

MUNI
TTO

INTELLECTUAL PROPERTY
AT MASARYK UNIVERSITY
ON THE SQUARE

Dear colleagues,

working at Masaryk University (MU) means that you often either encounter someone else's intellectual property or create it directly. The aim of this material is to inform you about intellectual property, the way it is managed at our university, the rules we abide by, and the rights and obligations that both employees and the university have.

The material will briefly guide you through the subject and we believe that a few minutes devoted to reading it will be useful both for you and MU.

Team of the Technology Transfer Office MU

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What is intellectual property?

Intellectual property (IP) includes all intellectual works, inventions and other **intangible results** of human creativity, discoveries and intellectual activity (e.g. know-how). These are usually results of **scientific research, pedagogical or other activities** at the university, which were created as part of work or study duties.

Types of intellectual property

Copyrighted works:

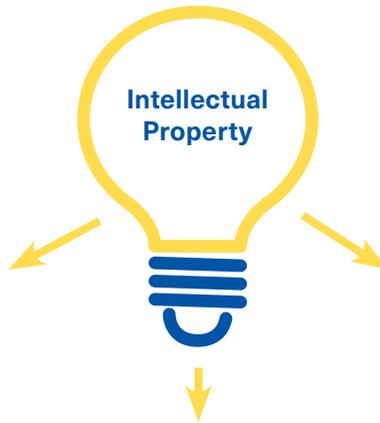
these works constitute the majority of intellectual property of universities and include (among other things) scientific publications (monographs, research articles, studies...), software, photographs, musical and literary works or databases.

Industrial property:

new and industrially applicable results – this type of intellectual property is formally protected (**registered industrial property**) – especially patents, utility models, industrial designs, or trademarks.

Intellectual property protected by other legislation:

for example unregistered indications, trade secrets, confidential information or know-how. This intellectual property is either related to copyrighted works or to industrial property. Based on this information, MU decides on further IP protection. Intellectual property protected by other legislation **is not subject to special registration** together with copyrighted works.



Copyrighted works

Unregistered, for example:

- Monograph
- Research article
- Software
- Conference proceedings
- Database

Industrial property

Registered, for example:

- Patent
- Utility model
- Industrial design
- Trademarks
- Animal and plant breeders' rights, integrated circuit topographies
- Geographical indications and appellations of origin

IP protected by other legislation

Unregistered, for example:

- Know-how
- Trade secret
- Goodwill
- Confidential information
- Unregistered designation

Why and how to protect intellectual property?

Unlike tangible goods (computers, books, CD carriers, etc.), intellectual property is by nature **intangible** and **independent** of material things (“tangible property”) themselves. Based on that, it might be used by an unlimited number of subjects anytime and anywhere in the world without causing any actual harm. Possible interference and damage associated with improperly secured exercise of intellectual property rights (someone has created them, someone owns them, someone profits from their use) can be more dangerous. It is the considerable fragility of intellectual property which makes it valuable and **worthy of protection**. Therefore, it is highly inappropriate to handle intellectual property poorly and not take good care of it.

Copyrighted works and intellectual property protected by other legislation shall enjoy legal protection by their creation, there is no need to register them to ensure their protection. Their protection is therefore **informal**.

In case of industrial property, it is necessary to ask for protection by filing the relevant applications (e.g. a patent application); thusly obtained protection is then recorded in publicly accessible registers. The strategy of this **formal protection** has to be carefully thought out beforehand because it is **time-consuming and financially demanding**. In case of industrial property in scientific environment, we should primarily ensure formal protection of the results with future financial appreciation potential (economic aspect), but other factors may be also relevant. Therefore, whether to protect particular industrial property and what kind of protection to choose should always be consulted with **the professionals from the Technology Transfer Office (TTO)**, which is a specialized workplace of MU focusing on these issues.

The purpose of intellectual property protection is **to provide benefits to creators and owners** of new solutions, and to **secure these results against competition** in order to prevent quick and easy acquisition of this intellectual property without incurring adequate costs and depriving the creator, owner or project sponsor (manager) of **the profits which belong to them**.

Proper care of intellectual property is in the best interest of both the university and the author or originator. MU has set strong **incentive rules for the remuneration** of intellectual property creators. In the best-case scenario, both MU and its employees profit financially (e.g. receive licence fees).

Benefits deriving from the existence of intellectual property do not need to be only financial. Above all, it is a matter of prestige: not only do we possess intellectual property, but we are also able to protect it, thus showing that MU is successful in the practical application of results of science and research with actual benefits for the society. The prestige of the institution is reflected in the increasing attractiveness and good reputation of MU in general. Therefore, the probability of obtaining scientific research and other projects increases the chances of getting research projects and participating in more attractive international collaborations.

Who is authorized to decide on intellectual property?

Intellectual property rights are generally exercised by its creator (author or originator). In case of intellectual property created as an employee's work (to fulfil the job responsibilities – e.g. employment contract), in our environment the employer is exercising economic rights, while the rights associated with the creator (moral rights) belong to the author or the originator.

However, there is an exception at Masaryk University which regards exercising economic rights to works created in order to be published in scientific journals or conference proceedings. In such cases, exercising economic rights is left to the employee in question. In the case of publishing monographs and similar employees' outputs, the employee is obligated to consult the competent MU authority. The way of dealing with intellectual property is determined by the internal MU norms, in particular by **the Directive no. 10/2013 the Intellectual Property at Masaryk University**, available in the MU Information System (IS). This Directive regulates protection and use of intellectual property at MU and determines rights and obligations related to creation, reporting, recording, protection and use of intellectual property. The Directive, in addition to interpreting the basic concepts and handling of IP, also deals with the possibilities and the mechanisms of its internal and external use (e.g. commercialization) and the remuneration of authors/originators.

Economic rights include the ability to use the work and to decide on the work. It means it is up to MU to decide whether to protect intellectual property formally as well as what the strategy of potential commercialization of the intellectual property should be. This is usually consulted with the creator. The moral rights guarantee that the creator is always quoted as the originator/author of the intellectual property.

Especially in the case of inventions, the creation of such intellectual property must be (regarding the employers' rights), **announced to the employer**, subsequently the employer should assess and evaluate the intellectual property and possibly apply some kind of protection (and then reasonably remunerate the originator). At MU, we use **a form** called "Report of Invention". TTO is offering its assistance with clarifying all related aspects and filling in the form and will assist with the preparation of a possible patent application and especially with assessing the commercial potential of the invention.

With termination of an employment relationship the regime of exercising of economic rights is not ceased, thus the rights are not "returned" to the author/originator.

In contrast, **students**, unless they have an employment contract/agreement concluded with MU (e.g. within a research grant), are not employees. Therefore, the university **does not exercise** any rights to the intellectual property created by students (this is called a "school work"). School works (except for computer programs) might be used for teaching purposes or for internal purposes of the university. MU is also entitled to conclude a license agreement under usual (commercial) conditions.

What to beware of?

There are very important so-called conceptual features in the field of intellectual property law. **The author's work** must be, among other things, unique, creative and captured **in an objectively perceptible form** (until the thought is captured on paper, presented at a conference or lecture, there is no IP protection).

In the field of inventions, it is **novelty, inventive activities, and industrial applicability**. Caution is to be exercised especially considering the novelty that is based on global (worldwide) knowledge. At the moment, when you publish the essence of an invention (in a scientific journal, share the knowledge with a third person, present it at a conference), the idea is no longer new and it is impossible for it to be formally protected. Such an invention is therefore **unpatentable** – even if you want to apply “only” for a Czech patent and you have presented your solution at a conference abroad. Such an invention is no longer new, information about it has become public and cannot be formally protected.

Assessing the necessity of conceptual features and all the other relations constitutes a very difficult endeavour. Use the services provided by TTO, a workplace specializing in IP issues and well-suited to solve your problems.

Utilization of intellectual property at MU

The university uses its intellectual property for **both internal and external purposes**. Internal use means primarily the use for teaching or scientific research purposes. To further develop intellectual property and to gain financial profit, it is usually necessary **to cooperate** with other subjects (mostly companies). These are commonly more able to “transform” the idea or the invention that originated at the university to a product or a service applicable on the market. The external use of intellectual property is primarily aimed at commercial use. Any use (even gratuitous) by an external entity must be always **properly contractually managed**.

Exploitation of intellectual property by third parties is mostly realised through **granting a licence**. The university (using a license agreement), grants to the entity a consent to use its intellectual property (e.g. patent). Other terms of use are defined in the licence agreement, namely:

- exclusivity/non-exclusivity (granting a licence exclusively to one entity or to multiple entities),
- period during which the licensee will use the IP,
- extent of use of the IP (territorial aspect – in which countries the IP can be used),
- domain of use of the IP (may be limited e.g. to some industrial sectors, i.e. another license can be granted for the same invention, but in another industrial field).

License agreement also adjusts the **financial terms**, which set the conditions under which the licensee is allowed to use the intellectual property.

In addition to licensing, there is a possibility of practical use of intellectual property, e.g. through **spin-off companies**. MU is already using this method to **valorise several of its outputs**. Spin-off is a company linked more or less with the university through intellectual property of MU. In case of a spin-off company with a MU financial share, the university has a personnel supervision in the structure of this company. In case of spin-off companies without any MU share, they are mostly founded by an MU employee. In both cases, it is possible to secure an effective use of intellectual property in the business sphere.

Copyright issues at MU

The university is in essence based on copyright and related rights. Copyrighted works capture the thoughts, ideas and knowledge that MU employees produce in the form of their creative work. Within MU, the individual **economic centres** (e.g. faculties) manage their own employees' works **separately**, it is not a centralized activity. Therefore, each economic centre provides **contact points for intellectual property issues**, which closely cooperate with TTO and are ready to help with not only copyright issues. However, it is possible to use TTO services directly.

Intellectual property: questions and answers

A set of frequently asked questions and answers published on the website ctt.muni.cz shows what are the rights and obligations of MU employees in relation to intellectual property of MU and how to proceed in most common situations.

Selected internal regulations related to intellectual property of MU

- MU Directive no. 10/2013 The Intellectual Property at Masaryk University
- Order of Masaryk University no. 6/2017 the Valuation and Evidence of Intellectual property
- Rector's Action no. 9/2013 to Ensure the Sustainability of the Outputs in the Field of the Intellectual property
- Order of Masaryk University no. 3/2018 Foundation and Operation of Spin-off Companies of Masaryk University
- TTO Guidance Notes on Trademark Applications and Maintenance of Trademarks
- MU Directive no. 2/2015 the Principles of the Use of (representative) Characters of Masaryk University

Selected laws related to the intellectual property

- Act no. 527/1990 Col., On Inventions and Rationalisation Proposals, as amended
- Act no. 478/1992 Col., On Utility Models, as amended
- Act no. 207/2000 Col., On Protection of Industrial Designs, as amended
- Act no. 441/2003 Col., On Trademarks, as amended
- Act no. 121/2000 Col., On Copyright and Related Rights (Copyright Act), as amended
- Act no. 89/2012 Col., Civil Code, as amended

Who helps MU employees with intellectual property?

In 2005 MU was one of the first Czech universities to establish a specialized **Technology Transfer Office**. Its main tasks are management, protection and use of intellectual property and also technology and knowledge transfer, cooperation with the industry and the business sphere, and establishing spin-off companies. TTO is a specialized MU department with university-wide competencies. The TTO team consists of business development managers, project managers and lawyers with economic and administrative background. The TTO team services are intended for both MU employees and students (**free of charge**), and for commercial companies as well. Thanks to the quality of the services provided, TTO is considered to be the leader in the field.

- TTO is the primary contact point of MU for companies in the area
- TTO supports the application of research results in practice
- TTO protects and manages intellectual property of MU
- TTO offers education and advice regarding technology transfer and intellectual property issues

ctt.muni.cz website contains **all the important documents** concerning intellectual property as well as a series of additional materials including the aforementioned frequently asked questions.

Do not hesitate to contact our team, we are here to help you!



WWW.CTT.MUNI.CZ