

UNIVERSITY POLICY ON INTELLECTUAL PROPERTY

1. INTRODUCTION

- 1.1 City University of Hong Kong ("University") encourages the dissemination of knowledge. The activities of staff and students will inevitably lead to the creation of intellectual property. This document details the University's policy on the ownership of such intellectual property. Copyright, patents, registered designs, trade and service marks, trade secrets, circuit layout, plant varieties are different types of intellectual property. It should be noted that more than one type of intellectual property can subsist in a given product or service. Take a can of "Coca-Cola" as an example. The design on the can can be protected by copyright, the graphics and the red/white colours taken as a distinctive get-up can be protected by passing off, the formula of the beverage by confidential information and the name "Coca-cola" by trade mark, and the manufacturing process by patent.
- 1.2 The University intellectual property policy relates to three aspects of intellectual property, namely, (i) Copyright, (ii) Patents, Registered Designs, Circuit Layout and Plant Variety Rights, and (iii) Trade & Service Marks. Each of these three areas are dealt with in separate sections below. The policy reflects the current laws in Hong Kong relating to intellectual property and will be subject to review from time to time. Questions arising from the implementation or interpretation of these policies should be referred to the Intellectual Property Committee ("IPC") of the University.

2. MEANING OF INTELLECTUAL PROPERTY

- 2.1 The law of intellectual property (sometimes also referred to as "industrial and intellectual property") regulates the ownership, protection and exploitation of certain types of intangible property. The word "intellectual" signifies its intangible nature and its difference from tangible "physical" property.
- 2.2 Tangible property includes things such as cars, apartments, personal belongings, plant & machinery, etc. Intellectual property, being a type of intangible property, includes things such as rights in respect of songs, art work, designs, manufacturing processes, business reputation, and etc.
- 2.3 Intellectual property which subsists in a particular item is separate and distinguished from the physical item itself. For example, when someone buys a book he/she does not buy the copyright in it which deals with the right to copy. Therefore the purchaser is not entitled to make any further copy.

3. APPLICABILITY

The University's intellectual property policy applies to all staff and to students.

4. DEFINITIONS

4.1 Staff

Staff in the context of this policy means any person who is in the employment of the University.

4.2 Student

Student means any student registered on a programme of study leading to the degrees or other academic awards of the University as approved by the Senate.

5. COPYRIGHT

5.1 The law governing copyright can be found in the Copyright Ordinance (Chapter 528, Laws of Hong Kong) and relevant case law.

5.2 Copyright protection in Hong Kong arises automatically upon the creation of a copyright work (a subject matter recognised by the law) by its author. No registration or formal notification is required. People of all nationalities and places of residence can attract copyright in Hong Kong to their works under the "open qualification" system of the Copyright Ordinance.

5.3 According to its legal definition, copyright concerns the exclusive rights to copy or otherwise exploit certain specified copyright works and to authorise others to do the said acts. In a simplified sense, provided the work is original, i.e. not copied from other work and is created by the author using minimal skill, labour and judgment, the work can be protected by copyright.

5.4 It must be remembered that copyright does not protect ideas per se. Protection is only given to the particular form in which the idea is expressed and when such expression is reduced in writing or some other material form. For example, the idea of a vacuum cleaner cannot be protected by copyright. However, a particular design for a vacuum cleaner can be protected by copyright or, if registrable, by registered design. A clothes designer's idea for a new dress is not protected until this idea has been drawn. A composer's new song is not protected until he has written the song, recorded or performed it.

5.5 There is no requirement that a work must be something novel. A new expression of an old idea can likewise be protected. A compilation of questions

from existing examination papers will attract copyright protection as a literary work and no one else can copy that compilation without the author's permission. Another compilation of the same or similar examination questions by another author can also attract copyright protection and there is no copyright infringement of the first work provided that it is independently created.

5.6 Scope

The following are the subject matters protected by copyright with emphasis given to those works which the reader is more likely to encounter: -

5.6.1 literary works:

5.6.1.1 Literary work covers any work, other than a dramatic or musical work, which is written, spoken or sung. It refers to any form of notation which conveys information, provides instructions or gives pleasure. Literary work includes a compilation of data or other material, in any form, which by reason of the selection or arrangement of its contents constitutes an intellectual creation (including but not limited to a table). **It includes a computer program, and the preparatory design material for a computer program.**

5.6.1.2 Literary work is not confined to writings in a strict literary sense and refers to thoughts expressed in print or writing, or songs, irrespective of the quality and style of the print/writing/songs. Besides, the specified work needs not be an expression of inventive or innovative thoughts provided that the same must originate from their respective authors.

5.6.1.3 Examples of literary works include books, instruction material, journal articles, timetables, advertisements, pamphlets, computer source and object code, glossaries, examination papers, reports, etc.

5.6.2 artistic works

These can be divided into three categories: -

5.6.2.1 irrespective of artistic quality:-

graphic works (including paintings, drawings, maps, charts, plans or OHP illustrations), photographs, sculptures, etching, lithograph, woodcut or similar work;

5.6.2.2 where artistic quality is required:-

works of architecture being buildings (including any fixed structure, and a part of building or fixed structure) or models of buildings; and

5.6.2.3 where a particular level of artistic quality is required:-

works of artistic craftsmanship (such as artifacts relating to jewellery, furniture, toys, etc).

5.6.3 dramatic works

Dramatic works refer to any choreographic works or entertainments in dumb show and adaptation of such dramatic works. Examples include dance, mime shows and presentations which have been reduced to writing, etc.

5.6.4 musical works

Musical works are works consisting of music, exclusive of any words or action intended to be sung, spoken or performed with the music. In addition to music compositions, adaptation of musical works will also be protected. Adaptation includes arrangement or transcription of the relevant musical work which may include addition of accompaniments, new harmonies, new rhythms or the like to such musical work.

5.6.5 sound recordings

Sound recordings are the aggregate of sounds embodied in, and capable of being reproduced by means of a record of any literary, dramatic or musical work regardless of the medium on which the sounds are produced or reproduced. Copyright does not subsist in a sound recording which is, or to the extent that it is, a copy taken from a previous sound recording.

5.6.6 published editions of works

Copyright subsists in the published editions of the whole or any part of one or more literary, dramatic or musical works. It does not subsist in the typographical arrangement of a published edition if, or to the extent that, it reproduces the typographical arrangement of a previous edition.

5.6.7 films

Films including videos and other types of films are the recordings on any medium from which moving images may by any means be produced. The sound-track accompanying a film is treated as part of the film. Copyright does not subsist in a film which is, or to the extent that it is, a copy taken from a previous film.

5.6.8 other works

Other works protected by copyright include television and sound broadcasts

and cable programmes.

5.7 Duration of Copyright

5.7.1 Literary, Dramatic, Musical and Artistic Work

5.7.1.1 Copyright in a literary, dramatic, musical or artistic work expires at the end of the period of 50 years from the end of the calendar year in which the author dies. In case of joint authorship, this time limit applies to the last surviving author. If the work is of unknown authorship, copyright expires at the end of the period of 50 years from the end of the calendar year in which the work was first made, or if during that period the work is made available to the public, at the end of the period of 50 years from the end of the calendar year in which it is first so made available. In this connection, making a work available to the public can be by way of publication, performance in public, offer for sale to the public, and broadcasting or inclusion in a cable programme service. The term “publication” means the circulation of sufficient copies of the relevant copyright works to the general public and, therefore, secret circulation of the work amongst a specific group shall not be regarded as publication of such work.

5.7.1.2 If the work is computer-generated, copyright expires at the end of the period of 50 years from the end of the calendar year in which the work was made.

5.7.1.3 In respect of published editions of a work, copyright protection is afforded to them for a period of 25 years from the end of the calendar year in which the work was first published.

5.7.2 Sound Recording

Copyright in a sound recording expires at the end of the period of 50 years from the end of the calendar year in which it was made; or if during that period it is released, 50 years from the end of the calendar year in which it is released. A sound recording is “released” when it is first published, played in public, broadcast or included in a cable programme service; but in determining whether a sound recording has been released no account will be taken of any unauthorized act.

5.7.3 Broadcast or Cable Programme

As for a broadcast or cable programme, the copyright expires at the end of the period of 50 years from the end of the calendar year in which the broadcast was made or the programme was included in a cable programme service. Copyright in a repeat broadcast or cable programme expires at the same time as that in the original broadcast or cable programme; and accordingly no copyright arises in respect of a repeat broadcast or cable programme which is

broadcast or included in a cable programme service after the expiry of the copyright in the original broadcast or cable programme.

5.7.4 Film

Copyright in a film expires at the end of the period of 50 years from the end of the calendar year in which the death occurs of the last to die of the following persons: (a) the principal director; (b) the author of the screenplay; (c) the author of the dialogue; or (d) the composer of music especially created for or used in the film. If the identity of any of these persons is unknown, copyright expires at the end of the period of 50 years from the end of the calendar year in which the film was made; or if during that period the film is made available to the public, at the end of the period of 50 years from the end of the calendar year in which it is first so made available.

5.8 Eligibility

Unlike most other countries where the nationality, residency and domicile of an author, and the place where the copyright work is first published determines copyright protection, the Copyright Ordinance of Hong Kong creates an “open qualification” system for copyright.

5.9 OWNERSHIP OF COPYRIGHT

This section sets out various categories of work and their copyright ownership.

5.9.1 Scholarly Work

In line with traditional practice, staff shall own the copyright in scholarly works created in pursuance of their normal duties, studies or otherwise, provided that the creation of the works does not entail significant additional University involvement and resources (library and computer use excepted), unless the works are also sponsored works or contracted facilities works, or unless the designated staff agrees to participate in a project which has special provisions on copyright ownership. Scholarly work encompasses all types of outputs requiring a high level of intellectual pursuit and it shall be defined broadly to include publications, dissemination of artistic works and relevant computer software. Any royalty or other payments generated by scholarly work, exclusive of cash prizes and awards, received by staff shall be treated as staff income and be subject to income-sharing governed by the University’s regulations on outside practice.

5.9.2 Teaching Materials

Subject to 5.9.5 and 5.9.6, copyright materials created by staff or students for teaching purposes within the University shall be owned by the staff or

students concerned. The University will, however, have a royalty-free and non-exclusive perpetual licence to use such materials for normal University educational and operational purposes. Moreover, the University may authorize other staff or students to use the materials including but not limited to digitisation, but subject to attribution as per 5.10. Where teaching materials are published in any form, other than for teaching purposes within the University and such materials have been adapted from the materials of the original author(s), compiler(s) or originator(s) and, where appropriate, any adaptor(s) of the materials, then such publication shall contain attribution as per 5.10.

5.9.3 Personal Work

Subject to 5.9.4, copyright in personal work created by staff outside the scope of their employment shall be owned by staff, but may be subject to the University's income-sharing rules.

5.9.4 University Assisted Personal Work

Where the relevant work was created not in the course of employment within 5.9.7 but involved significant use of the University facilities (library and computer use excepted), staff or other resources, copyright in such work shall be owned by the relevant staff, but the University shall enjoy unrestricted rights to utilize the work for publication and educational purposes. Any royalty or other payments received from commercial exploitation of the work shall be shared between the creator(s) of the work and the University in the ratio of 70 to 30 provided always that the creator(s) and/or the University may apply to the IPC for the sharing to be in a different ratio to be determined by the IPC where the circumstances make a different sharing appropriate.

5.9.5 Sponsored and Consultancy Work

Where the work is produced by staff or students pursuant to the contracts the University or staff or students enter into with outside bodies, its copyright ownership shall be governed by the terms of the contracts concerned. If under such terms the University is a copyright owner, or entitled to income derived from the work, the University may at the discretion of the IPC share the copyright and income with the staff or students who create the work.

5.9.6 Research and Other Funded Work

Under normal circumstances, the copyright ownership of the work created by staff or students in research or other projects funded either by the University or external organizations shall be determined by the terms of the project grant. Where the terms are silent on this issue, the copyright ownership shall

vest in the University. The University may at the discretion of the IPC share the copyright and income with the staff or students who create the work.

5.9.7 Work Created in Employment

Save for the provisions set out in 5.9.1 to 5.9.6, all intellectual property rights of the works created by staff in the course of their employment with the University shall automatically vest in the University notwithstanding any rule of law or equity to the contrary. Any royalties or other payments due in respect of the work created by staff pursuant to a specific task assigned by the University shall be owned by the University. If deemed appropriate, the University may at the discretion of the IPC share such royalties or payments with the creator(s) of the work by means of reward (or encouragement) in such proportions to be determined by the IPC.

5.9.8 Student Work

Subject to 5.9.5 and 5.9.6, copyright in all original work produced by students in the course of or for the purposes of their studies, scholarship or research with or at the University shall be owned by the students concerned. Examples of student work include dissertations, theses, films, computer programs, and research papers. The University will, however, have a royalty-free and non-exclusive perpetual licence to use such work for normal University educational and operational purposes. In addition, the University may authorize other staff or students to use such work including but not limited to digitisation, but subject to attribution as per 5.10.

5.10 MORAL RIGHTS TO TEACHING MATERIALS: ATTRIBUTION AND INTEGRITY

5.10.1 Any staff or student who alone or jointly writes, compiles or otherwise originates materials to be used for teaching purposes of the University has the right to be acknowledged as the author or the compiler or originator of the materials. All copies of the materials published by the University shall contain appropriate written or other recognition of the author or the compiler or originator.

5.10.2 Even after a substantial adaptation of such teaching materials, the original author(s), compiler(s) or originator(s) shall continue to have the right to attribution referred to in 5.10.1. The person(s) responsible for the adaptation shall also be entitled to attribution as the adaptor(s) of the materials.

5.10.3 Where such materials are proposed to be used by the University for a purpose or in a context or application other than that in or for which they

were originally prepared, each person entitled to such attribution shall be given attribution in such use as the University makes of such materials.

6. PATENT RIGHTS

6.1 Patent

6.1.1 A patent is a registered monopoly right in respect of an invented product or process, which confers an exclusive right on the patentee to use and to exploit the patented invention and to stop other people from copying, dealing with or importing the invention into a given country. The patent law of a given country determines what inventions may qualify for the granting of a patent. In Hong Kong, the governing law in respect of patents is the Patents Ordinance (Chapter 514, Laws of Hong Kong).

6.1.2 A patent is a purely national right. A Hong Kong patent applies to Hong Kong, a US or Japanese patent to the United States and Japan respectively.

6.1.3 However, the Paris Convention for the Protection of Industrial Property 1883 which applies to Hong Kong provides a system of reciprocal protection of priority rights in signatory countries. Convention priority rights mean that an application for a patent in one Convention country gives a period of twelve months during which the applicant can file an application in any other Convention country and the same filing date as the application in the first patent filing country shall apply to the later application.

6.1.4 Hong Kong has no examination system for patents. Instead it extends patent rights to applicants who, following the notification procedure in the Patents Ordinance, have been granted one of the following patents : 1) a British Patent; 2) a European Patent designating the United Kingdom; and 3) a Chinese (PRC) patent. It should be noted that the Patent Cooperation Treaty (PCT) is also an avenue for processing patent applications.

6.1.5 In addition to a standard patent of 20 years' duration, a short-term patent of 8 years is also available. There is no formal examination system for short-term patents. The novelty and inventive step requirements of such patents are less strict, the cost less and the time to acquire is less.

6.2 Scope

6.2.1 An invention, in order to be patentable, must be new, involves an inventive step, and capable of industrial application.

6.2.2 An invention shall be taken to be new if it does not form part of the state of the art. The state of the art comprises all matters which have been made available to the public anywhere by written or oral description, use or in other

way. It also comprises the matter contained in an application for another patent which was published on or after the date of application for patent of that invention, if that matter was contained in the application for that other patent both as filed and as published and the date of application for patent of that matter is earlier than that of the invention. If a prior publication contains clear and unmistakable directions to do what the patentee claims to have invented, that claim will lack novelty. **It is therefore of fundamental importance to bear in mind that a potentially patentable invention must not be published prior to application; failing which the invention will lack novelty.** In case of doubt, staff are encouraged to contact the Knowledge Transfer Office for advice.

6.2.3 An inventive step is present where, having regard to the state of the art, the invention is not obvious to a man skilled in the art. The state of the art extends to all sources as defined for novelty purpose and includes all parts of the world. The question is whether what is claimed is so obvious that it would at once occur to anyone acquainted with the subject, and desirous of accomplishing the end.

6.2.4 An invention shall be taken to be capable of industrial application if it can be made or used in any kind of industry, including agriculture. However, an invention of a method of treatment of the human or animal body shall not be taken to be capable of industrial application. This has been judicially interpreted not to cover pharmaceuticals and certain medical procedures.

6.2.5 Examples of inventions which are patentable include the following :-

- a new product or a new industrial process
- pharmaceutical
- mechanical and electronic devices
- methods of manufacturing

6.3 Duration

A standard patent lasts for 20 years from the date of application. A short-term patent lasts for 8 years from the date of application. It is not unusual that the application process for the grant of a patent may take up the first three to five years of this period.

6.4 Eligibility

Any person may file an application for a patent, though only the inventor, his assignee, his employer or his successor in title are entitled to the grant of a patent.

6.5 Expense

Patents are very expensive to obtain and maintain. A patent may cost in excess of HK\$200,000 and requires at least three years to obtain. A different patent is required in each country where patent protection is sought and this multiplies the cost. The University may be able to provide financial assistance to staff to apply for patents.

7. REGISTERED DESIGNS

7.1 Registered Designs

7.1.1 Many products have an external appearance which is very important. For example, the peculiar shape of a perfume bottle may be a major selling point of the product. To stop the copying of designs, the appearance (i.e. the external look) of a product can be registered.

7.1.2 Applications for registration of a design are governed by the Registered Designs Ordinance (Chapter 522, Laws of Hong Kong).

7.2 Different types of "designs"

7.2.1 When the term "design" is used in the context of intellectual property in Hong Kong, it means one of the following :-

(a) the external appearance of a product designed to appeal to potential customers, and in respect of which a registered design certificate can be obtained. This is called a registrable design. Once registered, the owner of a registered design shall enjoy protection under the registration against other people from copying the registered design and from making or importing, selling or hiring in Hong Kong any article in respect of which the design is registered and to what that design or a design not substantially different from the registered design has been applied. In addition, the owner has parallel protection under the law of copyright.

(b) the external appearance of a product designed to appeal to potential customers, and in respect of which a registered design certificate could have been obtained, but the designer, deliberate or otherwise, did not apply for registration. This is called a registrable design. The designer only has protection under the law of copyright.

(c) designs in respect of features of shape or configuration which are dependent upon the appearance of another article of which the article is intended by the author to form an integral part, e.g. spare and replacement parts of machinery; or products whose external appearance is dictated solely by the function which the article to be made in that shape or

configuration has to perform, e.g. the legs of electric plugs. These are unregistrable designs for which no protection is available.

7.3 Scope

7.3.1 A registered design can be sought for the following non-exclusive designs, provided they are new designs :-

(a) shapes, e.g. a vase;

(b) configurations, e.g. where the various external parts of a cassette player are arranged in an innovative way;

(c) patterns, e.g. the pattern on wall paper; and

(d) ornaments, e.g. the addition of fashionable buckles, bows and straps to a leather carrying bag.

7.3.2 It should be noted that computer programs and protected layout-designs (topographies) are not registrable. These are protected by the Copyright Ordinance (Chapter 528, Laws of Hong Kong) and the Layout-Design (Typography) of Integrated Circuits Ordinance (Chapter 445, Laws of Hong Kong).

7.3.3 But (a) - (d) in 7.3.1 must be applied to an article produced commercially (normally at least 50 must be manufactured), and the design must have an element of novelty. A design shall be taken to be new if it does not form part of the state of the art, which shall be taken to comprise all matters which have, at any time before the application for registration of the design, been made available to the public. Therefore, disclosure to one single person, free of obligations of confidence of a design is sufficient to impugn the novelty of a later design of the same subject matter. Furthermore, differences in immaterial details or in features which are variants commonly used in the trade are not sufficient to render the design new. The designer must have applied some further skill and labour of a draftsmanlike nature.

7.3.4 A new design must also be applied for the purpose of enhancing the product's visual appeal, i.e. for the purpose of aesthetic "eye" appeal and must not be dictated solely by the function which the article has to perform.

7.4 Duration

The initial period of registration of a design is 5 years beginning on the filing date of the application for registration. The period of registration may be extended for additional periods of 5 years each but the total period of

registration may not exceed 25 years beginning on the filing date of the application for registration.

7.5 Eligibility

The designer of a registrable design is eligible to apply for registration.

8. CIRCUIT LAYOUTS (CL)

Layout Designs of Integrated Circuits in Semi Conductor Chip

The Layout-Design (Topography) of Integrated Circuits Ordinance Cap 445 came into force on 31 March 1994. It creates a sui generis regime, similar to that of copyright, for protection of integrated circuit layouts. An integrated circuit layout must be original and the author must have a right of abode in Hong Kong or a World Trade Organisation (WTO) member state. WTO member state includes most countries of the world. Protection is for 15 years from creation or 10 years from commercial exploitation.

9. PLANT VARIETY RIGHTS (PVR)

The Plant Varieties Protection Ordinance 1996 creates a sui generis regime, akin to the patent system. It protects new plant varieties created by traditional propagation techniques or genetic engineering. An application must be filed with the Director of Agriculture, Fisheries & Conservation. Protection is available to periods in excess of 25 years. Varieties must be new.

10. OWNERSHIP OF PATENTS, REGISTERED DESIGNS, CIRCUIT LAYOUTS, AND PLANT VARIETY RIGHTS

10.1 Subject to the exceptions set out below, it is the University's policy and a term of employment of staff and a term of admission of students that unless otherwise agreed expressly by the University in writing, ownership of all patents, registered designs, CL or PVR in all relevant works created by staff in the course of their employment with the University or created by students during their studentship shall automatically vest in the University notwithstanding any rule of law or equity to the contrary.

10.2 Definitions

10.2.1 "Pursue the invention" means to take appropriate action to protect the patentable inventions, registrable designs, CL or PVR by applications for

patent, design registration, CL or PVR, to exploit it commercially and to deal with related financial arrangements.

10.2.2 "Net income" means gross revenues arising from the commercial exploitation of any of the University's patentable inventions, registrable designs, CL or PVR less any reasonable expenditures borne by the University and/or the intellectual property right creator(s) incurred in securing the patents, registered designs, CL or PVR, and effecting a licence or other commercial agreement, the development and administration thereof, and all expenditures incurred in contemplation of or in any litigation or controversy between the creator(s)/University and third parties involving rights to any such inventions or designs.

10.3.1 Staff and students should note that KTO is available for consultation by those who wish to pursue the invention. Funding support may be available and KTO can advise on this and other matters.

10.3.2 Creators of patentable inventions, registrable designs, CL or PVR of which the University has the ownership or in which the University has an interest to pursue the invention must inform the University of the creation as soon as it becomes practicable to pursue the invention.

10.4 Sponsored and Consultancy Work

The ownership of any patentable inventions, registrable designs, CL or PVR which is created from sponsored and consultancy work is usually determined by the terms of the contract with the sponsor or any other relevant parties. Where the terms are silent on this issue, the ownership of the patentable inventions, registrable designs, CL or PVR shall be determined by the IPC and in making their determination the IPC may, so far as appropriate, apply *mutatis mutandis* the categorisation of work set out below.

10.5 Intellectual Property Rights Created in Employment

When a patentable invention, registrable design, CL or PVR is developed in the course of employment of staff, its ownership shall vest with the University.

(a) If the University decides to pursue the patentable invention, registrable design, CL or PVR, the net income shall be divided between the University and the intellectual property right creator(s) in the ratio of 70 to 30. Unless otherwise agreed, the University shall have 90 days from notification of the patentable invention, registrable design, CL or PVR by the creator(s) to the IPC to decide whether to pursue the patentable invention, registrable design, CL or PVR.

- (b) If the University decides not to pursue the patentable invention, registrable design, CL or PVR, the creator(s) may pursue it in his or her own name. Under such circumstances, the net income shall be divided between the University and the creator(s) in equal shares.
- (c) If the creator comprises more than one member, all members of the group shall be treated as one entity for the purpose of income-sharing between the creator and the University. The group shall submit to the University a written agreement on profit-sharing mutually agreed upon by all members of the group. If any member of the group is not a member of staff, the creator must draw his/her attention to the terms of this policy and agreement with the University prior to embarking on any design project or other exploitation of intellectual property.

10.6 University Assisted Personal Work

When a patentable invention, registrable design, CL or PVR is developed by staff not in the course of their employment but with the use of University facilities, staff and resources (library and computer use excepted), ownership of the intellectual property rights in the patentable invention, registrable design, CL or PVR shall vest with the intellectual property right creator(s) subject to the following :-

- (a) If the creator(s) decides to pursue the intellectual property right in his or her own name, the net income shall be divided between the creator(s) and the University in the ratio of 70 to 30.
- (b) If the creator(s) decides not to pursue the intellectual property right, the University may pursue it within 90 days of notification from the creator(s) (or such further time as both parties may agree). Under such circumstances, the net income shall be divided between the University and the creator(s) in equal shares.
- (c) If the creator comprises more than one member, all members of the group shall be treated as one entity for the purpose of income-sharing between the creator and the University. The group shall submit to the University a written agreement on profit-sharing mutually agreed upon by all members of the group. Similarly, if any member of the group is not a member of staff, the creator must draw his/her attention to the terms of this policy and agreement with the University prior to embarking on any design project or other exploitation of the intellectual property.

10.7 Personal Work

When a patentable invention, registrable design, CL or PVR is developed by staff not in the course of their employment and which does not fall under

category 10.6 above, the University has no ownership in any of the intellectual property rights. For the avoidance of doubt, in such cases :-

- (a) If the intellectual property right creator(s) decides to pursue the intellectual property right in his or her own name, the creator(s) shall have the right to retain all the net income.
- (b) If the creator(s) decides not to pursue the intellectual property right and the University, with the permission of the creator(s), pursues it, the net income shall be divided between the University and the creator(s) in equal shares, or in such other ratio as may be mutually agreed between the IPC on behalf of the University and the creator(s).

10.8 Research and Other Funded Work

Where a patentable invention, registrable design, CL or PVR is developed by staff or students in the course of conducting research or other projects funded either by the University or external organizations, not being Sponsored and Consultancy Work under 10.4, its ownership shall be determined by the terms of the project grant. Where the terms are silent on this issue, the ownership shall vest with the University.

- (a) If the University decides to pursue the patentable invention, registrable Design, CL or PVR, the net income derived shall be divided between the University and the intellectual property right creator(s) in the ratio of 70 to 30. Unless otherwise agreed, the University shall have 90 days from notification of the patentable invention, registrable design, CL or PVR by the creator(s) to the IPC to decide whether to pursue the patentable invention, registrable design, CL or PVR.
- (b) If the University decides not to pursue the patentable invention, registrable design, CL or PVR, the creator (s) may pursue it in his or her own name. Under such circumstances, the net income shall be divided between the University and the creator (s) in equal shares.
- (c) If the creator comprises more than one member, all members of the group shall be treated as one entity for the purpose of income-sharing between the creator and the University. The group shall submit to the University a written agreement on profit-sharing mutually agreed upon by all members of the group. If any member of the group is not a member of staff or students of the University, the creator must draw his/her attention to the terms of this policy and agreement with the University prior to embarking on any design project or other exploitation of intellectual property.

10.9 Publication of Work

Subject to any express terms to the contrary or to the University's directions and subject to ample notice being given to the IPC to decide whether or not to pursue the patentable inventions, registrable designs, CL or PVR created by such work, the University and/or the creators of such patentable inventions, registrable designs, CL or PVR shall have the right to publish the patentable inventions, registrable designs, CL or PVR once they are created. **However, it should be noted that any patentable inventions, registrable designs, CL or PVR will no longer have the requisite element of novelty for the purpose of the application if prior to application, there has already been disclosure by way of sale, advertising or publication.** Any contract with sponsors which requires the deferment of publication of the patentable inventions, registrable designs, CL or PVR for more than twelve months should only be accepted with prior written approval of the IPC.

11. PROPRIETARY INFORMATION AND KNOWHOW

Where staff or students create or acquire any proprietary information and knowhow in the course of their employment with the University or in the course of or for the purposes of their studies at the University, for which a patent or other intellectual property right cannot or will not be pursued but it has the potential for commercial exploitation, ownership of such proprietary information and knowhow shall vest in the University. If the University succeeds in commercialising the proprietary information and knowhow through licensing, technology transfer or other appropriate forms, the University may at the discretion of the IPC give 30% to 50% of the net income to the staff or students concerned. In this context, the net income is defined as the proceeds after deducting the total expenditure incurred by the University in the course of commercialisation.

12. TRADE AND SERVICE MARKS

12.1 Trade Mark

Trade mark informs of a number of things including origin, quality, status and image and these elements distinguish the goods or services of one business from that of another. Common examples include "Sony", "Coca-Cola", "Ralph Lauren Horse Device", "Christian Dior", "Hongkong Bank" and "Park'n Shop", and etc. Three dimensional objects such as soap in the shape of Mickey Mouse, and certain distinctive sounds are now registrable as trade marks.

OWNERSHIP AND USE OF UNIVERSITY TRADE AND SERVICE MARKS

12.2 The ownership of various logos, marks, designs, etc as used by the University including but not limited to "City University of Hong Kong", "CityU" and the University logo shall vest with the University. These marks (collectively referred to as the "Marks") are the property of the University. The University has the sole and exclusive right to use the Marks and license their use for commercial purposes on various forms of merchandise. The University also uses and licenses the use of the Marks as service marks in connection with various business enterprises and in the promotion of the University and its activities.

12.3 The Marks are extremely important to the University. Their importance is increasing as the University engages in more commercial and external activities. These Marks are therefore a commercial asset with increasing value.

12.4 The University has to ensure that the Marks are used:-

12.4.1 in a way that conforms with the requirements of Hong Kong trade mark law;

12.4.2 in an appropriate manner up to the standards and expectations of the University;

12.4.3 not in a derogatory manner causing any dilution of the University's reputation;

12.4.4 strictly in accordance with any agreements with outside bodies.

12.4.5 The University requires that the Marks, both now and in the future, be strictly used in accordance with the terms of this policy.

12.5.1 Subject to the University's overall control of the use of the Marks as stated in 12.2, the use of the Marks by staff and students for normal University educational and operational purposes is permitted provided that the Marks are not used in any derogatory, deceptive, scandalous or distorted manner. Prior written permission must be obtained from the IPC for any other use, including but not limited to :-

(a) use on goods of any kind

e.g. production and/or sale of clothing, badges, stationery etc. bearing one or more of the Marks

(b) use in connection with services of any kind

e.g. staff engaging in outside practice but using one of the Marks as part of, or promoting, that practice

- 12.5.2 The above provisions shall apply only to uses of the Marks to be made after the introduction of this revised intellectual property policy.
- 12.5.3 Applications for permission to use the Marks have to be submitted to the IPC at least 28 days before the Marks are scheduled to be used for the relevant purpose. All applications must be accompanied by a statement setting out the purpose for which the Marks are used, the duration of the proposed use of the Marks and the party(ies) involved in the relevant projects. A sketch of the Marks and the item(s) on which the Marks will be imprinted and, if available, a sample of the item(s) have to be provided to the IPC for consideration. The IPC shall, in its absolute discretion, decide whether or not to grant permission to use the Marks.
- 12.5.4 Applications will be handled with flexibility. However, in most cases, requests for the use of the Marks will be refused unless the University endorses or is involved in the relevant project.
- 12.6 It is the University's policy and a term of employment of staff and a term of admission of students that unless otherwise agreed expressly by the University in writing, ownership of all trade and service marks created by staff in the course of their employment or created by students during their studentship shall automatically vest in the University notwithstanding any rule of law or equity to the contrary.

13. IMPLEMENTATION OF THE POLICY

- 13.1 The IPC shall oversee the implementation of the policy on intellectual property. Its terms of reference is given in the Appendix.
- 13.2 Special cases which may arise and which are not specifically covered by the guidelines above should be submitted to the IPC for resolution. In any event when the intellectual property right owner, being either the University or staff, acts in accordance with the policy, the other party shall give all assistance as may be reasonably required by the other party, including the execution of all acts and documents to effect or facilitate the application and processing of the application.
- 13.3 The IPC shall decide upon issues of ownership in case of dispute or uncertainty and upon other issues given to it under this policy for decision. If any staff, student, Faculty, Department or other organizational unit within the University with an interest in a decision of the IPC is aggrieved by such decision, they shall have the right to request the President to review the decision of the IPC.

The President may seek such advice and accept such representations in relation to the decision as the President shall deem appropriate, both in relation to any decision to review and to the review itself. In determining whether or not to review the decision of the IPC, the President may seek to resolve the matter by conciliation, mediation or any other appropriate means. If the President decides not to review the decision of the IPC, that decision shall be final and binding on all parties concerned. If the President decides to review the decision, he may confirm the decision of the IPC or substitute an alternative decision. In either case the President's decision shall be final and binding on all parties concerned.

- 13.4 Where under the terms of this policy document provision is made for an income-sharing ratio, the University and/or the creator(s) of the relevant intellectual property rights may apply to the IPC for the ratio to be varied and the IPC may vary such ratio where if the IPC is satisfied that in all the circumstances of the case a different sharing is appropriate. The decision of the IPC shall be subject to review in the same manner as set out in section 13.3.
- 13.5 It shall be the responsibility of individual staff and students to inform the IPC if intellectual property rights in a work which may be owned by the University or in which the University has an interest to pursue are likely to be generated.
- 13.6 Where under the terms of this policy document the University or the creator(s) of intellectual property rights have the option to pursue those rights but decide not to do so, they shall do all things necessary and execute all documents necessary to enable the other party or parties to pursue the rights if they wish to do so.

June 2003 (Rev 3.2009)

Intellectual Property Committee

1. Organization Structure

As an executive committee established by the Management Board, the Intellectual Property Committee (IPC) is in charge of all matters relating to intellectual property at the University.

2. Terms of Reference

2.1 To promulgate and implement the University policies on intellectual property.

2.2 To vet proposals for patent, registered design and copyright from staff and students.

2.3 To apply for intellectual property protection to local and international patent and copyright offices.

2.4 To submit an annual report to the Management Board on activities relating to intellectual property at the University.

2.5 To co-opt additional members as the Committee sees fit.

3. Composition of the Committee

Chairman : Appointed by the President.

Members : Five members of academic staff appointed by the President.

Associate Vice-President (Knowledge Transfer) (ex-officio)

Secretary : Nominated by Associate Vice-President (Knowledge Transfer)

4. Term of Office

The term of office of all members including the Chairman is two years.

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