

IP1 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'.