

## Draft IPR Rules

# **RULES FOR THE PROTECTION OF INTELLECTUAL PROPERTY RIGHTS ARISING OUT OF INVENTIONS BY EMPLOYEES AND STUDENTS OF SLIET LONGOWAL AND FOR THEIR COMMERCIAL EXPLOITATION**

These rules may be called the “Sant Longowal Institute of Engineering & Technology (SLIET), Longowal, Intellectual Property Rights (IPR) Rules”. These rules shall come into effect from the date of approval by the Board of Management (BOM), SLIET, Longowal.

The objectives of the Intellectual Property Rights (IPR) Rules are:

1. To lay down the norms to protect the legitimate interest of Inventors of SLIET and the society with respect to Intellectual Property including
  - a. Patents
  - b. Copyrights
  - c. Industrial designs
  - d. IC layout designs
  - e. New plant and microorganism variety and Biotechnology inventions
  - f. Traditional knowledge and Geographical Indications
2. To provide a transparent administrative system for the ownership, control and transfer of the intellectual property created and owned by the Institute within the framework of the relevant Indian Laws.
3. To share a global perception of practices related to intellectual property retaining national identity and local constraints, avoiding as far as possible ‘conflict’ of opposing interests.
4. To promote sustainable use of bio-resources and conservation of biodiversity.

### Definitions:

In these rules, unless the context otherwise requires:

- a) *Institute* means Sant Longowal Institute of Engineering & Technology, Longowal; hereinafter referred to as SLIET.
- b) *Director* means the Director of Sant Longowal Institute of Engineering & Technology (SLIET), Longowal.
- c) *Invention* means evolution of a know-how, design, instrument, device or process that may be original or an improvement.
- d) *Inventor* means a person or a group of persons responsible for creating an IP. At least one of the inventor will be from SLIET. In case, creation of IP is associated with more than one inventor, one of them, from SLIET, would function as a **Lead Inventor**. Inventor may be faculty/student/project staff/supporting staff /visitor.
- e) *Patent means* an exclusive right granted for an invention, which is a product or a process that provides a new way of doing something, or offers a new technical solution to a problem.
- f) *Copyright* means an exclusive right given to the author of the original literary, architectural, dramatic, musical and artistic works; cinematograph films; and sound recordings.

- g) *Industrial Design* means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device.
- h) *IC Layout Designs* means a layout of transistors and other circuitry elements and includes lead wires connecting such elements and expressed in any manner in a semiconductor integrated circuit.
- i) *New Plant Variety* means a plant variety that is novel, distinct and shows uniform and stable characteristics.
- j) *Biotechnology Inventions* include recombinant products such as vectors, nucleotide sequences, micro-organisms.
- k) *Traditional Knowledge* means the knowledge developed by the indigenous or local communities for the use of a natural resource with respect to agriculture, food, medicine etc. over a period of time and has been passed from one generation to another traditionally.
- l) *Geographical Indications* means an indication which identify such goods as agricultural goods, natural goods as originating or manufactured in the territory of a country or manufactured in the territory of a country or a region or locality in that territory where a given quality, reputation or other characteristic of such goods is essentially attributable to its geographical origin and in case where such goods are manufactured one of the activities of either the production or of processing or preparation of the goods concerned takes place in such territory, regions or locality as the case may be.
- m) *First Party* – Sant Longowal Institute of Engineering and Technology (SLIET).
- n) *Second Party*- Faculty, Supporting staff, Project staff and Students of SLIET.
- o) *Third Party*- Any governmental or non-governmental organization with whom the First or the Second Party interacts for any activity with/without exchange of consideration in cash or kind.
- p) *Activity*- Activities related to teaching, research, consultancy, generation and dissemination of information carried out by a person or an Institution independently, or collaboratively.
- q) *Visitor* means a person either from India or abroad visiting under a collaborative activity or associated work at SLIET. It is expected that the visit has been approved by competent authority of SLIET.
- r) *Work for hire*- The work (or a product) originated from SLIET and is meant for the specific purpose of SLIET and produced by (a) an author during his/her employment at SLIET or (b) non-employee under contracted work by SLIET.
- s) *Work Commissioned/Outsourced* - work commissioned by SLIET to a creator or group of creators either employed by SLIET or invited from outside SLIET with or without any consideration in cash or kind. Typical examples of SLIET commissioned works are: a. Design work, b. Artistic Work, c. Engineering/Architectural Models, d. Computer Software e. Reports based on surveys and analysis, f. Video works.
- t) *Associated Agreement* – document created with mutual consent of involved parties defining the rights, roles and responsibilities of each of the parties, for example, Memorandum of Understanding (MoU), Memorandum of Association (MoA), Research Agreement, Consultancy Agreement, Non Disclosure Agreement (NDA), etc.
- u) *Non Disclosure Agreement (NDA)/Confidentiality Agreement* -The agreement intends to protect proprietary or confidential information among the parties involved in executing a NDA.

### **Administration of IPR Policy:**

1. SLIET, through its Board of Management (referred to as BOM), will have the full power to make changes to the IPR policy or bring out a new policy as and when it is felt necessary. This can happen in view of changes in government policies or other national and international developments including treaties and legal judgements. The changes or the new policy shall be applicable to all faculty/students/project staff/ supporting staff /visitors from the date of its approval by the BOM.
2. SLIET, through its Director, will have full powers to create and amend administrative mechanism from time to time in view of the changing needs including creating administrative bodies and entrusting role and responsibilities to various individual(s)/existing entities for evolving detailed procedures and to facilitate implementation of the IPR policy of SLIET.
3. In case of any conflict, grievance regarding ownership of IP, processing of IP proposals, procedures adopted for implementation of IPR policy and interpretation of various clauses of IPR policy, any aggrieved person can appeal to the administrative body formed for the purpose to resolve the issue. In case the appellant is not satisfied with the decision of such a body, he/she can appeal to the Director of SLIET, whose decision shall be final.
4. In case of violation/infringement of any intellectual property rights such as patent infringement by the SLIET faculty /research students/project staff/ supporting staff/visitors or any third party) infringing upon the IPR of a SLIET inventor, SLIET would create an appropriate administrative body, which would first investigate the matter and make recommendations to the Director for resolution of such violation/infringement. In case of any third party infringing upon IPR of SLIET, the above administrative body would investigate and make recommendations to the Director including need for any legal course of action.

### **Administrative mechanism for policy implementation**

An IPR Standing Committee (IPR SC) will be entrusted with the responsibility of implementation of IPR policy. The Committee shall comprise of the following members

- |                                    |                          |
|------------------------------------|--------------------------|
| 1. Dean (R&C)                      | Chairperson (Ex-officio) |
| 2. Dean (Academics)                | Member (Ex-officio)      |
| 3. Registrar                       | Member (Ex-officio)      |
| 4. Faculty In-Charge (Patent Cell) | Member Secretary         |

The suggested role of IPR SC would include the following:

- a. To examine whether the transfer of the know-how be through NRDC or directly.
- b. To create expert groups in different subject domains for assessing and recommending proposals for IP filing. (Note: this assessment step can be skipped in case the costs of filing are borne by an external funding source including sponsored project or consultancy)
- c. To create and finalize procedures, forms (and guidelines) for implementation of the IPR policy at SLIET.
- d. To evolve proper procedures and guidelines for good practices for record keeping enabling efficient IP filing and protection.
- e. To create and finalize draft agreements to facilitate IP protection by SLIET.

- f. To appoint a panel of attorneys to facilitate filing of IPs by both the Institute appointed body as well by individual faculty/staff using their project or other funding.
- g. To provide guidelines for IPR related documentation including creating infrastructure for the same.
- h. To formulate programs for educating faculty/students/supporting staff/project staff/visitors about IPR and other associated issues.
- i. To approach funding agencies, venture capitalists etc. for funds for promotion of IPR activities at SLIET.
- j. To promote Tie-up with organizations for filing, licensing/assigning of IPR on revenue sharing basis.
- k. To provide waivers and release of IPR to Inventor(s) and/or Third party(ies) within the framework of IPR policy of SLIET.
- l. To evolve modalities of financing of IP related activities at SLIET.
- m. To redress any conflict, grievance regarding ownership of IP, processing of IP proposals, procedures adopted for implementation of IPR policy and interpretation of various clauses of IPR policy.
- n. To investigate the matter of violation/infringement of any intellectual property rights related to SLIET and make recommendations to the Director for resolution of such violation/infringement.
- o. To deal with any relevant issues arising out of promotion as well as implementation of IPR policy.
- p. To decide whether the Institute may consider requests for registration of Patents in foreign countries, based on the merit of the inventions.
- q. The members of the IPR SC will not disclose the know-how to any person/organisation without prior permission of the Institute.

IPR SC may appoint committee(s) or expert group(s) with members from within and/or outside SLIET to seek their opinion in carrying out any of the above responsibilities.

#### **Disclosures, Confidentiality and Assignment of Rights:**

For sponsored and/or collaborative work the provisions of the contract pertaining to disclosure of creative work are applied.

For all other invention(s) produced at SLIET, if the inventor(s) wish to protect the invention(s) they produce, then they are required to disclose the creative work to the IPR SC at the earliest date using an Invention Disclosure form (IDF). Disclosure is a critical part of the IP protection process and it formally documents claims of inventorship, the date of the invention and other details of the invention. The inventor(s) shall assign the rights of the disclosed invention to SLIET. **All SLIET personnel and non-SLIET personnel associated with any activity of SLIET shall treat all IP related information which has been disclosed to the IPR SC and/or whose rights are assigned to SLIET, or whose rights rest with SLIET personnel, as confidential.** Such confidentiality shall be maintained till the date as demanded by the relevant contract, if any, between the concerned parties unless such knowledge is in the public domain or is generally available to the public.

#### **Assessment of Innovation(s) for Protection:**

An inventor from SLIET who creates some IP in the form of know-how/designs/instruments/devices/processes and want to get protection for the IPR and / or transfer them for commercial exploitation will be required to make an application for the purpose to the Dean (R&C) through the Head of the Department /section where they are working. However, while making such an application the claims of the invention will be kept confidential. To facilitate assessment, an IP Assessment Committee (IPAC) shall be formed under the chairmanship of the Dean (R&C) consisting of the inventor(s) and at least three additional faculty members with domain expertise or familiarity/experience in areas related to the creative work. The inventor(s) would be free to suggest names of faculty who are qualified to evaluate the creative work who may be invited by the Dean (R&C) to be a part of the IPAC. The IPAC shall assess the disclosure in a timely manner and shall make recommendations to the IPR SC about the patentability of the invention. The IPAC may make one of the following recommendations:

- a) that SLIET shall take the responsibility of protection of the IP, in which case, SLIET will initiate appropriate processes.
- b) that SLIET shall not take the responsibility of protection of the IP, in which case, the rights to the disclosed invention shall be promptly reassigned to the inventor(s). The inventor(s) may then choose to protect the creative work on their own.

**All members of IPAC shall treat the technical/scientific information, which has been disclosed to the IPAC by the inventor, as strictly confidential.**

Filings of IP Applications in foreign countries: Within six months of filing the Complete IP Application in India, SLIET shall, based on available information, decide on the suitability of protection of the invention in foreign countries. If SLIET opts not to undertake such protection in any specific country requested by the inventor(s), SLIET shall assign rights of the IP in that country to the inventor(s) for the purpose of such protection.

Renewal of IP Rights: A decision on the annual renewal of IP rights will be taken by a committee constituted by the Dean (R&C). If SLIET decides not to renew the IPR in any country, then it will assign the rights of the IP in that country to the inventor(s) upon a request to that affect from the inventor(s). In case of patents, the process of reassignment will be completed in a period of three months before the due date for its renewal. In all cases where IP rights in any specific country have been reassigned to the inventor(s), SLIET shall not claim any share of proceeds earned through that IP in that country excepting for the costs already incurred by SLIET.

### **Obtaining IPR:**

If SLIET opts to protect the creative work, it shall provide an IPR Advisor/Patent Attorney for drafting the IP application as appropriate. SLIET shall pay for access to the relevant IP information databases and other associated costs. The inventor(s) shall conduct IP searches, study the prior art and provide the necessary inputs to assist in the drafting of the IP application. SLIET shall bear all costs (including patent fees, attorney fees, and other incidentals) of drafting and filing an Indian IP application. If SLIET chooses to file IP applications in other countries, then it shall bear the cost of application and other associated costs. SLIET shall be free to enter into agreements with overseas institutions for protection and licensing of the IP.

Alternatively, SLIET can approach other Govt. agencies like Patent Facilitating Centre, TIFAC, New Delhi, for managing and financing the process of obtaining and maintaining IPR.

### **Types of activities leading to generation of IP**

1. Research taken up by an Inventor faculty/student/project staff/supporting staff /visitor in the normal course of his/her appointment/engagement at SLIET with funds coming from SLIET (this would include research projects undertaken by students under the supervision of the faculty member)
2. Research taken up by an Inventor from funds coming from a sponsor such as Government of India, state governments, international agencies, or foreign governments, etc.;
3. Collaborative research undertaken with other institutions including government departments and agencies, PSUs and private companies located in India;
4. International collaborative research with institutions and companies located outside India;
5. Research supported by companies and other private organizations through research projects or consultancy assignments; and
6. Any combination(s) of the above

### **Ownership of IP:**

#### **Patent, Copyright on Software, Industrial design, IC layout design and New plant variety**

1. **Intellectual property is owned wholly or exclusively by SLIET if:**
  - a. It has been developed either solely with the use of funds / facilities provided by SLIET or with a mix of funds/facilities of SLIET and external agencies but without any formal associated agreement
  - b. It has been developed with the use of external funds / facilities, including, that of sponsored research and consultancy projects without any associated agreement.
  - c. It has been developed under any contract arrangement including “work for hire”, work commissioned and/or outsourced by SLIET.
  - d. It has been developed pursuant to a written agreement where ownership has been transferred to SLIET. Examples are work assigned to programmers, writers of SLIET publications, etc.
  - e. It is not assignable to an individual or a specific group of identifiable contributors, i.e. software or technology or process developed over a period of time with contribution from different individuals of / for SLIET.
2. **Intellectual property can be owned by Third party(ies) (exclusively or jointly with SLIET) if:**
  - a. It has been developed with external funding from Third party(ies) including sponsored research, consultancy projects and other collaborative activity(ies) with a formal associated agreement.
  - b. It has been developed without external funding from third parties under collaborative project(s) or activity(ies) with Third party(ies) with associated agreement(s).
  - c. It has been developed out of the work carried out by SLIET faculty/student/project staff/supporting staff during their visit to a Third party Institution/organization.

For sharing of IPR in case of sponsored research and consultancy projects or any other collaborative activity, the following guidelines shall be followed:

- I. If the funding agency allows SLIET to own the IP, then SLIET may share its rights with other Third party(ies) subject to their respective contribution.
  - II. In case of funds provided by an agency of Government of India, the ownership shall be decided in compliance with the ownership clauses defined by the funding agency at the time of approval of the activity(ies).
  - III. In case of funds provided by a non-government agency - the ownership may be shared between SLIET and funding agency. The sharing may take into consideration relative contributions of parties involved as well as any background IP with respective parties. Waiver of joint ownership can be considered by SLIET on recommendation(s) of the involved Inventor(s) or Lead Inventor based on the adequacy of compensation provided to SLIET.
  - IV. For a multi-country/multi-institutional collaborative project, there must be an explicit agreement defining the ownership of IP generated. Normally, IP will be shared among only those parties that contribute towards creation of IP through direct involvement of their human/other resources.
  - V. In case of collaborative activity with foreign institutions involving indigenous biological material, IP ownership has to take into account restrictions as per the prevailing 'Biological Diversity Act 2002' of India.
3. **The Intellectual property can be owned by the Inventor(s) if:**
- a. None of the situations defined above for SLIET or Third party ownership applies, and the IP is unrelated to the inventor's engagement with SLIET. For faculty and staff, the engagement implies responsibilities associated with employment. It is also expected that the person concerned would have pursued these activities outside of normal working hours of SLIET and without the utilization of the resources of SLIET.

### **Copyright other than Software**

1. **The copyright owned by the author(s):** The copyrights is owned by the authors for textbooks, research books, articles, monographs, teaching- learning resource materials and other scholarly publications unless restricted by an associated agreement. These may also include popular novels, poems, musical composition, other works of artistic imagination, etc. It is advisable to keep SLIET informed about such creations. Revenue generated, if any, from such activities must be reported to SLIET as per the prevailing rules of income from other professional activities/sources.
2. **The copyright owned by SLIET:** The copyright is owned by SLIET if the work is created under any contract
3. **The copyright reassignable to Authors:** Copyright works that are normally assignable to SLIET may be reassigned to the author on request of the author provided it does not violate any agreement with Third party and does not intervene/harm the interests of SLIET.
4. **Copyright owned by student**
  - a. Copyrights of thesis, dissertations, term papers, laboratory records, and of other documents that are produced by a student during the course of his/her study will reside with the student unless restricted by an associated agreement and/or research carried out using facilities that have come to SLIET with pre-imposed IP protection restrictions.
  - b. For claiming ownership of copyright for thesis and dissertations, the student(s) has/have to declare that the thesis does not include any information that needs IP protection by SLIET.
  - c. If any such work could not be protected before submission of the thesis, concerned inventors should take steps to protect the IP within a period of one year of

submission of thesis. SLIET would have a mechanism in place for processing such thesis in order to protect the confidential information during this period.

## **PROTECTION OF BIODIVERSITY AND TRADITIONAL KNOWLEDGE**

Inventor(s) has/have to ensure that the provisions under the national laws on biodiversity and traditional knowledge are not violated during the course of securing any IP protection or use of such knowledge.

## **WAIVER OF IP RIGHTS BY SLIET**

Subject to any associated agreement and with appropriate approval from the sponsor, SLIET may waive its rights to specified intellectual property in favour of the inventor so as to enable the inventor to seek funding or other support for the purpose of commercialization, or the Institute assessment doesn't favour IP protection. Such waiver of ownership in favour of the inventor(s) can be considered-

1. if it is established that such ownership of the inventor would be essential to enable dissemination of benefits of the invention to the society, or
2. if SLIET decides not to pursue the protection of IP within a period of six months of complete disclosure by the inventor to SLIET. The decision to pursue or not to pursue should be communicated to the inventor within a period of three months of complete disclosure by the inventor to SLIET.

In all cases, unless explicitly agreed to, SLIET shall normally retain a perpetual, royalty-free license to use the intellectual property and any corresponding IP for research and educational purposes.

### **Transfer and use of IP:**

Commercialization of IP is generally carried out via licensing or assignment. A licensing agreement is a partnership between an intellectual property rights owner (licensor) and another who is authorized to use such rights (licensee) in exchange for an agreed payment (fee or royalty) where as assignment of IP involves transfer of ownership irrevocably and permanently to the assignee by the assignor. Also, proprietary know-how generated by SLIET is a known form of IP, and its transfer and use is covered by this policy.

### **Material transfer agreement (MTA)**

In case NDA does not cover material transfer clause, an appropriate MTA such as in the case of biotechnology inventions shall be signed between the donor and the recipient of the material regarding the use of the subject material.

### **Policy related to transfer of biological resource and associated knowledge**

The Biological Diversity Act 2002 of India regulates the access to Biological resources of the country by non citizens , non residents of the country as well as a body corporate, association or organization not incorporated or registered in India. The Act prohibits such persons/entities from obtaining any biological resource occurring in India or knowledge associated there to for research or for commercial utilization or for bio-safety and bio-utilization. The Act prevents any person from transferring the results of any research for financial consideration or otherwise to such persons/entities without prior approval of the National Biodiversity authority (NBA).

### **Policy for IP licensing and assignment**



Licensing intellectual property to a third party is the most common modality for technology transfer leading towards commercialization. There are various modes of licensing strategy including the following:

- Exclusive licensing: The licensor licenses the IP only to one licensee. In other words the licensee is the only one authorized by the licensor to use and exploit the IP. Even the licensor is excluded from using and exploiting the IP.
- Sole licensing: In this case also, the licensor licenses to only one licensee. However, under this licensing, the licensor can also use and exploit the IP.
- Non-exclusive licensing: In this type of licensing, the licensor is permitted to enter into agreements with more than one entity for use and exploitation of the IP. In other words, the same IP may be used by many licensees at the same time for the same purpose or for different purposes.
- Sub-licensing: Sub-licensing is applicable when a licensee wishes to further license the IP to another party(ies).

The following guidelines are applicable to license agreement with a Third party :

1. Generally no entity shall be granted exclusive right for the development/commercialization of intellectual property owned by SLIET.
2. If an entity is granted exclusive rights with respect to a particular IP, the same should be for a limited period to obviate the possibility of misuse/no-use.
3. Sub-licensing must be specified whether it is permitted or not, and even if permitted, whether the consent of the licensor is required or not, should be clearly stated in the license agreement.
4. SLIET and its inventors should be protected and indemnified from all liability arising from development and commercialization of a particular intellectual property.
5. Wherever applicable, it should be ensured that the licensing process does not restrict the research/publication rights as well as incorporation of necessary material in the thesis of the associated student inventor(s).
6. Licencing will not place restriction(s) beyond the inventor(s) on SLIET from entering into research and development in the same area independently or with other organization(s).

The license agreement may contain such other provisions as may be determined by SLIET in the best interest of the society.

Assignment of IP by SLIET to another party may be carried out under the circumstances such as conditions by the government or its agencies, defence purposes or if the IP created distinctly accrues benefits to the society at large.

#### **Revenue sharing between SLIET and inventor:**

Protection of IP among other things is meant to provide incentive to all those associated with SLIET with a potential for pursuing research leading to marketable product or processes and as a consequence generate revenue for SLIET. Therefore, it is the policy of SLIET to share the revenue from monetization of IP among stakeholders. These stakeholders besides SLIET will include inventors, associated academic entities of SLIET and the administrative entities engaged in IP management and commercialization.

SLIET reserves the right to determine the share of the different stakeholders involved in IP creation and dissemination from time to time.

Revenue share of the inventor(s) shall continue even after their association with SLIET ends. The administering entity would evolve procedure to enable this sharing.

The income generated by licensing/assigning of IPR or on receipt of royalties associated with technology transfer / specific innovation programs shall be divided as follows:

- (a) 60% (sixty percent) of the revenue will go to the Inventor(s); the share of each inventor may be decided by the Lead Inventor.
- (b) 40% (forty per cent) shall be credited to the Institute IRDF (Industrial Research and Development Fund).
- (c) Till the Institute surrenders its interest, the "know-how" will be the joint property of the inventor and the institute.
- (d) A student will not be entitled to any share in the profits accruing from the exploitation of a patent, even if his work is a contributing factor, if such work is in partial or complete fulfilment of the prescribed requirement of a degree awarded by the Institute.

The Institute is however free to allow the student any share it considers appropriate. In case of any disputes, the Director's verdict shall be final.

(e) If the development of the know-how is not a part of the official duties of the applicant and no Institute facilities have been utilised by him for its development he may apply to the Institute for permission to transfer the know-how to outside organisations on his own.

(f) All sanctions for patents and/or transfer of technical know-how accorded by the Director, in any financial year, will be reported to the Board of Management for their information at the close of the financial year.