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**Directive S2020-03**

Annex No. 2

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General rule – if you have any doubts, questions, ideas, turn to IOCB TECH immediately. The sooner the project starts developing through IOCB TECH, the better the chances of success. It is very unfortunate, for example, to strive to draw up a patent quickly a week before sending a publication or travelling to a conference. Such an approach mostly only leads to a lot of work but not to the desired result. For this reason, the potential protection of the Item of Intellectual Property needs to be discussed as soon as possible. IOCB TECH has its seat in 4.27a, building A, 4th floor, internal line 554, e-mail [ladislava.souckova@ouchb.cas.cz](mailto:ladislava.souckova@ouchb.cas.cz), or internal line 200, e-mail [barbara.eignerova@ouchb.cas.cz](mailto:barbara.eignerova@ouchb.cas.cz), for more information, visit [www.iocbtech.cz](http://www.iocbtech.cz).

### **1. Procedure of Protection of the Item of Intellectual Property (including but not limited to applications for inventions and utility models)**

If the solution achieved at the Institute is considered inventive by the member(s) of staff of the Institute – originator(s) of intellectual property – to such extent that it should be protected, the procedure described below is followed. An invention and its patenting is given here as an example. In the case of another Item of Intellectual Property, the procedure shall apply mutatis mutandis:

- a. The filled in Notification form together with documents for evaluation of the invention including a statement of the Responsible Person shall be submitted to the Director's Secretary Office. Documents for evaluation of the invention may include, for example, theses or manuscript of a publication pertaining to the subject, or a submission in the form of a patent application. The above applies to all cases, even if the invention application is being prepared in collaboration with another institution.
- b. After registration at the Director's Secretary Office, the Notification shall be submitted to IOCB TECH, which will arrange the following steps.
- c. IOCB TECH will arrange a meeting with the originator of the invention where the originator will explain the main points and intentions/aspects of the invention.
- d. Based on the meeting, IOCB TECH will perform an analysis with the aid of an expert committee convened ad hoc.
- e. IOCB TECH will propose one of the following procedures to the Institute Director (with justification). However, the Director is not obliged to follow the proposal of IOCB TECH. The originator will be informed about the conclusion at the earliest possible date (within 3 months of the Notification) and the whole process will be sped up if the originator(s) inform(s) IOCB TECH about the intention to patent at the earliest possible stage. The Institute's answer may be:
  - i. The Institute is not interested in the invention.

The Institute informs the originator(s) in writing about its lack of interest in the invention. In this case, the results may be published immediately, or the originator may register the

invention themselves at their own cost. If the Institute fails to give a statement within 3 months of the Notification submission, it is deemed not interested.

ii. The Institute is interested in the invention.

The Institute informs the originator(s) in writing about its interest in the invention, whereby it exercises its right to the invention. If the Institute exercises its right to the invention and the application is filed, the originator(s) shall be entitled to the remuneration of CZK 10,000. The remuneration shall be divided among the originators in the proportion of their contribution to the invention creation. An Agreement on exploitation of the invention will be concluded by and between the originator(s) and the Institute. At the same time, IOCB TECH will continue cooperating with the originator(s) on defining the next steps in the process of ensuring formal protection of the invention. In the event of an invention in collaboration with a third party, IOCB TECH negotiates the terms and conditions of the agreement with the third party.

f. The Institute is the exclusive owner of the invention and it is solely at the Institute's discretion to select a protection procedure. IOCB TECH proposes a procedure to the Institute management, which the Institute may or may not follow. The Institute decides, among other things:

- i. When and where the invention will be protected;
- ii. That the invention application will not be filed in a given stage and the invention protection will be ensured by confidentiality (in which case nothing can be published);
- iii. On suspension of the invention application proceedings;
- iv. On patent validity termination.

With regard to clauses iii. and iv., the Institute has no legal obligations towards the originator and no obligation to inform the originator about its decision and procedure; however, it is customary that before leaving the invention application or patent, it offers to sell them to the originator.

g. Publication of an invention (publications, sent abstract, etc.) which is protected is only allowed with a confirmation issued by the Industrial Property Office or another national or international office on submission of the invention application.

## **2. Samples**

If samples are provided to a third party, an agreement on the provision must be concluded with the third party. There are two main reasons for such an agreement:

- a. Protection of intellectual property that originated at IOCB
- b. Holding IOCB harmless from any claims arising from potential unsuitable use of the sample (e.g. damage in relation with economic losses or harm to health).

**The obligation to sign MTA shall not apply to:**

- Ongoing collaboration within joint grant projects
- Routine analytical testing

**The obligation to sign MTA shall in particular, and without limitation, apply to:**

- Sample transfer to commercial entities
- Sample transfer to foreign entities

In parallel, the provision of samples may be provided for in agreements with third parties (domestic and foreign academic institution or a commercial partner) which include legal provisions on sample handling. In such a case, it is not necessary to sign MTA but it has to be thoroughly verified (e.g. by consultation with IOCB TECH) whether the rights and responsibilities related to the samples are really provided for in another agreement with the third party.

### **3. Collaboration with other commercial and scientific institutions**

The Responsible Person is responsible for all their subordinates to care for protection of intellectual property and trade secret, during collaboration with both domestic and foreign entities.

#### **a. Collaboration with commercial institutions.**

A commercial institution is a third party that is not a scientific institution. If such a third party addresses an employee with a request for collaboration, it is necessary to contact IOCB TECH as soon as possible to further negotiate the particular terms and conditions of the collaboration.

Initially, it is absolutely necessary to conclude a non-disclosure agreement or a mutual confidentiality agreement. The same agreement may not be applied to different types of contacts, discussions and potential collaborations; therefore, it is necessary to ask IOCB TECH to draft it. The agreement must be executed before giving or disclosing any information related to intellectual property and/or information that is trade secret in nature.

If the negotiations with the third party proceed to the definition of future collaboration, a written agreement on the collaboration has to be concluded before any work is started within the collaboration. Among other things, the agreement shall deal with the matter of intellectual property protection and contribution to jointly created intellectual property. These activities shall be ensured by IOCB TECH.

Effective participation of IOCB TECH in the process of intellectual property handling, trade secret protection and handling of samples depends on timely, complete and true information that IOCB TECH receives from the Institute employees.

#### **b. Collaboration with another scientific institution**

The provisions applicable to commercial institution shall apply *mutatis mutandis*.