



University of
St Andrews

Operating Procedure for Filing and Prosecuting Registrable IP.

Document type	Procedure
Scope (applies to)	All staff and postgraduate students
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Purpose	To provide guidance on the University's approach to protecting intellectual property via patent applications

Version number	Purpose / changes	Document status	Author of changes, role and school / unit	Date
Patents/001				
Registrable IP/001				

Operating Procedure for Filing and Prosecuting Patents.

Purpose: The aim of the procedure is to provide guidance on The University's approach to protecting intellectual property via patent applications and other forms of IP filings. The procedure aims to ensure,

- 1) that the University of St Andrews owns the intellectual property generated,
- 2) identify whether there are any third-party obligations as a result of the terms and conditions of the research funding received by the University,
- 3) that the new invention has the potential to have a commercial application.

Responsibilities:

Academic Staff are required to,

- 1) support the procedure by completion of an invention disclosure form available from the Technology Transfer Centre (TTC). TTC staff will work with the academic member(s) of staff and provide guidance on how to complete the invention disclosure form,
- 2) confirm that they will support the development and/or commercialisation of the technology,
- 3) work with TTC staff with the aim of maximising the impact of the technology via either industrial or non-industrial partners

TTC staff are required to,

- 1) support academic staff in completion of the invention disclosure form
- 2) work with the academic member(s) of staff to support the assessment of technologies prior to filing a patent application
- 3) work with the academic member(s) of staff with the aim of maximising the impact of the technology via either industrial or non-industrial partners. This will include identification of and support for translational funding awards and licensing of technology,
- 4) keep inventors informed of decisions on IP filings and registrations,
- 5) work with the inventors in responding to IP prosecution, particularly in relation to patent examination reports

Procedure:

1. New disclosures

- a. Prior to filing a patent application or other IP registration, a new invention disclosure will be assessed by the Technology Transfer Centre (TTC) to determine
 - i. Ownership of IP and whether there are third party obligations
 - ii. Whether a confirmatory assignment has been executed.
 - iii. Has the IP been developed by University of St Andrews staff?
 - iv. Do any students have an inventive contribution?
 - v. Who funded the work and under what terms and conditions?
 - vi. Is there any known prior art as determined by discussion with staff, Google search, a publications search and a patent search if appropriate.
- b. What is the market potential?
 - i. Current technology
 - ii. Size of market
 - iii. Geographical considerations
 - iv. What problem is solved by the new technology
 - v. Potential licensees

2. Policy on disclosures

- a. It is recognised that publication in peer reviewed journals is an essential aspect of good research practice, supports career development, can support applications for future research funding and can lead to impact and public benefit. However, the protection of intellectual property must also be considered as it can support development of new technologies and may be a condition of the funding that has led to the invention.
- b. The TTC will work with the academic(s) to consider disclosure requirements alongside the obligation to consider the protection of the intellectual property.
- c. Where new discoveries are made that may constitute an invention an "Invention Disclosure Form" must be completed prior to public dissemination.
- d. If disclosure has taken place then it may be possible to file a US patent application within 12 months of the original disclosure but these cases should be by exception.

3. Patent applications

- a. UK priority applications
 - i. If the outcome of the assessment of new disclosure as described in 1 above is considered satisfactory the TTC will seek approval from the Business Ventures Group (BVG) to file a UK priority patent application. Once approval is secured, the TTC will work with the member of staff and an appointed patent agent to file a UK priority patent application
- b. PCT applications
 - i. 12 months after the filing of the UK priority application the University, following approval by BVG, will proceed with a PCT application BUT only after review of a report on activity since the filing of the UK priority application;
 - ii. The report must include an update on the market and commercial potential of the technology, a technology report highlighting any development in the technology since the UK filing date, an update on any additional funding to support development of the technology either awarded or applied for and whether there has been any contact and/or discussions with an industry or non-industry partner
- c. Within 12 months of filing a PCT application the University, via the BVG, will consider entering the National Phase in defined territories
- d. National Phase applications
 - i. National Phase applications will not proceed unless there is a report on what activities have been undertaken since the UK priority filing and an update on the commercial potential of the invention.
 - ii. The report must include an update on the market and commercial potential of the technology, a technology report highlighting any development in the technology since the PCT filing date, an update on any additional funding to support development of the technology either awarded or applied for and whether there has been any contact and/or discussions with an industry or non-industry partner
 - iii. National Phase filings will be dependent on either translational funding or tangible commercial interest with the aim, where possible, of patent costs being covered from National Phase.
 - iv. Entry into National Phase will be limited to Europe and the USA unless there is a commercial case for additional territories to be included.
 - v. Where the invention is the subject of a commercial arrangement then filing will take into consideration the requirements of the commercial entity, with the University retaining the right for final decisions.

4. Non Patent IP filings:

- a. Applications
 - vi. If the outcome of the assessment of new disclosure as described in 1 above is considered satisfactory the TTC will seek approval from the Business Ventures Group (BVG) to file application(s) in appropriate territories. Once approval is secured, the TTC will work with the member of staff and an appointed attorney to file the application(s).