

INDIAN INSTITUTE OF TECHNOLOGY (BHU) VARANASI
INTELLECTUAL PROPERTY POLICY DOCUMENT

1. Introduction

The Institute recognizes the need for encouraging the practical application and economic use of the results of research carried out at the Institute for the benefit of the general public; therefore it adopted the following Policy on Intellectual Property.

The present Policy relates to the ownership, protection and commercial exploitation of Intellectual Property created by Researchers in the course of their duties or activities at the Institute. The document sets out the rules of the Institute for sharing of the economic benefits arising from the commercialization of Intellectual Property.

This policy aims to:

- i) Promote, encourage and aid scientific investigation and research;
- ii) Provide legal certainty in research activities and technology-based relationships with third parties;
- iii) Set out the Institute's procedures on the identification, ownership, protection and commercialization of Intellectual Property;
- iv) Ensure the timely and efficient protection and management of Intellectual Property;
- v) Ensure that economic benefits arising from the commercialization of Intellectual Property are distributed in a fair and equitable manner recognizing the contributions of the Inventors, the Institute as well as any other relevant stakeholders;
- vi) Enhance the reputation of the Institute as an academic research institution and a member of society as well as the reputation of the Researchers through bringing the research results to public use and benefit.

2. Definitions

- A. **"Intellectual Property"** means inventions, technologies, developments, improvements, materials, compounds, processes and all other research results and tangible research properties, including software and other copyrighted works which include but not limited to Patents, Trademarks, Copyrights, Trade Secrets and other species such as computer software or printed material, any new and useful process, machine, composition of matter, life form, article of manufacture, software, copyrighted work, such things as new or improved devices, circuits, chemical compounds, drugs, genetically engineered biological organisms, data sets, software, musical processes, or unique and innovative uses of existing inventions. For the purposes of these Ordinances Intellectual Property may or may not be patentable or copyrightable.

*Approved
in BoG
9/11/2020
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Know-how means the knowledge, innovations, practices, expertise, processes or procedures, and secrets of individuals regarding the use of a material, product or resource, or the practice of a method, for a particular purpose

Publication means a public enabling disclosure of an Invention, and may be verbal or printed. Printed publications include abstracts, student theses and, in certain instances, grant proposals.

Patent and Patentable material Patent and Patentable materials are as defined in Indian Patent Act. These include discoveries and inventions of new products and process.

B. "Intellectual Property Rights" (IP Rights) means ownership and associated rights relating to Intellectual Property, including patents, rights in utility model, plant breeders rights, rights in designs, trademarks, topography rights, know-how, trade secrets and all other intellectual or industrial property rights as well as copyrights, either registered or unregistered and including applications or rights to apply for them and together with all extensions and renewals of them, and in each and every case all rights or forms of protection having equivalent or similar effect anywhere in the world.

C. "Inventor" means the Researcher who contributed to the creation of the Intellectual Property

The inventor may be the faculty, staff, student and other persons employed by the Institute whether full or part-time; visiting faculty and researchers; and any other persons, who create intellectual property using Institute resources.

D. "Researcher" means:

- i) persons employed by the Institute, including student employees technical staff and project staff
- ii) students, including graduate post graduate and doctoral students of the Institute
- iii) any persons, including who use the Institute resources and who perform any research task at the Institute or otherwise participate in any research project administered by the Institute, including those funded by external sponsors.

E. "Visiting Researcher" means individuals having an association with the Institute without being either employees or students. "Visiting Researchers" includes academic visitors, individuals with honorary appointments in the Institute and emeritus staff.

F. Institute Research means any research or development activity which is undertaken by the Institute, or which is related to duties and responsibilities for which a person is compensated by the Institute, or which is conducted with substantial use of Institute facilities, or resources.

G. "Institute resources" means any form of funds, facilities or resources, including equipment, consumables and human resources provided by the Institute either in a direct or indirect way.

H. Substantial use of Institute facilities or resources means the regular utilization of Institute facilities, equipment, personnel or other resources owned by the Institute directly or indirectly.

I. Direct expenses are the costs associated with the development, protection, maintenance and licensing of intellectual property.

J. Invention Disclosure means a written description of an invention that is confidentially made by the inventor to the Institute.

K. Confidential Disclosure means an agreement between disclosing and recipient parties, or a term in a Research Contract or License Agreement.

L. Assignment means the transfer of rights or title in the Intellectual Property in writing.

M. "Commercialization" means any form of exploitation of Intellectual Property, including assignment, licensing, internal exploitation within the Institute and commercialization via a spin-off enterprise or any other means in practice.

N. "Agreement" may refer to Allegiance, Affirmation and Confidentiality Agreement, Evaluation Agreement, License Agreement, Technology Transfer (Commercialization) Agreement, Alternative Dispute Resolution Agreement, Classified Information Non-Disclosure (specific) Agreement and any other type of agreement concerning research pursued by Researchers and/or Intellectual Property created at the Institute.

3. Scope of the Policy

This Intellectual Property Policy apply to faculty, staff, graduate students, post-doctoral fellows, and non-employees (including visiting faculty, affiliate and adjunct faculty, industrial personnel, fellows, etc.) who participate in research projects in the Institute.

This Policy shall apply to all Intellectual Property created on or after [date] and all IP Rights associated with them. This Policy shall apply to all Researchers who have established legal relationship with the Institute based on which the Researcher is bound by this Policy. Such a legal relationship may arise pursuant to the provision of law, collective agreement or individual agreement

The present Policy shall not apply in cases in which the Researcher entered into an explicit arrangement to the contrary with the Institute before the effective date of the Policy, or the Institute previously entered into an agreement with a third party concerning rights and obligations set out in this Policy.

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4. Intellectual Property Ownership

A. IIT-BHU Ownership

1. Intellectual property of any kind created by Inventor(s) of the Institute and faculty, students, staff, project staff, visitors and others, such as trainees from other institutes, participating in IIT-BHU programs or using IIT-BHU funds or facilities, are owned by IIT-BHU when either of the following applies:
 - a) The intellectual property was created with the substantial support of the Institute in form of funds or facilities owned / administered by IIT-BHU.
 - b) The intellectual property was created (i) as a part of the normal professional duty or (ii) work for hire.
 - c) The intellectual property was created in the course of or pursuant to a sponsored/consultancy research agreement with IIT-BHU. In such cases, specific provisions related to IP made in contracts governing such activity will determine the ownership of IP.
 - d) The intellectual property was created as a part of academic research and training leading towards a degree or otherwise.

B. Inventor Ownership

1. Inventors/Authors will own intellectual property when none of the situation defined above for IIT-BHU-ownership of intellectual property applies
2. After evaluation of IP, if IIT-BHU decides not to take the responsibility for the protection of the IP, then it will assign all the rights of the IP to the inventors.

C. Third-Party Ownership

1. Ownership of intellectual property resulting from:
 - a) Funds provided partially or fully by a third-party to IIT-BHU will be governed by specific provisions in the contract (MoU/MoA) between the third-party and IIT-BHU.
 - b) Exchange programs between IIT-BHU and other institutions will be governed by specific provisions in the contract (MoU/MoA) between the third-party and IIT-BHU.
 - c) In case no such specific contract exists, IPR will remain with IIT-BHU.
2. In cases of all IP produced at IIT-BHU, IIT-BHU shall retain a non-exclusive, free, irrevocable license to copy/use IP for teaching, research activities and commercialization consistent with confidentiality arguments where ever entered by IIT-BHU.
3. In cases where an IP is created by IIT-BHU personnel, fully or as a part of the team, during deputation, official leave, or sabbatical, the concerned IIT-BHU personnel should officially communicate the IP to IIT-BHU. If the IP involves ideas/software developed, fully or in part, using significant institute resources, then the IP will also be owned by IIT-BHU fully or partially, as the case may be.

5. Disclosures, Confidentiality and Assignment of Rights

1. For sponsored and/or collaborative work the provisions of the contract pertaining to disclosure of IP are applied.
2. For all other IP produced at IIT-BHU, the inventors will be required to disclose their IP to IPR Evaluation Committee or IPR Coordinator and Dean R&D (if required).
3. The inventor shall assign the rights of the disclosed IP to IIT-BHU before leaving the institute and will agree to the terms and conditions for the sharing of any financial benefits received by the institute by commercialization of such IP.
4. Having made the disclosure, the inventors, both IIT-BHU and non-IIT-BHU personnel, shall maintain confidentiality of the IP during the period it is pending with IIT-BHU for the assessment of the possibility of commercialization and protection of IP, unless authorized in writing by IIT-BHU.

6. Contracts and Agreements

All agreements related to IP undertaken by any IIT-BHU personnel and students need to be approved by the institute.

The Dean (R&D), with specific approval of the Director, will be the authorized signatory for all such agreements.

7. Commercialization

1. IIT-BHU or Inventor shall market the IP and identify potential licensee(s) for the IP to which it (i) has ownership and (ii) for which rights have been assigned to it. Inventor(s) will request for technology transfer providing details as per the Intellectual Property Disclosure Form (Annexure-1) directly or through any agency or third party.
2. For the IP where exclusive rights have not already been assigned to a third party, the inventors may also contact potential licensee(s) on their initiative maintaining confidentiality and taking all necessary care to ensure that the value of the IP is not affected.
3. It is suggested the technology transfer should be non-exclusive or if exclusive then for a short time period say 2 years.
4. The valuation of the technology should be done by the inventor(s) followed by R&D committee of the concerned Department/School for "one time Earning" and "Royalty" based on the Intellectual Property Disclosure Form (Annexure-1). Inventor(s) and the R&D committee of the Department/School must ensure that technology (IPR) is properly advertised (Institute website and by informing technology related industries) and efforts have been made to get best buyer by the inventor(s). Inventor & Departmental R&D committee should consider the total expenditure on the development of technology and also protection of IPR while valuation of technology (IPR).

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5. Recommendation of the Departmental R&D committee will be processed through the Coordinator IPR Cell and Dean R&D for approval of the Director. After approval Inventor may provide Confidential Disclosure through agreement to recipient party after receiving the one time grant and agreement for Royalty.

8. Revenue Sharing

1. The net earnings from the commercialization of IP owned by IIT-BHU would be shared as follows:

Case	Net earnings	Inventor(s)	IIT-BHU's Share	Department/School Share
1	For the amount upto 50 lakhs	65%	25%	10%
2	For the amount above 50 lakhs	45%	45%	10%

2. The Inventor(s) share would be declared annually and disbursement will be made to the inventor(s), their legal heir, whether or not the inventors are associated with IIT-BHU at the time of disbursement.
3. Co-inventors of IP shall sign at the time of disclosure, a distribution of IP Earnings' Agreement, which shall specify the percentage distribution of earnings from IP to each co-inventor. The inventors may at any time by mutual consent revise the Distribution of IP Earnings Agreement.

9. Infringements, Damages, Liability and Indemnity Insurance

1. As a matter of policy, IIT-BHU shall, in any contract between the licensee and IIT-BHU, seek indemnity from any legal proceedings including without limitation manufacturing defects, production problems, design guarantee, upgradation and debugging obligation.
2. IIT-BHU shall also ensure that IIT-BHU personnel have an indemnity clause built-into the agreements with licensee(s) while transferring technology or copyrighted material to licensees.
3. IIT-BHU shall retain the right to engage or not in any litigation concerning patents and license infringements.
4. IIT-BHU shall have all the rights to discontinue a patent application, to withdraw it, or not to maintain a granted or registered right.

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10. Conflict of Interest

The inventor(s) are required to disclose any conflict of interest or potential conflict of interest. If the inventor(s) and/or their immediate family have a stake in a licensee or potential licensee company then they are required to disclose the stake they and/or their immediate family have in the company. Under these circumstances, it must be ensured by the inventor(s) that their entrepreneurial activities do not have an adverse impact on inventor(s) teaching, research and any other institutional responsibilities. In this case inventor(s) will not get any share in revenue (item VI).

11. Dispute Resolution

In case of any disputes between IIT-BHU and the inventor(s) or the licensee(s) regarding the implementation of the IP policy, the aggrieved party may appeal to the Director, IIT-BHU. Efforts shall be made to address the concerns of the aggrieved party. The Director's decision in this regard would be final and binding.

12. Jurisdiction

As a policy, all agreements to be signed by IIT-BHU will have the jurisdiction of the courts in Varanasi or High Court Allahabad and shall be governed by appropriate laws in India.

Signature
9/12/2020

Signature

ANNEXURE I
Intellectual Property Disclosure Form
Indian Institute of Technology (BHU) Varanasi

Title of the invention:

Innovator(s):

Name:

Position:

Department:

Phone:

E-mail:

Brief description of the invention:

How does this invention relate to new processes, machines, compositions of matter, etc.? Please cover the following points:

- (a) Describe the invention so that the R&D Committee of the Department can evaluate the technical and commercial merits of the technology.
- (b) What are the advantages of the present invention over the comparable inventions?
- (c) Has the invention been tested experimentally? Are experimental data available?
- (d) Has the invention been patented or protected under confidentiality agreement?
(Please use additional sheets to elaborate and to attach sketches, drawings, photographs and other materials that help illustrate the description).

Commercial potential:

What are the

- (a) Possible uses/application areas and/or products you feel may embody aspects of your technology and
- (b) Possible end-users
- (c) Potential marketability including commercial suggestions viz.,
 - (1) input required,
 - (2) production capacity where applicable,
 - (3) raw material requirement,
 - (4) target companies and countries,
 - (5) economic data,
 - (6) potential long-term commercial interest.

(Please provide as much information as possible; attach extra sheets if required)

Prior disclosure and possible intent:

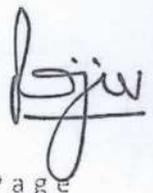
Has the invention been disclosed to entrepreneurs, industry representatives or third parties? Has any commercial interest been shown in it and of what nature? Name companies and specific individuals and their titles.

Provide efforts made to advertise the invention and technology:

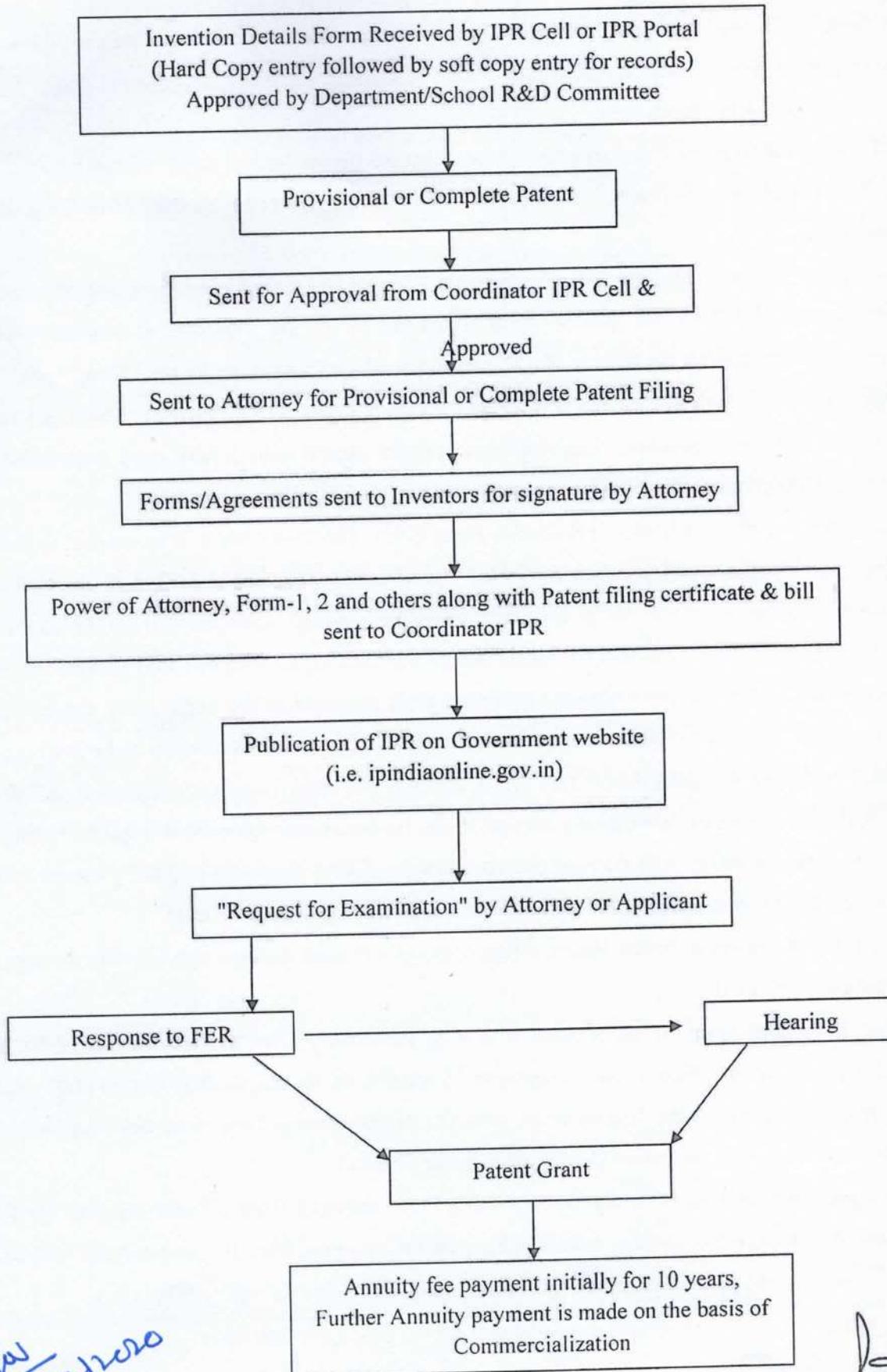
Terms & conditions for technology transfer. Please indicate the extent of fees in lump sum and royalties that is to be contemplated.

Signature of Inventor with date

Signature of Inventor with date



Patent filing Process



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How to Apply for a Patent at IIT-BHU

- In order to proceed with Patent/Design filing of your research work as a Product or Process. Inventors are advised to do a preliminary search on Google Patents (<https://patents.google.com/>), or other free patent search sites.
- After ensuring from the Prior art search Report that the Invention does not previously exist in the form of Patent or Non-Patent Literature, Inventors should proceed with the Patent filing of the Invention.
- For filing a Patent or Design, there is a specific Form of IPR Cell (coordinator.ipr@itbhu.ac.in) after completely filing the form & with signatures of all the inventors at required places, Inventor should submit the form to HoD/Coordinator of the Department/School for approval.
- HoD/Coordinator will discuss the IPR in the R&D committee of the Department/School having inventors as invited member. After approval Inventor should submit hard copy (forwarded by the HoD/Coordinator) & online soft copy to Coordinator IPR Cell.
- After approval of Coordinator IPR Cell & Dean R&D, The Invention will be subject to Patent filing, the invention will be send to one of the empanelled Patent attorneys of IIT-BHU or inventor may file directly to Indian Patent office by the inventor (on request) as per the norms.
- At the time of draft preparation of Patent/Design application, the attorney may contact the first Inventor (or as per the prior request) regarding draft approval of the application; the inventor may provide his input to the attorney and ask for any modification/rectification in the draft.
- To file the Patent Application at Patent office, attorney will send forms and assignment of IPR to IIT-BHU form, Form-1, 2 etc to the Inventors, the Inventors are supposed to sign the Forms in original copies & return it to attorney directly. (All the Forms should be originally signed by all the inventors, Photocopy/Scanned signatures are liable for rejection of patent)
- After filing the patent to Indian Patent office, attorney will send document to inventor & copy to Coordinator IPR Cell.
- Patent filing and grant of certificates is a long procedure, after the submission of Patent application at Patent office, it may takes upto 18 months for the Patent Application publication and upto 48 months for the Examination, after the examination if there is no objection/hearing by the examiner, then the Patent Certificate is being Granted.
- Patent maintenance fees (Annuity fees) is being made annually from 3rd year onwards for the granted Patents, Initially annuity fees is being paid for 10 years, after 10 years annuity fees will only be paid on the basis of commercialization aspect of the Technology.
- In any case IIT-BHU will remain the Applicant for the Patent application.

