

**Policy and Strategic Guidelines on Deploying Research and Intellectual Property Rights at the  
University of Milan – Bicocca**  
[Approved by the Board of Governors on 15 December 2015]

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**1. Introduction**

The instant document is predicated on the best practices as promulgated by the NETVAL (Network for Deploying University Research) of which the University of Milan-Bicocca is a member. This document has the triple goal of:

- outlining a **“University Strategic Initiative to Deploy Research and Intellectual Property Rights”** (whether independently or in tandem with the “University Strategic Initiative to Foster the Creation of New, Innovative Businesses”) might spark the acquisition, management, and conveyance of intellectual-property rights arising from the findings of activities conducted within the University in order to maximise the impact and ripple effect of investments in research and development not only for the University, but for the community at large;
- building a **“strategic, operational, and procedural hub for the acquisition, management, and conveyance of intellectual property rights arising from the findings of activities conducted within the University”** superseding the application the “University of Milan-Bicocca Regulation on Patents and Transfers of Technology” [promulgated by Rector’s Decree no. 8/6/2005, amended by a Rector’s Decree of 22/9/2006], without prejudice to Art. 18 “Formation of the Patent Council” [promulgated with Rector’s Decree no. 2276/2014 of 08/09/2014] of the aforementioned Regulation;
- ensuring the **“management of intellectual property generated by research activities”** in accordance with the guidelines and rules applicable to projects funded as part of the European Horizon2020 framework programme, with the aim of making programmes at the University of Milan-Bicocca better candidates for grant funding.

The instant guidelines have been shared with the Universities of Bergamo, Pavia, and Brescia pursuant to the “Convention for the Creation of a Research-Deployment Partnership”, signed by the aforementioned universities.

## 2. Legislative Framework

- Industrial Property Code (“CPI”), approved by Legislative Decree no. 30 (12/02/2005, as subsequently amended), Art. 65 in particular.
- Law no. 633 of 22/04/1941 “Protection of Copyright and Rights Relating to the Exercise Thereof” (Copyright Law).
- European Charter of Researchers

## 3. “Deployment of Research and Intellectual Property Rights” Strategic Initiative

The University of Milan – Bicocca Articles of Organisation “The aim of the University is to contribute to the development of society by promoting the cultural and civic growth of individuals and supporting a culture based on the universal values of human rights, peace, international solidarity and environmental protection. The University pursues this aim through scientific research activities, by **transferring** and **deploying its research findings** and through higher education.

Furthermore, pursuant to its own stated purposes, the University of Milan-Bicocca aims to spark and to incentivise creative activities, supporting all efforts by university researchers to protect their research findings and to make use of the same, as well as to identify and to coordinate (within the University) the most efficient methods of apportioning and deploying the rights to use these findings, whether independently, or in collaboration with other entities in the public and private spheres.

In accordance with such standards and objectives, the “Deployment of Research and Intellectual Property Rights” Strategic Initiative aims to:

- disseminate a culture of harnessing the value of University of Milan-Bicocca research findings, including by seeking legal protections for its intellectual-property rights;
- increase the economic, social, strategic, design, and innovative role played by the University of Milan-Bicocca in interactions with companies, businesses, and institutions, developing those tools that would allow for the effective application of the University of Milan-Bicocca’s research findings;
- create an integrated vision of the work to make proper use of University of Milan-Bicocca research activities through, for example, patents, trademarks, drawings and models, plant varieties, utility models, software, databases, know-how, projects;
- create an integrated vision of all parties, employees, and non-employees howsoever engaged in the process to create marketable products;
- identify the guiding principles from which the processes for acquiring, managing, and transferring intellectual-property rights arise;
- set the criteria for identifying the potential impact of the actions undertaken to deploy such research; these criteria shall be inspired by the tenets of transparency, the rights and responsibilities of researchers, and the rule that public interest trumps private interests;
- avoid the risk of inadvertent loss of intellectual-property rights, and the risk of infringing upon the intellectual-property rights of others;
- achieve the University’s training and research mission, by raising awareness of the tools and processes relating to intellectual property, and technological transfer amongst researchers, young graduates, and doctoral students, to provide professional development (for technical and administrative staff as well) that aligns with the expectations of the job market.

Within such strategic initiative, the University intends to promote activities and services to develop a culture in which the value of research findings is harnessed, and one in which the acquisition, management, and conveyance of intellectual-property rights is promoted and supported.

#### **4. “Intellectual Property” Plan**

The “Deployment of Research and Intellectual Property Rights” Strategic Initiative contemplates an “Intellectual Property Rights” Plan focussed on setting guidelines for the acquisition, management, and conveyance of intellectual-property rights.

##### **4.1. Definitions**

For purposes of the instant guidelines the following terms (when capitalised) shall have the following meanings:

- “University”: the University of Milan-Bicocca;
- “Research Activities”: any activity that might yield the creation or the attainment, by the Researcher, of one or more Intangible Assets, and which is (i) financed in whole or in part by the University, including any activities commissioned by third parties; or (ii) instituted as part of research programmes or projects in which either the University at large, or any one of its departmental units is participating, or (iii) conducted in an independent manner by the Researcher, but made possible through the use of University facilities or resources, be they economic or capital resources;
- “Intangible Assets”: the drawings and models, inventions, utility models, topographies of semi-conductor products, confidential information, plant varieties, trademarks and other distinctive signs, geographic indications, denominations of origin, and all creative works (including software programmes, databases, industrial-design works, engineering projects, etc.) as identified under applicable Italian and EU intellectual-property law;
- “Boilerplate”: standard contract provisions for the protection of intellectual-property rights, especially with respect to industrial-property rights, to be included in any contract for works commissioned by a third party, be it public or private. This boilerplate (which must be harmonised with any applicable University regulations) contemplate that the University share in securing and managing rights on all Inventions which are the fruit of such contracts;
- Intellectual Property: includes copyright and related rights; industrial property rights;
- “Intellectual Property Rights”: rights on Intangible Assets which are recognised or attributed by applicable Italian or European intellectual-property law, predicated either simply on the creation of an Intangible Asset, or following a procedure to register or patent the same;
- “Scientific Director”: the party, howsoever named, who assumes responsibility for the Research Activities;
- “Researchers”: first- and second-tier faculty, contract or permanent researchers, technical / administrative personnel on contract or on permanent hire, adjunct faculty, research fellows, doctoral students, students on research scholarships or on a stage, and all other associates howsoever named, as well as students at all levels of study;
- “Organisational Unit”: Departments, Schools, and other University facilities or components as defined in the University's Articles.

##### **4.2. Delegations of Authority**

When Intellectual Property Rights accrue to the University, all related management operations (including those aimed at safeguarding and deploying such rights), are carried out directly by University administration, to wit, the Research Deployment Office.

##### **4.3. Scope**

The instant Guidelines shall apply to University Researchers who have created or have otherwise attained an Intangible Asset within the course of performance of their Research Activities as well as any other course of performance of their assigned duties.

#### **4.4. Title to Intellectual Property Rights in Intangible Assets**

Intellectual Property Rights to Intangible Assets created or otherwise attained by a Researcher in the performance of Research Activities shall accrue to the University or to the Researcher who is the creator thereof pursuant to applicable provisions of law, or the contract governing the relationship between such Researcher and the University.

To wit, Intellectual Property Rights to Intangible Assets created or otherwise attained by a Researcher within the scope of any Research Activities shall accrue to the University when such Research Activities:

- are financed, whether in whole or in part, by private parties; or
  
- are generated within the scope of a specific research project or programme which is financed, whether in whole or in part, by public or private entities other than the University.

#### **4.5. Confidentiality**

Insofar as compatible with Researchers' interests in publishing the findings of Research Activities, Researchers are required to keep anything relating (whether directly or indirectly) to the Research Activities carried out strictly confidential to the extent required to safeguard University rights and interests, including cases in which the University must discharge duties assumed as against third parties.

Insofar as needed to protect University rights, the Researcher:

- shall refrain from disclosing anything directly or indirectly related to the Research Activities, and refrain from rendering them accessible to Third Parties in any way;
  
- shall use all suitable methods, and take all reasonably necessary steps in order to ensure that anything related (whether directly or indirectly) to the Research Activities is not freely accessible to Third Parties;
  
- work to promptly advise the Research Deployment Office of any fact which might lead to the statutory requirements allowing the Intangible Assets to be safeguarded by the University to lapse.

The duty of confidentiality shall not apply to:

- data, news, information, and knowledge whose publication or public dissemination would not infringe upon the rights or interests of the University;
  
- data, news, information, and knowledge which are, or which hereafter become, freely accessible due to acts or omissions by Third Parties;
  
- data, news, information, and knowledge expressly intended for publication;
  
- information which the Researcher is required to disclose or make accessible in the discharge of any statutory or regulatory duty, or in compliance with any order by the public authorities.

For purposes of application of the instant article, "Third Parties" shall include any person who does not have a specific reason or need to access information related (whether directly or indirectly) to Research Activities.

#### **4.6. Notice**

The Researcher who, as part of the Research Activities, creates or attains an Intangible Asset for which a patent, registration, or other legal protection is pending, shall notify the Research Deployment Office of the University using the designated form. Such notice shall be made by the Researcher's Scientific Director when the Intangible Asset was created or attained within the scope of any research projects or programmes in which the University or Organisational Unit thereof has participated.

Following the notice required under the immediately preceding paragraph, the Research Deployment Office for the University shall vet the following:

- Are the Intellectual Property rights held by the University or the Researcher (in the latter case: does the Researcher intend to offer to convey such rights to the University?);

- Might the Intellectual Property Rights be deployed in the interest of the University;
- Might the University exercise those property rights contemplated under Intellectual Property law?

#### **4.7. Conveyance of Intellectual Property Rights to the University**

Subject to the terms and conditions of point 4.4, *supra*, in order to ensure proper Deployment of the Intangible Assets created or attained within the scope of Research Activities, the University shall incentivise the conveyance of any Intellectual Property Rights originally held by Researchers to the University.

Conveyances of Intellectual Property Rights to the University shall always be voluntary. To that end, the Researcher may offer to convey Intellectual Property Rights to the University in that same Notice required under Art. 4.6 of the instant Guidelines. In such cases, the University shall have the right, but not the duty, to accept the offer of conveyance tendered by the Researcher. The University's assessment of such tender shall be conducted by an ad-hoc technical committee formed by the University. Should the University decide to accept the offer, it shall duly submit a Deed of Assignment of Intellectual Property Rights to the Researcher, which must then be signed by both parties. The division of any proceeds arising from the Deployment of Intangible Assets shall be determined pursuant to the terms and conditions set forth in Art. 4.10, *infra*.

#### **4.8. Deployment of the Intangible Assets Subject to Conveyance to the University**

In cases where Intellectual Property Rights to an Intangible Asset have been conveyed by a Researcher to the University as contemplated in point 4.7 hereof, the University shall, in cooperation with the Researcher, undertake those assessments deemed most apt in order to move forward with deploying the Asset.

Should the University fail, for five (5) years following such conveyance to take action to deploy the Intangible Asset subject to the conveyance, except where such lack of action is otherwise excusable, the Researcher may terminate the deed of assignment, and title to the Intellectual Property Rights conveyed through such instrument shall revert back to the Researcher. The Researcher who intends to exercise the option to terminate the deed shall be required, however, to reimburse the University for any documented expenses incurred to protect the Intangible Asset subject to conveyance, and all out-of-pocket expenses for such conveyance; moreover, in instance of any Inventions, Researcher shall pay the University those royalties contemplated under Art. 65, paragraph 2, Legislative Decree no. 30 (10 February 2005, as subsequently amended) of the Code of Industrial Property Rights.

#### **4.9. Research Projects or Programmes in which the University or Departmental Unit thereof is Participating**

For any research projects or programmes in which the University or Organisational Unit thereof is participating, and which are funded (whether in whole or in part) by private or public entities (other than the University), the Scientific Director shall be responsible for ensuring (with the support of the Research Deployment Office) that all Researchers involved in the Research Activities have previously conveyed their Intellectual Property Rights to the University.

#### **4.10. Division of Proceeds**

When the University moves forward with deploying the Intangible Assets, the University shall pay the following share of proceeds arising from such operations:

- 50% to the Researcher
- 20% to the Researcher's Organisational Unit (as of the time the Intangible Asset is legally protected through patent/registration or other protection). The share shall increase to 25% when the Intangible Asset is attained as part of a Commissioned project, the standards of which conform to those set forth in the contract Boilerplate;
- the balance to support University Research-Deployment activities.

The aforementioned percentages shall be deemed net of any costs borne by the University, and of any expenses borne by the University to protect, develop, and convey the Intangible Asset subject to conveyance.

Should the Intellectual Property Rights on an Intangible Asset accrue to multiple Researchers, the shares under the immediately preceding paragraph shall be divided amongst the same pursuant to the shares set forth in the conveyance agreement; where the agreement is silent on the matter, they shall be evenly split.

When a Researcher moves forward independently (or through a third party) to deploy an Intangible Asset whose Intellectual Property Rights are held or licensed by Researcher, Researcher shall pay the University 50% of the proceeds arising from such deployment operations.

The rule under the immediately preceding paragraph shall not apply where the Intangible Asset is a creative work protected by Copyright Law, unless otherwise agreed between Researcher and University.

#### **4.11. Research Deployment Office**

The Research Deployment Office is the entity which the University makes available to Researchers in order to ensure the best way to protect, and to harness the value of, any Intangible Assets created or otherwise attained by Researchers as part of any Research Activities.

To that end, the following persons may utilise the services of the Research Deployment Office:

- Researchers who have created or otherwise attained, as part of any Research Activities, the Intangible Assets to which the University holds Intellectual Property Rights pursuant to point 4.4 hereof;
- Researchers who have conveyed, or who intend to convey, Intellectual Property Rights to the University pursuant to point 4.7 hereof.

#### **4.12. Budget**

Each year, the University sets a budget to support Research-Deployment activities. Intellectual Property Rights (patents, for example) shall be acquired / managed using such budget, until such budget is fully utilised. Should such depletion happen during the year in question, the budget may be replenished pursuant to a report by the Deputy to the Rector charged with Research Deployment. Moreover, the Deputy to the Rector charged with Research Deployment shall each year generate a report on deployment activities, including all costs incurred, and any revenues from the deployment of such Intangible Assets, which report shall be presented to the Academic Senate and to the Board of Governors. The portion of proceeds arising from the deployment of Intangible Assets accruing to the University shall increase its available research-deployment budget.

### **5. Other Useful Documents**

In order to assist and to guide Researchers in harnessing the value of all research, and the management of intellectual-property rights, the following documents have been generated and made available on the University of Milan-Bicocca's website:

- Annotations on the Policy and Strategic Guidelines on the Deployment of Research and Intellectual Property Rights at the University of Milan-Bicocca. This document contains annotations from the Industrial Property Code, and from other documents, which are useful to setting the operating standards for such guidelines. Likewise, the processes used by the University of Milan-Bicocca to carry out the various phases of acquiring and managing Intellectual Property Rights are detailed.
- Forms. The following forms and templates are available:
  - disclosure form for the "Creation of an Intangible Asset";
  - offer form for Conveyance of Intellectual Property Rights to the University;
  - contract template for the conveyance of Intellectual Property Rights from the Researcher to the University;
  - conveyance form for use by researchers (especially contracted researchers) who are participating in, or otherwise implicated in, the Intellectual Property Rights arising from Research Activities financed whether in whole or in part by private entities, or by public entities other than the University.
- Inventor's Guide. This is a guide which illustrates Intangible Goods by identifying the characteristics, usages, requirements, and procedures to secure and to deploy the same.