

University of Jyväskylä Regulations Regarding Inventions

1 Purpose and scope of application

The purpose of these regulations is to promote the recognition, protection and utilisation of inventions made at the University of Jyväskylä in a manner appropriate for the inventor, the University, and society.

These regulations apply to inventions patentable in Finland and made by employees of the University of Jyväskylä. If the inventor applies for a patent or otherwise utilises the invention within six months of the end of the employment relationship, the invention is to be regarded as produced during the employment relationship. This is not the case if the inventor can present probable grounds for the creation of the invention after the employment.

These regulations are based on the Act on the Right in Inventions made at Higher Education Institutions (369/2006, later in this document referred to as “University Inventions Act”). The regulations define the procedure for making and processing invention disclosure notifications at the University of Jyväskylä, as well as the policy on rewarding inventors.

2 Definitions

An invention is something new, innovative, industrially applicable and reproducible. An invention is not merely an idea, but a concrete embodiment of it: a device, a product, or a method. An invention must meet certain criteria in order to receive a patent. The criteria for receiving a patent are defined in the Patents Act (550/1967).

In the context of these regulations:

1) **Open research** refers to

- a) research performed in an employment relationship in order to carry out research duties at the University without external funding or external contracting parties,
- b) research that would otherwise meet the criteria of commissioned research, but the University and the research partner have specifically agreed in advance that it is open research, or

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c) research undertaken with external funding, which does not imply any other provisions than those related to the publication of the results.

2) **Commissioned research** refers to

a) research constituting chargeable services in compliance with the Act on Criteria for Charges Payable to the State (150/1992),

b) research other than that referred to in paragraph 1 above or subparagraph a) of the present paragraph involving at least one party external to the University, either as the party performing part of the research, a financier or other participant, and including obligations related to research results or mode of implementation.

3) **Invention made under other circumstances** refers to

invention(s) that fall within the scope of application of these regulations, made under other circumstances than those referred to in paragraphs 1 or 2 above.

3 Invention disclosure notification

Prior to submitting an invention disclosure notification, the inventor may contact University Services' Research and Innovation Services team (later in this document referred to as Innovation Services). With an expert from Innovation Services, the inventor can clarify in advance, for example, the novelty and/or patentability of the invention, the appropriate time for submitting the invention disclosure notification, and other issues regarding protecting the idea.

In compliance with the "University Inventions Act", employees of the University must without delay inform the University of an invention they have made in the capacity of University employees. The University must be informed of all inventions made by the employees of the University, regardless of who the inventor considers to be the holder of the rights to said invention. The head of the research group must guide the inventors in making the invention disclosure notification, even if he/she had not made the invention. The head of the department must also urge his/her employees to make the invention disclosure notification.

The invention disclosure notification must provide sufficient information on the invention and the inventors, so that the University may evaluate the invention and clarify the holders of the rights to the invention, as well as whether collaboration contracts have been made regarding the invention. The notification must be submitted to Innovation Services online through the Greip IP system. An innovation advisor or other employee taking care of innovation or legal services will acknowledge the invention disclosure notification as received.

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The notification is made in the Greip IP system using a specific online form. To access the Greip IP system, open Intranet Uno and select Help Centre - IPR counselling - Invention Disclosure Form (<https://uno.jyu.fi/fi/ohjeet/ipr-neuvonta-ja-tutkimustulosten-kaupallistaminen/keksintoilmoitus-1>).

In the invention disclosure notification, the inventor or group of inventors express their idea of who is/are the inventor/s. The inventors also note their view of the research or situation in which the invention was created. All of the inventors involved confirm the correctness of the notification in the Greip IP system. If needed, the inventors must submit a clarification of the various inventors' contributions to the invention. For this purpose, careful documentation in a laboratory log book or other document is recommended. The head of the department will confirm in the Greip IP system that he/she has received information about the invention disclosure notification and informs whether he/she agrees with the researchers' view on the context in which the invention was created.

The invention disclosure notification must contain the following information: the inventors and their contact information, the title and description of the invention, information on the research projects on which each of the inventors has worked at the time when the invention was made and during six months preceding the date of the invention, the inventors' signatures, and the date. If the submitted invention disclosure notification does not provide all the required information, the representative of Innovation Services will notify the inventors without delay through the Greip IP system.

In addition to the invention disclosure notification, the inventor must give further information on the invention upon request.

4 The University's reply to the invention disclosure notification

Within two months of the date on which the University registers the receipt of the invention disclosure notification including the sufficient information, the University will inform the inventor of

- 1) the University's view on whether the invention was made in an open or commissioned research or under other circumstances
- 2) the measures conceded to and obligations falling on the University and the inventors based on the "University Inventions Act".

The reply does not contain the University's evaluation of the invention's commercial potential or patentability.

If the University and the inventor(s) disagree on the connection of the invention to the employment relation and research projects, the parties shall attempt to solve their disagreement firstly by negotiating. If the negotiations do not lead to an agreement, a statement on the matter may be requested from the Employee Invention Committee. As a final measure, the matter may be brought to the Helsinki District Court to be resolved.

5 Rights to the invention

5.1 Inventions made in open research

The inventor has the primary right to utilise an invention made in open research. The invention may be utilised both scientifically and commercially. University can acquire the rights to an invention made in open research after six months of receiving a due invention disclosure notification, if the inventor during this period has not published the invention or indicated his/her willingness to utilise it. The inventor may also indicate that he/she intends to utilise the invention after the abovementioned six months have passed.

Before the end of the six-month period, the inventor may voluntarily renounce his/her right to utilise the invention, and propose that the University make use of the invention.

5.2 Inventions made in commissioned research

Within six months of receiving an invention disclosure notification that contains the sufficient information, the University has the right to acquire the rights to inventions made in commissioned research. The University notifies the inventor of the rights acquisition in writing. The University strives to make decisions regarding the rights to inventions and patenting well before the expiration of the time limit set by legislation. This will ensure that potential patenting does not unnecessarily delay scientific publishing. When the University has acquired the rights to the invention in the manner referred to in this section, the inventor must, upon the University's request, sign the deed of transfer regarding the invention, as well as other necessary documents, without delay. The terms regarding the inventor's compensation and the distribution of profits received from the invention's utilisation will be agreed upon in a separate agreement, in accordance with these regulations.

5.3 Inventions made under other circumstances

If an invention that falls within the scope of the "University Inventions Act" has been made in circumstances other than open or commissioned research, the University takes priority in negotiating with the inventor over the rights to the invention. If the invention is necessary for the operation of the University, the University is also entitled to obtain the right to use the invention by paying a reasonable compensation.

6 Publication of research results

The inventor may not publish the results of commissioned research in a manner that would jeopardise the protection or utilisation of the invention. The inventor must not file a patent application for an invention or otherwise dispose of an invention before the expiry of the six-month time limit reserved for the University to adopt the rights. However, the inventor

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may do this if the University informs him/her in writing that the University will not acquire the rights to the invention or will give the inventor permission to patent the invention.

The University must not disclose the information given to it about the invention until the invention has been protected in a sufficient manner and there are no other particular reasons for confidentiality. The University can, however, disclose information about the invention to the parties of the research cooperation if the research contracts provide for the utilisation, transfer or notification of the results, and if the University has ensured that the dissemination of the information does not jeopardise the protection or utilisation of the invention.

The University may also disclose information about the invention to parties other than those involved in the research cooperation, if such disclosure is necessary for the evaluation or commercialisation of the invention. In such a case, the University must ensure that the protection or utilisation of the invention, or the inventor's primary scientific publication right, are not jeopardised.

7 Actions and decision-making at the University

The decisions at the University that fall within the scope of these regulations are made by Innovation Services after hearing the inventors and, if necessary, the University's cooperation partners and external experts. The Rector, or a person designated by the Rector, decides on agreements related to immaterial rights.

The University will take the necessary actions, acquire the necessary reports and statements, and make decisions on matters regarding inventions without undue delay.

8 Compensations

When the University acquires the rights to an invention, the inventor will have a statutory right to obtain reasonable compensation for the invention.

Rewards

The Rector, or a person designated by the Rector, confirms the reward sums for invention disclosure notifications, patent applications and granted patents.

Profit distribution

Costs are always incurred in the protection and commercial exploitation of an invention, but when these actions are performed successfully, they may also result in profit to be distributed after the costs have been deducted.

If the commercial exploitation of an invention results in net profit to the University (the costs

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incurred by the University employees' work are not deducted when calculating the net profit), the profit will be divided as follows:

- 50% of the net profit will be paid to the inventor(s)
- 25% of the net profit will be directed to the University department(s) in question
- 25% of the net profit will be directed to the University's common funds.

If the invention in question has been made by more than one person, the profit deemed to be paid to the inventors will be divided equally among the inventors, unless they have agreed otherwise before patent application, or unless the circumstances do not allow for the profit to be divided equally.

If the rights to the invention made in commissioned research are transferred to a research partner of the University on the basis of a research contract, the inventor will be reasonably compensated in a manner agreed upon in said contract.

9 Reporting and evaluating the results of innovation activity

University Services will monitor the implementation of these regulations. It will report annually on the results of innovation activity to the University Board, in connection with the Board Review, and to the Rector when necessary.

10 Entry into force, amendments and scope of application

These regulations will enter into force on 9 January 2019 and replace the former University of Jyväskylä Regulations Regarding Inventions, approved by the Rector on 10 February 2014. The regulations are valid until further notice. The Rector, or a person designated by the Rector, will decide on amendments to these regulations. The regulations will apply to inventions whose invention disclosure notification has been submitted after the regulations' entry into force.

Rector Keijo Hämäläinen