

Supplementary Guidelines for the Protection, Management and Valorization of Industrial Property

The official and legally binding of the regulations is the one in Italian. This document is for informational purposes only and cannot be used for legal purposes; it provides general overview of IUSS regulations in English.

1. Preamble

These guidelines supplement the "Regulation on the protection and promotion of the industrial property of Scuola Superiore Sant'Anna, Scuola Normale Superiore, Scuola IMT Alti Studi Lucca, and Scuola Universitaria Superiore IUSS di Pavia" (hereinafter referred to as the "**Regulation**"), by providing operational and procedural guidance. They respond to the need to harmonize internal procedures with the legislative provisions in force regarding industrial property, in order to support and facilitate the valorization of university research results. These guidelines take into account best practices in industrial property management adopted by other academic institutions, while nonetheless preserving the identity and autonomy of the Scuola Universitaria Superiore IUSS Pavia (hereinafter referred to as the "School's IP Guidelines").

In particular, the School's IP Guidelines define:

- (i) the methods and timelines for the submission of the invention disclosure by the Inventor to the Technology Transfer Office ("**TTO**") of the IUSS School;
- (ii) the internal methods and procedures for the protection, management and valorization of industrial property rights relating to Inventions, as defined by the JoTTO Regulation, as well as the procedures for decisions concerning the maintenance or abandonment of such rights;
- (iii) the criteria for negotiating agreements between the IUSS School and the funding or commissioning entity, in compliance with the inter-ministerial Guidelines ("**MIMIT-MUR Guidelines**");
- (iv) the rules governing incentives associated with the inventive activity, which are granted to the Inventors of the IUSS School;

such provisions are intended to ensure a clear and structured process for the management of industrial property, while promoting the interest of research and its practical application.

2.Scope and definitions

2.1 Scope

These School's IP Guidelines regulate the internal methods and procedures for the protection, management and valorization of Inventions, including patents, software, trademarks, industrial designs, know-how, trade secrets, and any other right protectable under the Codice della Proprietà Industriale ("C.P.I."), generated within the framework of (i) institutional research, namely research conducted within the IUSS School using its own funds and initiatives, including resources from the Ordinary Financing Fund, and (ii) funded or commissioned research, namely research supported and financed, in whole or in part, by external entities for the institutional purposes of the IUSS School or for the performance of research on behalf of third parties. In the case of Inventions arising from research funded or commissioned by third parties, the methods and procedures specified herein supplement

the provisions laid down from time to time in the specific contractual agreements entered into between the IUSS School and the funding or commissioning entity, negotiated in accordance with the general principles defined by the MIMIT-MUR Guidelines and in compliance with Article 6, paragraph 3, of the Regulation.

2.2 Definitions

The definitions set forth in the Regulation are hereby fully incorporated into the School's IP Guidelines, as applicable, such as:

- a) "Invention",
- b) "IP Rights",
- c) "Inventor",
- d) "Commission",
- e) "JoTTO",
- f) "TTO",
- g) "CPI",
- h) "Invention Disclosure",
- i) "School's IP Guidelines",
- j) "MIMIT-MUR Guidelines".

Furthermore, for the purposes of the School's IP Guidelines:

k) "Know-how" means the body of knowledge, whether codified or not, arising from the research carried out by the Inventors and constituting the subject matter of non-registered industrial property rights, including Inventions not yet patented.

l) "IUSS Technology Transfer Commission" or "CTT IUSS" means the Technology Transfer Commission of the IUSS School, established with Rectoral Decree no. 98/2023 and regulated within the "Regulation on the promotion of new entrepreneurship, spin-offs and start-ups" of the Scuola Universitaria Superiore IUSS Pavia.

3.Procedure for the initiation of protection and valorization of Inventions

In the process of initiating the protection and valorization of Inventions within the IUSS School, various bodies with specific competencies are involved, ensuring a structured and transparent management of industrial property.

3.1 Invention Disclosure

As defined in the Regulation, the TTO is the Technology Transfer Office of the IUSS School, regardless of its actual and updated designation. At the time of issuing the Regulation, the TTO is the "U.O. Rapporti con le imprese e impatto".

Inventors are required to disclose to the TTO any research result that, in good faith and based on their experience,

they believe may constitute a protectable Invention or Know-how, using the forms specifically prepared by the TTO and also available on the institutional website, sending the Disclosure to impatto@iusspavia.it (cc: organi@iusspavia.it), in compliance with Articles 4 and 7 of the Regulation.

The Disclosure shall include:

- i) the name(s) of the Inventor(s), their position within the IUSS School, and the percentage of their inventive contribution;
- ii) a detailed description of the Invention, highlighting the technical problem addressed by the Invention and the advantages or improvements it provides over what is already known in the state of the art;
- iii) the name of any inventors external to the IUSS School, with their affiliation, and/or other external entities or subjects involved;
- iv) the context in which the Invention arises, indicating any research projects, collaboration and/or commissioned research contracts in any way connected or related to the Invention;
- v) any meetings, events, publications or other circumstances that may have resulted in the disclosure of information related to the Invention;
- vi) any other information useful for the preliminary evaluation of the Invention.

3.2 Should the Disclosure fail to include all the information necessary to carry out the evaluation referred to in the following Article 4, the TTO shall request any additional information it deems appropriate in order to proceed with the subsequent steps. The Inventor(s) shall cooperate in order to ensure that the Disclosure is complete and exhaustive.

4. Preliminary Evaluation (Pre-screening)

Upon receipt of the Disclosure referred to in Section 3.1 above, the IUSS School TTO shall intervene in the procedure for initiating the protection of Inventions, with the following functions:

- to carry out an initial evaluation (pre-screening) of the Invention through a preliminary analysis on the existence of the patentability requirements and of its suitability for protection by means of a patent or other forms of protection of IP Rights;
- in the event of a positive evaluation, the TTO shall prepare the necessary documentation and process the application for submission to the Technology Transfer Commission, so that it may issue a reasoned opinion.

5. Examination by the Technology Transfer Commission (CTT IUSS)

At the first available session, or, where there are well-founded reasons of urgency, also by means of asynchronous online consultation, the CTT IUSS, based on the assessment carried out by the TTO, shall issue a reasoned opinion on whether or not it is appropriate to proceed with the protection of the Invention.

5.1 In the event of a negative opinion, the TTO shall inform the Inventor of the negative outcome of the CTT IUSS evaluation and submit the application to the governing bodies of the IUSS School, so that they may adopt the decisions within their competence. Upon receipt of the resolution, the TTO shall notify the Inventor of the IUSS School's lack of interest in proceeding with the protection of the Invention, leaving the Inventor the option to proceed independently pursuant to Article 65, paragraph 3, C.P.I.

5.2 In the event of a positive opinion, the TTO shall process the application for submission to the Joint Technology Transfer Commission JoTTO, pursuant to Article 8 of the Regulation. The JoTTO Commission, having examined the documentation received from the TTO, shall issue an opinion on whether or not it is appropriate to protect the Invention through IP Rights in the interest of the IUSS School. The opinion issued by the JoTTO Commission, together with that issued by the CTT IUSS, shall then be forwarded to the Inventor, via the TTO. The application shall subsequently be submitted to the governing bodies of the IUSS School, so that they may adopt the final decisions within their competence regarding the protection of the Invention.

6. Management of the Industrial Property portfolio

6.1 The IUSS School, through its TTO, shall carry out periodic monitoring of its portfolio of industrial property rights, aimed at ensuring that resources are allocated efficiently to Inventions with the highest potential for economic, academic, and strategic valorization, as well as the capacity to generate social impact. The TTO may rely on the support of an external patent firm to supplement the technical and strategic analysis, which includes:

- evaluation of the valorization prospects of the rights and of any expressions of interest received from external entities;
- verification of the status of the industrial property rights, including filed patent applications under examination, patents already granted, and registered trademarks;
- verification of the financial resources available for maintaining the related rights, or for proceeding with activities useful or necessary to ensure the validity of filed patent applications, such as, by way of example but not limited to: (i) the territorial extension of patent protection, (ii) the filing of responses to official communications received from competent patent and trademark offices, (iii) the filing of oppositions or reply briefs to any third-party oppositions, (iv) the payment of renewal fees for registered rights, (v) the entry into national phases.

6.2 Based on the monitoring results, the TTO, in collaboration with the Technology Transfer Commission (CTT IUSS):

- proposes the maintenance of industrial property rights considered relevant and/or strategic, assessing whether to proceed with the activity/activities referred to in point 6.1.;
- may suggest the abandonment of rights no longer considered relevant or economically advantageous.

Where applicable, the proposals of the TTO and the CTT IUSS shall be submitted to the governing bodies of the IUSS School for final approval/disapproval and for the adoption of the resolutions within their competence.

6.3 In the event that a title is deemed of interest and a decision is made to proceed with the territorial extension of patent protection and/or entry into national phases, in the absence of expressions of interest or letters of intent from external parties, the Inventors shall be required to provide a financial contribution to cover the related patent expenses.

6.4 In the event that a title is no longer considered of interest and a decision is made to abandon it:

- the Inventor shall be promptly informed and may assume ownership of the title, taking full responsibility for all future maintenance and management costs.

Inventors who assume ownership shall be required to reimburse the patent expenses already incurred by the IUSS School, according to terms and conditions defined in a separate agreement. 6.5 In addition to periodic monitoring, the IUSS School may initiate extraordinary reviews of its portfolio of industrial property rights in the presence of significant changes in the technological, regulatory, or economic context in which it operates, in order to ensure a more flexible and proactive management of the portfolio.

7. Valorization of Inventions

The Inventors and the TTO shall commit to implementing all initiatives deemed most suitable for the valorization of the Inventions and their related IP Rights, including through appropriate contractual instruments, either in the form of licenses or assignments.

7.1 Identification of third parties

In compliance with current regulations, the IUSS School shall give the widest possible public notice, also through its institutional website and any specialized portals, to its portfolio of industrial property rights that it intends to assign or license, in order to identify any potential assignees or licensees. Thirty (30) days after the publication of the expression of interest on the institutional website, the IUSS School shall evaluate any offers received and, if no offers have been submitted, may initiate and conduct direct negotiation procedures.

For the same purposes of valorizing its portfolio of industrial property rights and identifying potential assignees or licensees, the IUSS School may also make use of the public research valorization networks to which it belongs and the tools made available by them. The Inventors shall participate, in coordination with the TTO, in the drafting of marketing sheets or other promotional materials useful for valorization activities.

Upon request of the TTO, the JoTTO Commission may issue an opinion on negotiating acts aimed at the valorization and economic exploitation of IP Rights owned by the IUSS School, with final approval entrusted to the governing body of the IUSS School.

7.2 Grant of licenses

The IUSS School may transfer IP Rights to external parties, preferably through licenses, either exclusive or non-exclusive depending on the field of application of the Inventions. Licenses shall be structured so as to potentially ensure the highest economic return for the IUSS School and the Inventors, in accordance with Article 8, while at the same time ensuring the freedom to use the results and Inventions for research and teaching purposes in the academic context.

7.3 Assignment of rights

In specific circumstances, the IUSS School may decide to assign IP Rights to external parties, following the receipt of a positive opinion from the CTT IUSS and, where required, from the JoTTO Commission. Assignments shall comply with national regulations and ensure an adequate economic compensation for the School and the Inventors, in accordance with Article 8 of these School's IP Guidelines.

7.4 Transfer of rights to commissioning entities

Inventions generated within the framework of commissioned research activities are jointly owned in equal shares, by the IUSS School and the commissioning entity, unless otherwise agreed based on significantly different inventive contributions. In compliance with the MIMIT-MUR Guidelines, the commissioned research contract may provide for the exercise of an exclusive transfer option in favor of the commissioning entity for the share of IP Rights owned by the IUSS School on the Inventions developed in execution of the contract. The option may be exercised within a term defined by the contract, subject to the assumption by the commissioning party of the costs of protection and safeguarding, and the recognition in favor of the IUSS School of an economic consideration to be agreed.

7.5 Support for the creation of spin-offs

The IUSS School encourages the creation of spin-off companies to valorize Inventions or Know-how, in accordance with the "Regulation on the promotion of new entrepreneurship, spin-offs and start-ups of the Scuola Universitaria Superiore IUSS Pavia." Inventors who intend to establish a start-up or spin-off must notify the TTO, which will provide technical and legal support during the start-up phase. The Inventions and Know-how used by the spin-offs may be subject to specific license or assignment agreements by the IUSS School.

8. Distribution of proceeds

8.1 Method of Allocation

Proceeds deriving from the activities of valorization of IP Rights, that is, arising from the execution of licenses and/or assignments referred to in Article 7, shall be distributed as follows:

- 70% to the Inventors (in equal parts or according to the percentage of inventive contribution declared by each Inventor at the time of the Disclosure referred to in Article 3.1);
- 30% to the IUSS School, distributed as follows:
 - 15% to the Class(es) of affiliation of the Inventor, to support research and third mission activities;
 - 15% to the fund to support the protection and valorization activities of industrial and intellectual property of the IUSS School.

8.2 Expense charges

The aforementioned percentages are understood net of any charges borne by the IUSS School and any expenses incurred, including patent costs and legal fees, for the protection, management, and valorization of Inventions and the related IP Rights.

9. Confidentiality obligations

Inventors and all persons involved in technology transfer activities must ensure the strictest confidentiality regarding all data and information relating to Inventions until the completion of the protection procedures. Any publication or disclosure concerning data and/or results that have been Disclosed and/or that constitute Know-how must be previously authorized by the TTO to prevent any prejudice to a potential patent application.

Upon request of IUSS personnel, structured and unstructured, the TTO provides consultancy on the drafting and review of confidentiality agreements in all interactions with parties external to the IUSS School, including those occurring prior to the start of research activities, where the disclosure of Know-how or any other knowledge

owned by the IUSS School is involved.