

# **REGULATIONS FOR PROTECTION AND ENHANCEMENT OF THE INDUSTRIAL PROPERTY OF THE SANT'ANNA SCHOOL OF ADVANCED STUDIES, THE SCUOLA NORMALE SUPERIORE, IMT LUCCA AND THE UNIVERSITY INSTITUTE FOR ADVANCED STUDIES OF PAVIA**

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## **INTRODUCTION**

HAVING REGARD TO the Framework Agreement entered into on 7th January 2015 among the Sant'Anna School of Advanced Studies, the Scuola Normale Superiore and IMT Lucca (hereinafter, individually referred to as the "School" and jointly referred to as the "Schools") that defines "*the joint commitment of the Parties to develop advantageous collaborative relationships in administrative and organisational areas*" and, in particular, to "*encourage synergy among the Parties and the exchange of experience and practices in order to increase the effectiveness, efficiency and economy of the administrative performance, also through the establishment of joint working groups*";

HAVING REGARD TO the projects submitted by the Schools to the Ministry of Education, University and Research ("MIUR") as part of the 2013-2015 Three-Year Plan in which establishing a Joint Technology Transfer Office is indicated among the final objectives to be achieved by 2015;

HAVING REGARD TO the document named "*Policy for the management of technology transfer activities*" duly approved jointly by the four Schools;

CONSIDERING that on 1st October 2015 the Joint Technology Transfer Office was established among the Sant'Anna School of Advanced Studies, the Scuola Normale Superiore and IMT Lucca, subsequently integrated with the Institute for Advanced Studies (IUSS) on 1st April 2017;

CONSIDERING that the joint Committee was established on 1st October 2015 among the Schools, subsequently integrated with the Decree dated 1st April 2017;

HAVING REGARD TO the Industrial Property Code, duly approved with Legislative Decree (D. Lgs.) No. 30 dated 10th February 2005, and subsequent amendments;

HAVING CONSIDERED it appropriate that the Schools adopt specific regulations to protect and enhance industrial property with identical content:

the following regulations to protect and enhance the industrial property of the Sant'Anna School of Advanced Studies, the Scuola Normale Superiore, IMT Lucca and the Institute for Advanced Studies of Pavia (IUSS) are duly approved.

## **CHAPTER I - GENERAL PART**

### **Art. 1**

#### **Scope of operation**

1. These Regulations govern the management of industrial property generated, also separately, within the Schools, in order to promote the protection, use and more in general, the enhancement of the industrial property, in compliance with the Industrial Property Code, duly approved with Legislative Decree No. 30 dated 10th February 2005, and subsequent amendments.

## **Art. 2** **Definitions**

1. For the purposes of applying these Regulations:
  - a) “Invention” means: inventions, utility models, trademarks and other distinctive signs, geographical indications, designations of origin, industrial designs, topographies of semiconductor products, new plant varieties and secret information, as identified by current national and community legislation on industrial property obtained within the framework of:
    - Institutional Research: research supported and financed using the School’s own funds, including resources from the Ordinary Financing Fund;
    - Institutionally Funded research: research supported and financed, in whole or in part, by external parties for the School’s institutional goals;
    - Research funded on behalf of third parties: research carried out when performing research projects on behalf of third parties;
  - b) “Industrial Property” rights (or “IP”) mean the rights on the Inventions as recognised or attributed by the national, community and international industrial property legislation in force;
  - c) “Inventor” means the person or persons who has or have conceived the Invention: professor, researcher, research fellow, PhD student, visiting student/professor/researcher, undergraduate thesis student, affiliate organisation, scholarship holder, intern, administration and technical staff and collaborator of the School, in any capacity;
  - d) “Committee”: means the Joint Committee initially established by the Sant’Anna School of Advanced Studies, the Scuola Normale Superiore and IMT Lucca on 1st October 2015 and subsequently integrated with a member of the Institute for Advanced Studies of Pavia (IUSS);
  - e) “TTO”: refers to the joint Technology Transfer Office established initially among the Schools on 1st October 2015, and subsequently integrated on 1st April 2017;
  - f) “Code”: means the industrial property Code duly approved with Legislative Decree No. 30 dated 10th February 2005.

## **Art. 3** **Competent bodies and facilities**

1. Actions to protect and promote the IP rights within each School not involve only the Inventor, but also the governing bodies, the Committee and the TTO, each within their respective area of responsibilities.
2. In particular, any decision regarding the most appropriate protection and economic exploitation of the IP generated by each School (licensing of patents and know-how, exploitation agreements, etc.), is the responsibility of the respective management body, subject to investigation by the Committee performed with the support of the TTO.
3. As a general rule, the IP Committee has investigating duties and expresses its opinion in order to identify the most suitable forms of protection for the:
  - transfer to the Schools of the IP generated within the Schools themselves;
  - protection, enhancement and economic exploitation of the IP rights of which the School is or becomes the owner and of the resulting negotiation instruments.

**Art. 4**  
**Inventor's duties**

1. The Inventor who develops research results which are eligible for protection is required to contact the TTO promptly and to comply with the confidentiality requirements regarding the results, in order to take the most appropriate measures to protect the industrial property to the extent this is necessary to protect the rights and interests of the originating School, including cases where the School must fulfil obligations towards third parties.
2. The Inventor is invited to provide technical and scientific support to the TTO for any possible need, during the procedure for the protection of the School's IP, and in relation to the technology transfer activities.
3. If the Inventor decides to protect the invention in his/her own name, pursuant to art. 6, paragraph 1 below, then he/she is required to notify the School promptly.

**Art. 5**  
**Confidentiality Obligation**

1. For the purposes of protecting the IP, those who come into contact with technical information, data, projects, drawings, prototypes and other confidential information owned by the School, for whatever reason, are required to sign specific confidentiality undertakings, as soon as they begin their activity at the relevant School and where this is not already provided for in their respective contracts.
2. Likewise, the other parties involved, for example the TTO and the Committee members, are required to comply strictly with the utmost confidentiality in order to safeguard the IP rights related to the research results.

**CHAPTER II - INVENTIONS**

**Art. 6**  
**Inventions and IP rights attained when performing Institutional Research**

1. Pursuant to art. 65 of the Code, the Inventor is the exclusive owner of the rights deriving from the Invention of which he/she is the author, if achieved when performing Institutional Research, and in particular, has the right to file the patent application and to exploit the patent economically in his/her own name, and with all the expenses and economic risk to be borne by him/her. In the case where there is more than one author of the Invention (the School's Inventor or the Inventor of other Universities or Public Authorities), the rights deriving from the Invention belong to all of them in equal parts, unless otherwise agreed in writing among the authors in question.
2. If the Inventor is the exclusive owner of the rights deriving from the Invention, he/she may independently submit the patent application, as provided for in paragraph 1 above, notifying the TTO accordingly; the Inventor may also decide not to submit the application in his/her own name, but to transfer ownership rights to the Invention in favour of the School, as envisaged in art. 9 below, and the School will consider whether to proceed to file the application, bearing the respective costs to the extent provided for in art. 12 of these Regulations.
3. In the event that the Inventor, having filed the patent application in his/her own name, then decides to subsequently transfer the patent to a third party, the School has the right of first refusal to purchase the title, to be exercised within 2 (two) months from the date of the Inventor's notification to the TTO regarding the transfer proposal, and the relative conditions.

4. The income deriving from the economic exploitation of the Invention registered in the Inventor's name is to be distributed according to the provisions and subject to the terms indicated in the resolution that will be adopted by each School, in compliance with art. 16, paragraph 3 of these Regulations.

5. If, within five years from the date the patent is granted, the Inventor or his/her assignees have not started the industrial exploitation, and unless this is due to causes beyond their control, then the School may acquire a free, non-exclusive licence with entitlement to sub-license, in order to exploit the Invention, except for the Inventor's right to be acknowledged as the author.

#### **Art. 7**

##### **Inventions and IP rights attained when performing Institutional Funded Research**

1. IP rights resulting from Institutional Funded Research, as governed or defined in research programmes and scientific collaboration agreements and conventions, are governed in accordance with the terms and procedures defined in the above-mentioned agreements and conventions. The School has the right to define specific agreements with the Inventor in order to govern the use, also with the exclusive use, of the IP rights, in line with any obligations undertaken in the context of Institutional Funded Research programmes.

2. Unless otherwise agreed, the ownership of the IP rights deriving from Institutional Funded Research is represented by a joint ownership between the School and the third-party; whereas, if the research is carried out independently by only one party (the School or the third-party), that party shall have the exclusive ownership of the IP rights.

3. The scientific collaboration conventions and agreements defined within the framework of Institutional Funded Research must envisage the School's right to freely publish the results of the research; such publication may be deferred temporarily and only for the time strictly necessary to ensure the legal protection of any inventive results.

4. The income deriving from the economic exploitation of the Invention registered in the School's name, possibly in co-ownership with third parties, are to be distributed according to the provisions and subject to the terms indicated in the resolution that will be adopted by each School, in accordance with art. 16, paragraph 3 of these Regulations.

#### **Art. 8**

##### **Inventions and IP rights attained when performing third-party Funded Research**

1. The ownership of all IP rights obtained when performing third-party Funded Research belongs to the School, without prejudice to the Inventor's moral right to be acknowledged as the author of the Invention.

2. The School has the full and exclusive right to define the procedures to implement patent protection and the Invention's economic exploitation, as well as to interrupt the respective procedure.

3. The IP rights which are the result of third-party Funded Research are governed by the agreement entered into between the School and the financing organisation (or contracting authority). Unless otherwise agreed, the IP rights resulting from third-party Funded Research are owned equally by the School and the contracting authority.

4. The Inventor is required to notify the TTO regarding any inventive result that may be the subject of a patent or other IP right obtained when performing Funded Research, by submitting the protection proposal, in accordance with the specifications set out in art. 9.

5. The income deriving from the economic exploitation of the Invention registered in the School's name is to be distributed according to the provisions and subject to the terms indicated in the

resolution that will be adopted by each School, in accordance with art. 16, paragraph 3 of these Regulations.

6. The School may envisage the transfer of the IP in favour of the financing party; any consideration received is deemed to be additional to the consideration envisaged for carrying out the research activity.

## **CHAPTER III - PROCEDURES**

### **Art. 9**

#### **Protection proposal**

1. The patenting procedure or other form of IP protection is initiated by means of a proposal that the Inventor sends to the TTO, unless the Inventor decides to file the patent application independently, in the case provided for in art. 6, paragraph 1, above.
2. The proposal referred to in paragraph 1, if referred to a patentable invention, needs to contain at least the following information according to the "Invention Disclosure" and "Patent Report" formats prepared by the TTO and made accessible on the School's website:
  - a) the Inventor's name, specifying the relationship between the Inventor and the School;
  - b) a brief description of the Invention;
  - c) the results of the research carried out by the Inventor on the state-of-the-art, for a preliminary verification of the novelty and originality of the discovery;
  - d) an examination aimed at identifying the potential industrial sectors for the invention's application and possibly a list of interested companies;
  - e) the proposal to transfer the patent rights in the case of Institutional Research.

### **Art. 10**

#### **Proposal examination**

1. The TTO performs a preliminary examination of the proposal submitted, pursuant to art. 9, above, and verifies whether the patentability requirements or other form of IP protection have been met.
2. If the patentability or protection requirements have been met, then the TTO assists the Inventor in preparing the technical report and prepares the paperwork to be submitted to the Committee.
3. The Committee performs a detailed analysis of the proposal with the support of external experts, where appropriate, in order to:
  - a) verify that the Invention meets the requirements set out in the Code;
  - b) perform an analysis of the costs and economic resources expected to be incurred to ensure protection;
  - c) consider and describe the Invention's potential industrial use and identify the most appropriate exploitation strategies for the School (licensing, transferring rights, etc.);
  - d) analyse the legal aspects.

4. The Committee expresses its opinion on whether it is appropriate to proceed with the registration based on this analysis:

- a) if favourable, the Committee ensures that the preparation of the paperwork is completed within 60 days from the date the proposal was submitted. To this end the TTO will formalise the industrial property registration service, being able to identify the patent consultant who will prepare and file the industrial property application in the name and on behalf of the School, in compliance with the law and the procedures for the acquisition of services;
- b) if unfavourable, the Committee will notify the proposing Inventor promptly, through the TTO, detailing the reasons, and the proposing Inventor may decide whether to register the proposed Invention anyway in his/her name, and with all the expenses to be borne thereby.

#### **Art. 11**

##### **Extensions, maintenance and abandonment**

1. The inventors work together with the TTO, also after the protection application has been filed by the School, in order to maintain the industrial property right in force, providing their support, if necessary, in the subsequent phases of the procedure.
2. After the industrial property right has been filed, the School decides on the international extensions and abandoning the industrial property right based on the funds available and the prospects of development.

#### **Art. 12**

##### **Expenses**

1. The expenses relating to the Invention's protection, both the expenses regarding project funds and the expenses regarding ordinary financing funds are governed by each School by means of a specific resolution that will be adopted by each School, in accordance with art. 16, paragraph 3 of these Regulations.

### **CHAPTER IV - EXPLOITATION**

#### **Art. 13**

##### **Obligation for the economic exploitation of IP rights**

1. The Committee, the TTO and the Inventor undertake to implement all possible initiatives to exploit the School's IP rights, both in the form of granting exploitation rights and the transfer of the exploitation rights in question.
2. The Committee, the TTO and the Inventor undertake to identify the organisations (public and/or private bodies, companies, etc., hereafter, generally referred to as Organisations) potentially interested in exploiting the results of the research owned by the School, for the purposes of exploiting the School's IP rights.
3. In particular, the Committee with the support of the TTO, publicises the School's IP in the most appropriate and effective way to potentially interested organisations; in addition, the Committee implements the procedures and carries out negotiations to select the parties to whom the IP rights may be transferred in the forms deemed most appropriate and at the best economic conditions, forwarding the respective proposals to the TTO for the preliminary activity aimed at obtaining the approval of the School's management body.

4. If it is found that suitable conditions for the development and exploitation of an IP right have not been met, then the School may decide to waive the industrial title or to suspend payment of the respective maintenance fees.
5. The IP rights comply with the provisions set out in the individual internal regulations with reference to the relationship between each School and the respective spin-offs.

#### **Art. 14**

##### **Total transfer or licence of IP rights to third parties**

1. Licensing IP rights is preferred compared to their transfer, in compliance with the provisions set out in the *Management policy for technology transfer activities* mentioned in the introduction.
2. Unless otherwise agreed, the consideration in favour of the School to transfer or licence IP rights to third parties may be constituted as follows:
  - a) a single lump sum to be paid at the time of transfer or licence;
  - or,
  - b) a lump sum and periodic royalties on the turnover deriving from exploiting the results, to be paid respectively at the time of transfer or licence and from the beginning of the commercial exploitation, if deemed to be more convenient.
3. The transfer or licence agreements must include specific clauses which establish that the charges, taxes and expenses related to obtaining and maintaining the relevant right are to be borne by the assignee or the licensee, as well as a specific provision according to which the School's rights referred to in the previous paragraph are guaranteed, even if the transfer or licence agreements are subsequently transferred, in any way, to third parties.

#### **Art. 15**

##### **Income distribution rules**

1. The income resulting from the economic exploitation of the School's IP rights are divided among:
  - a) the Inventor;
  - b) the School's facilities or departments, including but not limited to the Institutes and faculties where the research was conducted;
  - c) the School's administration and technical staff incentive fund;
  - d) any other funds decided by the School's management body.
2. The School's competent department allocates the income deriving from the exploitation of IP rights at the end of each year, according to the provisions and subject to the terms indicated in the resolution to be adopted by each School, in compliance with art. 16, paragraph 3 of these Regulations, after having deducted the respective management costs (registration, promotion, maintenance, etc.).

## **CHAPTER V - FINAL PROVISIONS**

### **Art. 16**

#### **Entry into force, amendments and supplements to the regulations and deferment**

1. These regulations and their subsequent amendments and supplements will enter into force on the day after they are issued.
2. The approval and revision of these Regulations are decided by the competent bodies of the Sant'Anna School of Advanced Studies, the Scuola Normale Superiore, the IMT Lucca and the Institute for Advanced Studies of Pavia (IUSS), in accordance with their respective Statutes and internal regulations.
3. In addition to these regulations, the competent bodies of each School decide the allocation of the expenses to protect industrial property and regarding the proceeds resulting from the exploitation of industrial property.
4. The Code and the other applicable provisions of law or the specific rules laid down in special agreements entered into with third parties by each School shall apply to all matters not expressly provided for in these Regulations.