



# Intellectual Property and Commercialisation

## 1. INTRODUCTION

This policy responds to the HEA requirements that each Research Performing Organisation (RPO) in Ireland adopts and disseminates a policy for intellectual property (IP) commercialisation that fulfils National IP Management Requirements, including Minimum Requirements for an IP Commercialisation Policy. Some relevant documents include the [Review of Implementation of Intellectual Property \(IP\) Policies within Higher Education Institutions](#) carried out by IP Pragmatics on behalf of Knowledge Transfer Ireland and the HEA, and the [Review of IP Management and Conflicts of Interest](#) by KTI and HEA which was published in 2018. This policy will fulfil the MIC institutional requirement to have its own IP commercialisation policy, and will also address the requirements of the HEA as the regulatory body of Irish Higher Education Institutions (HEIs).

## 2. REGULATORY AND LEGAL CONTEXT

In January 2019, an updated version of the National IP Protocol was published, which included the National IP Management Requirements, which should be adopted by all HEIs and RPOs in Ireland. This consolidated into one publicly available document previous recommendations by KTI and the HEA as to the minimum requirements for an IP commercialisation policy. Requirement 1 of the National IP Management Requirements is that each HEI must “Adopt and disseminate a policy for IP commercialisation that includes the Minimum Requirements for an IP commercialisation policy.” Further details about these minimum requirements are provided in the associated [IP Protocol Resource Guide](#).

In summary, it is directed that:

- All HEIs shall have in place a single policy for IP commercialisation
- This policy shall be reviewed at least every four years and within six months of any new or updated National IP Protocol or, for HEIs, the relevant Code(s)
- At the scheduled review date, all HEIs should carefully review their IP policy again against the Minimum Requirements laid out in the National IP Protocol

Further to the findings and recommendations of the 2021 review by KTI and HEA, all HEIs are asked to confirm that they have implemented a single policy for IP commercialisation, which incorporates the Minimum Requirements laid out in the [National IP Policy \(2019\)](#). HEIs are required to supply a copy of this policy document to the HEA and Knowledge Transfer Ireland.

## 3. SCOPE & PURPOSE OF THIS THIS POLICY

MIC staff produce IP in the course of their research and scholarship. Some IP may have significant commercial value for exploitation to the benefit of many. In other cases, IP may have little commercial value, but is a significant contribution to the body of academic knowledge and expertise in a variety of fields within higher education (HE).

In recognition of the unique status of a university level college and acknowledging a long-standing academic tradition, MIC does not assert ownership of IP that the College deems to be of a non-commercial nature. This includes pedagogical works, scholarly publications, books or artistic works of MIC staff, regardless of the form of expression.

This policy sets out how MIC will, at the request of a staff member(s), provide guidance and advice on how to engage in early identification of IP that holds (or may hold) potential commercial value. The policy is a practical tool to help manage commercialisation of IP created by MIC staff, specifically where such IP holds (or has potential) commercial value.

This policy adheres to national guidelines under the current National IP Protocol (2019) as required by the HEA. It demonstrates MIC's compliance with the national system for management of IP as a follow-up on the Review of Implementation of IP policies within HEIs.

This policy allows MIC to recognise and, where appropriate, cooperate with MIC staff in extracting and maximising IP holding commercial value. MIC acknowledges that this policy must be cognisant of, and compatible with, academic freedom in the context of academic work, including research, publications, teaching, and other activities undertaken by MIC staff.

This policy creates rights for MIC: it does not create any binding obligations. No obligations arising out of this policy shall bind MIC otherwise than in accordance with the terms and conditions of any agreements specifically agreed by MIC in writing.

This policy supersedes and replaces all other policies, protocols and practices whatsoever dealing with IP, its management and commercialisation at and by MIC. This fulfils the HEA requirement that "all HEIs shall have in place a single policy for IP commercialisation" (Letter to College Presidents Thursday, July 7, 2022).

The objectives of this policy include:

- to provide MIC staff who seek to develop IP holding actual or potential commercial value with clarity as to any mutual rights, entitlements and equity enjoyed by both MIC and those parties who originate IP arising out of their research and/or other work activities using MIC resources;
- to provide advice and guidance to MIC staff on the recognition of commercially viable IP arising out of their research and/or other work activities, and provide the resources for to them and MIC to maximise the marketability of IP holding actual or potential commercial value;
- to provide genuine incentives to MIC staff to identify and develop IP holding actual or potential commercial value arising out of their research and/or other work activities. This includes sharing in the financial benefits of such commercialisation with the creator/originator of IP holding actual or potential commercial value;
- to document a clear set of principles that facilitates the efficient transfer of knowledge and technology within MIC;
- to utilise MIC's share of the financial and other returns from the commercialisation of IP for financing and sponsorship of research, to advance and encourage research activities including further support similar and/or further phases of projects from which the revenue originated, and, where appropriate, the enhance the broader commercialisation and revenue strategy in MIC;
- to ensure MIC is compliant with the National IP Protocol (2012 and revised in 2016 and 2019) and national policies for the management, protection, and use of IP; and
- to provide the basis for a set of Standard Operating Procedures (SOPs) and internal controls enabling MIC to demonstrate its adherence to relevant legal provision and to reflect this in its Financial Statement and Statement of Governance.

Any queries in relation to this policy or the content of it should be addressed to the Research Office Manager, MIC [email [RGSO@MIC.UL.IE](mailto:RGSO@MIC.UL.IE)] in the first instance.

This policy applies in full to all MIC staff.

Where an actual or perceived conflict of interest arises in the implementation of this policy, that conflict will be managed in accordance with the MIC Conflict of Interest Policy.

#### 4. GLOSSARY OF TERMS

MIC	Means Mary Immaculate College
MIC staff	Means:

	<ul style="list-style-type: none"> <li>– any person in the employment of MIC (whether permanent, temporary, part-time, fixed-term, contract or otherwise);</li> <li>– any person engaged by MIC such as consultants and/or independent contractors engaged in MIC activities;</li> <li>– MIC post-graduate research students; and</li> <li>– any students registered with MIC that are engaged in MIC activities</li> </ul>
MIC work activities	<p>Means any one or more work activities (including, but not limited to, research, training and/or services) undertaken by MIC staff involving at least one of the following:</p> <ul style="list-style-type: none"> <li>– use of resources, facilities or equipment owned or controlled by MIC;</li> <li>– use of funding administered or provided by MIC;</li> <li>– use of IP owned or controlled by MIC; and</li> <li>– research in respect of which MIC is contractually obliged to ensure it owns the IP arising from such activities.</li> </ul>
MIC IP	Means IP created by MIC staff in the course of their employment and/or MIC work activities.
IP	Means property such as patents, copyright (written material, drawings, software algorithms and code etc), trademarks, service-marks, brand names, designs, domain names, databases, confidential information, trade-secrets and know-how, all specialist types of IP protection and any commensurate rights or property of any nature in any part of the world. IP allows the results of innovation and creativity (including research results) to be owned, similar to physical property. IP is a very broad concept including all forms of products whether or not these are capable of registration.
Background IP	<p>Means all IP, regardless of form or medium, which:</p> <ul style="list-style-type: none"> <li>– is created or obtained (e.g. through licence) independently of the research or project (as relevant); and/or</li> <li>– is created by any party prior to the beginning of the relevant research or project</li> </ul>
Foreground IP	Means all IP, regardless of form or medium, that is created during the course of research programmes or other projects or work activities.
Policy	Means this Intellectual Property Commercialisation Policy (PGP115, 2023)
Commercialise	Means the use of IP to create or develop commercial activity. The words 'commercialise', 'commercialisation', 'commercialised' and 'commercialising' are to be construed accordingly. Commercialisation may include, for example, licensing or assignment (if permitted by MIC) and may lead to a new company (e.g. a spin-out company) and / or the development of new or improved products or services.
IP Desk	Means the IP Desk established by MIC to undertake, amongst other matters, the duties set out in this policy.
IP Disclosure Form	Means the IP Disclosure Form in the format adopted by MIC.
Creator/Originator	Means the member or members of MIC staff who (whether alone or in conjunction with other MIC staff and/or one or more external parties) may be a creator/originator/developer/contributor in relation to IP holding actual or potential commercial value within the scope of this policy.
Relevant Contract	Means the agreement between MIC and an external agency, funder, industry partner or other organisation in relation to the performance of a programme of research or other activity.

## 5. OWNERSHIP OF INTELLECTUAL PROPERTY

### General

Cognisant of Section 3 of this policy, and in particular the College's recognition of the unique status of MIC as a university level college, and furthermore acknowledging a long- standing academic tradition, MIC does not assert ownership of IP that the College deems to be of a non-commercial nature.

### IP holding actual or potential commercial value

All IP (and any associated rights) created by MIC staff in the course of their employment and/or MIC work activities holding actual or potential commercial value, will be owned by MIC (or such companies or organisations nominated by MIC) and will constitute MIC IP.

For the avoidance of doubt, this principle applies to any IP created or developed by MIC staff:

- both during working hours and outside of those hours if related to or within the scope of the individual's duties (whether or not using MIC resources, facilities, or equipment);
- at any time when using resources, facilities or equipment owned or controlled by MIC;
- in relation to any work activities or research performed for or on behalf of MIC.

### Exceptions

This general rule applying to ownership of IP holding actual or potential commercial value that is created by MIC staff may be altered in individual circumstances. This would require entry into a specific contractual arrangement by MIC and the creator/originator by mutual agreement.

IP created by MIC staff assigned to a research programme funded by a third party or in collaboration with a third party may be required under contractual arrangements to be owned by that third party or there may be other contractual arrangements put in place that govern IP arising from that research and/or collaboration.

### Documentation and Reasonable Assistance

MIC staff are required to execute any and all documentation and to provide all reasonable assistance to MIC that, in each case, MIC considers necessary or desirable to secure, protect, perfect, or enforce any and all of MIC's rights, title and interests in and to IP owned by MIC and to otherwise to give effect to this policy and/or comply with MIC's obligations under a Relevant Contract. Therefore, from time to time, MIC may require MIC staff to enter into an agreement with MIC to regulate their relationship with MIC and to provide for a formal transfer of IP to MIC.

Originators may also be required to waive in writing any rights that they may have in respect of MIC IP.

## 6. MANAGEMENT AND PROCEDURES

### Disclosure Processes

All MIC IP holding actual or potential commercial value should be disclosed to MIC by completing and submitting an IP Disclosure Form. For the avoidance of doubt, many different forms of IP carry actual or potential commercial value, including software, databases, and some written materials, such as Handbooks, Manuals etc. Some valuable forms of IP can be overlooked, simply because they are not inventions.

Disclosure of such IP to MIC should occur in a timely fashion, at least within 30 days of creation or development of the IP where possible. The IP Desk will assist with initial queries from MIC staff who are creators /originators of IP holding actual or potential commercial value. It will be necessary for the IP Desk to know full details, including the contents of the Disclosure Form, to provide an informed

guidance. A Disclosure Form may be obtained from the IP Desk [email RGSO@MIC.UL.IE] [or from the RGS Intranet.

### **Protection of IP, Delays on Publication or Disclosure**

MIC staff shall do everything reasonable that is required of them by MIC (and at MIC's expense) to protect, maintain and realise the potential of MIC IP holding actual or potential commercial value.

MIC staff creators/originators must take reasonable measures to protect such MIC IP, and confidentiality in this respect is of prime concern. To protect IP with a view to commercialisation, it may be essential to delay disclosure and/or publication of research and/or the IP. Failure to maintain confidentiality of IP can lead to (a) a third-party claiming IP ownership themselves and/or (b) failure of a claim of ownership over IP.

The approval of the IP Desk is required prior to disclosure and/or publication of any MIC IP holding actual or potential commercial value. Any doubt in this regard should be raised with the IP Desk prior to disclosure or publication.

Full and complete records of IP and its creation process should be maintained by the creator/originator. This helps to define the IP and to protect and process it.

## **7. IP DESK**

The purpose of MIC's IP Desk (working closely with the IP Team) is to:

- provide informed general advice and guidance to MIC staff on all aspects of commercialisation of IP holding actual or potential commercial value;
- process Disclosure Forms submitted by MIC staff including a commercial assessment of new IP (which may require further information from the creator/originator or other party); and
  - consider and recommend the protection and prosecution of IP for MIC (including filing and management of IP applications and registrations);
  - consider and recommend approval of MIC support to commercialise and/or further develop IP, including deciding upon the appropriate exploitation route;
  - negotiate with third parties on development of IP (if applicable) and in the commercialisation of IP;
  - consider and, where appropriate, recommend MIC support the formation of spin-out companies;
  - consider and recommend not to proceed with an IP application and the process applicable;
- maintain a record of MIC IP and licences of MIC IP.

The IP Desk / IP Team will treat as confidential any Disclosure Forms and other information provided to it.

The IP Desk will be supplied with appropriate professional staffing and the IP Desk may draw upon relevant external and legal expertise as required.

### **IP Decision Making / IP Team**

The IP Desk reports to, and is directed by, the Research Office Manager, who in turn reports to the Vice President Research (VPR) and the IP Team.

The IP Team shall comprise:

- VPR (Chair); ROM; VPAA (or nominee); VPAF (or nominee); IP Desk Administrator
- Other members will be co-opted on a needs basis

The IP Team shall meet as necessary to consider business for implementation by the IP Desk. Decisions of the IP Team shall be taken on a majority basis. All decisions taken by the IP Team are subject to appeal to the President of MIC who may refer disputed decisions for legal advice. The President has the right to engage the advice of external experts in relation to the circumstances of any appeal and will normally respond with a decision within 30 days of referral to him/her of the appeal.

### **Conflicts of Interest**

Examples of conflicts of interest that may arise in connection with IP commercialisation are:

- influencing a contract or other favourable terms for a company in which they, or a connected person, have a financial interest;
- use of MIC resources or IP for personal benefit or benefit to a connected person, whether financial or non-financial;
- conducting business, employment, or activity outside of MIC which adversely affects or compromises their ability to perform their duties.

If an actual or perceived conflict of interest arises in connection with IP commercialisation, the conflict will be managed in accordance with the MIC Conflict of Interest Policy. If any member of the IP Desk, IP Team or otherwise has a conflict of interest in any matter to be considered by them, they are required under the MIC Conflict of Interest Policy to declare their interests and withdraw from consideration of such business.

### **Routes to Commercialisation**

A fast and efficient means of commercialisation is through licensing. With the assistance of the creator/originator, the IP Desk/Team may negotiate a licence with one or more third parties (on an exclusive or non-exclusive basis) and on fair and reasonable commercial terms. Similarly, the sale or assignment of IP may be an appropriate route to commercialisation. If the IP is sufficiently strong to support a new company, a spin-out company may be considered an appropriate commercialisation route. Further information on spin-out companies is set out in Section 8 of this policy.

### **Assignment of IP to the Creator/Originator**

If MIC determines it does not wish to protect and/or commercialise an item of disclosed MIC IP, or decides not to proceed with it, then the creator/originator may request MIC to formally assign its rights in the MIC IP to the creator/originator. If MIC grants any such assignment, which it may do at its discretion, the assignment will be on terms satisfactory to MIC and subject to:

- MIC receiving fair consideration arising from any successful commercialisation;
- reimbursement of MIC for costs and expenses incurred in relation to the development, establishment and maintenance of such IP;
- any conditionality MIC considers necessary to protect its reputation and academic activities;
- not infringing upon any third-party rights or law to MIC's satisfaction at its discretion.

For the avoidance of doubt MIC shall be free in all cases and at all times to dispose of any MIC IP holding actual or potential commercial value as it deems appropriate.

## 8. SPIN-OUT COMPANIES

The formation of a spin-out company may be a viable means for IP commercialisation. This may be considered by MIC if the IP Desk/Team consider the relevant MIC IP is best commercialised in this way. Should this be considered, the IP Desk will consult with the creator /originator. A MIC spin-out company would be a registered company based primarily on MIC IP holding actual or potential commercial value. Such a company may be promoted by MIC staff and/or external business partners, subject to the provisions set out in this policy.

An MIC spin-out company would require the approval of the MIC Executive Team. The process for the approval would require a detailed business plan to be prepared, a suitable management team to be identified and appropriate investment put in place. A spin-out company would require the terms of an exclusive licence for relevant MIC IP to be agreed between MIC and the spin-out company, providing for fair commercial royalty payments for MIC. MIC's ownership would not require an up-front payment and would be based on its licence arrangement and other supports provided to the spin-out company. MIC would expect to hold a minority interest of at least 15% in the spin-out company subject to a shareholders' agreement (or as otherwise agreed with the creator/originator and the proposed management team for the spin-out company), with the remaining ownership being held by the creator/originator and/or management team and/or investment entities. MIC may choose to dispose of its ownership of any spin-out company as it sees fit, subject to any agreed restrictions set out in finally agreed constitutional documents and a shareholders' agreement. Any financial gain from such disposal shall vest exclusively in and be for the benefit of MIC.

It is recognised that, in some cases, the creator/originator may cease to be a member of MIC staff, while in other cases, they may continue as MIC staff.

## 9. REWARDING ORIGINATORS

MIC is committed to providing non-financial rewards for the development of MIC IP holding actual or potential commercial value. These may include academic recognition, improvements in facilities and the provision of funding for research activities. MIC also acknowledges the importance of incentivising MIC staff to commercialise MIC IP holding actual or potential commercial value.

Where MIC IP is commercialised through licencing or sale, net income (after expenses incurred by MIC are deducted) will be made available for creators/originators of that IP. Direct expenses include all legal and other expenses and costs involved in protection and any subsequent investigation, development, and promotion, which will be deducted from the initial royalty income (including any milestone, maintenance, or lump sum payments). Net income distribution between MIC and creators/originators will be as follows:

Net income below €100,000	Net income above €100,000
MIC: 25% Creator(s) / Originator(s): 75%	MIC: 35% Creator(s) / Originator(s): 65%

If more than one creator/originator is involved any net income will be distributed in a manner agreed among the creators/originators themselves. This distribution is expected by MIC to be *pro rata* (i.e.

proportionate to the respective contributions made). In the absence of agreement among the creators/originators themselves, any income will be divided equally among the creators/originators.

If MIC IP is commercialised via a licence granted to an MIC spin-out company and the creator(s)/originator(s) hold an ownership interest in that spin-out company, then the share of any royalty income that results from the licence will be determined on a case-by-case basis.

## **10. DISPUTE RESOLUTION**

Any dispute that arises between MIC and the creator/originator of MIC IP holding actual or potential commercial value relating to that IP, or otherwise under or in connection with this policy, shall be subject to discussion between the creator/originator (and/or other relevant parties) and MIC with a view to agreeing a reasonable and fair resolution.

If the parties cannot resolve the dispute within 90 days of the date of commencement of discussions, one or more parties may submit the dispute for mediation by an agreed mediator, or a mediator appointed by the national Centre for Dispute Resolution. The cost of any such arrangements shall be born equally among the parties. Any disputes that cannot be resolved through mediation within 180 days shall be subject to resolution in the Irish Courts.

## **11. EFFECTIVE DATE**

This policy is adopted by an tÚdarás Rialaithe and becomes effective on and from 18 December 2023.

## **12. POLICY REVIEW**

A formal review of the policy will be carried out by MIC, in line with the national IP Protocol, at least every four years and within 6 months of updates to, or replacements of, the national IP Protocol or Code of Governance or any other significant change in national policy or guidance.

This policy shall be reviewed by An tÚdarás Rialaithe as required by any circumstances arising (such as the introduction of new regulatory or statutory measures).

This policy will be monitored on an ongoing basis by the VPR and MIC's IP Team, who may make such minor edits, amendments and other updates to this policy as reasonably required from time to time.

This policy, as amended from time to time, shall be posted on the MIC website and/or intranet. The policy and any amendments thereto shall be fully valid and effective from the date of posting.

<b>Revision</b>	<b>Document History</b>	<b>Reviewed By ET</b>	<b>Approved By UR</b>
0			UR2019#02
1	Amendment	ET2023#11	UR2023#05
2			
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