

**IMT Decree Rep. N.02300(121). I .3.22.07.08**

**THE DIRECTOR**

**GIVEN** the Articles of Association of IMT School for Advanced Studies Lucca, issued with Decree n 243(3). I.2.06.02.2007 and published in the Official Journal, General Series n. 44 on 22.02.2007;

**CONSIDERING** the resolution of the Board of Directors, in the meeting on 21 July 2008, held in Lucca, with which the Regulations on the results of research activities were approved, with possible adjustments or corrections to be made by the Director

**APPROVES**

- The issuance of the Regulations on the results of research activities attached to this Decree, of which they are an integral part;
- That the aforementioned Regulations are published in the official register and on the School website and enter into force with effect from the day following that of publication.
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Lucca, 22/07/2008

The Director

IMT Institute for Advanced Studies Lucca

Prof. Fabio Pammolli

(signature of Fabio Pammolli)

## **REGULATIONS ON THE RESULTS OF RESEARCH ACTIVITIES**

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## Chapter I – General rules

### Article 1 – Purpose

1. IMT promotes technology transfer and use of the results of research activity through the promotion of basic research and applied research, also in collaboration with other public or private parties.
2. In particular, IMT favours the patenting and the economic use of the results of the research activity and makes the authors and the inventors participate significantly to the utilities that result from the use of the research results.

### Article 2 – Definitions

1. The following are defined for the purpose of these Regulations:

**“Research activities”**: indicates the activities performed by employees and non-employees in carrying out their duties and tasks, aimed at scientific research and/or training, by using equipment, facilities or financial resources attributable to the IMT budget or, in any case, of economic resources administered by the latter;

**“Author/s”**: indicates the individual who has the moral right to be recognized as the author of what is the object of both intellectual property rights and industrial property rights other than inventions;

**“Patent/s”**: indicates the industrial property rights through which the invention rights are acquired. They are, therefore, included: invention patents, utility model patents, patents on a new plant variety and the recordings of semiconductor product topographies. In addition, the patents provided for by national legislation (Italian or any other State of the world), by Community law and by international conventions;

**“Employees”**: indicates the subordinate workers (both fixed-term and temporary) of any kind of the School, with tasks related to teaching and/or research. Therefore, teachers and researchers are included, as well as all the technical staff who support teaching and research, with tasks that are not purely executive;

**“Industrial property right/s”**: indicates, pursuant to and for the purposes of Legislative Decree of 10 February 2005, n. 30, brands and other distinctive signs, geographical indications, designations of origin, designs and models, inventions, utility models, topographies of semiconductor products, confidential company information and new plant varieties;

**“Other industrial and intellectual property rights”**: collectively indicates the combination of industrial property rights other than the inventions and of the intellectual property rights;

**“Intellectual property right/s”**: indicates creative works, including computer programs and databases, as governed by the Law of 22 April 1941, n. 633. Pursuant to these Regulations, the term intellectual property right/s refers exclusively to computer programs and industrial design works;

**“Internal non-employee/s”**: indicates employees *pro-tempore* that carry out teaching and/or research activities for any reason. Pursuant to these Regulations, students are also included in the term internal non-employees;

**“Inventor/s”**: indicates the individual that accomplishes the invention, as well as the individual entitled to the rights set forth in Chapter II of these Regulations;

**“Invention/s”**: indicates any useful result deriving from the Research Activity, which is likely to be the subject of an invention patent and whose discipline is contained in Section IV of the Industrial Property Code. Pursuant to these Regulations, the term Invention also includes: (i) utility models; (ii) topographies of semiconductor products; (iii) Know-how; (iv) new plant varieties;

**“Know-how”**: also pursuant to and for the purposes of Article 98 of the CPI, indicates the information and technical-industrial experiences, subject to the legitimate control of the holder, which are secret, have economic value, as they are secret, and are subjected to measures to be considered reasonably adequate to keep them secret;

**“Registration/s”**: indicates the industrial property rights (and all other forms provided for by the Industrial Property Code) through which the industrial property rights other than the inventions are purchased. Pursuant to these Regulations, all forms of acquisition of intellectual property rights are also understood. In addition, the records provided for by national legislation (Italian or any other State of the world), by Community law and by international conventions;

**“Funded research”**; indicates the Research Activity carried out within specific research projects funded totally or partially by public or private entities other than the School, which do not directly use any research results;

**“Commissioned research”**: indicates the research activity carried out in the field of services for third parties defined by research or consultancy contracts, using equipment and facilities of the School or economic resources administered by the School;

**“Research contract”**: this is the contract stipulated by the School with third parties to perform research activities involving the participation of employees of the School and/or non-employees and/or use of equipment or facilities of the School;

**“Institutional research”**: indicates all the Research Activity other than funded or commissioned research;

**“Invention rights”**: any property right on the invention and moral right of the inventor to be recognized as the author;

**“Patent expenses”**: any expenditure actually incurred towards third parties for filing the application for a patent (national or any other type), including search for anteriority and analysis of market potential, to obtain the patent, for its possible extension and for its maintenance in life.

### Article 3 – Research commission

1. The Research Commission is composed of a fixed member which includes, in addition to the Director of the School, the Heads of the Research Areas and a variable member of up to three subjects, internal or external to the School, appointed by the Director in relation to technical-scientific skills related to

the individual issues under examination or experts in the field of patents and protection of intellectual property.

2. The Research Commission is convened by the Director with a notice also delivered by e-mail, at least seven days before the meeting. The Commission is regularly constituted with the presence of the majority of those entitled to vote and deliberates with the majority of those present.
3. The Commission can also operate in a reduced composition, with the presence of just the fixed member, when this is foreseen by these Regulations.
4. Members of the Research Commission have the obligation of secrecy regarding news and confidential documents brought to their knowledge, with particular reference to new inventions and the content of patent applications not yet made accessible to the public.
5. The Commission has the task of examining any request for registration, patenting and use of the results of the research activity, and in particular:
  - a) with regard to the inventions and in general to the rights on the results of the research activity held by the School, expresses its opinion on the technical-scientific and commercial opportunity to start the registration, patenting or extension procedure of the patent, as well as on the most opportune use strategies and on the legal aspects;
  - b) expresses its opinion regarding negotiation proceedings concerning inventions and other intellectual property rights of the School;
  - c) decides on the ongoing maintenance of the patent and registration;
  - d) at the request of the interested parties, provides assistance or opinions regarding inventions and other industrial and intellectual property rights held by employees or internal non-employees;
  - e) promotes fundraising and the establishment of spinoffs.
6. The Commission avails itself of the support of the competent organizational unit of the School, with particular reference to all the investigation activity necessary for the performance of its functions, as well as the procedures for the patenting and registration and those related to the deed negotiations on the matter.

#### **Article 4 – Competent organizational unit**

1. With regard to the protection of research results and technology transfer, the competent organizational unit, as well as performing instructive tasks for the Research Commission:
  - a) supports the inventor in the verification of the requisites established by the current legislation for the protection of the invention and the relative state of the art, as well as in the assessment of the potential for industrial use, availing itself when necessary of professionals, also to prepare the required documentation;
  - b) takes care of the development of the invention by promoting it in order to identify third parties who are interested in acquiring or using the invention economically and managing the aspects

relating to the relative negotiation and contractual activity, availing, where appropriate, the work of external professionals;

- c) supports the School Research Areas for all aspects related to intellectual and industrial property.

#### **Article 5 – Scope of application**

1. These Regulations apply:
  - a) to the inventions carried out by one or more employees or internal non-employee inventors of IMT during the research activity;
  - b) to other industrial and intellectual property rights achieved by employees and internal non-employees during the research activity.
2. The internal non-employees state before starting the activity, to accept the application of these Regulations.
3. If to achieve an invention there is also the shared contribution of individuals unrelated to the School, the property rights of the latter are regulated by the law and by specific agreements.

### **Chapter II – Inventions**

#### **Article 6 – Inventions within the institutional research activities**

1. The inventors have the right to be recognized in any case as authors of the inventions achieved in the research activity and holders of the related moral rights. Any negotiation or agreement concerning the invention accomplished by the inventor must contain a specific clause on the moral right of the inventor which must specify in all the patent documentation, that apart from the moral authorship, the invention has also been achieved in the scope of the IMT research activity.
2. The inventor is the exclusive holder of the property rights arising from the invention and the related patent, without prejudice to the right to assign such rights to IMT. In case of several inventors, the rights and obligations set forth in these Regulations with reference to the invention are to be referred to all the co-inventors in proportion to the respective shares, unless otherwise agreed. In the case of shared contribution to inventions by several individuals, the School, in the absence of a different communication signed by all the co-inventors, assumes in the relations with the same co-inventors that the shares of co-inventors are equal. All patent costs are borne by the inventor or the group of inventors.
3. The inventor, in his own interest and that of the School, has the obligation to keep, in the mutual relations and communications, the utmost confidentiality with reference to information that may prejudice any patent rights related to the inventive results. Specifically, if the inventor considers that the results of the research activity can be patented, if it is used in contexts of dissemination or scientific or didactic communication, he must evaluate that this use does not result in any infringement of patenting and in the case of doubt is required to call the Research Commission to agree on how to use it. The Research Commission, with reduced members, will express itself within 15 days of the request presented to the competent organizational unit for the investigation activity. If the information

provided by the inventor is insufficient for a correct evaluation, further information can be requested from the inventor. In this case, the expiry of the term is interrupted, and a new 15-day term starts to from the moment in which the required information is received by the competent organizational unit for the investigation activity. If there is silence from the Commission, once the deadlines have elapsed, the authorization for use is intended as agreed, as per the inventor's request.

4. In any case where the information concerning the results achieved is communicated by the inventor to third parties, external to IMT, also for the purpose of the subsequent use of the related rights, these third parties are required to sign a confidentiality agreement on the information provided to them, according to the specific forms provided by the School.
5. The inventors who submit, individually or in groups, patent applications in their own name are required to give prior written notice to the Commission through appropriate forms to be filed with the competent organizational unit and to provide a copy of the filed patent application within 1 month of its filing.
6. In case of economic use or transfer to any title of the technical results of the research previously to (or in absence of) the filing of the patent application, the inventor immediately communicates to School of the initiate economic use or the transfer to third parties, sending the complete documentation within thirty days.
7. If the inventor decides to transfer the patent rights to third parties, the right of pre-emption will be granted to the School; to this end, the inventor will proceed to communicate the offers received from third parties, within 30 days of receipt, exactly specifying the considerations, all the contractual terms, as well as the identity of the bidder. Should the offer contain, even if only partially, a counterpart not expressed in pecuniary terms (such as, for example, in case of conferment of the invention in a company, exchange, donation, etc.), the parties must submit the invention for the evaluation of a third party, appointed by common agreement.
8. In order to allow the School to exercise the rights and powers provided for in these Regulations, the inventor is required to notify the Commission of the terms and conditions of the contracts signed in relation to the patent.
9. If the inventor has not transferred the property rights to IMT, he is obliged to recognize to the School a portion of the fees, or in any case of the total proceeds deriving from the use of the same patent, minus the expenses incurred by the inventor or the group of inventors for the achievement of the patent and its maintenance in life, equal to 30%.
10. to Article 65 of the Industrial Property Code, after 5 years from the date of issue of the patent, if the inventor or his successors have not started industrial use and provided that this does not derive from causes independent of their will, the School will automatically acquire the non-exclusive free right to use the invention and the property rights connected to it or to have them used by third parties, without prejudice to the right of the inventor to be recognized as the author and the right to the share of any royalties or proceeds.

#### **Article 7 – Assignment of the rights of the inventor to the School and distribution of income for economic use**

1. The School, on an exceptional basis, reserves the right to evaluate the acquisition of property rights on the invention, which the inventor or co-inventors jointly intend to transfer, through a specific proposal on forms prepared by the School.

2. The patent proposal will normally cover the request to file a national patent application. Requests for different filings will be assessed on a case-by-case basis by the Research Commission if the applicant/s provide adequate and exhaustive documentation, explaining the reasons for the request, with particular regard to the analysis of the state of the technologies in the reference sector and the possibilities of commercial use.
3. On the acceptance or non-acceptance of the bid, the Board of Directors decides on the basis of the opinion and evaluations of the Research Commission. The resolution considers the conditions of economic sustainability, the degree of technological and commercial uncertainty and the length of the return period of the investment.
4. The Commission verifies the formal regularity of the application and the completeness of the attached documentation by making use of the organizational unit's investigation activity, and in the event of a positive outcome of such verification, expresses its opinion within 60 days from receipt of the request.
5. If the Commission requests clarifications or additions of documentation to the inventor before the expiration of the aforementioned deadline, the deadline will remain suspended, and will fully start, for a further 30 days, from the moment the requested information is received by the organizational unit. The request for clarification cannot be repeated, except for serious reasons.
6. In case of approval by the Board of Directors, the School stipulates a transfer agreement, with which the inventor transfers the property rights of his invention. In this agreement, in addition to the recognition of the right to paternity of the invention, consideration must also be given for the payment of the transfer which, apart from particular situations, corresponds to 50% of the proceeds, after deducting the patent fees, if the School transfers the rights on the invention or patent to third parties or grants one or the other as a license to third parties. In the case of more than one inventor, this percentage is paid to the whole group, according to the shares agreed upon and signed by all the co-inventors, or in the absence of communication on the point, in equal parts.
7. The School undertakes to file the patent application within 6 months from the signing of the transfer agreement, after which the agreement will lose its effectiveness, and the inventor may proceed by patenting the invention independently, without prejudice to the percentage of income attributable to the School pursuant to Article 6. Should the Board decide not to file patent applications in all the States requested by the inventor, it must notify the inventor who reacquires, after a proportional reimbursement of the expenses of the deed of transfer and of the relative transcription, all property rights related to the invention for countries for which the School does not intend to file the related application.
8. In the preparation of patent applications and at every stage of the patenting procedures, the inventor must provide all assistance, in particular by making available, in a complete and accessible form, any secret non-patentable information necessary to evaluate the prospects for use of the patent, as well as all the information and documents in his possession relating to the invention. The inventor also informs the School of the existence of external individuals who have expressed an interest in acquiring the invention and the relative patent or license for use.
9. The contracts for the assignment or license of the patents owned by the School are signed by the Director, after deliberation by the Board of Directors, following the opinion expressed by the Research Commission.

10. The School, considering the criteria proposed by the Research Commission, stipulates with third parties the transfer of rights on the inventions it owns. In particular, priority will be given to the transmission of rights on inventions to consortia promoted or participated by the School or to the school's spin offs.
11. The School reserves the right to include a clause in the contracts that protects it in the event that the amount of the compensation actually obtained by the person to whom the right of the patent use has been passed clearly exceeds that envisaged at the time of stipulation of the agreement between the parties.
12. This regulation also applies to the pro-quota property rights of the School on shared patents and inventions.
13. After 5 years from the filing date of the patent application without the industrial use of it having started, or if the proceeds are lower than maintenance costs, the Board of Directors, having heard the opinion of the Research Commission, may decide to suspend the payment of life maintenance fees. If the Board decides not to keep the patent alive, it will inform the inventor at least 30 days before the deadline for paying the maintenance fee. In this case, the inventor may take over the ownership of patent rights, after reimbursement of the costs of the transfer and the relative registration, and without prejudice to the recognition of the fee for the school.

**Article 8 – Rules regarding inventions achieved in the context of funded or commissioned research**

1. In the event that the invention has been achieved in the context of funded or commissioned research activities, the legal and economic discipline established in the deed of funding or in the contract is applied as it is not contrary to mandatory provisions of law. In particular the ownership of any patents obtained from the research, the charges and fees (including those for the inventive activity) for the School and the researcher, without prejudice to the right of the inventor to be recognized as author, will be predetermined, with clauses signed by the researchers.
2. Generally, the School is the exclusive holder of property rights relating to inventions achieved by employees and internal non-employees within the scope of funded or commissioned research, without prejudice to the moral right of those who have achieved the invention to be recognized as authors.
3. No claim can be made by the inventor to IMT for the inventive activity if a specific and distinct compensation for this activity has not been foreseen in the research contract by the client or the lender.
4. The payment obtained from the transfer or licensing of the property rights resulting from the commissioned research activity, belonging to the School, is shared between IMT and the inventor or co-inventors, to whom a minimum share of 60% and maximum 95% is destined, according to the resolution of the Board of Directors, upon proposal of the Research Commission.
5. The payment obtained from the transfer or licensing of the property rights resulting from the funded, research activity belonging to the School, is distributed as in the previous paragraph, unless otherwise provided for in the funding deed.
6. For anything not provided for in this article, reference is made to the rules of the aforementioned article, as applicable.

## **Chapter III – Other industrial and intellectual property rights**

### **Article 9 – Other industrial and intellectual property rights**

1. The employee or the internal non-employee has the right to be in any case recognized as author with reference to the other industrial and intellectual property rights achieved in the research activity and to be recognized as the holder of the related moral rights. Any negotiation or agreement concerning these rights must contain a specific clause on the moral right of the inventors that must specify, in addition to moral authorship, the IMT membership, indicated in the registration and in the remaining documentation.
2. When the rights covered by this article are achieved by several co-authors, the rights and obligations provided for in these Regulations with reference to the individual author, are entitled to all in equal parts unless, in agreement between them, the authors do not indicate a different percentage of participation in relation to the importance of the contribution provided by each one.
3. In the event that other industrial and intellectual property rights are achieved within the institutional research activities, the author is also recognized as the exclusive holder of the related property rights. The School can exceptionally evaluate to acquire such rights, that the authors intend to give, according to the procedure also foreseen for inventions in the previous Chapter.
4. In the event that the other industrial and intellectual property rights are achieved in the context of the commissioned and funded research, the related property rights belong to the School which recognizes to the author, in case of transfer or licensing of such rights, a compensation equal to a minimum of 60% and a maximum of 95% of the profits obtained, once all the costs incurred for registration and its maintenance in force have been deducted, as established by the Board of Directors, with the exception of the funded research, for the case in which the funding deed provides otherwise.
5. In the event of approval by the Board of Directors, the School enters into an assignment agreement, with which the inventor transfers the property rights referred to in paragraph 3. In this agreement, in addition to the recognition of the moral right to be acknowledged to the author, also the payment for the transfer which, except in particular situations, corresponds to 50% of the proceeds deducted the costs for registration, if the School transfers or grants such rights to third parties.
6. When the author does not transfer the property rights to the School, the School has a right of pre-emption, under the same conditions, with reference to any act of transfer to third parties by the author of the right to registration. Moreover, where the author transfers to third parties or licenses the relative rights, he is obliged to pay to the School a percentage of the proceeds, deducting all expenses for registration and its maintenance in force, equal to 30%. The provisions of Article 6, paragraph 8 apply.
7. For matters not provided for in this Chapter, please refer to the rules of these Regulations concerning inventions, as applicable.

## **Chapter IV – Final rules**

### **Article 10 – Disputes**

1. In the case of disputes which the School is involved in regarding relations provided for in these regulations, the School proposes to dispose, where it is not excluded by mandatory laws or contractual obligations with third parties, the disputes to an arbitration board composed of three members, appointing one to each party and the third by the first two or in case of disagreement, by the President of the Court, without prejudice to the completion of an attempt at conciliation.