

# Indian Institute of Science



## **INTELLECTUAL PROPERTY POLICY AND GUIDELINES 2016**

## Table of Contents

1. OBJECTIVES.....	1
2. DEFINITIONS.....	1
3. TO WHOM IS THE IP POLICY APPLICABLE? .....	5
4. INTELLECTUAL PROPERTY (IP) OWNERSHIP.....	5
5. RESEARCH AND DEVELOPMENT (R&D): CATEGORIES OF AND OWNERSHIP OF IP .....	7
6. COPYRIGHT .....	8
7. INTELLECTUAL PROPERTY ADMINISTRATION .....	9
8. DISCLOSURE, EVALUATION, AND UTILIZATION OF INSTITUTE IP.....	9
9. COMMERCIALIZATION/ UTILIZATION OF INSTITUTE IP .....	11
10. REVENUE SHARING .....	12
11. RESEARCH & DEVELOPMENT (R&D) AGREEMENTS.....	13
12. GENERAL.....	14

## 1. OBJECTIVES

Through this official Intellectual Property (IP) Policy and Guidelines, the Indian Institute of Science (the “Institute”), intends to put in place a system that brings order to the process of protection of inventions, and the utilization of inventions through processes of technology transfer and entrepreneurship. Within the above broad objectives, the specific objectives of this IP Policy are as follows:

- 1.1. Undertake the mining, identification, and location of IP in the various research, consultancy, educational, and all other academic activities of the Institute;
- 1.2. Encourage, create awareness, and facilitate the process(es) of securing and protecting the IP rights of all Institute personnel;
- 1.3. Initiating and pursuing all actions and deeds to maintain, prosecute, and keep in vogue the secured IP rights of the Institute; and
- 1.4. Pursuing all the necessary procedures and actions to facilitate, catalyze, and bring to bear the Transfer of Technologies (ToT), including the commercialization, licensing, and other means of disseminating the technologies developed by the Institute

## 2. DEFINITIONS

- 2.1. “**Confidential Information**” means any IP, information or data that is confidential or proprietary in nature, including all oral and/or visual information, all information or data recorded in writing or in any other medium or by any other method, and all IP, information and data which the authorized recipient is under an obligation, whether contractual or otherwise, not to divulge.
- 2.2. An “**Invention**” is a novel or unique device, method, composition, or process. An invention process is a series of steps within an overall engineering and product development process. An invention may be an improvement upon an existing product, process, or service, or it may be an entirely new product, process, or service. Such works are novel, and are not obvious to others skilled in the same art or field.
- 2.3. An “**Inventor**” refers to the Institute Personnel performing the act of an Invention.
- 2.4. An “**Innovation**” is an Invention that has been implemented, or put to actual, practical use, that results in better products, processes, or services. Such Innovations result in new products, processes, or services that result in better solutions that meet new requirements, unarticulated needs, or existing market needs. The basic difference between an invention and an innovation is that the former is a laboratory creation, whereas an innovation is its actual application in the field.
- 2.5. “**Disclosure of an Invention**” refers to the Confidential Information written up, and revealed by an Inventor to the Institute, to determine whether the Intellectual Property in the said Invention should be sought and obtained by the Institute. The Institute would also ascertain what could be the scope for Technology Transfer, Commercialization, and Licensing of the said Invention.

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- 2.6. **“Intellectual Property (IP)”** refers to creations of the mind: inventions, literary and artistic works, designs and symbols, names and images used in business and commerce.
- 2.7. **“Intellectual Property Rights (IPR)”**: refer to rights of ownership and monopoly, assigned by law to, and vested in, the designated owners of the IP. Intellectual Property Rights include Patents, Copyright, Industrial Design Rights, Trademarks, Plant Variety Rights, Trade Dress, and in some Jurisdictions, Trade Secrets. There are also more specialized or derived varieties of *sui generis* exclusive rights, such as Circuit Design Rights (called Mask Work Rights in the US) and Supplementary Protection Certificates for pharmaceutical products (after expiry of a Patent protecting them) and Database Rights (in European law).
- 2.8. **“Intellectual Property (IP) Policy and Guidelines”**: The instant IP Policy and Guidelines refers to the set of principles, values, and guidelines that will govern all the actions and efforts of the Institute, towards the identification, protection, prosecution, utilization, transfer, licensing, and commercialization of all IP arising out of the R&D work of the Institute Personnel
- 2.9. **“Patent”**: A Patent is a set of exclusive rights granted by a sovereign state to an Inventor or assignee, for a limited period of time, in exchange for a detailed public disclosure of an Invention.
- 2.10. **“Copyright”**: A Copyright is a legal right, created by the law of a country, that grants the creator of an original work, exclusive rights for its use and distribution. This is usually only for a limited time.
- 2.11. **“Indian Institute of Science”** or **“Institute”** refers to an autonomous institution of higher learning and advanced research, founded in 1909, and located in Bangalore. The term Institute will be used to refer to the Indian Institute of Science, and the expression shall include its campuses in Bangalore and Challakere, and, unless repugnant, also include all its assigns, heirs, and legal representatives.
- 2.12. **“Institute Personnel”** shall mean and include all Faculty, Students, Staff, (permanent and temporary), Retired but Continuing Faculty, Consultants, Ad-hoc Appointees, and Contract Employees, engaging in higher education and advanced research at the premises of the Institute or off the premises of the Institute, working during leave or on duty from the Institute, including Research Staff, Research Associates, Post-Doctoral Researchers, Students enrolled by the Institute in various Degree Programs of the Institute, regardless of the mode of entry through which they are admitted, such as Undergraduate Admission and Graduate Admission under the M.E./M.Tech./M.Tech.(Research)/M.Mgt./MDes/ M.Sc.(Engg.)/Ph.D. programs, the Integrated PhD program, the External Registration Program (ERP), the Quality Improvement Program (QIP), as well as students at the Institute from other Universities (whether in India or abroad) studying/conducting research under exchange programs. Institute Personnel also includes visiting faculty members or scientists, adjunct faculty, industrial personnel, fellows project/research/technical assistants, summer fellows/trainees and any other personnel from outside institute engaged in research and development work at the institute independently or in collaboration with Institute Personnel. Institute Personnel whose R&D effort results in an Invention, and whose IP needs to be protected by the Institute, will be referred to in this document as Inventors.

2.13. "**Sabbatical Leave, Deputation, Lien**" A Sabbatical is a rest from work, or a break, often lasting from two months to a year. Strictly speaking, the original scriptural essence of sabbatical means it would last one year. A deputation is the official delegation, or the assignment of responsibility or authority to a person, from the Institute, to another organization, to carry out specific designated roles and activities. A lien is the official, continuing attachment of an Institute Personnel, to his or her post of substantial employment at the Institute, during designated period(s) when such person(s) have availed leave of accrued nature, to seek gainful employment in another organization. It is the responsibility of the Institute Personnel to ensure that their agreements with third parties are in keeping with their obligations to the Institute. The Office of IPTeL can provide suggested language for inclusion in such agreements with outside entities, especially during Sabbatical Leave/ Deputation/ Lien.

2.14. "**Substantial Use of Institute Resources**" means use of the Institute's experimental facilities, laboratories, computational facilities, Institute-provided or Institute-administered funds, space or human resources including their release time from regularly assigned duties during the course of their work. The routine use of Institute library/information resources does not constitute "substantial use of Institute resources".

2.15. "**Research and Development (R&D)**" refers to the set of activities associated with Institute Innovation. It is usually the front end of the Innovation lifecycle. At the Institute, there exist the following forms of R&D:

2.15.1. "**Sponsored R&D**": This is the category of R&D wherein the agenda for the research is set by the Institute Personnel (most often the Institute Faculty who generate an R&D Proposal, based on their intellectual curiosity and chosen area of interest and specialization. The Sponsor/ Funding Agency, upon scrutiny and peer review of the Proposal, decide to fund the R&D Proposal, and sanction the necessary administrative and financial approval for the same. Also, the innovation work would be done by institute personnel only. The IP in all such Sponsored R&D will be completely owned by the Institute.

2.15.2. "**Collaborative R&D**": In this category of R&D, would comprise projects that are jointly conceived, planned, and executed by the Institute Personnel, in collaboration and partnership with, the representatives, personnel, and staff of the Sponsor/ Funding Agency/ Industry/ Collaborator, including Inter-University Collaborator(s). Such projects will be characterized by substantial inventive and financial contributions from the Sponsor/ Funding Agency/ Industry/ Collaborator, including Inter-University Collaborator(s). Consequently, the Institute would be amenable to considering joint ownership of the IP, with the corresponding Sponsor/ Funding Agency/ Industry/ Collaborator, including Inter-University Collaborator(s).

2.15.3. "**Contract R&D**": Contract R&D is the kind of R&D performed by Institute Personnel, when a Sponsor/ Funding Agency/ Industry sets out a specific problem/ research agenda/ scope of work, and the Institute Personnel work on the same, in a "work for hire" mode

2.16. "**Publications**": refer to the various documents, reports, technical communications, etc. arising out of a R&D work carried out by the Institute Personnel that are generally made available to the public, by means of sale or general transfer of ownership, or by rental, lease, or lending. In contrast, unpublished works (including the academic theses of students at the Institute) are those documents, reports, technical communications, etc. that have restricted or limited circulation, and thus are not available to the general public.

2.17. **“Sponsor/ Funding Agency/ Industry”:** These terms, used interchangeably in this IP Policy document, refer to the entity that funds the R&D work that is proposed to be carried out by the Institute. In addition, in the case of Collaborative R&D work carried out by the Institute and the Industry, the latter shall also make substantial inventive contributions, in tandem with the financial contributions made by it.

2.18. **“Technology Licensing”:** refers to the process by which the owner of an IP, (in this case the Institute) assigns to the other party (the Licensee) the right to use, put in practice, and commercialize the invention or technology covered by the IP. The specific terms of Technology Licensing will usually be set out in detail in the Agreement for Technology Licensing, that will be entered into and contracted, between the Owner of the Technology/ Invention/ IP (the Licenser) and the other party seeking the license (the Licensee).

2.19. **“Commercialization”:** refers to the various activities, processes, and steps undertaken by the Licensee, under the terms of the Technology Licensing Agreement, to put the Technology/ Invention/ IP to commercial use, in terms of sale, internal use, lease, rent or assign to any other party, etc., that result in financial, commercial, economic, or any other material benefit to the Licensee. The terms of the Licensing Agreement will specify the compensation to be paid by the Licensee to the Institute (the Licenser), and such compensation would include a one-time Lump Sum Technology Transfer Fee, as well as deferred Royalty payments. In addition, the Licensee may also offer a certain equity in the proposed start-up venture to the Institute, on terms to be mutually discussed and negotiated.

2.20. **“Revenue”** refers to all the financial earnings made by the Licensee, from the rights to use the Technology/ Invention/ IP, for commercial purposes, including the sale, internal use, lease, rent, or assign to any other party, etc. that result in financial, commercial, economic, or any other material benefit to the Licensee. Where the context so admits, Revenue would also refer to the financial compensation paid by the Licensee to the Licenser, in this case, the Institute, for the rights to use the Technology/ Invention/ IP, for commercial purposes, including the sale, internal use, lease, rent, or assign to any other party, etc. that result in financial, commercial, economic, or any other material benefit to the Licensee.

2.21. **“Release of an Invention:** The Release of an Invention to the Inventor(s) to mean temporary transfer of rights to administer the protection of IP, its prosecution, and commercial licensing of the same

2.22. **“Lump Sum Technology Transfer Fee”:** is the financial compensation paid by the Licensee to the Licenser, in this case, the Institute, for the rights to use the Technology/ Invention/ IP, for commercial purposes, including the sale, internal use, lease, rent, or assign to any other party, etc. that result in financial, commercial, economic, or any other material benefit to the Licensee.

2.23. **“Royalty/ Royalties”:** A Royalty is the deferred payment made by the Licensee to the Licenser, in this case, the Institute, to compensate for the rights to use the Technology/ Invention/ IP, for commercial purposes, including the sale, internal use, lease, rent, or assign to any other party, etc. that result in financial, commercial, economic, or any other material benefit to the Licensee. The terms of the Royalty/ Royalties will usually be specified in the Technology Licensing Agreement as a certain fixed or variable percentage of the Net Sales Value, resulting from the Commercialization of the said Technology/ Invention/ IP.

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- 2.24. **“Conflict of Interest”**; This term will be used in this IP Policy document to refer to a situation in which a person or organization is involved in multiple interests, or has stake(s) in multiple roles, financial interests or otherwise, one or more of which could corrupt or cause to disrupt or interfere, with the motivation of the individual(s) or the organization(s), or one or more of which disrupt or interfere with other roles or interests.
- 2.25. **“Dispute Resolution”**: refers to one or more processes for settling outstanding problems or conflicts amongst a contract or business process. It includes mechanisms such as negotiations, conciliation, mediation, arbitration, and litigation.
- 2.26. **“Indemnity”**: Indemnity is a compensation for damages or loss. Indemnity in the legal sense may also refer to the exemption from liability to damages or loss. The concept of indemnity is based on a contractual agreement made between two parties, in which one party agrees to pay for the potential losses or damages caused by the other party.
- 2.27. **“Warranty”**: means a guarantee or promise which provides assurance by one party to the other party that the specific facts or conditions are true and will happen.
- 2.28. **“Legal Jurisdiction”**: refers to the legal power and authority of a court of law to try and rule on legal matters within an authorized geographical area.
- 2.29. **“SID/CSIC/CSSP”**: Society for Innovation and Development (SID), Society registered under the Karnataka Societies Registration Act of 1960, by the Institute to provide a window for interaction with Industry in Research and Development. Center for Scientific and Industrial Consultancy (CSIC) and Center for Sponsored Schemes and Projects(CSSP) are administrative units of the Institute dealing with Consultancy and Sponsored Research Projects, respectively.
- 2.30. **In this Policy**

Headings are inserted for guidance only, and will not affect the meaning and interpretation or limit the scope of this policy or the intent of any provision thereof.

Singular and plural: words importing the singular number shall include the plural and vice versa where the context requires.

### **3. TO WHOM IS THE IP POLICY APPLICABLE?**

- 3.1. The IP Policy of the Institute is applicable to all Institute Personnel making Substantial Use of Institute Resources.
- 3.2. When Institute Personnel work at other organizations through a formal agreement between the Institute and the organization, as set out in Clauses 2.15 and 5.3, the IP Policy of the Institute will be interpreted in reference to the relevant formal inter-institutional agreement.

### **4. INTELLECTUAL PROPERTY (IP) OWNERSHIP**

- 4.1. With the exception of rights to Copyright of works which are dealt with under Clause 6, the ownership of all IP developed by Institute Personnel in the course of or pursuant to Research and Development at the Institute, as defined more fully below, vests with the Institute. Inventors shall provide, upon request by the Institute, assignment of their rights in inventions to the Institute and/or other documents necessary for the Institute to

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perfect its ownership rights in relevant IP. The Institute shall, at the time of engaging any personnel, get relevant agreement executed by said personnel that mandates them to execute assignments such as above at relevant times as and when such IP is created/developed using the Institute's resources.

#### 4.2. **Exception and Release**

- 4.2.1. All IP developed by Institute Personnel in their own personal time and which is neither connected to R&D of the Institute nor developed with substantial use of the Institute's resources shall belong to such personal identified as inventors, provided prior written disclosure is made to the Institute.
- 4.2.2. IP Policy during Sabbatical Leave/ Deputation/ Lien of Institute Personnel; The governing aspects of the IP Policy during Sabbatical Leave/ Deputation/ Lien of the Institute Personnel will be governed by the broad terms of the Institute IP Policy, as they apply to all Institute Personnel. Such Institute Personnel should be careful that their work off-site from the Institute, including work during Sabbatical Leave/ Deputation/ Lien, while visiting other institutions and while consulting with industry, does not conflict with their obligations and commitments to the Institute. It is the responsibility of the Institute Personnel to ensure that their agreements with third parties are in keeping with their obligations to the Institute. The Office of IPTeL can provide suggested language for inclusion in such agreements with outside entities, especially during Sabbatical Leave/ Deputation/ Lien.
- 4.2.3. If the Institute cannot, or decides not to protect or commercialize any specific IP or decides not to proceed with the prosecution or maintenance of the specific IPR, the Inventors may request release of the IP/IPR. Upon determination by the Institute that releasing the IP to the Inventors will not violate the terms of an external Funding Agency Agreement and that such releasing would be in the best interests of the Institute and the public, the Institute may agree to release the Invention to the Inventor(s). As defined in this Policy, the release of the Invention to the Inventor(s) to mean temporary transfer of rights to administer the protection of IP, its prosecution, and commercial licensing of the same. However, the ownership rights shall remain with Institute. In such case, no funds received at the Institute through any of the funding mechanism can be used by inventor for prosecution and utilization of Inventions. In the event of such release, the Institute will retain the right to a non-exclusive, non-transferable, irrevocable, royalty-free, worldwide license to the Invention for research and educational purposes. In the event of an invention being released to Inventor(s), the Inventor(s) will be required to sign a separate agreement to remit to the Institute (i) all legal expenses and fees incurred by Institute in protecting the IP, and (ii) at least 30 (thirty) percent of net earnings received by the Inventor(s) through the commercialization of the said Invention. The net earnings to the Inventor(s) will be calculated after deducting the expenses incurred by the Inventor(s) towards obtaining and maintaining the IP, from the gross revenues earned by Technology Transfer, Licensing, and Commercialization of the said Invention/ IP. The Inventor(s) shall pay the legal expenses and fees incurred by the Institute at the time of release of the Invention. Later, if and when commercial gains accrue to the Inventor(s), (t)he(y) will share the same with the Institute. The process of filing and handling the IP may be carried out by a Patent Attorney chosen from a panel of attorneys approved by Institute, or else by a Patent Attorney of the choosing of the Inventor(s).

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## 5. RESEARCH AND DEVELOPMENT (R&D): CATEGORIES OF AND OWNERSHIP OF IP

The ownership of all IP developed by Institute personnel in the course of or pursuant to Research and Development at the Institute, with Substantial Utilisation of Institute Resources vests with the Institute. As an exception, joint ownership of IP with the Sponsor/ Funding Agency/ Industry will be considered under following circumstances:

- 5.1. Where R&D funding is provided by the Government of India, or a State Government in India, the IP generated will be governed as per the stipulations made by the Funding Agency at the time the funding is provided, consistent with national legislation, if any, that is applicable.
- 5.2. Where R&D funding is provided by Governments of other countries and international organizations / agencies that are covered by inter-governmental agreements (with the Government of India), the ownership of any resulting IP shall belong to the Institute or as prescribed in the inter-governmental agreements, which is generally prescribed in a non-negotiable but fair manner. Insofar as such provisions are consistent with the IP policy of the Institute, such prescriptions would be acceptable to the Institute
- 5.3. Where R&D funding is provided by Industry/ Private Agencies, following guidelines apply to ownership of IP generated, their commercial use and licensing, in recognition that the R&D work undertaken can be of one of the following categories:
  - 5.3.1. **“Sponsored R&D”:** This is the category of R&D wherein the agenda for the research is set by the Institute Personnel (most often the Institute Faculty), who generate an R&D Proposal, based on their intellectual curiosity and chosen area of interest and specialization. The Sponsor/ Funding Agency, upon scrutiny and peer review of the Proposal, decide to fund the R&D Proposal, and sanction the necessary administrative and financial approval for the same. The IP in all such Sponsored R&D will be owned by the Institute, unless otherwise indicated as provided in 5.2 above. The Industry/ Private Funding Agency/ Collaborator shall have the first right to negotiate a non-exclusive royalty-bearing license for commercial use of the instant Institute-owned IP. An exclusive or sole license may not be available to any background IP owned by the Institute, if such background IP has been generated through public funding.
  - 5.3.2. **“Collaborative R&D”:** In this category of R&D, would comprise projects that are jointly conceived, planned, and executed by the Institute Personnel, in collaboration and partnership with, the representatives, personnel, and staff of the Sponsor/ Funding Agency/ Industry/ Collaborator. Such projects will be characterized by substantial inventive and financial contributions from the Sponsor/ Funding Agency/ Industry. Consequently, the Institute would be amenable to considering joint ownership of the IP, with the corresponding Sponsor/ Funding Agency/ Industry.
    - 5.3.2.1. The Institute will consider joint ownership of IP with an Industry/ Funding Agency/ Collaborator that contributes its background IP to an Institute project, or makes intellectual contributions to the project IP through the participation of its employees in generating IP together with the Institute, provided the agency also meets a substantial part of the costs of the project. If the agency wishes to exploit such jointly owned project IP commercially, the Institute will grant the agency the first right to negotiate a royalty-bearing license from the Institute. The agency's joint ownership will, however, be limited to the field of application, as identified in the project agreement with the Institute. The Institute reserves ownership of any IP generated in the fields of application not specified in the project agreement, and will be free to exploit the IP in those other fields of application without being accountable to the collaborating agency.

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- 5.3.2.2. The Institute will consider joint ownership of IP generated in collaborations with start-ups and incubatees in which these agencies contribute their background IP or their manpower, whereas the Institute provides its own background IP, faculty expertise, and also a part of the collaborating agency's costs. If the start-up or incubatee wishes to exploit the IP generated from the collaboration commercially, the Institute will grant the agency the first right to negotiate a royalty-bearing license from the Institute. The agency's joint ownership will, however, be limited to the field of application, as identified in the agreement with the Institute. The Institute reserves ownership of any IP generated in the fields of application not specified in the agreement, and will be free to exploit the IP in other fields of application without being accountable to the collaborating agency, except not licensing to potential collaborators.
- 5.3.2.3. Research under the External Registration Program (ERP) is viewed as a collaborative research arrangement between the Institute and the employer of the registered student, and the ownership of the IP generated will be shared between the Institute and the employer organization. If the employer organization wishes to exploit such jointly owned project IP commercially, the Institute will grant the organization the first right to negotiate a royalty-bearing license from the Institute. The organization's joint ownership will, however, be limited to the field of application, as identified in the research proposal in the application for external registration. The Institute reserves ownership of any IP generated in the fields of application not specified in the research proposal, and will be free to exploit the IP in those other fields of application without being accountable to the employer organization.
- 5.3.3. **“Contract R&D”:** This form of R&D would arise when a Sponsor/ Funding Agency/ Industry/ Collaborator sets out a specific problem/ research agenda/ scope of work in the R&D. The Institute Personnel would essentially be working on the above problem/ research agenda/ scope of work, in the “work for hire” mode, and the Contract R&D Project would be completely funded by the Sponsor/ Funding Agency/ Industry/ Collaborator, to cover all direct and indirect costs, as well as all operating costs and overheads for the independent (out-sourced) execution of the Contract R&D. In such extreme and rare cases, the Institute may consider the request(s) for exclusive ownership of IP, from the Sponsor/ Funding Agency/ Industry/ Collaborator.

## 6. COPYRIGHT

- 6.1. As per accepted practices of the Indian Copyright Act, the Institute shall not claim ownership of copyright on any creative works of the Institute Personnel, including but not restricted to Books and Publications authored by Institute Personnel.
- 6.2. Provisions of Section 17 of the Indian Copyright Act, as may be applicable on case to case basis, shall be applicable.
- 6.3. The Institute's Copyright policy towards software created by its personnel may be summed up as follows.
  - 6.3.1. Whenever a software is created by Institute Personnel as part of his or her normal duties, the copyright would vest with the Institute, in accordance with Indian Copyright law.

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- 6.3.2. If an Institute Personnel creates software that is not part of his or her normal duties, does not substantially utilise Institute resources, and if the software development is done outside of the normal working hours of the Institute, the ownership of such software would remain with the Institute Personnel.
- 6.3.3. Unless the Institute has some obligation or special investment in regard to the work leading to the software that would make Institute ownership appropriate, the intent is to vest ownership in the student of any software which was created as part of the student's class work, or as part of normal extra-curricular activities.
- 6.4. Student Thesis: A student shall own the copyright of his or her thesis. The student shall grant to the Institute a royalty-free permission to reproduce, publish, and publicly distribute copies of the thesis, in any appropriate form.
- 6.5. If Thesis, Publication or Book by institute personnel contains information on any invention that the institute is entitled under this policy, the personnel shall make relevant disclosures to the institute to obtain 'no objection' before such publication is made or caused to be made.

## **7. INTELLECTUAL PROPERTY ADMINISTRATION**

- 7.1. The Intellectual Property Management Committee (IPMC), appointed by the Director of the Institute, shall oversee and guide the processing and management of the Institute's IP, including its utilization/commercialization. The IPMC is responsible for reviewing and interpreting this IP policy and for resolving any dispute that may arise in the context of IP and IP management at the Institute. The IPMC will also provide guidelines for technology transfer undertaken by the Institute and for technology licensing practices of the Institute.
- 7.2. The Office of Intellectual Property and Technology Licensing (IPTeL) is the administrative body of the Institute, reporting to the Director of the Institute and guided by the IPMC, which is responsible for the day-to-day handling of IP matters, dealing with Disclosures of Inventions submitted by the Institute Personnel, arranging for the Evaluation of Disclosures, filing and maintaining Patent and other IP applications, and negotiating Technology Transfer, Licensing, and Commercialization Agreements, Research Agreements, or any other Agreements concerning IP related matters, except as it pertains to start-ups/ faculty entrepreneurs, for which the negotiations on the Technology Transfer and Licensing would be done by SID, and for the Research Agreements by CSSP/CSIC/ SID.

## **8. DISCLOSURE, EVALUATION, AND UTILIZATION OF INSTITUTE IP**

- 8.1. If the R&D effort of an Institute Personnel results in IP, whose ownership is vested in the Institute (solely or jointly) as per Clause 5 above, the Inventor is obliged to disclose such an IP to the Institute. The Inventor(s) must promptly disclose the complete details of the IP generated or conceived, to the Office of IPTeL through the prescribed Disclosure of Invention Forms. Where an Invention results from a project funded by a Public Agency, the nature of protection of any IP shall be consistent with the conditions under which Funding Agency has financed the R&D Project.

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- 8.2. Following the submission of Disclosure of Invention Form, the Inventor(s) shall maintain the confidentiality of the IP until the process of its Evaluation has been completed and a decision has been made by the Institute regarding protection for the IP and communicated to the Inventor(s). Specifically, the Inventor(s) shall not make public disclosure of the Invention in any forum, whether in a scholarly Journal, and Conference, or in the news media, until after an application seeking protection for the IP has been filed. It is important to realize that the Disclosure of an Invention is made by the Inventor(s) in a Confidential Manner. This information must be treated with the absolute care, especially using secure means of handling the Confidential Information.
- 8.3. The Office of IPTeL shall, within one month of the submission of a Disclosure of Invention Form, evaluate for the requisite statutory protection and commercial potential of any IP submitted, either using its own resources or, more commonly, by constituting an invention-specific Evaluation Committee (IPEC) for each IP.
- 8.4. Where an IPEC is constituted for an IP, it shall be chaired by the Chairman of the Academic Division of the Institute or in his absence or unavailability, the Chairman of the respective Department to which the inventor belongs, and composed of at least two researchers of the Institute with expertise in the field of IP, and the Chairman of the Office of IPTeL. The IPEC may meet formally for such an evaluation, inviting the inventor(s) to discuss the invention in detail, or the IPEC may conduct its evaluation without a formal meeting, but holding detailed consultations with the Inventor(s) for understanding the Invention and its potential application(s). The IPEC may also consult experts in IP law and the commercialization of inventions, in confidence, to assess the potential of an invention for patentability and commercialization. The IPEC may direct the Office of IPTeL to undertake such consultations and report the recommendations of the consultants to the IPEC. The Institute may not seek protection for the IP, even though scientifically and technically meritorious if, after consultations, the IPEC believes that an IP may not be commercially attractive.
- 8.5. Based on such evaluation, which includes a closed-door meeting of the IPEC, the IPEC shall make a recommendation on whether the Institute should seek statutory protection for the IP and, if so, on the territories in which such protection is to be sought. This recommendation is to be conveyed by the Office of IPTeL promptly in writing to the inventor(s). In case the IPEC recommends seeking statutory protection for an IP, the Inventor(s) shall cooperate promptly and fully with the Office of IPTeL and the Patent Attorney chosen from a panel of attorneys approved by Institute, to prepare the application to file for protection in the jurisdictions recommended, including preparation of supporting documents, forms, affidavits, authorizations etc.
- 8.6. The Office of IPTeL shall review and evaluate the IP Portfolio of the Institute periodically, to assess the utility, and potential for Technology Transfer, Licensing, and Commercialization, or culling of the IP based on the potential and actual use and utility of the Inventions and IP owned by the Institute.
- 8.7. The expenses involved in seeking and maintaining protection for IP will be met as follows: Where an Invention has resulted from an R&D Project whose funding provides specifically for IP expenses, the Institute shall utilize such funds for seeking IP protection. Where such funds designated specifically for IP expenses are not available to the project from which the IP has been generated, the Institute shall bear the costs of IP protection, wholly or in part, depending on whether the inventor(s) are able to meet a part of the expenses through funds available to them. The extent of costs borne by the Institute will be limited to protection of IP in India only

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- 8.8. Where a student's academic thesis contains invention(s) for which statutory protection is sought by the Institute Faculty/ Student, the IPTeL, working with the office of the Deans, shall seek to delay the publication of the thesis and its contents until the IPTeL conveys to the Deans a decision made (following usual procedure) by the IPEC about seeking legal protection for invention(s) in the thesis. If the decision of the IPEC is not to seek statutory protection for the invention(s) in question, the IPTeL shall convey the same to the Dean promptly, so that the publication of the thesis may be made forthwith. If the decision is to seek protection, expedited efforts shall be made by the IPTeL to have the necessary legal steps taken. After these steps have been taken, the Office of IPTeL shall inform the Deans promptly of the same, so that a copy of the thesis is placed in the Institute Library, as is customary, making the thesis public.
- 8.9. The Institute shall, through the Office of IPTeL, secure a formal letter contract, assigning all rights of the Inventor(s) in the IP, to the Institute, on a permanent, irrevocable basis. Such an assignment would protect the Institute from any claims at a later date, when the IP rights may be licensed, transferred, or commercialized through a third party, as the case may be.

## **9. COMMERCIALIZATION/ UTILIZATION OF INSTITUTE IP**

As the sole or joint owner of any IP, the Institute is entitled to enter into binding agreement with any party for the utilization of its IP, whether on commercial terms or on non-commercial terms in the public interest, and in a manner consistent with the terms of any agreement involving the R&D project from which IP is generated read harmoniously with the terms of this policy.

- 9.1. The Institute shall be entitled to grant Licenses, whether exclusive or not, for the utilization and commercial exploitation of Institute IP, or to make such other arrangements as the Institute may deem fit to facilitate Technology Transfer, Licensing, and other means of Commercialization of Institute IP to industry or other entities, while preserving the rights and interests of the Institute and of the Inventor(s). Where Institute IP results from R&D projects funded by Public Agencies or through the resources provided by the Institute, an exclusive license may only be granted if the terms of public funding permit such a license. Any licensing of IP generated from public-funded R&D, including R&D work supported by the Institute, shall comply with applicable national legislation, if any.
- 9.2. The cooperation of Inventor(s) with the Institute and with licensees of Institute IP is usually essential for the success of efforts to utilize/commercialize IP. Therefore, Inventor(s) shall provide all assistance to the Institute both during the effort to protect IP and the later efforts to undertake Technology Transfer, Licensing, and Commercialization. The assistance and active cooperation of Inventor(s) is also required in identifying potential licensees for Institute-owned IP and in negotiations with potential licensees.
- 9.3. Where an Inventor wishes to develop and commercialize Institute IP based on his/her Invention, the Institute will generally license such IP to the Inventor, on a priority basis, as compared to their license seekers, on terms favourable to the Inventor(s), such as through taking an equity stake in the Start-up Company that such an inventor might set up. Such initiatives may be channelled through SID or other similar bodies formed by the Institute to promote such initiatives. Agreements to enable such Commercialization efforts will be formulated on a case-by-case basis.

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## 10. REVENUE SHARING

10.1. Except as otherwise provided in this policy, the following scale would apply to apportion, among the Inventor(s) and the Institute, any Technology Transfer Fees, Lump sum payments, and Royalty(ies) received through the Technology Transfer, Licensing, and Commercialization efforts of the Institute-owned IP.

10.1.1. For all Revenues (Technology Transfer Fees plus Lump sum payments plus Royalties) Up to Rs. 50 Lakhs: 60/40: 60% in favour of the Inventor(s) and 40% to the Institute

10.1.2. For all Revenues in excess of Rs. 50 Lakhs: For the first Rs. 50 lakhs Rs. 30 Lakhs to the Inventors

For any amounts in excess of 50 Lakhs: 20% of the Revenues in excess of Rs. 50 lakhs as Overheads to the Institute

Balance amount of the Revenue: 60/40: 60 % to the Inventor(s); 40% to the Institute

10.2. The Institute may at times accept equity in the Licensee Company as part of the license fee. The inventor's share in such equity granted to the Institute shall be decided on a case-by-case basis.

10.3. In the event of any inconsistency with the national legislation or government policies concerning IP revenue sharing, the respective legislation or government policies shall prevail.

10.4. Where the Institute licenses Institute-owned IP to the Inventor(s), for example, under a Student or Faculty Entrepreneurship Program, to a start-up Company, through the SID, or any other initiative within or outside Institute, the Institute may accept equity in the start-up Company as part of the License Fee. Such equity shall vest solely with the Entity created to hold such equity, with no share to the Inventor(s). The Inventor(s) shall not be entitled to any share in such equity.

10.5. Apportionment amongst Individual Inventors:

Where more than one Inventor is involved, initial responsibility for agreeing to the division of the Inventors' share of revenue amongst them shall lie with those Inventors. The revenue would be shared based on the apportionment provided by the concerned Institute Faculty or primary Inventor.

10.6. Leaving employment of the Institute

Cessation of employment either by resigning, retirement, or completion of project/course, under normal circumstances, will not affect an individual's right to receive a share of "Royalty(ies)", provided the IP/revenue was generated during the due course of their employment or association with the Institute. Such cessation shall not also absolve the Institute Personnel from their obligations towards confidentiality or the procurement/registration of IP in so far as executing necessary documents and/or assisting attorneys of the Institute towards the objectives of the Institute are concerned.

#### 10.7. Death

In the case of the death of the Inventor, any due share of the revenue will be paid to the legal representatives of the deceased.

### 11. RESEARCH & DEVELOPMENT (R&D) AGREEMENTS

- 11.1. As part of its R&D programs, the Institute enters into agreements for funding and/or collaboration with other entities, such as universities, research institutions, industry, and funding agencies, including government agencies and foundations. Such agreements include Memoranda of Understanding (MOU), Research Agreements, Non-Disclosure Agreements (NDA), Material Transfer Agreements (MTA), Material Testing Agreements (MEA), Technology Transfer Agreements, and Technology Licensing Agreements. To ensure that such Agreements are in compliance with the IP Policy of the Institute and to protect the interest of the Institute fully, the Institute has prepared templates for each of these Agreements. These templates shall be used in preparing any such Agreement, regardless of the channel of the Institute through which the agreement is routed, namely, CSSP, CSIC, SID, etc. As specific details of an Agreement may vary from case to case, the templates can be customized for a particular case, while preserving the interests of the Institute.
- 11.2. Where template agreements are provided to the Institute, as when public funding agencies and foundations are involved, the Office of IPTeL shall ensure that such templates are in compliance with the IP Policy of the Institute.
- 11.3. Where template Agreements are provided by industry, the Office of IPTeL shall ensure that the terms of the agreement are consistent with the IP Policy of the Institute, even though the preferred mode of entering into agreements with industry would always be to use templates prepared by the Institute for such engagements.
  - 11.3.1. *Agreements:* All Agreements entered into by the Institute which may involve IP, including Memoranda of Understanding (MOU), Research Agreements, Non-Disclosure Agreements (NDA), Material Transfer Agreements (MTA), Material Testing Agreements (MEA), Technology Transfer Agreements, and Technology Licensing Agreements etc., shall be consistent with the provisions of the IP Policy. The Inventor(s)/ Institute Personnel also need to disclose, at the time of submission of the Invention Disclosure Form (IDF) to the Office of IPTeL, whether (t)he(y) have signed any such Agreement(s)
  - 11.3.2. *Publications:* Research Agreements entered into by the Institute must be consistent with the primary interest of the Institute in the prompt public dissemination of its academic and research output, subject to securing statutory protection for inventions where called for.
  - 11.3.3. *Warranties:* As the research is conducted only on a reasonable efforts basis and is experimental in nature, the results or deliverables are provided "AS- IS" and without any representation or warranty of any kind, expressed or implied including warranty of merchantability or fitness for any particular purpose or any warranty that any use will not infringe or violate any patent or other proprietary rights of any other person or organization.

11.3.4. *Indemnity*: The Institute requires the contracting party to indemnify the Institute from any claim, loss, cost, expense or liability of any kind that may be incurred by the External party, due to the use of the results, deliverables or IP generated in any R&D Project, including manufacturing defects, production problems, design guarantee, up gradation and debugging obligation.

11.3.5. *Dispute Resolution*: In the event of any differing viewpoints, interpretations of the Agreements or dispute between the Institute and the other external party, efforts shall be made to settle the issue amicably and expeditiously by mutual consultation or negotiation. Should such an amicable settlement prove to be impossible, the parties may consider arbitration mechanism under the Arbitration and Reconciliation Act to resolve the differences.

11.3.6. *Signatory*: Agreements of all types (covered by this IP Policy) entered into by the Institute are considered to be valid and binding only when signed by the Registrar of the Institute or his or her representative. To ensure that the relevant Institute personnel are aware of the terms of a given Agreement, each Agreement is to be witnessed by one of the Institute personnel whose effort will be central to meeting the obligations of that Agreement.

11.3.7. *Governing Law*: As a policy, all contractual agreements entered into by the Institute shall have the jurisdiction of the Courts in Bangalore and shall be governed by appropriate laws in India.

11.3.8. *Audit of Accounts and Records*: The Institute shall retain the right to audit the accounts and records of the Licensee for any Institute licensed IP. In the event of any discrepancy in the account and records, Licensee shall pay the reasonable costs of the audit incurred by the Institute. The Licensee is required to maintain separate account and records for the Licensed IP of the Institute.

11.3.9. *Infringement*: Institute shall retain the right to engage in or desist from any litigation concerning IP and license infringements including patents, copyright, and design.

## 12. GENERAL

### 12.1. Regulatory

The Institute, through its Agents, Attorneys or Advocates, shall ensure that all its R&D conducted independently, by the Institute Personnel discussed in this IP[ Policy, is not in violation of any regulatory law or any other law operational in India. In case of Collaborative R&D discussed in this IP Policy, the Institute should ensure that the concerned Agreement which governs the Collaborative R&D clearly spells out the responsibility of obtaining necessary regulatory approvals that may be required under the law for conducting said research or later actions thereto.

### 12.2. Waiver of the IP Policy

The Institute shall have the discretion to waive or vary any or all of the provisions of this IP Policy, or any of the rules or guidelines framed there under, in a particular case. Such discretion shall lie solely with the Director of the Institute. A waiver on one occasion and for a particular case shall not be deemed to be a waiver or variation or act as a precedent for a waiver or variation of the same or any other provision on a future occasion or for a future case.

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### 12.3. Amendment of the Provision and Guidelines of the IP Policy

The Institute may amend the provisions and guidelines set out in the IP Policy from time to time. The Institute shall notify the Institute Personnel of such amendments as soon as possible. The amendments shall be in full force and effect on the date the amendments have been announced by the Institute to take effect.

### 12.4. Conflict of Interest

The inventor(s) are required to disclose any conflict of interest or potential conflict of interest. If the inventor(s) and/or their immediate family have a stake in a licensee-company, then they are required to disclose the stake they and /or their immediate family have in the company, and license or an assignment of rights for a patent to the licensee - company in such circumstances, shall be subject to the approval of the IP Management Committee.

### 12.5. Dispute Resolution

In case of any disputes between IISc and the Inventor(s) regarding the implementation of the IP policy, the inventor(s) may appeal to the Director of IISc. The Director's decision in this regard would be final and binding on both institute and inventor.

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