.

Article 2. Definitions.

For the purposes of this regulation, the following definitions are taken into consideration:

a) **Research Personnel:** Personnel employed by the Institution who carry out Research Activities, performed within the framework of the relationship with ICREA.

b) **Research Activities:** creative work done systematically in order to increase the volume of knowledge, including that relative to the human being, culture and society, the use of such knowledge to create new applications, its transfer and its dissemination performed within the framework of its relationship with ICREA.

c) **Results of the Research:** all technology, know-how and processes which have been generated by the Research Personnel in the general framework of the Research Activities, including:

c.1) **Works:** Results of the Research susceptible of protection by Intellectual Property rights, including as an example but not limited to, books, publications, professorial teaching, lectures, multimedia works, databases and software.

c.2) **Inventions:** Results of the Research susceptible of protection by Industrial Property rights, including as an example but not limited to, patents, utility models, semiconductor topographies and industrial designs.

d) **Host Institutions:** (hereinafter HI). The different institutions at which Research Personnel are adscribed to by ICREA to carry out their Research Activities. The adscription of ICREA Researchers to any particular Host Institution is regulated by bilateral agreements between ICREA and the HI.

e) **Joint ownership, joint rights:** The respective proportions or percentages of said ownership or rights that correspond to ICREA and HI as provisioned in the bilateral agreements in force between both parties.

f) **Profits:** the difference between the gross income obtained by the Institution from the commercial exploitation of the Results, less the expenses directly imputable to the protection, management, valorisation, and transfer of the Research Results (including as an example, but not limited to, expenses for intermediary services, lawyers, industrial and intellectual property agents, etc.). The profits to be shared will be understood as the result of the exploitation account proper to the project, which will be closed annually.

TITLE II. OWNERSHIP OF THE RESULTS OF THE RESEARCH, THE INDUSTRIAL AND INTELLECTUAL PROPERTY RIGHTS ARISING FROM THEM AND EXPLOITATION RIGHTS

CHAPTER I. RESEARCH PERTAINING TO THE INSTITUTION

Article 3. Ownership of the Research Results of the Institution.

ICREA, together with the HI, has joint ownership, as well as joint exploitation rights, of the Results of Research developed by Research Personnel as a consequence of their Research Activities.

Article 4. Ownership of industrial property rights.

ICREA, together with the HI, has joint ownership, as well as joint exploitation rights, of the Industrial Property rights over inventions arising from the Results of the Research described in Article 2 above.

Article 5. Ownership of intellectual property rights.

Research Personnel have the authorship of Works created as a consequence of their Research Activities, except in the cases expressly envisaged in this regulation.

The exploitation rights over the Works carried out in the framework of the aforesaid functions are for ICREA and the HI, jointly, in the terms and with the extent envisaged in legislation on intellectual property and as provisioned in the agreements between the institutions.

Without prejudice to the above, ICREA and the HI will endeavour to agree with the Research Personnel the assignment to ICREA (and to the HI) of any other exploitation rights over the Works generated in the Research Activities which could possibly remain in the ownership of the Research Personnel.

5.1. Publications

Notwithstanding the foregoing, and without prejudice of any right that the HI or any third party may have, ICREA assigns to the authors all the exploitation rights of the books, publications, professional teaching, or other similar works carried out in the framework of their Research Activities, provided they do not refer to or include other Results of Research. However, such assignment expressly excludes the economic rights over them, which are regulated by the provisions set forth in clause 14.

5.2. Software

In the event that the Work developed by the Research Personnel in the execution of its Research Activities is a piece of software, the ownership of exploitation rights thereon will exclusively correspond to ICREA and HI jointly.

In the case that the software has been collectively developed at the initiative and under the coordination of the Institution, the authorship, as well as the ownership of exploitation rights on the said Work, will correspond to ICREA and the HI if they edit it and disseminate it under their name, except otherwise agreed.

5.3. Collective Works

In the event that the Work has been created collectively at the initiative and under the coordination of the Institution and/or HI, the authorship, as well as the ownership of exploitation rights on the said Work, will correspond to the Institution and/or HI, if they edit it and disseminate it under their name, except otherwise agreed.

5.4. Databases

Databases may constitute intellectual creations in accordance with applicable regulations by reason of their selection or disposal of their contents. ICREA and the HI will jointly have the ownership of exploitation rights of databases developed in execution of Research Activities without prejudice of the rights that may subsist on these contents.

Article 6. The Research Personnel's moral rights of authorship.

ICREA will in every case respect the right of the Research Personnel to be recognized as inventor or author of the Inventions or the Works which they may have developed, in accordance with the provisions of the regulations in force in matters of Industrial and Intellectual Property.

Article 7. Obligation of acknowledgement of the Institution.

Except in the case of publications defined in 5.1 above, and unless ICREA declares otherwise, any Work in which the Research Personnel took part and in which the exploitation rights are owned by ICREA, undertaken as a direct or indirect consequence of their Research Activities in ICREA, must refer to their link or relationship with ICREA. In this sense, all the Works in the ownership of ICREA will bear in visible form the following phrase: “© Institució Catalana de Recerca i Estudis Avançats (ICREA), year (...). All rights reserved”.

CHAPTER II. RESEARCH PROJECTS DEVELOPED JOINTLY WITH OTHER ENTITIES

Article 8. Research results obtained by virtue of research projects developed in collaboration with third parties other than the Host Institutions

8.1. The undertaking of any research commission or project by the Research Personnel, independently of the branch of knowledge to which it refers, will follow the approved procedures and regulations of the Host Institution.

8.2. In every case, the rights which could belong to ICREA in virtue of this regulation must be respected.

8.3. In the Research Activities developed by Research Personnel sponsored by private entities, the public interest and transparency will prevail. In this sense, the necessary clauses will be agreed upon in order to protect the intellectual liberty of the Research Personnel, prevent disproportional undertakings of confidentiality or unjustified restrictions on the publication of the results obtained.

CHAPTER III. MANAGEMENT AND PROTECTION OF THE RESEARCH RESULTS

Article 9. Communication and management of protection of the Research Results.

9.1. In the event that the Research Personnel may develop a Research Result which could be susceptible of protection, they must:

- a) follow the HI procedures for disclosure of inventions and other research results
- b) in parallel, notify ICREA.

This notification shall be made within 3 months from the date of the generation of the Results and through the mechanism that ICREA makes available, to start seeking legal protection.

9.2. In relation with the Research Results arising from projects of collaboration with public and/or private entities other than the HI, the notification will be carried out in accordance with what is established in the conventions signed between the collaborating entities.

Article 10. Collaboration of the Research Personnel.

10.1. The authors or inventors of the Research Result must collaborate with ICREA in everything necessary to obtain adequate protection for the intellectual and industrial property rights and possibly, their transfer.

10.2. The obligation of collaboration will include, among others, the obligation of signing the public and private documents necessary before any national or foreign office competent in matters of industrial and intellectual property (as an example, but not limited to, Patent and Trade Mark Offices, Intellectual Property Registries, etc.), so that ICREA is recorded as or becomes, as appropriate, the holder of its share of the industrial and intellectual property rights over the Research Result, and can exercise the rights which it has in virtue of its status as proprietor for all purposes.

Article 11. Confidentiality and dissemination of the Results of Research.

11.1. Research Personnel, and any other personnel who take part in the Research Activities under the aegis of the ICREA, must deal with the information relating to any research developed under the aegis of the Institution confidentially, and use their best efforts to ensure this confidentiality, in order to preserve the rights of ICREA, the HI, or any third parties who collaborate in the Research Activities.

11.2. Research Personnel and any other personnel who takes part in the Research Activities will respect the timing established by ICREA and the HI relative to the dissemination of their research, and will undertake not to carry out any act of dissemination until the date established in order not to prejudice its legal protection.

11.3. At the time of disseminating or publishing the Research Results, except where expressly agreed otherwise, the following must be explicitly declared:

- a) That the Research Personnel belong to ICREA,
- b) Details of the subsidies, aids or sponsorship received, if this inclusion is mandatory.

Article 12. Assignment of Industrial and Intellectual Property rights.

12.1. ICREA can require its Research Personnel and any other personnel who take part in Research Activities to sign, before starting work on their activities, a contract or analogous document which establishes the assignment of exploitation rights over the intellectual and industrial property rights developed on the occasion of their supply of services under the aegis of the Institution, or which use means, infrastructures or resources belonging to it.

12.2. The lack of signature of any prior document will in no case mean that ICREA waives its rights, or that the Research Personnel has the ownership of those rights which have been obtained as a result of the working or contractual relationship.

12.3. The document referred to will be intended to resolve that this assignment is made without time, territorial or material restrictions, as set out in this Title II.

12.4. Additionally, in the event that ICREA is not interested in the ownership of any title or international extension of an Industrial Property right or decides to waive the application or the maintenance of it, this must be communicated to the inventors. In the event that they are interested, the Institution can transfer these rights to them, provided that the applicable regulations so permit.

12.5. Nevertheless, in the event that the Institution has signed a contract with a third party which grants the latter a preferential right to take up ownership of the Results of the Research in the event of a waiver or withdrawal by ICREA, the regime envisaged in the contract will apply.

12.6. In the event that the Institution has abandoned or waived its rights in favour of the inventor, the latter may commercially exploit the Results of the Research provided that the commercial activity is not contrary to the governing principles of ICREA.

12.7. ICREA reserves a right to participate financially in the exploitation of Research Results transferred to the inventors, according to the terms envisaged in Title III of this regulation, both in the case of being exploited by them and in the case of being transferred to third parties. Further, ICREA reserves in every case the right to use the Results of the Research for non-commercial ends by means of a non-exclusive, non-transferable and free licence for use, in research, care or training activities carried out by the entities members of its Board of Trustees.

12.8. In the event of a waiver in favour of the Research Personnel, ICREA may establish the mechanisms it deems appropriate to recover the expenses caused by the management, drawing up, processing and maintenance of the relevant Industrial Property title.

TITLE III. EXPLOITATION OF THE RESEARCH RESULTS

CHAPTER I. FORMULAS FOR EXPLOITATION OF THE RESEARCH RESULTS

Article 13. Formulas for exploitation of the Research Results.

ICREA, either individually or jointly with the HI, may commercially exploit the Research Results in the form that it deems most appropriate for compliance with its purposes, ensuring in every case the best possible access for society to the new knowledge and technology. In every case, for the transfer of the rights, the applicable rules will be followed for the disposal, transfer and burdening of ICREA's assets.

CHAPTER II. DISTRIBUTION OF THE BENEFITS FROM EXPLOITATION OF THE RESEARCH RESULTS

Article 14. Distribution of the benefits of commercial exploitation.

14.1. The Profits obtained by ICREA arising from commercial exploitation of the Research Results will be distributed in accordance with the following proportion:

- a) 50% to the Research Personnel considered as the author(s) or inventor(s);
- b) 50% for ICREA.

14.2. In the case that there is more than one author or inventor, ICREA will distribute the 50% in section 14.1 a) as agreed by all ICREA authors or inventors in written, by legal or arbitral resolution in the absence of such agreement, or in equal parts in the absence of any of the former options.

14.3. The share of profits to be received by the Research Personnel which are obtained by the Host Institution from the commercial exploitation of the Research Results jointly owned by ICREA is provisioned on the framework agreement between ICREA and the HI.

14.4. In every case, the distribution of profits envisaged in this article must respect the possible limitations established in the general regulations applicable to the Institution and its Research Personnel.

TITLE IV. FINAL PROVISIONS

One. Interpretation of the Regulation.

The settlement of any doubt over interpretation of the regulation is for the Director of ICREA.

Two. Entry into force.

This regulation will come into force on the day following its approval by the Board of Trustees of ICREA.

Three. Transitional provision.

The rights and duties contained in this regulation will be of application after its entry into force to all those activities of Research carried out by ICREA, both before and after its coming into force, without prejudice that the regulation of distribution of the benefits arising from the exploitation of the Research Results, will only apply to that income obtained subsequently to the coming into force of this regulation.

ICREA will endeavour to adapt all the contracts signed in the framework of its activities, such as contracts with its personnel and current conventions with other public and/or private entities, to the provisions established in this regulation.