

INTELLECTUAL PROPERTY RIGHTS (IPR) POLICY



2019

**BIRLA INSTITUTE OF TECHNOLOGY
MESRA, RANCHI**

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1.PREAMBLE

Birla Institute of Technology, Mesra, Ranchi (hereinafter called the Institute) encourage, promote and foster innovation and discovery by its employees, staff and students in all fields of endeavour in which the institute is engaged. The Institute strives to create an environment fostering the interests of the academic community through providing resources and by obtaining external support from public and private sources.

The Institute wishes to encourage its faculty, staff, and students to develop scholarly and creative works and other intellectual property which can be used for the benefit of the Institute and the society. Innovation and creativity produce Intellectual Property (IP) in the form of patents, know-how, copyrights, designs, software's and other inventions, which can be commercially exploited either with or without registration under Patents Act/Copyright act. This would yield financial returns to the institute and partially support the R&D efforts.

As, IP's are valuable intangible assets of the institute, this policy document states the Intellectual Property Rights (IPR) policy of the institute with respect to protection, ownership, confidentiality requirement and licensing of IP that is generated with/without external funding.

2. GUIDELINES

This IPR policy is to be followed in all matters related to IPR in the Institute. IPR Cell is the nodal agency of the Institute for processing all the matters related to intellectual property (IP) generated by inventors permanently or temporarily employed at the institute or studying at the institute by using this IPR policy document as guideline. This policy may be modified time to time to suit the emergent needs.

3. OBJECTIVE

The objectives of this IPR Policy document are as follows:

- a) to promote, stimulate and encourage creative activities in the area of science and technology by ensuring timely protection and disclosure of IP and its commercialization.
- b) to establish principles and procedures for management of IP in the Institute.
- c) to ensure uniformity in IP related activities throughout the Institute.
- d) to protect the legitimate interests of inventors (permanent/temporary employees, scholars, and students) funding organisations and collaborators, if any, to avoid conflict of interest.

4. ROLE OF IPR CELL IN IP PROTECTION

The IPR Cell of the Institute aims to provide guidance, support and resources to all Institute personnel towards the protection and deployment of intellectual property.

The role of IPR cell shall include but not limited to:

- a) enhance awareness on IP related issues

- b) implement the IPR policy,
- c) ensure transparency and fairness of the IP policy to encourage compliance,
- d) periodical review of the policy to improve upon any shortcomings,
- e) strengthen the infrastructure and resources for protection and exploitation of IP and to make available the expert inputs.
- f) management of IP related issues like ownership, confidentiality, disclosure, patentability, technology transfer, revenue sharing, and conflict of interest
- g) provide templates and guidelines for the contracts, agreements and MOUs governing the effective exploitation of the IP produced by Institute.

5. THE IPR POLICY

This IPR policy shall apply to all full-time and part-time employees of institute, visiting faculty, scientists employed by the Institute, students, postdoctoral fellows and visiting scientists as well as non-Institute personnel associated with any activity of the Institute.

The non-Institute personnel associated with IP activity are identified through MOUs/ agreements/contracts between individuals or institutions wherever applicable.

This policy shall apply to all kinds of IP including, but not limited to, any invention, design, discovery, scientific or technological development, research data, computer software, trademark, copyright, and trade secret etc.

5.1 Intellectual Property and Ownership

5.1.1 Patentable inventions, other Invention(s), Designs, Integrated Circuit Layouts and other Creative works:

- a) Invention(s) including software, designs and integrated circuit layouts, created by Institute personnel without the use of any Institute resources and not connected with the profession for which employed at the Institute, shall be owned by the Inventor(s) after due approval of the Institute.
- b) For invention(s) including software, designs and integrated circuit layouts, produced during the course of sponsored and/or collaborative activity between the Institute and external agencies/bodies, specific provisions related to IP made in contracts governing the collaborative activity shall determine the ownership of IP.
- c) The Institute shall be the owner of all invention(s) including software, designs and integrated circuit layouts created by teams of the Institute and non- Institute personnel, associated with any activity of the Institute. Non- Institute personnel, who create invention(s) including software, designs or integrated circuit layouts at the Institute but without intellectual contribution of Institute personnel or any use of the Institute resources, shall be the owner of such invention(s).
- d) An employee of the institute who is on sabbatical or other forms of long leave, or a student who is on leave or as permitted by the institute to be employed in an organisation while being registered as a student, or who is engaged in research in other organisation with the permission of the Institute, will be permitted to directly negotiate with the organisation, the terms of any IP sharing that is generated, in its entirety and

without any use of the institute resources, during the duration of the engagement in that organisation. However, any revenue that is received by the employee/student subsequently while on duty at the Institute, as royalty/fees for the IP generated as above, shall be subjected to the prevailing IPR revenue sharing norms of the Institute.

In case the IP so created by the employee/student, during the leave period as described above, is based in part or full on prior IP developed at the Institute, the employee/student is required to inform the institute and enable the institute to enter into a licensing agreement with the organisation in which the employee/student is temporarily engaged.

- e) Except as stipulated above, the Institute shall be the owner of all invention(s) including software, designs and integrated circuit layouts created at the Institute.

5.1.2 Copyrightable Work:

- a) The Institute will not own the rights in copyrightable works such as books, articles, monographs, lectures, speeches and other communications produced by the institute personnel in the course of research and teaching using Institute resources.
- b) Ownership of copyright of all copyrightable work shall remain with the author(s) with the exclusive of the work produced during the course of sponsored and/or collaborative activity, specific provisions related to IP, made in contracts governing such activity, shall determine the ownership of IP.
- c) The Institute shall be the owner of the copyright of work, including software, created by the Institute personnel with significant use of Institute resources.
- d) The Institute shall be the owner of the copyright on all teaching materials developed by the Institute personnel as a part of any of the academic programs at the Institute. However, the authors shall have the right to use the material in her/his professional capacity.
- e) The Institute shall be the owner of the copyright of work produced by non- Institute personnel associated with any activity of the Institute with the intellectual contribution of the Institute personnel. However, the authors shall have the right to use the material in her/his professional capacity.
- f) The student and his/her supervisor(s) will jointly have the ownership of copyright in the thesis / dissertation / project report written by a student.
- g) Where copyright has not been assigned to the Institute, the Institute will be entitled to a non-exclusive, non-transferable license to use the work within the Institute for non-commercial educational and research purposes.

5.1.3 Trade Mark(s) / Service Mark(s):

Ownership of trade mark(s) / service mark(s) created for the Institute shall be with the Institute.

In cases of all IP's produced at the Institute, the Institute shall retain a non-exclusive, free, irrevocable license to copy/use IP for teaching and research activities, consistent with confidentiality agreements entered into/by the Institute.

5.2. 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 the Institute, if the inventor(s) wish to protect the invention(s) they produce, then they are required to disclose the creative work to the IPR cell at the earliest.

All Institute personnel and non-Institute personnel in a group or as an individual involved in the activity related to IP shall maintain full confidentiality and shall not disclose the details of IP to any person/organization without prior permission of the institute.

In this connection all the institute personnel and non-institute personnel involved in any activity related to IP shall sign a mutual secrecy agreement between self and the institute before getting involved into any activity related to IP.

In case of thesis and other such written documents containing details of patentable IP, it is advised to file a provisional patent before documenting the details of IP in thesis and any such written documents.

5.3. Evaluation and Exploitation Decisions

Inventors/creators of the know how/design/instrument/device/process/specimens and other such IP, who want to get patents(s)/copyright(s)/registration of Design are required to make an application for the purpose to IPR Cell. The IPR cell of the Institute will evaluate the IPs submitted to the cell on the patentability or registration. The IPR cell then would suggest separate committees in consultation with Dean Sponsored Research/Dean Faculty & Sponsored research/any other Dean or other official delegated this responsibility by competent authority depending on the domain of the work and would ask the committee concerned to evaluate the viability in terms of its usefulness and economic value and submit its report to the IPR cell within a fortnight from the date of formation of the committee.

Registrar will notify the committee constituted from each IP application. The composition of the committee will be as follows:

- a) Dean (Sponsored Research)/Dean(Research)/Dean(FA&SR) - Chairman
- b) One expert from the department - Member
- c) One expert from allied department - Member
- d) One member of IPR Cell- Member

Based on the report of the committee the IPR cell shall communicate to the inventor(s) within 60 days from the date of disclosure, its decision whether the

- i. Institute wishes to own and commercialise the intellectual property.
- ii. Institute is unwilling to own and commercialise the intellectual property.
- iii. The ownership of the intellectual property is in doubt.

In case the Institute is not willing to apply for the patent or register the invention, the inventor can apply for the patent with their own funds/with other sponsor, after obtaining written permission from the IPR cell.

5.4. Commercialization

The Institute will license at its discretion the Institute-owned intellectual property for commercialisation through third parties who may or may not be the inventor through the grant of exclusive/non-exclusive licenses, or assign its ownership rights to third parties/ inventor safeguarding the interests, financial or otherwise, of the Institute.

In seeking and developing commercialization of intellectual property, a primary objective and responsibility of the Institute shall be to assure that the products of its intellectual activity are brought into the widest possible use for the general benefit of society.

- a) The IPR Cell may determine whether the Institute has a legal interest in the commercialization of the property. However, the Institute is not legally bound to commercialization of each property.
- b) The costs of transfer of interest/ right/ ownership and maintenance of rights in the Institute-owned property by way of license, assignment will be borne exclusively by the licensee, assignee, and person acquiring such rights.
- c) The assignment or license may be subject to additional terms and conditions, such as revenue sharing with the Institute or reimbursement of the cost of statutory protection. The Institute will be free to revoke the license from the third party if the third party fails to take steps for commercialisation of licence within stipulated time.
- d) Active participation of the originator in all commercialization efforts shall be sought.

5.5. Revenue sharing:

In case of commercialization of intellectual property by licensing rights to third party in consultation with the inventors(s), the revenue generated through royalty payments will be equitably shared among the inventors and the Institute.

The inventor(s) share would be declared annually, and disbursement will be made to the inventor(s), whether or not the inventors are associated with the Institute at the time of disbursement. The net earnings from the commercialization of IP owned by the Institute would be shared as follows:

- a) The initial amount (for year I) will be shared as 60% for the inventor(s) and 40% for the Institute.
- b) For year II, it will be shared as 50% for the inventor(s) and 50% for the Institute.
- c) For year III onwards it will be 40% for inventor(s) and 60% for the Institute.
- d) All the inventors of IP shall sign at the time of disclosure, an earnings distribution agreement, which shall specify the percentage distribution of earnings from IP to each co-inventor. The inventors may at any time, by mutual consent, revise the distribution of IP earnings Agreement.
- e) In the event of payments received from interested parties before commercialisation of IP, like awards, rewards, patenting bonus, etc., the inventors' share will be 60 %, irrespective of the value.
- f) If the IP is co-owned between the Institute and sponsors, the revenue sharing will be based on the contract/agreement between the Institution and sponsors.

- g) In case the Institute is not willing to apply for the patent or register the invention, the IPR cell's decision on revenue sharing out of this case will be final and binding. Preferably, the revenue sharing shall be subjected to the prevailing IPR revenue sharing norms of the Institute.

5.6. Renewal of Patents

The renewal fees for patents taken up solely by the Institution will be paid by the Institution for first seven years. If it is a joint patent with other sponsors, the costs will be shared between the Institution and the sponsor based on the contract/agreement. If the patent has been commercially exploited within the first seven years, the Institute shall pay the Patent renewal fees for the remaining period of the life of the patent. If the patent has not been commercially exploited within the first seven years, the Institute and inventors shall share the subsequent instalments of renewal fees on 50:50 basis. If the Inventor(s) does not show interest in such renewals, the Institute can either continue maintenance of the patent by paying the fees for its full term or withdraw application for Patent protection at its discretion.

5.7. Infringements, Damages, Liability and Indemnity Insurance

- a) As a matter of policy, the Institute shall, in any contract between the licensee and the Institute, seek indemnity from any legal proceedings including without limitation manufacturing defects, production problems, design guarantee, up gradation and debugging obligation.
- b) The Institute shall also ensure that the Institute personnel have an indemnity clause built-into the agreements with licensee(s) while transferring technology or copyrighted material to licensees.
- c) The Institute shall retain the right to engage or not in any litigation concerning patents and license infringements.

5.8. Conflict of Interest

The inventor(s) are required to reveal any divergence of interest or potential conflict of interest. If the inventor(s) and/or their immediate family have a stake in a licensee or potential licensee company then they are required to disclose the stake they and/or their immediate family have in the company. A license or an assignment of rights for a patent to a company in which the inventors have a stake shall be subject to the approval of the Vice Chancellor taking into consideration this fact.

5.9. Jurisdiction

As a policy, all agreements to be signed by the Institute will have the jurisdiction of the courts in Ranchi and shall be governed by appropriate laws in India.

5.10 Dispute Resolution

In case of any disputes between BIT and the inventors regarding the implementation of the IP policy, the aggrieved party may appeal to the Vice Chancellor of BIT. Efforts shall be made to address the concerns of the aggrieved party. The Vice Chancellors decision in this regard would be final and binding.

6. DEFINITION OF PATENT

A patent is an exclusive right granted by a country to the owner of an invention to make, use, manufacture and market the invention, provided the invention satisfies certain conditions stipulated in the law. Under the Patents Act 1970 an invention means “*a new product or process involving an inventive step and capable of industrial application*”.

This right is available only for a limited period of time and is territorial in nature. The inventors/their assignees will have to file separate patent applications in countries of their interest, along with necessary fees, for obtaining patents in those countries.

An invention must satisfy the following three conditions of:

(i) Novelty:

A novel invention is one, which has not been disclosed, in the prior art where prior art means everything that has been published, presented or otherwise disclosed to the public on the date of patent either in written or in any other form, or in any language.

(ii) Inventiveness (Non-obviousness):

A patent application involves an inventive step if the proposed invention is not obvious to a person skilled in the art i.e., skilled in the subject matter of the patent application. The prior art should not point towards the invention implying that the practitioner of the subject matter could not have thought about the invention prior to filing of the patent application.

(iii) Usefulness:

An invention must possess utility for the grant of patent. No valid patent can be granted for an invention devoid of utility.

Patentable Inventions under the Patents Act, 1970

- a) Art, process, method or manner of manufacture.
- b) Machine, apparatus or other article, Substances produced by manufacture, which include any new and useful improvements of any of them and an alleged invention.
- c) However, inventions claiming substance intended for use, or capable of being used, as food or as medicine or drug or relating to substances prepared or produced by chemical processes (including alloys, optical glass, semiconductors and inter-metallic compounds) are not patentable.

Inventions which are not Patentable in India

An invention may satisfy the conditions of novelty, inventiveness and usefulness but it may not qualify for a patent under the following situations:

- a) An invention which is frivolous, or which claims anything obviously contrary to well established natural laws e.g. different types of perpetual motion machines.
- b) An invention the primary or intended use of which would be contrary to law or morality or injurious to public health e.g. a process for the preparation of a beverage which involves use of a carcinogenic substance, although the beverage may have higher nourishment value.

- c) The mere discovery of a scientific principle or formulation of an abstract theory e.g., Raman Effect.
- d) The mere discovery of any new property or new use of known substance or the mere use of a known process, machine or apparatus unless such a known process results in a new product or employs at least one new reactant.
- e) A substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance.
- f) The mere arrangement or rearrangement or duplication of features of known devices each functioning independently of one another in a known way.
- g) A method or process of testing applicable during the process of manufacture for rendering the machine, apparatus or other equipment more efficient.
- h) A method of agriculture or horticulture.
- i) Any process for medical, surgical, curative, prophylactic or other treatment of human beings, or any process for a similar treatment of animals or plants.
- j) Inventions relating to atomic energy.

7. GLOSSARY

- i. 'The Institute' refers to Birla Institute of Technology, Mesra, Ranchi and all its extension centres.
- ii. 'Institute personnel' includes but is not limited to the faculty, students, staff or visiting faculty, researchers and scientists at Birla Institute of Technology, Mesra, Ranchi.
- iii. 'Intellectual property rights' (IPR) allows people to assert ownership rights on the outcomes of their creativity and innovative activity in the same way that they can own physical property. The four main types of intellectual property rights are: patents, trademarks, design and copyrights.
- iv. 'Intellectual Property' includes but is not limited to copyrights and copyrightable materials, patented and patentable inventions, tangible research results, trademarks, service marks and trade secrets.
- v. 'Copyright' means the exclusive right granted by law for a certain period of time to an author to reproduce, print, publish and sell copies of his or her creative work.
- vi. 'Copyrightable Work' is a creative work that is protectable under copyright laws. Copyright protection is available for most literary, musical, dramatic, and other types of creative work, including software, teaching materials, multimedia works, proposals, and research reports.
- vii. 'Invention' includes but is not limited to any new and useful process, formula or machine conceived or first reduced to practice in whole or in part, defined within the purview of the Patent Act. Inventor(s) are person(s) who produce an invention.
- viii. 'Inventor' means faculty, students, staff or visiting faculty who has/have written or created a creative work. It also includes any person who signs an agreement or MOU with the Institute for any work that result in IP creation.
- ix. 'Co-inventors' are the co-authors of the invention

- x. 'IPR cell' is a cell formed by BIT Mesra and is the sole authorized body to handle all IPR related issues and conflicts.
- xi. "Licensing" is the practice of renting the intellectual property to a third party.
- xii. "PCT Application" A PCT is a system of filing a patent application in several countries through a single application keeping the priority of the first filing in any of the countries within the PCT system. This is administered by the World Intellectual Property Organisation (WIPO) in Geneva. It is not a patent granting system.
- xiii. 'Earnings' mean earnings resulting from the licensing or commercialization of the IP, reduced by the actual expenses incurred in obtaining and commercialization of the IP, including the outstanding expenses.
- xiv. "Royalty" is the payment made to an inventor/author or an institution usually for legal use of a patented invention or any Intellectual Property when licensed.
- xv. A "Patent" is an intellectual property right issued by authorized bodies to inventors to make use of and exploit their inventions for a limited period of time (generally 20 years).
- xvi. "Patentability" is the ability of an invention to satisfy the legal requirements for obtaining a patent. The basic conditions of patentability, which an application must meet before it is granted, are that the invention must be novel, contain an inventive step, be capable of industrial application and not be in one of a number of excluded fields.
- xvii. "Preliminary Examination" is the initial study of an application by an official in the patent office to check that the specification is properly arranged and for preparing search reports.
- xviii. "Preliminary hearing" is a hearing appointed to decide a point of procedure, usually in with notice (inter parties) proceedings.
- xix. "Prior art" is previously used or published technology that may be referred to in a patent application or examination report.
- xx. "Priority country" is the country where the patent is first filed before being (possibly) extended to other countries.
- xxi. "Protection of Layout of Integrated Circuits" is the layout scheme of Integrated circuits that are functionally important.
- xxii. "Publication" is a patent application which is successfully granted will be published twice. The first time (A-publication) occurs around 18 months after the filing date of the application (or the priority date, if it has one). The application will generally be published "as filed". The second time (B-publication) occurs when the patent is granted, and publishes the application in its final form.
- xxiii. "Publication date" is the date on which the patent application is published (i.e. the information is available to public). This normally occurs 18 months after the priority date.
- xxiv. "Renewal fees" is annual fees payable to the office to keep the patent in force once a patent is granted.
- xxv. "Research Disclosure" is defensive-type publications which are published, often anonymously, to give companies and inventors "freedom of use" rather than legal

protection. Once research disclosures are published the invention described cannot be patented.

- xxvi. “Restorations” are the proceedings by which a patent which has lapsed through failure to pay renewal fees may be restored.
- xxvii. “Revocation” is the process by which a granted patent can be annulled. This can happen because it is demonstrated that the patent does not satisfy one of the patentability criteria - but it can also occur for other reasons.
- xxviii. ‘Design’ means only the features of shape, configuration, pattern or ornament or composition of lines or colour or combination thereof applied to any article whether 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.
- xxix. "Article" means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately
- xxx. 'Design Registration' is registration of the novel non-functional features such as shape, or ornamentation of a product. The registration of a design confers upon the registered proprietor ‘Copyright’ in the design for the period of registration. ‘Copyright’ means the exclusive right to apply a design to the article belonging to the class in which it is registered.
- xxxi. “Significant Use of Institute Resources” is any usage of Institute’s resources in the creation of the invention(s), excess of the routine use of office facilities, computers, library resources and resources available to the general public.
- xxxii. “Software” means anything executable in a computer.
- xxxiii. “Teaching material” means any material that aids the process of teaching.
- xxxiv. “Trade Mark / Service Mark” is a distinctive word, symbol or picture or a combination of these, which is used by a business entity to discriminate its products and services from those of other business entities.
- xxxv. “Trade Secret” Usually some information such as know-how of commercial or strategic value that is not disclosed to all and is used in a restricted manner.
- xxxvi. 'Conflict of Interest' or a 'Potential Conflict of Interest' exists when an inventor/author is or may be in a position to use either creative work or influence for unmerited personal or family gain.
- xxxvii. ‘Ethical standards’ refer to principles that when followed promote values such as trust, good behaviour, fairness and/or kindness.

9. Revision of the Policy:

The IPR policies as outlined earlier may be reviewed, if require, after five years.