

# **THE UNIVERSITY OF THE WEST INDIES**

## **A POLICY ON INTELLECTUAL PROPERTY MANAGEMENT AND COMMERCIALISATION**

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## **POLICY ON INTELLECTUAL PROPERTY MANAGEMENT AND COMMERCIALISATION**

### **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 members 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, films, inventions and other creations, in which intellectual property inheres. Traditionally, much of the intellectual output of the University is 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 and technology, 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.

Further, the University is aware of the need to provide guidance on the appropriate use of the University's name, Coat of Arms and other University trade marks, so as to safeguard the institution's brand.

Therefore, 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 generated within the University, the respective rights and responsibilities of those involved and the administrative arrangements for the management of intellectual property in the University. The Policy

also provides guidance on the commercialisation of intellectual property developed within the University and on the use of University-owned trade marks.

## **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 the University to the wider community and the generation of income derived from the commercialisation of intellectual property rights owned by the University;
- (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;
- (e) to provide guidelines on the use of trade marks owned by the University;
- (f) to make provision for the proper administration of intellectual property rights within the University.

### **Scope**

This Policy covers copyrightable materials, inventions, trade marks and plant varieties. It has effect in relation to University activities in all countries served by the University and applies to all faculties, departments, schools, centres, institutes and other academic and administrative units of the University.

The Policy extends to staff members of the University including such staff members on sabbatical leave, and also to scholars visiting from another university or research facility, 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 the 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 of the countries served by the University. Interpretation of the Policy in relation to any matter arising in any such country will be in accordance with its relevant laws.

### **C. INTERPRETATION**

In this Policy -

"Committee" means the University Committee on Intellectual Property established under Part IV, paragraph 1.2 of this Policy;

"Contributing Country" has the meaning assigned to that expression in Article 24 of the Charter of the University;

"Designated Office" means the Office on a campus of the University designated by the Principal of that campus as the Office responsible for carrying out functions under this Policy; and different Offices may be designated to perform functions under different Parts of this Policy or in relation to different categories of intellectual property;

"intellectual property" means copyright, inventions (whether or not patented) trade marks and plant varieties;

"Pro Vice Chancellor" means the Pro Vice Chancellor responsible for Research;

"related proprietary rights" means in relation to an invention, any

proprietary rights associated with the invention, including know how, confidential information, trade secrets and copyright;

"sponsored research or other agreement" means 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" means a member of the academic staff, senior academic staff and professional staff, within the meanings assigned to those expressions, respectively, in the Statutes for the time being of the University, and any other person employed by the University;

"student" has the meaning assigned to that expression in the Statutes for the time being of the University;

"sub-Committee" means a sub-committee appointed under Part IV, paragraph 1.4 of this Policy;

"UWI mark" means the name of the University, the acronym "UWI", any other abbreviation of the name, the Coat of Arms and the Seal of the University, any insignia, design, symbol, name, words or combination thereof, or any other representation (whether or not registered) that connotes an association with the University, and any domain name assigned to a campus of the University.

## **PART 1: COPYRIGHT**

### **1.0 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 typographically 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 Contributing Countries.

## **2.0 Ownership of Copyright**

**2.1** Under the copyright laws of Contributing Countries, the general rule is that the creator of a work is the first owner of copyright in the 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 a work created under a contract of employment, unless there is an agreement to the contrary. In such countries, this Policy can be considered such an agreement by which the University will reassign 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 ownership, 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 member 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 organisations 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 of 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 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 2.10.

**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 Contributing Country;
- (e) publish an abstract of any work that is a student thesis.

**2.10** The University may claim proprietary rights in a work produced by a student where

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- (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 authorised use by students of computers, facilities, equipment or other University 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.

### **3.0 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.

#### **4.0 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.

#### **5.0 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.

#### **6.0 Infringement of Copyright**

**6.1** The University Community is reminded that the copyright legislation of all Contributing Countries is specific with respect to infringement of copyright. Copyright is infringed by any person who, without consent, does anything that only the copyright owner has the right to do. Infringement may occur, for example, in the reproduction in any form of a work protected by copyright or the duplication of protected sound recordings and computer programs, unless the act falls within an exception to the infringement of copyright specified in the copyright legislation of the relevant Contributing Country or is covered by a licensing arrangement made between the University and an organisation representing the copyright owner. The Designated Office will provide information on the permitted uses of copyright material under any such licensing arrangements.

## **PART II: INVENTIONS**

### **1.0 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 inventions 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 that are capable of profitable exploitation and, where appropriate, 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 in Contributing Countries governing patents.

**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.

**1.4** A patent gives the patentee the exclusive right to use and exploit the invention for a specified time, subject to prescribed statutory exceptions. 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.

**1.5** 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 jeopardised.

### **2.0 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 in the course of demonstrably private research, in the case of staff members, unrelated to their normal University duties and in the case of students, unrelated to their programmes of study, and 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 by students in the course of programmes of study 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 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, or by a student in the course of a programme of study at the University shall be the property of the University. If the University undertakes patenting and commercial development and exploitation of the invention, the staff member or student 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, if the invention is owned in part by an outside sponsor, then 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.

### **3.0 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.
- 3.7** Where a patent is obtained for an invention, then, subject to paragraph 3.8, the right of an inventor to receive income under this Policy shall extend for the term of the patent and any renewals thereof and such right may be assigned or bequeathed by the inventor.
- 3.8** Each inventor is required to keep the Designated Office informed of his or her current home address, as royalty income will be sent to that address. The Office



will make reasonable efforts to trace the whereabouts of an inventor for whom a current address is not available. However, royalties that remain unclaimed for twenty four months after the first notification of the payment of royalties sent to the address last furnished by the inventor will be re-invested in commercialisation activities at the Campus on which the inventor was employed or was a registered student (as the case may be) when the invention was developed.

#### **4.0 Invention Disclosure**

**4.1** A staff member or student who has made an invention must disclose it promptly in writing to the Designated Office using the Invention Disclosure Form available from that Office. (See the Website of the Office).

Where necessary, assistance in completing the form will be provided by that 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 invention was developed. The staff member or student shall, if requested to do so, provide a copy of the Invention Disclosure Form or proposed patent application.

**4.3** It is important that this initial contact is made as soon as possible and that no steps are 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 head of the Designated Office.

**4.4** The Form should be submitted to the head of the Designated Office (copied to the Pro-Vice Chancellor) who will request the sub-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.

## **5.0 Responsibility of University in relation to Invention Disclosure**

- 5.1.** Within 30 days of the date of submission of a duly completed Invention Disclosure Form, the head of the Designated Office must convene or cause to be convened a meeting of the sub-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 sub-Committee may use a variety of tools, including Web searches and proprietary databases, and may co-opt such financial, technical and legal experts as may reasonably be required in order that a thorough assessment of the technology may be made.
- 5.2** Using the information supplied by the staff member or student in the Invention Disclosure Form, the sub-Committee will determine whether the invention and any related proprietary rights are owned solely by the University, the staff member or student or an outside sponsor, or is jointly owned by the University and a staff member, student, an outside sponsor or some other person or body. The sub-Committee will also determine the identity of all co-inventors.
- 5.3.** The sub-Committee must also: a) enquire into the marketability of the invention and make a recommendation as to whether it should be commercialised; b) express an opinion as to whether the invention appears to meet the criteria for patentability; and c) make a recommendation as to whether the University should seek patent protection for the invention. Discussions may also be held with industry contacts under confidentiality agreements, where necessary.
- 5.4** Where the results of an evaluation indicate that a technology needs further development, prototyping or proof of concept before it is ready for patenting, it will be referred back to the inventor(s), and commercialisation efforts will be put on hold until further data can be generated and the details of the invention expanded. The Designated Office will assist in identifying funds for further development.
- 5.5** Within 5 working days of the conclusion of its deliberations on the matters specified in paragraphs 5.2, 5.3 and 5.4, the head of the Designated Office shall provide the Pro Vice Chancellor with a report on the findings and recommendations of the sub-Committee.

- 5.6** If the University owns the invention, the Pro Vice Chancellor, on the recommendation of the sub-Committee, and taking into account the provisions of paragraph 5.13, will decide within 90 days of the date of disclosure: a) whether or not the University will proceed with the commercial exploitation of the invention and, if so, the most appropriate means; and b) if a patent application should be filed. Before making a decision the Pro Vice Chancellor may, in any particular case, request that a more extensive assessment be undertaken to confirm the patentability and/or commercial potential of the invention.
- 5.7** If the University owns the invention and decides to proceed with the commercial exploitation of the invention, the staff member and/or student will assign in writing to the University all rights to that invention using the appropriate form. The Designated Office is responsible for ensuring that the assignment is effected.
- 5.8** If the University does not wish to proceed with the commercial exploitation of the invention, then, at its discretion, it may: a) on request, 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; or b) release the invention to the public domain.
- 5.9** If the decision is that the invention is owned by the staff member or student, the Pro Vice Chancellor or the head of the Designated Office on behalf of the Pro Vice Chancellor, will so advise the staff member or student in writing. The staff member or student is then free to commercialise the invention privately or may offer it to the University for exploitation or appraisal as provided in paragraph 2.3.
- 5.10** If the University is a joint owner of an invention with a person or persons outside the University, the Pro Vice Chancellor or designee will undertake discussions with the other joint owners with a view to determining the appropriate route for commercial exploitation.
- 5.11** If the invention is owned by a sponsor or outside client, the Pro Vice Chancellor or the head of the Designated Office on behalf of 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.

- 5.12** Inventors of an invention for which a patent application is filed shall co-operate, without expense to the inventors, in the patenting process in all ways required by the University, its agent or designate.
- 5.13** The University will not normally file a patent application for an invention unless it has decided to proceed with the commercial exploitation of the invention. Early in the evaluation process, the University will seek to secure options to license the invention and will explore such other contractual arrangements for its exploitation as may be appropriate in the circumstances.

**6.0 Commercialisation of UWI Inventions**

- 6.1** Commercialisation of an invention owned by the University may, without limitation, be by way of (i) assignment for consideration (i.e. sale) ; (ii) licensing for consideration or (iii) equity participation in a spin-off company.
- 6.2** Where commercialisation is by means of licensing, the University will normally grant non-exclusive royalty-bearing licences to all qualified licensees. However, given that in some cases, non-exclusive licensing may not be effective in bringing an invention to the commercial market in a satisfactory manner, the University may grant an exclusive licence to an invention, where it determines that this is required in the public interest to encourage the marketing and public use of the invention. An entity that is granted an exclusive licence to develop or commercialise a University – owned invention that is patentable shall be required to reimburse or bear all the expenses incurred in obtaining the licensed patents(s).
- 6.3** In all licensing arrangements for an invention owned by the University -
- (a) the University shall reserve to itself a right to make or have made and to use the invention within the University for its own educational and/or research purposes;
  - (b) royalty rates will be reasonable and consistent with the goal of the University to transfer technology effectively in the public interest;
  - (c) the licence must generally include provisions covering non-refundable licence fees, patent expense reimbursement, royalties and minimum royalty

payments, a requirement of diligence, the cessation of licensing rights and the termination of the arrangement, should the licensee fail to develop and market the product within a reasonable time;

- (d) the University, its staff members and students should be protected and indemnified from all liability arising from the development, marketing or use of the invention or related proprietary rights;
- (e) the licensing process shall not restrict the publication rights of the inventor(s);
- (f) commitments should not be made for future University inventions even when improvements are expected. However, the Designated Office may make exceptions occasionally, as appropriate, including without limitation, to handle subordinate patents and well-defined derivative works for software;
- (g) the University shall have the right to receive or examine accounting records maintained by the licensee and any sub-licensee.

**6.4** Only the Pro Vice Chancellor or the Principal of a Campus or a person authorised by either of them may assign or license rights in an invention to a third party: no one else has the authority to do so. It is incumbent upon all members of the University community to ensure that no language purporting to assign or license any proprietary rights owned by the University is included in any agreement that they sign.

**6.5** An invention owned by the University, although unpatentable for various reasons, may still contain confidential proprietary information of commercial significance, for example, technical know-how and trade secrets. Rights in confidential proprietary information may be licensed, and such information should be included in the Invention Disclosure Form required to be completed under paragraph 4.1.

**6.6** The head of the Designated Office shall ensure that licensees of University-owned inventions fulfil the promises they made in their licence agreements with the University, especially those relating to obligations for diligently developing products based on the licensed technology and for paying royalties and other fees that come due under the licence.

- 6.7** The officer in the Designated Office who is assigned responsibility for the administration of a licence agreement (the licensing officer) must keep in contact with the licensee after the execution of the licence agreement, facilitate the receipt of all reports from the licensee, and verify that all financial obligations and diligence provisions are met.
- 6.8** In the event that a licensee is not in compliance with a licence agreement, the licensing officer, under the direction of the head of the Designated Office must employ proactive measures to bring the licensee in line with its obligations.
- 6.9** If the issue cannot be easily resolved, the licensing officer, in consultation with the inventor(s), will work with the licensee to determine mutually workable arrangements that help the licensee to meet the obligations. These arrangements may include, but are not limited to, setting up a payment plan to help the licensee meet the financial obligations to the University, setting new deadlines by which the obligations under the licence might become due or amending other terms and conditions of the licence, as may be necessary and appropriate.
- 6.10** Where issues cannot be resolved through negotiations, other means may be considered, such as initiating proceedings to suspend or terminate the licence and, in extreme circumstances, taking legal action to enforce the terms of the licence. In taking any such action the Designated Office shall involve other parties, including the Pro Vice Chancellor, the Principal of the campus concerned, legal counsel and the inventors.
- 6.11** In exercising its functions under this Part, the Office shall -
- (a) obtain such legal, financial and other expert advice as may be necessary or desirable;
  - (b) make reasonable efforts to ensure that inventor(s) are informed of the commercialisation efforts of the Office; and
  - (b) keep the Pro Vice Chancellor and the Principal of the campus concerned abreast of all developments concerning the protection and commercialisation of the invention.

## **7.0 Action by University where patent unexploited**

- 7.1.** Where a patent owned by the University is not commercially exploited for a continuous period of not less than five years, the University, at its sole discretion, may discontinue the payment of annuities to maintain the patent. When payment is discontinued, the patent will fall into the public domain. Before taking action, the University will notify the inventor(s) named in the patent of its intention to discontinue payment and of its willingness to assign the patent to the inventor(s) if, within the time-frame specified in the notice, the inventor(s) request the assignment of the patent. On a request being so made, the University will assign the patent.

## **PART III: OTHER INTELLECTUAL PROPERTY RIGHTS**

### **Trade Marks**

#### **1.0 Introduction**

- 1.1** Trade marks are words, phrases, logos or other symbols associated with the quality and reputation of products and services. They are used to identify and distinguish the products and services of a person or entity from those of another. The owner of a trade mark enjoys exclusive rights conferred by law to use and commercially exploit the trade marks.
- 1.2** This Part of the Policy provides guidelines on the use of UWI marks (as defined in Section C of this Policy) making explicit the uses that are authorised, restricted and prohibited.

#### **2.0 Ownership of UWI Marks**

- 2.1** Ownership of UWI marks is vested in the University.
- 2.2** A Faculty, department or other unit of the University or a staff member or a student organisation recognised by the University that wishes: a) to design or create a new trade mark; or b) to register a trade mark on behalf of the University or for a University- related project, must make a written submission with respect to the proposed trade mark to the University Registrar or designee.

**2.3** After consultation with legal and marketing personnel, the University Registrar or nominee will determine: a) whether or not to approve the mark as a UWI mark; and b) if the mark should be registered.

**2.4** A trade mark created or registered by a staff member in the course of a contract of service with the University or by a student in connection with any University-related activity, holds that trade mark for and on behalf of the University.

### **3.0 Authorisation required to use UWI marks**

**3.1** Except where paragraph 4 of this Part applies, any individual, organisation or company, any faculty, department or other unit of the University and any student organisation recognised by the University that wishes to use a UWI mark must first obtain the right to do so from the University. Authorisation must be obtained before producing or arranging for the production of any product or the offering of any service involving the use of a UWI mark.

**3.2** For non-commercial use of UWI marks, prior written permission must be obtained from the University Registrar or designee.

**3.3** A licence is required for the use of UWI marks on products that are manufactured for resale or other commercial purpose.

**3.4** The office selected on each campus as the Designated Office in relation to the management of UWI marks is delegated the responsibility for the licensing of UWI marks on that campus. The University Registrar shall have the responsibility for licensing UWI marks where the use of the marks relates to the University as a whole. Approval of each use of a UWI mark must be on a per product, per design basis.

**3.5** A licence shall provide for the payment of royalties and fees as provided in paragraph 8.1 below, unless the exemption in paragraph 8.2 applies.

**3.6** Authorisation to use a UWI mark does not constitute approval to manufacture a particular product. Only an Officially Licensed Manufacturer may manufacture products bearing a UWI mark and only an Officially Licensed Vendor may sell products bearing UWI marks. *(For a current list of Officially Licensed*



*Manufacturers and Officially Licensed Vendors contact the office selected on a campus as the Designated Office for the management of UWI marks.)*

- 3.7** Where the authorisation relates to the use of the name of the University and/or the University Coat of Arms, such use must conform to the standards prescribed in the Brand Identity Guidelines available at:

<https://sta.uwi.edu/resources/policies/uwistylemanual.pdf>

and to any other guidelines that may be issued by the University Registrar from time to time.

*(If you need assistance with respect to the use of these Guidelines, contact the office at a campus responsible for marketing and communication or the Designated Office.)*

#### **4.0 Use of UWI marks permitted without specific authorisation**

- 4.1** Without obtaining the authorisation of the University Registrar or designee –

- (a) staff members and students may use UWI marks for normal University educational and operational purposes, provided that the marks are not used in any derogatory, deceptive, scandalous or distorted manner;
- (b) staff members may use the University’s name and/or Coat of Arms to identify themselves on stationery, business cards, in publications, research or educational journals and other materials used in the course of their university-related activities (e.g. Susan Smith, Professor of Law, The University of the West Indies.);
- (c) students and alumni may wish to identify themselves as students or graduates of the University in biographical information.

All other proposed uses of the University’s name, Coat of Arms or other UWI mark by staff members, students and alumni must be submitted to the University Registrar or designee for authorisation.

- 4.2** Without obtaining the authorisation of the University Registrar or designee -

- (a) A third party may use the University’s name when reporting a transaction internally or reporting a transaction to regulatory authorities as required by applicable law (e.g. an entity that has made a grant to the University may

make a report on the grant internally or to a government body for tax purposes).

- (b) A government or non-profit entity that has funded research or programming at the University may use the University's name to disclose that it has provided such funding.

## **5.0 Licensing of UWI marks prohibited**

**5.1** The University will not license products that do not meet minimum standards of quality and/or good taste or are judged to be dangerous and/or carry high product liability risks.

**5.2** The University will not approve the use of UWI marks in the promotion of weapons, alcohol, tobacco, or "recreational" drug products. The University reserves the right to prohibit other uses which it deems inappropriate as being inconsistent with the image and mission of the University.

## **6.0 Restrictions on use of UWI marks**

**6.1** A UWI mark may not be incorporated into the name or mark of any other body. The use of the name and Coat of Arms of the University with a trade mark associated with another entity must confirm to the guidelines specified in the Brand Identity Guidelines (See paragraph 3.7 of this Part).

**6.2** UWI marks may not be used in any way that would constitute an endorsement by the University of any organisation, product, activity, service, or contract, or any political party or any political or religious view.

**6.3** Use of the University's name or Coat of Arms or other UWI mark is NOT permitted on cards, stationery, signage, promotional literature, web sites or other communication used in connection with an individual's private practice or business.

## **7.0 Use of UWI marks by staff member with permission**

**7.1** In appropriate cases, the Council or a Campus Council on its behalf, or an officer duly authorised by the Council or Campus Council may, subject to such conditions

may be determined in a particular case, permit a staff member wishing to commercialise intellectual property rights owned by the staff member pursuant to Part I paragraph 2.2 and Part II paragraph 2.2 of this Policy, to use University marks for commercial activities with which the staff member is or will be associated.

## **8.0 Royalties and Fees**

**8.1** All licensed products manufactured for sale to the public are subject to a royalty. The royalty rate is designated by the University and is subject to change by the University. The royalty rate is paid on wholesale sales by the manufacturer of the products. Other fees include an administrative application processing fee and a reinstatement fee for licences cancelled for cause.

**8.2** No royalty is payable under a licensing arrangement involving the use of a UWI mark -

- (a) on products purchased by the University for internal consumption - that is, by staff members and students, (e.g. plaques, calendars, athletic uniforms, schedules of events, programmes);
- (b) on products manufactured or purchased by the University to promote the University and its programmes (e.g. student recruitment materials, fund-raising items, advertisement of University programmes and notices of special events); or
- (c) in connection with *bona fide* fund - raising events of a student organisation recognised by the University and approved by the Office responsible for student services and development on the campus concerned.

## **9.0 Infringement**

**9.1** Products bearing UWI marks and produced without authorisation may be considered counterfeit or infringing items and subject to all available legal remedies, including, but not limited to, seizure of the products.

- 9.2** The unauthorised use of a UWI mark in connection with the provision of a service also constitutes an infringement in respect of which legal action may be taken by the University.

### **Plant Variety Rights**

- 1.1** Plant variety rights are proprietary rights conferred by law in respect of the development of new varieties of plants (including agricultural, horticultural and ornamental plants). Some Contributing Countries provide legal protection for plant varieties, granting the owner exclusive rights to commercially use, sell, and direct the production, sale and distribution of plant varieties. To qualify for protection, a plant variety must be new, distinctive from other varieties, uniform in its characteristics and stable after repeated propagation.
- 1.2** With such modifications as may be necessary, the following provisions of this Policy shall apply in respect of a plant variety developed within the University -
- (a) Part II, paragraphs 2.1 to 2.7, inclusive (ownership);
  - (b) Part II, paragraph 3 (distribution of royalties and fees);
  - (c) Part II paragraphs 4 and 5 (invention disclosure);
  - (d) Part II paragraph 6 (commercialisation).

## **PART IV: GENERAL PROVISIONS**

### **1.0 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 Registrar, University Bursar, University Counsel or their respective nominees, and the head of the Designated Office on a campus that has responsibility for functions under Parts I and II of this Policy 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, inventions and plant varieties 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 protection and exploitability of any work, invention or plant variety in which the University has rights;
- (e) the protection and use of UWI marks;
- (f) the need for modification of this Policy; and
- (g) 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.

**1.5.** The University may elect to assign its rights covered by this Policy to a nominee company.

## **2.0 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, invention or plant variety or a decision on the identity of the author of a work or the person who made an invention or plant variety 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 the other 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.

### **3.0 Revenue and Expenditure**

**3.1** A royalty account will be established on each Campus for each work, invention or plant variety in respect of which income is received for the exploitation of the proprietary rights in such work, invention or plant variety authorised expenses are incurred for the protection or licensing of such work, invention or plant variety. All such income and expenses shall be recorded in that account. One account may be opened in respect of two or more works, inventions or plant varieties that are so related that they have items of income or expenses in common. A single account may be established on a campus to receive royalties and fees derived from the exploitation of UWI marks.

**3.2** An accounting of income and expenditure related to each work, invention or plant variety will be provided to the author or inventor annually, or more frequently by special arrangement, where circumstances warrant.

### **4.0 Confidentiality**

**4.1** All staff members and students involved in the process of invention disclosure, ownership determination, commercialisation 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, confidentiality agreements should be used.

**4.2** A staff member or student who 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.

**5.0 Execution of Contracts**

**5.1** Contracts arising from works, inventions, whether patented or not, or plant varieties, will be executed in accordance with established University policies and procedures.

**5.2** Staff members must ensure that contracts under which works, inventions and plant varieties may be developed and in which the University has or might have intellectual property rights are cleared by the Designated Office before execution and made in accordance with established University policies and procedures.

**6.0 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.

**7.0 Use of UWI marks prohibited**

**7.1** Where the proprietary rights in a work, invention or plant variety are owned exclusively by a staff member or student, the name of the University or any other UWI mark shall not be used in connection with any publication, production, documentation, promotion or exploitation of the work, invention or plant variety unless permitted under Part III of this Policy.

**8.0 Review of Policy**

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

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