

On the basis of point 2 of Article 253, point 2 of paragraph 1 of Article 271 of the Statute of the University of Maribor (UM Statute, official consolidated text no. 10 (UPB-10), Official Gazette of the Republic of Slovenia no. 46/2012), point 1 of paragraph 1 of Article 10 of the Order on the Reorganisation of the University of Maribor (Official Gazette of the Republic of Slovenia no. 28/2000 – OdPUM-1, as amended to 6/2009) and the provisions of the Employment Related Industrial Property Rights Act (ZPILDR, official consolidated text no. 9 (UPB-2), Official Gazette of the Republic of Slovenia no. 15/2007), the Senate and the Management Board of the University of Maribor adopted, at their 16th regular session of 18 December 2012 and 24th regular session of 17 December 2012 respectively, the following

RULES ON INDUSTRIAL PROPERTY RIGHTS MANAGEMENT AT THE UNIVERSITY OF MARIBOR

Article 1

These Rules regulate the acquisition procedure of employee inventions at the University of Maribor (hereinafter referred to as “UM”) as well as rights and obligations of UM and inventors stemming from inventions discovered or created on the basis of an employment relationship at UM.

The provisions of these Rules shall apply mutatis mutandis to the acquisition procedure of rights pertaining to inventions discovered or created either by contractors on the basis of a contractual relationship or by students.

Article 2

Definition of terms:

1. The term “inventors” refers to university teachers, researchers and other employees in higher education at UM who create an invention irrespective of whether they are full-time or part-time employees or whether they are employed for an indefinite period or a fixed term. The term also refers to contractors or students, who are in a civil contractual relationship with UM and create an invention on the basis of a contractual relationship or with UM’s resources.
2. The “primary inventor” is either the sole inventor or an inventor representing other inventors in the invention acquisition procedure in accordance with their written consent.
3. The “student” is a person enrolled either in graduate or postgraduate programmes conducted by UM.
4. An “invention” is a novel or unique creation of the human mind that (1) meets the requirements for patent protection, trademark registration, service mark registration or industrial design registration in accordance with regulations on industrial property; or (2) represents technical or other developments and improvements leading to greater productivity, increased quality of products or services, savings with regard to material and energy, more efficient use of machinery and equipment, improved control over production, greater occupational safety, etc.
5. An “employee invention” is an invention discovered or created during the term of employment,
6. A “direct employee invention” is an invention discovered or created during the term of employment at UM while fulfilling contractual obligations at the explicit request of supervisors or on the basis of a separate contract concluded between UM and the inventor.

7. An “indirect employee invention” is an invention discovered or created during the term of employment at UM provided work experiences or the employer’s resources contributed heavily to the discovery or creation of the invention.
8. A “free invention” is an invention discovered or created during the term of employment but not under the conditions specified under points 6 and 7 of this Article. The inventor has the exclusive right to dispose of the invention.
9. The “Technology Transfer Office” is an organizational unit in charge of technology transfer at UM. It is organized either as a unit of UM or a company that has direct or indirect ownership links with UM.
10. “Full invention acquisition” means that all rights and obligations concerning the employee invention are transferred to UM.
11. “Limited invention acquisition” means that UM has the non-exclusive right to use the employee invention (UM does not have the exclusive right to dispose of the invention).
12. “Commercial exploitation of the invention” refers to licencing or the sale of intellectual property rights protecting the acquired employee invention.
13. A “unit of a university member” has the same meaning as units of university members under the general act regulating the organisation and staffing structure of UM and university members (chairs, institutes, departments, centres and labs).
14. The term “Rector’s fund” refers to assets managed by the Rector on the behalf and account of UM with the purpose of accelerating progress and providing support for underfunded programmes or projects.
15. The term “costs of invention acquisition” refers to the costs of preparing the application for invention registration, application fees and other costs related to the protection of industrial property rights in Slovenia or abroad.

For the purpose of simplification, only the male form is used in these Rules.

The provisions of these Rules shall apply mutatis mutandis to other types of industrial property rights in accordance with the Industrial Property Act and related laws not specified in these Rules.

Article 3

These Rules shall apply to all inventions discovered or created during the term of employment. In accordance with these Rules, termination of employment has no effect on the rights and obligations pertaining to employee inventions.

These Rules shall also apply to students and other persons not employed at UM. With regard to funding or co-funding of scientific research conducted by such a person, UM may conclude an agreement in order to specify who is in command of the invention created as a result of research work and to regulate issues concerning the right to use the invention, the amount and modality of a potential special payment, etc. In this respect, due consideration shall be given to contractual obligations of all parties.

Article 4

The inventor who created an invention shall immediately inform in writing the University's Department for Scientific Research by clearly indicating that the writing is a notification of invention. If several inventors worked on the invention, the notification may be submitted jointly, in which case the name of the primary inventor representing others in the procedure may be stated.

The notification referred to in the preceding paragraph shall contain the following:

- a) exact description of the invention, i.e. technical tasks, solutions and drawings explaining the invention;
- b) information on how the invention was created plus a statement that the invention is a direct/indirect employee invention and an indication as to the point of Article 7 in accordance with which the acquisition procedure shall be conducted;
- c) data on persons participating in the discovery or creation of the invention plus a description of their contribution;
- d) statement on potential sources, amount and structure of funds to be provided by the inventor or research group for the implementation of the acquisition procedure;
- e) data on potential rights and obligations of companies or third parties stemming from agreements related to the invention.

Within three working days, the University's Department for Scientific Research shall submit the notification to the Technology Transfer Office in charge of the acquisition procedure.

A notification not containing data from the second paragraph of this Article shall be considered complete provided the Technology Transfer Office does not request a supplementation within one month of receipt of the notification.

In order to inform UM of the invention, the inventor may use the form given in the Appendix of these Rules.

Within eight days from receipt of the notification at the latest, the University's Department for Scientific Research must acknowledge to the inventor, in writing, receipt of the notification.

Before and after the submission of the notification, the inventor shall refrain from any actions disclosing the invention to unauthorized persons, thus putting the patent protection of the invention or the protection of other industrial property rights at risk.

If the inventor deliberately acts in conflict with the provisions of the preceding paragraph despite being aware that the disclosure might cause failure to meet the requirements for patent protection or the protection of other industrial property rights, he loses the right referred to in Article 14 of these Rules.

If the inventor fails to inform the University's Department for Scientific Research in writing of the invention in accordance with the first paragraph of this Article, he breaches the obligations deriving from employment.

Article 5

Upon receipt of the notification of employee invention, UM is entitled to full or limited invention acquisition.

Within three months from receipt of the notification at the latest, UM shall inform the inventor of the right to the invention that shall be enforced and explain whether the University agrees with the definition of the invention.

If UM has not been informed of the employee invention, the period referred to in the preceding paragraph shall begin to run from the date the Rector has been informed of the invention.

Article 6

UM must keep the invention confidential as required by the inventor's interests until the patent application has been filed.

The inventor must keep the invention confidential until he has the right to dispose of it in the meaning of Article 11 of these Rules but no longer than up to the point the application for the registration of the invention has been filed.

Persons who were informed of the invention during the acquisition procedure shall not benefit from this knowledge or publish it without the specific written permission of both the inventor(s) and UM.

Article 7

The course of the acquisition procedure is subjected to the amount of costs covered by the inventor or research group:

1. Costs of the acquisition procedure are financed entirely by the inventor or university member from funds of the group(s) that created the invention.
2. Costs of the acquisition procedure are financed in a limited extent by the inventor or university member from research grants of the group(s) that created the invention (at least 40 % of costs). The remaining amount is financed by UM from relevant system resources.
3. Costs of the acquisition procedure are financed entirely by UM from relevant system resources.

When selecting the relevant acquisition procedure, the order of priority determined in the preceding paragraph of this Article shall be taken into account.

Article 8

If the primary inventor requests the course of the procedure under point 1 of Article 7 of these Rules, the invention shall be fully acquired by UM, while the continuation of the procedure shall be conducted by the primary inventor with support of the university member. However, the dean of the university member, by authority of the Rector, shall decide on the commercial exploitation of the invention following a proposal of the primary inventor.

After the primary inventor has filed the patent application or the application for the protection of other industrial property rights, he must forward a copy of the application and appendices to UM. The primary inventor is obliged to keep UM informed of the proceedings for grant of the patent or other industrial property rights.

If the acquisition procedure is conducted in accordance with point 1 of Article 7 of these Rules, UM has the right to ask inventors or university members that covered the costs of the acquisition procedure to reimburse costs related to potential judicial proceedings, administrative disputes and similar conflicts pertaining to the acquired invention.

In cases laid down in points 2 and 3 of Article 7 of these Rules, the decision on full or limited acquisition is made by the Rector on the basis of the opinion of the Committee for the preparation of opinions in invention acquisition procedures (hereinafter referred to as "Committee"), which is formulated at the request of the Technology Transfer Office. The Committee shall determine the procedure and financing of costs of the acquisition procedure in the order of priority laid down in Article 7.

In cases where the acquisition procedure is conducted in accordance with points 2 and 3 of Article 7, the Rector decides on the economic exploitation of the invention following a proposal of the primary inventor and the Committee.

Article 9

The Committee is composed of:

- one representative of the relevant university member proposed by the dean with the approval of the primary inventor. In cases where there is no primary inventor, the approval of all inventors is required (simple majority vote),
- one representative of UM representing the relevant scientific discipline proposed by the Vice Rector for Scientific Research,
- one representative of the Technology Transfer Office proposed by the head of the Office.

Committee members are appointed by the Rector.

Committee members shall perform their function ethically, responsibly and professionally. This function is usually not remunerated unless earmarked funds are provided.

Inventors, their blood relatives, relatives by marriage, spouses or partners cannot serve as committee members.

Committee members to whom the above mentioned applies shall immediately inform the Rector, who appoints an alternate.

If a committee member is aware of other factors that might impact his impartiality, he shall inform the Rector who decides his exclusion.

Exclusion for reasons referred to in the fourth and sixth paragraph of this Article may also be requested by the primary inventor and other committee members.

Article 10

The Committee's opinion shall contain an examination of the invention, possibilities for its protection and an assessment of potential commercial exploitation in Slovenia and abroad. During the acquisition procedure, the inventor shall provide both the Committee and the Technology Transfer Office with assistance by offering explanations regarding the invention and by giving relevant statements.

By serving the written statement on full invention acquisition on the inventor, all rights related to the invention shall be conferred on UM.

The employee invention may also be acquired in a limited extent if consensus with the inventor is achieved. By serving the written statement on the inventor, the invention shall be acquired in a limited extent, which means that UM gains the non-exclusive right to use the invention.

If the limited acquisition clearly impedes the exploitation of the invention, the inventor may request UM either to fully acquire the invention or transfer the right to dispose of it to him within two months from the acquisition.

If the inventor has disposed of the invention before UM has reached a decision within the time limit laid down in these Rules, such a disposal has no legal effects in relation to UM if its rights have been affected.

Article 11

The inventor has the exclusive right to dispose of the invention if:

- a) UM waived the invention in writing;
- b) UM did not fully acquire the invention within three months from receipt of the complete notification referred to in Article 4 of these Rules or within two months in the event of acquisition referred to in the fourth paragraph of the preceding Article.

Article 12

For each fully acquired employee invention, UM shall file a patent application or an application for the protection of other industrial property rights. Patent applications and applications for the protection of other industrial property rights filed in the Republic of Slovenia or member states of the Paris Convention for the protection of industrial property are considered relevant.

If UM fails to act in accordance with the preceding paragraph and is given a notice by the inventor to file an application or provide a justification as to why it does not intend to file an application within the period laid down in the inventor's request (no less than one month), the inventor may file a patent application or an application for the protection of other industrial property rights in the Republic of Slovenia on behalf and for the account of UM.

If UM fails to file a patent application or an application for the protection of other industrial property rights in a foreign country, the right to dispose of the invention shall be assigned to the inventor for this particular country. In this country, the inventor may request protection of the invention at his own expense. A statement confirming the assignment of the invention for all countries or only certain countries shall be submitted within four months from filing of the application in accordance with the first or second paragraph of this Article, so that the inventor may exercise the priority right by the stipulated deadline.

UM is not obliged to file an application for the protection of a fully acquired employee invention if:

- a) it obtains the opinion of the patent office confirming that the invention does not meet the requirements for patent protection or the protection of other convenient industrial property rights;
- b) it obtains the inventor's consent;
- c) the conditions referred to in Article 14 of these Rules are met.

After filing the patent application or an application for the protection of other industrial property rights, UM shall submit a copy of the application and appendices to the inventor. UM is obliged to inform the inventor of the course of the proceedings for grant of a patent or the protection of other industrial property rights.

In the course of the proceedings, the inventor shall provide UM with assistance by offering explanations about the invention and by making the necessary declarations.

Article 13

If UM abandons the patent application of fully acquired employee invention or the application for its protection by other industrial property rights, the inventor shall be informed without delay. If UM no longer wishes to maintain the granted patent or other intellectual property rights for an employee invention, the inventor shall be informed at least three months prior to the expiry of the regular time period for the payment of the maintenance fee for a patent or other industrial property rights. In both cases, UM is obliged to assign industrial property rights to the inventor and hand over the required documentation for the protection of these rights at his request and expense.

The inventor may request the transfer of rights and documentation referred to in the preceding paragraph within three months from receipt of the above mentioned notification at the latest.

Article 14

If UM wishes, with approval of the inventor, to keep the acquired employee invention confidential despite the fact that it is not considered confidential in accordance with regulations on industrial property, UM is not obliged to file a patent application or an application for the protection of other industrial property rights. In this case, UM is obliged to determine the amount of the compensation payment and pay the total amount in accordance with these Rules.

When determining the amount of the compensation payment referred to in the preceding paragraph, damage suffered because the invention has not been protected by patent or other industrial property rights shall also be taken into account.

UM is not obliged to file an application provided it comes to the conclusion that it is not reasonable to protect the acquired invention in accordance with the provisions for protection and regulations on industrial property since the costs of protection would be higher than the commercial value of the invention. In this case, UM is obliged to allow the inventor to protect his invention on his own behalf and at his expense.

Article 15

If UM does not start to commercially exploit the employee invention within five years from the acquisition of the invention, the inventor(s) may ask for it to be transferred. The invention shall be transferred to the inventor(s) as a free invention.

Article 16

The inventor shall obtain the right to claim appropriate compensation after UM starts to commercially exploit the acquired invention irrespective of the type of acquisition (full or limited). This right arises after the invention has been acquired by the UM - payment must be made after revenue from the commercial exploitation of the invention has been generated.

The basis for calculating shares of the inventor, the university member, the organizational unit where the inventor is employed, UM and the Rector's fund are gross incomes generated from the commercial exploitation of the acquired invention. The basis for the calculation also depends on both the financing structure laid down in Article 7 of these Rules and the financial contribution of the inventor:

Financing structure in accordance with Article 7 of these Rules	Share belonging directly to the inventor	Share belonging to the university member or research group that created the invention	Share belonging to UM and the Rector's fund
Point 1	65 %	30 %	5 %
Point 2	50 %	20 %	30 %
Point 3	40 %	25 %	35 %

The percentage belonging to the research group or organizational unit of the university member that created the invention shall amount to a minimum of 75 % of funds to which the university member and research group are entitled to.

Irrespective of the manner of distribution laid down in this Article, UM, the relevant university member and the inventors may agree on a different manner of distribution in a special agreement, which must be signed by all inventors or the primary inventor provided he obtained their explicit authorization.

If there are several inventors or the inventors are employed at different university members or organizational units, the shares specified in the second paragraph of this Article shall be distributed, as appropriate, to all the inventors, university members and research groups on the basis of their contributions laid down in the notification of invention referred to in Article 4 of these Rules or a written agreement of all eligible inventors, university members and research groups specifying the respective percentages. Such an agreement shall be concluded and appended to the notification of invention.

If inventors fail to conclude such an agreement, it shall be considered that they contributed equally both in terms of shares as well as their role in creating the invention.

If the economic exploitation of the invention is of non-monetary nature, the reward shall be distributed in a manner laid down in a written agreement concluded by the beneficiaries referred to in the second paragraph of this Article.

Shares laid down in the second paragraph of this Article shall be transferred to the beneficiaries within 15 days from receipt of gross incomes generated from the commercial exploitation of the invention.

Article 17

The Technology Transfer Office shall be authorized and responsible for all activities falling within UM's competence in accordance with these Rules, in particular:

- receiving and sending out notifications, calling upon applicants to supplement the notifications of inventions;
- sending out certificates;
- drawing up opinions;
- serving declarations;
- receiving and submitting requests;
- filing applications;
- sending out copies of applications and appendices;
- formulating proposals;
- other tasks arising from these Rules.

Article 18

When concluding agreements on the basis of which companies or other legal entities of private law co-fund scientific research at UM, the parties are obliged to ensure adequate financial implications deriving from the creation of potential intellectual property and always ensure at least gratuitous non-commercial use of intellectual property rights, which are the subject-matter of the agreement and do not belong to UM, in order to support teaching activities and research work conducted by employees of UM. Signatory of UM is obliged to ensure that the contract shall include appropriate arrangements to enable the enforcement from intellectual property. Advance agreement at the conclusion of the contract, which denies UM the right to the payment of created intellectual property based on its effect, is not admissible.

Agreements concluded with companies or other legal entities of private law shall therefore include an additional mandatory article determining the financial implications for UM in the event of a successful commercialization of the invention. The parties typically have to agree on royalty payments determined on the basis of the net sales figure of products or services deriving from the invention.

Derogations from the above mentioned principle are possible only with the written consent of the Rector.

An inventor who, by UM's order, participates in research work funded by non-budgetary contracting entities, the consequence of which is the created employee invention assigned to UM, which is obliged to transfer the industrial property rights to the non-budgetary contracting entity in question and make a lump-sum payment to the inventors, the consequence of which is the exclusion of provisions under Article 16 of these Rules, shall be entitled to a reward in the net amount of 2500 EUR when transferring rights to the non-budgetary contracting entity or filing an application for the protection of industrial property rights on the part of the contracting entity provided he created the invention on his own. If several inventors participated in the creation of the invention, they shall be entitled to a proportionate share subject to mutual agreement, where one exists. In the opposite case, the reward shall be apportioned equally to all inventors.

If industrial property rights are transferred in accordance with the preceding paragraph, the provisions for the distribution of revenue laid down in Article 16 of these Rules shall not be taken into account.

Article 19

UM may also benefit from the invention by establishing spin-off or spin-out companies exploiting the invention.

If a spin-off or spin-out has been established, the inventor has the prior right to the conclusion of a licence agreement with UM concerning the assumption of the right to exploit the patented invention or to buy the patent.

Article 20

Any dispute between inventors and UM shall be settled by mutual agreement.

If no mutually agreed solution can be found, the dispute shall be settled in accordance with the procedure prescribed by the law regulating employee inventions.

Article 21

These Rules shall be adopted by both the Senate and the Management Board of UM. They shall come into force on the eight day following their publication in the Announcements of the University of Maribor.

Article 22

The provisions of these Rules shall not apply to inventions for which protection procedures have already been initiated or completed.

Rector of the University of Maribor:

Prof. Danijel Rebolj, PhD

Chairman of the Management Board:

Prof. Mirko Pšunder, PhD