Frequently Asked Questions – Intellectual Property Commercialisation

What is Intellectual Property (IP)?

Intellectual Property or IP is the term used to describe creative outputs that can be legally protected arising from scientific, engineering, literary and artistic endeavours. In a university setting IP is considered to be the results arising from research.

What are IP rights (IPRs)?

IPRs are the legal rights granted to the owners of IP. IPRs include the right to stop others from using the IP without the owner’s permission. They are viewed as a “property” in the sense that they are a tradable asset.

Types of IP

IP can be categorised into two groups. The first is registered IP protection, which is sought by submitting a patent application at the UK Intellectual Property Office (UKIPO). The process of obtaining IP registration often requires liaising with an examiner until the legal requirements for registration have been met. On grant, the IP is listed on the register at UKIPO for all to view and will remain in force for a term that might vary depending on the type of IP (see details below) provided that renewal fees are paid and its validity is not successfully challenged. Whilst the second arises automatically on creation of the IP e.g. copyright.

Registered IPR

A patent is a state granted twenty year monopoly for an invention, such as a pharmaceutical or engineering device (widget) that are granted by the state in exchange for the details of the invention being published. The first known UK patent was granted in 1449 by King Henry VI to John of Utynam to protect the process of making stained glass, during this time, none of King Henry VI’s subjects could use this process without the consent of John.

A design right protects the outward appearance of an article or a set of articles of manufacture to which the design is applied e.g. the shape of a container. Should they be granted the proprietor has the exclusive right to make articles of that appearance for up to twenty-five years.

A trade mark protects a brand or image such as a word/logo which distinguishes the goods or services of one trader from those of another e.g. The Coca-Cola Company has registered
the words Coca-Cola and their logo (Coca-Cola written in red, stylised writing) as trade marks. Registration is only possible if the mark is distinctive, if it is found acceptable by the trade mark examiner and if it is advertised to give third parties the opportunity to oppose. Once it meets these conditions, the trade mark will then be registered for ten years from the date of filing the application and can be kept in force indefinitely by renewal at intervals of ten years. A registered trade mark is often displayed with the symbol: ®.

**Unregistered IPR**

Copyright is the right to prevent the copying of original literary, artistic and musical works e.g. text, graphics, software, data, art, music. Copyright arises automatically whenever such a work is physically recorded and does not require registration. Copyright protection normally lasts for the lifetime of the author plus seventy years, although there are some exceptions.

A database right protects the systematic arrangement of a collection of data, but not the data itself. Database rights last for fifteen years and can be extended if the database is updated.

Confidential information and know-how are non-public ideas and information, such as know-how, data, technical data, contracts, documentation, presentations, business plans, formulas, products, specifications, rules and procedures, product plans, business methods, product functionality, services, formats, methodologies, applications, developments, processes, payment, designs, drawings, algorithms, marketing or finance. The term of any confidential information or know-how can be infinite, as it continues until the confidential information or know-how is disclosed publicly.

An unregistered trade mark may benefit from some protection under common law if a reputation has been built up in that trade mark and that reputation has been harmed by someone else's use of the mark.

An unregistered design right protects against the copying of features, shape or configuration of industrially produced articles. Protection arises automatically when a design is created. It does not require any form of official application or registration. In the UK unregistered design rights last for the shorter of: i) 15 years from the end of the calendar year in which the design was first recorded or an article was first made to the design; or ii) 10 years from the end of the calendar year in which an article made to the design was first available for sale or hire.

**Is registering for IP protection relevant to realising the public benefit from publicly funded research?**

In keeping with the College Charter and the European Commission’s recommendation on the management of intellectual property in knowledge transfer activities and code of practice for universities and other public research organisations, College is duty bound to
Encourage the commercialisation of IP emanating from College, with a view to generating the greatest social and economic benefit.

The process of registering commercially valuable IP for protection provides a period of exclusivity to protect against copyist, without which there would be no investment in the IP and College would not be able to translate the research into innovations and realise public benefit from publicly funded research.

**How is College’s IP commercialised?**

College IP is commercialised by College’s commercialisation partner Imperial Innovations. Imperial Innovations (Innovations) are responsible for deciding how College IP is to be commercialised (which may be by licensing the IP or the formation of a spin-out company). Innovations will also register for IP protection (if applicable) at its own expense. This is very important since the registration of IP can be costly. For example, an initial patent application may cost £5,000 in patent agent fees alone, and the costs grow thereafter (often approaching over £30,000 within two and a half years). Innovations assuming the costs of commercialising IP and registering for IP protection there is no financial risk to College (as the owner of the IP) or the individuals that generated the IP.

**When should I contact Imperial Innovations?**

Please contact Innovations as soon as you believe you have generated commercially valuable IP, thereby enabling them to provide you with timely and appropriate advice and guidance. Should the technology be eligible for registered patent protection, it is essential that this contact is made before the results are presented or a manuscript submitted for peer review, as an inadvertent disclosure of the technology may jeopardise the invention from meeting the novelty requirement for granted patent protection.

**Can I expect to get anything in return for disclosing the IP I have generated and my involvement in the commercialising the IP?**

Yes, the College operates a discretionary Reward to Inventors Scheme under which the income received by College from Innovations for various IP commercialisation activities (such as licences and the sale of research reagents) to be divided between the individuals involved in creating that IP and their Departments. Alternatively, if a spin-out company is formed the generators of the IP may be eligible for equity in that spin-out company.

**Are laboratory notebooks important for the patenting process?**

In addition to being an essential and regular part of a researcher's routine, laboratory notebooks are also important to the patenting process, as a demonstrable record of the research giving arise to the invention and may be required in obtaining patent protection. Staff and students engaged in research are required to comply with all applicable codes of
practice and regulation, including the College’s Guidelines for Proper Scientific Conduct in Research.

Only since 1996 has evidence produced outside of the US been permissible in patenting and inventor disputes and such evidence is normally contained within a laboratory notebook.

In order to provide this evidence, data should be recorded:-

- promptly;
- accurately (legible and factually complete entries describing all experimental procedures);
- permanently (permanent binding, numbered pages (no gaps) and permanent ink); and
- signed off and dated by the investigator and witness.

Can the IP I generate be both patented and published?

Yes, provided the process is managed correctly. Imperial Innovations is sensitive to the requirement of scientific results and observations being published as rapidly as possible to generate the greatest impact, and actively endeavours not to delay the submission of a manuscript for publication in preparing a patent application. The trend towards greater open access has led to a host of funder requirements now surrounding report outcomes and outputs, however, a patent application is another form of publication (issued 18 months after filing) and the current view is open access can potentially support innovation and the inventive process (see PraxisUnico statement).

Will seeking patent protection prevent me from undertaking further research in this area?

No, the arrangement between College and Innovations for the commercialisation provides a ‘licence-back’ to College for College assigned IP for academic teaching and research purposes.

Will seeking registered IP protection prevent others from viewing the information contained within the patent application?

A patent is a monopoly granted by the state in exchange for a complete disclosure of the invention. In the UK the patent application is published approximately eighteen months after the application is submitted.

How are disputes relating to IP matters resolved?

Any disagreement concerning IP that cannot be resolved by discussion can be referred to the Director of the Research Office for final determination.