



**THE UNIVERSITY OF THE**

**WEST INDIES**

**POLICY**

**ON**

**INTELLECTUAL PROPERTY**

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## **A. INTRODUCTION**

The primary functions of a University are teaching and research and the dissemination of the results of such research for the public good. Those Universities which are supported by public funds, such as the University of the West Indies, must also have as part of their mission the advancement of the public interest and the promotion of the economic and cultural development of the area which they serve.

Staff and students of the University expand the body of general knowledge and enrich the educational programme of the University through research papers, articles, books, computer programs, audio-visual materials and inventions, in which intellectual property inheres. Traditionally, much of the intellectual output of the University has been disseminated by publication and by placing it in the public domain.

The University affirms the principle of freedom of research and unrestricted dissemination of the information generated. It accepts that it is not a principal aim of the University to undertake research solely in anticipation of profit. However, the University recognizes that significant financial benefits may be derived from the exploitation of products of creative activity in the University, especially in science, engineering and agriculture. Such exploitation must be undertaken within a framework which fairly safeguards both the interests of the individuals who create the intellectual property in these products as well as the interests of the University.

Therefore, and within the context of the intellectual property law regimes of the countries served by the University, this Policy sets out the principles, governing the ownership and disposition of intellectual property in works created by staff and students, the respective rights and responsibilities of those involved and the administrative arrangements for the management of intellectual property in the University.

## **B. PURPOSE AND SCOPE OF POLICY**

### **Purpose**

This Policy is designed for the following main purposes:

- (a) to provide a framework which will stimulate and facilitate staff members and students to undertake research and to protect and exploit potentially valuable research results;
- (b) to establish a proper basis for the transfer of technology from University to the wider community;
- (c) to encourage and develop institutional growth through the commercial application of research results and through ventures with industry and commerce;
- (d) to ensure that the rights and interests of all parties concerned are fairly determined with full regard for the proper role of the University and the principles of academic freedom; and
- (e) to provide guidelines for the proper administration of intellectual property rights within the University.

### **Scope**

This Policy covers copyrightable materials and inventions. It has effect in relation to University activities in all Campus and Non-Campus countries and applies to all faculties, departments, schools, centers, institutes and other administrative units of the University.

The Policy extends to both academic and non-academic staff of the University, including staff on sabbatical leave, and also to visiting staff, except in so far as its application is precluded by the policies of the host institution of a staff member on sabbatical or, as the case may be, by the institution to which the visiting scholar is employed, and the University has agreed to different arrangements.

Students who are also employees of the University shall be treated under the Policy as staff members in connection with activities related to their employment. Students who hold awards (e.g. scholarships and fellowships) through the University in respect of which the funding body has placed restrictions on proprietary rights in items developed under and during the

course of the award, shall be treated under this Policy in the same manner as students working on sponsored research or other agreements.

This Policy operates in the context of applicable laws in the countries which the University serves. Interpretation of the Policy in relation to any matter arising in any such country will be in accordance with its relevant laws.

This Policy supersedes any guideline or practice operating on any faculty or Department affecting the ownership and disposition of intellectual property created in the University. Accordingly, such practice or guideline shall cease to have effect to the extent of its inconsistency with the Policy.

### **C. INTERPRETATION**

**Committee** - the University Committee on Intellectual Property established under Part 111 of this Policy;

**Pro Vice Chancellor** - the Pro Vice Chancellor responsible for Research;

**Sponsored research or other agreement** - an agreement entered into by the University and a government, agency, firm or other body whereby funds are provided by such government, agency, firm or other body to support partially or fully, research or other work undertaken by the University;

**Staff member** - a member of the academic staff, senior administrative staff and other staff, within the meanings assigned to those expressions, respectively, in the Statutes of the University;

**Student** - has the meaning assigned to that expression in the Statutes for the time being of the University;

**University country** - a country defined as a “contributing country” in the Charter of the University.

## **PART 1: COPYRIGHT**

### **1. Introduction**

- 1.1 Copyright is a property right which the law gives to creators of literary works (including scholarly and scientific papers and examination questions) dramatic, musical and artistic works, databases, photographs, computer programs, films, broadcasts, cable programmes and the typographical arrangement of published editions. For a work to enjoy copyright protection it must be original, in the sense that it should not be a mere copy of another work and, in addition, it must be recorded in a tangible form. Certain prescribed requirements must be satisfied relating to the nationality or habitual residence of the author or the place of first publication of the work. Copyright protection of a work is not dependent on registration or other formality. The owner of copyright in a work is given the exclusive right for a specified time to exploit the work, subject to prescribed exceptions.
- 1.2 This Part of the Policy establishes the respective rights of the University, its staff members and students in relation to the ownership and disposition of rights in works generated within the University that are protected by copyright.
- 1.3 In its application, the Policy is subject to the relevant laws governing copyright in University countries.

### **2. Ownership of Copyright**

- 2.1 Under the copyrights laws in University countries, the general rule is that the creator of a work is the first owner of copyright in that work, unless a contrary arrangement is made. By way of exception to this principle, some laws give to an employer an automatic ownership of copyright in work created under a contract of employment, unless there is an agreement to the contrary. In such countries, this Policy can be considered as such an agreement by which the university will re-assign copyright ownership to staff members, except in the specific instances indicated below in paragraph 2.4.
- 2.2 This Policy maintains the traditional relationship between the University and staff members who are authors of scholarly and artistic works, whereby copyright in textbooks, monographs, papers, lecture

notes, unpublished manuscripts, slides, musical compositions, works of art, and similar material, are the exclusive property of the staff member, except where they are produced as part of a sponsored programme or other agreement or where the University claims ownership under this Policy.

- 2.3 A staff member who owns copyright in a work has the full responsibilities and exclusive rights of proprietorship, including the full enjoyment of any royalties accruing from the exploitation of the work.

**However -**

- (a) if, during the preparation of the work by the staff member, the University incurs some incremental costs (for example, overtime typing costs, hiring of extra secretarial help, cost of tapes, film or other expendable materials) such costs shall be recovered as provided in paragraph 4.1; and
- (b) in recognition of the general resources and facilities provided by the University, the staff member shall grant the University a royalty-free right to reproduce and use the work within the University.

- 2.4 The University owns copyright in a work in the following cases, unless another arrangement to the contrary was made in writing before the work was undertaken.

- (a) where the University specifically asks or directs a staff member to undertake the work; and
- (b) where the University employs staff for the express purpose of creating or producing works which may be eligible for copyright or where there is an explicit requirement in a job description for this responsibility (e.g. editors, film makers, media producers).

In such cases, the professional interest of the staff member and the reputation of the University require that there be adequate mutual control over the use of such work. The extent of such control and mutual rights with respect to the revision, withdrawal, limitation and

termination of use of such work shall be agreed in writing between the University and the staff member before the work is undertaken.

- 2.5 The University may allow the staff or members who created work in which the university claims proprietary rights to share in any royalties that accrue from the sale or lease of the work outside the University, provided an appropriate agreement was entered into before the work was undertaken.
- 2.6 Where a staff member develops a work in the course of or pursuant to a sponsored research or other agreement, ownership of the copyright in the work shall be determined in accordance with the terms of the sponsored research or other agreement. The University reserves the sole right to make agreements with sponsoring organizations and to include therein such provisions as to the ownership and disposition of copyright as it thinks appropriate. However, the University will not, without the consent of the staff member who is the author, make agreements which affect the staff member's copyright in any work.
- 2.7 Where, pursuant to this Policy, the University claims part-ownership in any work, the University and the staff member who is the author, by agreement, will each assign and transfer to the other the right to acquire and use copies of the work at the cost reproduction, without payment of fee or royalty. The agreement between the University and the staff member will continue after the staff member's employment with the University is terminated, unless an arrangement is made to the contrary. Access to the work by third parties shall be the subject of a specific agreement between the University and the staff member.
- 2.8 Where a student produces a work based on research or other scholarly activity conducted under the supervision of a staff member and the supervision of that work is a requirement of the student's academic programme, then, the University will not claim proprietary rights in the work except in the circumstances described in paragraph 2.9.

Where a student has proprietary rights in a work, the University shall receive a non-exclusive, royalty-free licence to:

- (a) make copies or representations of the work for academic purposes within the University;
- (b) circulate the work as part of the University library collection;
- (c) at the request of other Universities or of other institutions approved by the University, make single copies of a thesis deposited in the University library;
- (d) make available the work to the National Library of a University country;
- (e) publish an abstract of any work that is a student thesis.

2.9 The University may claim proprietary rights in a work produced by a student where –

- (a) the staff involvement in the creation of the work is substantial and the University desires to exercise its rights based on this involvement; or
- (b) the work is part of a larger work over which the University intends to exercise its rights; or
- (c) the use of the facilities, equipment or other resources of the University are substantially in excess of the norm for educational purposes.

The properly authorized use by students of word processors, facilities, equipment or resources or the use of University libraries to create works shall not constitute a basis for a claim by the University of proprietary rights in such works.

### **3. Distribution of Income Generated from the Exploitation of Copyright**

3.1 Where the University claims ownership of copyright in any work, the University will make an income agreement with the staff member or student who created the work. The income received is to be used first to

meet all marketing costs and any costs associated with the protection or defence of the copyright, and also to repay any funds specifically advanced for the project by the University.

3.2 The agreement on distribution of further income will be based on the following guidelines:

- (a) Until all preparation or development costs incurred by the University are recovered, the staff member or student will receive 25% and the University 75% of this income
- (b) once all preparation or development costs have been recovered, the staff member or student will receive 75% and the University 25% of this income;
- (c) If more than one staff member or student is involved, the available income will be distributed among them in accordance with a pre-arranged and agreed distribution ratio.

#### **4. Recovery of University Costs**

4.1 Where the copyright in a work belongs to a staff member but the work was produced with the use of University facilities, which in the opinion of the Head of Department exceeds those available for normal academic and administrative matters, the University, including the Department, expects to recover its financial input in the work. Accordingly, the University and the staff member will agree to either:

- (a) reimbursement of the University to the extent of the identifiable costs incurred in the preparation and production of the work; or
- (b) distribution of royalties as indicated in paragraph 3.2 above.

#### **5. Allocation of University Royalties and Fees**

5.1 Royalties, or other income from the exploitation of copyright, accruing to the University in excess of the amount necessary to meet the costs specified in paragraph 3.1 will normally be made available for the enhancement and development of academic research programmes and resources.

## **6. Infringement of Copyright**

- 6.1 The University Community is reminded that the copyright legislation of all University countries is specific with respect to infringement of copyright. Copyright is infringed by any person who, without the consent of the owner, does anything that only the copyright owner has the right to do. Infringement occurs, for example, in the reproduction of a printed work protected by copyright or the duplication of protected sound recordings and computer programs. However, “fair dealing” with the work for the purpose of private study, research, criticism or review is not regarded as infringement. Guidelines on the use of the “fair dealing” exception and other permitted acts may be obtained from the Business Development Office on each Campus.

## **PART II: INVENTIONS**

### **1. Introduction**

- 1.1 This Part of the Policy defines and establishes the respective rights and obligations of the University, its staff members and students, in relation to any inventions or discoveries resulting from research or other activities conducted by them.

A basic principle underlying the Policy is that all parties, including students, who have made a significant contribution to an invention should receive a fair share of the benefits derived from it. The Policy is intended to provide the framework for identifying those inventions and discoveries that are capable of profitable exploitation and to obtain protection for them whether by way of patents or by some other form of protection.

- 1.2 In its application, the Policy is subject to the relevant laws governing patents in University countries.
- 1.3 To be patentable an invention, which may be a process or product, must (a) be new (b) involve an inventive step, that is, a step not obvious to anyone skilled in the subject and (c) be capable of industrial application. A patent gives the patentee the exclusive right to use and exploit the invention for a specified time. The patenting process can be long and expensive and is not worthwhile unless the invention has a strong chance of being developed and marketed. Inventions that are not patentable or in respect of which a patent application is not pursued may, nevertheless, be profitable through licensing and other arrangements with industry.
- 1.4 The success of the Policy depends on the awareness of staff members and students of the issues involved, their bringing the invention to the University's attention at an early stage and co-operating to ensure that the interests of the staff member, or as the case may be, the student, the University and, where applicable, outside sponsors, are not jeopardized.

## **2. Ownership of Inventions**

2.1 The rights and obligations of the University, staff members and students may be defined in terms of the following categories:

- A. Inventions made by staff members or students of the University in the course of demonstrably private research unrelated to their University duties which do not involve any significant use of funds, space or facilities administered by the University;
- B. Inventions made –
  - (a) by staff members in the course of their normal duties at the University; or
  - (b) by staff members or students involving the significant use of space, funds or other facilities administered by the University;
- C. Inventions made by staff members or students which are subject to the terms of a sponsored research or other agreement between the University and a third party.

2.2 Inventions made in the course of demonstrably private research and not involving the significant use of funds, space and facilities administered by the University are wholly the property of the staff member or student. The University will not construe the payment of salary to a staff member from general funds or the provision of office or library facilities as constituting significant use of University funds, space or facilities.

2.3 Where an invention falls within the category referred to in paragraph 2.2 the staff member or student may, under terms of an agreement with the University (a) submit the invention to the University for the purpose of obtaining a patent or for its commercial exploitation and management or (b) request that the invention be appraised by and, if appropriate, assigned to the University. The University shall not be obliged to accept the invention and, if it accepts the invention for review, may decide that it is not in the best interests of the University to exploit or manage the invention or to take an assignment.

- 2.4 Inventions which are made by a staff member within or partially within the staff member's normal field of activities or employment responsibilities or involving the significant use of space, funds or other facilities administered by the University, shall be the property of the University. When the University undertakes patenting and commercial development and exploitation of the invention, the staff member shall receive a share of the net income generated by the invention, as set out in paragraph 3.
- 2.5 Staff members who are also part-time students shall be considered staff members as regards the ownership and disposition of inventions.
- 2.6 Inventions which are made by staff members or students under sponsored research or other agreements are governed by the terms of those agreements.
- 2.7 Where, in relation to inventions falling within categories B and C of paragraph 2.1, one or more individuals from outside the University are co-inventors with a staff member or student, then, if the invention is owned in part by an outside sponsor, the university will share in the ownership of the invention to the extent determined by negotiation between the Pro Vice Chancellor and the outside inventor or sponsor.

**3 Distribution of Royalties and Fees**

- 3.1 Where an invention (whether patentable or not) is exploited by the University directly or in partnership with others, the University agrees in normal cases to pay the staff members or students who made the invention such sums as shall ensure that the University and the staff members or students shall each obtain mutually acceptable shares of the benefit derived from the invention, having regard to all the circumstances of the case. Such share shall be governed, for the time being, by the following formula –

To the inventor(s)	-	50% of net income
To the originating Department or Institute	-	20% of net income

- To the originating Campus - 15 % of net income
- To the University or its Assignee - 15% of net income

3.2 In paragraph 3.1 “net income” means the amount remaining after documented direct assignable expenses incurred in connection with an invention and an amount to cover overhead expenses (not exceeding 15% of the direct assignable expenses) are deducted from the gross income derived from that invention; and for the purpose of this definition –

- (a) “direct assignable expenses” includes expenses connected with patent filings, patent prosecution and defence and maintenance fees and specific marketing costs; and
- (b) “gross income” means all royalties, payments or benefits actually received in relation to a disclosed invention.

3.3 Although the provisions specified in paragraph 3.1 shall normally apply, the Bursar may draw to the attention of the Pro Vice Chancellor any special cases and, in particular, any case where the income is likely to be substantial.

3.4 Where two or more staff members or two or more students made the exploited invention, each of them shall share equally in the inventor’s share of the net income, unless all of them have previously agreed in writing to a different distribution of such share.

3.5 In the event of any litigation, actual or imminent or any other action to protect patent rights or other proprietary rights, the University may withhold distribution of all royalty income until the resolution of the matter.

3.6 Funds received in accordance with this Policy by a Department or Campus or by the University shall be used for administrative purposes with special emphasis on research and scholarly activities.

#### **4. Invention Disclosure**

- 4.1 Any staff member or student who suspects that he or she has made an invention should complete the Invention Disclosure Form which is available at the Business Development Office on the Campus. Where necessary, assistance in completing the form will be provided by the Office.
- 4.2 The staff member or student shall not file or permit others to file a patent application in the name of such member or student without providing at least 30 days' notice, in writing, to the Pro Vice Chancellor and a statement of the circumstances in which the item was developed. The staff member or student shall, if requested to do so, provide a copy of the invention disclosure or proposed patent application.
- 4.3 It is important that this initial contact be made as soon as possible and that no steps be taken to place the invention in the public domain by a lecture or publication until the invention has been reported to and discussed with the Pro Vice Chancellor.
- 4.4 The Form should be submitted to the Pro Vice Chancellor who will request the Committee to investigate, as soon as possible, the patenting (or other means of protection) and marketing of the invention, unless the Form is accompanied by a letter requesting other action by the University, such as a waiver by the University of its rights of ownership in the invention.

#### **5. Responsibility of university in relation to Invention Disclosure**

- 5.1 Within thirty days of the date of submission of a duly completed Invention Disclosure Form, the Pro Vice Chancellor will convene or cause to be convened a meeting of the committee. The Head of Department in which the invention originated, the Dean of the relevant Faculty and the inventor or inventors will be invited to attend. In order to assist its deliberations in any particular case, the Committee may co-opt such financial, technical and legal experts as may reasonably be required in order that a thorough assessment of the technology be made.
- 5.2 Using the information supplied by the staff member or student in the disclosure, the Committee will determine whether the invention is

owned solely by the University, the staff member, student or an outside sponsor, or is jointly owned by the University and a staff member, student or an outside sponsor. The Committee will also determine the identity of all co-inventors.

- 5.3 If the University owns the invention, the Pro Vice Chancellor, on the recommendation of the Committee, will decide within 90 days of the date of disclosure whether or not the University will proceed with commercial exploitation of the invention and, if so, the most appropriate means.
- 5.4 If the University owns the invention and decides to proceed with the commercial exploitation of the invention, the staff member or members will assign in writing to the University all rights to the invention, using the appropriate form.
- 5.5 If the University does not wish to proceed with the commercial exploitation of the invention, it will assign in writing to the staff member or student all rights to the invention, but will retain a royalty-free licence to use the invention in its teaching and research programmes.
- 5.6 If the decision is that the invention is owned by the staff member, the Pro Vice Chancellor will so advise the staff member in writing. The staff member is then free to commercialize the invention privately or may offer it to the University for exploitation or appraisal as provided in paragraph 2.3.
- 5.7 If the University is a joint owner of an invention with a person or persons outside the University, the Vice Chancellor will undertake discussions with the other joint owners with a view to determining the appropriate route for commercial exploitation.
- 5.8 If the invention is owned by a sponsor or outside client, the Pro Vice Chancellor will notify the sponsor or client and take whatever action is appropriate under the terms of the agreement between the sponsor or client and the University.

## **PART III: GENERAL PROVISIONS**

### **1. Policy Administration**

- 1.1 The Management of this Policy is the responsibility of the Pro Vice Chancellor responsible for Research.
- 1.2 There shall be established a University Committee on Intellectual Property which shall consist of eleven persons selected from among academic and administrative staff. The University Bursar and the Executive Director of each Business Development Office shall be members of the Committee, ex officio. The other members shall be appointed by the Pro Vice Chancellor and shall serve for three years.
- 1.3 The Committee shall advise the Pro Vice Chancellor on –
  - (a) the determination of ownership rights in relation to works and inventions created within the University;
  - (b) the distribution of the University's share of income among departments, faculties and programmes of the university;
  - (c) the resolution of any conflict relating to the interpretation or operation of this Policy;
  - (d) the exploitability of any work or invention in which the University has rights;
  - (e) the need for modification of this Policy; and(f) such other matters relating to this Policy as the Pro Vice Chancellor may request.
- 1.4 The Committee may appoint such sub-committees as it thinks fit.

### **2. Resolution of Disputes**

- 2.1 If all other attempts fail in an effort to resolve a dispute between the University and another party with respect to a decision on ownership of rights in any work or invention or a decision on the identity of the author of a work or the person who made an invention or on revenue sharing, the dispute shall be referred to a Board of Arbitration composed

of one representative nominated by the University, one by the other party, and a third member selected by the two representatives thus chosen.

- 2.2 Either the University or the other party may require that a Board of Arbitration be selected by giving to them written notice of such requirement. If either the University or the other party does not nominate a member of the Board of Arbitration within ten (10) days after the other has given such written notice, then, the Committee shall make the nomination.
- 2.3 If the two persons nominated as members of the Board of Arbitration pursuant to paragraph 2.2 are unable to agree on a third member for the Board, this shall be resolved under the applicable law in the University country in which the dispute has arisen.
- 2.4 The decision of the Board of Arbitration shall be final.

### **3. Revenue and Expenditure**

- 3.1 A royalty account will be established on each Campus for each work or invention in respect of which income is received for the exploitation of the proprietary licensing of such work or invention or authorized expenses are incurred for the protection or licensing of such work or invention. All such income and expenses shall be recorded in that account. One account may be opened in respect of two or more works or inventions which are so related that they have items of income or expenses in common.
- 3.2 An accounting of income and expenditure related to each work or invention will be provided to the author or inventor annually, or more frequently by special arrangement, where circumstances warrant.

### **4. Confidentiality**

- 4.1 All staff members and students involved in the process of invention disclosure, ownership determination, commercialization and patentability evaluation, and commercial exploitation must make every effort to maintain the confidentiality of the invention until it is protected by patent. Where appropriate, the Pro-Vice-Chancellor will use

confidentiality agreements to ensure confidentiality when dealing with non-University personnel.

- 4.2 A staff member or student has disclosed an invention under paragraph 4 of Part II should not normally be restricted for more than a period of one year, beginning with the date of disclosure, from publishing any information so disclosed.

## **5. Execution of Contracts**

- 5.1 Contracts arising from works or inventions, whether patented or not, will be executed in accordance with established University policies and procedures.
- 5.2 Staff members must ensure that contracts under which works or inventions may be developed and in which the University has or might have intellectual property rights are cleared by the Office of the Pro Vice Chancellor before execution and made in accordance with established University policies and procedures.

## **6. Consulting Activities**

- 6.1 Staff members who provide consulting services and those charged with approving such activities on behalf of the University are responsible for ensuring that any related agreements with external entities are not in conflict with this Policy. Staff members should therefore make their obligations to the University clear to those with whom they make agreements and should provide other parties to the agreement with a current statement of this Policy.

## **7. Use of the University's Name**

- 7.1 Where the proprietary rights in a work or invention are owned exclusively by a staff member or student, the name of the University shall not be used in connection with any publication, production, documentation, promotion or exploitation of the work or invention, except in such form as may be approved by the Dean of the Faculty concerned. Such approval shall be in accordance with University policy regarding the use of the University's name.

**8. Review of Policy**

- 8.1 This Policy shall be reviewed from time to time by the University Intellectual Property Committee and a report made to the Pro Vice Chancellor. The report shall form the basis for any revision of the Policy that may be appropriate.

Office of Planning  
The Vice Chancellery  
January 1998