

Rules on the legal protection of intellectual property at Tallinn University

TU Senate Regulation No. 9 of 21 April 2014

Established on the basis of clause 16 (1) 6) of the Tallinn University Statutes and subsection 1 (5) of the Tallinn University Rules for Research and Development Activity.

Chapter 1 **GENERAL PROVISIONS [Amended 14.12.2015.]**

§1. Objective [Amended 14.12.2015.]

- (1) The objective of the Rules on the Legal Protection of Intellectual Property (hereinafter *Rules*) is to lay down the procedure for handling the intellectual property that is created as a result of the creative activity of Tallinn University (hereinafter *University*), the University community, and persons who are in contractual relations with the University.
- (2) In the legal protection of intellectual property, the University is governed by the legislation effective in the European Union and the Republic of Estonia, and the legal acts of the University, incl. the Statute and the Rules on Research and Development.
- (3) Counselling regarding the legal protection of intellectual property at the University is coordinated by the support unit for research administration. [Amended 14.12.2015.]

§2. Subjects and objects

- (1) Intellectual property denotes rights which are created in respect of the results of creative work. Personal rights inalienably owned by the author(s) as well as proprietary rights evolve in connection with objects of intellectual property. Intellectual proprietary rights are divided into copyrights, rights related to copyrights, and industrial property.
- (2) Intellectual property relating to the University is created as a result of the learning, research, development and creative activities of the University community (staff, students, research groups, etc.) and individuals participating in the work of the University on a contractual basis.
- (3) Subjects of intellectual property:
 - 1) author – a natural person that has created intellectual property. Where there are several authors, they are represented in relations with both the University and third parties by a representative selected by them unless otherwise stipulated in a written agreement between them. With a view to appointing a representative, the authors shall sign an authors' agreement in the format set forth in Annex 1;
 - 2) right holder – a person who holds rights to an object of intellectual property;
 - 3) right user – a person who has the right to use the rights arising out of an object of intellectual property;
- (4) Objects of intellectual property:
 - 1) work – a work of literature, science and art, incl. a computer programme, database;

- 2) objects of rights related to copyrights – performance of a work, a phonogram, original recording of a film, etc.;
- 3) objects of industrial property – an invention, utility model (or a small invention), industrial design, trademark, confidential information (knowhow) and the like.
- (5) The University and the author shall exercise their rights and perform their obligations in good faith without damaging other persons.

Chapter 2

COPYRIGHTS RELATING TO THE UNIVERSITY

§3. Ownership of copyrights and rights related to copyrights

- (1) Proprietary rights shall belong to the University provided that at least one of the following conditions is met:
 - 1) the work has been created under an employment contract in the course of performing direct duties of work;
 - 2) creation of the work and waiver of proprietary rights is set forth in the contract entered into with the author and/or contracting entity;
 - 3) proprietary rights have been transferred, or have been rendered for use, from the author or right holder to the University under a contract or have transferred to the University under another legal basis.
- (2) The University shall waive proprietary rights for the benefit of the author as regards scientific articles, monographs and conference materials (presentations, theses). Waiver of proprietary rights from the University to the author or performer of the work as regards other objects may occur by way of exception under a contract between the University and the author. The author or performer of the work shall submit a substantiated application for the transfer of proprietary rights. [Amended 14.12.2015.]
- (3) The University may agree with an employee in the employment contract between them that a Creative Commons Estonian licence or a compatible Creative Commons licence shall apply to works created by the employee in the course of their duties, which allows public dissemination of learning materials and other works. The employee is required to mark the materials disseminated under a Creative Commons licence as such.
- (4) In the following cases, the ownership and use of intellectual property shall be agreed upon in a contract between the University and another party (other parties) entered into before the creation of the intellectual property:
 - 1) authors belonging to a collective of authors that have no current employment contracts with the University;
 - 2) intellectual property is created under a contract between the University and the entity commissioning the work or service;
 - 3) intellectual property is created within the framework of research, development and creative projects where the University participates as one of the partners. The University may use the outcomes of a project free of charge for the purposes of learning, research and development activities.
- (5) Where the ownership of proprietary rights has not transferred to the University based on the provisions of subsections 1–4 of this section and the author wishes to transfer their proprietary rights to the University, the University and the author(s) shall sign an instrument of the transfer of proprietary rights in the format set forth in Annex 2.

[Amended 14.12.2015.]

- (6) The Author may render the right to exercise personal rights in the use of the University under a licencing contract. Rendering into use, public performance and broadcasting of an object of copyright or rights related to copyrights shall occur under a written licencing contract. Entry into the licencing contract and the distribution of costs shall be agreed upon in a contract between the parties, giving due consideration to the costs incurred by the sale or rendering into use of the object of copyright.
- (7) Where the University is the holder or user of an object of intellectual property, the author or performer of the work is required to make a reference in the work that the work or performance has been created at the University. Details of the person(s) that created the work and the holder of the proprietary rights of the work shall be marked on the work (on hard copy, in an electronic or other format). Details shall be displayed on the work in a way that they are clearly visible and easily located. Copyrights shall be marked as follows:
 - 1) in Estonian – Autoriõigus, <autor/koostaja eesnimi perekonnanimi>, Tallinna Ülikool, <loomise aasta>;
 - 2) in English – Copyright, <author's/compiler's first name family name>, Tallinn University, <year>.
- (8) The protection of copyrights and rendering of works in use shall be organised by the University units that are involved in the creation of the relevant work or result of other creative activity.

Chapter 3

INDUSTRIAL PROPERTY RELATING TO THE UNIVERSITY

(Note: Trademarks relating to the University are addressed in Chapter 4.)

§4. Ownership of industrial property rights

- (1) The University may apply for the registration of industrial property (incl. patent claims) and to become the holder of proprietary rights, if at least one of the following conditions has been met:
 - 1) industrial property has been created under an employment contract in the course of direct duties and the contract between the parties does not stipulate the ownership of proprietary rights in another way;
 - 2) creation of industrial property and/or waiver of proprietary rights is set forth in the contract entered into with the author and/or contracting entity;
 - 3) proprietary rights have transferred to the University on any other legal basis.
- (2) The ownership of proprietary rights of industrial property created by third persons in the course of fulfilling obligations under a contract entered into with the University (incl. the provision of knowledge services and projects finances within the framework of international cooperation) shall be agreed upon in a contract. Where industrial property has been created as commissioned by third persons, proprietary rights may be held by persons other than the University or the contracting entity if so set forth in the contract.
- (3) Individuals that participate in a project implemented on behalf of the University, incl. students who have no employment relationship with the University or whose employment contract does not regulate the ownership of intellectual property, shall

transfer, before they start implementing the project, to the University the right to apply for legal protection of the subject-matter of industrial property stemming from the outcomes created by the project and to become the owner of the subject-matter of intellectual property (form presented in Annex 2).

- (4) Where there are several authors of industrial property, arrangements regarding the distribution of work, proprietary contributions and costs, ownership and use of industrial property, proceeds, etc., shall be made already in the preparation process of the industrial property planning.
- (5) Where industrial property created with the participation of the University is the result of joint activities of several natural persons, the University shall have co-authorship with the partners. In case of co-authorship, all authors shall exercise their rights jointly unless otherwise provided in the written agreement between them.

§5. Confidential information regarding industrial property

- (1) Any confidential information regarding the University's industrial property (information, the disclosure of which may damage the intellectual property of the University and its use, incl. business secrets and knowhow) shall belong to the University.
- (2) Employees are required to keep confidential any information regarding objects of industrial property which, if disclosed, may damage the legal rights of the University. Information regarding the University's industrial property shall remain confidential at least until an application for legal protection is submitted to the Patent Office, a disclosure decision is made by the University or the deadline arising from the contract that underlies the information created.
- (3) The author is required to inform the person responsible for the implementation of the project and all heads of units participating in the project about the outcomes that presumably have a commercial value, who shall submit information concerning the object to the support unit for research administration in the relevant format (Annex 3). [Amended 14.12.2015.]
- (4) The head of the unit or the person responsible for the implementation of the project shall organise entry into an agreement ensuring confidentiality between the author(s) and other persons who have confidential information regarding industrial property (the format can be found in Annex 4) and shall ensure that all documents containing confidential information are correspondingly marked as "Confidential". [Amended 14.12.2015.]
- (5) Disclosure of materials containing confidential information shall have been approved beforehand according to the procedure laid down in the agreement ensuring confidentiality.

§6. Application for the legal protection and use of industrial property

- (1) The protection and rendering in use of industrial property shall be organised by the University units involved in the creation of the relevant object of industrial property who shall also cover the related costs. If the unit has no funds to apply for legal protection or pay the state fee, the head of the unit may request money to cover such

costs from the University budget. The decision on the allocation of funds shall be made by the Rector or a head of studies designated by the Rector. [Amended 14.12.2015.].

- (2) A decision to initiate a patent study and/or assessment of commercial viability of an object of industrial property shall be made by the head of the unit and approved by the Rector or Prorector designated by the Rector. Activities concerning the patentability / assessment of commercial viability of an object of industrial property, carrying out of necessary preliminary research (patent study, market research, etc.) and application for legal protection shall be organised by the support unit for research administration of the University. [Amended 14.12.2015.]
- (3) A decision to initiate application for industrial property and major financial decisions relating to the applications for legal protection submitted on behalf of the University (continued validity, extension of validity, etc.) shall be made by the Rector or a head of studies designated by the Rector based on a joint submission from the unit and support unit for research administration. [Amended 14.12.2015.]
- (4) A decision to initiate application for legal protection for industrial property may be one of the following:
 - 1) to initiate application for legal protection on behalf of the University;
 - 2) to treat the industrial property to be created as knowhow owned by the University, without initiating the legal protection process;
 - 3) to not initiate application for legal protection on behalf of the University.
- (5) If the University foregoes organisation of the patent study / assessment of commercial viability of industrial property and application for legal protection or if continued validity of the application for legal protection / extension of the legal protection document is deemed to be not purposeful, proprietary rights together with the right to apply for legal protection may be waived to the author or, if the author rejects the offer to any interested third persons, subject to a relevant written contract and as prescribed by legislation.
- (6) Rendering use of an object of the University's industrial property or sale of the right of use may occur after receipt from the Estonian Patent Office of a notice regarding the admissibility of the application for a patent, utility model, industrial property design, etc. Rendering use of an object of the University industrial property or sale of the right of use shall be subject to a written licencing contract or a contract on the use of knowhow.
- (7) Licensing contracts with the licensee shall be entered into by the University (the licensor) or a third person with whom the University has a contract granting the relevant rights to them. The terms and conditions of the licencing contract shall be determined on the basis of the results of negotiations between the licensee and the licensor. The University shall involve the authors of the object of industrial property in the negotiations preceding the licencing contract.
- (8) Knowhow contracts shall be entered into by the University. The rights of use of knowhow shall be sold either separately, or together with the invention or other outcomes of the project.
- (9) Licensing contracts relating to a legally protected patent, utility model and industrial design shall be registered with the licensing office of the relevant country or international organisation. The support unit for research administration shall be

responsible for registration in the University. [Amended 14.12.2015.]

- (10) The author of industrial property is entitled to fair remuneration (profit share) for rendering use of the object of industrial property. The profit share shall be disbursed out of the proceeds after the costs incurred by having legal protection, continued validity and rendering in use of industrial property have been covered. The University shall enter into a profit distribution contract with the author, laying down the profit share of the author, procedure and conditions of disbursement.
- (11) The University shall guarantee to the author in the terms and conditions of the contract waiving the author's proprietary rights a justified portion of the proceeds of industrial property, which shall be at least 33% of the net profit from sale of a licence or resale of a patent. In distributing the profit, the principle shall be proceeded from that the share of the University shall not be less than 33%.

Chapter 4

TRADEMARKS RELATED TO THE UNIVERSITY

§7. Application for legal protection of a trademark

- (1) The Rector, Prorector, Chancellor or Unit Head have the right to initiate the trademark process. The initiator of the trademark process shall notify the support unit for research administration about the initiation of the trademark process (the format can be found in Annex 3), organise the preparation of materials needed for the statute and legal assessment of the trademark in cooperation with relevant support units. [Amended 14.12.2015.]
- (2) A decision to initiate the legal protection of the trademark and major financial decisions relating to the applications for legal protection submitted on behalf of the University (continued validity, extension of validity, etc.) shall be made by the Rector or a head of studies designated by the Rector based on a joint submission from the initiator of the trademark process. [Amended 14.12.2015.]
- (3) A decision to initiate application for legal protection for trademark may be one of the following:
 - 1) to initiate registration of the trademark on behalf of the University;
 - 2) to not initiate registration of the trademark on behalf of the University.
- (4) Licensing contracts relating to a legally protected trademark shall be registered with the licensing office of the relevant country or international organisation. The support unit for research administration shall be responsible for registration. [Amended 14.12.2015.]

Chapter 5

STUDENT WORKS

§8. Clauses on student works

- (1) The copyright of a student work shall belong to the student unless otherwise provided by law or contract. [Amended 14.12.2015.]
- (2) A lecturer shall be deemed to be a joint author or co-author of a work created by the

student in the course of studies in the University if the lecturer provided their direct creative input to the work. Consultation of the student and fulfilment of the function of administrative control, revision of the work, drawing of graphs, schemes, etc., and provision of other types of technical assistance shall not be deemed to constitute direct creative input. Where a lecturer and a student have joint authorship or co-authorship, their relations shall be governed by a contract.

- (3) In case of commissioned work for third persons performed in the course of studies or in case of participating in other projects implemented on behalf of the University, the University shall enter into a contract with the student who has no relationship with the University or whose contract does not regulate the ownership of intellectual property and by this contract the student waives their proprietary rights stemming from the outcomes created by the project to the University (the format can be found in Annex 2).
- (4) If a final thesis, doctoral thesis or relevant publications contain confidential information regarding the intellectual property of the University (incl. knowhow), the supervisor of the thesis is required to submit a request to hold the defence of the thesis in camera and the defence committee shall restrict access to the doctoral thesis.

Chapter 6

FINAL CLAUSES

§9. Implementation clauses

“Rules on the legal protection of intellectual property in the Tallinn University” established by the 14 June 2004 Regulation No. 9 of the Council of the Tallinn Teacher Training University shall be repealed.

/signed digitally/

Tiit Land
Rector

/signed digitally/

Hille Erik
Senate Secretary

AUTHORS' AGREEMENT

In Tallinn, 20.....

Pursuant to the legislation regulating the protection of intellectual property effective in the Republic of Estonia, the authors of intellectual property to be created within the framework of the contract

.....
have agreed as follows:

The title of the work / object of industrial property shall be:

""

The authors of the work / object of industrial property shall be:

First name Surname

First name Surname

First name Surname

First name Surname

Ownership of copyright:

1) the proprietary rights of the work / object of industrial property shall belong to ***Tallinn University***;

2) the personal rights of the author shall belong to the authors ***jointly***.

Any proceeds from the sale or rendering in use of intellectual property prescribed to be received by authors shall be distributed between the authors (e.g., ***as follows:***) (e.g., ***in equal parts***).....

The authors shall be represented in relations with Tallinn University and third persons by.....

(*first name, surname, contact data*)

Should the list of authors change, the representative of the authors shall promptly notify Tallinn University in writing about this.

First name Surname(Signature) Address

First name Surname(Signature) Address

First name Surname(Signature) Address

First name Surname(Signature) Address

INSTRUMENT OF THE TRANSFER OF PROPRIETARY RIGHTS

In Tallinn, 20.....

We, the undersigned, represent and warrant that we transfer all proprietary rights stemming from the outcomes of the research and development project / contract

.....

,
 incl. the right to apply for the registration of a patent and utility model and become the owner of the patent and utility model, to Tallinn University, Narva mnt 25, Tallinn 10120 (registry code 74000122).

Author(s)

First name and surname	Position	Unit [Amended 14.12.2015.]	Signature

Tallinn University

First name and surname	Position	Signature

NOTICE CONCERNING THE CREATION OF AN OBJECT OF INDUSTRIAL PROPERTY

The submission of this notice aims to give information to the University concerning an object of industrial property with a presumed commercial value to facilitate the making of legal and financial decisions and assessing the commercial viability. Such information shall be treated as confidential.

1. Title of the object of industrial property:	
2. Authors (<i>name, position, unit, e-mail</i>): [Amended 14.12.2015.]	
3. Description of the invention:	
- purpose/objective of the invention	
- a brief description of the invention	
- what is innovative about the invention	
- advantages and improvements compared with existing solutions	
- uses, incl. potential users in Estonia	
- uses, incl. potential users in other countries	
4. Creative process of the invention:	
- first oral disclosure, date, notes	
- first publication, date, notes	
- creation of the prototype/model, date, notes	
- the project from which the invention evolved	
- other important events	
5. Contracts/grants which resulted in the creation of the invention (registration number in the Tallinn University, source(s) of finance, contractual ownership of the invention)	
6. Background information:	
- results of the patent study carried out (list of patents/publications found), sources used in carrying out the study	
- keywords to order the patent study from the research department	
- other important background information	

The following documents are attached to this notice:

<i>For an invention and industrial design:</i>	<i>For a trademark:</i>
<i>a) authors' agreement (Annex 1 to the Rules)</i>	<i>a) draft statute of the trademark</i>
<i>b) estimated costs needed for the application of legal protection</i>	<i>b) design of the trademark</i>
<i>c) source of financing</i>	<i>b) estimated costs needed for the application of legal protection and the source of financing</i>
<i>d) where relevant, instrument of the transfer of proprietary rights (Annex 2 to the Rules)</i>	<i>d) explanation regarding the options of rendering the trademark in use</i>

Person responsible for the implementation of the project

Name

Signature

Head of Unit [Amended 14.12.2015.]

Name

Signature

CONFIDENTIALITY AGREEMENT

In Tallinn, 20.....

We, the undersigned, represent and warrant that we will keep confidential information regarding intellectual property to be created within the framework of the contract

.....

and to not disclose such information to third parties to the extent of

.....

(name of the invention, knowhow, design, etc.).

Such information remains confidential until

..... *(to be filled in by the person responsible for project implementation)*

Authors / project performers

First name and surname	Position	Unit [Amended 14.12.2015.]	Signature

Tallinn University

First name and surname	Position	Signature