

Guide to

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



HR EXCELLENCE IN RESEARCH

TO WHOM DO THE REGULATIONS APPLY?

The regulations bind all current and former employees of the Institute, i.e. persons who concluded or have concluded an employment contract with the Institute. Type of a position (scientific, research-technical, administration employee) does not matter in this case .

Moreover, the regulations may apply to persons who concluded or have concluded with the Institute other types of contract (i.e. contracts of mandate, task-specific contracts), if it results from detailed provisions of these contracts. An exemplary provision is as follows:

"The Contractor declares that he/she has become acquainted with 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 IPC PAS, and that he/she accepts them and accepts to apply them".

In this document, these persons are collectively referred to as "employees".

WHAT IS REGULATED?

The regulations define rights and duties of the Institute and its employees in case of developing—under agreement concluded with the Institute and during its validity—a creation, know-how, invention etc. They are not limited to the research results but cover all results of work, e.g. programmes, databases. In particular the regulations specify:

- who has the right to decide how to use these goods,
- how these goods can be used and
- who can get financial benefits from their use and in what amount.

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FORMS OF COMMERCIALIZATION

Inventions, know-how, other results of creative or engineering work (e.g. created databases of computer programmes) can be commercialized by both—the Institute and their creators. In the first case we deal with—so called - **independent commercialization**, while in the second—with **commercialization by the creator**.

Both—the Institute and the creator may directly take actions aimed at commercialization, i.e. involve in conducting further R&D works and take other measures aimed at technology or product launch on the market. Alternatively, a special **purpose vehicle (SPV)** may be set up to carry out these works and activities.

In this situation, we will be dealing with **indirect commercialization**.

Commercialization by a special purpose vehicle is recommended when activities aimed at refining the technology, testing or selling it are labor-intensive, and the party responsible for commercialization does not want to devote solely to this. For example, the creator prefers to do scientific work rather than developing the technology. Then, under SPV a team is designated to develop technology, prepare it for sale to a financial or industry investor, or launch it on the market.

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DISTRIBUTION OF COSTS AND FINANCIAL BENEFITS

The share in profit from the sale of a technology or product developed by an employee of the Institute depends on the party which is involved in commercialization - the Institute or the creator.

In the case of **independent commercialization by the Institute**, the creator is entitled to a fee of 50% of the funds obtained from commercialization reduced by 25% of the costs incurred directly in connection with the commercialization undertaken by the Institute or SPV established by it. If there are several creators, their share in the fee will be equal to their shares in the creation of the invention.

If the creator or creators are responsible for commercialization (**commercialization by the creator**) - independently or with SPV - the Institute is entitled to the fee in the amount corresponding to 25% of funds obtained as a result of commercialization reduced by 25% of costs incurred directly in connection with commercialization undertaken by the creator, creators or SPV.

	Commercialization by the Institute	Commercialization by creators
Fee of the creator	[50% of income – 25% of costs]	[75% of income – 75% of costs]
Fee of the Institute	[50% of income – 75% of costs]	[25% of income – 25% of costs]

COSTS AND FINANCIAL BENEFITS OF COMMERCIALIZATION ON EXAMPLES

INDEPENDENT COMMERCIALIZATION BY THE INSTITUTE: If, as a result of the sale of a patent for an invention, the Institute obtained the amount of PLN 50,000, and the only cost incurred in connection with this sale was the cost of patent protection and its evaluation - PLN 10,000, the creator will receive a fee of PLN 22,500. The fee of the Institute will be PLN 17,500. If three authors participated in the creation of the invention, creator A had a 50% share in its creation, and creators B and C - 25% each, the fee of the creators shall be respectively:
A - PLN 11,250, B - PLN 5,625, C - PLN 5,625.

COMMERCIALIZATION BY THE CREATOR: As a result of commercialization led by the creators, the creators obtained the fee of PLN 50,000. Providing that their only cost was patent evaluation - PLN 10,000, the Institute will receive PLN 10,000. The distribution of the remaining funds between creators will depend on their arrangements. Although it is recommended to base it on individual contributions in the product creation, and participation in preparatory works aimed at the sale of technology and/or its implementation.

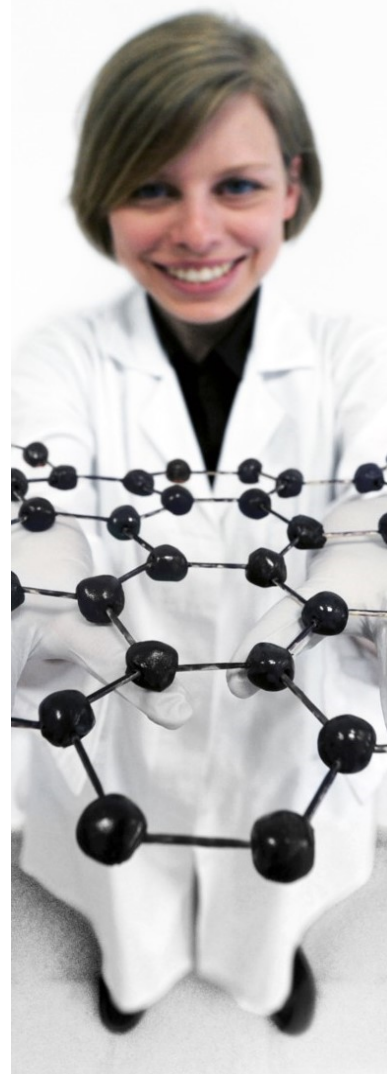
	Commercialization by the Institute	Commercialization by creators
Fee of the creator	PLN 22,500	PLN 30,000
Fee of the Institute	PLN 17,500	PLN 10,000

WHO HAS THE RIGHT TO MAKE A DECISION ON COMMERCIALIZATION?

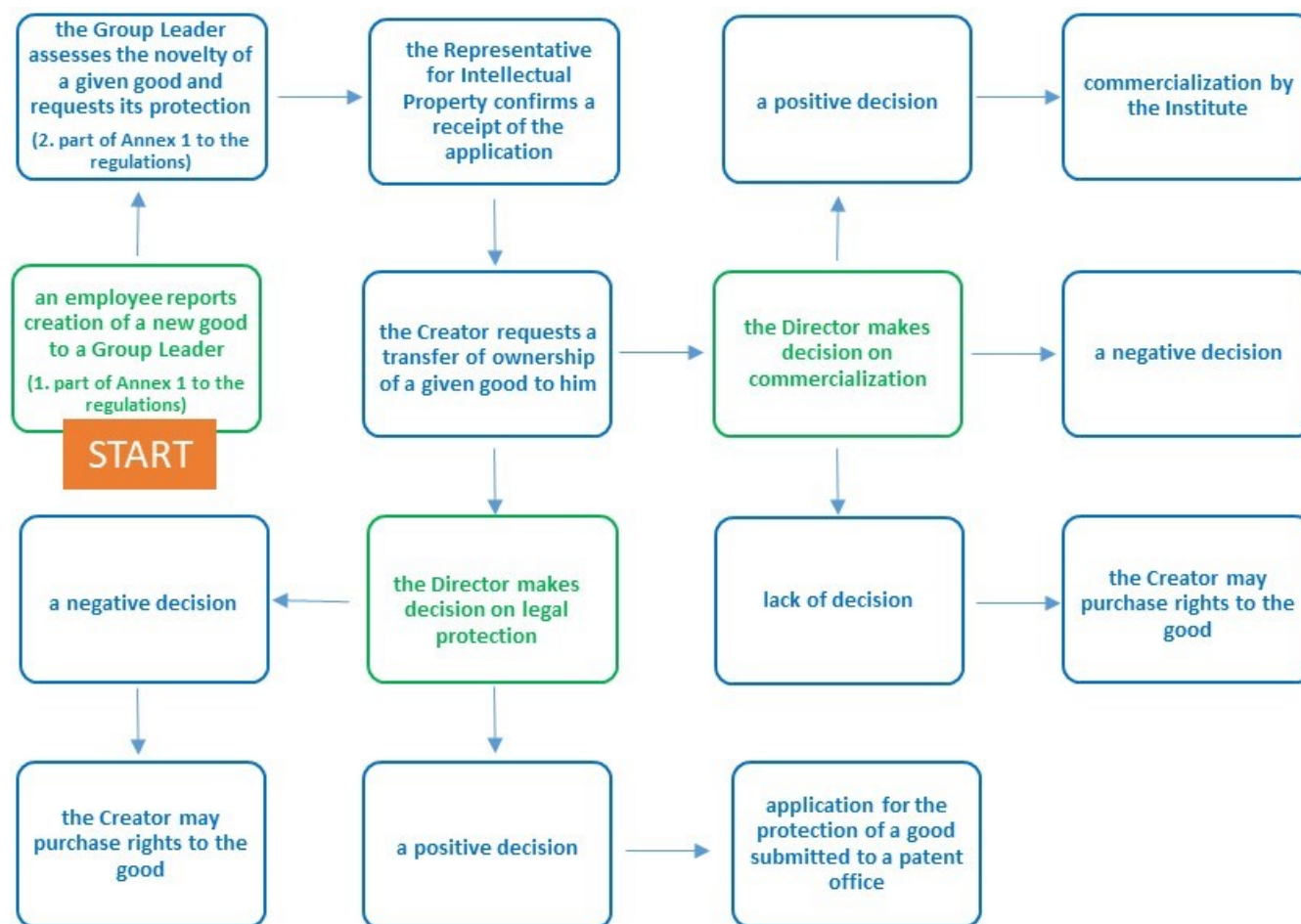
According to the respective legal regulations, the Institute Director has the right to decide, acting alone, whether and how the Institute will commercialize a given invention, know-how or other good having commercialization potential. However, it is better to make such a decision in cooperation with the creator(s). **In practice, if the creator is not interested in enabling practical use of his own invention, it will be very difficult to commercialize it.** Adaptation of a product or technology to the commercial use requires involvement of a team possessing knowledge and experience in a narrow field related to the invention. The decision on commercialization includes as well the formula under which a given good will be commercialized, i.e. whether the technology should be sold to an external entity or transferred to a spin-off company, which will adapt the technology / product to the requirements of customers or investors.

Covering an invention, an industrial design or a utility design by legal protection (patent, registration right or protection right) is also the sole decision of the Director of the Institute. Nevertheless, the creator can always turn to the Director to legally protect the results of his/her work, indicating as well the proposed geographical area in which this protection should be secured.

It is important to keep the results of work confidential when making these decisions, as their disclosure may hamper their protection.



COMMERCIALIZATION STEP BY STEP



Reporting new industrial property goods

An employee who has created the invention, know-how, programme, database, etc. should report this to the head of the unit in which he carried out this work. Most often, the employee will notify the group leader of his own research group. The creation of the new good is reported using the form included in Annex 1) to the Regulations. The creator or creators complete its first part. In particular, in this form, each creator specifies his/her % contribution to the creation of a given good.

After receiving the notification, the group leader assesses the novelty of the given good and analyzes the possibilities and rationality of its covering by legal protection, completing the 2. part of the form with an appropriate information. The completed Annex 1. should be signed by at least one of the creators and the group leader. The scanned form is sent to the Representative for Intellectual Property by e-mail on the following address: [komercjalizacja@ichf.edu.pl](mailto:kommercjalizacja@ichf.edu.pl).

Decision on protection and commercialization

Within 14 days from the date of submitting a complete notification on a creation of a new good to the Representative for Intellectual Property, the creator or creators may apply to the Director to transfer to them an ownership of a given invention, know-how or other good produced by them. If such a request is filed, the Director has 3 months to make a decision on covering this good with legal protection and decide on its commercialization. In case of a negative decision on commercialization or failure of the Director to make such a decision on time, the author gains the right to purchase the rights to this good.

These rights are transferred by contract. The fee due to the Institute for the transfer of rights is 5% of the average monthly remuneration for work in the previous year, announced by the President of the Central Statistical Office. At the same time, payment to the Institute of the fee for transferring the rights to this good to the creator does not release the creator from the obligation to include the Institute in the distribution of profits obtained from commercialization of this good.

„payment to the Institute of the fee for transferring the rights to this good to the creator does not release the creator from the obligation to include the Institute in the distribution of profits obtained from commercialization of this good.”

	Average monthly remuneration for work in 2018	Fee due to the Institute
Fee due to the Institute in 2019 for transferring to the creator rights to an invention, know-how etc.	PLN 4,585.03	PLN 229.25

Legal protection

In the case of a positive decision on the covering a given good with legal protection (i.e. patent, protection right, registration right or other), the creator or creators prepare the documentation necessary to submit an application to the appropriate patent office. In this work they are supported by the patent office serving the Institute and the Representative for Intellectual Property (Piotr Cwalina). At the same time, before submitting the documentation to the patent office, the creators sign a statement (Annex 2. to the regulations) in which, again, they specify their individual % contribution to the production of a given good. If the co-creators of a given good are from outside of the Institute, an appropriate agreement is also concluded. This agreement regulates the use of this good and the distribution of costs and financial benefits. As a rule, the costs of obtaining and maintaining protection are borne by the Institute.

The Representative for Intellectual Property monitors applications and granted rights such as patent protection. In addition, the Representative informs the Director of the Institute about the upcoming expiry of the protection period, while the Director decides to continue the protection or to discontinue it. In the case of a decision to terminate protection, the creator may request the Director to transfer to him/her the rights to this good. Such request is submitted through the Representative. The fee due to the Institute in this respect amounts to 5% of the average monthly remuneration for work in the previous year, announced by the President of the Central Statistical Office.

Analysis of a potential

When assessing the commercialization potential of the reported good, the group leader analyzes the possibility and rationality of covering it with legal protection. Until the decision on protection is made, employees should not disclose details of the given good, because it is a prerequisite for obtaining legal protection (e.g. patent). However, even without filing a request for protection the group leader may also oblige employees not to disclose this invention. This is quite a popular practice in the companies that see the commercialization potential of a given invention, however they want to refine its details and cover with multi-level protection (i.e. also register alternative construction solutions).

Text of Regulations

[Polish version](#)

[English version](#)

COMMERCIALIZATION AND THE RIGHT TO DISCLOSE THE RESULTS OF WORK

The employee has the right to publish the results of the work or other dissemination thereof, as long as it does not disclose confidential information about a given invention, know-how, design, database or programme. The required minimum confidentiality period for this information is specified by the Director in the commercialization decision.

However, in practice - already at the stage of creation of a given good, the employee should take care of the confidentiality of detailed technological information. In particular - if the employee stipulates that the result of his/her work may be subject to commercialization, he/she should refrain from disclosing confidential information regarding the subject of the work and ensure the security of the used ICT systems.

Organization:

Institute of Physical Chemistry PAS

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