



This document is a translation of the original Decree n.82735(526) of 08/05/2019 drafted in Italian, which is the only one holding legal value. The following is only a translation designed to simplify the understanding for all those who have greater familiarity with the English language.

Decreto n. 82735 (526)
Year 2019

Regulations for the management of industrial and intellectual property rights with reference to research activities carried out by university staff

Article 1

Definitions and subject of the discipline

1. For the purposes of these regulations, the following definitions apply:

a) Researcher/s: subordinate workers, both permanent and fixed-term, of any position and level (full and associate professors, researchers, technical-administrative staff, collaborators and linguistic experts), PhD students, research fellows, research grant holders, interns, contractors of all kinds, non-employed teachers, including visiting and guest professors, students of all levels, including those enrolled in the Specialization Schools and visiting students, any other similar subject.

b) Invention: any result of the research carried out by the Researchers which may have an asset value and is susceptible of an exclusive right. This category includes: industrial inventions, plant varieties, models and drawings, software and databases, engineering work projects, brands.

c) Industrial Property Law: exclusive right obtained on Inventions, software, databases and engineering work projects, by means of a patenting or registration process by virtue of which a temporary exploitation monopoly is conferred. The same definition also refers to the certificate of deposit as obtained following the delivery of software, databases and engineering work projects at the OLAF-Unpublished work deposit established at the SIAE.

d) Institutional Research: research financed with internal resources of the University of Florence and with funding for institutional research from the Ministry of Education, University and Research (e.g. PRIN).

e) Contract Research: research financed in whole or in part, by private entities or carried out within specific research projects funded by public entities other than the University.

2. These regulations govern the internal procedures of the University of Florence relating to the Inventions and apply to all researchers as defined above. Researchers who do not have a subordinate employment relationship, before the start of their activity, must declare to accept that the rules dictated by these Regulations will also apply to them.

3. The transfer of know-how, which is part of the "corporate information and technical-industrial experiences", defined by art. 98 of Legislative Decree n.30/2005 (Industrial Property Code), is



regulated within the “Regulation on the Conduct of research or teaching activities commissioned by public and private subjects” of the University of Florence.

4. The inventions achieved, during or following research activities, also by making use of equipment and/or structures belonging to the University and of funding and or economic resources administered by it, including the inventions for which the transfer referred to in art.4 is made, within two years from when the Researcher has ceased their relationship established with the University, in whichever capacity.

Article 2

Rights and duties of University Researchers with regard to Inventions achieved in the context of Institutional Research

1. The Industrial Property Right consequent to the Institutional Research activity conducted by a Researcher belongs to the Researcher themselves.

2. The Researcher retains all the faculties of exploitation of the Industrial Property Law, including that of filing any requests for protection or registration in their own name, assuming all expenses, taxes and charges in general, relating to the Law and its maintenance. If the invention is achieved through the contribution of multiple researchers, the industrial property right is attributed to all in equal parts, unless otherwise agreed.

3. For patentable inventions only, the Researcher must notify the University within 30 days of submitting the patent application. If the industrial invention is achieved through the contribution of multiple researchers, the communication must be signed by all interested parties.

4. The Researcher has the duty to communicate to the University the type of commercial operation, executed for a fee or free of charge, carried out in relation to the patentable inventions of which they are the author and the content of the concluded negotiating documents. In the event that the Researcher obtains proceeds from the exploitation of the patent, in particular from the sale or licensing of the same, the University is entitled to 40% of the aforementioned proceeds, distributed as a percentage according to the provisions of the following art. 7 paragraph 2, once all expenses incurred by the Researcher for the protection of the industrial invention and for its maintenance are subtracted.

5. In the event that the Researcher transfers the Invention free of charge, the rights of the University as per the previous paragraph remain unaffected. The Researcher is required to make the transferee aware of the existence of these rights.

6. If, at the end of the 5 years from the achievement of the Industrial Property Right, the Researcher has not started its commercial exploitation, they must notify the University which automatically acquires a free, non-exclusive, right to exploit the Invention and the property rights connected to it, or it may decide to have them exploited by third parties, except for the right of the Researcher to be recognized as the author.



Article 3

Inventions made as part of the Contract Research activity

1. In the event of Contract Research, the Industrial Property Right thereby obtained is the property of the University which remains the owner of any rights deriving from Inventions obtained with the contribution of its Researchers pursuant to paragraph 5 of art. 65 of the Industrial Property Code (D. Lgs. n. 30/2005).
2. The property rights deriving from the Invention, which are due to the University and to the sponsor, are defined by the same parties by negotiation if not already regulated in the contract governing the research project, according to the provisions of the “Regulations for carrying out research or teaching activities commissioned by public and private entities.”
3. The Researcher must communicate to the President of the University the achievement of the patentable result by providing a brief description of the Invention. The University can proceed with the filing in its name, bearing the related costs, without prejudice to the exclusive right of the Researcher themselves to be recognized as the author.
4. The proceeds deriving from the economic exploitation of the Industrial Property Right relating to the quota pertaining to the University are distributed according to what is established in the following art.7.

Article 4

Transfer of the invention copyright to the University

1. The Researcher can offer to the University at any time the rights referred to in art. 2 para. 1, ensuring that they are the only inventor/author and/or that they can freely dispose of this right, by proposing to the University to acquire ownership.
If the invention is achieved through the contribution of multiple researchers, a communication signed by all must be sent, with a clear indication of the contribution of each team member.
2. If Inventions are obtained with the participation of subjects external to the University of Florence where the case is not already regulated by a prior agreement, the University must obtain written communication from these subjects aimed at demonstrating the full availability of the right with respect to the entities they are affiliated to.
3. The Board of Directors decides whether or not to accept the offer, evaluating its economic convenience, also on the basis of the opinions and assessments of the Commission pursuant to art.5. If the University decides not to accept the offer of the Invention, the Researcher is no longer subject to the obligations deriving from paragraph 4 of art.2.
4. In the event that the Researcher offers the University an Industrial Property Right filed in their name and the University decides not to accept the offer, the obligations for the Researcher



provided for in paragraph 4 of Article 2 will still remain.

Article 5

University Commission for Industrial and Intellectual Property

1. A University Commission for Industrial and Intellectual Property has been established. It is made up of no fewer than three and no more than five members, including the President. The members and the President of the Commission are appointed by the President of the University, remain in office for 4 academic years and can only be confirmed once. The President of CsaVRI participates in the work of the Commission. The Commission can be integrated by an expert in the reference sector of the particular invention being evaluated. The expert is chosen by the Commission and will participate without voting rights. The Commission is chaired by the President, who summons it, either via traditional mail or via email. A technical/administrative staff from the competent Administration Office also participates in the Commission as the minute-taking Secretary. Minutes are drawn up for each session of the Commission, signed by the President and the Secretary. Commission decisions are taken by a majority of those present. In the event of a tie, the President has the casting vote. The deliberations of the Commission must be made within 30 days from the date of receipt of the request, or, in case of urgency documented by the applicant, within 10 working days.

2. The Commission shall express its opinion on the following:

- a) requests for the acquisition of Industrial Property Rights in the exclusive name of the University and in co-ownership;
- b) Industrial Property agreements related to joint research projects or contracts or research activity agreements commissioned by third parties, both for the benefit of the University and of the administrative units that manage or intend to manage such research;
- c) abandonment of the entire patent family;
- d) acquisition of patent applications/patents already granted/other forms of Industrial Property Law that are offered to the University.

The Commission takes decisions on:

- a) extension of Industrial Property Rights;
- b) maintenance of Industrial Property Rights;
- c) financing the procedures referred to in the previous points;
- d) management and promotion of the inventions protected by the University, including negotiation of the conditions of license of the University's Industrial Property Rights.

The Commission has the right to carry out checks on the correct application of these Regulations.

3. The Commission can hear the proposing Researcher before formulating its opinion and can make use of all the resources made available by the University or by subjects appointed by the University for obtaining information useful for the decision about the opportunity to protect the Invention.

Article 6

Management of procedures relating to the establishment of Industrial Property Rights owned



by the University

1. The University, through the competent Administration Office shall:

- a) offer Researchers advice and support in managing the procedures for the attainment of Industrial Property Rights;
- b) collaborate with the Researchers, in agreement with other University bodies responsible for Technology Transfer, to promote intellectual and industrial property by providing support, directly or through experts from within or outside the University, for the assessment of the requirements to attain Industrial Property Rights and for the potential for commercial use of those same Rights.
- c) collaborate with researchers in relation to technical and scientific issues relating to the invention, the definition of practices relating to the procedural stages, the maintenance and promotion of industrial property law.

2. In the event of acceptance of the offer received by the Researcher to transfer to the University their rights on an Invention, the University, following the opinion of the Commission referred to in Article 5, approves the first filing/registration.

The University decides after the first filing or the first registration, on the basis of both the funds available and the prospects for the promotion of the Industrial Property Right, on the costs incurred for the maintenance and continuation of the patent and related registration process.

3. If the University decides to suspend the retention of the Industrial Property Right in its possession or to suspend the territorial extension procedure, it must communicate, in due time, and in any case before the Right expires, such decision to the Researcher, making it fully available for assignment free of charge of the Right to the inventor or to another person indicated by the latter. The inventor or other designated person may be charged with the costs of the registration and relative transcription of the deed of sale.

4. The University endeavors to promote the Industrial Property Rights it owns, in order to derive the best results in terms of socio-economic impact from their exploitation, through the stipulation of agreements with third parties concerning the transfer of the Right of Industrial Property, i.e. its exclusive or non-exclusive assignment under license, or the assignment of the right to the patent/registration application.

Article 7

Breakdown of proceeds resulting from the University's exploitation of Industrial Property Rights

1. Pursuant to the previous art. 3 and 4, the proceeds from the sale or license of the University's Industrial Property Rights, minus the costs incurred for the establishment of the aforementioned and for the maintenance of the ownership title, are divided as follows: 50% to the University and 50% to the Researcher. In the case of multiple Researchers, their 50% share is distributed in equal parts, unless a different breakdown is established before the start of the procedures for establishing the patent.



2. The net proceeds of the University deriving from the exploitation of its Rights are used as follows:

- a) for the benefit of the research budget of the Researcher's structure(s) of affiliation;
- b) to feed the budget for the registration of Industrial Property Rights and for the activities of the competent Administration Office at CsaVRI;
- c) for the benefit of the general budget of the University.

The distribution criteria are approved annually by the Board of Directors, upon proposal by the Commission pursuant to art.5. As a norm, it is provided that an amount of not less than 40% of proceeds will go towards the research budget of the structure of affiliation of the Researcher.

Article 8

Inventions made by subjects belonging to entities other than the University of Florence

1. Pursuant to the previous art. 4, if Inventions are obtained with the participation of subjects external to the University of Florence, if case is not already regulated by a prior agreement, the inventors must promptly notify in writing the respective bodies, in order to allow them to reach an agreement on the ownership and management of the results achieved.

2. The share of costs for obtaining the Industrial Property Right and the share of any proceeds deriving from the exploitation of the Invention are distributed among the owners based on the percentage of ownership held.

Article 9

Confidentiality

1. The Researcher and any other person who has collaborated in research activities subject to protection, the members of the University Commission for Industrial and Intellectual Property, all University staff, and external consultants and collaborators in any capacity are obliged to observe the utmost confidentiality, including the prohibition of any form of publication and external dissemination of any matter regarding the Invention for which protection is sought, until the moment in which the patent application has been filed or any other form of Industrial Property Right has been asserted.

2. On occasions of contact with subjects external to the University of Florence, even prior to the start of research activities, which presuppose the communication of know-how, the Researcher is required to make use of confidentiality agreements.

3. In order to allow the student/doctoral candidate to obtain the qualification before filing/registration, appropriate precautions may be provided to exclude the disclosure of the Invention.



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AREA
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Article 10

Entry into force

These Regulations are published on the University's Official Register and come into force on the day following their publication.

Florence, 08/05/2019

The President of the University of Florence
Prof. Luigi Dei