



Agreement between the University of Oslo and employee at the University of Oslo regarding acquisition of rights to work results

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This agreement (the "**Agreement**") was entered into between:

- (1) **The University of Oslo** ("UiO") and
- (2) **Employee at the University of Oslo**, [Name and personal identification number - 11 numbers] (the "**Employee**").

Background and purpose of the Agreement

On 16 November 2004, the University Board adopted a policy for the management of intellectual property rights at the University of Oslo. The policy deals with, amongst other things, management of rights to work results which have commercial potential, i.e. that may be exploited in business. The background to this is that arranging for social exploitation constitutes a part of the University's social responsibilities pursuant to Section 2 Subsection 4 of the Act relating to Universities and Colleges. In order to achieve this goal, UiO has formed the company inven2, which will be managing the University's rights to research results that are suitable for commercialisation. Inven2's responsibilities include assisting UiO in acquiring rights from Employees, and inven2 is authorised by UiO to receive statements and make such declarations as mentioned in this Agreement.

The purpose of this Agreement is to regulate the transfer of rights to work results that are comprised by the Act respecting the right to employees' inventions of 17 April 1970 no. 21, the Copyright Act of 12 May 1961 no. 2 and the Act relating to the protection of layout-designs for integrated circuits of 15 June 1990 no. 27, as well as other work results that are comprised by UiO's rights policy. Moreover, the Agreement shall secure the Employee reasonable remuneration for the transfer of the rights.

1 Main rules

UiO is entitled to the right to work results that are produced by the Employee, and the Employee is entitled to remuneration from UiO in accordance with the provisions of this Agreement. The meaning of work results is defined in Clause 5.1.

The Agreement shall only apply to work results that are related to the Employee's employment at UiO.

If a work result has been produced through co-operation between several people, this Agreement shall apply to the Employee's share of the work result.

2 Employees with several employers

In relation to Employees with several employers, this Agreement shall apply so far as it does not conflict with:

- (i) separate project agreements entered into between UiO and the Employee, or between UiO and an institution/company where the Employee is employed,
- (ii) framework agreement entered into between UiO and an institution/company where the



Employee is employed, _

- (iii) the Employee's employment contract with another employer, provided that UiO has been informed of, and accepted the content of, such agreement.

If the Employee has another main employer, this Agreement shall only apply to:

- (iv) work results that have fully or partly been produced in connection with work for UiO,
- (v) work results that have been produced in connection with research or co-operation projects in which UiO is a participant.

Even if UiO is the main employer, the agreement shall not apply to:

- (vi) work results which entirely have been produced in connection with the Employee's ancillary occupation or self-employment as long as the production of such results has taken place outside the Employee's working hours and without use of UiO's resources, and provided that the Employee has reported such work or assignment to UiO in a prescribed manner.

3 The impact of applicable laws

This Agreement is subject to those rights which are mandatory according to law, see Section 3 of the Copyright Act regarding the author's moral rights and Section 7, Subsection 1 of the Act respecting the right to employees' inventions (the employee's right to reasonable compensation), Section 9 (right of disposal regarding an invention which is made later than one year after expiry of the service) and Section 10 (right to revision of stipulated remuneration). The Act respecting the right to employees' inventions and other legislation shall supplement the Agreement where the Agreement does not stipulate anything other than that which follows from the law.

4 Obligations pursuant to other agreements

If UiO, directly or through one of its units, has entered into agreements with third parties concerning research co-operation or research financing, including contribution or commissioned research, the Employee shall comply with the provisions agreed upon in those agreements regarding rights to work results, and support UiO in ensuring that it may fulfil its obligations to third parties. UiO is, directly or through one of its units, responsible for informing the Employee in writing about relevant provisions.

5 Obligation to notify

5.1 The extent of the notification obligation

The Employee shall, without undue delay, notify UiO (represented by inven2) when he or she, alone or in co-operation with others, has produced a work result (hereinafter called "work results") which falls under one of the following categories:



- (i) Patentable and non-patentable inventions,
- (ii) Other technology which has potential for commercial exploitation, e.g. practical solutions, technical principles and know-how, scientific and commercial information and business concepts.
- (iii) Databases and "catalogues" which are protected pursuant to Section 43 of the Copyright Act, including any related documentation, and which have a potential for commercial exploitation,
- (iv) Computer programmes and any related documentation and source code which have a potential for commercial exploitation,
- (v) Varieties of plants which are protected pursuant to the Act relating to the plant breeder's right of 12 March 1993 no. 32, and which have a potential for commercial exploitation,
- (vi) Integrated circuit designs which are protected by the Act relating to the protection of layout- designs for integrated circuits of 15 June 1990, and which have a potential for commercial exploitation,
- (vii) Physical objects made from organic, inorganic or biological material, including substances, organisms and crops, as well as materials resulting from UiO's investments which have a potential for commercial exploitation. UiO's investments include amongst other things use of the University's resources and objects that have been created through activities at the UiO.

If the Employee is in doubt as to whether a work result has potential for commercial exploitation, he or she shall submit the issue to UiO (represented by inven2).

Publishing through a publisher is not regarded as commercial exploitation for the purposes of the above-mentioned provisions.

5.2 What the notification must contain

The notification shall be submitted by means of a particular form that may be obtained at www.inven2.com, and shall include all the information requested. UiO (represented by inven2) may request further information if this is necessary in order to consider whether a work result has potential for commercial exploitation.

5.3 Failure to notify

If the Employee fails to comply with his obligation to notify UiO (represented by inven2) of his work result and instead exploits the work result himself or through others, UiO shall be entitled to 2/3 of the net earnings that are directly or indirectly created through commercial exploitation of the work result.

5.4 Postponed accessibility

Inventions can only be patented if a patent application has been filed before the invention is made accessible to others. Thus, subject to the publication right (cf. Clause 8.1, third paragraph)



the Employee agrees to refrain from making the invention accessible to others, orally or in writing, until after UiO (represented by inven2) has made a decision as to whether the rights shall be acquired, and -if the invention is in fact taken over- until a patent application has been filed (cf. Clause 7 below). Manuscripts may be offered for publication before a patent application has been filed if this has been approved in advance by UiO (represented by inven2). Once the patent application has been filed, the Employee is free to disclose the invention to the public, e.g. in a lecture or as part of a scientific publication. More detailed provisions are set out in Clause 8 below.

6 UiO's rights to work results

6.1 Main rule

UiO is entitled to acquire all rights (rights of ownership) to the work results mentioned in Clause 5.1. With regard to work results that fall within the Copyright Act, it is emphasized that the transfer of rights also includes the right to alter the work and the right to further assign the rights, cf. Section 39 b. For such work results it is further emphasized that UiO's rights include exploitation through use of relevant current or future technology and in current and future relevant media. The rights shall be acquired by means of a timely statement made in accordance with Clause 7 below. The rights are deemed to have been transferred to UiO when such a statement has been made.

6.2 Research

The acquisition of rights does not limit the Employee's or others' rights pursuant to the Patent Act and the Copyright Act to use the work results in further research.

7 Statement regarding acquisition and subsequent assistance

If UiO intends to acquire the rights to work results according to Clause 6.1 above, a written acquisition statement must be provided by UiO (represented by inven2) within 4 (four) months of receipt of a notification pursuant to Clause 5.2. If UiO (represented by inven2) has requested further information which is necessary in order to assess whether the work result has potential for commercial exploitation, the time limit shall be calculated from the point in time when such information was given to UiO (represented by inven2).

Unless otherwise stated in the acquisition statement, the transfer of rights covers all rights mentioned in Clause 6.1.

If UiO has acquired a work result, the Employee shall – if so requested by UiO (represented by inven2) – confirm the transfer in writing and provide assistance as far as may be reasonable in connection with patenting and commercial exploitation. If such assistance exceeds what is reasonable to expect within the Employee's employment at UiO, a separate agreement shall be entered into regarding remuneration in respect of the assistance provided by the Employee.



8 Disclosure of the work results etc.

8.1 During the 4-month period referred to in Clause 7

Prior to the expiry of 4 (four) months from the time UiO (represented by inven2) received the notification in accordance with Clause 5 above, the Employee shall not make an invention accessible to others without UiO's written consent. The same applies to other work results where the confidentiality of such work result is a prerequisite for its commercial exploitation or where such confidentiality has been agreed upon with a third party.

UiO (represented by) shall aspire to make the period during which the invention or other work results cannot be made accessible to others as short as possible. UiO (represented by inven2) shall also, to the extent possible, aim to notify the Employee as to whether UiO (represented by inven2) will acquire the rights to the work results prior to the expiry of 4-month period referred to in Clause 7 above.

Teachers and members of the scientific staff at UiO are nevertheless entitled to publish the invention or other work results if UiO (represented by inven2) was notified of this in the notification regarding the invention in accordance with Clause 5, and provided that there are no rights of third parties that prevent this. This may for example include confidentiality agreements. If the above-mentioned conditions for publication are fulfilled, UiO is not entitled to acquire the invention or any other work result in accordance with Clause 6. However, if the Employee has not taken steps towards publication within one year of submission of the notification in accordance with Clause 5.1, UiO may still acquire the invention or other work result.

An Employee, who has reserved the right to publish an invention, cannot apply for a patent for the invention without UiO's (represented by inven2) written consent.

8.2 Duty of confidentiality after UiO has acquired the rights

The Employee shall not make the invention accessible to others until a patent application has been filed. If needed, UiO, represented by inven2, may demand that the invention is kept secret for a limited period after the patent application has been filed if this is necessary in order to achieve satisfactory protection pursuant to patent laws. UiO, represented by inven2, shall aspire to make the period during which the invention must be kept secret, as short as possible.

8.3 Right to apply for a patent during the 4-month period pursuant to Section 6

The Employee may, with UiO's (represented by inven2) consent, apply for a patent for the invention during the 4-month period in accordance with Clause 7 if this is necessary to secure priority in relation to other applications.

8.4 Other actions that might limit UiO's right to work results

Before 4 (four) months have passed from the time UiO (represented by inven2) received the notification in accordance with Clause 5, the Employee shall not – without UiO's (represented by inven2) written consent – carry out any other actions that might reduce the possibility for commercial exploitation, such as entering into agreements with others for the exploitation of work results. Clause 8.1, second paragraph, shall apply accordingly.



8.5 Disclosure to the public and exploitation if UiO does not acquire the rights to the work results

If UiO does not acquire the rights to the work results within the expiration of the 4-month period referred to in Clause 7 above, the Employee is free to disclose to the public and otherwise dispose of the work results to the extent that this does not conflict with any obligations towards third parties or with the Employee's other obligations towards UiO as the employer. In such cases, UiO shall be entitled to 15 % of those net earnings which are directly or indirectly created through commercial exploitation of the work results.

8.6 Special regulations for computer programmes – "open source code"

An Employee who has produced a computer programme may demand that it shall only be licensed as "open source code", i.e. that the source code shall be openly available and that any modifications of the computer programme that are distributed to others, shall also be openly available. If the computer programme includes an invention, the Employee is nevertheless obliged to keep the source code secret in accordance with the rules in Clauses 8.1 and 8.2 above. The Employee cannot demand that the licensing shall take place as "open source code" if this will conflict with the rights of third parties.

9 Remuneration

9.1 The Employee's right to reasonable remuneration when UiO acquires the rights

The Employee is entitled to reasonable remuneration which will be determined in accordance with the "Guidelines for Distribution of Net Earnings from Research-based Innovation at the University of Oslo" ("Retningslinjer for fordeling av nettoinntekter fra forskningsbasert nyskaping ved Universitetet i Oslo"), which is attached to this agreement as [Appendix 1](#).

9.2 Access to the basis on which remuneration is calculated

The Employee has a right of access to the basis on which the remuneration has been calculated. Access shall take place at inven2.

9.3 Distribution of remuneration in relation to work results that have been produced through co-operation

If a work result has been produced by several people, and the work result has fully or partly been acquired by UiO, those who have produced the work result shall reach agreement on how the remuneration shall be apportioned between them, and report this to UiO (represented by inven2). If no such agreement is reached, UiO may deposit the remuneration with Norges Bank pursuant to the provisions of the Act relating to the right to deposit an item of debt of 17 February 1939 no. 2, until agreement has been reached on the apportionment.



10 Reassignment of rights back to the employee

UiO may reassign rights that it has acquired back to the Employee. After such reassignment the Employee is free to exploit the work results itself or through others, to the extent that this does not conflict with obligations towards third parties or other obligations towards UiO as the employer. In such cases, UiO shall be entitled to 15 % of those net earnings that are directly or indirectly created through commercial exploitation of the work results.

11 Choice of law and dispute resolution

11.1 Choice of law

This agreement shall be governed by Norwegian law.

11.2 Dispute resolution

The parties shall seek to resolve any disputes between them through negotiation. If the parties do not reach agreement, each of the parties may bring disputes regarding inventions before the Conciliation Board for Employees' inventions ("Meklingsnemda"). The parties may agree that this Board shall function as a court of arbitration pursuant to Section 13 of the Act respecting the right to employees' inventions.

If the dispute is not resolved in accordance with the above, the provisions of the Civil Procedure Act will apply.

11.3 Interpretation

The provisions in this translated Agreement express and describe Norwegian legal concepts in English and not in their original Norwegian terms; consequently, words, terms and expressions used in this Agreement shall be construed and interpreted in accordance with the laws of Norway. In the event of any conflict between the provisions of this translated Agreement and the terms of the original Norwegian version of this Agreement, the Norwegian version shall prevail.

* * *

This agreement has been executed in two -2- copies, whereof the parties have retained one copy each.

The Employee

Oslo,

The University of Oslo

Oslo,



Appendix 1: Guidelines for Distribution of Net Earnings from Research-based Innovation at the University of Oslo

These guidelines replace the "Guidelines for remuneration for inventor and university" ("Retningslinjer for godtgjøring til oppfinner og universitet") adopted by the Collegium on 3 December 2002.

Area of application

These guidelines shall apply to those inventions which the University of Oslo, or another unit authorized by the University, acquires pursuant to "the Act respecting the right to employees' inventions", as well as other projects with commercial potential where the University of Oslo, represented by inven2, acquires the right to commercial exploitation.

All employees at the University of Oslo shall be granted the same remuneration and incentive for inventions, i.e. both scientific and technical/administrative staff are entitled to the same share of the net earnings. The remuneration rules do not apply to individuals who have entered into an agreement regarding commissioned research etc. with the University of Oslo.

Instructions

- (i) After inven2's external invoiced costs for commercialisation have been deducted, the net earnings shall be apportioned with one third to the inventor/employee and two thirds to the University of Oslo.

Out of the University of Oslo's share, a defined share in the form of research allocations through the lowest administrative level (base unit) above the inventor, shall normally be granted to the research community where the inventor/Employee works. Out of the first NOK 10 million in net accumulated earnings, 25 % shall be reserved for such research allocations. In respect of earnings exceeding NOK 10 million, 10 % shall be reserved for research allocations up to a total sum of NOK 50 million. The relevant faculty or base unit shall be granted an 8 % share of the net earnings for coverage of its own innovation work.

Earnings for inventors/employees and research allocations are disbursed consecutively during the annual settlement in the form of money. If licensing is paid for with shares in the company that is licensee, the disbursement may take place after the shares in the company have been sold (exit). Alternatively, the University of Oslo may decide that the inventors shall be remunerated by means of shares.

Inven2 manages the University of Oslo's funds by investing in and operating its own innovation projects and/or through other investments (fund management) by using profits. Allocations can also be made for the purposes of establishing an innovation fund at the University of Oslo by agreement with the owner.



- (ii) If income is accumulated on projects in which the University of Oslo has rights, but where it has not demanded that the right to the invention be transferred to itself and/or where it transfers the right of exploitation back to the inventor – and the inventor exploits the invention for commercial purposes, 15 % of the net earnings accrues to the University of Oslo.
- (iii) If the inventor/employee neglects his or her duty to notify UiO, represented by inven2, of work results, and instead exploits the work results himself or through others, UiO shall be entitled to 2/3 of the net earnings that directly or indirectly are created through commercial exploitation of the work result.
- (iv) An invention or other research result with commercial potential may form the basis for the formation of a company. In the case of a formation of a company based on the technology of a commercialisation project, the price of the technology shall be negotiated in shares and weighed against other investments in the company, inven2's efforts (in this instance shares will replace overhead), the commercialisation companies' efforts, entrepreneurs' efforts after creation of the invention etc. inven2 shall negotiate with the inventors on behalf of the University of Oslo.

The allocation of shares shall be determined by the pricing of the different elements during the negotiations. The shares which represent payment for the transfer of the invention/technology itself, shall be apportioned according to the same principles that apply for cash. The shares shall be transferred to the researcher/employee directly. Inven2 manages, and possibly owns where this is desirable, all the shares owned by the University of Oslo (two thirds) up to exit, after which the base unit shall be awarded its earnings.