

IP summary for Grand Challenge projects

All projects come under the CAPE Partnership Agreement, the main terms relating to protection of intellectual property can be summarised as:

Foreground IP

- Any foreground IP developed solely by University staff belongs to the University (and any solely invented by CAPE Partner staff belongs to that Partner)
- Any IP with joint university and partner inventors has joint ownership.
- The participating CAPE Partner has an exclusive 6 month option period to take a non-exclusive license to the foreground IP on 'fair and reasonable terms'.
- The Partner can also seek to negotiate an exclusive licence with Cambridge Enterprise, but that does not have to be granted.
- The University has the right to use any resulting IP for teaching/non-commercially funded research.

Background IP

- The project partners grant each other non exclusive royalty free license to background IP necessary for completing the project for the duration of the project only (if this is prevented e.g. by an existing license terms then Partner must be informed before project start).
- The Partner can request a non-exclusive license to the background IP (on fair and reasonable terms) if it was necessary to exploit foreground IP from the project.

Protection of IP

- Foreground IP owned solely by the University will be protected by Cambridge Enterprise. (Note that CE are unlikely to file IP unless there is a good prospect that it will be licensed).
- If a Partner wishes University-owned IP to be protected in countries where the university has decided not to file, the Partner reimburses the University for the filing costs
- For jointly owned IP, filing costs will be shared equally for countries where the parties agree to pursue protection. Filing can be done through CE or suitably qualified patent professionals. If a party opts-out of protection in a country, their ownership share is transferred to the remaining parties on fair and reasonable terms and the remaining parties cover the filing costs.

CAPE Procedures

- We require all PIs to complete an IP checklist along with the project proposal detailing the relevant background IP, anything already invented or published should be declared then. The IP checklist is reviewed by Cambridge Enterprise before being sent to the CAPE Steering Committee as part of the proposal review process.
- All inventions in CAPE projects must be disclosed to Cambridge Enterprise.

Confidentiality

- The CAPE agreement covers confidentiality so a separate NDA is not required.
- Any students working on a CAPE project must have in place an appropriate studentship agreement that covers confidentiality and IP ownership.

Patent Application Procedure

In the event a potential patent arising from a CAPE research project, please inform Cambridge Enterprise (CE) and complete an invention disclosure, which can be done online at the address below. CE must be involved and be listed as the applicant using the details listed below, not the University of Cambridge (CU). CE is a part of the University of Cambridge, and it is the official CU body for patenting and knowledge transfer. Please contact them using the email address listed below.

Email: ps.ipportfolio@enterprise.cam.ac.uk

Website:

<https://www.enterprise.cam.ac.uk/for-the-university/develop-a-commercial-opportunity/get-started/>

Address: Cambridge Enterprise
The Old Schools
Trinity Lane
Cambridge
CB2 1TN