UNIVERSITY OF OULU CODE ON INVENTIONS

1. PURPOSE OF THE CODE

The basic duties of the University of Oulu (‘the University’) are academic research and research-based education. In carrying out its tasks, the University must interact with the surrounding society and promote the social impact of research findings. New business opportunities can emerge in connection with these duties. The University encourages and helps its staff to identify such opportunities.

The aim is to exploit research outcomes and inventions produced at the University of Oulu so that they add value to the University staff, the University, and to society as a whole.

The purpose of this Code is to establish the procedure based on the Act on the Right in Inventions Made at Higher Education Institutions (369/2006, ‘the Inventions Act’) for the processing of inventions made by University employees.

2. SCOPE OF APPLICATION

This Code applies to all inventions made by persons employed by the University of Oulu during employment or within six months thereafter, which may be patentable in Finland.

3. APPLICATION OF THE CODE TO STUDENTS AND GRANT RESEARCHERS

This Code applies to university students and grant researcher in an employment relationship with the University.

If a student or grant researcher works in a University research project without an employment relationship with the University, the head of the research team and the head of unit must ensure that “an agreement on
project addenda” (i.e. a transfer of rights agreement) is concluded between the student/grant researcher and the University before commencing work. This agreement ensures that the University has the right of ownership to the results of the student’s/grant researcher’s work to the extent required by the Inventions Act and any research agreements.

4. Definitions

For the purposes of this Code:

A. Open research
   a) refers to research performed in employment for the fulfilment of the research duties of the University, without outside funding and without external contractual partners participating in the research;
   b) research performed with the funding of an external party but which does not imply any provisions other than those related to the publication of the results; or
   c) research which would otherwise meet the criteria of contract research, had the University and the research cooperation partner agreed before the start of the research that it is open research.

B. Contract research
   a) refers to research constituting chargeable services under the Act on Criteria for Charges Payable to the State (150/1992); or
   b) research other than that referred to in paragraph A 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 liabilities related to results or the mode of implementation of the research.

C. Invention made under other circumstances
   refers to an invention under the scope of this Code, made during operations other than the research referred to in paragraphs A or B.
5. INVENTION DISCLOSURE

According to law, a person employed by the University must immediately inform the University after having made an invention. The disclosure obligation applies to all inventions made in employment, irrespective of the inventor's view of the right of ownership to the invention. The head of the research team must instruct the inventors in the team to file an invention disclosure, even if they are not one of the inventors. Similarly, as a manager, the head of unit must also instruct inventors to file an invention disclosure.

The invention disclosure must be made in writing by completing the invention disclosure form, which is available on the University intranet with the filling instructions.

The invention disclosure must contain sufficient information about the invention and each of the inventors to enable the University to analyse the invention, as well as to establish the rights to the invention and possible related collaboration and other agreements.

In the invention disclosure, the inventor or group of inventors specify their views on the inventor(s). They also specify their view on the type of research or circumstances in which the invention was born.

Furthermore, inventors are obliged, if necessary, to provide an account of the contribution of each inventor to the creation of the invention. It is recommended to keep a detailed laboratory notebook.

The invention disclosure must contain the following information: the inventor(s) with contact details, the name of the invention and a description of the invention, and a list of research projects in which the inventor has worked at the time of the invention and during the six months preceding it. If the invention disclosure submitted does not contain sufficient information, the University informs the inventor without delay of the lack of information.

The completed invention disclosure must be submitted electronically using the Greip® invention disclosure tool.
The invention disclosure is deemed to have been submitted to the University when the University’s Innovation Manager or other person performing the post has deemed the disclosure to contain sufficient information and has marked it as received.

Moreover, the inventor must at request provide the University with other necessary information about the invention.

The inventor is not entitled to file a patent application in his/her own name until the University has given the inventor the notice referred to in section 5 of the Inventions Act.

6. UNIVERSITY NOTICE

Within two months of the date on which the University received the invention disclosure with the sufficient information, the University must provide the inventor with a notice specifying:

1) whether the University agrees with the inventor’s view on whether the invention was made in an open or contract research situation or under other circumstances;
2) the admissible measures and requirements applicable to the university and the inventors by virtue of the Inventions Act.

The University notice does not contain an assessment of the commercial applicability or patentability of the invention.

If the University fails to give the notice under this section, the University is deemed to have waived its rights to the invention in the case of contract research or its secondary rights to the invention in the case of open research.

If the views of the University and the inventor(s) differ as regards the connection of the invention to the employment relationship and research projects, the aim is to primarily settle the dispute through negotiations. If the negotiations fail to lead to a result, an opinion may be requested from the Employee Invention Committee, and ultimately the decision may be referred to the Helsinki District Court.
7. RIGHTS TO THE INVENTION

A) in open research

The inventor has the primary right to exploit the invention created in open research. Exploitation can be both scientific and economic.

The University is entitled to acquire the rights to an invention made in open research if the inventor has not published the invention or notified his/her willingness to exploit the invention within six months of submitting the invention disclosure containing sufficient information. The inventor may also declare that he/she will not exploit the invention until after the six-month time limit referred to above.

Prior to the time limit, the inventor may voluntarily declare that he/she will not make use of the invention and express a wish that the University take action to exploit the invention.

B) in contract research

The University is entitled to acquire the rights to inventions made in contract research within six months of submitting the invention disclosure containing sufficient information. During this period, the University processes the invention disclosure, obtains expert opinions on the invention, if necessary, and examines other relevant issues (e.g. contractual obligations and the interests of contracting partners) as appropriate. The University informs inventors of the decision to redeem the rights to the invention electronically.

The University aims to make the decision on the rights and protection measures more quickly than the time limit set out in law, so that possible protection measures concerning the invention do not unnecessarily delay scientific publication.

Once the University has acquired the rights to the invention under this section, the inventor must, at the request of the University, sign the deed of transfer regarding the invention, as well as other necessary documents without delay. In the deed of transfer, the parties agree, among other things, upon the compensation paid to the inventor and the distribution of the income from the invention.
C) under other circumstances
The University takes priority in negotiating with the inventor on the rights to the invention if the invention has been made in circumstances other than in open or contract research. If the invention is necessary for the operation of the University, the University also has the right to obtain the right to use the invention against reasonable compensation. Such a procedure must be agreed upon separately.

8. CONFIDENTIALITY, PUBLICATION OF RESEARCH RESULTS AND DISCLOSURE OF INFORMATION ON THE INVENTION MADE IN COLLABORATIVE RESEARCH

If the University is entitled to acquire the rights to the invention, the inventor may not publish the research results in a manner that would jeopardise the protection or other exploitation of the invention. While the University processes the invention disclosure, the inventor may not disclose the content of the invention to a third party. The inventor must request permission to disclose the content of the invention, for example, in connection with a scientific presentation or article, in which case the parties may agree to postpone, for example, the article or presentation until the patent application concerning the invention has been drawn up and filed with a patent office.

The inventor may not submit a patent application for or otherwise control an invention made in contract research before the end of the six-month period reserved for the University, unless the University informs the inventor electronically or in writing that the University will not acquire the rights to the invention or gives the inventor a written permission to patent his/her invention.

The University may not disclose any information disclosed to it about the invention until the invention has been protected in a sufficient manner and there are no other particular reasons for confidentiality. However, the University may disclose information on the invention to parties involved in research cooperation if the research agreements provide for the exploitation, transfer or notification of the results. In that case, the University must ensure that the disclosure of information does not jeopardise the inventor’s primary scientific publication right or the protection or exploitation of the invention.
The University may also disclose information on the invention to parties other than those involved in research cooperation, if such disclosure is necessary for the exploitation of the invention. In that case, the University must ensure that this does not jeopardise the inventor’s primary scientific publication right or the protection or exploitation of the invention.

9. **Selling, Licensing and Protection of the Invention When the University Has the Rights to the Invention**

When the University has acquired the rights to the invention, the University has the right to decide on the exploitation of the invention (e.g. selling or licensing), as well as on the publishing, internal uses, and protection of the invention. The primary aim is to sell the rights of ownership or use concerning the invention to the contracting parties who, by virtue of the research agreement, have the priority in negotiating on the exploitation of the invention.

Where the University decides not to sell the invention but retains the rights to the invention and only grants licences to use the invention, the University typically takes care of the protection of the invention.

The University may, at its discretion, combine the protection and maintenance of patent protection of multiple inventions.

The University selects the intellectual property firm and other specialist services to be used and instructs them on the necessary measures. The inventor is not entitled to agree on these matters on behalf of the University.

The inventor has a duty to assist in the drafting of patent applications and responses to interim decisions and in other expert tasks concerning the protection of the invention. The inventor also has a duty to act as the expert in connection with the exploitation of the invention owned by the University. If the invention is sold or licensed by the University, the potential obligations of the inventor and compensation for the expertise are agreed with the buyer separately.
10. **Compensation to the Inventor**

When the University acquires the rights to the invention, the inventor has the legal right to a reasonable compensation for the invention.

The aim is to make inventions as widely available as possible. This may require several years of work, and during this time the University will also incur direct costs from fees paid to external parties.

Each year, the principal, who is also responsible for the University’s cooperation relationships, establishes the amount of fees payable for inventions and the criteria for distributing net income.

The net income generated by the invention is distributed between the inventor, the University research unit where the invention was made, and the University. ‘Net income’ means the amount of money paid by the user of the invention to the University less the invention protection and commercialisation fees paid by the University to external parties.

The current compensation criteria are available on the University intranet.

11. **University Activities and Decision-Making**

The decisions of the University within the scope of this Code are taken by the University Innovation Centre after consulting the inventors concerned and, where appropriate, the University’s partners and external experts.

The University takes the necessary measures, obtains the necessary reports and opinions, and takes decisions on inventions without undue delay.

12. **Other Obligations of the Inventor**

If an inventor covered by this Code also has obligations towards another employer, this Code will not affect these obligations. If an inventor also makes an invention disclosure to an employer other than the University of Oulu, they must disclose this in their invention disclosure to the University.
13. **ENTRY INTO FORCE AND ENFORCEMENT**

This Code on Inventions will enter into force on 1 June 2020 and will replace the previous Code on Inventions approved by the University's Board of Directors on 1 January 2007. The Code applies to inventions for which the invention disclosure has been submitted after the entry into force of the Code.

The University Innovation Centre reports to the University's Board of Directors on the enforcement of this Code. Changes to the Code are decided by the University's Executive Committee.