

**INTELLECTUAL
PROPERTY
RIGHT
POLICY
(2018)**



**NATIONAL INSTITUTE OF TECHNOLOGY,
SILCHAR**

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SECTION 1

INTRODUCTION

1.1 PREAMBLE

As joint ventures of the Government of India and the respective State Governments, the 15th Regional Engineering College (REC) was established at Silchar, Assam in the year 1967 with the prime objective of imparting quality technical education throughout the country and to foster national integration. Functioning for more than 3 decades as a REC, the institute was transformed and upgraded to National Institute of Technology, Silchar (NITS) (An Institution of National Importance) with the status of Deemed University on 28th June 2002 on the basis of the report of the High Powered Joint Expert Committee of AICTE and UGC under the chairmanship of Prof. S. K. Joshi, Director General of Council for Scientific and Industrial Research (CSIR). Presently, NITS has dedicated itself in providing the technical manpower and know-how with a mission of remaining one of the leading centers of teaching, research and extension in Engineering and Technology through total commitment to excellence in every endeavor.

In this contemporary world, Intellectual property (IP) plays a vital role in preserving and commercializing the intellectual outcome of an Institute. The Intellectual Property Rights (IPR) Policy of the institute is needed not only to preserve the output of NITS but also to create awareness among the faculty, staff and students of NITS and to know about its influences in the world at large. This Intellectual Property Rights (IPR) policy of the institute is expected to promote a competitive and conducive environment for both the curiosity driven and market-driven research and development activities conducted at the Institute level so as to protect the creation of original works of authorship. Also, it is in consonance with the National IPR Policy of Government of India, 2016.

1.2 PURPOSE

The purpose of the IPR policy of NITS is to:

- I. Provide a conducive environment leading to the development of Intellectual Property.
- II. Facilitate, encourage, promote and safeguard scientific inquiry, research pursuits and the academic freedom of its faculty, researchers and students.

- III. Provide a clear understanding of the rights and responsibilities of the faculty, staff, and students so as to protect the interests of the Institute and its members
- IV. Establish an IPR management policy and procedural guidelines for converting the knowledge generated in the Institute to wealth through IP commercialization
- V. Enabling the Institute to secure sponsored research funding at all levels of research
- VI. Empowering the Institute to make beneficial use of such developed IP for the maximum possible benefit of the creators, the Institute, and the Nation at large.

1.3 OBJECTIVES

The objectives of the IPR policy of NITS are as follows:

- I. To protect the intellectual property generated in the Institute from the scientific tasks and offer a scope for wealth generation;
- II. To urge all faculty, staff and students to document their IP, so that it could be protected and applied to the gain of the country, the institute and the concerned inventors;
- III. To provide a single window interference system for all IPR related issues;
- IV. To provide legal support, wherever necessary, to defend and protect the intellectual property rights obtained by the Institute against any infringement/ unauthorized use;
- V. To create an environment for acquiring new knowledge through innovation and research, compatible with the educational vision and mission of the Institute;

1.4 TYPES OF INTELLECTUAL PROPERTY

The intellectual properties has been broadly classified and illustrated as follows:

- a) Patents
- b) Copyrights
- c) Trade/Service marks
- d) Industrial designs
- e) Software programmes
- f) Business models

1.5 DEFINITIONS

- a) **Patent** is the exclusive right granted for a particular invention, which may be a product or a process for providing a new way of execution or bring a new technical solution to a problem.
- b) **Copyright** is an exclusive right given to the author of the original literary, architectural, dramatic, musical and artistic works; cinematograph films; and sound recordings.
- c) **Trade/Service mark** means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colors.
- d) **Industrial Design** means only the features of shape, configuration, pattern, ornament or composition of lines or colors applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separated or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device.
- e) **Software programmes** refer the codes developed by the institute researchers, students and faculty that are not usable by a second party without permission.
- f) **Business models** - Models for business strategy developed by institute personnel that are not usable by others without permission.
- g) **First Party** - National Institute of Technology Silchar (NITS).
- h) **Second Party** - Faculty, Supporting Staff, Project Staff and Students of NITS.
 - i) Faculty means a professionally qualified person who conveys his/her knowledge to the learners through teaching and research at NITS. He/she may be as a full time employee, or a visiting professor appointed by NITS. (Note: this definition of faculty is meant only for the purposes of this document and in not intended to replace the definition of faculty in the statutes or any other documents of NITs or NIT Silchar.)
 - ii) Supporting Staff is the person who helps the relevant members to carry out the research, development, teaching or any other related activities.
 - iii) Student means an individual who enroll himself/herself as full time, part-time or exchange student from other universities/colleges for

- iv) Project staff means a person who is temporarily employed under a research project, consultancy or any other activity carried out by NITSy on a contract basis.
- m) *Third Party*** - Any organization with whom the First or the Second Party interacts for any activity by exchanging cash or kind.
- n) *Activity*** - Practices related to teaching, research, consultancy, generation and dissemination of information carried out by a person or an Institution independently, or collaboratively.
- o) *Inventor(s)*** – A responsible person or a group of persons deal with the creation of an IP. In case, creation of IP is associated with more than one inventor, one of them, from NITS, would function as a *Lead Inventor*.
- p) *Visitor*** - A person visiting under a collaborative activity or associated work at NITS. It is expected that the visit has been approved by competent authority of NITS.
- q) *Associated Agreement*** – Document created with mutual consent of involved parties defining the rights, roles and responsibilities of each of the parties, such as, Memorandum of Understanding (MoU), Memorandum of Association (MoA), Research Agreement, Consultancy Agreement, Non-Disclosure Agreement (NDA), etc.
- r) *Non-Disclosure Agreement (NDA)*** - The agreement intends to protect proprietary or confidential information among the parties involved in executing a NDA.
- s) *Invention*** –includes but is not limited to any new and useful design, process, formula or machine conceived or first reduced to practice in whole or in part, defined within the purview of the Patent Act. The inventions result in but not limited to Patent, copyright works, software, designs, PCB and circuit layouts. Inventor(s) are person(s) who produce an invention.
- t) *Design Registration*** –is registration of the novel non-functional features such as shape, or ornamentation of a product.
- u) *IPR Committee*** – is a committee formed by NITS management and is the sole authorized body to handle all IPR related issues and conflicts
- v) *Licensing*** – is the practice of renting the Intellectual Property to a third party
- w) *Patentee*** – means the person for the time being entered on the Register of Patents kept under the Indian Patents Act 2002 as the generator or proprietor of the patent.

x) Revenue – It is any payment received as per an agreement by the institute usually for the legal use of IP through a license.

y) Conflict of Interest – or a 'Potential Conflict of Interest' exists when an inventor/author is or may be in a position to use either creative work or influence for unmerited personal or family gain.

1.6 IPR STANDING COMMITTEE (SC) AND ITS ROLE

The IPR Standing Committee will be the leading administrative body, which will be responsible for formulating the procedures and to implement the IPR policy of NITS. IPR Standing Committee would also clarify any issues/appeals related to IPR policy. The members of IPR Standing Committee include:

| | |
|--|---|
| Dean (R&C) | Chairperson (Ex officio) |
| Coordinator(s), IPR cell | Member Secretary (Ex officio) |
| Associate Dean (R&C) | Member (Ex officio) |
| Director's nominee from NITS | Member |
| Director's nominee (from legal background) | Member |
| Subject Expert in the relevant area | Special invitee nominated by the Director |

The function of IPR Standing Committee would be the following:

- (a) To form expert groups with members from different background to assess the proposals for filing IP.
- (b) To create and finalize procedures and guidelines for the effective implementation of the IPR policy at NITS.
- (c) To provide record of the filled IPs and to track the various IPs filed so as to ensure a speedy and hassle free IP process.
- (d) To facilitate IP protection by drafting agreements.
- (f) Providing guidelines for IPR related documentation including creating infrastructure for the same.
- (g) Conducting IP awareness programs for educating faculty/ students/ supporting staff/ project staff/ visitors.
- (h) To approach external funding agencies for generating funds to promote the IPR activities.

- (i) To collaborate with organizations for filing, licensing/assigning of IPR to generate revenue through commercialization.
- (j) Release of IPR to Inventor(s) and/or Third party(ies) without violating the IPR policy of NITS.
- (l) Solving disputes regarding ownership of IP, violating the IPR policy, processing of IP proposals, procedures adopted for implementation of IPR policy.
- (m) To take over the issues related to the violation of IPR policy of the Institute and to report the same to the Director for necessary action.
- (n) To encourage and implement the IPR policy in a proactive manner for the shared benefits of both the inventor and institute.

IPR Standing Committee may seek the opinion of expert group(s) formed with members from within and/or outside NITS.

1.7 TYPES OF ACTIVITIES LEADING TO THE GENERATION OF IP

The various Research and Development activities performed in NITS can generate different types of IPs which are illustrated as follows:

- a) Research done by a faculty/staff/student/visitor in the normal course of his/her engagement at NITS with funds coming from NITS (this would include research projects undertaken by students under the supervision of the faculty member);
- b) Research done through the sponsored projects by a faculty/staff/student;
- c) Collaborative projects and researches performed with other institutions including government departments and agencies, PSUs and Private companies located in India;
- d) Collaborative research with foreign institutes/universities and companies; and
- f) Any combination(s) of the above

SECTION 2 INTELLECTUAL PROPERTY POLICY

2.1 INTRODUCTION

The vision of NITS is to bring excellence in research and education and to share and accumulate knowledge. This leads to the generation of new Intellectual Property (IP). For the benefit of the society, it is equally important to protect, develop and to commercialize the IP. The newly created IP holds the conformations which should be disseminated at the earliest so as to carry out further research. The scientific community is not deprived of its right to knowledge for which the newly created IP is needed to be clearly defined. Clarity on ownership of IP restricts the interest of both the society and the inventors.

This IP policy is applicable to all personnel belonging to NITS and covers all different classes of Intellectual Property - Patent, Copyright, Design, Registration, Trademark, and Confidential Information.

2.2 INTELLECTUAL PROPERTY OWNERSHIP

I. Patent, Copyright on Software, Industrial design and Business models

(A) Intellectual property is owned wholly or exclusively by NITS if:

- i. It has been developed either solely with the use of funds / facilities provided by NITS or with a mix of funds/facilities of NITS and external agencies but without any formal associated agreement.
- ii. It has been developed with the use of external funds/facilities, including, that of sponsored research and consultancy projects without any associated agreement.
- iii. It has been developed under any contract arrangement including “work for hire”, work commissioned and/or outsourced by NITS.
- iv. It has been developed pursuant to a written agreement where ownership has been transferred to NITS.
- v. It is not assignable to an individual or a specific group of identifiable contributors, i.e. software or technology or process developed over a period of time with contribution from different individuals of / for NITS.

(B) Intellectual property can be owned by Third party (ies) (exclusively or jointly with NITS) if:

- i. It has been developed with external funding from Third party(ies) including sponsored research, consultancy projects and other collaborative activity(ies) with a formal associated agreement.
- ii. It has been developed without external funding from third parties under collaborative project(s) or activity (ies) with Third party (ies) with associated agreement(s).
- iii. It has been developed out of the work carried out by NITS faculty/student/project staff/supporting staff during their visit to a Third party Institution/organization.

(C) The Intellectual property can be owned by the Inventor(s) if:

None of the situations defined above for NITS or Third party ownership applies, and the IP is unrelated to the inventor's engagement with NITS. For faculty and staff, the engagement implies responsibilities associated with the employment. It is also expected that the person concerned would have pursued these activities outside of normal working hours of NITS.

II. Copyright other than Software

- i. All ownership of copyright works rests with the creator except if the work is produced during the course of sponsored or collaborative activity and with specific provisions related to IPR in contract.
- ii. The ownership of the copyright will rest with the Institution if it is created with significant use of resources of the Institution and as decided by the IPR committee.
- iii. The ownership of copyright of teaching material developed as a part of academic programs rests with the Institution.
- iv. Copyrights of thesis, dissertations, term papers, laboratory records, and of other documents that are produced by a student during the course of his/her study will reside with the student creator and supervisor(s) unless restricted by an associated agreement and/or research carried out using facilities that have come to NITS with preimposed IP protection restrictions. It is the responsibility of the author/creator that their creation does not violate any copyright rules or ethical standards. NITS reserves all right to display the thesis in soft and hard forms.

III. TRADE MARK(S) / SERVICE MARK(S)

- i. Goods and services involving NITS should be trademarked with NITS and the Institute will be the sole or exclusive owner.
- ii. The users of NITS' name through trademark will be bonded with certain standards and accountability.
- iii. Third parties can use the name of NITS with proper trademark only if the property has been licensed by the Institute through a signed agreement.
- iv. Prior approval of NITS is mandatory in the matter regarding the use of NITS's name and trademark in any electronic and digital media.

IV. COPYRIGHTS OWNED BY THIRD PARTIES

(a) Software

NITS expects that its faculty/staff/students/visitors to be aware about agreements made to the Third party related to software and databases. It may happen that NITS faculty/staff/students /visitors use software and databases for creating IPs which are not under licensed agreement by NITS with the Third party. Such software will have license restriction on IP creation and usage of such can hamper the institute policy in a legal sense. Therefore, prior settlement of any such license related issues with the Third party regarding software is essential before initiating IP protection.

Software of general use shall be procured with valid license.

(b) Other copyrighted material (other than software)

It is strongly mentioned here that NITS and its faculty, students, supporting staff, project staff and visitors:

- (i) Will not violate the copyright law of the nation related to any material,
- (ii) Would use copyrighted materials for only personal use, teaching and research purposes as permitted by Indian law, and
- (iii) Would not use copyrighted material in their thesis, publications, reports and other professional documents without taking explicit prior permission of the copyright holder.

2.3 TECHNOLOGY TRANSFER

The Intellectual Property of the Institute held either in the name of NITS or jointly with other Institutions/Industry will be marketed for commercial exploitation under agreements involving technology transfer, licensing and its Inventor(s). The Inventor(s) may seek NITS to assign the rights to them after a certain holding period.

2.4 REVENUE SHARING

The revenue arising out of licensing and commercialization of IP and royalty would be shared between the inventor(s) and the Institute in the appropriate ratio as follows:

| Inventor(s) share | NITS share |
|-------------------|------------|
| 60% | 40% |

2.5 INFRINGEMENTS, DAMAGES, LIABILITY AND INDEMNITY

- i). As a matter of policy, NITS shall, in any contract between the licensee and NITS, seek indemnity from any legal proceedings including this, but not limited to manufacturing defects, production problems, design guarantee, upgradation and debugging obligation.
- ii). NITS shall also ensure that NITS personnel have an indemnity clause built into the agreements with licensee(s) while transferring technology or copyrighted material to licensees.
- iii). NITS shall retain the right to engage in or desist from or not in any litigation concerning patent and license infringements.

2.6 CONFLICT OF INTEREST

The inventor(s) are required to disclose any conflict of interest or potential conflict of interest revenue sharing models. 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.

2.7 DISPUTE RESOLUTION

The inventor(s) may appeal to the Director NITS on the occurrence of any disputes between NITS and the inventors regarding the implementation of the IPR policy. To

address the concerns of the inventor(s), an arbitration mechanism and arrangement will be developed. The Director's decision in this regard would be final and binding on both institute and inventor.

2.8 JURISDICTION

As a matter of policy, all the agreements to be signed by NITS must have the jurisdiction of the courts in Assam and shall be governed the appropriate laws in India.

SECTION 3

TRANSFER AND USE OF IP IN NIT SILCHAR

3.1 INTRODUCTION

The purpose of transfer and use of IP by NITS, which is a nonprofit educational organization, is to meet one of its stated objectives of disseminating the fruits of research and development for the benefit of the society. The institute recognizes that translation of created IP to products and services of benefit to society is a complex process that normally involves considerable risk taking and expenses. NITS on transfer and use of IP proposed here takes into account the above fact. Commercialization of IP is generally carried out via licensing or assignment. A licensing agreement is a partnership between an intellectual property rights owner (licensor) and another who is authorized to use such rights (licensee) in exchange for an agreed payment (fee or royalty) whereas assignment of IP involves transfer of ownership irrevocably and permanently to the assignee by the assignor.

3.2 MATERIAL TRANSFER AGREEMENT (MTA)

In case the material transfer clause is not covered, an appropriate MTA such as in the case of biotechnology inventions shall be signed between the donor and the recipient of the material regarding the use of the subject material.

3.3 POLICY FOR IP LICENSING AND ASSIGNMENT

Licensing intellectual property to a third party is the most common modality for technology transfer leading towards commercialization. There are various modes of licensing strategy which includes the following:

- **Exclusive licensing:** The licensor licenses the IP only to one licensee. In other words the licensee is the only one authorized by the licensor to use and exploit the IP. Even the licensor is excluded from using and exploiting the IP.
- **Sole licensing:** In this type of licensing, the licensor issues license to only one licensee. However, this will enable the licensor to use and exploit the IP also.

- **Non-exclusive licensing:** In this type of licensing, the licensor is permitted to sign agreements with more than one entity for usage. In other words, the same IP may be used by many licensees at the same time for the same/different purposes.
- **Sub-licensing:** Sublicensing is applicable when a licensee wishes to further license the IP to another party.

With the creation of a diversified IP at NITS, each license agreement has certain difference in the technology being exported/ transferred. The following guidelines are applicable to license agreement with a Third party:

- i) Generally no entity shall be issued exclusive right for the development/commercialization of intellectual property owned by NITS.
- ii) A time limit for usage of IP owned by NITS will be implemented to obviate the possibility of misuse.
- iii) The license agreement should state clearly whether permission for Sub-licensing is permitted or not, and, whether the consent of the licensor is required or not in this matter.
- iv) NITS and its inventors should be protected from all liabilities arising from development and commercialization of a particular IP.
- v) Right to publish and incorporation of necessary material in the student's thesis should not be restricted by the licensing process.
- vi) Third party will not place restriction(s) beyond the inventor(s) on NITS from entering into research and development in the same area independently or collaboration with other organization(s).

The license agreement may contain such other provisions as may be determined by NITS in the best interest of the society.