



Guideline for the claim and exploitation of service inventions and intellectual property (IP) at the University of Natural Resources and Life Sciences, Vienna (BOKU)

Guideline claim, exploitation, IP

published in Bulletin no. 13 / academic year 2023/2024 on 20.03.2024

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1 Preamble

Universities play an essential role in the continuous innovation process, which is of key importance to our economy and to society. In this process, BOKU is a source of ideas and inspiration and continually encourages its employees to translate their research results and to realise their ideas. Compliance with legal and internal regulations on service inventions and intellectual property is essential in this context.

2 Scope

The scope of this guideline covers all matters regarding the claim and exploitation of service inventions and intellectual property (IP) at the University of Natural Resources and Life Sciences, Vienna ("BOKU"). All university employees are bound by the guideline.

The guideline was adopted at the meeting of the Rectorate on 12.03.2024 and takes effect on 20.03.2024 (publication date in Bulletin no. 13 / academic year 2023/2024).

This guideline replaces the "Guideline for the claim and exploitation of service inventions at BOKU" (in German) from 2017.

Further information can be found on the BOKU intranet in section "Service inventions" [<https://boku.ac.at/fos/themen/diensterfindungen>] (login required!).

3 Definitions

Employees

Employees constitute any individuals employed by the University of Natural Resources and Life Sciences, Vienna. This includes university employees and civil servants who are part of the university's office.

Intellectual property (IP)

In this guideline, intellectual property (IP) refers to inventions in particular, but also to all other research and work results of employees of the University of Natural Resources and Life Sciences, Vienna (BOKU) irrespective of their eligibility for intellectual property rights.

Exploitation

Through exploiting IP, university research results are disseminated as inventions to society and the economy. Thereby, BOKU fulfils its social responsibility benefitting a sustainable future according to its Third Mission.

Invention

An invention is a technical solution to a problem. To be patentable, it must be new, inventive and commercially exploitable. These characteristics are measured against the current state of the art. The current state of the art constitutes anything that is made publicly available (publication, lecture, website, etc.). If no intellectual property right has been registered yet, it is important to keep the invention confidential to allow for exploitation.

Service invention

According to Section 7 (3) of the Austrian Patent Act a service invention is defined as:

A service invention shall mean the invention of an employee if its subject matter falls within the activities of the enterprise in which the employee is active and if

- a. either the activity that led to the invention forms part of the employee's obligations, or
- b. the incentive for the invention by the employee is based on his activity within the enterprise, or
- c. the making of the invention was significantly facilitated by using the experiences or resources of the enterprise.

In the remaining document service inventions are referred to as inventions.

Other IP:

- **Technology without intellectual property rights – non-patentable IP**

Technologies without intellectual property rights (TOS) are research results that can be commercially exploited, but do not qualify for granting intellectual property rights, or for which no intellectual property rights are sought, such as (published) cell lines, methods, research reagents, know-how, standard operating procedures (SOPs), work results, etc.

- **Design** - Protection of the external form of an industrial product or craft product or a part thereof.
- **Trade mark** - A trade mark is a company feature that intends to distinguish a company's goods and services from those of its competitors.
- **Variety** - Plant variety protection confers an exclusive right to produce and distribute propagating material for new plant varieties. This right is granted to the breeder for a fee upon application and is valid for a maximum of 25 years (except for trees, vines, hops and potatoes: 30 years). Currently, all species are eligible for plant variety protection in Austria.
- **Software** – Programming of software constitutes a particular case. If a "technical effect" is achieved, software can be patented. If this "technical effect" is not achieved, the software is classified as TOS. The programming of software is protected by copyright. Software can also be protected by other industrial intellectual property rights, such as design protection, trade mark protection, etc.

Research Support - Technology Transfer (FoS-TT)

FoS-TT comprises the Technology Transfer and BOKU:BASE departments within the Research Support and acts as the point of contact for matters concerning the claim and exploitation of service inventions and other IP at BOKU (<https://boku.ac.at/fos/technologietransfer/>).

4 Notification of inventions

According to Section 106 (2) and (3) of the Austrian Universities Act, the university is entitled to service inventions created at a university during public or private law employment or during training relationships with the federal civil service or the university.

Inventors must report all inventions according to Section 7 (3) of the Austrian Patent Act, which are created in part or in whole by employees of BOKU, to BOKU.

Failure to report a service invention or false information may result in the employee's liability for damages. A patent must not be filed prior to reporting the corresponding invention. Inventions must also be reported in case they arise from third-party funded research or in cooperation with third parties (e.g., companies) and are filed for patent by third parties according to contractual obligations.

Any individuals employed by BOKU are required to report (also applies to employees on leave, provided that the legal requirements for a service invention are met). Therefore, this does not apply to students, diploma students and doctoral candidates not employed by BOKU (a separate agreement is thus required).

A potential service invention is reported using the invention disclosure form (<https://boku.ac.at/fos/technologietransfer/formulare-richtlinien>). Inventors send the original, completely filled-in and signed form including all necessary documents (if applicable, copies of relevant contracts, sketches and publications mentioned) by internal mail or post to:

*BOKU Research Support
Technology Transfer
Peter-Jordan-Straße 70
A - 1190 Vienna*

The Rectorate has to notify the inventor within three months from the **date of full receipt** about the claim of the rights to the service invention.

Only those invention disclosures, that contain all the documents and information necessary for examination and are confirmed with a positive response by the FoS-TT, are considered as "received in full".

5 Notification of other IP

Technologies and materials developed at BOKU without industrial intellectual property rights also belong to BOKU as the employer. These should be reported to the Technology Transfer prior to commercialisation, and no later than at the start of negotiations with interested commercial parties. If BOKU decides to exploit the technology, it will determine a strategy for exploitation with the researchers.

To report other IP with commercialisation potential, please contact FoS-TT (techtransfer@boku.ac.at).

6 Evaluation

Upon receipt of the invention disclosure / disclosure of other IP, Technology Transfer examines the formal information and the legal framework of the invention / other IP.

- **Inventions** are assessed internally regarding their patentability and marketability. If required, additional external experts or patent exploitation agencies and patent attorneys are consulted for this assessment.
If the invention arose from a project with third parties, the associated concluded contracts are reviewed.
- For **other IP**, the general conditions (marketability) are assessed. If required, external experts are consulted, and the further course of action is determined in consultation with the inventors.

7 Confidentiality

The inventor must keep the invention confidential until BOKU has reached a decision about claiming the invention or, if the invention is claimed, until the patent application has been filed.

All employees processing the invention disclosure and external experts also have a duty of confidentiality or, if required, confidentiality agreements need to be concluded.

For other IP, confidentiality needs to be assessed on a case-by-case basis and duration and scope of confidentiality need to be determined by Technology Transfer.

8 Decision about claiming inventions

If BOKU claims the rights to the reported invention through the Rectorate, it must communicate its decision within three months after having received the invention disclosure in full. The Rectorate's decision is based on the evaluation by FoS-TT and/or by external experts.

In case of a claim, the inventors are notified in writing and must confirm receipt of this notification in writing. For this purpose, the confirmation of receipt form which is enclosed with the notification about the claim should be returned to Research Support by internal mail or post.

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Technology Transfer
Peter-Jordan-Straße 70
A - 1190 Vienna*

The **claim of an invention does not release the inventors from their obligation to maintain confidentiality**. Results or the invention can only be published after an application for intellectual property rights has been filed or after BOKU has approved publication.

If the university decides not to claim the service invention, the rights to the invention are transferred to the inventors. This decision is also communicated to the inventors in writing.

9 Rights to other IP

The rights to other IP, created at BOKU, belong to BOKU as the employer.

Working closely with the researchers, the university assesses the possibility of exploitation, e.g., commercially or for research and teaching at the university.

10 Exploitation

If BOKU decides to claim / exploit the service invention / other IPs, an exploitation strategy will be determined with the inventors / employees, consulting an exploitation agency, if required. The patent costs are paid by BOKU as the employer.

BOKU takes the following actions, among others, for the **exploitation of inventions / other IP** (external experts are consulted, if required):

- Discussion with employees/inventors to evaluate commercialisation options (e.g., licence, sale, founding) and to develop an exploitation strategy.
- For inventions: Initial consultation with a patent law firm to plan the patent strategy/application and to prepare the patent application.
- Identification of interested parties and cooperation partners
- Establishing and initiating contact with interested parties
- Establishing legal certainty for all partners (university, industry, etc.)
- Negotiation and conclusion of exploitation agreements involving the inventors

Depending on the legal background, **other IP** can be exploited in a similar way to an invention.

11 Revenue and remuneration

If BOKU claims the reported invention, the inventors are entitled to inventor remuneration (§§ 8 et seqq. Austrian Patent Act). This is due as soon as revenue (e.g., licensing revenue, option payments) is generated from the exploitation of the invention. The payment is subject to social security and income tax regulations. Any funding for patent costs or the full/partial assumption/refunding of patent costs by third parties do not entitle to payment. If multiple inventors are involved in the invention, proceeds will be divided according to the percentage shares of the invention stated in the invention disclosure.

The first € 3,000 of returns from the exploitation of an invention are paid to inventors in full - if applicable, proportionally to the shares of the invention stated in the invention disclosure. In case of active employment by BOKU, payment is made via payroll (minus employee and employer contributions). Inventors who are not currently employed by BOKU will issue an invoice in consultation with the BOKU Technology Transfer Office and the (pro rata, if applicable) amount will be transferred to an account specified by the respective inventor. These inventors are responsible for correction taxation and BOKU must be indemnified and held harmless regarding income tax and social security contributions.



Inventors who are not currently employed by BOKU must ensure that BOKU Technology Transfer has their current contact address.

Exploitation proceeds in excess of € 3,000 are used to cover **costs incurred** during exploitation (see "Exploitation"); **this can be based not only on costs already incurred, but also on certainly expected future costs.**

After covering any exploitation costs, the remaining returns are divided between **BOKU** inventors, their affiliated **department**, in the form of **future investment** for transfer and exploitation activities and in the form of **risk coverage** in a **35:15:30:20** ratio [inventors: department: future investment: risk coverage].

The departmental share is used exclusively to **support research infrastructure**. The head of the department is responsible for its disposition. It is recommended to allocate the funds to an area associated with the inventor. If several departments are involved in the invention, the funds are allocated to the departments proportionally to their inventors' involvement in the invention. For amounts below € 1,000, the amount will be allocated to the department with the largest share of the invention.

The shares of **future investment** are used for financing future patenting and commercialisation activities at BOKU.

The **risk coverage covers the financial risk** in applications for intellectual property rights (costs incurred in the event of financial failure).

For **other IP**, there is no legal obligation for the University of Natural Resources and Applied Life Sciences, Vienna to exploit / remunerate. In case of exploitation, the process is the same as the one defined for inventions in this guideline.

12 History

Version	Amendment	From	decided on	published
1	Initial creation	Vice Rectorate for Research; h13000	Rectorate on 22.04.2004	2004
2	On 21.01.2014 the Rectorate adopted the invention disclosure form "Erfindungsmeldung-BOKU_v2014-01-21_final". This form replaces the form valid from 22.04.2004 according to the "Guideline for the claim and exploitation of service inventions at the University of Natural Resources and Life Sciences" (in German)	Vice Rectorate for Research; h13000	Rectorate on 21.01.2014	06.02.2014
3	Update of all sections	Vice-Rectorate for Research & International Research Cooperations; h13000	Rectorate on 10.01.2017	06.03.2017, no. 149, 11th issue, academic year 2016 / 2017
4	Updated version of invention disclosure form Changes apply to <ul style="list-style-type: none"> - Information about sharing contact details - Addition of providing a private email address - Gender-neutral salutation - Translation into English 	Vice Rectorate for Research; h13000	(Version of form according to the decision of the Rectorate from 21.01.2014)	Bulletin Academic year 2021/22 29.09.2022 27 th issue
5	Update of all sections	Vice-Rectorate for Research & Innovation; h13030, h13070	Rectorate on 16.01.2024	Bulletin Academic year 2023/24 No. 09 / 02.02.2024
6	Translation into English	Vice-Rectorate for Research & Innovation	Rectorate on 12.03.2024	Bulletin Academic year 2023/24 No. 13/ 20.03.2024