

INTELLECTUAL PROPERTY RIGHT POLICY

2015



**Centre for Industry Institute Partnership Programme
PANJAB UNIVERSITY, CHANDIGARH**

**INTELLECTUAL PROPERTY RIGHT
POLICY**

2015

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**Centre for Industry Institute Partnership Programme
PANJAB UNIVERSITY, CHANDIGARH**

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Professor S.K. SONI, Director, CIIPP and Nodal Office, IPR Cell, Panjab University,
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Preface

Government of India is spending crores of rupees on research every year, however, very few outcomes are translated to products or processes which are commercialized to fulfill the societal needs. This is evident from the number of Intellectual property rights (IPRs) acquired by Indians which are negligible as compared to those granted to the researchers from USA and China during the last decade. Most of the research outputs end in 'thesis' or 'journal articles' probably due to lack of sufficient awareness about the IPRs or the myth that patent filing is a very tedious, slow and expensive process. Further, the lack of well defined IPR policies in most of the institutions for promoting, facilitating and providing incentives to the inventor(s) who take initiatives to transfer their work to the public may be another reason for poor efforts in this direction by the researchers.

There is a need to stimulate the researchers to think beyond publications and to encourage them for carrying out the creative and scholarly works for the development of new products, devices, processes and other types of intellectual property. A single innovative technology or a product can make the researcher billionaire and make the country self reliance. Keeping in view the economic fortunes of India and its socio-cultural development by innovations to make Hon'ble Prime Minister Mr. Narendra Modi's 'Make in India' campaign a reality, and considering the intellectual strength of Panjab University, Chandigarh, IPR Cell of the University, under the aegis of Centre for Industry Institute Partnership Programme (CIIPP), has formulated an IPR policy document. This will provide guidance to the researchers of Panjab University and its affiliated colleges, comprising academic and non-academic staff, students, research scholars, post-doctoral fellows, visiting scientists and outside agencies involved in the collaborative work for improving the standards of the research for matching the levels which can be translated easily to IPRs. This document highlights the practices and the rules of Panjab University regarding intellectual property rights and obligations, requirements of its ownership, licensing, technology transfer and revenue sharing.

This policy has been finalized due to painstaking efforts, valuable inputs, constructive criticism and help rendered by Prof. Lalit Bansal, former Dean Research and former Director, CIIPP, PU, Chandigarh; Prof. Rupinder Tewari, former Director, CIIPP, PU, Chandigarh; Prof. O.P. Katare, Director, Research Promotion cell, PU, Chandigarh; Prof. Sanjay Chhibber, Former Coordinator, Research Promotion Cell, PU, Chandigarh; Prof. Meenu Paul, IPR Expert, Department of Laws, PU, Chandigarh; Dr. Neelima Jerath, Executive Director, Punjab State Council for Science and Technology (PSCST), Chandigarh; Mr. Gurharminder Singh, Incharge, Patent Information Centre (PIC), PSCST, Chandigarh; Mrs. Divya Kaushik, Scientist, PIC, PSCST, Chandigarh; Mr. Garry Bedi, Scientist, Patent Management cell, Institute of Microbial Technology (IMTECH), Chandigarh and Prof. Bhupinder Singh Bhoop, Chairman, University Institute of Pharmaceutical Sciences, Chandigarh.

It is hoped that the policy laid down in this document will help to fulfill the commitment of Panjab University to promote academic freedom and provide a conducive environment for research and development of commercial importance. It is also expected that the policy will serve as a model document for other Universities/ Institutions for spreading awareness about the innovative research of commercial value and the need for the protection of intellectual properties of the region

S.K. SONI

Director (Honorary), Centre for Industry Institute Partnership programme

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1. PREAMBLE

Panjab University has a glorious tradition of pursuing excellence in Teaching and Research in the fields of Science and Technology, Engineering, Humanities, Social Sciences, Performing Arts and Sports established during the period of more than 130 years of service, inherited since its inception in 1882 at Lahore (now Pakistan). After re-location in 1956 at Chandigarh, Panjab University has dedicated itself in providing the Technical Manpower, Technical Know-how, Technologies, Technical Consultancies, Advisory Consultancies, Intellectual Property Rights by its qualified, experienced and dedicated Faculty, Technical Personnel, Administrative Staff as well as Students with a mission of remaining as one of the leading centers of teaching, research and excellence through total commitment in every endeavour. The University has already been recognized globally because of its teaching and research potentials becoming India's No. 1 University to attain the world ranking in the bracket 276-300 in the Times Higher Education World University Rankings, 2014-2015 powered by Thomson Reuters. The University has 75 teaching and research departments and 15 Centers/Chairs for teaching and research at the main campus.

Despite spending crores of rupees on research every year, hardly any research is converted to products which benefit the society. Most of the research ends in 'thesis' or in 'journal articles'. There is a dire need to stimulate researchers to think beyond publications and think about the applications of their research in larger societal interest. IP protection and licensing is the key to successful application of research in larger societal interest. Inherent in these responsibilities is the need to encourage the production of creative and scholarly works for the development of new and useful materials, products, devices, processes and other types of intellectual property, some of which with potential commercial value. These activities contribute to the professional development of the individuals involved, enhance the reputation of the University, provide additional educational opportunities and promote public welfare. The University encourages bringing new knowledge into use for public domain. Such knowledge or technology often has commercial value and should be treated as a financial asset to be used, conserved and applied in such a way as to generate an appropriate financial return. The transfer of such information or technology through licensing satisfies both the above objectives, *i.e.*, dissemination for use and realization of financial returns.

Intellectual property plays an important role in providing a competitive edge to an organization. The intangible assets of an organization - such as know-how, inventions, brands, designs and other creative and innovative products - are today, often more valuable than its physical assets. Over the last decade, appreciation of the commercial value of intellectual property has grown both within the academic community and in the society at large. Concerns related to confidentiality, publication, and ownership of intellectual property are now commonplace. The pace of development of the human mind, resulting in new and useful inventions, initiated a need for a central policy in determining the course of the creation, protection and commercialization of intellectual property in the University. The intellectual property rights are now not only being used as a tool to protect the creativity and generate revenue but also to build strategic alliances for the socio-economic and technological growth. Keeping in view the importance of higher education in spawning societal changes and transforming the economic fortunes of a country by emphasizing innovations, Panjab University has taken several measures for promoting innovative research by encouraging inter-disciplinary research through inter-university, intra-university, university-institute and university-industry collaborations.

With a view of bridging the gap between theory and practice, and to sensitize University towards the needs of the industry, Centre for Industry Institute Partnership Programme (CIIPP) was set up by Panjab University in 1996. The main objectives of CIIPP are to bring industry closer to the academia and vice-versa, to make strategies for the promotion of synergistic interface with industry, to organize industry interactions, to identify the specific areas of mutual interest, to develop methodologies and guidelines for encouraging consultancy and technology transfer, to encourage R&D programmes for meeting industrial need(s) and to generate resources in the form of industry-supported projects and consultancy programmes. CIIPP has already drafted the consultancy rules which have been adopted by the University and are in force. As per the Consultancy rules, Panjab University allows the Academic and Technical staff of the University to undertake the consultancy or to provide technical services to any industry and other organizations using University facilities through CIIPP. As per the rules, the consultancy fee is distributed between the consultant and the University in 70:30 ratio. Of the university share, 10% is retained as Administrative charges, 40% is transferred to the Corpus Fund "Development Fund", while the remaining 50% is made available to the Department concerned for infrastructure development or any academic/industry interaction activity. Several departments of the University, including University Institute of Pharmaceutical Sciences (UIPS), University Institute of Chemical Engineering and Technology (UICET), University Institute of Engineering and Technology (UIET), Institute of Dental Sciences (IDS), Department of Chemistry, Department of Microbial Biotechnology, Department of Microbiology, Department of Geology and Computer Centre are already enriching the Panjab University with their consultancy works.

The CIIPP also houses an Intellectual Property Rights (IPR) Cell, which has been established as a nodal agency of Patent Information Centre (PIC), Punjab State Council for Science and Technology (PSCST), Chandigarh, which is a joint venture of Technology Information, Forecasting & Assessment Council (TIFAC), Department of Science and Technology (DST), Government of India and Government of Punjab. The aim of the IPR cell is to propagate awareness on intellectual property among the researchers of Panjab University and the affiliated colleges by organizing workshops, seminars and training programmes. The cell also facilitates the researchers in obtaining IPRs by providing technical and financial help.

Keeping in mind, the intellectual strength of Panjab University, growing awareness about the innovative research of commercial value and the need for the protection of intellectual property, an IPR policy document has been formulated to provide guidance to the researchers of Panjab University, comprising academic and non-academic staff, students, research scholars, post-doctoral fellows, visiting scientists and outside agencies involved in the collaborative work. This document highlights the practices and the rules of Panjab University regarding intellectual property rights (IPR) and obligations depending upon the nature of intellectual property (IP), requirements of its ownership, its confidentiality, licensing, technology transfer and revenue sharing. The policy laid down in this document is expected to fulfill the commitment of the University to promote academic freedom and provide a conducive environment for research and development of commercial importance.

2. PURPOSE OF FORMULATING INTELLECTUAL PROPERTY RIGHT (IPR) POLICY OF PANJAB UNIVERSITY

Panjab University has formulated this policy for the management and ethical conduct of IPRs with the objectives to:

- Provide a conducive environment at Panjab University leading to the generation of IP;

- Ignite and improve the standards of the research matching the levels which can be translated easily to IPRs;
- Facilitate, encourage, promote and safeguard scientific investigation and research in Panjab University with the freedom of the faculty, non-faculty, students, inventors and sponsors involved in Research & Development;
- Make the inventor(s) of IP aware of the applicable laws and rules for ensuring their compliance;
- Establish an IPR management policy and procedural guidelines, making the inventions and discoveries made in the course of research carried out in the Panjab University available to the public;
- Promote, facilitate and provide incentives to the inventor(s) who take initiatives to transfer University IP to the public;
- Enable the University to make beneficial use of developed IP with the maximum possible benefit of the inventors, the University, and the nation at large.
- Safeguard the interest of inventor(s) of IP and provide fair distribution of returns accruing from the commercialization of IP by providing distribution of resulting economic gains among the developers/ authors/ inventors, the University and where applicable, the sponsors.
- Create respect for other people's IP among members of the University community.
- Help in introducing prudent IP management practices within the University to promote an IPR culture.

3. STAKEHOLDERS IN INTELLECTUAL PROPERTY GENERATED BY RESEARCHERS AT PANJAB UNIVERSITY

There are several stakeholders in the process of development of innovative research, acquiring patents and commercialization of innovations or inventions. These include:

- Panjab University (PU);
- Researchers and Inventors of PU including regional centres and affiliated colleges;
- Collaborators/ Visiting Scientists from other institutes or industry;
- Sponsors;
- Licensee;
- Government;

Each of these stakeholders contributes in one way or another in the process of generation and commercialization of innovations, inventions and research findings. The stakeholders have their interests and expectations which in most cases are in conflict with each other.

Panjab University is a major stakeholder in patented and/or commercialized innovations, inventions and research findings. It contributes to the following:

- the infrastructure for the researcher or inventor to operate in;
- the researcher's salary;
- the funds for research;

- the goodwill in the name of the university, which happens to be one of the premier institutes in India, which is equally important, not only for obtaining sponsorship and research contracts but also during the process of commercialization of the innovations and inventions.

Since it is normally the academic and research staff who makes the initial contact with a company or other sponsoring agency regarding a potential research collaboration or contract, it is important that research staff is aware of the key points to be addressed in discussing or negotiating a collaborative project.

The research activities are undertaken in most cases with the support of students, research fellows/ assistants/ associates, guest researchers or postdoctoral fellows. For their contribution, this category of researchers would expect financial rewards as well as unrestricted publication and utilization of the knowledge acquired.

The researcher's publication needs must be safeguarded for the sake of his professional and career development, but potential innovations and research findings must be guarded against premature disclosure, which may jeopardize the patentability and commercial exploitation of an invention.

The sponsor, which can be the government, industry or any other institution/University, provides funds for research and development. Sometimes sponsors also provide research facilities and may also participate in joint research and development. For that the sponsor may expect ownership of the IP generated and/or unrestricted utilization of the knowledge acquired.

The licensee is the industry or institution that purchases the license for an invention or technology. It pays for the technology and therefore may expect rights in it.

The government provides funds for infrastructure, research and other services. It therefore expects that any invention, innovation and research findings, arising from the university would be used for the development of the country and that no useful inventions would be kept unutilized, through unfair monopoly of ownership.

4. ISSUES COVERED BY THE IPR POLICY OF PANJAB UNIVERSITY

In order to harmonize the various conflicting interests of stakeholders and to achieve broad-based objectives, the intellectual property right policy of Panjab University addresses following issues:

- i) Coverage of Intellectual Property Right (IPR) Policy;
- ii) Intellectual Property (IP) Ownership criteria
- iii) IPR Policy Administration
- iv) Regulation of IPR Policy
- v) Disclosure of Intellectual Property and Maintenance of Confidentiality
- vi) Evaluation of Disclosed Intellectual Property for Protection of Rights
- vii) Commercialization of IP
- viii) IP protection, Licensing and Technology Transfer;
- ix) Revenue Sharing;
- x) Other pertinent issues

4.1. **COVERAGE OF IPR POLICY**

This policy covers all rights arising from any type of the IP which can be secured under any protection mechanism, including patents, copyrights, trademarks, industrial designs, layouts of integrated circuits, devised, created or made by the staff/ students/ researchers in the course of their employment/ enrollment for any degree/ course in the university. This policy should be deemed a part of the conditions of employment for every employee of the University and a part of the conditions of enrollment of students at the university and to all existing staff and students. Further, the University reserves the right to amend the IPR Policy as and when such need arises.

All potential inventors who participate in a sponsored research project and/ or make use of University-sponsored resources should abide by this policy and should accept the principles of ownership of IP as stated in this policy unless an exception is approved in writing by the University. All inventors of IP should execute appropriate documents required to set forth effectively the ownership and rights as specified in this policy. It would be obligatory for all Faculties/ Research Fellows/ Post-doctoral Fellows/ Students/ Laboratory Staff/ Visiting Scientists/ Collaborators to follow the IPR Policy of Panjab University and abide by various terms and conditions laid in it. No patentable invention /technology innovation / trademarks developed by them and others they should be working with, be disclosed to any other party. Any prior disclosure, directly or indirectly, either during the period of work or after its termination, should render them prosecutable as per laws that may be in force at the time. Furthermore, no copyright material assigned by them to the Panjab University should be reproduced by them beyond that which falls under fair use and they should retain only moral rights to this material.

4.2. **INTELLECTUAL PROPERTY (IP) OWNERSHIP CRITERIA**

The ownership criteria for various types of IPs developed by the employees and students of Panjab University should be determined as follows:

4.2.1. **Patents**

A patent is owned by the assignee. If an employee makes an invention, the rights usually belong to the employer. This means that IP developed by the university researcher is owned by the university, with the researcher(s) named as inventor(s). The Panjab University will be the sole owner/assignee of the patent if the invention domain falls within the specialization of the inventors, depending upon the following conditions. If the invention domain falls out of the specialized areas of the inventor and involves no use of University resources, then the inventor will be the individual owner/assignee of the IP created, however, he/she will have to seek permission from the University before applying for the protection of the IP.

- a) IP generated by an employee, a student/ researcher of the University or visiting professional should always be the property of the Panjab University whether University resources are used or not. The University will thus be the assignee while the researchers will be the inventors. Where a patent is applied for, the inventors should agree to maintain secrecy and confidentiality of all relevant details of IP until the patent application has been filed.
- b) The University will be the sole assignee of IP created through sponsored research where the sponsor does not claim IP rights.
- c) If a University employee or a student creates IP while working with another organization/industry/sponsor, where the latter claims IP rights, it should be jointly owned by the Panjab University, Chandigarh, and the organization/industry/ sponsor.

- d) Where research has been sponsored by a private industry/ foundation or government agency and no prior agreement exists on sharing of IP, then licensing of patents and revenue sharing should be negotiated between the sponsor and the University before embarking on such research program.
- e) Any IP generated as a work for hire will belong to the University.
- f) Royalty accruing or any type of payment received from the commercialization of the University-owned IP should be shared between the University and the inventors vide policy guidelines of PU for revenue sharing.

4.2.2. **Copyrights**

The University will not own the rights in copyrightable works such as books, articles, monographs, lectures, speeches, video presentations and other communications produced by the staff in the course of research and teaching without using University resources. Ownership of the copyright of all copyrightable work will be according to the following criteria:

- a) The University would be the owner of the copyright of the work related to the area of specialization including software created by the University personnel with the use of University resources other than a literary work. If the work is not related to the domain area of the inventor and does not involve University resources, then the University will have no ownership right in the work.
- b) The University would be the owner of the copyright of all teaching materials developed by the University personnel as a part of any of the academic programs of the University. However, the authors should have the right to use the material in her/his personal use.
- c) The University would be the owner of the copyright of the work produced by non- University personnel associated with any activity of the University with the intellectual contribution of the University personnel. However, the authors should have the right to use the material in her/his professional capacity.
- d) If the work is produced during the course of sponsored and/or collaborative activity, specific provisions related to IP, made in contracts governing such activity, should determine the ownership of IP.
- e) The student and his/her supervisor(s) will jointly have the ownership of copyright in the thesis / dissertation / project report written by a student.
- f) Any copyrightable work generated as a work for hire will belong to the University.

Where copyright has not been assigned to the University, the University will be entitled to a non-exclusive, non-transferable license to use the work within the University for non-commercial, educational and research purposes, or to possess a limited number of copies for such purposes, whichever is relevant.

4.2.3. **Softwares, designs, integrated circuit layouts and other creative works**

- a) The University should be the owner of all softwares, designs and integrated circuit layouts, created by a team of the University and non-University personnel associated with any activity of the University.

- b) Softwares, designs and integrated circuit layouts produced during the course of sponsored and / or collaborative activity, specific provisions related to IP made in the contracts governing the collaborative activities should determine the ownership of IP.
- c) Softwares, designs and integrated circuit layouts created by the University personnel without use of the University resources and not connected with the profession for which he/she is employed at the University should be owned by the inventor(s).

4.2.4. **Open and distance education material**

All original works/study material, in print or electronic mode, submitted by the ‘contractual contributors’/faculty member of University for open and distance education programmes/courses being offered by the university, for which university has paid salary/ honorarium, will remain the property of the Panjab University.

The University has the right to use the study materials developed by the faculty member and/or by some ‘contracted contributor/author’ for the University's own educational, research, and other purposes.

If the study materials are licensed, sold or otherwise conveyed to a third party, the royalties will be governed according to policy guidelines of PU. If the material is used in open and distance education activities, generating revenue under a scheme where instructors/contracted contributors/authors or other University personnel receive specific compensation, the originator of the coursework is entitled to a fair share of the proceeds, the exact amount being determined by the University.

As to revisions and updates of a distance learning course, the faculty member(s) or other author(s) of the course will have the primary responsibility for revising and updating the programme/course and related study materials as long as he/she/they are employed by the University. If a faculty member who is an author is no longer employed by the University or is unable to revise and update the course as needed, the material may be revised and updated by other competent University faculty member/ expert. In any case, editing or vetting of the material in due course shall not undermine the contribution of the original author(s).

4.2.5. **Sponsored research**

Ownership of any IP that is made, discovered or created in the course of research funded by a sponsor pursuant to a grant or research agreement or which is subject to a material transfer agreement, confidentiality disclosure agreement or other legal obligation affecting ownership, will be governed by the terms of the grant or agreement, as approved by the institution, although normally the institution would claim ownership. It would be mandatory for the Research Fellows/ Project Fellows/ Research Associates/ equivalent persons hired in sponsored Research Projects to abide by various terms and conditions laid in Panjab University IPR policy.

The IP generated from research projects sponsored by government/ non-government agencies will be owned by Panjab University and the Sponsoring agency. The sponsoring agency will bear 50% of the protection cost or forgo the rights to the IP. In case the project was accepted by the Investigator/ University under terms different from that stated herein, the terms agreed to should prevail.

Where Panjab University is a joint owner of the IP with one or more institutions or business entities and where income is shared between the participating entities, the patents are normally jointly owned by the participating institutions and the rights to use the invention alongwith the distribution of royalties among the institutions is generally negotiated after confidentiality disclosure of the invention, but before the patent application is filed.

4.2.6. Handling of thesis, term papers and research proposals submitted by students

The texts of all student thesis and dissertations and works derived from these are considered 'exempted scholarly works'. It is a requirement in academia that the supervising teacher and the student must own the copyright of the thesis, term papers and the research proposals which the students submit for the fulfillment of the requirements for an academic degree or diploma. However, the supervising teacher and the student will grant a non-exclusive, non-transferable, royalty-free license to the Panjab University for use of these, in the course of non-commercial academic activity.

The student and the supervisor will have to allow the University to make available the abstract of the thesis in both hard copy and electronic form keeping in the library record of the University. The University reserves the right of a non-exclusive license to make limited copies of the thesis in whole or in part and to loan such copies at the University's discretion to academic persons and bodies approved of from time to time by the University for non-commercial academic use. All usage under this clause will be governed by the relevant fair use provisions laid down by the Indian Copyright Act, in force at the time of submission of the thesis.

The supervisor of the student submitting the thesis holds all rights in inventions, discoveries or rights of patent and / or similar property rights derived from the thesis wherever the thesis has been completed. If the author/supervisor wishes to file a patent based on the thesis, they will have to maintain confidentiality while the University will restrict access to the thesis for a limited period and will not disclose any part of thesis to any person(s) without written authorization from author for one year after the date of submission of the thesis or filing a patent, whichever is earlier.

The university will be assigned all the Intellectual Property Rights for the inventions while the copyright of the thesis in which this invention is described or outlined will remain with the teacher and the student. If the student is employed to assist in the execution of a sponsored project or program, the IPRs in their contribution to that project will be governed by the terms of the contract between the student, supervisor, the University and the sponsoring agency of the project.

4.2.7. IP generated through consultancy

Since consultancy comes to academic staff through University channels and is administered centrally by Centre for Industry Institute Partnership Programme (CIIPP), any intellectual property arising from the consultancy should be assigned jointly to the University and the consulting firm and the total cost incurred in acquiring the IP and its maintenance will be borne equally by the two parties. The royalty arising from commercialization of IP generated through consultancy will be distributed following the procedure as determined by Panjab University Consultancy rules. The inventors who are engaged in consultancy work should not be in conflict with University policy and should make their University obligations known to outside parties before they make such agreements.

4.3. IPR POLICY ADMINISTRATION

This policy should be applicable to all the university personnel, as well as non-university personnel associated with any activity of the University and will be controlled by the University's Intellectual Property Right Cell.

4.3.1. IPR CELL BODY

University's Intellectual Property Right Cell, would comprise the Director, CIIPP, Executive Director, Punjab State Council for Science & Technology, three additional senior faculty members with expertise in areas related to creative work, legal aspects of IPR and technology transfer, as recommended by the Director, CIIPP and approved by the Vice-Chancellor in addition to one Vice-Chancellor's nominee. The tenure of the members of the IPR cell shall be three years and the Cell should be responsible to administer all decisive issues related to IP policy and other relevant matters as should be determined from time to time.

4.3.2. Right to regulate Policy

The IPR Cell will be responsible for interpreting the policy, resolving disputes and recommending changes to the policy from time to time to the Panjab University governing bodies including Syndicate and Senate. The IPR Policy may be reviewed after every 2 years or earlier, if a major change in the same takes place at the National Level. The IPR cell will establish IPR centers in all the educational institutes affiliated to PU and guide them in their functioning, as well as filing of patents. The IPR cell will arrange IPR awareness workshops and seminars time to time to encourage researchers for innovations.

4.3.3. Assessment of Innovation for Protection

To facilitate the assessment of creations for protection, the IPR Cell will seek the services of Patent Information Centre (PIC) at Punjab State Council for Science and Technology (PSCST), Chandigarh for novelty assessment of innovation. PIC is a joint project of Technology Information, Forecasting & Assessment Council (TIFAC), Department of Science and Technology, Government of India, and Government of Punjab set up in PSCST to create awareness on Intellectual Property Rights (IPRs) and to facilitate the filing of patents from the region. On scrutiny of the report from PIC, PSCST and the subsequent feedback by the inventor(s), the IPR cell may make one of the following recommendations to the Centre for Industry Institute Partnership Programme (CIIPP) regarding filing of the patent on that invention:

- a) That the University will assist in the protection of the IP and will facilitate the inventor in acquiring the IPR taking the services of PIC, PSCST or some patent attorney/law firm, if required. The CIIPP will also provide a financial assistance to the inventor upto a maximum of Rs.50,000/- for the same.
- b) That the University will not financially assist the inventor in the protection of the IP. However, the inventor(s) may file his patent taking the services of PIC, PSCST which provides the patent filing services free of cost.

4.3.4. Authority regulating all Contracts and Commitments

All Commitments, Agreements, Memoranda of Understanding, relating to commercialization or exploitation of University-owned IP will be granted in the name of the Panjab University for and on behalf of the University by the Registrar, Panjab University on the recommendations of the Director, CIIPP.

4.3.5. Contracts and agreements

All agreements, undertaken by any Panjab University personnel and students need to be approved by the Registrar, Panjab University who shall act as the final signing authority in all the categories of agreements listed on the recommendations of the Director, CIIPP.

4.4. REGULATION OF IPR POLICY

The CIIPP will prepare and distribute, to the various departments, copies of IPR Policy of Panjab University and other recommendations as may be considered appropriate for the implementation of the guidelines and provisions of IP policy adopted by the Panjab University, Chandigarh. The policy will also be made available online on the CIIPP home page in the Panjab University website (<http://ciipp.puchd.ac.in>).

The policies set forth herein constitute the understanding which is binding on University faculty, staff, and students as a condition of their participation in University research, teaching, and service programmes.

4.4.1. Transparency of IP Administration

The University and the inventors should maintain complete transparency in sharing information at all stages of the process. The inventors should keep the University informed of updates or the development of the IP.

4.4.2. Responsibilities of Departments

Each department will administer Panjab University IPR policy as defined herein through its Departmental Academic Committee. In particular, each inventor must maintain in his or her department records detailing his or her activities in generating IP. Such records must be made available on demand to the IPR Cell.

4.5. DISCLOSURE OF INTELLECTUAL PROPERTY AND MAINTENANCE OF CONFIDENTIALITY

When the inventors believe that they have generated patentable or commercializeable intellectual property using University-supported resources, they should report it promptly in writing along with relevant documents, data and information, to the University's CIIPP requesting for IPR protection and inventor's revealing to University about the Invention/ Technology Development/ copyrightable materials comprising technical/ professional/ scientific/ artistic work/ copyrightable software. In order to be patentable, an invention must be NOVEL, USEFUL and NOT OBVIOUS, based upon everything which was available at the time of the invention. Justify how your invention fulfills these criteria. Indicate the state of the Art of your invention considering what was already in existence (whether patented or not) before the invention. The information should be forwarded through the Chairman/ HOD and constitute the following:

- a) Full and complete disclosure of the nature, particulars and other details of the IP, indicating the problem for which solution was researched with identification of all persons who constitute the inventor(s) team
- b) In case of the sponsored and/or collaborative work the provisions of the contract pertaining to disclosure of the creative work and IP protection should be mentioned.
- c) An undertaking that the disclosed work has not been communicated or published

or discussed in any conference/ workshop/ journal/ book/ lecture. The inventors should understand the legality of such disclosures and then later on it turns out that absolute novelty is missing due to prior disclosure through above means.

- d) What parts/steps, make up the invention?
- e) Which parts/steps are new to this invention, which are old?
- f) How does your invention perform its function different from or better than, these prior devices (methods)?
- g) Who would be likely to purchase or use the invention?
- h) Has the work been reported / published / presented oral or poster anywhere (if yes, give full description)?
- i) Has any related patents been filed by the inventor?
- j) Has the permission been taken from National Biodiversity Authority/ Board in case a biological sample has been used? Attach the copy of the permission
- k) Has the microorganism been deposited with the International Depository, in case your invention involves the used of a microorganism? If yes, attach the copy of the letter
- l) Information available in the published literature (prior-art) about the problem tackled
- m) Is the work completed and the results validated or is at a basic conceptualisation stage?
- n) The inventor should assign the right of the disclosed IP to the University and agree to the terms and conditions for the sharing of any financial benefits received by the university as a result of commercialization.

4.5.1. Statement by inventors of IP

The inventors of IP under the terms of this policy should be required to determine and to state that to the best of their knowledge the IP does not infringe on any existing patents or other IP or other legal rights of third parties.

- a) If any part of the work is not the original work or creation of the inventors, they must show the certificate to use the property obtained from the owner or state their reasons for believing that such permission is not necessary as the use constitutes fair use. They will further certify that the work contains neither libellous material nor material that invades the privacy of others.
- b) In case a third party alleges infringement of their rights by an inventor and the IPR Cell finds prima-facie that the inventor may have made false claims, the University will take immediate steps to dissociate itself from the said IP.
- c) All agreements with inventors should indemnify the University against all damages arising out of such litigation.

4.5.2. Confidentiality guidelines related to innovation disclosed to CIIPP

All university personnel and non-university personnel associated with any of the university's activities should treat all IP related information which has been disclosed to the

CIIPP and/or whose rights are assigned to the University, as confidential. Such confidentiality should be maintained till such date as is 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. Having disclosed the invention, the inventor(s) should maintain confidentiality, i.e. refrain from disclosing the details, unless authorized otherwise in writing by the University, until the University has assessed the possibility of commercialization of the IP. The inventor(s) and Panjab University (through CIIPP) will abide by confidentiality clauses as below:

Subject to the right of academic freedom the University staff should not directly, except in the proper course of their duties, either during or after a period of their appointment, disclose to any third party or use for their own purposes or benefit or the purposes of any third party, any confidential information unless that information is public knowledge or he/she is required by law to disclose it.

Access to areas where confidential information is made available, seen or used and to confidential documents, records, etc. is to be limited only to those who are inventors or are bound by confidentiality agreements. Inventors and/ or University personnel must take care not to disclose confidential details of IP in their publications, speeches or other communications.

All invention / proprietary information is and remains the property of the disclosing party and must be returned, in a form suitable to be returned, within ninety (90) days after the disclosing party makes a written request for its return or at the conclusion of the evaluation.

4.6. EVALUATION OF DISCLOSED IP FOR PROTECTION OF RIGHTS

The IPR Cell of the University will evaluate the disclosure made by the inventor(s) and the prior-art report prepared by PIC, PSCST to determine whether there is a good prima facie case for believing that the IP has economic value and it needs protection. It will communicate to the inventors the decision about the extent to which the CIIPP will bear the financial burden for acquiring the IPR which will be upto a maximum of Rs. 50,000/-. The inventor(s) should furnish all the documents from time to time as may be reasonably required for effective protection and maintenance of proprietary rights of the University. The University will be entitled to a non-exclusive, non-transferable license to use the work within the University for non-commercial educational and research purposes. The University will review the situation after 7 years, if the IP has been commercialized, the subsequent cost of maintaining statutory protection will be met through receipts from the licensee. If the property has not been commercialized, the University should no more be liable to pay for statutory protection of the property.

4.7. COMMERCIALIZATION OF IP

The University will encourage the inventors to commercialize their intellectual property by organizing specific industry interactions for showcasing the inventions. In case a patent is to be applied for, the inventor should agree to maintain all relevant details of IP secret and confidential until the patent application has been filed.

The University will also allow the inventors to commercialize their IP through third parties who may or may not be the joint inventors through the grant of exclusive/ non-exclusive licenses, or assign its ownership rights to third parties/ inventors safeguarding the interests, financial or otherwise, of the University. The receiving institute / company and Panjab University will sign a license agreement to utilize the IP for promoting research and education.

When a third party is interested in commercializing an item of IP after inspecting the

relevant Technology Profile, they may apply to the Director, CIIPP with the deposition of the required fee for transfer of the technology. They will be required to demonstrate their capacity to commercialize the technology to the University's satisfaction. The University will then require the third party to sign contractual confidentiality or secrecy agreements undertaking to maintain the confidentiality of all information disclosed, before any further disclosure is made.

Third parties must obtain express authorization writing from the University to commercialize/exploit the IP. Confidentiality agreements will continue in force even if the commercialization process is aborted at any stage. However, it is recommended that no disclosure should be made by third party, if there is any doubt as to the outcome of the commercialization process.

All such licensing agreements or assignments in particular where the third party is also the inventor, would be carefully examined by the University to determine that no conflict of interest will occur as a result of their ratification. The third party when interested in any such transfer of rights must demonstrate technical and business capability to commercialize the IP.

The costs of transfer of interest/ right/ ownership and maintenance of rights in the University-owned property by way of license, assignment or otherwise devolution of rights for such purposes will be borne exclusively by the licensee, assignee, and person acquiring such rights. The University may under special circumstances retain a non-exclusive royalty-free license to use the property for teaching and research.

The assignment or license may be subject to additional terms and conditions, such as revenue sharing with the University or reimbursement of the cost of statutory protection, when justified by the circumstances of development of the IP licensed. If the University finds that the third party has not taken steps to commercialize the property within one year of acceptance of the license, the University will be free to revoke the license.

4.8. IP PROTECTION, LICENSING AND TECHNOLOGY TRANSFER

4.8.1. Procedure of IP Protection

All employees (Faculty/Researchers/Staff) and students desirous of filing a patent application in connection with an innovative work done by them should follow the procedure outlined below:

- a) Forward a proposal prepared by the concerned investigator/inventor to the Director, CIIPP, outlining the wish to file a patent application with the main highlights of the invention requesting to forward the application to the Patent Information Centre (PIC) of Punjab State Council for Science & Technology (PSCST), Chandigarh for prior-art search (novelty search). This is a paid service and attracts a fee of Rs. 1500/- from Graduate & Post Graduate Degree Colleges, Government Department and Individuals and Rs. 2500/- from Universities, Engineering Colleges, other Institutions of higher learning and Industry. The investigator/inventor will have to submit the required fee in the form of a demand draft in favour of Punjab State Council for Science & Technology payable at Chandigarh or may deposit the same in cash in accounts wing of PSCST, along with the request for a patentability search. The same will be reimbursed by CIIPP after getting a request from the inventor on submitting the original receipt issued by PIC, PSCST.
- b) The application will be processed by the office of Director, CIIPP as per the IPR Policy of the University.

- c) The director will forward the application in a sealed envelope to Patent Information Centre (PIC) of Punjab State Council for Science & Technology (PSCST), Chandigarh for a patentability search/prior-art-search.
- d) The report generated by PIC, Punjab State Council for Science & Technology, Chandigarh will be forwarded directly to the inventor(s) and Director CIIPP in sealed envelope only.
- e) The IPR Cell will assess the application, based on a feedback from the PIC, PSCST, Chandigarh.
- f) If the work is recommended for patenting by the University, the applicant will be requested to have further discussion with the patent attorney/PIC, PSCST for completing formalities for filing the application in India/ abroad.
- g) If the invention fulfills the patentability criteria, then the inventor is allowed to file patent either
 - i. Through PIC, PSCST or
 - ii. Through paid consultants/ agents

In any case, Panjab University will be made as the sole or one of the assignees with the applicants as the inventors. The applications in all the cases will be forwarded by the Director, CIIPP, after getting necessary approval from the Registrar, Panjab University, Chandigarh.

Patent filing through PIC, PSCST, is free of cost and all the charges are borne by Technology Information, Forecasting & Assessment Council (TIFAC), Department of Science & Technology (DST), Government of India. The agency continues to maintain the patent for a maximum of 10 years, on the receipt of information regarding sincere efforts of the inventors to commercialize the invention.

The CIIPP has created separate funds to financially help inventors in IP filings through paid consultants. Expenses upto Rs 50,000 will be borne by the University and the rest has to be managed by the inventor(s). The university will finance maximum two patents per faculty member per year. The financial assistance is open to meet any expenses incurred towards patent filing including filing fee, attorney fee towards patent drafting or replying to examiners objections, patent examination fee, microbial culture deposit fee, maintenance fee etc. The funding will be made available only to those innovators who route their patent related documents through CIIPP and don't have any financial assistance available with them and whose innovation has some commercial value as per the recommendations of the advisory committee of IPR cell. The funding can also be made available to the inventors from the affiliated colleges of Panjab University in obtaining IPR in which Panjab University is one of the assignees.

4.8.2. Market Evaluation and Licensing

It is essential that any patentable invention should be analyzed for its industrial relevance and commercial potential. The inventors should answer the following questions before initialing market evaluation, licensing and technology transfer:

- a) Does the technology offer a cheaper and/or a better way of accomplishing something?
- b) Are there competing technologies available and if so how much better is the invention?

- c) Does the invention provide a technological answer to an existing problem?
- d) Does it have the potential for creating a new market?
- e) How much investment, in both time and money, will be required to bring the invention to the market place?
- f) Will the inventors continue to work on the invention?
- g) What will be the potential pay-off for a company that makes an investment in the development of the invention?

4.8.3. **Technology Transfer**

The inventor(s) may contact potential licensee(s) by maintaining confidentiality and taking all necessary care so as not to affect the value of the IP through appropriate agreements such as Non-Disclosure Agreement (NDA) with the potential licensee(s) during technology marketing discussions. The CIIPP may also organize specific industry interactions for helping the inventors in showcasing their IPs and may contract the IP to Technology Management Agencies (Government/Private), which manage the commercialization of the IP.

4.8.4. **Licensing**

Licenses may be awarded on an exclusive or non-exclusive basis and may provide for payment of license fees, milestones, royalties or other income to the owner of the intellectual property. In case of IP arising out of sponsored research, following guidelines will be followed for licensing:

- a) When the inventor generates an IP at Panjab University, the sponsor will get an option to license the resulting IP on terms to be negotiated on a case-by-case basis. The sponsor has to either accept or refuse its 'first-refusal option' within 90 days of the date of the offer of the option by the University to the sponsor. If the University finds that the sponsor has not taken steps to commercialize the property within one year of acceptance of the option, the University will be free to revoke the license. Confidentiality agreements will continue to apply in that event.
- b) If the sponsor refuses to exercise his or her first-refusal licensing option, the University will proceed to commercialize the IP in such manner as it deems fit.
- c) The University may, at its own discretion, contract with sponsors to allow them specific rights, whether exclusive or non-exclusive, in the IP whose creation they sponsor, if in the University's opinion the granting of such rights will facilitate the commercialization of the IP.

4.9. **REVENUE SHARING**

Any revenue generated from the commercialization of University-owned IP will be shared between the inventor, his or her team and University on the following terms and conditions:

- a) In case the patent filing costs are not borne by the University, the inventor can first deduct the costs incurred in this regard and maintenance of such patents, till licensing, from income accruing from the commercial exploitation of the patent. Excess income beyond such recovered costs will be shared with the University. Any MoU signed by the PU with the sponsoring agency based on which the IP is

- generated, or with any patent filing organization, may set aside the provisions under this clause.
- b) In case there is a third party, the respective shares of the University and inventors will be calculated on the net receipts after deducting the third party's share.
 - c) The net earnings generated by the exploitation of IP will be shared between the Inventor(s) and the University on 70:30 ratio.
 - d) The inventor's share will continue to be paid irrespective of whether or not the individual continues as an employee /student/ research scholar of the University.
 - e) The inventor(s) share would be declared annually and disbursement will be made to the inventor(s), their legal heir, whether or not the inventors are associated with the University at the time of disbursement.
 - f) Co-inventors of IP should sign at the time of disclosure or filing for IP protection, a distribution of the IP earnings agreement, which should specify the proportional percentage distribution of earnings from IP to each co-inventor. The inventor(s) may, at any time, by mutual consent, revise the distribution of IP earnings agreement.
 - g) If there is only one inventor of the IP, the whole amount of inventor's share will be retained by the inventor. If there are more than one inventors, inventor's share will be distributed among the co-inventors on the mutually agreed terms and conditions.
 - h) If there are two inventors, the principal investigator/supervisor/team leader will get upto 60%, while the co-inventor will get atleast 40% of inventor's share by mutual agreement.
 - i) If there are more than two inventors, the principal investigator/ supervisor/ team leader will get upto 60% of inventor's share and the rest will be distributed among the co-inventors in the proportions on the mutually agreed terms and conditions at the time of IP disclosure or at the time of filing for IP protection.
 - j) Students/Project staff may have a share in revenue earned but the share in case of 'work for hire' is not as a right, but may be as an incentive at the sole discretion of the principal investigator or supervisor in consultation with the Director, CIIPP, if the need arises.
 - k) Revenue sharing is not necessarily concurrent with the inventor-ship. Mere assistance like assistance in the preparation and conduct of the experiments, data analysis, etc. does not entitle one for inventor-ship, but may entitle for revenue sharing as an acknowledgement of intellectual contributions for routine/mechanical contribution at the sole discretion of the principal Investigator/ Supervisor of the work.
 - l) If any inventor is unable to be contacted/traced for one year because of lack of information, the revenue corresponding to his/her share will be credited to the IP fund.
 - m) Of the University share, 50% will be used for creating an University's IP fund, which will be utilized for any activity related to commercialization and maintenance of IPR or obtaining IPR in another country, or for capacity building. Further, 10% of the share will be paid to the University as Administrative charges and 40% will be made available to the Department concerned for the purchase of equipments or material or for any academic activity and promotion of industrial partnership.

4.10. INFRINGEMENT, LIABILITY AND INDEMNITY INSURANCE

In case of infringement of any intellectual property right(s) by the PU faculty/technical staff/students/project staff/visitors or any third party, IPR cell would first investigate the matter and make recommendations to the Vice-Chancellor for resolution of such infringement including the need for any disciplinary/legal course of action.

As a matter of policy, the Panjab University shall, in any contract between the licensee and the University, seek indemnity from any legal proceedings in production problems, process efficiency, design guarantee, up-gradation and debugging obligation.

Panjab University shall also ensure that the institute personnel have an indemnity clause built into the agreements with licensees. The University shall retain the right to engage in any litigation concerning patents and license infringements.

4.11. OTHER PERTINENT ISSUES

4.11.1. Publication of Thesis/Project Work, Term Papers and Research proposals

It is possible that the research carried out by students as part of the program of study may result in the generation of IP other than the text of the thesis/project work. Supervisors should advise the students during the course of their work that certain kinds of research may lead to the generation of IP which will require protection of its commercial value through confidentiality, for which the student will have to hold publication/disclosure before the filing of a patent. Care should be taken at all stages to see that no conflict of interest arises between the student's academic activities and the generation of IP.

Where the thesis/project work of a student contains details of commercialisable IP, the University, the supervisor and the student must agree to keep the thesis/project work, in part or whole, and all relevant documents, confidential until the process of securing the statutory protection for the IP is complete. It should be noted that the submission of the thesis/project work for examination does not violate confidentiality because the thesis/project work remains confidential until the examination process is over.

It is to be noted that retention of the hard copy by the University library is essential for meeting the requirements for a degree, and the supervisor and the student must agree to allow the thesis to be made available electronically. On the University's part, the library has a duty to ensure that the use of the texts of thesis held by it is consonant with the laws governing copyright and fair use, as well as sound academic practice.

4.11.2. Deposition of the biological cultures isolated from the environment or genetically modified organisms

All biological cultures, including microorganisms, cell lines, plants and animals, isolated from the environment or genetically modified during the course of study by the students/ research scholars/ Research assistants/ associates/ post doctorate fellows should be the property of the university under the name of the supervisor (s). These cultures should be deposited to the supervisor before getting the clearance from the department. The students cannot use the same for any academic or commercial purpose without the written consent of the supervisor.

4.11.3. Protection of biodiversity and traditional knowledge

Panjab University confirms that it abides by the national laws on biodiversity and traditional knowledge. Inventor(s) has/have to make sure that the conditions under the national laws on biodiversity and traditional knowledge are not breached during the course of obtaining any IP protection or any use of such knowledge.

4.11.4. 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 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 of a patent to a company in which the inventors have a stake should be subject to the approval of the IPR cell body, PU taking into consideration this fact.

4.11.5. Dispute Resolution

In case of any conflict/dispute/grievance between the University and the researchers/inventors/collaborators/sponsors regarding the ownership of IP, the implementation of the IP policy, the aggrieved party may appeal to the IPR Cell body. In case the appellant is not satisfied with the decision of the body, he/she can appeal to the Vice-Chancellor of PU, whose decision shall be final.

4.11.6. Legal Jurisdiction

As a policy, all agreements signed by the University and dispute(s) arising there, will be subjected to the legal jurisdiction of the Punjab and Haryana High Court of Adjudicator at Chandigarh only and should be governed by the appropriate laws of India.

4.11.7. Mandatory Obligations for the Inventors

It would be mandatory for all the researchers/ inventors to make Panjab University as the owner of the IP as per the provisions mentioned in the Policy document and to keep CIIPP in the loop for all the activities related to registration for IP protection and commercialization of IP. If the IP protection is sought by taking the services of paid consultants/ third parties, the same is to be brought into the record of CIIPP by submitting a copy of the documents. Failing to comply with the provisions of the IPR policy may attract a disciplinary action by the University.