

Indian Institute of Science  
Intellectual Property  
and  
Technology Transfer  
Policy and Guidelines  
2019



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## 1. OBJECTIVES

Through this official Intellectual Property (IP) Policy and Guidelines, the Indian Institute of Science (the “Institute”), intends to put in place a system that brings order to the process of protection of IP including inventions, and the utilization of IP through processes of technology transfer and entrepreneurship. Within the above broad objectives, the specific objectives of this IP Policy are as follows:

- 1.1. Undertake the mining, and identification of IP in the various research, consultancy, educational, and all other academic activities of the Institute;
- 1.2. Encourage, create awareness, and facilitate the process(es) of securing and protecting the IP rights of all Institute personnel;
- 1.3. Initiating and pursuing all actions and deeds to maintain, prosecute, and keep in vogue the secured IP rights of the Institute; and
- 1.4. Pursuing all the necessary procedures and actions to facilitate, catalyze, and bring to bear the Transfer of Technologies (ToT), including the commercialization, licensing, and other means of disseminating the technologies developed by the Institute

## 2. DEFINITIONS

- 2.1. **“Applicant”** refers a person or an organization, who owns the rights to the IP generated/ developed and makes a formal application before an IP office for grant of the respective right such as Patent, Industrial Design or Copyright. Institute is usually the Applicant for all IP generated/developed by the Institute Personnel.
- 2.2. **“Assignee”** refers to a person or an organization like the Institute to whom/which ownership right(s) to the IP is legally transferred.
- 2.3. **“Assignment”** refers to the act of transferring the ownership rights including the title and interest in the IP generated/developed. Under this IP policy all Institute Personnel by virtue of their engagement with the Institute assign or transfer Ownership rights to the Institute.

- 2.4. **“Background IP”** refers to any IP/IPR that's created, invested, authored or developed prior to or independently owned or controlled by the parties before the date of the agreement/contract. In simple words, the Background IP is preexisting IP that a party brings to a research project. The parties include Institute, funding agencies, collaborators or Government of India (hereinafter referred to as “GOI”).
- 2.5. **“Confidential Information”** shall mean and include any and all proprietary information whether commercial or technical of the Institute and shall without limitation, include Trade Secrets, data, Know-how, software programs, processes, specifications, drawings, marketing plans, financial, strategies, forecasts, any or all Intellectual Property, product development plans, marketing, sales leads and work in progress; engineering, technical, manufacturing, service, financial and personnel information relating to all transactions of IISc, evaluation material, internal discussions and all nonpublic information whether the information is in print, written, electronic form or oral that is valuable to IISc and not generally known to outsiders.
- 2.6. **“Collaborative R&D”**: refers to projects that are jointly conceived, planned, and executed by the Institute Personnel, in collaboration and partnership with, the representatives, personnel, and staff of the collaborator such as an Industry, sponsors, universities, NGO's, research organizations, hospitals or any other third party interested in R&D. Such projects will be characterized by substantial inventive and financial contributions from these entities. In addition, in the case of Collaborative R&D work carried out by the Institute and the Industry, the latter shall also make substantial inventive contributions, in tandem with the financial contributions made by it.
- 2.7. **“Copyright”** is a type of IP and refers to describe the rights that creators have over their literary and artistic works. Works covered by copyright range from books, music, paintings, sculpture and films, to computer programs, algorithms databases, advertisements, maps and technical drawings.
- 2.8. **“Commercialization”**: refers to the various activities, processes, and steps undertaken by the Licensee, under the terms of the Technology Licensing Agreement, to put the Technology/ Invention/ IP to commercial use, in

terms of sale, internal use, etc., that result in financial, commercial, economic, or any other material benefit to the Licensee. The terms of the Licensing Agreement will specify the compensation to be paid by the Licensee to the Institute (the Licensor), and such compensation would include a one-time Lump Sum Technology Transfer Fee, as well as deferred Royalty payments. In addition, the Licensee may also offer a certain equity in the start-up venture to the Institute, on terms to be mutually discussed and negotiated.

- 2.9. **“Consultancy Projects”** refers to the work conceived and funded by industries or any third party to the Institute for providing advice/solution to a specific problem without using Substantial Institute Resources.
- 2.10. **“Disclosure of IP”** refers to the Confidential Information such as Invention written up, and revealed by an Inventor to the Institute, to determine whether Intellectual Property Rights for the said disclosure should be sought and obtained by the Institute. The Institute would also ascertain what could be the scope for Technology Transfer, Commercialization, and Licensing of the said Invention.
- 2.11. **“Entity”** refers to legally recognized business organizations, academic and research organizations or non-profit organizations under the law and includes private limited, public limited, corporations, LLP, partnership firms, proprietorship, research institutes, universities, societies and associations, trusts, NGO’s (non-government organizations) etc., established and governed by various laws of the land.
- 2.12. **“Foreground IP”** refers to IP/IPR resulting directly from and authored, conceived, developed, reduced to practice or otherwise created during the performance of the research agreement/contract by the Institute or in collaboration with the collaborating Entity.
- 2.13. **“IPTeL”** refers to the Intellectual Property and Technology Licensing office
- 2.14. **“IPTeL Chairperson”** refers to the head of IPTeL office appointed by the Director.
- 2.15. **“IPTeL Technical Committee”** refers to the committee set up by IPTeL Chairperson and shall include IPTeL Manager and other members to evaluate the inventions received by IPTeL for seeking appropriate IP Protection.

- 2.16. **“IPTeL Manager”** refers to the manager of IPTeL appointed by IPTeL Management Committee.
- 2.17. **“Intellectual Property Management Committee” (IPMC)** refers to the committee set up by the Director IISc from time to time to oversee the functioning of IPTeL Activities.
- 2.18. **“Industrial design”** is a type of IP and refers to the rights pertaining to the ornamental or aesthetic features/design of an article. A design may consist of three-dimensional features, such as the shape or surface of an article, or of two-dimensional features, such as patterns, lines or color.
- 2.19. **“Invention”** refers to an act of inventing something which is novel or unique, typically a device, method, composition, or process. An invention may be an improvement upon an existing product, process, or service, or it may be an entirely new product, process or service.
- 2.20. **“Inventor”, creator or an author** (Collectively “Inventor”), refers to the Institute Personnel who contributed to the creation/conception or/and development of the IP. In Patents, inventor is the person, or persons who preferably contribute to the claims of a patentable Invention
- 2.21. **“Intellectual Property or IP”** refers to creation of mind and primarily encompasses inventions; literary and artistic works; designs; symbols and names used in commerce, method or process of manufacture; biological material; drawings, prototypes, integrated circuit, circuit layout or semiconductor chip layout or design; or scientific, technical or engineering information; computer software (in source and object format); improvement, modification or development of any of the foregoing; trade secret and Know-how.
- 2.22. **“Intellectual Property Rights (IPR)”** Intellectual property rights are the rights given to Inventor(s), Applicant or the Assignee for the IP created/generated. The right usually gives the Inventor, Applicant or the Assignee an exclusive right to exercise the monopoly over the use of their creations for a certain period of time. The different types of Intellectual Property Rights include Patents, Copyright, Industrial Design Rights, Trademarks, Integrated circuit design rights or the mask layout rights, Plant Variety Rights, Geographical Indication(GI) and in some Jurisdictions, Trade Secrets.

2.23. **“Intellectual Property (IP) Policy and Guidelines”**: IP Policy and guidelines refers to the instant policy along with the Annexures and the previous versions of the IP Policy, if any in force. The instant IP Policy and Guidelines refers to the set of principles, values, and guidelines that will govern all the actions and efforts of the Institute, towards the identification, protection, prosecution, utilization, transfer, licensing, and commercialization of all IP arising out of the R&D work of the Institute Personnel.

2.24. **“Indian Institute of Science”/“IISc”/“Institute”** refers to an autonomous institution of higher learning and advanced research, founded in 1909, and located in Bangalore. It also includes its other campus situated in Challakere and its research centers or laboratories setup at various places in India, and, unless repugnant, also include all its assigns, heirs, and legal representatives.

2.25. **“Institute Personnel”** shall refer to all Faculty ( active, retired or alumni), Students, Staff, (permanent and temporary), retired but continuing faculty, consultants, Ad-hoc appointees, and contract employees, engaging in education and research at the premises of the Institute or off the premises of the Institute, working during leave or on duty from the Institute, including emeritus professor, honorary appointee, visiting fellow, research staff, research associates, post-doctoral researchers, project assistants, students on internship, students enrolled by the Institute in various degree programs of the Institute, regardless of the mode of entry through which they are admitted, such as Undergraduate Admission and Graduate Admission under the M.E./M.Tech./M.Tech.(Research)/M.Mgt./MDes/ M.Sc.(Engg.)/Ph.D. programs, the Integrated PhD program, the External Registration Program (ERP), the Quality Improvement Program (QIP), as well as students at the Institute from other Universities (whether in India or abroad) studying/conducting research under exchange programs. Institute Personnel also includes visiting faculty members or scientists, adjunct faculty, industrial personnel, fellows project/research/technical assistants, summer fellows/trainees, Institute alumni and any other personnel from outside institute engaged in research and development work at the institute independently or in collaboration with Institute

Personnel. Institute Personnel whose R&D effort results in an Invention, and whose IP needs to be protected by the Institute, will be referred to in this document as Inventors.

- 2.26. **“Institute resources”** means any form of funds, facilities or resources, including equipment, consumables and human resources such as faculty time, student time, staff time and support staff time provided by the Institute either in a direct or indirect way.
- 2.27. **“Joint IP/ Joint ownership”** refers to IP that may be jointly owned by the Institute and the external party that has contributed intellectually to the generation of such IP through its employees.
- 2.28. **“Know-how”** refers to any technical information or tacit knowledge closely-held together with accumulated skills which is valuable and identifiable, including results, experimental techniques, formulae, chemical structures, source code etc; not strictly a form of IP but equally important and proprietary to the Institute.
- 2.29. **“Lump Sum Technology Transfer Fee”** refers to the financial compensation paid as a single payment by the Licensee to the Licensor, in this case, the Institute, for the rights to use the Technology/ Invention/ IP(R), for commercial purposes, including the sale, internal use, lease, rent, or assign to any other party, etc. that result in financial, commercial, economic, or any other material benefit to the Licensee.
- 2.30. **“Licensor”** refers to a person or an organization such as Institute which grants a license to another or a third party known as Licensee. It simply means that the Institute who is the IP(R) owner grants permission to another individual or an organization to make, use, import, sell etc., the rights it holds in a patent, copyright or other forms of IPR.
- 2.31. **“Net sales”** refers to total revenue (gross sales), less the cost of sales returns, allowances, and discounts
- 2.32. **“Ownership”** refers to the rights an organization holds under this policy to deal with the IP generated/created by the Institute Personnel. Subject to the rights of the government and any exceptions contained in this policy, IISc owns or will be considered the owner of all the IP generated by the Institute Personnel. Ownership of Patent or IP is independent of

inventorship/authorship. The Institute Personnel generating/creating the IP will be considered Inventors/authors.

2.33. **“Patent”** is a type of IP and refers to an exclusive right granted for an Invention which is either a novel product or a process that provides a novel way of doing something, or that offers a new technical solution to a problem which has some industrial use and is not obvious to a person skilled in the art.

2.34. **“Project”** refers to a series of tasks that need to be completed in order to reach a specific outcome by the Institute either on its own or in collaboration with an external entity and includes research project(s), consultancy projects(s).

2.35. **“Publications or Public disclosure”**: refers to the various documents, reports, technical communications, research papers, manuscripts, software, research data etc. arising out of a R&D work carried out by the Institute Personnel that are generally made available to the public by act of publishing, including electronic and printed copies, through different forms such as journal publications, books, thesis, dissertations, newspaper articles, posters, conference publications or other publications via a website or other electronic means, physical copies or in an oral presentation to someone who is not an employee of the Institute, or is not bound by confidentiality to keep such information secret. Demonstration/promotion of the invention in a public place is also considered public disclosure. Thesis and dissertations kept in the IISc library or published as an e-copy is also considered public disclosure.

2.36. **“Revenue”** refers to all the financial earnings made by the Licensee, from the rights to use the Invention/ IP(R), for commercial purposes, including the sale, sub-license, internal use, or assign to any other party, etc. that result in financial, commercial, economic, or any other material benefit to the Licensee. Where the context so admits, Revenue would also refer to the financial compensation paid by the Licensee to the Licensor, in this case, the Institute, for the rights to use the Invention/ IP(R)/technology, for commercial purposes, such as the sale, internal use, sub-license, to make, import or assign to any other party that result in financial, commercial, economic, or any other material benefit to the Licensee.

- 2.37. "**Release of an IP**" refers to the release of the Ownership rights on the IP(R) to the Inventor(s) to administer the protection of IP, its prosecution, and commercial licensing of the same.
- 2.38. "**Sabbatical Leave, Deputation, Lien**" A Sabbatical is a rest from work, or a break, often lasting from two months to a year. Strictly speaking, the original scriptural essence of sabbatical means it would last one year. A deputation is the official delegation, or the assignment of responsibility or authority to a person, from the Institute, to another organization, to carry out specific designated roles and activities. A lien is the official, continuing attachment of an Institute Personnel, to his or her post of substantial employment at the Institute, during designated period(s) when such person(s) have availed leave of accrued nature, to seek gainful employment in another organization. It is the responsibility of the Institute Personnel to ensure that their agreements with third parties are in keeping with their obligations to the Institute. The Office of IPTeL can provide suggested language for inclusion in such agreements with outside entities, especially during Sabbatical Leave/ Deputation/ Lien.
- 2.39. "**Substantial Use of Institute Resources**" means use of the Institute's Resources such as experimental facilities, background IP, Know-how, laboratories, computational facilities, software, hardware, institute-provided or institute-administered funds or industry/ state/ central funding or other external sponsorship/funding, space provided by or through the Institute or human resources including their release time from regularly assigned duties during the course of their work or on paid leave. The routine uses of Institute library/information, desktops/laptops does not constitute "substantial use of Institute resources".
- 2.40. "**Sponsored R&D**": refers to those R&D projects and/or activities which are originated and conducted by members of the faculty or, in some instances, by staff members and are supported wholly or in part by external agencies like the government funded projects or the Industry funded projects. It also refers to research which is conceived and funded by industries requesting Institute to provide a solution to a specific problem and such solution is provided solely by the Institute using its Institute Resources in addition to the funds from the Industry.

- 2.41. **“Sponsor/ Funding Agency/ Industry”**: These terms, used interchangeably in this IP Policy document, refer to the entity that funds the R&D work that is proposed to be carried out by the Institute.
- 2.42. **“Sole IISc IP/ Sole ownership”** refers to IP that has been generated or conceived solely by Institute Personnel without the involvement of external agencies/Sponsor or any third-party personnel in the generation of such IP.
- 2.43. **“Technology Transfer”**: refers to the process by which the Institute owned IP, is transferred to another party (the Licensee) to use, put in practice, and commercialize the Invention/ technology or IP owned by the Institute. The specific terms of technology licensing will usually be set out in detail in the licensing agreement or any suitable agreement, that will be entered into and contracted, between the Institute which is an owner of the Invention/ IP (the Licensor) and the other party seeking the License (the Licensee).
- 2.44. **“Royalty/ Royalties”** refers to the deferred payment made by the Licensee/Assignee to the Institute, to compensate for the rights to use the IP, for commercial purposes, including the sale, internal use, import, sublicense etc. that result in financial, commercial, economic, or any other material benefit to the Licensee. The terms of the Royalty/ Royalties will usually be specified in the License agreements as a certain fixed or variable percentage of the Net Sales Value, resulting from the Commercialization of the said Technology/ Invention/ IP.
- 2.45. **“SID/CSIC/CSSP”**: Society for Innovation and Development (SID), Society registered under the Karnataka Societies Registration Act of 1960, by the Institute to provide a window for interaction with Industry in Research and Development. Center for Scientific and Industrial Consultancy (CSIC) and Center for Sponsored Schemes and Projects (CSSP) are administrative units of the Institute dealing with Consultancy, Sponsored and Collaborative Research Projects, respectively.
- 2.46. **“Startup”**: An entity shall be considered as a Startup incorporated as a private limited company (as defined in the Companies Act, 2013) or registered as a partnership firm (registered under section 59 of the Partnership Act, 1932) or a limited liability partnership (under the Limited

Liability Partnership Act, 2008) in India and as further defined in the notification dated 19/02/19 issued by ministry of commerce and industry vide Gazette Notification No G.S.R 34(E) dated January 16, 2019.

2.47. **“Trade Secret”** means any information not generally known or readily accessible to a third-party or accessible to people in the field that would normally deal with that information including Intellectual Property, but not limited to, an invention, specifications, computer software, circuits designs, schematics, data and know-how, drawings, computer software, copyrightable materials, programs, process, techniques, formulae, product, device, method, program, technical data, compilation or pattern that (i) derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can derive economic value from its disclosure or use and (ii) is the subject of efforts that reasonable under the circumstances to maintain its secrecy.

2.48. **“Trademark”** is a type of IP that refers to a sign, logo or a name capable of distinguishing the goods or services of one enterprise from those of other enterprises.

2.49. **In this Policy:** Headings are inserted for guidance only. They will not affect the meaning and interpretation, limit the scope of this policy or the intent of any provision thereof.

Singular and plural: words importing the singular number shall include the plural and vice versa where the context requires.

### **3. TO WHOM IS THE IP POLICY APPLICABLE**

3.1. The IP Policy of the Institute is applicable to all Institute Personnel, active, retired or alumni, associated or engaged with IISc and/or making Substantial Use of Institute Resources.

3.2. When Institute Personnel work at other organizations through a formal agreement between the Institute and the organization, as set out in Sections 2.15 and 5.3, the IP policy of the Institute will be interpreted with reference to the relevant formal inter-institutional agreement.

## **4. IP OWNERSHIP (GENERAL PROVISIONS)**

- 4.1. With the exception of rights to Copyright of works, which are dealt with under Section 6, and other exceptions contained in this Policy, the Ownership of all IP developed by Institute Personnel in the course of or pursuant to Research and Development at the Institute or outside, as defined more fully below, vests with the Institute. Inventors shall provide, upon request by the Institute, assignment of their rights in inventions to the Institute and/or other documents necessary for the Institute to perfect its Ownership rights in relevant IP.
- 4.2. It is the obligation of employees of the Institute engaged in Consulting and other activities with outside entities to ensure that their activities and agreements with third parties are not in conflict with the provisions of this Policy or other commitments involving the Institute. Employees should inform those outside/third parties with whom they make agreements of their obligations to the Institute.

### **4.3. Exception and Release**

- 4.3.1.1. All IP developed by Institute Personnel in their own personal time and which is neither connected to R&D of the Institute nor developed with substantial use of the Institute's resources shall belong to such Personnel identified as Inventors. However, prior to seeking any IP protection or Commercialization, the concerned Personnel shall submit a full disclosure to the Institute in the format prescribed and the relevant documentation supporting the claim that there was no significant use of Institute resources. If the Institute is satisfied, it shall give the Inventor a written acknowledgement that it has no claim on Ownership of that Intellectual Property.
- 4.3.1.2. If the Institute cannot or decides not to protect or Commercialize any specific IP or decides not to proceed with the prosecution or maintenance of the specific IPR, the Institute Personnel may request

release of the IP/IPR. Upon determination by the Institute that releasing the IP to the Institute Personnel will not violate the terms of an external funding agreement and that such releasing would be in the best interests of the Institute and the public, the Institute may agree to release the Invention to the Inventor(s). If so, the Institute will Assign or release to the Inventors all interest which it holds or has the right to hold in the IP, subject to the conditions to be specified in writing by the Institute and subject to the Inventors not utilizing funds from any of the Institute financial resources including R&D Projects. In the event of such release, the Institute will retain the right to a non-exclusive, nontransferable, irrevocable, royalty-free, worldwide license to the invention for research and educational purposes. In the event of an Invention being released to Institute Personnel the Institute Personnel will be required to sign a suitable agreement to remit to the Institute ten percent of net earnings received by the Inventor(s) through the Commercialization of the said Invention.

#### **4.3.2. Sabbatical/Deputation/Lien of Institute Personnel**

The aspects of the IP Policy during Sabbatical Leave/ Deputation/ Lien of the Institute Personnel will be governed by the broad terms of the Institute IP Policy, as they apply to all Institute Personnel. Such Institute Personnel should be careful that their work off-site from the Institute, including work during Sabbatical Leave/ Deputation/ Lien, while visiting other institutions and while consulting with industry, does not conflict with their obligations and commitments to the Institute. It is the responsibility of the Institute Personnel to ensure that their agreements with third parties are in keeping with their obligations to the Institute. IPTeL office can provide suggested language for inclusion in such agreements with outside entities, especially during Sabbatical Leave/ Deputation/ Lien. Any IP that is generated partially at the Institute and partially at the visiting organization, the ownership ratio of such IP will be determined on a case to case basis.

## 5. IP OWNERSHIP (PROVISIONS PERTAINING TO MODE OF FUNDING)

5.1. **IISc in-house Projects:** With the exception of rights to Copyright of works which are dealt with under section 6 of the IP Policy of IISc, **the Ownership** of all IP developed by Institute Personnel in the course of or pursuant to research and development at the Institute or outside, as defined more fully under the IP Policy vests with the Institute.

5.2. **Government Sponsored Research:** IP arising from research funded by the government of India (GOI) or other government funding agency will be controlled by the terms of the grant or contract and applicable laws. IISc may usually own solely or jointly share the IP generated under the government-funded projects, subject to certain rights retained by the government. Any Commercialization option under the GOI sponsored research is subject to the terms of the contract.

### 5.3. Industry Funded Projects

5.3.1. **Sole Ownership:** Ownership to any IP generated without any intellectual contribution or any Background IP from the employees of the Industry pursuant to the Project shall be owned solely by IISc in India and in countries filed outside India.

5.3.2. **Joint Ownership:** IISc may consider joint Ownership of IP with an Industry that in addition to funding

- contributes its Background IP for the development of the Foreground IP, or
- makes intellectual contributions to the Foreground IP through the participation of its employees in generating IP together with the Institute.

5.3.3. The extent of Ownership shall be determined based on the intellectual contribution from each entity.

5.3.4. **Assignment/Transfer of Ownership:** IISc may consider transfer of Ownership or Assignment of rights outside India in a particular field of use to explore the Commercialization of the IP. Please refer to section 9 for terms and conditions of such transfer.

5.4. **Non-Industry Research Collaborator:** Ownership of any IP generated solely by IISc personnel shall be owned solely by IISc. IISc may also consider Joint Ownership if the collaborator

- contributes its Background IP for the development of the Foreground IP, or
- makes intellectual contributions to the development of Foreground IP, contributes intellectually to the generation of IP using its own funds or through funds from an external organization subject to the funding organization policies.

#### 5.5. **Ownership of tangible research property**

5.5.1. All tangible property developed at IISc using its funds, shall be Owned by IISc and shall be licensed in accordance with this policy. The tangible property includes but is not limited to, all forms of material - organic and inorganic chemicals, pharmaceuticals, biologicals, metals, ceramics and polymers, machinery -prototypes (equipment, machine), electrical and mechanical systems, circuits in all packaged and integrated forms- and computer software.

5.5.2. GOI funded projects: Any tangible property generated or made in the course of research/Consultancy projects funded or supported by GOI shall be owned by IISc subject to the Ownership and other provisions of the GOI grant.

5.5.3. GOI and Industry funded projects: In the event IISc receives funding from GOI **and Industry** for academia-industry collaboration projects, the Ownership of intangible property, if any, developed shall be subject to GOI policies.

5.5.4. Industry funded projects: Any tangible property generated or made in the course of research projects funded by the Industry shall be either solely owned or jointly owned by IISc. If the prototype is fabricated at IISc for subsequent off-campus use by the Industry, such equipment may be licensed exclusively/nonexclusively to the Industry. If the tangible property licensed to the Industry is used for profit by the Industry, then

it shall compensate IISc for such use, the terms of such use and the remuneration shall be negotiated through a separate agreement on a case by case basis.

## 5.6. Consultancy Projects

5.6.1. Research based Consultancy project: These kinds of consultancy projects arise when the researcher in addition to providing his/her research skills and/or expertise has to conduct lab work and may involve other Personnel of the Institute, like students, in conducting such work under the project in return for remuneration from an external agency.

In such research based Consultancy projects, IISc will consider Joint ownership of IP with an Industry

- that contributes its Background IP for the development of the Foreground IP to the said Project;
- or
- makes intellectual contributions to the Foreground IP through the participation of its employees in generating IP together with the Institute.

The extent of ownership shall be determined based on the intellectual contribution from each entity. Ownership to any IP generated without any intellectual contribution or any Background IP from the employees of the Industry pursuant to the Consultancy Project shall be owned solely by IISc in India and in countries filed outside India.

5.6.2. Advisory based Consultancy projects: These kinds of consultancies include providing professional services and technical expertise under contract for a third party or any external agencies for a fee and is expertise based. The services include, routine laboratory and other testing of materials, devices, products or produce; analysis of data; surveys, including market and opinion surveys; quality controls/checks; field trials; providing professional advice and opinion using knowledge that is already

present in the open domain. These kind of projects do not necessitate the consultant to conduct any lab work under the project to provide advice.

5.6.3. Any IP that is generated by IISc faculty under the Advisory based Consultancy project will belong to the external agency funding such project. IISc faculty shall be named as an inventor or an author in accordance with the IP law as applicable in the country where such protection is sought. Based on IISc request, the said external agency may consider paying an additional remuneration as a contribution towards the generation of such IP. This may be in the form of one-time payment or a running royalty to be mutually decided on a case by case basis when the IP is generated or the revenue is generated.

5.7. **Assignment/Transfer of Ownership:** IISc may consider transfer of Ownership outside India in a particular field of use to explore the Commercialization of the IP. Please refer to section 9 for terms and conditions of such transfer.

5.8. **Student Fellowship Funding by Companies:** If the Industry is funding only the student academic fellowship then the IP generated by the student shall be Owned by IISc and shall be treated as IISc IP and dealt in accordance with the IP Policy of IISc.

5.9. **Student Internship:** IISc encourages student internship onsite in industry for a period of up to three months and IISc shall not claim any ownership in the IP generated during the student internship for the said three-month period, provided the student does not use IISc's Background IP or IISc resources for generation of such Foreground IP. In the event the student uses IISc Background IP, IISc resources or continues to work in the same area he/she has been assigned at IISc, IISc shall have a stake in the Ownership and the **extent of Ownership** shall be determined on case by case basis. If the student spends more than three months in the Company, the engagement shall be converted into a suitable research project such as Research based Consultancy Project, Collaborative

project/Sponsored project etc. on a case by case basis and shall be dealt as per the policies of IISc.

5.10. **Research under the External Registration Program (ERP):** ERP is viewed as a collaborative research arrangement between the Institute and the employer of the registered student. The Ownership of the IP generated will be shared between the Institute and the employer organization provided the employer has appointed a co-research guide to guide the ERP student and the student is permitted to work in the premises of the employer towards the research problem identified during the enrolment. If the employer organization wishes to exploit such jointly owned Foreground IP commercially, the Institute will grant the organization the first right to negotiate a royalty-bearing exclusive license of the rights held by the Institute within six months from the date of disclosure. The organization's rights in the Joint IP will, however, be limited to the field of application, as identified in the research proposal in the application for external registration. The Institute reserves Ownership of any IP generated in the fields of application not specified in the research proposal and will be free to exploit the IP in those other fields of application without being accountable to the employer organization. In the event the exclusive rights are not exercised by the employer organization, IISc reserves the right of exploiting the IP without accounting to the employer organization including its competitors in the market. If the ERP student leaves the employer midway or is not permitted to use the employer's resources or does not identify a co-guide in the employer's organization or is on unpaid leave to work with IISc fulltime, then, the Foreground IP generated shall be owned solely by IISc and such IP shall be treated as IISc in-house IP.

5.11. **“Contract R&D”:** This form of R&D would arise when a Sponsor/Funding Agency/Industry/Collaborator sets out a specific problem/research agenda/ scope of work in the R&D. The Institute Personnel would essentially be working on the above problem/ research agenda/ scope of work, and the Contract R&D Project would be completely funded by the Sponsor/ Funding Agency/ Industry/ Collaborator, to cover all direct and indirect costs, costs to set up the laboratory, all operating costs and overheads for the independent (out-sourced) execution of the Contract R&D. In such

extreme and rare cases, the Institute may consider the request(s) for exclusive ownership of IP, from the Sponsor/Funding Agency/Industry/Collaborator.

## 6. COPYRIGHT

- 6.1. Unless expressly stated otherwise in this Policy or an agreement, Institute shall be the owner of all copyrights, including for computer software and database, teaching material and technical reports created by Institute personnel. If there is third party funding received for Projects that result in copyrightable work then the IP ownership provisions of this Policy will apply. As a traditional exception, the Institute shall not claim Ownership of copyright on books and publications authored by Institute personnel.
- 6.2. **Exception:** If an Institute Personnel creates software that is not part of his or her normal duties, does not substantially utilize Institute resources, and if the software development is done outside of the normal working hours of the Institute, the Ownership of such software would remain with the Institute Personnel. Unless the Institute has some obligation or special investment in regard to the work leading to the software that would make Institute Ownership appropriate, the intent is to vest Ownership in the student of any software which was created as part of the student's class work, or as part of normal extra-curricular activities.
- 6.3. **Student Thesis:** A student shall own the copyright of his or her thesis or dissertations written as student to satisfy the IISc degree requirements. The student shall grant to the Institute a royalty- free permission to reproduce, publish, and publicly distribute copies of the thesis, in any appropriate form. If a thesis contains information on an Invention or any IP that is protectable, the Institute at its discretion may delay the public dissemination of the thesis, if it intends to seek statutory protection for any material contained within it.
- 6.4. If the Institute hires a third party to perform specific tasks that contribute to a copyrightable work, the rights of such work shall belong to the Institute.

- 6.5. If the Institute Personnel wishes to make the copyrightable work open-source, the Institute Personnel is required to keep IPTeL informed about such intent. Subject to any third-party agreement, the Institute Personnel in consultation with IPTeL can choose the distribution and licensing schemes including free or open source arrangements. In case of disagreements between IPTeL and the concerned Institute Personnel, the matter will be decided by the IPMC.
- 6.6. **Registration and protection of works and Copyright notice**: The Institute will not register or otherwise protect or enforce the copyright in works it does not own. The Institute may register and protect the copyright in a work in which it has some right, title or interest. In those cases where the Institute is the owner, the following notice must be included:

**“Copyright © [year] Indian Institute of Science. All Rights Reserved”**

The date in the above notice should mention the year in which the work is/was first published, i.e., distributed to the public or any sizable audience.

- 6.7. **Copyright Infringement**: It is the duty of the Institute Personnel to respect the intellectual property of others. The Institute supports full utilization of the rights of fair use and the rights granted to educational institutions under copyright law. Where uses of copyrighted works of authorship will exceed those permitted by fair use and other statutory exceptions, permission to use the copyrighted works of authorship should be obtained from the copyright owner. Copyright infringement is a serious violation under the Institute code of conduct and the bylaws.

## **7. INTELLECTUAL PROPERTY ADMINISTRATION**

- 7.1. The Intellectual Property Management Committee (IPMC), appointed by the Director of the Institute, shall oversee and guide the processing and management of the Institute’s IP, including its utilization/commercialization. The IPMC is responsible for reviewing and interpreting this IP policy and for resolving any dispute that may arise in the context of IP and IP management at the Institute. The IPMC will also provide guidelines for

Technology Transfer undertaken by the Institute and for Technology licensing practices of the Institute.

- 7.2. The Office of Intellectual Property and Technology Licensing (IPTeL) is the administrative body of the Institute, reporting to the Director of the Institute and guided by the IPMC, which is responsible for the day-to-day handling of IP matters, dealing with Disclosures of Inventions submitted by the Institute Personnel, arranging for the Evaluation of Disclosures, filing and maintaining Patents and other IP applications, and negotiating Technology Transfer, Licensing, and Commercialization Agreements, Research Agreements, or any other Agreements concerning IP related matters, except as it pertains to start-ups/ faculty entrepreneurs, for which the negotiations on the Technology Transfer and Licensing would be done by SID, and for the Research Agreements by CSSP/CSIC/ SID in consultation with IPTeL and in accordance with this Policy. The disclosure and the evaluation process followed at IISc is provided in Annexure-1 This Annexure-1 is an IISc internal document and will be available only to the Institute Personnel.

## **8. COMMERCIALIZATION/ UTILIZATION OF IISc IP**

- 8.1. As the Sole or Joint owner of any IP, the Institute is entitled to enter into a binding agreement with any party for the utilization of its IP, whether on commercial terms or on non-commercial terms in the public interest, and in a manner consistent with the terms of any agreement involving the R&D project from which IP was generated and read harmoniously with the terms of this policy.
- 8.2. The Institute shall be entitled to grant Licenses, whether exclusive or not including open source licenses, for the utilization and commercial exploitation of Institute IP, or to make such other arrangements as the Institute may deem fit to facilitate Technology Transfer, Licensing, and other means of Commercialization of Institute IP to industry or other entities, while preserving the rights and interests of the Institute and of the Inventor(s). Where Institute IP results from R&D projects funded by Public Agencies or through the resources provided by the Institute, an

exclusive license may **only be granted** if the terms of public funding permit such a license. Any licensing of IP generated from public-funded R&D, including R&D work supported by the Institute, shall comply with applicable national legislation, if any. All Institute IP to be Commercialized will be listed on IPTeL website and the interested parties approaching the Office of IPTeL will be considered for such licenses.

8.3. The cooperation of Inventor(s) with the Institute and with licensees of Institute IP is usually essential for the success of efforts to utilize/Commercialize IP. Therefore, Inventor(s) shall provide all assistance to the Institute both during the effort to protect IP and the later efforts to undertake Technology Transfer, Licensing, and Commercialization. The assistance and active cooperation of Inventor(s) is also required in identifying potential licensees for Institute-owned IP and in negotiations with potential licensees.

8.4. **Commercialization through start-ups:** IISc supports entrepreneurship and the creation of Startup companies as a means of exploiting IISc owned IP. Where an Inventor wishes to develop and Commercialize Institute IP based on his/her Invention, the Institute will generally license such IP exclusively to the Inventor's startup. The Institute may also consider assigning the rights of such Invention(s) partially or completely to the Startup. on a priority basis, as compared to other license seekers, through taking an equity stake in the Start-up Company that such an Inventor might set up and a combination of upfront payment/royalty. Such initiatives may be channeled through SID or other similar bodies formed by the Institute to promote such initiatives. Agreements to enable such Commercialization efforts will be formulated on a case-by-case basis. For guidance and the terms and conditions, SID or a similar body identified by the Institute should be approached.

#### **8.5. Modes of Commercializing IISc owned IP**

8.5.1. The possible modes of Commercializing of IISc owned IP include,

- non-exclusive licensing,
- exclusive licensing,

- exclusive licensing with enforcement rights and
- assignment of ownership under limited conditions
- Open-source licensing

8.5.2. The Institute encourages the development and Commercialization of IISc IP by an Industry for public use. A non-exclusive license allows several companies to exploit an Invention and ensures it meets wider public requirements. Hence, the Institute would prefer to grant a non-exclusive license. However, in some cases, an exclusive license may be necessary to provide an incentive to the Industry to undertake commercial development and production of such Inventions. The decisions will be taken on a case by case basis and will be subject to government of India restrictions.

## **8.6. Licensing of IP generated from IISc in-house projects**

### **8.6.1. Non- exclusive licensing option**

8.6.1.1. If IPTeL and the Inventor(s) are of the opinion that the Intellectual Property intended for Commercialization is applicable for a variety of markets, and **is a ready-to-use product**, IISc will aim for the Intellectual Property to be licensed to several licensees who would Commercialize in each of these different markets creating a potential of multiple revenue streams through the Non-exclusive licensing mode.

8.6.1.2. In this type of licensing, the Licensee is given the non-exclusive right to make, use and sell the given technology without the right to sublicense to others in a particular field of use or/and in a territory.

8.6.1.3. For this purpose, the Licensee shall pay a combination of an upfront licensing fee and an annual royalty which would be a percentage of the revenues generated due to the Invention/other IP rights. This combination will be decided on a case by case basis in consultation with IPTeL.

## **8.6.2. Exclusive licensing option**

8.6.2.1. If IPTeL and the Inventor(s) are of the opinion that the Intellectual Property intended for Commercialization needs a significant amount of product development work yet to be carried out and/or a significant amount of investment to get market clearance from regulatory bodies, IISc may consider licensing the IP to a single licensee through the Exclusive Licensing mode. The interested licensee

- may first enter into an exclusive/non-exclusive trial license agreement as per section 8.10.3.1 to evaluate the Invention  
or
- may enter into a licensing agreement directly.

8.6.2.2. In this type of licensing, the Licensee is given the exclusive right to make, use and sell the given technology by the licensee without the right to sublicense to others in a particular field of use or/and in a territory. For this purpose, licensee shall pay a combination of an upfront licensing fee and an annual royalty which would be a percentage of the revenues generated due to the invention. This combination will be decided on a case by case basis in consultation with IPTeL. Please refer Annexure 2-6 for guidance.

8.6.2.3. IISc, under certain exceptional cases and subject to GOI funding policies and the laws applicable to IISc, may consider granting a license for the IP generated under a Know-how agreement. Under this option, based on the kind of invention generated and the Industry and market requirements, IISc may consider not to seek IP rights and continue to maintain it as IISc's Confidential Information. The terms and conditions of such Know-how license shall be discussed on a case by case basis.

## **8.7. Licensing of IP Generated from GOI funded projects**

The Commercialization terms of all IP generated under GOI funded Projects, shall be subject to the terms and conditions of GOI policies or

the agreement executed with GOI or its agency. In the event that government policies or contracts allow IISc to Commercialize the IP, then such IP shall be considered as IISc funded IP and Commercialized in accordance with section 9.6.

## **8.8. Licensing of IP Generated from Industry funded projects**

### **8.8.1. Sole IISc IP** (See section 5.3.1 for description of Sole IISc IP)

#### **8.8.1.1. Non-exclusive license**

IISc may agree to grant to the Industry that has funded the Project upon request, a non- exclusive license under the following **possibilities**:

##### **8.8.1.1.1. Royalty-bearing licenses:**

- if Industry wants the right to grant sublicenses.
  - if industry **does not** want to bear IP filing and maintenance expenses
- The royalty terms for the aforesaid license shall be determined on a case by case basis.

##### **8.8.1.1.2. Royalty-free licenses:**

- for any non-commercial and internal research and development purposes.
- for Commercial purposes if the Industry bears the IP filing and maintenance expenses in India and in foreign jurisdictions **and** upon a payment of fees. In such cases the scope of Commercialization will be defined very clearly in an appropriate agreement between IISc and industry. The terms of such filing and maintenance expenses may be determined on a case by case basis. The cost of filing and maintenance would have to be committed by industry after the IP is generated. IISc will take the lead in filing. IISc will give the industry a maximum of 6-12 months to arrive at such decisions from the time such information has been conveyed to them on their official email id that is included in the agreement pertaining to the Project.

- in the field of use if the Background IP of the sponsor is part of the Foreground IP and such IP cannot function independent of each other.
- in any one country chosen by the Industry if the funding is substantial.

#### **8.8.1.2. Exclusive License and Royalty Bearing:**

IISc will consider granting an exclusive license to the industry funding the project to make, use and sell the IP without the right to sublicense to others in a particular field of use or/and in a territory. In such cases the scope of Commercialization will be defined very clearly in an appropriate agreement between IISc and industry. The cost of filing and maintenance of IP will be as per section 8.9 below. The licensing fee will be a combination of an upfront payment and a running royalty to be decided on a case by case basis.

If the Industry that funded the Project does not elect for a non-exclusive royalty-free/bearing license to use the Intellectual Property as specified above, then IISc may consider granting an exclusive license to a third party for Commercialization of the Intellectual Property without accounting to the Industry. Such IP shall be treated as IISc in-house IP/Institute IP.

#### **8.8.2. Joint IP:** (IP owned jointly with the Industry as per section 5.3.2)

IISc will consider granting an exclusive royalty bearing license to the Industry funding the project to make, use and sell the given IP without the right to sublicense to others in a particular field of use or/and in a territory. See section 8.10.5 for the licensing procedure. The exclusive license shall be initially granted for a fixed period of about 3 years (based on the technology/IP). In the event the Industry is unsuccessful in utilizing the IP within this Commercialization period, the license shall be cancelled or renegotiated on a case-by-case basis. The licensing fee will be a combination of an upfront payment and a running royalty to be decided on a case by case basis.

#### 8.9. Patent Costs for IP Generated from Industry Funded Projects:

- IISc shall take a lead in filing for an Indian patent or other IP application(s) in consultation with the Industry. Industry shall take over the filing, subject to the Industry entering into exclusive license agreement as detailed in this Policy.
- For IISc sole IP, IISc will bear the expenses for a certain evaluation period, typically 6-12 months, within which time industry is expected to get back to IISc on its interest in maintaining the IP. Post this period, IISc at its sole discretion may decide whether to continue with the filing or otherwise.
- For Joint IP, unless otherwise agreed to in the agreement with the Industry, IISc shall take the lead in seeking appropriate IP protection and may consider bearing the expenses equally in India, and if required for PCT filing. Outside of India, if IISc is not interested in seeking protection in a particular country, then the Industry **can** seek such protection in joint names at its cost. In such a case, the cost incurred by Industry on behalf of IISc may be deducted from the financial benefits to Industry from commercialization or third party licensing before determining the royalty to be paid to IISc. If the Industry is not interested in seeking protection and if IISc needs to pursue such protection, then IISc may continue to seek such protection at its discretion solely in its name and or in joint names.
- For IISc sole and Joint IP, if the Industry seeks an exclusive license, which implies that the Industry expects to commercially benefit from it, then the Industry shall bear the expenses in total for filing and maintaining the patent as part of the license agreement. In such a case, the costs incurred by Industry on behalf of IISc may be accommodated and adjusted in the “cost of licensing” component of agreements to be determined on a case by case basis.

8.10. **Open IP Policy:** IISc pursues an open policy for IP that is typically more than 5 years old. The aim of this open license policy is to enable interested industries to Commercialize IISc IP without upfront payment of fees as would be required in a Trial licensing policy. Interested companies

need to register at the IISc portal before embarking on such a process and get a permission to do so.

**8.11. Trial Licensing:** The companies/organizations interested in seeking a trial license, may approach IISc for a Trial Licensing agreement. A exclusive or non-exclusive trial license can be obtained by paying a nominal fee for a certain period of time, to be decided on a case by case basis but limited to a maximum period of 12 months before finalizing on the terms and conditions of the full license agreement.

## **9. ASSIGNMENT/TRANSFER OF OWNERSHIP**

Being a publicly funded university, IISc does not encourage complete transfer of ownership in India. However, outside India, although IISc prefers to grant an exclusive license as per section 8 or if required an exclusive license with all substantial rights including litigation rights, at times industry might want complete transfer of ownership such as for instance for the option of cross licensing or better enforcement of rights in jurisdictions outside of India. Therefore, based on the situations outlined below, IISc may consider assignment/transfer of ownership of Sole IISc IP or Joint IP as follows:

**9.1. IP Generated from IISc funded projects (IISc in-house Projects):** For IP that is filed in India, transfer of ownership shall not be possible, however, for IP filed outside India, transfer of ownership may be considered under the following situations:

- Licensee is ready to invest substantially in the development of the IP or
- Licensee is likely to be the only practical user of the resulting inventions or
- Licensee is going to provide its proprietary IP that would combine with IISc IP to add more value.

**9.2. IP Generated from GOI projects:** See section 8.7.

### 9.3. IP Generated from Industry funded Projects

9.3.1. **IISc sole IP:** For IISc sole IP, ownership in India shall NOT be Assigned. Outside India, IISc may consider sharing/complete transfer of Ownership in one or all of the following situations. This can happen when The Industry:

- is interested in making substantial investment in the development of the technology that is the subject of the IISc's research (A pharmaceutical company that has expended resources to validate through clinical studies an IISc developed drug is an example) or
- is likely to be the only practical user of the resulting inventions or
- has provided proprietary information, technology, or
- has provided material which is the basis of the research and becomes the Background IP.

9.3.2. **Joint IP:** Ownership rights held by IISc shall not be transferred/Assigned in India. For countries outside India, IISc may consider transfer/Assignment of IISc share in the ownership in one or all of the following situations. This can happen when the Industry:

- is willing to bear expenses that IISc cannot. IISc may agree to **transfer** the ownership with the Industry sponsoring the Project in the countries where IISc cannot bear the expenses and
- is interested in making substantial investment in the development of the technology that is the subject of the IISc's research (For eg: A pharmaceutical company that has expended resources to validate through clinical studies an IISc developed drug) or
- is likely to be the only practical user of the resulting inventions or
- has provided proprietary information, technology, or
- has provided its Background IP which is the basis of the research and becomes the part of the Foreground IP.

### 9.4. Remuneration terms for transfer or sharing of Ownership rights

9.4.1. Industry's request for complete transfer of Ownership or Assignment will be considered. Fees will be determined on a case by case basis. Industry will be responsible for maintaining the IP. These will be greater than that for an Exclusive License.

9.4.2. In cases when the Sponsor acquires Ownership of IP, IISc will continue to retain a royalty-free license right to use the Intellectual Property for any non-commercial purpose, research and teaching purposes and may retain the right to sublicense for non-commercial, research and teaching purposes.

## 10. INSTITUTE PERSONNEL IP RIGHTS AND DUTIES

10.1. All knowledge generated by Institute Personnel is IP and is owned by the Institute as per the bylaws of the institute.

10.2. Nothing in this policy shall limit or restrict the right of Institute Personnel to publish the results of their research, other than the terms and conditions of the funding source.

10.3. When the Institute Personnel would like to protect their IP, publication will have to be subjected to reasonable delays to preserve Intellectual Property Rights.

10.4. Research Agreements entered into by the Institute with external entities or individuals must be consistent with the primary interest of the Institute in the prompt public dissemination of its academic and research output.

10.5. Delays in publication required by the Institute or third parties in sponsored research agreements, as a general rule, shall not exceed 90 days from initial disclosure of the Intellectual Property to IPTeL or the funding agency. However, the period may be further extended with the consent of the respective Institute Personnel, if there is a requirement of protecting any IP.

10.6. **Third Party funding**: The Researchers may dedicate the IISc owned IP generated pursuant to research projects funded by third party to the public domain, thereby foreclosing the possibilities of protecting the IP or licensing without seeking permission from IISc subject to funding

agency terms and conditions. It is the responsibility of the IISc researcher to be aware of the terms and conditions related to the funding of his or her project. IPTeL, IISc, upon written request by the Inventor/s and to the extent permitted by law and third-party agreements will not insist that IP generated or to be generated by IISc researchers should be protected by patents or other forms of IPR. In cases where the terms and conditions of the funding project require IP protection, a researcher may still request IPTeL, IISc that the intellectual property he or she developed be published and made available to the public without restriction on use. IPTeL shall look into such a request to see if it may be fulfilled or if whether the intellectual property should be protected in some form. The Researcher's request may be considered by IPTeL in its broad discretion, and accorded due weight and deference, consistent with the overall objectives of the Intellectual Property Policy, potential commercial interest, requirements imposed by law, Background IP, agreements with Industries or Collaborators and the rights and interests of co-researchers including students.

- 10.7. Institute Personnel are required to disclose Inventions, discoveries and other Intellectual Property to IPTeL in a thorough and timely manner as stated above when they either want to protect their IP or are required to do so by the terms and conditions of the funding that was used to generate the IP.
- 10.8. Institute Personnel should abide by all commitments made in license, sponsored research and other agreements and comply with all laws and regulations related to public and privately funded research.
- 10.9. Institute Personnel cannot sign or enter into legal agreements with a third party. Only the Registrar and/or the Director as the case may be as per the Institute's Scheme, Regulations and Bye-Laws is authorized to sign legal agreement(s) with a third party on behalf of the Institute.
- 10.10. Institute Personnel cannot file for IP protection by themselves without the knowledge and approval of IPTeL.
- 10.11. The Inventor shall also provide such assistance as may be necessary throughout the technology transfer process to realize the goals and objectives of this policy

- 10.12. The Institute Personnel shall ensure that he or she does not enter into multiple agreements for the same technical scope of research work to avoid conflicts. In the event of a conflict or if the said Personnel foresees any possible conflict, he or she should inform and work with IPTeL to resolve such issues.
- 10.13. If the Inventor is seeking for appropriate IP Protection or has entered into an agreement with a funding agency, the Inventor shall keep the nature and all matters relating to the IP confidential until the fact and manner of disclosure is agreed by IPTeL.
- 10.14. The Institute personnel shall ensure that contracts are put in place with third parties involved in a project involving existing IP or the creation of new IP preferably before the start of the collaboration.
- 10.15. Inventors shall assist in protecting the Institute's rights to the IP by keeping suitable records of its creation (wherever necessary drawing on guidance from the Specialist IP advisors) and co-operating with any registration activity. In case IPTeL recommends seeking statutory protection for an IP, the Inventor(s) shall cooperate promptly and fully with the Office of IPTeL and the Patent Attorney chosen from a panel of attorneys approved by Institute, to prepare the application to file for protection in the jurisdictions recommended, including preparation of supporting documents, forms, affidavits and authorizations.

## **11. REVENUE SHARING WITH INVENTORS**

- 11.1. Except as otherwise provided in this policy, the following scale would apply to apportion, among the Inventor(s) and the Institute, any Technology Transfer Fees, Lump sum payments, and Royalty(ies) received through the Technology Transfer, Licensing, and Commercialization efforts of the Institute-owned IP, on a half yearly basis in the months of October and April.
- 11.2. For all Revenues (Technology Transfer Fees plus Lump sum payments plus Royalties) up to Rs. 50 Lakhs a 70/30 ratio will be used with 70% being in favour of the Inventor(s) and 30% to the Institute after deducting the expenses involved in IP protection and Technology Transfer if any.

- 11.3. For all Revenues in excess of Rs. 50 Lakhs:
- For the first Rs. 50 lakhs a 70/30 ratio as above will be used.
  - For the amounts in excess of 50 Lakhs 20% of the Revenues in excess of Rs. 50 lakhs will be remitted as Overheads to the Institute. To the balance amount a 70/30 ratio will be used with 70% being in favour of the Inventor(s) and 30% to the Institute.
- 11.4. The Institute may at times accept equity in the Licensee Company as part of the license fee. The inventor's share in such equity granted to the Institute shall be decided on a case-by-case basis.
- 11.5. In the event of any inconsistency with national legislation or government policies concerning IP revenue sharing, the respective legislation or government policies shall prevail.
- 11.6. Where the Institute Licenses Institute-owned IP to the Inventor(s), for example, under a Student or Faculty Entrepreneurship Program, to a start-up Company started by the Inventor or where the Inventor is directly or indirectly involved in the activities of the said Company, through the SID, or any other initiative within or outside Institute, the Institute may accept equity and/or royalty in the start-up Company as part of the License Fee. Such equity shall vest solely with the Entity created to hold such equity or with IISc with no share to the Inventor(s). Royalty will be shared with the inventors as per section 11.
- 11.7. Apportionment amongst Individual Inventors: Where more than one Inventor is involved, initial responsibility for agreeing to the division of the Inventors' share of revenue amongst them shall lie with those Inventors. The revenue would be shared based on the apportionment provided by the concerned Institute Faculty or the primary Inventor.
- 11.8. Cessation of employment either by resignation, retirement, or completion of project/ course, under normal circumstances, will not affect an individual's right to receive a share of "Royalty(ies)", provided the IP/revenue was generated during the due course of their employment or association with the Institute. Such cessation shall not also absolve the Institute Personnel from their obligations towards confidentiality or the procurement/registration of IP in so far as executing necessary documents

and/or assisting attorneys of the Institute towards the objectives of the Institute are concerned.

11.9. In the case of the death of the Inventor, any due share of the revenue will be paid to the legal representatives of the deceased.

## **12. RESEARCH & DEVELOPMENT (R&D) AGREEMENTS**

12.1. As part of its R&D programs, the Institute enters into agreements for funding and/or collaboration with other entities, such as universities, research institutions, industry, and funding agencies, including government agencies and foundations. Such agreements include Memorandum of Understanding (MOU), Research Agreements, Non-Disclosure Agreements (NDA), Material Transfer Agreements (MTA), Material Testing Agreements (MEA), Technology Transfer Agreements, and Technology Licensing Agreements. To ensure that such Agreements are in compliance with the IP Policy of the Institute and to protect the interest of the Institute fully, the Institute has prepared templates for each of these Agreements. These templates shall be used in preparing any such Agreement, regardless of the channel of the Institute through which the agreement is routed such as CSSP, CSIC, SID and others as the case may be. As specific details of an Agreement may vary from case to case, the templates can be customized for a particular case, while preserving the interests of the Institute.

12.2. Where template agreements are provided to the Institute, as when public funding agencies and foundations are involved, the Registrar's Office acting through IPTeL shall ensure that such templates are in compliance with the IP Policy of the Institute.

12.3. Where template Agreements are provided by industry, the Registrar's Office acting through IPTeL shall ensure that the IP and other relevant or connected terms of the agreement are consistent with the IP Policy of the Institute, even though the preferred mode of entering into agreements with industry would always be to use templates prepared by the Institute for such engagements.

- 12.4. Contracts: All Agreements entered into by the Institute which may involve IP, including Memorandum of Understanding (MOU), Research Agreements, Non-Disclosure Agreements (NDA), Material Transfer Agreements (MTA), Material Testing Agreements (MEA), Technology Transfer Agreements, and Technology Licensing Agreements, Consultancy Agreements etc., shall be consistent with the provisions of the IP Policy. The Inventor(s)/ Institute Personnel also need to disclose, at the time of submission of the Invention Disclosure Form (IDF) to the Office of IPTeL, whether (t)he(y) have signed any such Agreement(s).
- 12.5. All the R&D and consultancy agreements of the Institute must follow the below mentioned basic principles in the structuring of the interactions among the Inventor, the Institute and the funding agency.
- 12.5.1. Publication: All the Public dissemination of research results must not be compromised. The publication of research results must not be hampered by agreements made to commercialize intellectual property. However, a minimal and defined delay to protect intellectual property through patent applications may be included which may not go beyond 90 days. Inventors may be required to observe confidentiality and non-disclosure agreements covering defined funding agency intellectual property. The covered property must be clearly identified in the agreement.
- 12.5.2. Scientific Integrity: The scientific integrity of the creator must not be compromised. Any agreement should not compromise or appear to compromise the design, conduct or reporting of research conducted by the creator or the university.
- 12.5.3. All contracts must conform with Indian statutes and regulations. The terms of any agreement must be in conformance with applicable laws and regulations, including the tax code to avoid jeopardizing the Institute's tax-exempt status. The terms of an agreement must not be in conflict with existing licensing or research agreements.
- 12.5.4. Indemnification: The funding agency will normally be required to indemnify the Institute with respect to general liability, product liability and/or infringement claims related to licensed intellectual property to be used in any project. In addition, the Institute requires the contracting party to indemnify the Institute from any claim, loss, cost, expense or liability

of any kind that may be incurred by the External party, due to the use of the results, deliverables or IP generated in any R&D Project, including manufacturing defects, production problems, design guarantee, up gradation and debugging obligation.

12.5.5. Warranties: As the research is conducted only on a reasonable efforts basis and is experimental in nature, the results or deliverables that are generated under the various research projects are provided “AS- IS” and without any representation or warranty of any kind, expressed or implied including warranty of merchantability or fitness for any particular purpose or any warranty that any use will not infringe or violate any patent or other proprietary rights of any other person or organization.

12.5.6. Dispute Resolution: In the event of any differing viewpoints, interpretations of the Agreements or dispute between the Institute and the other external party, efforts shall be made to settle the issue amicably and expeditiously by mutual consultation or negotiation. Should such an amicable settlement prove to be impossible, the parties shall consider arbitration mechanism under the Indian Arbitration and Conciliation Act 1996, any statutory modification or re-enactment thereof, to resolve the differences. The seat and place of arbitration shall be Bangalore.

12.5.7. Signatory: Agreements of all types (covered by this IP Policy) entered into by the Institute are considered to be valid and binding only when signed by the Registrar of the Institute or his or her representative. To ensure that the relevant Institute personnel are aware of the terms of a given Agreement, each Agreement is to be witnessed by one of the Institute personnel whose effort will be central to meeting the obligations of that Agreement.

12.5.8. Governing Law: As a policy, all contractual agreements entered into by the Institute shall have the jurisdiction of the Courts in Bangalore and shall be governed by appropriate laws in India.

12.5.9. Audit of Accounts and Records: The Institute shall retain the right to audit the accounts and records of the Licensee for any Institute licensed IP. In the event of any discrepancy in the account and records, Licensee shall pay the reasonable costs of the audit incurred by the Institute. The

Licensee is required to maintain separate account and records for the Licensed IP of the Institute.

- 12.5.10. Infringement: Institute shall retain the right to engage in or desist from any litigation concerning IP and license infringements including patents, copyright, and design.

### 13. GENERAL SECTIONS

13.1.Regulatory Section: The Institute, through its Agents, Attorneys or Advocates, shall ensure that all its R&D conducted independently by the Institute Personnel discussed in this IP Policy, is not in violation of any regulatory law or any other law operational in India. In case of Collaborative R&D discussed in this IP Policy, the Institute should ensure that the concerned Agreement which governs the Collaborative R&D clearly spells out the responsibility of obtaining necessary regulatory approvals that may be required under the law for conducting said research or later actions thereto.

13.2.Waiver of the IP Policy: The Institute shall have the discretion to waive or vary any or all of the provisions of this IP Policy, or any of the rules or guidelines framed there under, in a particular case. Such discretion shall lie solely with the Director of the Institute. A waiver on one occasion and for a particular case shall not be deemed to be a waiver or variation or act as a precedent for a waiver or variation of the same or any other provision on a future occasion or for a future case.

13.3. Amendment of the Provision and Guidelines of the IP Policy: The Institute shall review the IP Policy once a year and may amend the provisions and guidelines set out in the IP Policy from time to time as required. The Institute shall notify the Institute Personnel of such amendments as soon as possible. The amendments shall be in full force and effect on the date the amendments have been announced by the Institute to take effect.

13.4.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-company, then they are

required to disclose the stake they and /or their immediate family have in the company, and license or an assignment of rights for a patent to the licensee - company in such circumstances, shall be subject to the approval of the IP Management Committee.

13.5.Dispute Resolution: In case of any disputes between IISc and the Inventor(s) regarding the implementation of the IP policy, the inventor(s) may appeal to the Director of IISc. The Director's decision in this regard would be final and binding on both institute and Inventor.