

INTELLECTUAL PROPERTY RIGHTS POLICY OF IIT MADRAS

PREAMBLE

Faculty, staff and students of IIT Madras are engaged in Research & Development work of diverse nature. Many of these R & D Programmes lead to evolution of intellectual property (IP) in the form of patents, know-how, copyrights, designs, instruments, devices, processes, specimens, software and other inventions, which can be commercially exploited either with or without registration under the Patents Act/Copyright Act. Such a commercial exploitation can be of considerable socio-economic benefit to the country. The Institute, therefore, encourages the protection and licensing of such IP to organisations which can effectively utilise the same for commercial exploitation. This would yield financial returns to the Institute, and partially support the R & D efforts.

Intellectual property could result from research supported by the Institute or government departments, or from research supported by industry or independent research organizations such as ISRO, DRDO, etc. Funded research may impose contractual obligations on the Institute with respect to ownership/licensing of intellectual property, which have to be agreed upon clearly and explicitly at the time the contracts are entered into. This document states the policy of the Institute with respect to protection, ownership and licensing, of IP that is generated with/without external funding.

Guidelines:

This IPR policy is to be followed in all matters related to IPR at the Indian Institute of Technology Madras (Institute). In view of the

evolving nature of the IP scenario, this policy may be modified from time to time to suit the emergent needs, or on a case-by-case basis. The IPR committee will address such specific cases by using this IPR policy document as the guideline.

Centre for IC&SR is the nodal agency of the Institute for processing all IPR related matters addressed in this policy, viz. any **intellectual property** generated out of the intellectual effort of the creator employed temporarily or permanently at Institute or studying at Institute.

1. Objective

The objective of this policy document is to lay down the policy to:

- a) foster, stimulate and encourage creative activities in the widest sense in the areas of technology, sciences and humanities.
- b) protect the legitimate interests of faculty/scholars/students of the Institute and the society and to avoid as far as possible conflict of opposing interests.
- c) lay down a transparent administration system for the ownership control and assignment of intellectual properties and sharing of the revenues generated by the intellectual properties generated and owned by the Institute.

2. Definitions

The meaning of terms in these rules is as given below, unless the context otherwise requires.

- a) "**Copyright**" means the exclusive right granted by law for a certain period of time to an author to reproduce, print, publish and sell copies of his or her creative work.
- b) "**Creator**" means any employee of the Indian Institute of Technology, Madras and includes those who are on probation, those who are employed on temporary basis either in the Institute and/or in projects and those who are research workers, research scholars or students who are responsible for the creation of an Intellectual Property, using the facilities of the Institute.
- c) "**Director**" means the Director of the Indian Institute of Technology, Madras.
- d) "**Institute**" means the Indian Institute of Technology Madras.
- e) "**Intellectual Property**" broadly includes any property generated out of intellectual effort of the creator(s). It includes but not limited to
 - (i) New and useful scientific and technical advancement in the form of innovations, inventions, products and processes, computer hardware and software, materials, biological varieties etc. which are patentable.
 - (ii) Industrial and architectural designs, models, drawings, software, creative, artistic and literary works teaching resource materials generated, records of research etc., which are copyrightable.
 - (iii) Trade marks, service marks, logos etc.

f) "**IPR Committee**" The committee constituted by the Director from time to time to evaluate and make recommendations regarding IP related issues.

g) "**Patent**" means a patent granted under the provisions of the Indian Patents Act, 1970.

h) "**Patentee**" means the person for the time being entered on the Register of Patents kept under the Indian Patents Act, 2002 as the generator or proprietor of the patent.

i) "**Revenue**" is any payment received as per an agreement by the Institute usually for legal use of an Intellectual Property through a license.

3. Ownership

a) Inventions, Designs, Integrated Circuit Layouts and other creative works:

- (i) Institute shall be the owner of all intellectual properties (IP) including inventions, software, designs and integrated circuits layouts, specimens, created by creators, unless specific agreements / contracts are entered into by the Institute as described below, prior to the creation of the IP, with an agency funding the research leading to the creation of the IP, or with a temporary employee or student.
- (ii) Specific provisions related to IPR made in contracts governing the collaborative activity shall determine the

ownership of IP arising out of sponsored or collaborative research, or consultancy assignment. The MoU / contract for such a project may require (a) joint ownership of such IP between IITM and the sponsor, or (b) full ownership of such IP by the sponsor, or (c) exclusive licensing of such IP owned by the Institute to the sponsor or its nominees, or (d) a separate agreement / contract to be entered into at a later date consequent to creation of such IP, for exclusive / non-exclusive ownership / licensing of the IP. In all these cases, the contract / agreement / MOU will specify conditions such as right of first refusal to such IP if applicable, the fee/royalty payable for ownership / licensing of such IP as applicable, and also specify how the patent filing, registration and maintenance costs will be borne by the sponsor and / or the Institute. When faculty / staff enter into an agreement for undertaking sponsored research or consultancy, they are required to assist the Institute to determine which of the above options is applicable to the particular project given the nature of research proposed to be undertaken, the degree to which prior relevant expertise of the researchers and Institute facilities are leveraged, and the amount of funding provided.

- (iii) If an IP is created as a result of a sponsored research project or consultancy assignment/project where the contract / MOU / agreement does not specify the ownership and / or licensing of such IP,, the Institute and the sponsor shall jointly own the IP . The Institute may however, if it deems appropriate, enter into a separate agreement / contract with the sponsor for licensing the IP

to it, which will specify payment of additional fees / royalty.

- (iv) An employee of the Institute who is on sabbatical or other forms of long leave, or a student who is on leave or is permitted by the Institute to be employed in an organization while being registered as a student, and who is engaged in research in an/the organization with the permission of the Institute, will be permitted to directly negotiate with the organization, the terms of any IP sharing that is generated, in its entirety and without any use of Institute resources, during the duration of the engagement in that organization. However, any revenue that is received by the employee/student subsequently while on duty at the Institute, as royalty / fees for the IP generated as above, shall be subjected to the prevailing IPR revenue sharing norms of the Institute. IP developed by the said employee or student during this period without involvement of creators who are employees or students of the Institute will be outside the purview of this policy. However, in case the IP so created by the employee/student, during the leave period as described above, is based in part or full on prior IP developed at the Institute, the employee/student is required to inform the Institute and enable the Institute to enter into a licensing agreement with the organization in which the employee/student is temporarily engaged.

b) Copyrightable Works:

- (i) Ownership of copyright of all copyrightable work including books and publications shall rest with the creator of the original work with the following exceptions:
- If the work is produced during the course of sponsored and/or collaborative activity, specific provisions related to IPR made in contracts governing such activity shall determine the ownership of the copyright.
- (ii) Institute shall be the owner of the copyright of work, including software, created with significant use of Institute resources.
- (iii) Institute shall be the owner of the copyright on all teaching material developed as part of any of the academic/distance learning programs of Institute. However, the creator(s) shall have the right to use the material in her/his professional capacity.

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

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

In cases of all IP produced at the Institute, the Institute strongly desires to retain a non-exclusive, free, irrevocable license to copy/use the IP for teaching and research purposes only, consistent with confidentiality agreements entered into by the Institute, if any. This is to enable the Institute to benefit from IP created by its staff and students for carrying out its teaching and research functions.

4. Evaluation and Management of IP

The Patent Cell / Office of Centre for IC&SR of the Institute is responsible for evaluating, protecting, marketing, licensing and managing the IP generated at the Institute. The creators of the IP shall provide all the necessary information to IC&SR to enable it to determine whether the Institute desires to own and manage the IP. An Invention will typically be patented by the Institute if it has ultimate commercial motivation and viability, even if it is not in the immediate future. If the Institute decides not to own and manage the IP, it shall permit the creator(s) to file patents and protect the IP on their own. However, share of the Institute in revenue resulting to the employee / student from licensing from such IP will be determined as described in Section 9. In the case of patentable IP, it is essential that patent protection is filed before publication or disclosure in any other form in public domain of the patentable IP.

The IPR Committee will examine the IP application and will then make specific recommendations regarding Patentability/Registration of the proposal by the Institute. The committee may seek the assistance of experts for this purpose. In all these endeavours confidentiality of the IP shall be strictly ensured.

In case the contract / agreement / MOU with a sponsor specifies that the sponsor will manage the process of filing of patents and bear the associated costs, the creators will provide information to the Patent Cell / Office of each such filing / application. Details of the invention need not be provided in such cases in the interest of confidentiality, if so desired. Progress of the application through various stages, such as PCT, national phase, etc will be informed to the Patent Cell / Office by the creators as and when the creators become aware of such progress.

5. Registration of patents /Copyrights:

a) *Filing of Applications in India*

Creators of the know how/designs/instruments/devices/processes/specimens and other such IP, who want to get patent(s) for the patentable IPs are required to make an application for the purpose to the Dean, IC&SR as per the procedure specified by the Institute at the time. In case, a sponsor of the research leading to the IP has contractually undertaken the responsibility of filing of applications, the creator may interact with the sponsor for the filing, after informing the Patent Cell / Office of the same. The creator is required to keep the Cell / Office informed of the progress of the application as it goes through various stages. The details of the application such as title, names of inventors, etc must be provided, although the invention details need not be provided as long as the details are not public knowledge in the patenting process.

Creator(s) are encouraged to file a provisional patent as soon as possible in order to protect their rights to the IP. As part of this process, a search report can also be obtained of existing patents that may relate to the key contributions of the proposed patent, to assist the creator(s) in their decision regarding filing of an application. If the creator(s) can pay for the cost of provisional filing from (a) the funds of the research project resulting in the IP, or (b) the PCF(s) of the creator(s), or (c) DDF of the department(s) of the creator(s) with approval of the concerned department Heads, or (d) personal financial resources of the creator(s), the permission for filing of provisional patent will be given automatically before evaluation of the application made by the creator(s) by the IPR Committee. In such cases, the technical details of the invention need not be

provided to the Patent Cell at this stage in the interest of confidentiality. However, should the Institute after due evaluation decide not to manage the IP, the provisional application will lapse, unless the creator(s) decide to take up the subsequent stages on their own. In such cases, the Institute will waive its rights to the ownership of the patent rights. If Institute decides to jointly or fully own and manage the IP, it will bear all costs related to filing and protection after the date on which it decides to do so. In case, the creator(s) paid for the provisional filing from personal financial resources or PCF, these costs will be reimbursed after the Institute decides to own and manage the IP.

IP-related information will either not be disclosed at all, or be provided on a need-to-know basis to certain employees of the Institute. All Institute employees associated with any activity of Institute shall treat all such IP-related information, which they may have access to as part of their official duties, as confidential. Such confidentiality shall be maintained till such time as required by the Institute or by the relevant contract, if any, between the Institute and concerned parties, unless such knowledge is in the public domain or is generally available to the public.

b) Filing of Applications in Foreign Countries

The Institute may consider requests for registration of Patents in foreign countries, based on the merit of the IP. Typically, the process to be followed in such cases is the filing of a provisional application, detailed evaluation of the commercial potential of the IP in the countries proposed for filing, filing of PCT application in case such potential is present, followed by national phase filing in the selected countries. During the time before the process reaches

the national phase, the commercial potential will be continually assessed, and if at any time it appears that the commercial potential in a foreign country appears to be low, Institute may decide to not file in the particular country. During this period, the creator(s) are also encouraged to apply for financial support for international filing being provided by several ministries to public institutions. If the Institute decides not to file such a patent in any foreign country, the Institute shall assign the rights for the IP in that country to the creator(s) and permit the creator(s) to protect the IP in that country either on their own or in partnership with a sponsor. Any revenue accruing to the creator(s) as a result of exploitation of the rights assigned to the creator(s) in that country will be subject to the rules for sharing of revenue with the Institute that are applicable to the creator(s) as per their employment / enrollment contracts. The creator(s) may seek re-imbursement of the costs borne by them for protection of the IP in that country from the revenue prior to sharing with the Institute.

In case the patenting costs are borne by the sponsor of a research project as agreed upon in the contract / agreement, the Patent Cell only needs to be kept informed of the progress of the international patent application(s) through various phases such as PCT, national phases, etc. The sponsor may choose any legal firm of their choice for the filing. If the Institute takes up the filing, the creator(s) are required to engage one of the legal firms approved for filing from time to time.

6. Renewal of Patents

The Institute will pay the Patent Fees for the first seven years in all cases where patent is taken by the Institute. If it is a joint patent

with a sponsoring agency the patenting costs may be equally shared. If the patent has been commercially exploited within the first seven years, the Institute shall pay the Patent Fees for the remaining period of the life of the patent. If the patent has not been commercially exploited within the first seven years, the Institute and the creator(s) shall share the subsequent installments of renewal fees on 50:50 basis. The creator(s) are permitted to pay their share of the costs from their PCF. If the creator does not show interest in such renewals, the Institute can either continue maintenance of the patent by paying the fees for its full term or withdraw application for Patent protection at its discretion.

7. Confidentiality of IP

Every creator in the group as well as every one involved in the protection process will not disclose the details of the IP to any person/organisation without prior written permission of the Institute.

In case of thesis and other such written documents containing details of patentable IP, all measures to avoid attracting the public disclosure clause leading to denial of patent may be taken by creators. It is best if the creators make provisional patent filings before documenting the details of the IP in theses, papers and other documents.

8. Licensing of IP

Institute, through its Patent Cell, or its agents, or the creator(s) may approach external agencies for licensing of IP owned by it. All

agreements shall be signed by the Dean IC&SR and the creator(s) of the IP being transferred, on behalf of the Institute.

In case of IP involving more than one creator, a coordinator from among the creator(s) shall be identified by the creators, for IP protection purposes. At this stage, all members of the group of creators shall sign a revenue sharing agreement for the IP being transferred. This revenue sharing agreement may be modified at any time on mutual consent among the creators and intimated to the Dean IC&SR. Any conflict with regard to revenue sharing among the creators will be resolved by the Institute which is binding on all the creators of the IP.

9. Revenue sharing

- a) The revenue shall be divided among the creators as per the prevailing IPR revenue sharing norms of the Institute at the time of signing of the agreement. In case the patent filing and registration costs for one or more countries are not borne by the Institute, the creator can first deduct the costs incurred by the creator in this regard and in regard to maintenance of such patents from income accruing to the creator from the commercial exploitation of the patent in those countries. Excess income beyond such recovered costs will be shared with the Institute as per the prevailing norms of the Institute. Any MoU signed by the Institute with the sponsoring agency based on which the IP is generated, or with any patent filing organization, may supersede provision under this clause.
- b) The creator(s) can start a new research project with the amount available to them from such revenue, i.e. the entire amount or a

partial amount of the creators' share can be put into a new research project for further development on the patent topic or further research in a related area. On request by the creator(s), the Institute will contribute an equal share, but the maximum share of such contribution by the Institute will be limited to 50% of the revenue accruing to the Institute.

10. Exception in case of IP unrelated to official work

Creator(s) may apply to the Institute for permission to patent/license know-how to organizations by themselves, when such IP is not related to the official duties and roles of the creator in the Institute. Such IP will typically in an area totally unrelated to the professional expertise of the creator for which the Institute has employed him/her. IPR Committee will examine the proposal and recommend whether or not the request by the creator(s) can be acceded to. If on the recommendations of the Committee the Director permits the creator(s) to own / protect / license the IP independently, the creators will be the sole beneficiary of all earnings from such IP and no amount therefrom will be payable by the creator(s) to the Institute.

11. Copyright

- a) All Ph.D. / MS theses are to be copyrighted with a copyright note: © *Indian Institute of Technology Madras (year)*. All rights reserved. The technical reports, review works, may also be copyrighted, if the author wishes to copyright.
- b) The author of a report may also request to copyright on behalf of the Institute, any other material such as B. Tech. and M. Tech project reports.

- c) While copyrighting the thesis it is the responsibility of the creator to ensure that the contents do not violate any copyright rules. If diagrams, tables and text are reproduced from any other copyrighted work, prior permission is to be obtained by the creators from the owner of the copy right document from where the material is taken.
- d) If information from some other sources are included, appropriate acknowledgement has to be given to this source, as per copyright law.
- e) Exceptions:
 - (i) The ownership of the copyrights by the Institute in no way deprives the claims of the creators / authors to publish the contributions in scholarly and intellectual work, and their authority to improve, publish and propagate the work. When a journal that accepts a paper submitted by an employee/student requires copyright for the paper to be given to them before publishing the said paper, the employee/student may do so.
 - (ii) The Institute may waive ownership of copyrights it owns in favour of the author(s), contributor(s) on request.
 - (iii) Students and scholars may be allowed ownership of the copy rights to their works provided

- they do not result from works for which they had received financial or supervisory support of any form from or through the Institute
- the work does not include any material generated entirely or partially with the help of Institute facility or ongoing research programme or the intellectual input of any employee of the Institute.

12. Computer Software

- a) A computer software may be patented, copyrighted or trade marked depending upon the IP Content. A Computer Software may be distributed by its creator to researchers / teachers / students in other institutions for research and teaching purpose only after obtaining appropriate undertaking from the recipient to the effect it will not be used for commercial purpose nor will it be transferred to any other party without explicit permission of the creator/Institute. This transfer does not liberate the software from IPR protection. The creator may decide to put IPR protectable software on public domain in the spirit of dissemination of scientific knowledge or set standards or obtain scientific feed back from the users to advance the research. However, the creator is encouraged to protect IP of such software as per the usual procedure.
- b) The legal and IPR restrictions by the suppliers of the software in the use of all software procured by the creators shall be clearly understood and adhered to.
- c) Institute encourages incorporation of software without license restrictions in the research and development works undertaken by its employees / students since they do not restrict, constrain and

impair the Institute's right to develop and distribute the R&D work.

- d) Before copyright and patent for software ownership is sought for by creator(s) the terms and conditions are to be settled with the owners of the copyright to the original software platforms, based on which the new software may have been developed.

13. Publication based on IP

- a) Faculty members, scientific staff, research scholars disseminate their creative work through publications for which they generally have unrestricted freedom. Publications constitute only a part of the body of knowledge generated. The Institute policy is to encourage transfer and dissemination of knowledge in as complete a form as possible subjected to the following restrictions.
 - (i) In the case of publications based on externally sponsored work permission from the sponsoring agency may sometimes be contractually required. The Institute's agreement with the sponsor usually requires that this permission may not be normally denied except so far as to protect any tangible IP which may be of commercial value or of security interest to the sponsor, and the sponsor will act within a reasonable time to give the permission to publish.
 - (ii) All publications based on sponsored project shall also acknowledge the sponsor's support for the work reported in the publications.
 - (iii) All the contracted obligations have to be adhered to by the creators in the case of IP generated through sponsored work.

- b) In case of patentable IP, it is desirable to obtain the patent protection at least in the form of a provisional application before such an IP is either published or exchanged so that both academic and commercial value of the IP is protected.
- c) In order to protect the commercial value of an IP without affecting the exchange of information, a special confidentiality agreement may be signed between interacting parties before exchanging the information about any IP.

14. Agreements and Contracts

a) Agreement categories and authorized signatories

All agreement including but not limited to the following categories, are to be approved by Institute:

- (i) Confidentiality Agreement, Classified Information Non-disclosure (specific) Agreement, only to enable the Institute to ensure that the Agreement does not render the Institute liable in any manner for breach of the agreement. Since such agreements often need to be entered into quickly to enable progress in collaboration / interaction, Institute will respond promptly if the Agreement is entirely between the external party and the employee or student, and the Institute is not directly or indirectly made liable by the Agreement in any manner.
- (ii) Revenue Sharing Agreement, Indemnity agreement.
- (iii) Evaluation Agreement, Consultation Agreement, Research and Development Agreement (R&DA/MOU)
- (iv) Technology Transfer Agreement, License Agreement, IP assignment agreement

(v) Alternative Dispute Resolution Agreement

Dean IC & SR, as designated by the Director, acts as the final signing authority in all the categories of agreements listed above, except confidentiality agreement which may be signed by the creator with the consent of Dean, IC&SR.

b) Infringements, Damages, Liability and Indemnity Insurance

- (i) In any contract with the licensee, Institute shall obtain indemnity from legal proceedings against the Institute including its employees, without limitation, due to reasons including but not limited to manufacturing defects, production problems, design guarantee, upgradation and debugging obligation.
- (ii) Generally Institute shall obtain, through appropriate agreement, indemnification from the organization to which IP is transferred, against any direct or third party legal liability arising out of commercial exploitation of IP.
- (iii) Any computer software developed and distributed by the Institute either through public domain or commercially, shall have explicit disclaimer against any liability arising out of the use of software by any user.
- (iv) Institute shall retain the right to engage in any litigation concerning patents and license infringements.

c) Conflict of Interest

- (i) The creator(s) are required to disclose any conflict of interest or potential conflict of interest. If the creator(s) and/or their immediate family members 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.

- (ii) A license or an assignment of rights of any IP to a company in which the inventors have a stake shall be subject to the approval of the Dean IC&SR taking into consideration this fact.

15. Dispute Resolution

In case of any dispute with regard to IPR policy, the decision of the Institute shall be deemed final and binding.

16. Jurisdiction

As a policy, all agreements to be signed by the Institute will have the jurisdiction of the courts in Chennai and shall be governed by appropriate laws in India. Exceptions to this may be allowed in certain cases by the Institute.
