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## ARTICLE 1 - PREFACE

### Context

The Institution is committed to ensuring that Intellectual Property (IP) emanating from its Research activities is used in accordance with its legal obligations for the benefit of the Institution, the Creators, and, most importantly, society-at-large.

### Purpose of the IP Policy

**Promotion of IP utilization.** The IP Policy intends to facilitate the widespread use of, through various modalities of access to, the Institution's IP.

**IP management.** The IP Policy seeks to set the framework for translating the IP from the Institution's Research into products, services, and processes. It encourages Staff Members, Students, and Visitors to become Creators and identify IP with potential commercial value. It also establishes clear rules and procedures for the management and Commercialization of such IP generated at the Institution.

**Balance of interests.** The IP Policy seeks to ensure the legal protection, where applicable; effective management and Commercialization of Institution IP; while at the same time not impeding with the traditions of education and scholarship, academic freedom, open and timely publications, Institution sovereignty, and the Institution's mission serving the public interest.

### Overall Principles

The Institution operates under the following overall principles:

**Responsible Commercialization.** Where IP arises with commercial potential as a result of Research, the Institution intends to make such IP available in a form that will most effectively promote its development and use for economic and social benefit.

**Incentives.** The Institution wishes to recognize and reward Staff Members, Students, and Visitors whose IP generates a demonstrable socio- and/or economic impact.

**Local development.** The Institution encourages Research that responds to the local, regional, and national needs.

## ARTICLE 2 - DEFINITIONS

Without prejudice to any applicable laws, in this Policy, the definitions set out below shall apply:

**Appointment.** A formal agreement for a Visitor at the Institution is a prerequisite to participate in or conduct Research, scholarship, creative work, or teaching at the Institution.

**Author.** Any person to whom this Policy is applicable, who individually or jointly with others makes a design, a mark, or copyrightable work, and meets the criteria for authorship under the government of [India's IP laws](#).

**Background IP.** Any pre-existing IP created before the execution of any Research Project, or prior to a Creator becoming subject to this IP Policy, by virtue of Appointment in the case of a Visitor, employment contract in a Staff Member case, or registration in the case of a Student.

**Commercialization.** Any form of utilization of IP intended to generate value may be in the form of a marketable product, process or service, commercial returns, or other benefit to society. **Commercialize** is similarly defined.

**Commercialization Entity.** A company that has access to the IP of the Institution, through any one or more of the available Commercialization modes, to produce new products, processes, or services. This can be a spin-off or start-up.

**Conflict of Commitment (COC).** Any situation in which an individual Staff Member's or Visitor's primary professional loyalty is not to the Institution because the time devoted to outside activities adversely affects their capacity to meet their responsibilities as set out in their employment contract of Appointment, respectively.

**Conflict of Interest (COI).** Any situation in which real or perceived interests of an individual Staff Member, Visitor or Student may run counter to the interests of the Institution or negatively affect their employment or duties.

**Course Materials.** All materials used in, or in connection with, and for the purpose of, teaching an education course through the provision of lectures, tutorials, seminars, workshops, field or laboratory classes, assessments, practicum, and other teaching activities conducted by the Institution; and all IP in such materials.

**Creator.** Any person to whom this Policy is applicable, who creates, conceives, reduces to practice, authors, or otherwise makes a substantive intellectual contribution to the creation of

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IP and who meets the definition of 'inventor', 'author' or 'breeder' as generally implied in the IP laws of Government of India.

**Enabler.** Any assistants, technicians, and other individuals who have indirectly contributed to the creation of IP by Creators - and as such may not be listed themselves as an author or inventor in terms of statutory Intellectual Property Rights (IPRs) - mainly through the execution of standard tasks or following through on specific instructions, but without whose practical contribution the Commercialization would not have been possible.

**Genetic Resources (GRs).** "Genetic material of actual or potential value. Genetic material is defined as "any material of plant, animal, microbial or other origin containing functional units of heredity". Some GRs are linked to Traditional Knowledge (TK) through their use and conservation by indigenous peoples and local communities, often over generations, and through their widespread use in modern scientific Research. Examples include medicinal plants, agricultural crops, and animal breeds.

**Gross IP Revenue.** All revenue received by the Institution on Commercialization of Institution IP before any deductions for IP Expenses, as defined in [Article 10](#).

**Guidelines.** The Guidelines for Customization of the IP

**Institution.** BNM INSTITUTE OF TECHNOLOGY, Bengaluru,560070.

**Institution IP.** IP owned or co-owned by the Institution.

**Intellectual Property (IP).** All outputs of creative endeavor in any field at the Institution for which legal rights may be obtained or enforced pursuant to the law. IP may include:

- a) literary works, including publications in respect of Research results, and associated materials, including drafts, data sets, and laboratory notebooks;
- b) teaching and learning materials;
- c) other original literary, dramatic, musical or artistic works, sound recordings, films, broadcasts, and typographical arrangements, multimedia works, photographs, drawings, and other works created with the aid of Institution resources or facilities;
- d) databases, tables or compilations, computer software, preparatory design material for a computer program, firmware, courseware, and related material;
- e) patentable and non-patentable technical information ;
- g) designs including layout designs (topographies) of integrated circuits;
- h) plant varieties and related information;
- i) trade secrets;
- j) know-how, information, and data associated with the above; and
- k) any other Institution-commissioned works not included above.

**Intellectual Property Rights (IPRs).** The proprietary rights that may be granted for an

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invention, mark, design, plant variety, or other types of IP, should the statutory requirements for protection be met to result in a patent, trademark, registered design, or plant breeders' right, respectively.

**Invention.** An invention is defined as “a new product or process involving an inventive step and capable of industrial application.” Therefore, the criteria for an invention to be patentable are –

- a. It must be novel
- b. It must have an inventive step, and
- c. It must be capable of industrial application.

Further, the invention should not fall under any of the categories of “Inventions- non-patentable” mentioned under Sections (3) and (4) of the [Patents Act, 1970](#).

**Inventor.** Any person to whom this Policy is applicable, who individually or jointly with others makes an Invention and meets the criteria for inventorship under the Indian Patent Law.

**IP Disclosure Form.** The form [provided in [Annexure 1](#)] to be completed by the Creators and submitted to IPMO to document their creation.

**IP Expenses.** All expenses incurred by the Institution in the management and Commercialization of IP for which Gross IP Revenue has been received.

**IP Committee.** The body within the Institution, set up in terms of [Article 4.1](#), is responsible for overseeing the drafting, implementation, monitoring, and evolution of the Policy, and providing strategic oversight of the IPMO.

**IP Management Office (IPMO).** The administrative unit established in terms of [Article 4.2](#), responsible for the day-to-day management of all IP-related activities of the Institution.

**Net IP Revenue.** Gross IP Revenue less IP Expenses.

**Open Educational Resources (OER).** Teaching, learning, and Research materials reside in the Public Domain and have been released under an open license that permits their free use or modification by others.

**Plant Variety.** A homogenous grouping of plants can be protected by a form of plant breeder's right such as that defined in the International Convention for the Protection of New Varieties of Plants<sup>1</sup>.

**Policy.** Intellectual Property Policy

**Public Disclosure.** The communication of information relating to IP to external parties. Public Disclosure includes, but is not limited to, disclosure in written or oral form; communication by email; posting on a web blog; disclosure in a news report, press release or interview; publication in a journal, abstract, poster, or report; presentation at a conference; examination of a thesis; demonstration of an Invention at a trade show; or the industrial application of an Invention.

**Public Domain.** The freely accessible public realm in which works that are not protected by IPRs, either because the rights have been forfeited or because the rights have been expired, is thereby held by the public at large and available for all to use without permission from the Creator or owner.

**Research.**<sup>2</sup> Any creative work undertaken on a systematic basis in order to increase the stock of knowledge, including knowledge of man, culture, and society, and the use of this stock of knowledge to devise new applications. It comprises three activities: basic research, applied research and experimental development.

**Research Contract.** Any type of agreement between the Institution and an external party or research sponsor concerning research could result in IP being created at the Institution. This shall include but is not limited to, all sponsorships, donorship, and collaborations with the external party or research sponsor.

**Research Project.** Any project that forms the basis of Research undertaken by the Institution and includes projects undertaken by a Student, under the supervision of a Staff Member or a Visitor, as part of a research degree program.

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<sup>1</sup> Generally referred to as "[UPOV Convention](#)."

<sup>2</sup> Definition from the [Frascati Manual](#).

**Scholarly Works.** All copyright works which are the outputs of academic Staff Members, Students or Visitors, including Research, creative and other outputs in the area(s) of his/her expertise. It does not include Course Materials and computer software and databases.

**Senior Responsible Officer.** The person at the Institution who has the ultimate decision-making authority regarding IP.

**Staff Member.** Any person under a contract of employment with the Institution includes academic, research, technical, administrative, and adjunct staff, whether full-time or part-time or on a temporary basis.

**Student.** Any student registered for an approved course at the Institution.

**Substantial Use.** Extensive [unreimbursed] use of the Institution's resources which include but are not limited to facilities, equipment, human resources or funds, and Background IP that is not publicly available. Not included in the routine use of libraries and/or office space.

**Trade Secret.** Confidential information not publicly available that has commercial value because of its confidential nature, and which the owner has taken reasonable efforts to keep secret.

**Traditional Knowledge (TK).** A living body of knowledge resulting from intellectual activity in a traditional context, which includes know-how, practices, skills, and innovations. TK embodies the traditional lifestyles of indigenous peoples and local communities and is transmitted from generation to generation, often forming part of the cultural and spiritual identity of the community. TK is not limited to any specific technical field, and may include agricultural, environmental, and medicinal knowledge. TK also often encompasses knowledge associated with Genetic Resources.<sup>3</sup>

**Visitor.** Any person who is neither a Staff Member nor a Student of the Institution who engages in work at the Institution, including visiting professors, adjunct and conjoint professors, teachers, researchers, scholars, and volunteers; and who concludes an Appointment agreement with the Institution.

## ARTICLE 3 – SCOPE OF THE POLICY

**IP.** This Policy applies to all IP generated at the Institution, in particular by Staff Members, Students, and Visitors.

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<sup>3</sup> There is not yet an accepted definition of "traditional knowledge" at the international level. The proposed definition is provided for the purposes of understanding.

**Background IP.** Upon commencing employment, enrolment, or an Appointment, Staff Members, Students, and Visitors must declare any existing IP they wish to exclude from the application of this Policy due to creation prior to their employment, enrolment, or Appointment at the Institution.

**Applicability.** This Policy applies to all Staff Members, Students, and Visitors who participate in a Research Project or produce Scholarly Works. Rights and obligations under this Policy shall survive any termination of employment, enrolment or Appointment at the Institution.

**Binding effect of the Policy.** This Policy constitutes an understanding that is binding on the Institution, Staff Members, Students, and Visitors, once adopted by the Board or Management of the Institution, on the following grounds:

**Staff Members.** The Institution shall ensure that the employment contract or other agreement establishing any type of employment relationship between the Institution and Staff Members includes a provision placing Staff Members under the scope of this Policy.

**Students participating in a Research Project.** The Institution shall ensure that Students participating in a Research Project sign an agreement before commencing the project, to the effect that they have read and will comply with the provisions of this Policy, according to [Article 5.2.5](#).

**Visitors.** The Institution shall ensure that Visitors sign an Appointment agreement before commencing any activity at the Institution. Such agreement shall place the Visitor under the scope of this Policy and shall make reference to this Policy, a copy of which will be made available to the Visitor.

**Informed consent.** This Policy shall be included on the Institution's website, the college calendar, the Title of faculty handbook, and the Title of student handbooks. In addition, a reference to this Policy shall be made in the terms and conditions of enrolment of Students, academic catalogs, or their equivalent. Said reference shall be sufficient to enable the full text of the Policy to be easily accessed.

## ARTICLE 4 – GOVERNANCE AND OPERATION

### 4.1 IP Committee

**Purpose.** The Institution shall establish an IP Committee to oversee the implementation and evolution of this Policy and provide strategic guidance to the IPMO (according to [Article 4.2](#) below).

**Composition.** The IP Committee shall consist of management, representatives from each department, and, chaired by the management or their designated other.

**Responsibilities.** The IP Committee is the ultimate decision-making body in the determination of IP management and Commercialization strategy for a particular IP.

**Meetings.** The IP Committee shall establish regular meetings and also be available for *ad hoc* meetings.

### 4.2 The IP Management Office (IPMO)

**Purpose.** The Institution shall establish an IP Management Office (IPMO) or designate a function within the Institution or another organisation to act as such, to assist the Institution in managing and Commercializing its IP in a form that will most effectively promote its development and use for economic and social benefit.

**Responsibilities.** The responsibilities of the IPMO shall include, but are not limited to:

- a. Outreach/awareness to Creators;
- b. Relationship management with Creators;
- c. IP management;
- d. Technology marketing and IP contract negotiation;
- e. IP contract management; and
- f. IP costs and revenue distribution.

## ARTICLE 5 - OWNERSHIP OF IP AND RIGHTS OF USE

### 5.1 IP Created by Staff Members

**Institution ownership.** The Institution owns all IP created by a Staff Member in the course and scope of his/her employment; or making Substantial Use of the Institution's resources.

**Staff Member ownership.** Staff Members will own/co-own the IP they have created when such IP:

- a. is outside the course and scope of their employment and without Substantial Use<sup>4</sup> of the Institution's resources;
- b. vests in Scholarly Works (see [Article 5.5](#));

**IP emanating from Research Contracts.** In the absence of provisions to the contrary in any national law or where there is no Substantial Use of the Institution's resources, the terms of the Research Contract will regulate ownership of IP created by Staff Members in the course of a Research Project that forms part of a Research Contract, as set out in [Article 7](#).

**Appointment of Staff Members at another Institution.**<sup>5</sup> It is the responsibility of each Staff Member that holds an honorary or other academic or research appointment at another institution (Host Institution) to bring to the attention of the Host Institution, including its IPMO, his/her obligations in terms of this Policy, prior to the tenure at the Host Institution. To the extent that the Host Institution's IP Policy makes a claim on IP created by the Staff Member pursuant to such appointment, the Staff Member shall ensure that the Host Institution negotiates a suitable IP arrangement with the Institution.

## 5.2 IP Created by Students

**5.2.1 Student ownership.** The Student will own IP created by a Student in the course of study at the Institution (including theses, dissertations and other Scholarly Works). This is in contrast to IP created by a Student in a Research Project, as per [Article 5.2.3](#) below.

### **Thesis or dissertations.**

- a. The Student must submit his/her final thesis or dissertation to the Institutional repository.
- b. The Student must grant a royalty-free license to the Institution to reproduce his/her thesis or dissertation and distribute copies thereof to the public.<sup>6</sup>

**5.2.2 Institution ownership.** IP emanating from a Student's Research Project shall be owned by the Institution in the following circumstances:

- c. if the IP is created by making Substantial Use of the Institution's resources (excluding supervision) and there is no re-imbursement agreement concluded between the Institution and the Student; or

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<sup>4</sup> Use will be deemed not Substantial if minimal overhead costs have been incurred by the Institution (such as the use of office space, the library, facilities or traditional desktop computers); only a minimal amount of time has been spent using significant Institution facilities; or the IP has been written or developed in the personal (unpaid) time of the Creator.

<sup>5</sup> This means that such Staff Members are a visitor at another institution.

<sup>6</sup> The Institution reserves the right to retain the original or copy of any theses, and a license as described in Article 5.2.2. Such retention does not affect any copyright or other IP right that may exist in such theses.

- d. if the Research carried out by the Student forms part of the Institution's Research Projects.

**5.2.3 IP emanating from Research Contracts.**<sup>7</sup> The terms of the Research Contract shall regulate the ownership of IP created by a Student in the course of such Research Contract, as set out in [Article 8](#).

**5.2.4 Institution ownership responsibilities.**<sup>8</sup> If the Institution is the owner of IP created by a Student, in terms of [Article 5.2.3](#) or [Article 5.2.4](#), and hence created in terms of a Research Project or Research Contract, respectively, the Institution shall:

- a. provide the Student with an explanation of the reasons for the assignment of IP rights to the Institution;
- b. advise the Student to seek independent advice regarding the assignment;
- c. obtain a deed of assignment from the Student for all IPRs emanating from the Student's Research Contract or Research Project, where relevant, in return for revenue sharing as provided for in [Article 10](#); and
- d. withdraw the Student from the Research Project or Research Contract if a Student elects not to assign the relevant IPRs to the Institution.

**5.2.5 Bursaries/scholarships.** An external party that grants a bursary or scholarship to a Student may elect to own the IP created by that Student in the course of his/her study at the Institution provided the Student and the Institution have consented to the assignment of IP ownership in writing and such consent is not contrary to any applicable local or national law.

**5.2.6 Student Owned IP.** IPMO may, upon agreement, provide Commercialization services to Students for their IP. The following options may be explored and dictated by the Institution.

- a. In this event, Students may be required to assign their IP to the Institution and will be afforded the same rights and obligations as Staff Members under this Policy.
- b. In the absence of an assignment of the IP to the Institution, the Students and IPMO may agree on the specific Commercialization services required,
- c. at no cost to the Student;
- d. in exchange for an agreed fee being paid to the Institution
- e. sharing of Commercialization revenues accruing to the Students.

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<sup>7</sup> That is, if the Student is participating in a Research Project under a Research Contract between the Institution and an external entity or research sponsor.

<sup>8</sup> See also Article 3.4.2 of this Policy.

### 5.3 IP Created by Visitors

**5.3.1 Institution ownership.** Unless otherwise agreed to in writing by the Institution and the Visitor's home institution prior to the tenure at the Institution, Visitors are required to assign to the Institution any IP:

- a. created in the course and scope of their Appointment at the Institution; or
- b. created by making Substantial Use of the Institution's resources.

**5.3.2 Institution IP.** On departure from the Institution, a Visitor must sign and submit to IPMO an IP Disclosure form disclosing any IP created, as per [Article 5.3.1](#), whilst at the Institution.

### 5.4 Special Rules for Course Materials

**5.4.1 Institution ownership.** The Institution will own the IP in Course Materials created by a Staff Member or a Visitor, with the exclusion of Course Material that is created from or for Open Educational Resources, in accordance with [Article 5.7.1](#).

**5.4.2 Licensed by the Institution.** The Institution grants the Creators of Course Materials a royalty-free, non-exclusive license to use the Course Materials created by them for teaching and research purposes at the Institution. With the express prior written permission of the Institution, such licence may be utilised for commercial purposes outside the Institution].

### 5.5 Special Rules for Scholarly Works

**5.5.1 Publication.** The Institution recognises and endorses the rights of Staff Members, Students and Visitors to publish their Scholarly Works, provided that any Scholarly Work which may disclose any possible Institutional IP shall first be cleared by IPMO after having an opportunity to protect such Institutional IP according to [Article 8](#).

**5.5.2 Institutional repository.** Staff Members, Students, and Visitors should endeavor to obtain publishers' permission to include published Scholarly Works in the Institutional repository [whether as a published edition or in pre-publication form].

**5.5.3 Licensed to the Institution.** Staff Members, Students, and Visitors shall grant the Institution a non-exclusive, royalty-free license to use their Scholarly Works for the Institution's [administrative, promotional,] Research and teaching purposes.

### 5.6 Moral Rights

**5.6.1 Recognition.** The Institution undertakes to respect and protect the moral rights that copyright law confers on Authors of copyright works.<sup>9</sup>

**5.6.2 Rights granted.** The Institution acknowledges that moral rights vest in Authors of

copyright works irrespective of the copyright ownership thereof and include:<sup>10</sup>

- a. the right of attribution of authorship in respect of the copyright works;
- b. the right not to have authorship of the copyright works falsely attributed; and
- c. the right of integrity of authorship in respect of the copyright works.

**5.6.3 No waiver.** The Institution will not require Staff Members, Students, or Visitors to waive their moral rights as a condition of employment, enrolment, Appointment, or funding.

### 5.7 Public Domain

**5.7.1 Public Domain.** Institution IP forms part of the Public Domain in the following circumstances:

- a. if a Research Contract provides that the Research results be placed into the Public Domain; or
- b. if Staff Members or Visitors use OERs or resources licensed through Open Source and the licensing conditions, require the release of derivatives into the Public Domain.

**5.7.2 Release into the public domain.** The Institution will release IP into the Public Domain in the following circumstances:

- a. where it is deemed to be in the public interest;
- b. if the IP has low commercial or other development potential and low prospects of fostering the development of new products or services; or
- c. if deemed necessary by the Institution.

## ARTICLE 6 – PUBLICATION, NON-DISCLOSURE AND TRADE SECRETS

**6.1 Right of publication.** The Institution encourages and supports the right of Creators to decide if and when to publish their research results, in accordance with [Article 5.5](#) above.

**6.2 Non-disclosure for IP protection.** In conjunction with the right of publication, Creators should be aware that premature Public Disclosure may result in loss of IP

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<sup>9</sup> As per the National Copyright law.

<sup>10</sup> The list of rights granted needs to be adapted to the moral rights recognized in national laws.

protection rights<sup>11</sup>. Therefore, they are strongly encouraged to make all reasonable efforts to identify any protectable IP as early as possible, according to [Article 8](#), and shall consult IPMO before making any Public Disclosure of potential Institution IP or exercising their academic freedom rights.

**Trade Secrets.** The Institution may designate certain confidential information as a Trade Secret, owned by the Institution. In that event, all Creators will be obligated to maintain the secrecy of the Trade Secret and follow the direction for managing the Trade Secret by IPMO.

## ARTICLE 7 – RESEARCH CONTRACTS

**Authority.** Staff Members, Students and Visitors shall not have the right to enter into a Research Contract with external parties on behalf of the Institution unless they are authorized to do so by an official representative of the Institution.

**Research Contract Policy.** All Research Contracts must be executed and performed in compliance with the [BNMIT Research Policy](#).

**Due diligence.** Persons acting for and on behalf of the Institution shall exercise all due diligence and consult IPMO when negotiating and signing contracts that may affect the Institution's IPRs.

**Government rules.** Research Contracts shall comply with any applicable law and/or Government regulations and/or rules, which may be applicable to Research undertaken by the Institution, in particular, as far as it relates to the ownership of IP resulting from such Research. The appropriate legal representative of the Institution will be consulted in this respect before signature of any Research Contract unless this responsibility has been delegated to IPMO by the Institution.

**Approval.** Proposed Research Contract and other legal statements concerning the Institution's IPRs shall comply with the provisions of this Policy. Any variance from this Policy must be approved by the Management of BNMIT.

Before signing, the full copy of the proposed Research Contract and other legal statements concerning the Institution's IPRs shall be submitted to IPMO for advice and approval by the Management of BNMIT, unless this responsibility has been delegated in writing to IPMO by the Institution.

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<sup>11</sup> Patents provide protection for technical inventions but there are strict procedures and rules which must be followed. A patent cannot be granted if the invention has already been disclosed and so care must be taken to avoid premature disclosure before the patent application has been filed.

**Basic Principles.** The IP clauses in all Research Contracts shall be governed by the following basic principles:

**Concluded from the outset.** A Research Contract must be executed in writing and signed by the Institution and the external party(ies)/sponsor(s) prior to the commencement of any Research Project and, as appropriate and without limitation, must contain terms relating to ownership, management, and use of IP arising from the Research Project as well as any Background IP.

**Background IP.** All Institution Background IP must be properly recorded and declared prior to the commencement of a Research Contract and belongs to the Institution. Similarly, the Background IP of the external party/sponsor, belongs to such party or sponsor. Use of such Background IP requires express written permission.

**Foreground IP (IP arising from the Research Contract).** IP generated pursuant to a Research Contract by Staff Members, Students or Visitors shall be governed in terms of the above provisions relating to IP generated by these parties. The general rule is that such IP shall be owned by the Institution.

### **Co-owned Foreground IP.**

- a. **Terms for co-ownership.** Co-ownership of IP generated pursuant to a Research Contract shall be in accordance with national legislative provisions, failing which, as per the percentage of IP created by the Institution and the external party(ies)/sponsor(s)], OR in an equal, undivided manner OR as mutually agreed contractually.
- b. **Costs for protecting and maintaining co-owned IP.** The costs for protecting and maintaining any IPRs shall be shared between the Institution and the external party(ies)/sponsor(s) OR in accordance with the percentage of IP ownership OR in an equal manner OR as mutually agreed contractually.

**Serendipitous IP<sup>12</sup>.** Any IP created during the course of the Research Contract which falls outside of scope of the Research Contract shall be owned by the Institution or the external party(ies)/sponsor(s) which developed such IP, unless agreed contractually otherwise in the Research Contract.

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**Right of first refusal to the IP.** The Research Contract may include provisions giving the external party(ies)/sponsors a right of first refusal to Commercialize the IP emanating from the Research Contract through a license or joint venture arrangement or assignment.

<sup>12</sup> Results are serendipitous when research that was originally funded for one purpose turns out to be useful for another purpose.

**Publication delay.** It is the strict policy of the Institution to allow Creators freedom to publish their work. However, the Institution acknowledges that delays in publication for the purpose of initiating statutory protection of the IP is often necessary. In this regard, the Institution will agree, on a case-by-case basis, to a contractual delay in publication by Creators. Such delay will not exceed typically 90 calendar days from the date IPMO is notified of the intent to publish, unless authorized by the Management of BNMIT. [IPMO may, if so required, will facilitate the signing of a non-disclosure agreement by the journal appointed peer reviewers, such that review of the article for publication can proceed while the necessary procedures are being followed for IP protection.]

**Use of the IP for Research and teaching.** In instances where the Institution IP is licensed exclusively or assigned as part of the Research Contract, all efforts should be made to secure a royalty-free license for the use of the IP for on-going Research and teaching purposes.

**Exceptions to the Policy.** In certain cases, it may be necessary and/or beneficial to the Institution to enter into a Research Contract that contains exceptions to the provisions of this Policy

## ARTICLE 8 – DETERMINATIONS BY THE IPMO

### 8.1 Responsibility to Disclose IP

**Recording.** Creators shall keep appropriate records of their Research in accordance with the Institution's applicable policy procedures and make reasonable efforts to ensure that only those individuals within the Institution who have a need to have access to such records for the performance of their duties are granted such access.

**IP Disclosure.** Where a Creator identifies potential IP resulting from his/her Research [or that of his/her team], he/she shall promptly disclose such potential IP to IPMO through an IP Disclosure Form [[Annexure 1](#)].

**Complete disclosure.** Creators must provide to IPMO such full, complete, and accurate information as IPMO may reasonably require to enable it to sufficiently assess the technical and related features and functions, ownership, commercial potential, and IP protection that might be applicable to such IP. Upon complete disclosure, the IP Disclosure will be registered and assigned a reference number, and IPMO will share this reference number (Docket number) with the Creators to signify that the Institution has formally received the IP Disclosure.

## 8.2 Creatorship and Ownership

**8.2.1 Creatorship.** Creators shall, upon request, sign the appropriate legal documents provided by IPMO that attest to creatorship. Where there is more than one Creator, and there is a dispute as to the contribution to creatorship, IPMO shall in consultation with the Creators, assist in the determination of the percentage IP creatorship, failing which it shall be assumed that there was an equal, undivided contribution.

**8.2.2 Ownership.** Once creatorship has been determined, the Creators shall be required to formally assign any right, title or interest they may have in that IP to the Institution in the form of a contract that specifies the rights that will accrue to the Creator(s) and the Institution and the obligations they will have to assist the Institution with the Commercialization of that IP. [Article 9.3](#) will apply.

## 8.3 Determination as to IP Protection and Commercialization

**8.3.1. Evaluation and recommendation.** IPMO will analyze the information disclosed in the IP Disclosure within 60-90 days of formal receipt. The analysis will include: whether or not the subject matter is protectable as IP; an assessment of economic viability or marketability; and determination of any rights of external parties, such as a funder or collaborator. After evaluation, IPMO will prepare a preliminary report with findings that enable the Institution to decide if it will proceed with IP protection and Commercialization. IPMO shall share the preliminary report with the Creator(s), and seek their input.

**8.3.2 Decision to protect/Commercialize.** The Institution will decide whether or not it wishes to protect and/or Commercialize the IP as soon as reasonably practicable. IPMO will use all reasonable efforts to notify the Creator(s) of the Institution's decision within 60-90 days of formal receipt of the IP Disclosure. IPMO will also make a determination in relation to the validity of any claim made by a Staff Member, a Visitor, or a Student that they are the true Creator(s) of that IP and in relation to their rights under this Policy.

**8.3.3. Institution's obligation to notify Creators of its decision.** Within no more than 60-90 days, IPMO will notify the Creator(s) of the decision of whether the Institution will or will not pursue IP protection and Commercialization of their IP Disclosure.

## 8.4 Institution Elects not to Protect /Commercialize the IP

**8.4.1 IP abandoned or not Commercialized.** The Institution reserves the right not to protect or Commercialize IP that it owns if after consultation with the Creators:

- a. there is no reasonable prospect of commercial success;
- b. it is not deemed to be in the best interest of the Institution; or
- c. it is not deemed to be in the public interest.

**8.4.2 Transfer of Ownership.** In the event the Institution decides not to pursue IP protection and/or Commercialization, it will take steps to return said IPRs to the Creator(s), contingent on any other superseding contract rights of the external party(ies)/sponsor(s).

**8.4.3 Written notification.** If the Institution is unable to or decides not to protect or Commercialize the Institution IP, it should notify the relevant Creator(s) of its decision in writing and in a timely<sup>13</sup> manner.

**8.4.4 No prejudice to IP protection.** The Creator(s) should receive the written notification in a timely manner that enables the relevant Creator(s) to take any formal steps to ensure the protection of IP, should they so desire.

**8.4.5 Assignment.** If the Creator elects to take an assignment of the IP, the Institution shall ensure that a deed of assignment is executed without delay.

**8.4.6 Terms and conditions.** If the Institution assigns IPRs to the Creator in terms of this [Article 8.4.5](#), the assignment may be subject to one or more of the following terms and conditions:

- a. that upon Commercialization, the Institution be compensated for any expenditure it may have incurred in connection with the protection and/or Commercialization of such IP; and/or
- b. that the Institution be granted a non-exclusive, royalty-free licence to use the IP for Research and teaching purposes.

## ARTICLE 9 - COMMERCIALIZATION OF IP

**9.1 Determination of the Commercialization Strategy.** Within 3-6 months of the decision to protect or Commercialise the IP under [Article 8.3.2](#), the Institution will determine the most appropriate Commercialization strategy with input from the Creators.

**9.2 Assistance to IPMO.** Creators of IP which has been selected for IP protection and Commercialization by the Institution must provide IPMO with all reasonable support in the assessment, protection (including preventing premature disclosure and

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<sup>13</sup> "Timely" means sufficient to not cause the loss of IP rights by failure to act.

execution of any documents including deeds of assignment and deeds attesting to creatorship), and Commercialization of the IP.

**9.3 Sovereignty and Cooperation.** The Institution shall have the sole discretion regarding the Commercialization of IP owned by it. Notwithstanding, the Institution will ensure that reasonable efforts are made to keep the Creators informed and, where appropriate, involved in the Commercialization of the IP to which they contributed. The Commercialization of Institution IP will be planned, executed, and monitored by IPMO.

**9.4 Commercialization Pathways.** Modes of IP Commercialization may include:

- a. license, either exclusive or non-exclusive, and variations thereof.
- b. assignment (sale).
- c. formation of a Commercialization Entity to which the IP is licensed or assigned in terms of this Policy;
- d. non-profit use or donation;
- e. joint ventures;
- f. royalty-free access on humanitarian or other grounds; or
- g. various combinations of the above.

**9.5 Guidelines.** Regardless of the mode of IP Commercialization, the transaction will be executed in a contract which:

- a. protects the interests of the Institution, its Staff Members, Students and Visitors;
- b. retains rights for the Institution to use the IP for educational and research purposes;
- c. assures that the IP will be utilized in a manner that will serve the public good;
- d. assures that the IP will be developed and brought to the marketplace as useful goods and services; and
- e. prohibits the “shelving” or “mothballing”<sup>14</sup> of the IP or its use in any illegal or unethical manner.

The Institution will endeavor to Commercialize IP in a manner that enhances local, regional, and national economic development.

The Institution will endeavor to Commercialize IP in a manner that encourages and fosters entrepreneurship by Staff Members and others and which supports Commercialization Entities.

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<sup>14</sup> Shelving or mothballing of academic IP refers to IP and invention disclosure bundles that remain unexplored, unlicensed or unused.

## ARTICLE 10 - INCENTIVES AND DISTRIBUTION OF REVENUES

### 10.1 The Institution's Incentive Structure

**Purpose and scope.** In the interest of promoting knowledge transfer, the Institution will give due consideration to incentives to researchers to foster Research that has a socio-economic impact; such incentives may be financial or non-financial. A Creator/Enabler may receive incentives from each IP they created/enabled, which is Commercialized.

### 10.2 Sharing of Revenues

**10.2.1 General.** The Institution will award Creators/Enablers in the sharing of monetary benefits that may accrue to the Institution from the Commercialization of Institution IP.

**10.2.2. Calculation of revenues for distribution.** Calculation of Gross IP Revenue, IP Expenses, and Net IP Revenue shall be in accordance with the following rules:

**10.2.2.1 Calculation of Gross IP Revenue.** "Gross IP Revenue" is defined in [Article 2](#) as "*all revenue received by the Institution for Commercialization of Institutional IP before any cost recovery or deductions for IP Expenses*" and includes, but is not limited to, outright sale of IP, option payments received, licence fees received, evaluation fees received, upfront and milestone payments received, royalty payments received, share of profits received, dividends received, commissions, income through disposal of equity, and direct sale of products or services.

**10.2.2.2. IP Expenses.** "IP Expenses" is defined in [Article 2](#) as "*all expenses incurred by the Institution in the management of IP for which Gross IP Revenue has been received*" and includes, but is not limited to, those expenses that relate to (i) the Institution's expenses incurred by payment to external entities for securing, maintaining and enforcing IP protection, such as patenting and litigation expenses; (ii) costs incurred by the Institution in the licensing/assignment of IP, including marketing costs, contract negotiation, and drafting costs; and (iii) costs in making, shipping or otherwise distributing products, processes or services that embody the particular IP, but not including staff time or general administrative costs.

**10.2.2.3 Calculation of Net IP Revenue.** IPMO shall maintain accurate and transparent documentation of IP Expenses incurred for a particular IP and

shall be entitled to cover all IP Expenses it has incurred, as set out in 10.2.2.2 above. The “Net IP Revenue” is calculated as the Gross IP Revenue less IP Expenses.

**10.2.2.4 Co-owned IP.** Where the IP is co-owned by the Institution and an outside organization, the Gross IP Revenue received by the Institution will be shared in accordance with a pre-determined formula as per a contractual arrangement. Thereafter, the Gross IP Revenue received by the Institution and the Net IP Revenue will be determined, and revenues will be shared in accordance with section 10.2.3.1 and 10.2.3.2 below.

## 10.2.3 Sharing of revenues – Creators/Enablers

### 10.2.3.1 Standard Creator’s share.

60% of the Net IP Revenue will be allocated to the Creator. Where there is more than one Creator, the Creators are entitled to an equal or *pro rata* share, based on contribution, of 60% of the Net IP Revenue, except where there is a prior written agreement between all the Creators to the contrary.

### 10.2.3.2 Standard Enabler’s share.

Creator(s) may, at their joint sole discretion, choose to provide for Enablers to receive a share of the Creator(s)’ portion of the Gross or Net IP Revenue. This arrangement must be agreed to in writing by all Creators, if more than one.

**10.2.3.3 Disputes.** In the event of a dispute or uncertainty regarding the Creators’/Enablers’ share of the Gross or Net IP Revenue from a specific IP, the issue shall be brought for resolution to the IP Committee.

**10.2.3.4 Payment.** Payment to the Creators/Enablers will be made by the Institution on a periodic basis as agreed in writing, but no later than twelve months after receipt of the Gross IP Revenue by the Institution.

**10.2.3.5 Taxes.** Payments made as per 10.2.3.4 are subject to personal tax<sup>15</sup>. The Institution may, if so obliged by national tax laws, make any applicable tax deductions before making payments to the Creators/Enablers.

**10.2.3.6 Entitlement.** Creators/Enablers and their heirs will be entitled to IP revenue sharing for as long as the Institution receives Gross IP Revenues from Commercialization of the Institution IP. The entitlement to a Creator’s/Enabler’s share of Gross or Net IP Revenue shall survive any resignation/termination of employment.

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<sup>15</sup> National law tax

**10.2.4 Banking details.** The onus is upon each Creator/Enabler to ensure that the Institution has their current banking details for the purpose of revenue sharing. The Institution will keep the relevant IP revenue amounts in reserve for a maximum period of 3 (three) years after which all rights of Creators/Enablers to receive such payments will be forfeited. If the Institution pays an amount into an incorrect account as a result of information supplied to it being outdated or incorrect, the Institution will not have any further obligation or liability in respect of such payment, which will be deemed to have been duly and properly made.

**10.2.5 Sharing of revenues – Institution.** The Institution's share of Net IP Revenue is distributed internally as follows:

- 5% for further Research;
- 5% to IPMO;
- 20% for further IP prosecution and maintenance costs; and
- 10% to institutional overheads.

### 10.3 Other Incentives

**10.3.1. General.** As a default position, the Institution will refrain from accepting non-monetary benefits for the Commercialization of its IP or from offering incentives other than revenue sharing, unless they are in addition to the revenue sharing as per 10.2.3.1 and 10.2.3.2, as appropriate. The Institution will thus give consideration, on a case-by-case basis, to the provision of other incentives, where monetary benefits (revenues) are not available or where the Creator/Enabler elects to choose other benefits *in lieu of* revenue sharing, which may only be realized in due course. Other incentives will include, but are not limited to, the incentives described in Article 10.3.2.– 10.3.4.

**10.3.2 Growth, development and acknowledgement.** A framework for growth and development of the Creator/Enabler in their professional and personal capacity shall be developed, including (i) recognition of IP generation and Commercialization performance in appraisal procedures; and (ii) opportunities for enterprise development or capacity development through, for example, specific training opportunities, sabbaticals, and local and international exchanges in their relevant Research field or in the field of IP management and knowledge transfer.

**10.3.3 Research funds.** The Institution will actively, through its IPMO, promote, source and/or facilitate collaborative arrangements with industry partners to secure funding for further Research for the Creators/Enablers.

### **10.3.4 Creator/Enabler receiving shares in a Commercialization Entity or other licensee.**

10.3.4.1 In the case where a Creator/Enabler is granted equity in a Commercialization Entity that licenses the Institution IP which the Creator/Enabler has created, <sup>16</sup> such Creator's/Enabler's portion in the standard revenue sharing formula of Article 10.2.3.1 or 10.2.3.2 will be adjusted accordingly, taking into account the shares held in the company by the Creator/ Enabler. All other Creators/Enablers will be rewarded in accordance with the formula in Article 10.2.3.1 or 10.2.3.2.

10.3.4.2 Where the Institution receives shares in a licensee company, which company may be a Commercialization Entity, as consideration for an IP license, the Institution will hold all the shares until liquidation, at which time the income will be considered Gross IP Revenue and the Creators/Enablers will receive their share according to the revenue sharing formula in Article 10.2.3.1 or 10.2.3.2.

10.3.4.3 Notwithstanding the benefit sharing in respect of shares in terms of this Article 10.3.4, the Creators/Enablers will still be entitled to their share of any other revenues under the IP license.

## **10.4 Contact Details**

**10.4.1 Contact details.** The onus is upon each Creator/Enabler to ensure that the Institution is in receipt of their current address details for the purpose of revenue sharing. Unless contrary to law, should the Institution be unable to locate the Creators/Enablers through reasonable efforts, in order to effect payment of the revenue share amount, and a period of 5 (five) years has passed since an initial attempt, then the portion owed to that Creator/Enabler or his/her heirs will be paid to the Institution's central fund to be used to support Research and innovation activities.

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<sup>16</sup> The institutional policy regulating Conflict of Interests must be consulted to assess additional measures that should be put in place especially when the researcher outsources research to the spin-off or start-up company, in which the researcher has a material interest.

## ARTICLE 11 - IP PORTFOLIO MAINTENANCE

- 11.1 Recording and monitoring.** IPMO [or an external entity designated by the IPMO] shall maintain records of the Institution's IP in an appropriate form and in sufficient detail. It shall monitor the deadlines for the payment obligations related to the maintenance or annuity fees of protected IP, and shall, within a reasonable time, inform the person or department designated to make such payments.
- 11.2 Accounting.** IPMO shall maintain income/expense accounting records on each IP so that revenue sharing allocations can be calculated.

## ARTICLE 12 - TRADITIONAL KNOWLEDGE AND GENETIC RESOURCES

- 12.1 When Research is conducted at the Institution using TK and/or GRs, provisions of national legislation must be observed,<sup>17</sup> which provisions may include prior informed consent, and access and benefit-sharing, and the need to obtain any relevant permits.
- 12.2 The Institution shall formulate procedures and mechanisms for access to GRs/TK in order to comply with national legislation.
- 12.3 The Institution shall make provision in all Research Contracts concluded to protect any IP that may arise from the use of TK and/or GRs.

## ARTICLE 13 - CONFLICTS OF INTEREST AND CONFLICTS OF COMMITMENT

- 13.1 Commitment to the Institution.** Staff Members' and Visitors' primary commitment of time and intellectual contributions should be to the education, research and academic programs of the Institution.
- 13.2 Best Interests of the Institution.** Staff Members and Visitors have a primary professional obligation to act in the best interests of the Institution; they should avoid situations where external interests could significantly and negatively affect their work ethic and research integrity.
- 13.3 Agreements with External Parties.** It is the responsibility of all Staff Members and Visitors to ensure that their agreements with external parties do not conflict with their duties and responsibilities in terms of this Policy. This provision shall apply in

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<sup>17</sup> For instance, when a member of the Institution needs to access and use GRs for the purpose of the research or when it is envisaged to share samples of GRs with partners from other countries, the Institution shall abide by the national laws in place.

particular to private consultancy, and other research service agreements concluded with external parties. Each individual should make his/her duties and responsibilities clear to those with whom such agreements may be made and should ensure that they are provided with a copy of this Policy.

**13.4 Disclosure of External Activities and Financial Interests.** Staff Members and Visitors shall promptly report all potential and existing Conflict of Interest (COI) or Conflict of Commitment (COC) to the appropriate Institutional authority, in compliance with applicable COI/COC policies. The authority will be responsible for resolving the conflict or reaching a solution satisfactory to all parties concerned. The decision must be approved by a high-level academic functionary.

**13.5 Policy.** The Institution will develop a separate and comprehensive policy on COI, in order to increase the awareness of Staff Members and Visitors about COI and COC; outline requirements for disclosure of COI and COC; and establish procedures to identify them, avoid or properly manage such conflicts.

## ARTICLE 14 - DISPUTE

**14.1 Violation.** Breach of the provisions of this Policy shall be dealt with under the normal procedures of the Institution, and in accordance with the relevant provisions of laws and regulations in force.

### **14.2 Dispute Resolution.**

Any internal disputes or questions of interpretation arising under this Policy must in the first instance, be referred to IPMO for consideration and mediation by the IP Committee.

If the matter cannot be resolved by the IP Committee within two months, then the dispute or question of interpretation must be referred to the management of SJEC for mediation.

The management of SJEC may at their sole discretion refer the matter to SJEC Governing Council and/or an independent committee for arbitration as the final arbiter of any disputed issues or for final determination.

**14.3 Appeal.** Individuals covered by this Policy shall have the right to appeal the application of any aspect of this Policy to the IP Committee.

## ARTICLE 15 - AMENDMENT

- 15.1 Revision.** This Policy may be amended at any time by a decision of the IP Committee. In this case:
- a. all IP disclosed on or *after* the effective date of such amendment shall be governed by the Policy as amended; and
  - b. all IP disclosed *prior* to the effective date of the amendment shall be governed by the Policy prior to such amendment, provided that the provisions of the Policy (as amended) shall apply to all IP licensed or otherwise Commercialized on or after the effective date of any such amendment regardless of when the IP is disclosed.

[End of document]

## ANNEXURE 1

**INVENTION DISCLOSURE FORM –****BNMIT00000**

BNM INSTITUTE OF TECHNOLOGY- CONFIDENTIAL

TITLE

**General Information**

Origination Date: 01 January 2019

Submission Date: 01 January 2019

**Inventor Information**

Inventor: -----

Address: -----

Inventor: -----

Address: -----

Email Address: -----

Phone: -----

Email Address: -----

Phone: -----

Inventor: -----

Address: -----

Inventor: -----

Address: -----

Email Address: -----

Phone: -----

Email Address: -----

Phone: -----

**Invention Information**

**1. Briefly describe the technical or commercial problem or need that this invention is intended to solve:**

**2. Briefly describe how this invention solves the problem or meets the need. Please list any unique and novel features. Please indicate how this invention is different from the prior art**

**3. Describe how to make and use the invention. Please describe the best way known to you to practice the invention. (Please provide drawings or flow charts for devices or processes)**

**4. What was the earliest date on which the invention was conceived? If available, attach documents which provide evidence of the foregoing (e.g. copy of pages from lab notebooks).**

**Conception date:**

**Date comments:**

**Supporting documents:**

**5. Is there a non-inventor who witnesses the conception?**

**6. Was the invention reduced to practice (i.e. made or used in prototypes or experimental examples)?**

### Miscellaneous

**1. Does the invention relate to any other (i) Issued patents, (ii) Pending patent applications or (iii) Previously submitted invention disclosures?**

### Patentability Report

**1. Please perform thorough patentability search and submit the patentability report along with this document to IPSC.**

**Inventor  
Name:**

**Signature:**

**Date:**

**Inventor  
Name:**

**Signature:**

**Date:**

**Inventor  
Name:**

**Signature:**

**Date:**

**Inventor  
Name:**

**Signature:**

**Date:**