The research commercialisation office of the University of Oxford, previously called **Isis Innovation**, has been renamed **Oxford University Innovation**

All documents and other materials will be updated accordingly. In the meantime the remaining content of this Isis Innovation document is still valid.

URLs beginning www.isis-innovation.com/... are automatically redirected to our new domain, www.innovation.ox.ac.uk/...

Phone numbers and email addresses for individual members of staff are unchanged

Email : enquiries@innovation.ox.ac.uk

INTELLECTUAL PROPERTY, PATENTS AND LICENCES

These guidelines have been written for researchers at the University of Oxford to guide you through the patenting procedure and describe how Isis Innovation will market and commercially develop your work through to licensing.

This booklet is one of a series of five Guidelines to Researchers available from Isis Innovation Ltd (and at www.isis-innovation.com). These are:

* Intellectual Property, Patents and Licences
* Starting a Spinout Company
* Consulting Agreements
* University Proof of Concept & Seed Funds
* Isis Startup Incubator

I welcome any comments you have on how these guidelines could be made more helpful.

LINDA NAYLOR
MANAGING DIRECTOR
ISIS INNOVATION LIMITED
JANUARY 2016

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The Technology Transfer Company of the University of Oxford

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[version 20160303]

INTRODUCTION TO ISIS INNOVATION

Isis Innovation Ltd is the University of Oxford's wholly owned technology transfer company. Isis was established in 1988 and in 1997 started a major expansion phase. Isis manages the University's intellectual property portfolio, working with University researchers on identifying, protecting and marketing technologies through licensing, spin-out company formation, consulting and material sales.

Isis Innovation provides researchers with commercial advice, funds patent applications and legal costs, negotiates exploitation and spin-out company agreements, and identifies and manages consultancy and service opportunities. Isis works with researchers from all areas of the University: medical sciences, mathematics, physical and life sciences, social sciences and humanities.

Patents & Licensing Isis files around 100 patent applications on behalf of the University per year, manages over 1500 patent application families and has concluded over 3000 commercial deals since the year 2000. Isis licenses technologies to companies who invest in developing and selling products in a timely and ethical manner. Licensees are sought from all technology and business sectors on an international basis.

Creating New Companies Isis has assisted in the formation of more than 110 University spin-out companies, generating significant value in equity holdings for the University of Oxford. Isis works with University researchers to develop new business opportunities, identifying and sourcing investment, management and professional services.

Consulting Oxford University Consulting (OUC) offers access to the expert knowledge of University researchers and departmental services within the University. OUC is part of Isis, providing a professional service dedicated to finding cost effective solutions to consultancy needs. Areas of expertise include problem solving, data analysis, expert evaluation, due diligence, management and business development. OUC's activities meet the ISO 9001 quality assurance standard.

Material Sales Isis manages the negotiation of sales agreements for biological and physical science materials developed within the University.

The **Oxford Innovation Society**, founded in 1990, enables industrial companies to benefit from Isis' activities by having a 'window' on Oxford science. Members enjoy advance notification of all patent applications marketed by Isis, a regular newsletter, customised benefits, including seminars and needs analysis, and attend meetings and dinners, which provide a unique environment for constructive interaction between business leaders, investors and top University scientists.

The **Isis Angels Network** introduces private investors and seed/venture capitalists interested in investing in spin-out companies from the University of Oxford to investment opportunities. IAN is a not-for-profit company limited by guarantee, established by Isis in 1999. Members of IAN may also be interested in serving as non-executive directors, nominated by the University, on the boards of the new spin-out companies.

Isis has strong **University links** with all the parts of the University involved in technology commercialisation and enterprise. These include Research Services; Begbroke Science Park; Oxford Science Enterprise Centre; and Entrepreneurship Said at the Saïd Business School.

Isis Enterprise is a division of Isis, offering consulting expertise and advice in technology transfer, based upon Isis Innovation Ltd's success as Oxford University's technology transfer company. Isis Enterprise helps universities, research organisations and governments develop their technology transfer activities.

WHAT IS INTELLECTUAL PROPERTY?

INTELLECTUAL PROPERTY (IP) is ideas, information and knowledge; in the University context IP can be viewed as the results and outcomes of research. "Intellectual" because it is creative output; and "Property" because it is viewed as a tradable commodity.

INTELLECTUAL PROPERTY RIGHTS (IPR) are specific legal rights which protect the owners of IP. IPR can be subdivided into the following major categories.

1. **PATENT**

A legal monopoly lasting 20 years granted in exchange for describing an invention and paying fees to the Patent Office. A patent position is destroyed by public disclosure of the idea before a patent application is filed (except for a short grace period in the US). **Think patent before you publish.**

2. **COPYRIGHT**

Copyright applies to literary and dramatic works, artistic and musical works, audio and video recordings, broadcasts and cable transmissions. Copyright is also the usual way of protecting software, although some software may be patented if it is a functional part of an invention. Copyright arises automatically; it does not need to be applied for; and lasts 70 years after the death of the author.

3. **DATABASE RIGHT**

Database rights apply to databases which are not protected by copyright (an EU right only).

4. **DESIGN RIGHT**

Design rights apply to aspects of the shape or configuration of an article. Unregistered design right (which covers computer chips, for example) can protect internal or external features. In the case of registered designs, the features must appeal to and be judged by the eye.

5. **TRADE MARK**

A mark (logo) or other distinctive sign applied to or associated with products or services, which does not describe the products or services.

6. **CONFIDENTIAL INFORMATION**

Confidential information is knowledge which only you possess and which you have only revealed under a non-disclosure/confidentiality agreement.

IPR	COVERS	NEED TO APPLY?	MAXIMUM DURATION
Patent	Inventions	Yes	20 years
Copyright	Literary, musical, artistic works, & software	No	70 years after death of author
Registered Design	Image; look & feel	Yes	25 years
Registered Trade Mark	Name, logo	Yes	Unlimited
Confidential Information	Unpublished secret information	No	Unlimited
Database Right	Databases	No	15 Years

Successful management of IPR provides the means by which individuals and institutions are able to protect their creative output from imitators. An understanding of IP and IPRs is an increasingly important aspect of University and business life. Now, more than ever, IP is recognised as a tradable commodity.

WHERE DOES ISIS INNOVATION FIT IN?

Isis Innovation helps researchers in these areas:

*Identifying research output of potential commercial value
*Evaluating its commercial potential
*Protecting research output with IPR
*Marketing inventions
*Deal-making

These activities form the foundation of successful technology transfer, which can be described as stimulating contact between the owners and potential users of IP. Successful technology transfer is a team activity and we expect researchers to participate in the promotion of their inventions. This can become a time-consuming activity although it is also very interesting.

IDENTIFYING

This involves encouraging researchers to consider the commercial applications of research at an early stage and also working to identify novel, inventive and protectable aspects of research.

OWNERSHIP OF INTELLECTUAL PROPERTY

It is essential always to have a clear understanding of who owns IP arising from research activities. Establishing ownership of IP arising within Oxford University is the responsibility of Research Services (contact the Director, Research Services, University Offices). This involves establishing the 'trail' from: invention, to inventor(s), to employer (normally), to funding body (where research contract terms dictate). The University will assign (or license) to Isis Innovation IP which it owns where Isis is the chosen means of exploiting that IP.

EVALUATING

Technology transfer is a commercial activity and the money spent on patents is an investment from which a financial return is expected. Due to the early and complex nature of University research the return is likely to be long term and difficult to define. Nevertheless we need to establish clearly that a market (current or potential) exists before we spend money on patenting.

PROTECTING

Building defensible walls around inventions and other research outputs is essential. It is a complex and hence expensive activity. Isis manages a portfolio of patent families and has pursued initial applications through to granted patents on a global basis. Isis pays for filing and prosecuting patent applications, design rights and trademarks, using a range of patent attorneys and lawyers expert in high technology fields.

MARKETING

Isis uses its specialist searching skills and leads from researchers to identify potential commercial partners; prepares and distributes non-confidential marketing information and follows up potential leads.

DEAL MAKING

Negotiating and closing deals associated with licensing and spin-out activity for the development and exploitation of IP to optimise the overall benefit to the researchers, host Departments, the University and Isis. The resulting revenue is distributed according to University Regulations (see page 10).

THE TECHNOLOGY TRANSFER PROCESS (LICENSING)

Obtain this booklet from Isis; visit Isis www site; contact Isis and be put in contact with Isis Technology Transfer Manager.

Complete Invention Record Form (page 11 of this booklet).

Complete IP/1 and IP/2 forms and return to Isis.

Isis registers project and sends IP forms to Research Services for checking and assignment of University rights.

Isis together with the inventor assesses patentability and commercial value. Should it be patented?

Yes

No

Isis instructs patent attorney to draft patent application.

Isis explains alternative strategies.

Patent attorney drafts patent application; Isis Technology Transfer Manager and Inventor approve it.

UK patent filed

30 days minimum

General Marketing Launch

Oxford Innovation Society Marketing Launch

Isis liaises with inventor(s) and reviews options.

Isis enters into discussions and negotiations with interested parties.

Isis negotiates and concludes Licence agreement.

PATENTS

A patentable invention must be new, inventive, capable of industrial application and must not fall into an excluded category (e.g. artistic creations, mathematical methods, some computer programs, and business schemes). Isis Innovation and its patent attorneys will help with determining the question of patentability. Establishing whether an invention meets these criteria is a complicated, time consuming and expensive process. Although patenting is expensive (e.g. over £40,000 over five years), the rewards may be significant. If inventions are not properly protected, rights may be lost irretrievably.

1. THINK PATENT BEFORE YOU PUBLISH

The opportunity for obtaining a patent can be lost by publication of the underlying research. No information on an invention should be made available to the public in any way anywhere in the world prior to a patent application being filed. This includes publication in grant applications, journals either as articles or as letters, oral presentation at seminars, or information posted on the Internet, abstracts, theses, e-mails, poster displays, exhibitions, open days, or confidential disclosures to many people. Any "enabling" information about an invention which is published in any way will constitute a disclosure and weaken or destroy its patentability. An enabling disclosure is one which provides the means by which someone skilled in the subject could reproduce the work about to be patented.

Patent provisions in the USA are different (until the America Invents Act of 2011 they operated a *first to invent* system, rather than the *first to file* system), and if the invention has been disclosed, Isis and its patent attorneys will advise as to whether it is still possible for valid patent protection to be secured in the USA.

Isis will not prevent you from publishing your work. A patent application can be prepared and filed quite quickly (days, more normally weeks) once a patent attorney has been instructed. As soon as the patent application has been filed there is no restriction on subsequent publication of the invention, subject to the points below.

Following filing an initial patent application no information which is new or additional should be published without first checking with the patent attorney involved in the case. It is possible that the new information could be included in the patent application. If the information needs to be included in the patent application the only way this can be done is by way of a new updated application; and the same requirement for novelty as discussed above will apply in so far as the new application is concerned.

If there is a risk that necessary development work or securing necessary investment may take more than one year from the filing of the patent application, the invention should not be published or otherwise made available to the public during that year. Any new patent applications filed in the UK within a year of the filing date of an original patent application for the same invention are entitled to claim the filing date of the original application. After the first year it is no longer possible to claim priority, and any publication of the invention during that year could be used to challenge the validity of any subsequent application filed outside of the first year. This is important in case it becomes necessary for the original application to be abandoned in favour of a new application with a new filing date.

2. PREPARING THE PATENT APPLICATION

In completing the Invention Record (see page 11) you will be providing to Isis Innovation important information to help the patent attorney draft the application.

In preparing a patent application the attorney is required to draft a specification which describes the invention in detail and highlights those features of the invention which are new and inventive over what is already known. At least one way for the invention to be put into effect should be included in the specification. Hence information on experimental examples and/or prototypes, although not essential, may make the difference in successfully securing valid patent protection.

The patent application will aim to describe the work in as broad a way as possible, so as to avoid others easily 'inventing around' your work. You will be encouraged to speculate as to the possible uses of your work to a level beyond that in an academic publication. The application itself will be published 18 months after filing.

It is possible to describe more than one related invention in a single patent application. In due course, however, the inventions will need to be divided out into separate applications, as a patent is only granted on a single invention. Isis and its patent attorneys are able to advise on this.

3. INVENTORSHIP

It is essential to identify accurately the people who made the invention(s) described in the patent application. Inventorship is a matter of legal fact, not opinion. It is unusual for an invention to be made by more than two or three people. Whilst those associated with research may be included as authors on academic publications, only true inventors may be included on patent applications. If inventorship is recorded wrongly, this may be enough for the patent authorities to refuse grant of or revoke a patent. Isis and its patent attorneys are able to assist in discussions to establish correct inventorship.

4. SEARCHING

Patent applications and granted patents are published by patent offices around the world and are publicly available documents. Published patents provide a wealth of information which researchers may wish to access for a number of reasons:

*assessing the likelihood of your own work being patentable over the existing publications;

*exploring the way patents are written to clarify the scope of an invention;

*part of a 'literature search' when embarking on a research programme;

*assessing the likelihood of planned commercial activities infringing existing patents.

Patent applications are published 18 months after they are filed. The published patent information can be accessed free on a number of www sites:

United States Patent & Trademark Office - http://portal.uspto.gov/external/portal/pair

UK Intellectual Property Office - http://www.ipo.gov.uk/

European Patent Office – http://www.european-patent-office.org/index.en.php

Japanese Patent Office – http://www.jpo.go.jp/

Google Patents – www.google.com/patents

World Intellectual Property Organisation - http://www.wipo.int/portal/index.html.en

Australian Patent Office - http://www.ipaustralia.gov.au/patents/search_index.shtml

Canadian Patent Office - http://brevets-patents.ic.gc.ca/opic-cipo/cpd/eng/introduction.html

Isis is able to assist in patent searching.

5. KEEPING A LABORATORY NOTEBOOK

It is only in 1996 that it became possible to prove a date of invention for US Patent purposes from evidence produced outside the US. In order to take advantage of this change in US Patent law inventors must follow certain guidelines.

Under US Patent law, an inventor must provide evidence of the following in order to prove a date of invention: date of conception of the invention; reduction to practice of the invention; diligence in achieving reduction to practice. The evidence which an inventor requires may be in a variety of forms but is frequently contained in a laboratory notebook.

In order to provide irrefutable evidence the following procedures are required in keeping a laboratory notebook: Permanent binding (not loose-leaf or spiral bound); Numbered pages; Good paper quality; Permanent ink (not pencil); Legible and factually complete entries; Describe all experimental procedures, giving conditions of experiment and apparatus; Ensure each page is signed off and dated by the author and witnessed as soon as possible (the witness should be someone who understands the area of research but who is not directly involved and cannot be considered to be under the control of the author); Do not leave any gaps, pages undated unsigned or unwitnessed. Isis and its patent attorneys are able to advise on this issue.

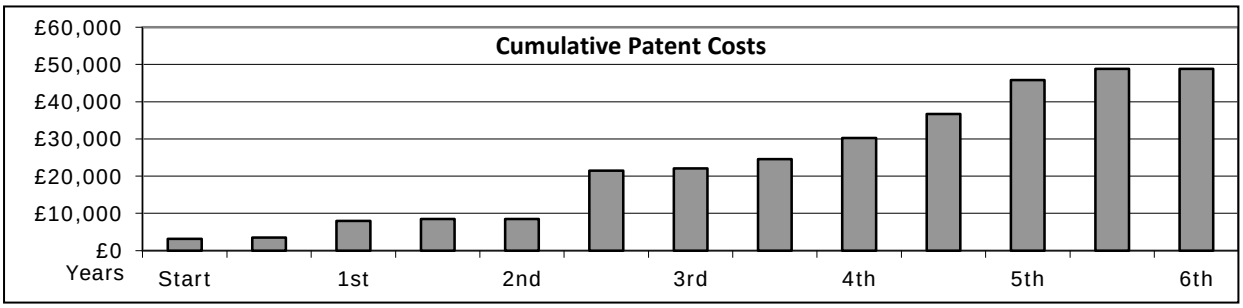
6. PATENT APPLICATION PROCEDURE

Most Isis patent applications are filed first in the UK, which establishes an international ‘priority date'; then after 12 months international protection is sought via the Patent Co-operation Treaty (PCT). This enables filing of a single patent application to establish protection in a range of countries. It simplifies international patent filing and

prosecution, and defers costs. Over one hundred countries have signed the PCT, and these can all be designated in one patent application. In addition Isis may file a separate US patent application to protect better this important market.

The maximum life of a patent in most countries of the world is 20 years from the initial filing date. Further protection can sometimes be achieved for some products in some markets (e.g. Supplementary Protection Certificates).

TIMESCALE	ACTIVITY
Start	Patent Application filed in UK; Priority Date established; Further exemplification of the invention must be done within the next 12 months, this period being crucial for adding value to the patent. **THE OPPORTUNITY FOR OBTAINING A PATENT CAN BE LOST BY PUBLICATION BEFORE FILING.**
1st year	Updated Application filed; At this stage more data can be added to the invention; Overseas countries are designated under the PCT system
1.5 years	Patent Application published with search report.
2 years	Patent Examiner report received
2.5 years	National Phase entry – key, expensive, decision point about which territories to pursue. Commercial interest is important to justify continued investment at this point.
3-6 years	The patent attorney working with the Isis Technology Transfer Manager, inventor(s) and the examiner to negotiate and agree the Patent claims. The patent is granted / refused in each of the designated countries
4 – 20 years	Annual renewal fees payable



Isis Innovation and its patent attorneys are able to assist and advise on all aspects of patenting.

MARKETING, COMMERCIAL DEVELOPMENT AND CONFIDENTIALITY

When potentially valuable technology has been identified and protected, Isis Innovation works closely with the inventors to commercialise the technology. This involves identifying the right partner for the commercial development and exploitation of the technology in the marketplace. It is easy to choose the wrong partner and a number of considerations should be addressed when choosing partner(s). Examples are: sufficient resources to take the technology to market; real intent to develop the technology as it may compete with in-house programmes; and awareness of access of the final products, where applicable, to developing countries. This last point, involving partly ethical concerns, is of particular relevance to human healthcare technologies and researchers should discuss with Isis appropriate measures which can be taken.

Isis Innovation will write a one page, non-confidential, summary of the invention in conjunction with the inventor which is initially distributed to the members of the Oxford Innovation Society, a group of leading industrial companies and potential investors.

One month after launching the technology to the Oxford Innovation Society, Isis then contacts other potential licensees and publishes the opportunity on the Isis web site. We actively encourage networking between potential licensees and researchers, and welcome commercial leads from researchers.

Following expressions of interest from companies, Isis will arrange meetings to discuss possible commercial transactions with a view to entering into option, evaluation or licensing arrangements. Such arrangements may also involve the funding of further research in the researchers' laboratory.

ACCESS TO ESSENTIAL MEDICINES IN THE DEVELOPING WORLD

The University of Oxford and Isis are mindful of the importance of development and distribution of new health-related technologies for less developed countries. The University's policy when licensing its technology for commercial exploitation purposes is, as far as is practicable:

1. to prosecute patent applications in less developed countries only as necessary (for example, to provide development and marketing leverage for new products, or to exert leverage over global licensees); and
2. to grant licences with provisions that seek to increase the availability of medicines at affordable prices to less developed countries.

The University expects its commercial licensing partners to appreciate and cooperate with this policy.

CONFIDENTIALITY AGREEMENTS

Unless published for academic reasons, it is very important that researchers do not discuss their inventions with third parties without the protection of a confidentiality (or non-disclosure) agreement (available from Isis). This is the case even when a patent application has been filed.

Outline or selected information about the technology is possibly of value to companies and can be obtained by companies from preliminary discussions with researchers. Confidentiality Agreements are necessary when you wish to disclose confidential information to a company in the early stages of discussions which may lead to research collaboration, or licensing of intellectual property.

Keeping information confidential until it can be protected by, for example, patents is often essential in establishing links with industry. It is far harder to encourage a company to fund research or to licence technology if the company has no privileged or exclusive access to the research work.

LICENSING

Licensing enables Isis Innovation to maintain ownership, and therefore control, of the University's IP whilst at the same time generating royalty income from the use of the IP by industry. A licence is an agreement involving the transfer of rights from one party ("the licensor") to the other ("the licensee"). These rights commonly control the use (for copying, manufacture, sale etc.) of an IPR (a patent, copyright material, confidential knowhow etc.).

A licence deal may include a lump sum payment for the right to exploit the invention (either exclusively or non-exclusively), usually in a particular market or for a particular purpose (referred to as the "field"), plus a royalty on the licensee's sales. The deal may include a consultancy or service arrangement under which the inventor gives the company assistance in setting up work in its own laboratories. Isis Innovation supports academic staff undertaking consultancies through Oxford University Consulting. OUC manages all the contractual and administrative aspects of consultancy, minimising the administrative burden while protecting your interests and those of the University. We also support departments to undertake departmental consulting and services work. The deal can include a research contract with the University, and this would be managed through Research Services for the University.

There are certain terms of a licence which **affect you directly**: confidentiality, improvements, and publication. Please discuss these issues with your Isis Technology Transfer Manager.

Confidentiality: the terms of the licence agreement (and occasionally its existence) and information about the licensee's development and commercial plans and activities are confidential to protect the University's and the company's interests.

Improvements: licensees expect access to improvements in the technology so they can sell more, better products and to protect against your future ideas going to a competitor. The risk is the creation of a 'pipeline' through which your future ideas are pre-sold to a single company, who may in future become an unsuitable commercial partner. Isis limits the definition of 'improvements' to ideas by named individuals, within two years, within the scope of the licensed technology.

Publication: companies sometimes insist on the right to review papers before they are submitted for publication; Isis limits any delay to up to 3 months.

SOFTWARE LICENSING

Isis Innovation has a strong portfolio of software technologies which are licenced to commercial organisations on an exclusive or non-exclusive basis. Researchers who wish to obtain clearance to publish and share their software though open source licensing should contact Research Services.

REVENUE SHARING FROM LICENSING

For each piece of intellectual property, the revenue from successful exploitation by Isis Innovation (whether lump sums or royalties, from option, licence, assignment or other agreements), is:

*first subject to repayment of external project costs (inc. patenting (page 8), exploitation, legal);

*Isis then retains 30% as a contribution towards its ongoing costs on this and other patents;

*the remainder, i.e. 70% of the net licence income, is then passed on to the University for distribution to the researchers, General Fund and Department, in accordance with University Council Regulation 7 of 2002.

TOTAL NET REVENUE	RESEARCHER(S) TOTAL	GENERAL FUND	DEPARTMENT	ISIS
To £72k	60%	10%*	0%	30%
£72k to £720k	31.5%	21%	17.5%	30%
Over £720k	15.75%	28%	26.25%	30%

(Effective since 1st April 2003. *This figure is intended to enable the University to pay Employer's National Insurance Contributions but otherwise leave the General Fund out of distribution in that band).

INVENTION RECORD

Project number: (for Isis use)

The invention record is a written description of your invention. It fulfils several important purposes:

- It helps Isis to assess whether the work is patentable;
- It helps the patent attorney to prepare the draft patent, if Isis decides to proceed with patenting;
- It helps give Isis and the University's Intellectual Property Due Diligence team an early indication as to the University's ownership of your invention, and identify issues which will need to be addressed downstream; and
- It provides an important record of the date of invention, which can become important in future patent process.

IMPORTANT: Discussions between you and Isis about your invention are confidential. To avoid any inadvertent public disclosure of your invention please consider all discussions about the invention confidential. Please use Confidential Disclosure Agreements to protect discussions with anyone outside the University. Please ask Isis for advice.

Please answer the following questions, either on these two pages or on separate sheets.

1. Descriptive Title of the Invention.

Please type here

2. Who was involved? Please tell us for each individual who contributed, invented or authored (if software):
    a. Their names and if any are foreign nationals;
    b. Who their employer is, and if this is not Oxford, are any contracts or arrangements in place?
    c. What they contributed to the development of the technology (e.g. came up with the original idea; designed experiments; carried out experimental work; wrote code)

Name	Nationality	Employer(s)	What did this person contribute?

IMPORTANT NOTE: Inventors must be legal inventors according to the definition in patent law (please ask your Isis Technology Transfer Manager for guidance if necessary). Software Authors are those who actually wrote the code and thereby created the copyright. The University also has a mechanism for rewarding contributors who are not inventors or authors but who have made a significant and identifiable contribution to the intellectual property, and revenue distribution to all individuals is dealt with through the IP2 form.

Please add rows or supply further detail on a separate sheet if there is not enough room.

3. Please tell us about your invention:

What do you think your invention is? What will your invention be used for? What are the advantages of your invention and how does it improve on the present situation? What is new about your invention? How and why does it work? What is the science behind the invention? Are there any other uses of the invention?

4. Are you aware of any companies who have an interest in the area, e.g. companies who sponsor research or who attend relevant conferences? If so, please supply the companies' names (and contact details, if you have them).

Please type here

5. Do you know of any published literature (including patents) relevant to your invention? Have you done any searching for published literature, and if so where? Please provide any details.

Please type here

6. Please tell us the story of the development of the invention:

When and where was the invention first conceived? When was the invention first reduced to practice? What practical work has been done to date on the invention? Has the invention been tested in the laboratory or has it been used? If so please give results. Who did what in the development of the invention?

7. What are your future plans for developing the technology? Do you have funds in place for this work, and what do you think you will achieve in this area in the next 12 months?

Please type here

8. Who have you told about the invention? When did you do this and where?

Please type here

9. When did you first describe the invention in writing or electronically? Do lab book records exist, or personal notes?

Please type here

10. Have you published, verbally, electronically or in writing, anything relevant to the invention, and if so when and what? Please tell us about abstracts, web pages and presentations as well as any published articles.

Please type here

11. Do you have plans to publish the work? If so, what is the timescale and where will the publication take place? If a draft paper exists please provide a copy.

Please type here

12. What is the funding background of the work you've done on the invention? Did you use any equipment, materials, samples, gifts or other in kind support provided by third parties, or biological materials obtained from humans? If so, please give details; specifically: was patient consent obtained?

Please type here

For inventions that include **software** please provide the following additional information.

13. Please provide the software application name and version number.

Please type here

14. For source code developed by the researchers identified in question 2 above:

List any third party software code, software libraries or tools that were or *are used by (called on by)* the technology or its development (this may include third party software called on by the technology, development tools such as the IDE, language or compiler).

Which organization owns each piece of software?

How was each piece of software obtained?

What source files were used? Please provide a list.

Which programming languages were used?

Please provide details of the licence terms and any copyright protection notices, or if it was a standard Open Source licence please provide the name of that licence.
GPL / BSD / MIT / Apache / other (please say what)

Please provide any licensing information available on the software(e.g. a hyperlink)

For new versions, which source files have been changed, added or removed since the previous version?

What documentation or other files are required for others to use, develop and maintain the software? Please provide a list.

Please indicate if the source files have been distributed outside the University, and if so, in what form and to whom?

Are the source files are available as a web download? If so, please provide the download URL and state the terms under which the download is available.

15. For other source files or libraries that are required to build the software application (external software):

List any third party software or software libraries *included in* the Subject Technology (this may include, for example, static libraries or source code copied from pre-existing sources) Which organization owns each piece of software? How was each piece of software obtained? What source files were used? Please provide a list. Which programming languages were used? Please provide details of the licence terms and any copyright protection notices, or if it was a standard Open Source licence please provide the name of that licence. GPL / BSD / MIT / Apache / other (please say what) Please provide any licensing information available on the software(e.g. a hyperlink)

Please sign and date the Invention Record below.

Signature:

Name:

Date:

The completed form should be returned to:
Buxton Court, 3 West Way, Oxford OX2 0SZ
T +44 (0) 1865 280830
F +44 (0) 1865 280831
E innovation@isis.ox.ac.uk

The next steps are for an Isis Technology Transfer Manager to discuss the invention with you. Further detailed forms are required to establish correct legal ownership of the intellectual property rights.

IP FORMS

The Invention Record is an important first step in creating a written description of your invention.

The IP/1 and IP/2 forms (included in this booklet and available from the Isis Innovation website) must also be completed, signed by all researchers and returned to Isis for onward transfer to the University's Research Services to audit University ownership. It is not Isis policy to suggest delays to academic publications; so patent applications need to be filed in good time.
The next pages contain two sample Forms:-

1. IP/1 Intellectual Property Due Diligence Form
2. IP/2 Intellectual Property Income Distribution Form

Blank forms can be obtained from Isis Innovation (including a downloadable version on our website www.isis-innovation.com), Research Services, Wellington Square, or your departmental administrator.

IP/1 INTELLECTUAL PROPERTY DUE DILIGENCE FORM

Isis project number:

BEFORE COMPLETING THIS FORM, PLEASE READ THE GUIDANCE NOTES AT THE END.

IMPORTANT: Discussions between you and Isis Innovation Limited ("Isis") about your technology are **confidential**. To avoid any inadvertent public disclosure of your technology please consider all discussions about the invention confidential. Please use Confidential Disclosure Agreements to protect discussions with anyone outside the University. Please ask Isis for advice.

SECTION 1: WHO IS INVOLVED AND WHEN WAS THE INTELLECTUAL PROPERTY DEVELOPED?

1. Working title or brief description of the intellectual property:

2. Your title and full name:

3. Please list all the individuals who you consider to have made an identifiable significant contribution to the intellectual property[(a)]

Name	**If person listed is not a member of the University of Oxford, please provide contact details for the individual and for their university or technology transfer office or employer**

If you have listed anyone who is not a member of the University, please indicate if there is a collaboration agreement or other type of written record in place which establishes the terms of the joint work.

☐ **Yes** ☐ **No**

If **YES**, please provide a copy of each contract if you have them, or full details. This is to help us to locate copies of contracts if you are unable to provide a copy:

4. Period of your research **directly** relevant to the creation of the intellectual property (inventive period)[(b)]:

From: (dd/mm/year)	To: (dd/mm/year)

SECTION 2: WHAT IS YOUR EMPLOYMENT HISTORY?

5. Please provide details of the history of the position(s) you have held **at** the University during the inventive period set out in question 4 above:[c]

Position(s) you held at Oxford[d]	**Oxford Department and/or Unit[e]:**	**Period you held this position: From**	**To:**
		(dd/mm/year)	(dd/mm/year)
		(dd/mm/year)	(dd/mm/year)

If you were a visitor or on secondment, please also answer the following[f]:

Which institution or company you were visiting or on secondment from?

Is there a visitor's or secondment agreement?

☐ **YES** ☐ **NO**

If YES, please provide a copy of each contract if you have them, or full details. This is to help us to locate copies of contracts if you are unable to provide a copy:

6. Please provide details of positions you have held **outside** the University during the inventive period set out in question 4 above, if any[g].

Position(s)[h]	**Name of academic institution, company or organisation, and contact details[i]**	**Time period From:**	**To:**
		(dd/mm/year)	(dd/mm/year)
		(dd/mm/year)	(dd/mm/year)

SECTION 3: HOW WAS YOUR WORK FUNDED AND WAS THERE ANY ADDITIONAL SUPPORT?

7. What funding was used in **direct** support of your work which led to the creation of this intellectual property?[j]

Principal Investigator on grant/contract[k]	**Funder**	**Project title**	**% funding contribution[l]**	**Reference number[m]**

8. Did the research relevant to the creation of the intellectual property above benefit directly from any non-monetary or other in-kind support, such as the provision of equipment or the supply of materials by other parties?[n]

☐ **YES** ☐ **NO**

If YES, please provide a copy of each contract if you have them, or full details. This is to help us to locate copies of contracts if you are unable to provide a copy:

9. Are you aware of any other legal or contractual obligations directly relevant to the intellectual property which are not cited above, whether past, present or currently under negotiation? [o]

☐ **YES** ☐ **NO**

If YES, please provide a copy of each contract if you have them, or full details. This is to help us to locate copies of contracts if you are unable to provide a copy:

10. Please indicate below if any part of the invention was made using biological materials obtained from humans.[p]

☐ **YES** ☐ **NO**

If YES, please provide an example of the patient consent form.

SECTION 4: DECLARATION AND SIGNATURE

IMPORTANT NOTICE: THE INFORMATION WHICH YOU PROVIDE ON THIS FORM WILL BE USED BY THE UNIVERSITY AND ISIS TO ASSESS THE OWNERSHIP OF INTELLECTUAL PROPERTY RIGHTS, POTENTIAL THIRD PARTY CLAIMS TO THOSE RIGHTS, AND OBLIGATIONS TO EXTERNAL FUNDERS. INCORRECT OR INCOMPLETE DETAILS COULD LEAD TO LITIGATION. THE REDUCTION OR LOSS OF EXPLOITATION REVENUES, OR THE INVALIDATION OF PATENT APPLICATIONS.

DECLARATION

I declare that the information which I have provided in this form is, to the best of my knowledge and belief, correct and complete.

SIGNED by the individual named in 2 above:

Signature: _____

Date: _____

Guidance Notes for Completing the IP1 Intellectual Property Due Diligence Form

The purpose of the IP1 form is to record and provide information to assist the University in determining the legal title and any potential third party claims to, or third party rights in connection with, intellectual property rights associated with the new technology. Each member of the University (employee, student, retired employee) or individual who used University of Oxford facilities (as a visitor, or on secondment, or under an honorary contract) who contributed to a new invention or other intellectual property ("IP") must complete an Intellectual Property Due Diligence Form (IP1). If in doubt, please disclose all information believed to be material to the creation of the IP in question. You may wish to check with your department administrator for copies of contracts or grants listed by you, or for full details of the same.

It is important that you provide an answer to all questions. Gaps or inconsistencies raise questions that will need to be checked by the University, and this will slow down the process of commercialising your technology. If you do not understand a question or need help in filling in the form, please ask your Isis technology transfer manager for assistance.

In the event that Isis is unable or unwilling to take forward the commercialisation of the IP, subject to the rights of third parties (including any collaborators or funders of research relevant to the creation of the IP), it will be offered to individuals in accordance with the Statutes and Regulations of the University of Oxford.

SECTION 1: WHO IS INVOLVED AND WHEN WAS THE IP DEVELOPED?

The purpose of this section is to establish details of the individuals who created the IP and the time frame during which it was created.

Question 1

Self-explanatory.

Question 2

Self-explanatory.

Question 3

(a) Please provide details in the box on the form of all individuals who have made an identifiable significant or material contribution. It will not necessarily be the case that all those listed on this form will be named as inventors for the purposes of legal documentation involved in the patent process or be authors of software code (see definitions of Inventors, Software Authors and Contributors on the IP2 form).

Include all relevant external individuals i.e. those who are employed outside the University and who did not use Oxford facilities, as well as individuals who are employed (or are students registered) outside the University but who have signed an agreement with it to conduct research here.

All individuals who are employees of the University or have a signed agreement with the University to conduct research here will be asked to complete form IP1. External individuals who were not based at the University do not need to complete form IP1 but must complete and sign page 1 of the Intellectual Property Income Distribution Form (IP2).

For software projects, it is ESSENTIAL that all individuals who wrote the code are listed here, as well as all inventors of the IP. This is to ensure that copyright in software is taken into account, as well as patent rights.

Question 4

(b) Information recorded in your lab books should help when considering the period from when you first conceived the idea to when you finished working on the technology. Please note that if you show on the form the inventive period ending at 'to date' or 'to present' or 'ongoing' (i.e. no actual end date), we will take that as being the date of your signature on the form and so do our due diligence checks up until that point and assign IP created up to that date.

Note that your inventive period may be different to that of the others involved in the creation of the IP, as you may have worked on this project at different times.

SECTION 2: WHAT IS YOUR EMPLOYMENT HISTORY?

We use the information provided by you in this section to establish who owns the IP you created. Your IP could be owned by more than one entity if you have changed employers or status during the inventive period so we need this level of detail.

Question 5: This question asks about positions you held at Oxford during the inventive period

(c) Please see question 6 below if at any time during the inventive period you were a student at or employed by an institution or organisation other than Oxford, or were self-employed or a consultant or other.

(d) Position you held: e.g. University employee, College employee, retired employee, undergraduate student, DPhil student. Bear in mind your status/position may have changed during the course of the inventive period. If it has, please give all details.

(e) We need to know which department you were working in when the IP was created because the Statutes and Regulations of the University provide departments with an entitlement to a share in higher net revenues from commercialisation.

(f) A visitor is someone who is engaged in research at the University of Oxford but who is either employed elsewhere or is registered as a student elsewhere or is self-employed. Such a person would normally be expected to have signed a visitor's agreement (this may also be called an honorary contract) for the department where they are engaged. A secondment is usually more formal and for a longer period, with a secondment agreement between the University and the employer of the secondee.

Question 6

(g) If you held a University position for the whole of the inventive period or if you held other positions but they were not **directly relevant** to the creation of the IP, put 'Not Applicable'.

(h) Position you held: e.g. employee, retired employee, undergraduate student, DPhil student, visitor, self-employed or other (please state). Bear in mind your status/position may have changed during the course of the inventive period. If it has, please give all details.

(i) Please provide a contact name, telephone number, and email address for the research services office or the technology transfer organisation for your employer or institution outside Oxford. We are likely to need to contact them to put in place necessary arrangements regarding the IP you have created, so, if you can provide contact details, it will help with the process.

SECTION 3: HOW WAS YOUR WORK FUNDED AND WAS THERE ANY ADDITIONAL SUPPORT?

The answers to the questions in this section will help us to establish whether there are any contractual terms and conditions with any funder(s) or other third parties that the University may need to comply with. This will also help Research Services to calculate any revenue share due to third parties.

Question 7

(j) Please list all forms of external financial support received by the University and internal financial support provided by the University ONLY if they are **directly** relevant to the IP, i.e. the IP you created falls within the scope of the research being funded (for example, this would be the case if the results you have reported to the funder contained the IP). Examples of external financial support include: Research Council grants, funding from charities, CASE studentships, industrial or commercial funders, government funding, EC funding; and internal support: seed funding (UCSF, IUIF).

Please only list funding which is relevant to you, the person named at question 2 above. Most funding will be relevant to the research project(s) which led to the creation of the IP as a whole and so will be listed on each individual's IP1, but on occasion there may also be funding which relates just to you. Before listing this, please check that it is relevant to the creation of **this** IP.

(k) The Principal Investigator ("PI") is the individual who applied for the funding and is responsible under the award or contract for the work carried out. Research Services needs this information to help find the contract/award.

(l) If you have listed more than one source of funding, please assess the relative percentage that each funding source made to the IP you created.

(m) The reference should be the Oracle account number (or the Research Services reference number): if you do not know either of these, then please obtain them from your Research Services contact or from your department administrator.

The information you provide will help Research Services to find the contract/award. We will then review the terms to establish ownership or other rights over the technology. It is helpful if you can supply copies of contracts.

Question 8

(n) Non-monetary or other in-kind support might have consisted of the supply of scientific equipment or research materials. The type of agreement could be a material transfer agreement (i.e. a written undertaking to supply particular material for the purpose of research), or an equipment loan agreement, or similar. In some cases there might be just an informal understanding, not an actual written agreement, with another party. We still need to know about this because of potential claims to the IP which that party might make as a result of its support, so please provide full details.

Question 9

(o) This question is designed to capture any other relevant agreement which might affect ownership of the IP or provide for third party rights over the IP. Examples would include services contracts, collaboration agreements or personal consultancies or other agreements which have not already been disclosed above.

Question 10

(p) The purpose of collecting any relevant patient consent form is to have a copy on the IP file with RS and Isis in case of future need (connected with Isis' exploitation activities). If you think this question is irrelevant to your invention (e.g. because you work in a completely unrelated field), please tick 'No'.

IP/2 INTELLECTUAL PROPERTY INCOME DISTRIBUTION FORM

Isis project number:

This form should be completed by all individuals whose work led to a new invention or other form of intellectual property. Individuals who are members of the University of Oxford (employee, student, retired employee) or who are using University of Oxford facilities, e.g. as a visitor, must each also complete Form IP1 Intellectual Property Due Diligence Form.

HOW TO COMPLETE THIS FORM

Oxford individuals: **You need to sign and date this form on page 1 to show you agree with the % revenue share, and fill in your personal details on page 2.**

External individuals: **You need to sign and date this form on page 1 to show you agree with the % revenue share but you do not need to fill in the personal details on page 2.**

1 The University of Oxford's Statutes and Regulations require individuals who contribute jointly to intellectual property to agree between themselves the proportion of exploitation income to which each will be entitled from the net revenue (i.e. less costs and payments to third parties) payable to individuals under the University's revenue-sharing scheme.

2. Please state below the relative percentage share of individuals' benefits due to each.

3. The percentage shares will be used to assist the University's negotiation of revenue-sharing agreements with external funders who supported the work which led to the creation of the intellectual property in question (where such funders require a revenue share).

4. The percentage shares will also be used as the basis for revenue-sharing arrangements between the University and other collaborating institutions, where one or more of the individuals contributing to the intellectual property are employed by (or are students of) another institution.

DETAILS OF INDIVIDUAL CONTRIBUTIONS

Working title of intellectual property:

We, the undersigned, agree that our individual contributions to the intellectual property named above are as follows:

Name	**Percentage Contribution**	**Inventor or Contributor?[1] Specify which. If a software project, please also specify all Software Authors**	**Signature**	**Date**
				(dd/mm/year)
				(dd/mm/year)
				(dd/mm/year)
				(dd/mm/year)
				(dd/mm/year)
				(dd/mm/year)
Total	**100%**			

[1] Inventors must be legal inventors according to the definition in patent law. Inventorship is not the same as authorship of an academic paper. Under European patent law, for example, a person is only a legally defined inventor if he or she conceives the idea underlying the invention. If you need help with deciding inventorship, please ask your Isis technology transfer manager. Contributors should have made a significant and identifiable contribution to the intellectual property. Software Authors are those who actually wrote the code and thereby created the copyright.

ROYALTIES

Royalties can be distributed only after this form has been completed. University employees and ex employees will be paid via the University payroll (net) or by cheque (gross), depending on their status and/or contract of employment. Individuals who have never been employed by the University will be sent a cheque for the royalties less tax at the basic rate but no national insurance will be deducted. Alternatively, they may be paid via their employing institution, depending on revenue-sharing arrangements with the collaborating institution.

THE UNIVERSITY CAN ONLY PAY MONEY TO YOU IF IT KNOWS WHERE TO FIND YOU. THE UNIVERSITY WILL USE ALL REASONABLE ENDEAVOURS TO FIND YOU IF MONEY IS DUE TO YOU, BUT IF THE UNIVERSITY CANNOT SUCCEED IN FINDING YOU AFTER SIX MONTHS YOU MAY LOSE YOUR ENTITLEMENT.

NOTES

1. Please give a permanent home address if you are in temporary accommodation.
2. All changes of address (including email address) should be notified to: University of Oxford, Finance Division, 23-28 Hythe Bridge Street, Oxford OX1 2ET or by email to royalties@admin.ox.ac.uk quoting the Isis project number.

ADDRESS DETAILS

Full Name:	Full Name:
Title (Professor, Dr, etc):	Title (Professor, Dr, etc):
Home Address:	Home Address:
Email address:	Email address:
Nationality:	Nationality:
Have you ever been employed by Oxford University? ☐ **Yes** ☐ **No** If yes, please give employee number:	Have you ever been employed by Oxford University? ☐ **Yes** ☐ **No** If yes, please give employee number:
Date of birth: (dd/mm/year)	Date of birth: (dd/mm/year)
Full Name:	Full Name:
Title (Professor, Dr, etc):	Title (Professor, Dr, etc):
Home Address:	Home Address:
Email address:	Email address:
Nationality:	Nationality:
Have you ever been employed by Oxford University? ☐ **Yes** ☐ **No** If yes, please give employee number:	Have you ever been employed by Oxford University? ☐ **Yes** ☐ **No** If yes, please give employee number:
Date of birth: (dd/mm/year)	Date of birth: (dd/mm/year)

ADDRESS DETAILS cont'd	
Full Name:	Full Name:
Title (Professor, Dr, etc):	Title (Professor, Dr, etc):
Home Address:	Home Address:
Email address:	Email address:
Nationality:	Nationality:
Have you ever been employed by Oxford University? ☐ **Yes** ☐ **No** If yes, please give employee number:	Have you ever been employed by Oxford University? ☐ **Yes** ☐ **No** If yes, please give employee number:
Date of birth: (dd/mm/year)	Date of birth: (dd/mm/year)
Full Name:	Full Name:
Title (Professor, Dr, etc):	Title (Professor, Dr, etc):
Home Address:	Home Address:
Email address:	Email address:
Nationality:	Nationality:
Have you ever been employed by Oxford University? ☐ **Yes** ☐ **No** If yes, please give employee number:	Have you ever been employed by Oxford University? ☐ **Yes** ☐ **No** If yes, please give employee number:
Date of birth: (dd/mm/year)	Date of birth: (dd/mm/year)
Full Name:	Full Name:
Title (Professor, Dr, etc):	Title (Professor, Dr, etc):
Home Address:	Home Address:
Email address:	Email address:
Nationality:	Nationality:
Have you ever been employed by Oxford University? ☐ **Yes** ☐ **No** If yes, please give employee number:	Have you ever been employed by Oxford University? ☐ **Yes** ☐ **No** If yes, please give employee number:
Date of birth: (dd/mm/year)	Date of birth: (dd/mm/year)

FOR COMPLETION BY RESEARCH SERVICES

1. Do University Statutes pre- or post-2000 apply?

   Pre-2000 / Post-2000 (delete as appropriate)

2. Please confirm that:

   (a) There are no entitlements to third-party research funders or collaborators; or

   (b) There is a revenue-sharing arrangement with third-party research funders or collaborators detailed as follows (if appropriate, a copy of the relevant agreement is enclosed):

3. Research Services Officer:

4. Which Department(s) have an entitlement to revenue sharing under bands 2 and 3 of Statute? If more than one Department, give the relative percentage entitlement between them.

Department	**Percentage**
Total	**100%**

5. Please give any other relevant information to help Finance in distributing any revenues.

Signed on behalf of Research Services

Signature: _____ Date: _____