

Revision of the IP Regulation

Preamble

Instituto de Medicina Molecular João Lobo Antunes (iMM) makes every effort to create a favourable environment to promote excellence, freedom and ambition in science, with the potential to generate discoveries that can be transformed into new medical solutions to improve human life. This is consistent with iMM's mission to develop new knowledge and facilitate its wide dissemination for the benefit of society.

iMM has been developing policies and guidance documents to strengthen and encourage the valorization of its knowledge and technology. The establishment of the Technology Transfer Office (TTO) in 2018 contributes to enhancing its ability to identify and protect commercially viable intellectual property (IP) and leverage its successful exploitation.

An IP policy is essential for the stability and predictability of matters related to the protection and valorisation of intellectual and industrial property rights, creating an objective and transparent framework on IP matters for iMM employees and external partners. iMM IP policy was established and standardized through iMM IP Regulation, approved by the Members General Meeting in 2015.

iMM IP Regulation provides for its revision within 3 years from the date of approval. The opportunity to review the IP Regulation is also justified by the needs to: i) ensure the compliance of the Regulation with the New Industrial Property Code (IPC), approved by Decree-Law No. 110/2018, of 10 December; ii) align the IP management practices with the University of Lisbon iii) fill gaps detected in IP management; iv) reflect the changes in the organization with impact on IP management and valorization; v) bring iMM IP policy closer to the best international practices.

The IP Regulation aims to:

- (i) define the ownership of IP, remuneration and commercial valorization of intellectual property rights obtained as a result of the activity of and/or functions performed by researchers linked to iMM or in which resources from iMM have been used, regardless of the existence, or not, of a contractual link;
- ii) the management of IP, establishing clear rules and procedures for the management and valorization of the IP generated in the institution;
- iii) the promotion of the use of iMM IP, facilitating the wide adoption and use of iMM IP through various access modalities;
- iv) the balancing of interests between the institution, employees and partners involved in research, development and innovation activities, aligning them with the interest of the general public;
- v) defining the roles and responsibilities of the parties involved in the protection and valorization of iMM IP.

Chapter I

General Provisions

Article 1

Object

The purpose of this regulation is to define and regulate the aspects relating to ownership, protection, remuneration and commercial valorization of intellectual property rights obtained as a result of the activity of and/or functions performed by researchers linked to iMM or in which iMM resources have been used, irrespective of the existence, or not, of a contractual relationship, without prejudice to the stipulations of intellectual property sharing agreements with entities with which resources have been shared during the work that gave rise to the intellectual property rights.

Article 2

iMM resources

Unless otherwise stipulated, iMM resources shall mean all tangible and intangible assets owned or managed by iMM, under existing protocols, and/or by its services and research laboratories, including, but not limited to, infrastructure, materials, equipment, human resources, industrial property and reputation in the national, European and international market.

Article 3

Subjective scope

1. The following are subject to this Regulation, hereinafter referred to as inventors:

- a) Researchers with a contractual link to the iMM, regardless of the nature of their contractual link;
- b) The researchers and visitors who, although not contractually bound to the iMM and without prejudice of being covered by other regulations or contractual intellectual property regimes, develop partially or integrally their research activity under any financing program granted to the iMM, public or private, national or not, as well as under scientific collaborations, using the resources of the iMM for such purpose;
- c) Students collaborating in iMM research laboratories, whether or not as part of their formal study programs;
- d) Any other person who is associated in any way, directly or indirectly, to iMM and who uses its resources, unless otherwise stipulated or provided by law.

2. iMM may require any of the persons referred to in the preceding paragraph to declare in writing that they have knowledge and accept fully and unreservedly this regulation, as well as the content of all its clauses, namely the rights and duties arising therefrom.

3. The situation of inventors linked to organic units of the University of Lisbon and/or covered by the University of Lisbon's Industrial Property Regulation shall be the object of a specific protocol between this entity and iMM, with respect to the ownership of industrial property rights.

4. Without prejudice to the provisions of the preceding paragraph, whenever researchers referred to in paragraph 1(b) are covered by other regulations or industrial property contractual regimes, a protocol should be executed, under the terms of Article 6, with the entity holding eventual industrial property rights under those regimes, prior to the beginning of the respective use of iMM resources and/or scientific collaboration.

5. The application of this Regulation shall extend until the end of the calendar year following the termination of the relationship established between any of the persons indicated in paragraph 1 and iMM, in respect of inventions disclosed during that period and derived from work carried out while the relationship with iMM was in force.

6. Any agreement, contract or protocol entered between iMM and any other entity that particularly regulates the activity of any of the persons mentioned in number 1 with respect to industrial property matters shall take precedence over this Regulation.

Chapter II

Ownership and Procedures

Article 4

Ownership

1. Ownership of IP rights over inventions or other creations, conceived and carried out by the persons indicated in Article 2, including IP rights protectable by the Industrial Property Code (IPC), shall vest in iMM.

2. The ownership referred to in the preceding paragraph shall result:

a) From the exercise of the right of option, provided for in Article 59, paragraph 3 of the IPC, in respect of inventions or creations susceptible of protection by this Code, conceived or carried out by inventors linked to the iMM through a legal employment relationship, and whenever iMM, in compliance with the provisions of paragraph a) of the referred Article, intends to remunerate them under the terms established in this Article.

b) In all other cases in which it is not legally possible to exercise the right of option, from the onerous transfer of all or a share of the intellectual property rights or ownership of industrial secrets, in favour of iMM, in exchange for remuneration under the terms set forth in this Article.

3. The use of iMM resources by inventors who are not subject to the exercise of the legal right of option, but in relation to whom inventive activity is expected to be carried out, namely grant holders, is subject to their adhesion to the present Regulation, by means of a written statement.

4. The statement referred to in the final part of the preceding paragraph shall be signed at Human Resources, upon the admission and mandatory registration of the inventors, before the beginning of their relationship with iMM.

5. The ownership of intellectual property rights is without prejudice to the moral rights of the respective inventor, except in case of express waiver, under the applicable legal terms.

Article 5

Remuneration

1. The remuneration to be processed by IMM by way of payment for an industrial property right, whether for the exercise of the option right or for the onerous transfer of the right, shall correspond to 50% of the revenues which it may obtain from the economic valorization of that right, after deduction of the expenses which it has proved to have incurred, or which it is estimated it will incur, with the constitution, maintenance, defence, promotion and commercialization of that right.
2. Whenever there are several inventors of IMM who contributed for the conception and making of an invention protected by the IPC, the percentage established in the preceding number shall be distributed among them in accordance with the distribution established in the invention disclosure form.
3. The right to receive remuneration provided for in the preceding paragraphs continues even after termination of the relationship or collaboration between IMM and the inventor.
4. By means of the subscription of the statement referred to in paragraphs 3 and 4 of the preceding article the respective inventor acknowledges, that no other amount or economic advantage, other than that set forth in this article, is or shall be owed to him/her by virtue of the right of option or transfer of the right in favour of IMM.
5. The inventor shall not be entitled to receive revenues derived from the participation of IMM in the capital of companies where the inventor has an individual participation in the capital of the concerned company.

Article 6

IP in contracts

1. Contracts, protocols and agreements established between IMM and other entities shall regulate the industrial property regime considering the provisions of this regulation, whenever activities that may result in industrial property rights are foreseen.
2. Contracts, protocols and agreements shall establish, in their body or in an additional term annexed, namely:
 - a) The ownership of the invention or creation;
 - b) The assumption of the costs with the process of constitution, maintenance, defence, promotion and commercialization of industrial property rights;
 - c) The commercial exploitation of the invention or creation and division of financial profits;
 - d) The safeguarding of the rights of IMM and the inventors, namely in the event of licensing or transfer to third parties;
 - e) The confidentiality and the conditions of disclosure and publication of the results obtained.

Article 7

Communication of invention

1. Inventors shall communicate to IMM Technology Transfer Office (TTO), within 3 months from the date it is concluded, the invention or new knowledge with potential for protection by industrial property right(s), by filling in an invention disclosure form, in a model established by IMM and to be made available on its intranet.
2. Upon receipt of the invention disclosure form, IMM shall decide within a maximum period of 60 days on its intention to protect the industrial property rights arising therefrom, taking into consideration in particular the interest of the inventors in disclosing the scientific knowledge.
3. If, in accordance with for the provision set forth in number 2, IMM decides not to protect and/or commercialize the invention, the respective inventor(s) may do so individually. In that case, IMM shall transfer the intellectual property rights in favour of the inventor(s).
4. The assignment / transfer of rights to the inventor(s) provided for in the preceding paragraph contemplates IMM's right to receive 2% of the net IP revenue obtained by the inventor(s) from the commercialization of the invention and any associated intellectual and industrial property rights, regardless of whether the commercialization is done directly by the inventor(s) or through a third party. Revenue subject to this provision shall include the payments resulting from the sale of equity interests in companies received by the inventor(s) as consideration for the assignment of rights to exploit the invention and any associated IP rights.

Article 8

Protection

1. IMM shall be responsible for determining the protection of the industrial property rights referred to in this Regulation.
2. IMM shall define the concrete means, scope and means of protection of the industrial property rights, after hearing the respective inventor(s) and in accordance with a judgement on the commercial potential of the scientific knowledge at stake.
3. The application for registration of the respective industrial property rights shall be made in favour of IMM under the terms of Article 3.
4. IMM shall be responsible, as owner, for the payment of expenses, fees and charges relating to the provisional patent application and to the drafting and submission of the definitive patent application, if and to the extent that the invention reveals a satisfactory commercial interest and its financial situation so permits.
5. Without prejudice to the provisions of the preceding paragraph, research projects susceptible of generating industrial property rights shall, whenever possible, include sufficient funds for the protection of industrial property rights.
6. If IMM decides to abandon a constituted industrial property right, it shall provide the possibility for it to be maintained by the inventor(s), in accordance with that defined in Article 7, points 3 and 4.

Article 9

Commercial exploitation

1. The granting of exploitation licenses, sale of industrial property rights or other exploitation agreements is the exclusive responsibility of IMM and does not depend upon the agreement of the inventor(s).
2. After hearing the inventor(s), IMM shall define the terms relating to the manner of valorization and exploitation of the invention and any industrial property rights related thereto, being the inventor(s) expressly forbidden to negotiate directly with third parties interested in the exploitation, except in cases duly authorized in writing by IMM.
3. Decisions regarding the commercial exploitation of the invention and any related intellectual and industrial property rights shall particularly take into consideration the scientific and financial interests of IMM, of the research laboratories and of the inventor(s) themselves.

Chapter IV

Final and Transitional Provisions

Article 10

Duration

1. The Regulation shall enter into force, after the approval by the Members General Meeting, on the business day following its communication to the persons referred to in Article 2.
2. The communication referred to in the preceding number may be made by sending an e-mail message, with receipt of delivery, and by disclosure on IMM intranet, such disclosure constituting a presumption of knowledge.

Article 11

Amendments

1. Amendments to the Regulation will be made by deliberation of the Members General Meeting, under proposal of the IMM Board of Directors.
2. The changes referred to in the previous number shall be communicated through institutional e-mail to each collaborator and the new version posted on IMM intranet.
3. If not changed at an earlier date, the Regulation shall be reviewed within three years after its approval or following legal changes that impose its revision.