

3.12: Model Contractual Clauses for Requesting Permission from Staff

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Context

These contractual clauses can be used to cover work produced by staff. We recommend that these clauses are incorporated into standard contracts of employment. Please customise the highlighted sections.

This resource should be adapted to suit specific requirements. It is based upon resources produced from the HEFCE-produced 'Good practice guidance for senior managers: Intellectual property rights in e-learning programmes'¹ and reused within the JISC-funded Web2Rights project (www.web2rights.org.uk).

It should be used in consultation with the following resources contained within this toolkit:

- 3.1 Getting Permissions Paper
- 3.2 IPR Risk Assessments

Model contractual clauses of employment for members of staff

Definitions

1. 'Materials' means any materials, text, image, audio and visually based, created within the institution or created on behalf of the institution by members of staff.
2. 'IPR' means patents, Trade Marks, trade names, design rights, copyright, confidential information, rights in know-how and other Intellectual Property Rights, in each case whether registered or unregistered and including applications for the grant of any of the foregoing and all rights or forms of protection having equivalent or similar effect to any of the foregoing which shall subsist anywhere in the world.
3. 'Member of staff' means academic staff, research associates, technicians, or any other members of staff of the institution who are employed under a contract of employment (whether fixed term or permanent).

Primary obligation

4. The parties foresee that the member of staff may make or discover or create intellectual property in the course of his or her duties under this agreement and agree that in this respect the member of staff has a special duty to further the interests of the institution.

Title to rights

5. Subject to the provisions of the Patents Act 1977, the Registered Designs Act 1949 and the Copyright, Designs and Patents Act 1988, all IPR in the materials originated by the member of staff and arising out of the performance of his/her duties under this agreement shall be the property of the institution, and the member of staff undertakes to do all acts and things as may be thought by the institution to be necessary to vest any such property in the institution and to register title in such property in the institution.
6. In the event that the member of staff fails (for whatever reason) within 30 days of a demand by the institution to do all acts and things effectively to vest any such property in the institution, the member of staff hereby authorises the institution in his/her name and on his/her behalf to execute all such deeds or documents as may be necessary or desirable to transfer such property in the materials to the institution and register title in the materials in the institution.
7. If material from other copyright works is included in the materials, the member of staff shall identify such material to the institution and shall obtain all necessary written permissions from the owners or from any rights organisation authorised by the owner to grant such permissions in respect of such material. Alternatively, the member of staff shall, if the institution so agrees, provide the institution with sufficient information to enable the institution to obtain such permissions, but the institution shall not thereby be obliged to secure such permissions and may require that the member of staff omit any such material from the materials.
8. The institution hereby agrees and acknowledges that all performers' rights in any video or other recording of the member of staff's own lectures or presentations or similar works are owned by the member of staff. The member of staff grants to the institution and its authorised users an irrevocable royalty-free non-exclusive licence to use such material for administrative, educational, teaching and research purposes.
9. Nothing in this agreement shall constitute a waiver by the member of staff of any moral right under the Copyright, Designs and Patents Act 1988, and nothing therein shall constitute an exclusive recording contract within the meaning of Part II of that Act or consent by the member of staff to the exploitation of any qualifying performance for the purposes of that Part.

Exploitation and income

10. The institution is free to exploit (whether for financial gain or not) such materials as it sees fit, including licensing or assigning the IPR in the materials to third parties, or merging said materials with other materials created within the institution or elsewhere.

11. In the event that the institution fails to exploit the materials within a period of **[to be inserted]**, the member of staff or his/her representative may give notice thereof to the institution, and in such event the institution shall declare within thirty (30) days in writing whether or not it intends to exploit the materials in the foreseeable future. The institution agrees it will enter into good faith negotiations with the member of staff with a view to assigning its rights in the materials to the member of staff if no prospect of commercial exploitation of materials is to be expected. In return, the member of staff shall grant the institution and its authorised users an irrevocable royalty-free licence to use such material for administrative, educational, teaching and research purposes.
12. Should the materials prove to be profitable, the institution agrees that it shall, in accordance with its normal procedures, enter into good faith negotiations with the member of staff regarding possible rewards.

Credits

13. The institution agrees to credit the member of staff for any significant contribution to the materials. The institution shall comply with any request by the member of staff in writing that his/her name be removed from the materials where such request is on grounds that the whole or parts of the materials are out of date or changed in a manner that might damage his/her reputation.
14. The institution may update or in any other way amend the materials to suit its requirements. The institution agrees to consult the member of staff over any significant amendments without any obligation to be bound by the same in deciding on the final form or content of such amendments.

Permitted uses

15. The institution grants to the member of staff a royalty-free non-exclusive licence to use the materials created by the member of staff or jointly with others for non-commercial teaching or research purposes only for as long as the member of staff remains employed by the institution. Such licence may continue after the termination of this agreement provided that the use of the materials does not damage the exploitation of the materials by the institution or prejudice in any way the interests of the institution.
16. Should the contract of employment of the member of staff terminate, the member of staff shall be entitled to enter into negotiations with the institution with a view to permitting the member of staff to make and retain a copy of the materials for his/her use for non-commercial teaching and research purposes. In the case of disagreement over these negotiations, dispute settlement procedures in accordance with Clause 20 of this agreement shall be invoked. Neither the member of staff nor his/her new employer is permitted to commercially exploit the materials without the express permission of the institution.
17. Nothing herein shall grant to the member of staff any right or licence to copy or use any versions of the materials updated or in any way amended by the institution after termination of the employment whose terms and conditions are governed by this agreement.

Prohibited uses

18. The member of staff is not permitted to assign or enter into any licence for the exploitation of the materials. In the event that the member of staff becomes aware of any third party wishing to exploit the materials, such third party shall be advised by the member of staff to contact the institution as the owner of the IPR in the materials.

Termination

19. Save as provided herein, all rights and obligations under this agreement shall continue to be in force after the termination of the employment whose terms and conditions are governed by this agreement in respect of all IPR in the materials originated by the member of staff during the member of staff's employment under this agreement, and shall be binding on his/her representatives.

Dispute settlement

20. Any dispute between the parties arising out of or in connection with this agreement, except as otherwise provided in this agreement, shall be referred to the arbitration of a single arbitrator appointed by agreement between the parties or, failing agreement between the parties, within thirty (30) days after a request for a reference is made by either party, [eg] nominated on the application of either party by the chairman for the time being of the Bar Council.

[There might be a reversion of rights clause also inserted. Public-sector bodies and, in particular, HEIs, FEIs and schools should allow for the possibility of reversion of rights if, should the HEIs, FEIs and schools choose not to exploit the materials commercially, the individual or team that developed the materials wishes to take on the exploitation of the materials. Negotiations should be entered into in good faith and should be based on the premise that the HEIs, FEIs and schools should not unreasonably refuse the individual or the team the IPR if the HEIs, FEIs and schools have no interest in exploiting the materials. Appropriate arbitration procedures should be in place in case of disagreement. In return for the acquisition of the IPR, the member of staff should always grant his/her employer and its authorised users a royalty-free licence to use the materials for administrative, educational, teaching or research purposes. Any such clause should forbid the individual from exploiting the material in a way that the HEIs, FEIs and schools in their reasonable opinion deems to be competitive to their own activities.]

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