UNIVERSITY REGULATION ON THE MATTER OF PATENTS

TITLE I
GENERAL PROVISIONS

Art. 1. – Object and definitions
1. The present regulation supervises, in accordance with applicable law and in particular with, D.Lgs. 10th February 2005 n.30 (Code of Industrial Property – CIP)) the internal procedures regarding inventions, utility models, models, designs, software and Know-How and any other innovative object or procedure (herein grouped under the term “Invention”) which can be protected by a patent or other form of registration.

2. The following definitions apply:
- **Patent**, the legal title that grants its legal holder the exclusive right, for a limited period of time, to make or use the invention and/or to profit from it within the country(ies) for which the patent has been granted. More specifically, the patent confers the exclusive right to prevent third parties from making, using, bringing to market, selling or importing for these purposes the invention or similar product without authorisation.
- **Inventor**, the author of the invention. The inventor is entitled to the moral rights on the invention; the actual property rights are regulated according to the following articles and applicable laws. In the articles that follow the term “Inventor” will be used both to indicate the single individual or the group of individuals that created the invention. In the second case, the share of ownership will be determined on the basis of the contribution by each person to the achievement of the inventive result, as expressly declared in the application form.

The following are essential requirements for patentability:
- **Novelty**, when the invention, before the application for a patent is filed, has not been disclosed or made available to the public in Italy or elsewhere in the World, in a manner so that it can be implemented. For this purpose, Inventors are recommended to maintain the strictest secrecy in regard to the invention, to avoid compromising patentability through early forms of dissemination;
- **Inventive step**, when the invention cannot be easily extracted from the state of the art; in other words when the solution represented by the invention is not obvious to the skilled person in the field of the invention;
- **Industrial applicability**, when the invention can be manufactured or used industrially;
- **Lawfulness**, when the invention in its commercial or industrial exploitation is not contrary to public order or ethical principles.

3. It can be regarded as patentable:
- The **invention** or original solution is to a technical problem, which can be manufactured or applied in the industrial field. The essential quality of the invention is not the object or procedure itself, but the principles onto which its creation lays. In other words, the invention must provide a new and original function (that has not found prior use and is not obvious from the state of the art) to the object, product, device, method, chemical compound, biological and/or biotechnological element or procedure that has been invented;
- The **utility model**, which provides specific efficacy and ease of application to machines or parts of machines, devices, tools and objects of general use.

The provisions of this regulations apply also to utility models, models or designs, software and Know-How in accordance with the CIP.
4. It is acknowledged that the fundamental goal of academic research is to make the results available and accessible to the public, thus the Know-How (also known as “industrial secret” and included among the “business information and technical-industrial experiences”, as defined in art. 98 of CIP) should be considered to the extent of this regulation if it is essentially anticipating, and not an alternative to patenting activities.

5. In compliance with the law, any individual (Inventor) falling within the definitions indicated in this Regulation is required to communicate to the University any invention that might be potentially patentable, before any other type of disclosure of the invention, through oral or written description, use or any other means. The lack of communication constitutes violation of the present Regulation.

**Art. 2 – Invention types relevant for the purposes of the Regulation.**

1. The obligations and rights deriving from an invention and that are object of this Regulation depend on the relationship between the Inventor and the University. In particular the following are relevant for the University:
   a. Inventions achieved by personnel having a relationship of subordinate employment with the University in the execution of their duties, or achieved within the range of the academic activities also without any casual link to their due activities, (Title II of the present Regulation);
   b. Inventions achieved by individuals with no subordinate employment relationship with the University, but who are linked to the University by a temporary contract (appointee to specific tasks either in research or teaching, that could consist also exclusively in innovative activities, recipients of scholarships, post-docs, PhD students, etc), in the execution of their duties, or achieved within the range of the academic activities also without any casual link to their due activities (Title III of the present Regulation);
   c. Inventions achieved by employed/contracted personnel within the scope of contracts for services rendered to third parties (Title IV of the present Regulation);

2. Any improvement, combination or translation of an invention when they display the requirements that justify application for a new patent are object of the present Regulation.

**Art. 3 – Inventions achieved in collaboration with other institutions employees.**

1. In case researchers employed by other Italian or foreign institutions (herein indicated as “External Inventor”) participate in the creation of an invention at Ca’ Foscari University, the External Inventors must promptly communicate the results to their institution in order to reach an agreement on the ownership of the results and on the distribution of possible costs for filing and managing the patent application.

2. In case of inventions obtained with the collaboration of researchers employed by other Italian universities or other public administrations pursuing research objectives among their institutional purposes (herein indicated as “Membership Institution”), the provisions indicated in the previous paragraph apply when the researchers declare to waive their ownership rights on the results in favour of the “Membership Institution”.

3. In case of an External Inventor, employed by other Italian University or other public administrations pursuing research objectives among their institutional purposes who decides not to waive the ownership rights to the Membership Institution, a transfer or licensing agreement must be made between Ca’ Foscari University and the External Inventor. In case of transfer the same provisions applicable to employed personnel are applied to the External Inventor.

**Art. 4 –Technical Patent Commission**

1. A Technical Patent Commission (herein indicated as “Commission”) is established by Rector’s Decree, after consulting the Senate. The Commission is composed of a fixed component and a
variable component. The variable component is called upon by the President on the basis of the technical-scientific expertise required to deliberate.

2. The fixed component remains in office for 3 academic years and can be renewed at the end of its mandate. It is composed of:
   - The Rector or her/his delegate acting as President;
   - Two Professors: one from the economic and management sectors and one from the legal sectors;
   - The Head of Administration, or her/his delegate.

3. Every three years, after receiving indications by the Heads of Department, the Rector selects at least three full professors and/or tenured researchers from each Department to make a list of names among which the President chooses each time the members of the variable component of the Commission, on the basis of the technical-scientific expertise required to deliberate.
   The above list is valid for three years and each name can be included in the list no more than one consecutive time. The list remains automatically valid until a new list is released.

4. The Head of Administration selects the secretary of the Commission among the technical and administrative personnel of the University.

5. The Commission has the following competences:
   - Monitor the correct application of the present Regulation;
   - Deliberate on patent filing applications and registrations, on all transfer agreements of patent applications that have already been filed, and on their extension abroad based on the annual budget set aside by the Board of Administration to cover the costs of filing and managing of patents and eventually of prototyping;
   - Provide opinions to University Authority on negotiations relating to the commercial exploitation of patent applications and/or granted patents;
   - Provide opinions on managing the patent portfolio and on the life of other registered titles during the post filing time, monitoring the implementation of the patents within the portfolio;
   - Provide opinions to the University Governing Bodies on the procedures, guiding lines and other standards relating to patentability.

6. Any time the Commission is called to express its opinion, it can employ any necessary measures of enquiry for the most appropriate and considered evaluation including, but not limited to, auditing any of the stake-holders.

7. In order to better evaluate any request for filing and/or any other title registration, the Commission, upon its members’ request, can invite any expert of the field or any academic or external consultant to participate in its sessions without voting rights.

8. The Commission, supported by the Research Office, monitors the progress of any industrial application of a patent by the Inventor or the successors in title, in order to verify the exact respective shares of the economic rights to which the University is entitled or the lack of implementation of the invention itself.

9. The Research Office in accordance with the Commission and the Inventor can avail itself of patent attorneys to fulfil any filing procedure. The patent attorneys are chosen on the basis of their professionalism, competence, celerity and cost-effectiveness.

Art. 5 – Procedure for requesting to file a patent application

1. The request to file an application for a patent in the name of the University must be forwarded to the Commission, through the Research Office, on proper forms as ratified by the Commission.

2. The patent proposal must contain the following information:
   a. A brief description of the invention;
   b. The name(s) of the inventor(s) and their position(s) with respect to the University;
c. The contribution to the results by each individual, in case of multiple inventors. This must be quantified, in order to determine the portion of rights owned by each inventor and subsequently the share of the profits deriving from the commercial exploitation of the invention.

d. A provisional evaluation of the patentability requirements of the invention in terms of novelty and inventive step;

e. A list of the industrial sectors potentially interested in the patent;

f. A list of companies potentially interested in utilizing or jointly developing the patent;

g. An estimate of the costs to fully develop the invention.

3. In all the structuring phases of a patent proposal, the Inventor can request the Research Office support. The Research Office offers the following services, availing itself if needed of the collaboration of external experts under confidentiality agreements:

   a. Evaluation of the state of the art using patent databases;

   b. Identification of the industrial sectors potentially interested in the patent;

   c. Preliminary analysis of the invention with respect of the patentability requirements, such as: novelty, inventive step, industrial application and sufficient description.

4. In the request for filing a patent application the Inventor must declare his/her commitment to:

   a. Transfer, by means of a contract, to the University all property rights regarding the invention according to the provisions of art.12 paragraph 6;

   b. Sign a release form for the economic treatment under the terms and conditions of the present Regulation;

   c. Not disclose in any form or at any location or event the object of the patent for 18 months from the filing date or three months from the filing date when the patent application is filed under fast tracking procedure. The Commission will collaborate with the Inventor to identify proper procedures to maintain the secrecy on the object of the patent and at the same time to allow publication of the scientific results, in the shortest time possible. Such publications cannot in any case refer to the technical teaching of the invention;

   d. Collaborate with the University in identifying any potential exploitation of the patent.

Art. 6 – Evaluation of the requests to file a patent application

1. Patent application requests are evaluated by the Commission.

2. The Head of the Department to which the Inventor reports to or with which he/she collaborates, takes part in the proceedings in an advisory capacity.

3. Any decision by the Commission must be taken by majority of its participants, within 20 days from the presentation of the request. In the case of a tie the President shall have the casting vote.

4. The Commission can request the Inventor to provide further documents deemed necessary to the decision making. In such a case, the 20-day limit for deliberation described in the previous paragraph is suspended until the requested documents are provided.

Art. 7 – Patent extension

1. Upon reception of the Search Report and in any case within eleven months from the filing date, the President convenes the Commission to evaluate the proposed extension abroad of the patent rights.

2. The Commission can request the Research Office to provide further information deemed necessary and/or useful to form its opinion.

3. The Research Office informs the Inventor of the Commission’s decision.

4. In case the Commission decides not to move forward with the extension or to limit the extension to specific Countries, unless differently agreed in the contract between the parties, the Inventor can proceed autonomously to extend the patent abroad, at his/her own
expenses. Nonetheless, the Inventor agrees to give to the University 20% of any profit derived from commercial exploitation of the invention in the Countries where the Inventor extends the patent.

Art. 8 – Confidentiality obligations
1. University personnel who in any way or form know about the invention and/or its know-how must maintain the strictest secrecy in regard to the invention, to avoid compromising the validity of the patent application.
2. External participants at the Commission proceedings must sign a non-disclosure agreement.

Art. 9 – Signature of the agreements for the exploitation of the inventions
1. All contracts relating to the transferring or licensing of a patent and all other agreements concerning the filing of a patent application are signed exclusively by the Rector or one of his/her representatives specifically appointed to the task.
2. All contracts exceeding the limits of the Rector’s autonomy require the approval of the Board of Administration approval, on the Commission’s proposal.

Art. 10 – External consultants
1. The University can avail itself of external consulting services for the procedures relating to preliminary searches, patent application filing and patent commercialization.

Art. 11 – Legal Actions
1. The University can enter into any legal action to protect the patent and/or to avoid any attempt to counterfeit the object of the patent, unless the licensee is responsible to take these actions and comply with the obligation, preventively communicating it to the University.
2. All disputes between the Inventor and the University will be decided exclusively by the Venetian court. The inventor expressly surrenders any rights to choose a court in a different jurisdiction.

TITLE II
INVENTIONS ACHIEVED BY UNIVERSITY INVENTOR-EMPLOYEE
Art. 12 – Obligations and rights of the employed personnel
1. It is the obligation of the Inventor-employee to respect the absolute confidentiality with regard to the results of the research, in case he/she intends to ask for patenting and not to use or disclose the invention and/or the associated know-how. This obligation is extended to any other person who collaborates in the research activities.
2. Failure to comply with the obligation to communicate as provided in art. 1 paragraph 5, of the present Regulation will be considered as violation of the loyalty obligation.
3. In the case the research as a whole or just in part is financed by private subjects or is the object of a specific project financed by public entities other than the University, ownership of the potentially patentable invention belongs to the University or to the third parties, with whom the University signed or will sign specific agreements. Moral rights on the invention remain with the Inventor.
   In this case, the Inventor must expressly request the Commission, through the Research Office, to file a patent application in name of the University, that will handle all the costs. The Inventor-employee retains the moral right to be recognized as the author of the invention. The University has the power to accept the Inventor’s request which will be evaluated by the Commission as indicate in art. 6 of the present Regulation.
   The University acknowledges to the Inventor 20% of the profit deriving from the commercial exploitation of the invention, deducting all costs of filing and managing the patent application, setting the respective amount aside in the Inventor’s personal research fund.
4. In case the research is wholly financed by the University, the Inventor has exclusive rights on the invention. The Inventor can decide whether to:
   a. File an application for a patent in his/her name, handling all the cost. In this case, the Inventor must promptly communicate his/her intention to the Commission through the Research Office.
   b. Request the Commission, through the Research Office, to have the University apply for a patent and to pay for the filing and managing procedures. The moral right to be recognized as the author of the invention remains to the Inventor-employee. The University has the authority to accept the Inventor’s request.

5. In case a patent application is filed by the Inventor in his/her own name, the portion of the profit, deducting all costs of filing and managing the patent application, to which the University is entitled to, referred to in art. 65 of the CIP, shall be 50%.
   If within five years from the date the patent is granted, the Inventor or his/her successors did not start industrial exploitation of the invention object of the patent due to their own fault, the University automatically and at no charge acquires the ownership of the patent and all exclusive rights concerning its commercial exploitation. The moral right to be recognized as the author of the invention remains to the Inventor-employee.

6. In case a patent application is filed by the University, the Inventor is entitled to 50% of the profit deducting all the costs of filing and managing the patent application. This portion can be raised to 70% if the Inventor-employee decides to set the amount aside in his/her personal research fund.
   All expenses regarding filing and managing the application and the annual costs to maintain the patent will be paid by the University.
   If within five years from the date the patent has been granted, the University did not initiate any commercial exploitation of the invention or the revenues of this exploitation are less than the costs to maintain the patent, the University can decide to stop the payment of the maintenance fees. The University will communicate promptly its decision to the Inventor, who will be able to acquire the ownership of the patent paying off the costs to register the transferring act.

Art. 13 – Exploitation of the invention
1. In case the Commission agrees to file the application as University, the University itself is bound to exploit the patent by means of transfer or licensing agreements or by the establishment of spin-offs.
2. During negotiations, University personnel must maintain the secrecy on the invention until the patent application is published (art. 5 paragraph 2 letter c).
3. In case of transferring of an application for which a patent has not been granted yet, specific restrictive provisions should be considered to limit University responsibility with regard to the validity of the patent and to define the non-interference of the patent with other titles owned by the University.

Art. 14 – Share of the profits between the University central administration and the department the Inventor reports to
1. It is being understood that the sharing percentages between University and Inventor are regulated according to art. 12. The University share, deducting all costs for the University (e.g. application filing and patent maintaining fees), will be divided as follows: 40% to the Department(s) the Inventor reports to and 60% to the University fund supporting research and internationalization of the results to finance the knowledge transfer activities.
2. The Department(s) the Inventor reports to can freely decide to employ its share within the range of its institutional activities.
3. The same apportioning of the profits is applicable to proceeds deriving from selling of goods containing the invention and/or defined in transferring agreements regarding research results which could be potentially covered by a patent.

**Art. 15 – Patent extension abroad**

1. Independently on what is understood in art. 7, the Inventor request to extend the patent abroad must be presented to the Commission within eight months from the Italian application filing date. The request must also indicate the Countries for which extension is sought after. The request must be completed with a report by the Inventor stating the technical, scientific and commercial benefits of extending the patent abroad.

**TITLE III**

**INVENTIONS BY NOT EMPLOYED INDIVIDUALS**

**Art. 16 – Rights and duties of personnel non directly employed by the University**

1. Individuals with no subordinate employment relationship to the University , who contribute to potentially patentable research results, within the range of activities of the projects or of appointments they have with the University are recognized as Inventors.

2. Individuals as defined in paragraph 1 must inform the Head of the Department they report to and the Commission of the invention. They must also not use or disclose the invention and maintain the strictest confidentiality regarding the evolution of the research.

3. Individuals as defined in paragraph 1 under a contract of collaboration with the University must abide by the contract provisions regarding inventions and invention Know-How. In the case it is recognized them the ownership on their invention by contract, they can request the Commission, through the Research Office, to file for a patent on behalf of University. In the case of acceptance by the Commission and if no other agreement is put forward in terms of compensation for the invention, the Inventor is entitled to the same rights and duties of Inventor regularly employed by the University (art. 12). The request for filing on behalf of the University will be evaluated according to arts. 5, 6 and 7 of the present Regulation.

4. If the request is accepted, the Inventor will commit him/herself to transfer, by means of a contract, to the University all property rights regarding the invention according to the provisions of art.12 of the present Regulation;

5. The ownership rights on inventions obtained by recipients of scholarships, post-docs and PhD students, within the range of activities object of their contract or fellowship belong to the University or to third parties with whom the University signed or will sign specific agreements.

6. All results obtained by Ph.D. students within the range of activities relating to their curriculum of study belong exclusively to the University which will decide whether to exploit, use and/or publish them. Moral rights on the invention remain with the Inventor/author. In this cases, the Ph.D. student, in agreement with his/her advisor, must promptly inform the University (at least six months before publication of his/her dissertation in the open access institutional database and/or six months before his/her dissertation defence) of the potential patentability of the results that have been obtained or will be obtained. The University will autonomously evaluate the information and decide whether to apply for a patent before the publication date of the Ph.D. student's dissertation in the open access institutional database. Before that date, the Ph.D. student must maintain the strictest confidentiality regarding the evolution of the research.

7. The University recognizes for the recipients of scholarships, the post-docs and the Ph.D. students, not only the moral rights on the invention, but also the sharing of the profits as provided for personnel with subordinate employment relationship as per art. 12 of the present Regulation.
8. Individuals with no subordinate employment relationship must accept in writing the provisions described in the present Regulation before starting their activity.

9. The ownership of inventions obtained by other individuals such as visiting professors/researchers within the range of their activities and in University structures is object of negotiation on an individual basis, between University, individual and individual’s Membership Institution

TITLE IV
INVENTIONS OBTAINED WITHIN THIRD PARTY CONTRACTS

Art. 17 – Relationships with contractors

1. In the case, where the invention is obtained within research activities performed under third party contracts:
   a. The Contractor can choose to file a patent application paying the relative fees and other costs;
   b. The application must include the University as co-owner of the future patent;
   c. The university and the Contractor will indicate the names of the inventors;
   d. At the same time the University and the Contractor will sign a transferring agreement, from the University to the Contractor, for the portion of the patent owned by the University or, as alternative, an agreement for the joint management of the patent. In the case of a transferring agreement, the Contractor must communicate to the filing office the acquisition of the full ownership of the title in order to fulfil the publication requirements.

2. The transferring or joint managing agreement must also indicate:
   a. That the Inventor is entitled to the moral rights on the invention and that the University can publish the results of the research once the application has been filed as agreed upon with the Contractor.
   b. After three years from the signing of the contract, the University can publish and disseminate the results obtained from the research activity even without a specific agreement with the Contractor, as long as there is no mention of any element that might contribute to identify it;
   c. Any time the Contractor refers to the research results, it must cite the University and the name of the University scientific supervisor.

3. In the case the research is obtained within the range of activities of a contract subscribed by the University and the Third Party for research fellowship funding, being understood the provisions of the present article, the ownership of the invention is assigned as follows:
   - Exclusively to the University if the funding is less than 70% of the total cost of the fellowship;
   - Jointly if the funding is equal to or more than 70% of the total cost of the fellowship.

To discipline the joint ownership of the research results, the agreement must define:
   a. The operational system of utilization/exploitation of the invention;
   b. The licensing and applicable royalties and the sharing of the profits deriving from the invention utilization;
   c. The potential limitations to the ownership transferring;
   d. Any other element pertaining to the invention and to the relationship between stakeholders in order to avoid any possible conflict of interest.

TITLE V
FINAL PROVISIONS

Art. 18 – Transitional provisions

1. For revenues deriving from licensing agreements not yet collected at time of publication of the present Regulation, the percentages indicated in art. 14 apply.
2. In the matter of patents, the provisions of the present Regulation overrule any other University regulation not compatible with the present Regulation.

**Art. 19 – Applicable law and conflicts resolution**

1. The interpretation and application of the present Regulation are governed by Italian law.
2. Any dispute regarding the interpretation and application of the present Regulation shall be referred to the exclusive competence of the Court of Venice, specialised section for enterprises.