

The Ministry of Enterprises and Made in Italy, in conjunction with the Ministry of University and Research, has approved the interministerial Guidelines in which the principles and criteria for regulating contractual relationships between Universities and third-party research funders are defined (Amendments to Art. 65 of the Industrial Property Code and Guidelines MIMIT-MUR).

The interministerial Guidelines elaborate on what the legislator indicated in the reformed Art. 65 of the Industrial Property Code, namely that the ownership of results belongs to the entity to which the subject who actively contributed to the development of the innovative result belongs.

In particular, three main contractual types are identified in the Guidelines, to which, in practice, commissioned research contracts can be attributed:

Contract involving service activities; Contract involving development activities; Contract involving innovative research activities. Although in all the above cases there is formally a contractual relationship of commission, the intensity of research activity varies and with it also vary both the needs for previous knowledge of the parties (so-called Background) and the prediction of new knowledge (so-called Foreground), eventually protectable through industrial property rights.

In summary and generally, depending on the contractual type, the ownership of industrial property rights over the results will be determined as follows:

TYPE OF COMMISSIONED RESEARCH CONTRACT	CONTRACT OBJECT	EXPECTED RESULT	OWNERSHIP OF INDUSTRIAL PROPERTY RIGHTS
a) for service activities	A standard activity, using consolidated and routine technical skills or capabilities, such as the execution of analyses, synthesis, tests, measurements, characterizations, investigations that do not involve specifically original and inventive contributions from the university researcher (e.g., routine analysis even if complex of a product or for which instrumentation not provided to the	Expected results consist of scientific data and reports. A result that meets the requirements for patent protection is usually, in these cases, an unusual result.	Exclusive ownership by the funding entity

	funding entity is required), or the preparation of known/standard products, or data collection.		
b) for development activities	This contractual type generally involves applied research on optimization or selection projects of products/processes or applications already in development at the funding entity, which normally has previous proprietary knowledge and sometimes also already protected by proprietary forms.	The generation of new industrial property represents a possible outcome of research activities and is generally related to the pre-existing innovation of the funding entity and in some cases constitutes an autonomous finding.	Joint ownership of results between the University and the funding entity, or - alternatively - Exclusive ownership by the University.
c) for innovative research activities	The subject of the relationship generally consists of projects with a marked propensity for innovation, such as research leading to the solution of a technical problem or a new product or new use of a product/application of the funding entity. The University's innovation contribution is particularly relevant because, while funding and applicative guidance are provided by the funding entity, the resulting solution fully derives from the knowledge and inventive capacity of	The generation of new industrial property is usually a contemplated outcome of the contractual program and represents a very likely and expected outcome of research activities.	Exclusive ownership by the University, or - alternatively - Joint ownership of results between the University and the funding entity

	the researcher or research group assigned to the research activities.		
--	---	--	--

The Guidelines also highlight the need to conclude the contract between the parties before the start of the research activity, in order to define all aspects of the relationship from the outset:

- a) indication of the parties;
- b) clear explanation of the purposes of the commissioned research;
- c) definition of key words or expressions used within the contract;
- d) clear and detailed indication of the subject and nature of the commissioned research;
- e) regime of previous knowledge of the parties (so-called background);
- f) regime of knowledge expected from commissioned research (so-called foreground); g) dissemination of results;
- h) indication of the responsible parties for each of the parties' implementation of the commissioned research/profile of the subjects currently or potentially involved in research activities; i) definition of economic aspects; j) definition of result ownership;
- k) confidentiality regime/confidentiality protection/discipline of obligations and communication modalities of research activity results;
- l) publication discipline;
- m) indication of duration;
- n) rules for termination and resolution.

Furthermore, with the aim of promoting the exploitation of results protected by the funding entity, the same contracts will define the modalities of transfer/licensing to the funding entity of the rights for commercial use of the University's ownership share, according to indications that will be provided by the University Bodies.

It is noted that, as confirmed by the same experts who worked on the drafting of the Guidelines, the term "collaboration" is improperly used in them: the contents of the Guidelines refer only to commissioned research.

That being said, pending the issuance of the new University Regulation, accompanied by the respective internal guidelines, which will provide practical implementation tools, the University Intellectual Property Commission and the ILO Office, Third Mission, and Incubator will offer maximum support in the review of commissioned research contracts and, more generally, of documents (contracts for collaborative research, NDA, MTA, etc.) containing clauses related to the management of industrial property rights and confidentiality - which are closely linked to disclosure rules - in order to fully and adequately implement the new legislative provisions.

It is noted that only support requests submitted by Department/Center Secretariats to the address ufficio.ilo@unipg.it will be examined. Requests made by individual researchers will not be evaluated.

Attached are the MIMIT-MUR Guidelines and a brief presentation of the reform.

[GUIDELINES: "Amendments to the Industrial Property Code, as per Legislative Decree February 10, 2005, no.30"](#)

[The reform of Art. 65 of the Industrial Property Code](#)

[Management of industrial property rights in the context of contractual acts with third parties: initial operational indications](#)