

## APPENDIX B

### Intellectual property Rights Policy for Staff, Students and Visitors

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#### 1 Preamble

1.1 The Intellectual Property Rights Policy (“Policy”) sets out the University’s policy on Intellectual Property Rights for works produced at the University by Staff, Students and Visitors of the University. It is important for Staff, Students and Visitors to understand their rights as well as how to protect such rights in order to avoid potential disputes when engaging in research and writing.

1.2 Staff, Student and Visitors during their course of study, employment, engagement or appointment generate original work. Staff, Students and Visitors, as creators of intellectual property, together with the University, have rights in respect of the fruit of their intellectual endeavours and work. These Intellectual Property Rights are protected under the laws of Hong Kong.

1.3 The University believes in promoting knowledge exchange and knowledge sharing and encouraging the flow of knowledge between the University and the community for mutual benefit. The University is a signatory to the Berlin Declaration on Open Access to Knowledge in the Sciences and Humanities, which recognizes that information should be made widely and readily available to society and encourages and advocates open access publication.

#### 2. Definitions

**Author** means the creator of a Copyright work.

**Copyright** means a collection of rights relating to original literary, dramatic, musical, and artistic works, sound recordings, films, broadcasts, cable programmes and the typographical arrangement of published editions. For the avoidance of doubt, ‘literary work’ includes software and digital publications.

**Course of employment** means any work undertaken by a Staff member in performing the duties for which the Staff member has been engaged and within the scope of the duties described in the Staff member’s contract of employment.

**Database** means a collection of independent works, information, data or other materials that are arranged in a systematic or methodical way and are individually accessible by electronic or other

means. The database may consist of textual entries (e.g. names or phone numbers), or independent works such as photographs or videos.

**Evaluation Committee** means the committee of the Technology Transfer Office responsible for evaluation the patentability and marketability of Inventions disclosed by Staff and Students.

**Institutional Work** includes works created using University funding (including funding obtained by the University from internal and external sources) and works that are commissioned by the University.

**Intellectual Property Rights (IPR)** means any and all intellectual and industrial property rights now in force or that come into force in the future in any part of the world whether or not registered or registerable and includes all applications and rights to apply for registration (and renewals and extensions of any registration) of such rights as well as all rights of action and remedies in relation to past infringements including rights in or in connection with:

- (a) confidential information, business or trade secrets, know-how;
  - (b) Inventions, Patents (including supplementary protection certificates);
  - (c) Copyright (including the rights to secure Copyright renewals and extensions of Copyrights, Copyright not yet in existence but that comes into existence in the future and all other rights of a like nature by law in force in any part of the world);
  - (d) Trade Marks, service marks, business or trade names; and
  - (e) Design rights, topography rights,
- together with all other rights of a similar or corresponding character or nature.

**Invention** means the conception and reduction to practice of a useful, novel and non-obvious product or process, or improvement thereon, for which a Patent may be obtained.

**Inventor** means the person who invents, develops or discovers an Invention.

**Licence** means a contract in which an intellectual Property Rights holder gives permission to another to perform any Restricted Acts in relation to the intellectual property.

**Net Receipts** means the total Royalties and fees generated from the commercialization (including but not limited to, joint venture and licensing) of an Invention or discovery, less:

- (a) all expenses reasonably incurred by the University and/or its wholly owned subsidiary (including patent agents fees and legal fees) for the filing, maintenance, protection and preservation of Intellectual Property Rights in connection with the Invention or discovery;
- (b) all expenses reasonably incurred by the University and/or its wholly owned subsidiary (including patent agents fees and legal fees) for the commercialization of the Invention or discovery; and

- (c) where the Invention is jointly owned by another university, legal entity or institution, 10% to 20% of gross Royalties to cover internal administrative overheads;
- (d) amounts of taxation payable by the University and/or its wholly owned subsidiary in respect of the Royalties;
- (e) any other expenditure that is agreed with the inventor(s).

**Patent** means a grant which gives the owner of an Invention a right to exclude all others from making, using, selling or importing the Invention in the relevant jurisdiction.

**Restricted Acts** means:

- (a) in relation to Copyright, the exclusive rights of a Copyright owner in respect of a work, including the right to make copies, to authorize other persons to make copies, to make available copies of a work to the public, to perform, show or play the work in public or to make an adaptation of the work;
- (b) in relation to Patents, the exclusive rights of a Patent owner in respect of an Invention, including the right to make, use, sell, put on the market, stock, offer for use, or import the Invention;
- (c) in relation to Trade Marks, the exclusive rights of a Trade Mark owner in respect of a Trade Mark, including the right to use the Trade Mark in trade or business (including without limitation, to apply the Trade Mark to goods or their packaging, offer or expose goods for sale bearing the Trade Mark, put goods on the market bearing the Trade Mark, offer or supply services under the Trade Mark, import or export goods bearing the Trade Mark, or use the Trade Mark on business papers or advertising);
- (d) in relation to Designs, the exclusive rights of a Design owner in respect of a Design, including the right to make, import, sell or hire any article in respect of which the Design is registered, or offer or export such article for sale or hire.

**Royalty** means a payment made to an Intellectual Property Rights holder for the right to use his or her intellectual property.

**Staff** means a person who is a member of the University's academic or non-academic staff (whether full-time or part-time).

**Student** means any full-time or part-time graduate or undergraduate student.

**Substantial use of University resources** means use of time for which the University is compensating the inventor, creator or author to provide services for the University; use of funding provided by the University and/or funding that is made available to the inventor, creator or author in the form of grants, contracts or awards from external sources; and/or use of any University resources that are not ordinarily used by, or available to, that Staff member or Student, but does not include an incidental

use of University resources. For the avoidance of doubt, casual use of library and desktop computer facilities shall not be considered to be a substantial use of University resources.

**Technology Transfer Office** means the office of the University responsible for managing and administrating the University's intellectual property, including without limitation administering Patent applications.

**Trade Mark** means a distinctive name, sign, logo or indicator used by an individual, business or other legal entity to distinguish its goods and/or services.

**University** means the University of Hong Kong, including all campuses of the University, whether located in Hong Kong or elsewhere.

**University Domain Names** means any domain names registered by the University from time to time, including without limitation, [www.hku.hk](http://www.hku.hk), [www.hku.edu.hk](http://www.hku.edu.hk) and any related sub-domain names.

**University Marks** means “The University of Hong Kong”, “香港大學”, the acronym “HKU”, “港大”, all other names, abbreviations, logos, whether registered as a trade mark or not, and any other form of visual identity that connotes an association with the University.

**Visitor** means a person who is not Staff, who takes part in teaching, research and other activity that would normally be conducted by Staff, including without limitation a scholar on short term exchange with the University, adjunct professors and honorary professors.

### 3. Application of Policy

3.1 This Policy applies to Staff, Students and Visitors of the University.

3.2 This Policy constitutes an understanding which is binding on the University and on the Staff, Students and Visitors to whom this policy applies, as a condition for participating in research programs at the University, for the use of University funds or facilities, or for commencing employment or studies with the University.

3.3 This Policy shall be incorporated in all employment contracts for Staff joining the University after this Policy has been implemented.

### 4. Overview

4.1 The key provisions of this Policy regarding Intellectual Property Rights of Staff, Students and Visitors are summarized below:

4.1.1 Staff

- (a) The University shall own all Intellectual Property Rights in works generated by Staff in the course of their employment with the University.
- (b) However, the University will normally only enforce such rights under a limited set of circumstances, including where the work was generated using a substantial use of University resources or personnel, where the work is an Institutional Work, or where the work is subject to an agreement signed by the Staff which requires the Staff to assign rights to the University or a third party.
- (c) Intellectual Property Rights in works generated by Staff in the course of an exchange with another institution shall be dealt with by the mutual agreement of the two institutions in accordance with their respective Intellectual Property Rights policies. It is recommended that a formal agreement regarding Intellectual Property Rights is entered into between the two institutions as early as possible.

#### 4.1.2 Students

The University may assert ownership of Intellectual Property Rights for works generated by Students in the course of study. However, the University shall not assert ownership of Intellectual Property Rights in the following circumstances:

- (a) Where the work is not an Institutional Work. For the avoidance of doubt works created in connection with graduate assistantships or scholarship grants to Students to pursue academic activities towards an advanced degree shall not be considered to be Institutional Works; or
- (b) where there has not been a substantial use of University resources or personnel; or
- (c) where the work consists of Student coursework or a Student's contribution to a written thesis, as outlined in more detail at paragraphs 5.1.2 and 5.1.3 below.

#### 4.1.3 Visitors

As a result of any Visitor having access to and use of any University facilities, equipment, accommodation or intellectual property, or participating in any teaching or research activities of the University, the University may require the Visitor to: (i) sign a confidentiality agreement in a form approved by the University; (ii) disclose to the University, immediately upon creation, full details on any Intellectual Property Rights created by the Visitor; (iii) do all things and sign all instruments necessary to assign such Intellectual Property Rights to the University; and/or (iv) give consent in relation to any moral rights he or she may have in the relevant work.

#### 4.1.4 Collaborative work

Depending on the nature and level of contributions made by other collaborators, Intellectual Property Rights *may* be shared between two or more parties,

including but not limited to supervisors, Students, Staff, the University and collaborating universities.

#### 4.2 Role of Staff

Staff are required to have an understanding of Intellectual Property Rights issues. This is particularly important when supervising research students, deciding when and what to publish about their work, negotiating with third party research sponsors, and in collaborative efforts with other institutions.

#### 4.3 Role of Supervisors

4.3.1 In different fields of study and research projects, the role of a supervisor varies and this has an implication on the arrangement of Intellectual Property Rights generated in research projects. A Student is expected to receive guidance from his or her supervisors. In the event that a supervisor merely acts as a mentor or a consultant, the Student will have the primary right to any Intellectual Property Rights generated in connection with the project. However, if a student works on an established research project and makes a substantial use of University resources assigned to the supervisor, the University shall own the Intellectual Property Rights created in connection with the research project.

4.3.2 In the event that a supervisor initiates a substantive idea in a research project, the University, as the employer of the supervisor, shall own the Intellectual Property Rights generated in connection with the research project, subject to any agreement to the contrary.

4.3.3 In the event that a supervisor and a Student collaborated in the conception and design of an Invention, and the work made a substantial use of University resources, the Invention and any resulting patents will be owned by the University.

4.3.4 In the event that a supervisor and a Student collaborated in the conception and design of an Invention in which the intellectual effort is inseparable, and the work did not make a substantial use of University resources, the Invention and any resulting patents will be jointly owned by the University and the Student. The percentage of Intellectual Property Rights ownership should be agreed between the supervisor and the Student as early as possible.

#### 4.4 Role of Students

All Students are required to familiarize themselves with this Policy. It is important that Students, before joining a research project, make enquiries with their supervisor or project group regarding Intellectual Property Rights for the research project and should agree on the Intellectual Property Rights arrangement for the research project.

#### 4.5 Student research in conjunction with externally funded projects

In the case of externally funded projects, the University may be under a contractual obligation to assign all or part of the Intellectual Property Rights to a third party. Before a Student participates in such a project, he or she is required to make enquiries with his or her supervisor regarding the Intellectual Property Rights arrangement for the project.

The University may, in its sole discretion, require the Student to sign a written agreement acknowledging and agreeing to the Intellectual Property Rights arrangement for the project.

## 5. Copyright

5.1 The University's policies on relation to copyright in various categories of works are outlined below:

### 5.1.1 Scholarly work and teaching materials created by Staff

- (a) The University does not normally exercise its claim of copyright ownership over any work created by Staff that is of a scholarly nature or created for teaching purposes.
- (b) Staff grant the University a royalty free, perpetual, non-exclusive, worldwide licence to use the work for non-commercial purposes. The licence granted under this clause shall continue after the Staff is no longer employed by the University.
- (c) Staff may submit their work to publishers and assign copyright in the work to a publisher as they judge appropriate, subject to any pre-existing licence granted in respect of the work. Staff shall procure that the University is granted the right to re-use the scholarly work (including any subsequent editions) for non-commercial purposes, including without limitation, posting the work on the University's institutional repository, the HKU Scholars Hub (the "**Hub**").
- (d) Where publishers' agreements permit, once a work is published, the University encourages Staff to submit their prior version of the published work ("**Author's Manuscript**") to the Hub to facilitate knowledge sharing. Administrators of the Hub will be responsible for confirming that the relevant publisher's agreement permits the posting of the Author's Manuscript, prior to posting any manuscripts on the Hub.
- (e) Works which have been specifically commissioned by the University or works governed by agreements with research sponsors will be governed by those agreements and not the above.

### 5.1.2 Student coursework

- (a) The Student shall retain copyright in his or her work submitted in the course of his or her study, including papers, essays, reports and articles.
- (b) The Student grants the University a royalty free, perpetual non-exclusive worldwide licence to use the work (i.e. perform any Restricted Acts in relation to the work) for non-commercial purposes. The licence granted under this clause shall subsist after the Student is no longer enrolled as a student of the University.

### 5.1.3 Student thesis

- (a) The Student shall retain copyright in his or her written thesis.
- (b) The Student grants the University, in particular the University Libraries and the University Archives, a royalty free, perpetual, non-exclusive worldwide licence to circulate the thesis or use the thesis for other non-commercial purposes. The licence granted under this clause shall persist should the Student no longer be enrolled as a Student of the University.
- (c) If research data included in a thesis are obtained by a collaborative effort (including collaboration between the Student and a supervisor or other researcher at the University), such data may be the joint property of the Student and the collaborating party. It is strongly advised that Students and supervisors/researchers make clear agreements in advance concerning the ownership and use of Intellectual Property Rights created in connection with a Student thesis.

#### 5.1.4 Jointly authored work

- (a) Where two or more Staff and/or Students have collaborated on a work in which the contributions of the collaborators are not separable, this work will be jointly owned by all Authors.
- (b) Where two or more Staff and/or Students have collaborated on a work in which each person's contribution is distinct (e.g. a chapter of a book is written by a different author), the work is a collective work and each Author shall own copyright in his or her individual work.

#### 5.1.5 Work involving substantial use of University resources

Where a work has been created by staff or students making a substantial use of University resources, the University shall retain ownership of such works, subject to any written agreement to the contrary. Where there may be a question of whether a work involves substantial use of University resources, it is strongly advised that an agreement relating to Intellectual Property Rights should be reached between the parties before the use of such resources.

#### 5.1.6 Software

- (a) The copyright in software created by Staff and Students shall normally be retained by the Authors of such software. However, the University shall retain ownership of the copyright in software produced by Staff and Students in the following circumstances: (i) where there is a substantial use of University resources; (ii) where the software is an Institutional Work; (iii) where the software was developed by a Staff member in the course of his or her employment.
- (b) Software developed as a result of work partially or fully funded by an external organization through a contract or grant to the University, shall be governed by the terms of the contract or grant.
- (c) If a Student creates software working in conjunction with a supervisor and both parties contribute original intellectual labour, and the

contributions are not separable, the work shall be jointly owned by the Student and the University.

- (d) Staff and Students grant the University a royalty free, perpetual, non-exclusive worldwide licence to use the software for non-commercial purposes. The licence granted under this clause shall continue after the relevant Staff and Students are no longer associated with the University.

#### 5.1.7 Databases

A database is protected by copyright law in Hong Kong, provided that the selection or arrangement of the contents meets the minimum standard of originality, i.e. that a sufficient amount of skill and labour is involved in the selection or arrangement of the contents of the Database.

- (a) Databases created as part of an established University project

The University may own copyright in a Database (e.g. a DNA Database on plant genomics produced by the Department of Biology). If a student undertakes laboratory research and expands any such Database, the Student may not have any rights to the Database as the Student's effort was performed as part of an established University project. It is recommended that the Student and supervisor discuss Intellectual Property Rights and arrive at a written agreement before commencing the work.

- (b) Databases created as part of student coursework

If a student creates a Database as part of course requirements (e.g. a database of eating habits for a marketing research project), the Student shall retain ownership of the copyright in the Database. The Student grants the University a royalty free, perpetual, non-exclusive worldwide licence to use the Database for non-commercial purposes. The licence granted under this clause shall continue after the Student is no longer enrolled as a Student of the University.

- (c) Databases jointly created by a Student and a supervisor

When a Student creates a Database and works in conjunction with a supervisor and both parties have been involved in the selection and arrangement of the contents of the Database, the copyright in the Database will be jointly owned by the University and the Student.

#### 5.1.8 Work created on the University web server

A Student shall retain ownership of any work that he or she creates and places on the University website. The Student grants the University a royalty free, perpetual, non-exclusive worldwide licence to use the work for non-commercial purposes. The licence granted under this clause shall continue after the Student is no longer enrolled as a Student of the University.

#### 5.1.9 Institutional works

The University shall retain ownership of Institutional Works and works resulting from simultaneous or sequential contributions over time by multiple Staff and

Students, such that the work can not be attributed to a single Author or a discrete number of Authors.

#### 5.1.10 Videotaping and related classroom technology

Copyright in audio recordings and audiovisual recordings of courses taught at the University or courses developed for the University shall be the property of the University. Videotaped courses and courses recorded using any other media are University property and may not be reproduced, distributed, performed or displayed without permission of the University.

### 6. Patents

#### 6.1 Inventions protected by patents

In order to be patentable, an Invention must be new/novel, involve an inventive step and be capable of industrial application. Patents apply to a wide variety of Inventions, including machines or devices (e.g. a laser printer, an electronic circuit), processes (e.g. a genetic engineering procedure, a business process), chemical compounds (e.g. a drug), new life forms (e.g. a genetically altered life-form). A Patent, once granted, prevents anyone else from using the Invention without the patent owner's permission for a fixed term. After the Patent expires anyone is able to use the Invention without a requirement to obtain the former Patent owner's permission.

#### 6.2 Duty to report Inventions

6.2.1 Staff and Students shall immediately notify and disclose to the Technology Transfer Office of the University any potentially patentable discoveries or Inventions made by them. The Evaluation Committee shall evaluate the patentability and marketability of Inventions disclosed by Staff and Students, and where appropriate, the Technology Transfer Office will administer the Patent application of the Staff and Students.

6.2.2 The First step to report an Invention is to complete and submit an Invention Disclosure Form (IDF) to:

Technology Transfer Office  
The University of Hong Kong

6.2.3 The Invention Disclosure form is obtainable from the Technology Transfer Office or can be downloaded from its website: [www.tto.hku.hk](http://www.tto.hku.hk).

#### 6.3 Confidentiality

It is important that any information about a potentially patentable Invention is not prematurely disclosed. Telling a third party about the information generated by a research project could constitute a disclosure and may mean that the invention loses the necessary quality of novelty, resulting in the Invention becoming un-patentable. In the event that Staff and/or Students need to discuss the details of an Invention with outside academics or potential developers, they should ensure that a non-disclosure agreement (in the form provided by the Technology Transfer Office) has been executed before disclosing any information about the Invention.

#### 6.4 Staff Inventions

- 6.4.1 Patentable Inventions made by Staff in the course of employment or with more than incidental use of University resources or developed under a project funded by or through the University must be disclosed to the University. Staff, as a condition of their employment with the University, shall assign all right, title and interest in such Inventions and/or Patents to the University and shall cooperate with and assist the University in the Patent application process, including without limitation, executing any deed of assignment and other documentation necessary to file a Patent application.
  - 6.4.2 Staff should not enter into any agreement with a third party which conflicts with their obligation to the University under this Policy. Each Staff member should make his or her obligations under this Policy clear to any third party when negotiating a sponsorship or consultancy agreement.
- 6.5 Student Inventions
- 6.5.1 Patentable Inventions created by a Student in the course of study and developed with more than incidental use of University resources and/or developed under a project funded by or through the University should be disclosed to the University. The Student Inventor shall assign all such Inventions and/or Patents to the University and shall cooperate with and assist the University in the Patent application process, Including without limitation, executing any deed of assignment and other documentation necessary to file a Patent application.
  - 6.5.2 Inventions made by a Student outside his or her course of study and without the use of University facilities or funding shall be the property of the Student, subject to any agreement to the contrary.
- 6.6 Decision to Patent an Invention
- 6.6.1 The University may, in its sole discretion decide to obtain a Patent for an Invention made by Staff and Students. The Evaluation Committee in the Technology Transfer Office is responsible for evaluating the patentability and marketability of an Invention.
  - 6.6.2 Where the Evaluation Committee decides to file a Patent application, such invention shall be filed in the name of the University.
  - 6.6.3 When the Evaluation Committee declines to file a Patent application for an Invention created by a Staff member and/or Student within a reasonable time, or where the University pursues an Invention but subsequently abandons the pursuit of the Patent or licence agreement, the relevant Staff member and/or Student may request the University in writing to waive the University's interest in the Invention. Upon receipt of the request, the Pro-Vice Chancellor and Vice-President (Research) and the Director of the Technology Transfer Office shall consider the case in the light of the University's obligations to sponsors, if any, and on whether the waiver would be in the best interest of the University, as well as whether the waiver would result in any conflict of interest. If the request is approved, the Intellectual Property Rights in the invention/Patent will be

assigned to the relevant Staff member and/or Student who will then be free to file a Patent application at his or her own cost and/or dispose of the Invention as he or she wishes. The relevant Staff member or Student shall grant the University a royalty free, perpetual, non-exclusive worldwide licence to use the Invention for non-commercial purposes. The licence granted under this clause shall persist should the relevant Staff member and/or Student no longer be associated with the University.

6.7 Fragmented IPR ownership - staff from another university

When a Staff member joins the University from another institution and undertakes the same area of research, it may result in fragmented ownership of Intellectual Property Rights. It is recommended that a formal agreement regarding Intellectual Property Rights is entered into between the two universities as early as possible. Any Patents which result from the research will normally be co-owned by the two universities and the distribution of derived Royalties between the universities will normally be negotiated after an invention disclosure, but prior to the initiation of the Patent application.

6.8 Intellectual Property Rights subject to an agreement with a sponsor

If a Staff member has obtained a grant which expressly provides that all intellectual Property Rights belong to the sponsor of the grant, any patentable invention which results from this research shall be governed by the agreement between the sponsor and the University, even if the project has made substantial use of University resources.

6.9 Sharing of Royalties with Inventor(s)

The University shall share Royalties from Inventions assigned to the University with the Inventor(s). The Net Receipts arising from the exploitation of an Invention shall be shared between the University, the relevant faculty/department and the inventor(s) in the ration of 1/3 : 1/3 : 1/3. The University reserves the right to amend the Royalty distribution at any time. Staff and Students should consult the Technology Transfer Office for more details regarding the distribution of Royalties.

7. Trade Names, Marks and Domain Names

7.1 Approval for use

7.1.1 The University Marks and University Domain Names are the property of the University. They are used to identify the University and its academic programmes, publications, services, products, etc. Staff and Students are not permitted to use the University Marks without the prior approval of the Vice-Chancellor or his or her designated authority.

7.1.2 In general, the University will not approve the use of the University Marks to endorse any commercial products or services. See the “Policies and Guidelines on the Use of the University’s Name and Visual Identity” available on the University’s website (<http://www.hku.hk/uid/detail.html>).

7.2 Authority to licence

The University has authority to licence the University Marks for commercial use and collect Royalties.

### 7.3 Products displaying University Marks

The University Marks must not be displayed on any products without the prior approval of the University. The University may, in its discretion, grant Staff and Students licences to use the University Marks in the manner contemplated by this clause.

### 8. Governing law and jurisdiction

This Policy and any dispute or claim arising out of or in connection with it or its subject matter shall be governed by and construed in accordance with the laws of the Hong Kong Special Administrative Region. The Courts of the Hong Kong Special Administrative Region shall have exclusive jurisdiction to settle any dispute or claim that arises out of or in connection with this Policy.

### 9. Amendments

The University reserves the right to amend this Policy from time to time.