

## **Regulations on the Management of Copyright and Related Rights, Industrial Property Rights and the Principles of Commercialization of the Results of Research and Development at the Institute of Physical Chemistry of the Polish Academy of Sciences**

### **Definitions**

**Documentation** - a collection of documents containing the information required to complete all the formalities necessary to submit patent applications and obtain patent protection. The documentation may include, among others, results, sketches, models, information on the literature, a description of the developed technology together with analytical results, the ranges of critical parameters, confirmatory analyses and scientific, technical and other information obtained by the creator in connection with work on the invention.

#### ***Protection rights:***

- 1) all industrial property protection rights, in particular: the patent rights for an invention, utility model protection rights, industrial design registration rights and integrated circuit topography registration rights ,as well as
- 2) the protection rights of a plant variety bred or discovered and developed by a plant breeder.

**Industrial property** - inventions, utility models, industrial designs, trademarks, integrated circuit topographies, bred or discovered and developed varieties of plants, Know-how.

**Creations** – creations as understood by copyright law (including scientific works, audiovisual, computer programs, databases), the subjects of related rights, databases.

**Intellectual property** – Industrial property and creations.

**Know-how** – knowledge, technical and organizational or other information of commercial value in terms of technology or the production process.

**R&D results** – the results of:

- 1) scientific research that is an invention, utility model, industrial design, integrated circuit topography, a bred or discovered and developed plant variety; or
- 2) development work.

**Commercialization** – activities carried out for the purpose of transferring R&D results or the Know-how associated with these results for payment to be used commercially through:

- 1) the sale of the rights to R&D results and/or Know-how,
- 2) the granting of a licence to the rights to R&D results and/or Know-how, or
- 3) the transfer of R&D results and/or Know-how to a company.

**Protection Decision** – a decision by the Institute to make the intellectual right subject to legal protection or to refrain from such protection.

**Commercialization Decision** – a decision taken by the Director of the Institute or an authorised person, for the Institute to commercialize the R&D results and/or Know-how associated with them (a positive Commercialization Decision) or not to commercialize these results and/or Know-how (a negative Commercialization Decision).

**Special Purpose Vehicle (SPV)** – a commercial company set up by the Institute independently or in cooperation with another entity in order to transfer part or all of the tasks of the Institute with regard to the commercialization and management of Intellectual Property Rights.

**Independent commercialization** - Commercialization carried out by Institute as a result of a positive Commercialization Decision.

**Direct Independent commercialization** – Commercialization carried out by Institute as a result of a positive Commercialization Decision without the participation of an SPV.

**Indirect independent commercialization** - Commercialization carried out by Institute as a result of a positive Commercialization Decision with the participation of an SPV.

**Commercialization by the creator** – Commercialization carried out by the creator as a result of a negative Commercialization Decision.

**Industrial property rights** – the rights to an invention, utility model, industrial design, integrated circuit topography, bred or discovered and developed plant varieties.

**Intellectual property rights** – the rights to industrial property, copyrights and related rights and the rights to Know-how.

**Spin-off company** – a commercial company set up by the Institute or with the participation of the Institute in order to implement the results of R&D and/or related Know-how, or to carry out further R&D on these results/Know-how for their commercial use.

**Creator** – a person who has created intellectual property.

*The Institute of Physical Chemistry of the Polish Academy of Sciences (hereinafter "IPC PAS" or "the Institute"), promotes the development of innovative solutions, and in particular, supports activities aimed at creating intellectual property for its commercial application. In order to protect the rights of the creators and safeguard the interests of the Institute, acting on the basis of Art. 94a of the Act dated 30th April, 2010 on the Polish Academy of Sciences (Journal of Laws No. 96, item 619, with subsequent amendments), the following Regulations are hereby introduced:*

## **General Provisions**

### **§ 1 Personal scope of application**

1. These regulations govern the management of copyright and related rights, industrial property rights and introduce the principles of commercialization of the results of R&D and Know-how associated with these results in the IPC PAS.
2. The provisions of these Regulations shall apply to all employees of the Institute.
3. For doctoral students, undergraduate students and others who are not employees of the Institute, these provisions shall apply if this results from separate clauses in agreements concluded with these persons or they have accepted these Regulations (hereinafter: "Collaborators"). In this case, the provisions of the Regulations relating to employees shall accordingly apply to the Collaborators.
4. The provisions of the Regulations with regard to Creators shall accordingly apply to co-creators.

## **§ 2 Material scope of application**

1. The rights to intellectual property are vested in the Institute, subject to paragraph 2, if:
  - 1) the intellectual property concerned was created in the course of research and development work at the Institute, in particular, that carried out by staff in the performance of their duties as employees or as Collaborators,
  - 2) the intellectual property concerned was created with the help or participation of the Institute,
  - 3) they have been transferred to the Institute,
  - 4) they have been entrusted to the Institute,
  - 5) in other cases, where the agreement so provides.
2. The provisions of these Regulations shall not apply to the rights referred to in paragraph 1:
  - 1) obtained as a result of the implementation of agreements that provide for an obligation to transfer the rights of the R&D work and/or Know-how associated with these results to the party funding or co-funding this work or to any entity other than a party to the contract,
  - 2) obtained using funds, where the principles of awarding or use specify an alternative method of using the results of R&D work and/or Know-how associated with these results.

## **§ 3 General principles concerning intellectual property at the IPC PAS**

1. Employees of the Institute are under a strict obligation not to disclose any confidential information relating to intellectual property to which the rights are vested in the Institute to third parties without the consent of the Director of the Institute. This disclosure includes both oral and written communication, as well as the public presentation of intellectual property.
2. Confidential information relating to intellectual property is understood to mean information that has not been publically disclosed by the Institute, that may have a market value, and whose disclosure would be associated with the risk of losing legal protection, would annihilate or restrict the possibility of obtaining such protection or

reduce the chances of the Institute gaining economic benefits in the event of the commercialization of this property.

3. The Creator is obliged to cooperate with the Institute in the commercialization of intellectual property, including proceedings aimed towards obtaining exclusive rights. The Creator is also under an obligation to provide the Institute – on every demand – with all the information held by the Creator, the creations together with the ownership of any data storage devices on which the creations are stored, the Know-how and technical experience necessary to commercialize the intellectual property.

4. The agreements concluded by the Institute for intellectual property must provide for the obligation for the parties to maintain confidentiality.

## **R&D Results and Know-how**

### **§ 4 Register of industrial property**

1. A register of the industrial property of the Institute is set up (hereinafter: the Register) which contains information on new R&D results and/or Know-how associated with these results, in respect of which the Institute is the subject of the rights or those in respect of which the Regulations impose a duty of notification.

2. The Register particularly contains information concerning:

- a) The type of industrial property,
- b) The Creator,
- c) The nature and extent of powers of the Institute,
- d) The Protection Decision and in the case of a positive Protection Decision - information on the submission of the application for the granting of protection rights, the granting of protection rights and their extent or rejection, the expiry of protection and the reasons therein,
- e) The Decision on Commercialization and its method.

3. The Register is maintained by the Proxy for intellectual property (hereinafter: the Proxy), taking care to not disclose within the Register any information, the publication of which could prevent or impede the obtaining of protection rights to this property or its commercialization.

### **§ 5 Methods of commercialization**

1. The Institute may independently commercialize intellectual property (independent commercialization), or refrain from commercialization of intellectual property, leaving this to the Creator (commercialization by the Creator).

2. Under the direct independent commercialization of intellectual property the Institute may sell the rights to the R&D results and/or Know-how, grant licenses for these rights, or transfer them into a company. The Institute may for this purpose create spin-off companies and/or take up shares in them, or it may use the services of third party intermediaries in the search for buyers, partners and licensees.

3. The Institute may set up a commercial company - an SPV, to which it transfers all or part of its own tasks associated with the commercialization of the intellectual property vested in the Institute (indirect independent commercialization).

4. Where an SPV is set up – its tasks may include in particular taking up shares in joint-stock companies or creating joint-stock companies in order to implement R&D results and/or Know-how, the management of intellectual property as well as directing and co-ordinating the commercialization process.

5. In order to implement the tasks referred to in paragraph 4, the Director of the Institute may entrust the SPV, by means of an agreement, with managing the intellectual property rights of the Institute, or may transfer the intellectual property rights in kind to the SPV, in particular the obtained industrial property rights, Know-how and apparatus and equipment associated with the given intellectual property or Know-how.

6. In order to commercialize intellectual property the Institute may permit the use by third parties of the research infrastructure of the Institute for a fee. Making the infrastructure available should be based on market conditions under a written agreement and/or order.

7. Employees of the Institute may provide paid scientific-research services to third parties using the infrastructure and other resources at the disposal of the Institute. The provision of these services should be based on market conditions under a written agreement, to which the Institute is a party.

6. In the process of commercialization of intellectual property the Institute may provide services related to the implementation and commercial use of this property, in particular carrying out the installation, staff training and providing the Know-how associated with the property. The detailed conditions for the provision of services by the Institute are specified in an agreement.

## **§ 6 Notification of new industrial property**

1. After creating new industrial property, the Creator shall immediately report this fact to the head of the organizational unit in which the given property has been produced, by completing the form which constitutes Appendix 1 (part 1) to these Regulations.

2. The head of the organizational unit in which the industrial property referred to in paragraph 1 has been created immediately evaluates the industrial property with regard to the possibilities of commercialization and the obtaining of protection rights for it, by completing the second part of Appendix 1, and then forwarding the form (parts 1 and 2) to the Proxy.

3. Where the Creators are a group of persons and the industrial property has been produced by the collaboration of a number of organizational units of the Institute - all the Creators submit one form referred to in paragraph 1. In this situation, the industrial property is evaluated by the head of the organizational unit of any of these persons. Disputes in this matter shall be resolved by the Proxy.

4. A scanned signed copy of the form referred to in paragraph 2 is forwarded to the Proxy by electronic mail to the following address: [komercjalizacja@ichf.edu.pl](mailto:komercjalizacja@ichf.edu.pl). The Proxy may request that other additional information concerning the industrial property being notified be forwarded by the Creator.

5. After receiving notification of the new industrial property, the Proxy records it in the Register,
6. The Proxy informs the Director of the Institute of the notification of new industrial property.
7. If the employee submits a declaration of interest in the transfer of rights to a new Industrial Property (Appendix 6) within 3 months, the Director of the Institute issues a Commercialization Decision and a Protection Decision.
8. The declaration referred to in paragraph 7 shall be submitted by the employee in writing within fourteen days of the receipt by the Proxy of a complete notification of the new Industrial Property. The three-month period referred to in paragraph 7 runs from the date of submission of the declaration.
9. The Director of the Institute may appoint an expert or team of experts to obtain an opinion on the subject of commercialization and/or protection of the given intellectual property, or authorize a third party or parties to carry out the activities referred to in paragraphs 7 and 8.
10. In the event of a positive Commercialization Decision for new industrial property in the form of Know-how, whilst simultaneously not being an invention, utility model, industrial design, a bred or discovered and developed plant species, in order to maintain confidentiality – the information is described as confidential, the measures required to maintain confidentiality are determined, as well as the expected period of protection, which may be extended.
11. In the event of a negative Commercialization Decision or after the expiry of the period referred to in paragraph 7, the IPC PAS submits to the Creator an unconditional offer to transfer the rights to the Industrial Property within 30 days of the date of the issue of the decision (hereinafter: the Offer). The transfer of the rights to this property takes place in the form of a written agreement, and the remuneration due to the Institute for this is 5% of the average monthly remuneration for work in the national economy in the previous year, announced by the President of the Central Statistical Office.
12. In the event that the Creator rejects the Offer referred to in paragraph 11, the rights to the R&D results and the Know-how associated with these results, together with the information, creations and ownership of the data storage devices on which the creations are stored, as well as the technical experiments are vested in the Institute.
13. The Creator is notified of the decision of the Director of the Institute with regard to the subject of commercialization and protection by means of electronic mail. The correct address for delivery for the Creator is the e-mail address indicated on the form referred to in paragraphs 1 and 2.
14. In the event that the Creator does not use electronic mail – the form referred to in paragraph 3, the Commercialization Decision, the Protection Decision and the Offer – are forwarded by hand or sent by traditional post. The address for delivery is then:
  - In the case of the Institute – the address of the Institute's headquarters,
  - In the case of the Creator – the address indicated in the form referred to in paragraph 1.

15. The Creator is required to immediately notify the Proxy of any change in address for delivery referred to in paragraphs 13 and 14.

### **§ 7 Legal protection of new industrial property**

1. In the event of a positive Protection Decision the Creator prepares the documentation required to obtain protection rights for the industrial property.

2. Supervision of the documentation is the responsibility of the head of the organizational unit in which the industrial property was created. If the industrial property was created with the collaboration of several organizational units – the Director of the Institute designates the head of the organizational unit responsible for supervision of the documentation.

3. The Creator is required to forward all information and documents as well as to carry out all the other formalities required for the Institute to submit an application and obtain protection rights.

4. The activities referred to in paragraph 3 particularly apply to the case where the Institute makes a positive Decision on the protection of industrial property rights in a state in which the applicant for such rights can only be the Creator. In this event, the Creator is required to immediately apply for industrial property protection rights. After receiving confirmation of the notification of the given protection rights, the rights are transferred to the Institute within a maximum period of 3 months from the day on which the transfer becomes possible.

5. Where the industrial property submitted for protection has been created by a group of persons, all the Creators complete one declaration according to Appendix 2. The declaration contains in particular details of the percentage share of each of the Creators in the creation of the property. In the event of a lack of consensus among the Creators in this regard, disputes among them are resolved by the head of the organizational unit in which the property was created, and in the case of several organizational units – the Director of the Institute. The declaration is forwarded to the Proxy, and a copy is attached to the documentation of the invention.

6. The cost of notification of the industrial property in order to obtain protection rights is borne by the Institute.

7. If the Institute is applying for protection rights for industrial property which has been created by both Institute employees and third parties – matters of intellectual and industrial property shall be regulated in a separate agreement.

8. The Proxy must inform the Director of the Institute with due notice of the approaching deadline for payment for a further period of protection, in order to make a decision on the subject of whether or not to extend the period of protection.

9. If the decision is taken to refrain from protection, the Creator may apply to the Director of Institute, through the Proxy, for the transfer of the rights to this industrial property to the Creator for the fee referred to in § 6 paragraph 11.

### **§ 8 Principles of independent commercialization of industrial property by the Institute**

1. The part of the Register pertaining to the industrial property with respect to which the Institute has taken a positive Commercialization Decision – may be made publically available in part or in its entirety by the Proxy or the Director of the Institute.
2. Independent commercialization of industrial property shall take place on the principles of open competition.
3. Industrial property earmarked for independent commercialization may be commercialized directly by the Institute or transferred into the SPV referred to in § 5 paragraph 3 for its further commercialization (indirect independent commercialization).
4. In the case of direct independent commercialization by the granting of a licence, these licences may be granted many times, provided that the licensee has not obtained a licence of an exclusive nature
5. Decisions concerning the particular conditions of commercialization of the industrial property are on each occasion taken by the Director of the Institute, with the interests of the Institute in mind.
6. The Creator may not, without notifying the Proxy and obtaining the permission of the Director, conclude an agreement to transfer or restrict the industrial property rights earmarked for direct or indirect independent commercialization by the Institute, or carry out any independent activities aimed at implementing the property to which the rights pertain.
7. The Creator is required to collaborate with the Institute in the process of commercialization of the industrial property referred to in paragraph 1.

#### **§ 9 Principles of remuneration and the distribution of the funds from commercialization**

1. In the case of direct independent commercialization of industrial property, the Creator shall receive a fee in the amount of 50% of the funds received by the Institute from the commercialization of the property less 25% of the costs directly associated with the commercialization which were incurred by the Institute.
2. In the case of indirect independent commercialization of industrial property, the Creator shall receive a fee in the amount of 50% of the funds received by the SPV from the commercialization of the property less 25% of the costs directly associated with the commercialization which were incurred by the Institute or the SPV.
3. Where there is a group of Creators, the total remuneration of all the Creators is 50% of the funds referred to respectively in paragraph 1 or 2, less 25% of the costs directly associated with the commercialization, referred to respectively in paragraph 1 or 2. The share of each Creator in the fee thus calculated is proportional to the share in the industrial property right, specified in the declaration referred to in §7 paragraph 5.
4. In the case of commercialization of industrial property rights by the Creator – apart from the fee referred to in § 6 paragraph 10 of the Regulations – the Institute is entitled to 25% of the funds received by the Creator from the commercialization, less 25% of the costs incurred by the Creator directly associated with the commercialization.



5. The costs directly associated with Commercialization include external costs, in particular the costs of obtaining Protection Rights, expert opinions, valuations of the subject of Commercialization and official fees. Indirect costs do not include any costs incurred before the issue of the Commercialization Decision or the remuneration referred to in § 6 paragraph 11 of the Regulations.

6. The remuneration referred to in paragraphs 1 - 4 shall be paid out in arrears, no later than by the end of the April of the year following the year in which funds were received from Commercialization.

## **Creations as understood by copyright and subjects of related rights**

### **§ 10 Scientific and work creation**

1. Subject to the provisions of the Work Regulations of the Institute of Physical Chemistry of the Polish Academy of Sciences, an employee has the freedom to choose the form and place of publication or other dissemination of a scientific work, as long as this does not disclose confidential information concerning the results of R&D or Know-how related to the results of R&D work conducted by the Institute, in respect of which a positive Commercialization Decision has been made and/or a positive Protection Decision.

2. In the case where R&D results and/or Know-how associated with the results, which are to be disseminated in accordance with paragraph 1, have been created by a group of persons, then commercialization is carried out by at least one of the co-creators – disclosure of information on the results of R&D and/or Know-how associated with the results can only take place after obtaining the written consent of the co-creator, who is carrying out the commercialization.

3. Irrespective of the form or place of dissemination of the scientific work referred to in paragraph 1, the employee is under an obligation to include the name of the Institute next to his name as the Creator.

### **§ 11 Computer programs, audiovisual works, databases**

1. The Institute is primarily entitled to the copyright to a computer program created by a Creator, even when it is of the nature of a scientific creation.

2. The Institute may appear in the role of producer of an audiovisual creation. In this situation, it is presumed it has exclusive property rights to use the creation as a whole, also when the audiovisual creation is at the same a scientific creation.

3. In incurring the risk of an investment outlay in creating a database, the Institute is its producer. In respect of this, it is entitled to exclusive, property and absolute rights to it.

4. The Creator of the intellectual property specified in paragraphs 1, 2 and 3 is required to notify the Institute of its creation under the provisions of § 6 paragraphs 1– 4.

5. With regard to the intellectual property mentioned in paragraphs 1 – 3, simultaneously being the results of R&D or the Know-how associated with these results – the remaining provisions of the Regulations apply, in so far as they relate to the commercialization of R&D results and/or the Know-how associated with them.

## **Final regulations**

### **§ 12 Final provisions**

1. The Director has the right to waive the provisions of the Regulations, if it is in the important interest of the Institute and it is not in conflict with the law.
2. In matters not regulated under these Regulations, the provisions of universally binding law apply, and in particular the provisions of the Act on the Polish Academy of Sciences, the Law on Copyright and Related Rights and the Industrial Property Law.
3. Team leaders are obliged to inform team members of these Regulations.
4. The employees referred to in §1 paragraph 2 are required to become acquainted with these Regulations and to sign the declaration in accordance with Appendix 5. This particularly relates to persons newly-employed at the IPC PAS.
5. These Regulations come into force on 2<sup>nd</sup> of March 2015.

**APPENDIX 1 – Template of new industrial property notification**

NOTIFICATION OF NEW INDUSTRIAL PROPERTY

**Part I) NOTIFICATION BY CREATOR** (to be completed by creator)

1. Information on Creator/notifier of solution or contact person

Name .....  
 Position held .....  
 Organizational unit .....  
 E-mail .....  
 Telephone .....

2. Title and type of industrial property:

.....<sup>1</sup> entitled. ....

3. Information on authors and authorised persons

Name	Surname	Address	Share [%]	Authorised institution	Legal basis <sup>2</sup>	Source of research funding	Source of protection funding

4. Information on industrial property

- Brief description

.....

- Advantages / innovative aspects in points

.....

- Application / commercial potential

.....

- Please indicate the protection rights associated with this property (*if applicable*)

.....

.....  
*Signature of applicant*

<sup>1</sup> An invention, utility model, industrial design, trademark, integrated circuit topography, plant species, Know-how, audiovisual creation, computer program, database.

<sup>2</sup> Employment contract, Commission contract, Grant agreement, Funding agreement, Cooperation agreement.

**Part II) OPINION OF MANAGER OF ORGANIZATIONAL UNIT** (to be completed by the Manager of the organizational unit in which the given industrial property was created)

In my opinion the presented solution:

- possesses a degree of novelty,
- does not possess a degree of novelty

In view of the above I request that:

- An application is made for legal protection of the solution in Poland,
- An application is made for legal protection in the European Patent Office,
- An application is made for international legal protection under PCT, through the Polish Patent Office,
- An application is made for legal protection in the following countries.....,
- The solution is made subject to confidentiality due to the commercial interests of the IPC PAS .....,
- The solution is not submitted to be covered by protection rights.

.....  
*Signature of Manager*

**APPENDIX 2 – Template of declaration of Creators of industrial property**

Warsaw, date.....

**DECLARATION**

In association with my intention of submitting for cover by .....<sup>3</sup>.....<sup>4</sup> entitled. "....." the undersigned declare that the Creators of .....<sup>4</sup> are the following persons

Name	Surname	Address	Share [%]	Authorized Institution	Signature

.....  
*Signatures of Creators*

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<sup>3</sup> Type of protective law: patent/ protection right / registration right / other –which?

<sup>4</sup> Type of industrial property: invention / industrial design / utility model / other –which?

**APPENDIX 3 – Template of Commercialization Decision**

Warsaw, date .....

**COMMERCIALIZATION DECISION**

Acting pursuant to Art. 94c paragraph 1 of the Act dated 30th April, 2010 on the Polish Academy of Sciences (Journal of Laws 96 item 619 with subsequent amendments) I hereby decide to proceed / not proceed<sup>5</sup> with the commercialization of.....<sup>6</sup>entitled.....  
.....

Simultaneously, since .....is confidential information, I hereby designate the following measures necessary to maintain the confidentiality of the information in question....., for the following period of time.....<sup>7</sup> .<sup>8</sup>

.....  
*Signature of Director  
/ authorised person*

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<sup>5</sup> Cross out or delete as required.

<sup>6</sup> Type of industrial property / industrial design / utility model / integrated circuit topography / trademark / bred or discovered and developed plant species / Know-how.

<sup>7</sup> The protection period may be extended.

<sup>8</sup> This applies to new industrial property in the form of Know-how and simultaneously not an invention, utility model, industrial design, trademark, integrated circuit topography, bred or discovered and developed plant species. If not applicable – delete the record.

## APPENDIX 4 - Template of Protection Decision

Warsaw, date .....

### PROTECTION DECISION

Regarding .....<sup>9</sup> for .....<sup>10</sup> entitled "....."

I hereby take the decision to:

- submit the solution to the Polish Patent Office in order to obtain legal protection in Poland,
- submit the solution to the European Patent Office<sup>11</sup>,
- Submit the solution for international legal protection under PCT, through the Polish Patent Office <sup>11</sup>
- Submit the solution in the following countries<sup>11</sup>  
.....,
- Maintain the confidentiality of the solution due to the commercial interests of the IPC PAS with regard to .....
- Not submit the solution to be covered by protection rights.

.....  
*Signature of Director  
/ authorized person*

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<sup>9</sup> Type of protection right: patent/ protection right/registration right/other – which?

<sup>10</sup> Type of industrial property: invention / industrial design / utility model / integrated circuit topography / trademark / bred or discovered and developed plant species.

<sup>11</sup> The Protection Decision may be extended within 12 months of the priority date of filing.

**APPENDIX 5 – Template of declaration of having read the Regulations**

Warsaw, date.....

**DECLARATION OF HAVING READ THE REGULATIONS**

I, the undersigned, hereby declare that I have read and understood the Regulations on the Management of Copyright and Related Rights, Industrial Property Rights and the Principles of Commercialization of the Results of Research and Development at the Institute of Physical Chemistry of the Polish Academy of Sciences and agree to abide by them.

Name	Surname	Signature



**APPENDIX 6 - Template of the declaration of interest in the transfer of rights**

Warsaw, date.....

DECLARATION OF INTEREST IN THE TRANSFER OF RIGHTS

I, the undersigned, ..... hereby declare that, I am interested in the transfer of rights to a new Industrial Property -.....<sup>12</sup> entitled .....

.....  
*Signature of Creator*

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<sup>12</sup> *Type of industrial property: invention / industrial design / utility model / integrated circuit topography / trademark / bred or discovered and developed plant species / Know-how.*