INDIAN INSTITUTE OF TECHNOLOGY, KANPUR

INTELLECTUAL PROPERTY POLICY DOCUMENT

I. Intellectual Property Ownership

A. IITK Ownership

1. Intellectual property of any kind created by faculty, students, staff, project staff, visitors and others, such as trainees from other institutes, participating in IITK programs or using IITK funds or facilities, are owned by IITK when either of the following applies:

    a) The intellectual property was created with the significant use of funds or facilities administered by IITK.
    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 IITK. 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.

2. All copyrights, including copyrighted software will be owned by IITK when it is created as a part of any of the academic programs of IITK or created pursuant to a written agreement with IITK, providing for transfer of copyright or ownership to IITK. More specifically:
    a) IITK will be the owner of the copyright on all teaching materials created by IITK and non-IITK personnel for external agencies, institutions and industry under the continuing education and distance education programs of IITK. However, the authors will have the right to use the material for their teaching and research activities.
    b) IITK will not claim ownership of copyright on books and scientific articles authored by IITK personnel. However, IITK will have the copyright if books and reports have been created using funds specifically provided for this purpose by IITK.

B. Inventor/Author Ownership

1. Inventors/Authors will own intellectual property when
    a) None of the situation defined above for IITK-ownership of intellectual property applies.
    b) It is created outside their assigned/normal area of research/teaching, for example, popular novels, poems, musical compositions, or other works of artistic imagination, without the use of significant institute resources.

2. Students will own copyright on theses/dissertation created as a part of their academic programmes. However, the student must grant to IITK royalty-free permission to reproduce and distribute copies for teaching and research as well as for dissemination for teaching and research to other academic institutions.

3. Ownership of software code, patentable subject matter and other intellectual property contained in the theses/reports are subject to conditions specified under IITK-ownership and Inventor/Author ownership.

C. Third-Party Ownership

1. Ownership of intellectual property resulting from:
   a) Funds provided partially or fully by a third-party to IITK will be governed by specific provisions in the contract between the third-party and IITK.
   b) Exchange programs between IITK and other institutions will be governed by specific provisions in the contract between the third-party and IITK.
   c) In case no such specific contract exists, IPR will remain with IITK.

2. In cases of all IP produced at IITK, IITK shall retain a non-exclusive, free, irrevocable license to copy/use IP for teaching and research activities, consistent with confidentiality arguments where ever entered by IITK.

3. In cases where an IP is created by IITK personnel, fully or as a part of the team, during deputation, official leave, or sabbatical, the concerned IITK personnel should officially communicate the IP to IITK. If the IP involves ideas/software developed, fully or in part, using significant institute resources, then the IP will also be owned by IITK fully or partially, as the case may be.

II. 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 IITK, the inventors will be required to disclose their IP to the **IPEC** (Intellectual Property Evaluation Committee) at the earliest date using an **IPDF** (Intellectual Property Disclosure Form).

3. It will be mandatory for students to submit an IPDF, countersigned by their supervisor(s), at the time of filing their B.Tech. report, M.Tech. and PhD theses.

4. The inventor shall assign the rights of the disclosed IP to IITK 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.

5. Having made the disclosure, the inventors, both IITK and non-IITK personnel, shall maintain confidentiality of the IP during the period it is pending with IITK for the

assessment of the possibility of commercialization and protection of IP, unless authorized in writing by IITK.

III. Evaluation of Intellectual Property

1. Evaluation of Intellectual Property will be done by the IPEC (Intellectual Property Evaluation Committee). Dean (R&D) will be the Chairman and the Head of the organization within IITK responsible for commercialization, will be the member secretary. The Director will nominate at least three additional faculty members with expertise or familiarity/experience in areas related to the IP.

2. Evaluation of IP means:
   a) Assigning ownership of IP.
   b) Determining whether an IP is innovative and fit for filing in India and foreign countries.
   c) Determining whether the IP has a reasonable chance for commercialization.

3. After evaluation of IP, if IITK 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.

4. Even in such cases, as in (3), IITK may take the responsibility of facilitating protection of the IP on case by case basis.

5. A decision on the annual renewal of IP rights will be taken by the IPEC. If IITK decides not to renew the IP, fully or partially, then it will assign the rights of the IP, wherever relevant, to the “inventors.”

IV. Contracts and Agreements

All agreements related to IP, including, but not limited to the following categories, undertaken by any IITK personnel and students need to be approved by the institute:

1. Allegiance, Affirmation and Confidentiality Agreement.

2. Evaluation Agreement.

3. License Agreement

4. Technology Transfer (Commercialization) Agreement

5. Alternative Dispute Resolution Agreement

6. Classified Information Non-Disclosure (specific) Agreement

The Dean (R&D), with specific approval of the Director, will be the authorized signatory in all categories of agreements listed above.

V. Commercialization

1. IITK 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.

2. For the IP where exclusive rights have not already been assigned to a third party, the creators 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. If IITK is not able to commercialize the IP in a reasonable time then the inventor(s) may approach IITK for assignment of rights of the invention(s) to them.

VI. Revenue Sharing

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

Case	Net earnings	Inventor(s)	IITK's Share	Service Account*
1	For the first amount Q	65%	25%	10%
2	For the next amount Q	45%	45%	10%
3	For amounts more than 2Q	25%	65%	10%

* Money may be used for the promotion and upgradation of the invention. Unused funds from the service account will be used for promotion of commercialization, IP protection and any other related activities.

2. It is suggested that amount Q be initially fixed at Rs. 100 lakhs. The creator(s) share would be declared annually and disbursement will be made to the creator(s), their legal heir, whether or not the creators are associated with IITK at the time of disbursement.

3. Co-creators 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.

VII. Infringements, Damages, Liability and Indemnity Insurance

1. As a matter of policy, IITK shall, in any contract between the licensee and IITK, seek indemnity from any legal proceedings including without limitation manufacturing defects, production problems, design guarantee, upgradation and debugging obligation.

2. IITK shall also ensure that IITK personnel have an indemnity clause built-into the agreements with licensee(s) while transferring technology or copyrighted material to licensees.

3. IITK shall retain the right to engage or not in any litigation concerning patents and license infringements.

VIII. 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.

IX. Dispute Resolution

In case of any disputes between IITK and the inventors regarding the implementation of the IP policy, the aggrieved party may appeal to the Director of IITK. Efforts shall be made to address the concerns of the aggrieved party. The Director's decision in this regard would be final and binding.

X. Jurisdiction

As a policy, all agreements to be signed by IITK will have the jurisdiction of the courts in Kanpur and shall be governed by appropriate laws in India.

Nomenclature

IP	Intellectual property
IITK	Indian Institute of Technology, Kanpur
IPEC	Intellectual Property Evaluation Committee
IPDF	Intellectual Property Disclosure Form

Glossary

1) "Director" means the Director of the Indian Institute of Technology, Kanpur
2) "Dean, R&D" means the Dean of Research & Development of Indian Institute of Technology, Kanpur.
3) "Author" means faculty, students, staff or visiting faculty who has/have written or created a creative work.
4) "Confidential Information" is information not in the public domain and declared confidential by parties as such in a MOU/Agreement that has been signed by the parties.
5) "Copyright" means the exclusive right granted by law for a certain period of time to an author to reproduce, print, publish and sell copies of his or her creative work. Copyright protection is available for most literary, musical, dramatic, and

other types of creative work, including software, teaching materials, multimedia works, proposals, and research reports.

6) “Creators” are persons who have produced any original work.
7) “Intellectual Contribution” means original technical or artistic contributions.
8) “Intellectual Property” includes but is not limited to copyrights and copyrightable materials, patented and patentable inventions, tangible research results, trademarks, service marks and trade secrets.
9) “Invention” includes but is not limited to any new and useful process, formula or machine conceived or first reduced to practice in whole or in part, defined within the purview of the Patent Act, Inventor(s) are person(s) who produce an invention.
10) “Licensing” is the practice of renting the intellectual property to a third party.
11) “Net Earnings” Earnings resulting from the licensing or commercialization of the IP reduced by the outstanding actual expenses incurred in obtaining and commercialization of the IP.
12) “Patent” means the exclusive right granted by law for making, using or selling an invention.
13) “Royalty” is the payment made to an inventor/author or an institution usually for legal use of a patented invention or any Intellectual Property when licensed.
14) “Significant Use of IITK Resources” is any usage of IITK’s resources in the creation of the invention(s), in excess of the routine use of office facilities, computers, library resources and resources available to the general public.
15) “Software” means anything executable in a computer.
16) “Teaching material” means any material that aids the process of teaching.
17) “Trade Mark/Service Mark” is a distinctive word, symbol or picture or a combination of these, which is used by a business entity to discriminate its products and services from those of other business entities.
18) “Trade Secret:” Usually some information such as know-how of commercial or strategic value that is not disclosed to all and is used in a restricted manner.

ANNEXURE I

Intellectual Property Disclosure Form

Indian Institute of Technology Kanpur

Title of the invention:

Innovator(s) who have contributed or conceived an essential element of the invention, either independently or jointly with others during evolution of the technology concept or reduction to practice:

Name:
Position:
Department:
Phone:
e-mail:

Name:
Position:
Department:
Phone:
e-mail:

Name:
Position:
Department:
Phone:
e-mail:

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 other faculty of the Institute who are knowledgeable in the field 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) transfer form,
    (5) target companies and countries,
    (6) economic data,
    (7) potential long-term commercial interest.

(Please provide as much information as possible; attach extra sheets of required) Prior disclosure and possible intent:

Has the invention been disclosed to 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.

Development stage:

Give you opinion on the current stage of development of the invention as it relates to its marketability (indicate appropriate response):

---------- Embryonic (needs substantial work to bring market)

---------- Partially developed (could be brought to market with significant investment)

---------- Off-the-shelf (could be brought to market with nominal investment)

Do you know of any other inventions that are congruent with this invention?

_____ _____
Signature of Inventor with date Signature of Inventor with date

_____ _____
Signature of Inventor with date Signature of Inventor with date

I, the undersigned, ---------- hereby certify that ---------- (the “Work”; attach additional sheet if necessary to accurately describe the work) was specially commissioned by and is to be considered a “work made for hire” by IIT Kanpur, herein after referred to as Institute with address at Indian Institute of Technology, Kanpur, Uttar Pradesh 208016, India, and that IIT Kanpur is

entitled to all patent/copyright/trademark and all other intellectual property rights thereto.

Without limiting the foregoing, for good and valuable consideration, receipt of which is thereby acknowledged and in accordance with the above entitlement of Institute to Intellectual Property generated by me, I hereby assign and/or transfer to Institute, its successors and assigns, absolutely and forever, all right, title, and interest, throughout the world in and to the Work and each element thereof, including but not limited to the copyright/patent/technology innovation contained therein.

I further agree that no copyright material assigned by me to the Institute under this agreement shall be reproduced by me beyond that which falls under fair use, and I shall retain only moral rights to this material. Furthermore, no patentable invention/technology innovation/trademarks developed by myself, and others shall be working with, be disclosed by me to any other party upon termination of this agreement. I understand that any prior disclosure by myself, directly or indirectly, either during the period of this work-for-hire agreement or after its termination, shall render me prosecutable as per laws that may be in force at the time.

Signed this _____ day of _____ (month), _____ (year)

Name:

Address: