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INSTITUTE OF ENGINEERING & MANAGEMENT
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INSTITUTE OF ENGINEERING & MANAGEMENT, KOLKATA

INTELLECTUAL PROPERTY RIGHT POLICY

INTELLECTUAL PROPERTY RIGHTS POLICY OF ENGINEERING & MANAGEMENT

(Adapted from IIT Madras IPR policy)

PREAMBLE

Faculty, employees, and students at the Institute of Engineering & Management (IEM) are involved in a variety of R&D projects. Many of these R&D programmes result in the emergence of intellectual property (IP) in the form of patents, know-how, copyrights, designs, instruments, devices, processes, specimens, software, and other inventions that can be commercially exploited with or without registration under the Patents Act/Copyright Act. Such commercial exploitation can provide significant socioeconomic benefits to the country. As a result, the Institute advocates the protection and licencing of such intellectual property to groups that can efficiently use it for economic exploitation. This would generate financial rewards for the Institute while also helping to fund R&D initiatives. Intellectual property may result from research funded by the Institute or government agencies or from research funded by industry or independent research organisations such as ISRO, DRDO, and others. Funded research may entail contractual duties on the Institute in terms of intellectual property ownership/licensing, which must be agreed upon clearly and openly at the time the contracts are signed. This paper outlines the Institute's policy regarding the protection, ownership, and licencing of intellectual property developed with or without external funding.

GUIDELINES

This IPR policy must be observed in all IPR concerns at IEM. Because the IP landscape is ever-changing, this policy may be updated from time to time to meet emerging demands, or on a case-by-case basis. The IPR committee will treat such unique cases by following the guidelines in this IPR policy document. The Intellectual Property Cell (IPC) is the Institute's nodal agency for handling all IPR-related matters addressed in this policy, namely any intellectual property developed by the creator's intellectual endeavour while employed temporarily or permanently at Institute or studying at Institute.

1. Objective

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

- a) Foster, stimulate, and support creative endeavours in technology, science, and the humanities in their broadest sense.
- b) Protect the legitimate interests of the Institute's faculty/scholars/students and society, and avoid conflict of opposing interests as much as feasible.
- c) Establish a transparent administration system for intellectual property ownership control and assignment, as well as revenue sharing from intellectual assets developed and controlled by the Institute.

2. Definitions

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



- a) **"Copyright"** means the exclusive right granted by law for a certain period of time to an author to reproduce, print, publish and sell copies of his or her creative work.
- b) **"Creator"** means any employee of IEM and includes those who are on probation, those who are employed on temporary basis either in the Institute and/or in projects and those who are research workers, research scholars or students who are responsible for the creation of an Intellectual Property, using the facilities of the Institute.
- c) **"Director"** means the Director of IEM.
- d) **"Institute"** means the Institute of Engineering & Management.
- e) **"Intellectual Property"** broadly includes any property generated out of intellectual effort of the creator(s). It includes but not limited to
1. Innovative and valuable scientific and technological progress in the form of patentable innovations, inventions, products and processes, computer hardware and software, materials, biological variations, and so on.
 2. Copyrightable industrial and architectural designs, models, drawings, software, creative, artistic, and literary works, educational resource materials developed, research records, and so on.
 3. Trademarks, service marks, logos etc.
- f) **"IPR Committee"** The committee constituted by the Director from time to time to evaluate and make recommendations regarding IP related issues.
- g) **"Patent"** means a patent granted under the provisions of the Indian Patents Act, 1970.
- h) **"Patentee"** means the person for the time being entered on the Register of Patents kept under the Indian Patents Act, 2002 as the generator or proprietor of the patent.
- i) **"Revenue"** is any payment received as per an agreement by the Institute usually for legal use of an Intellectual Property through a license.

3. Ownership

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

A. Unless specific agreements/contracts are entered into by the Institute as described below, prior to the creation of the IP, with an agency funding the research leading to the creation of the IP, or with a temporary employee or student, the Institute shall be the owner of all intellectual properties (IP), including inventions, software, designs, and integrated circuits layouts, specimens, created by creators.

B. The ownership of IP resulting from funded or collaborative research, or consulting assignments, shall be governed by specific IPR restrictions contained in contracts controlling the collaborative activity. The MoU or contract for such a project may call for (a) joint ownership of the IP by IEM and the sponsor, (b) full ownership of the IP by the sponsor, (c) exclusive licencing of the IP owned by the Institute to the sponsor or its nominees, or (d) the execution of a separate agreement or contract for



exclusive/non-exclusive ownership/licensing of the IP at a later time as a result of the creation of the IP. In each of these situations, the contract, agreement, or memorandum of understanding (MOU) will detail the terms, such as the fee or royalty payable for ownership or licencing of such IP as applicable, and also describe how the sponsor and/or the Institute will pay for the costs of patent filing, registration, and maintenance. Faculty and staff are required to work with the Institute to choose which of the aforementioned options is appropriate for a given project based on the type of research that is proposed to be conducted, the extent to which the researchers' prior relevant experience and the Institute's facilities are leveraged, and the amount of funding provided when they enter into an agreement for sponsored research or consulting.

C. The Institute and the sponsor shall jointly hold the IP if it results from a sponsored research study, consulting assignment, or project and the contract, memorandum of understanding, or agreement does not address the ownership and/or licencing of such IP. To licence the IP to it, the Institute may, however, if it sees fit, engage into a separate agreement or contract with the sponsor, which will define payment of additional costs or royalties.

D. An Institute employee who is on sabbatical or other extended leave, a student who is on leave or who has been given permission by the Institute to work for an organisation while enrolled as a student, and who is conducting research in the organisation, will be allowed to directly negotiate with the organisation the terms of any IP sharing that is generated, in its entirety and without using any resources from the Institute. However, any income collected by the employee or student in the future while they are working for the Institute as a result of the IP created above will be subject to the current IPR revenue sharing regulations of the Institute. IP created by the aforementioned employee or student during this time without the participation of creators who are Institute employees or students will be exempt from this restriction. But if the IP so developed by the employee or student, during the leave period as described above, is based entirely or in part on prior IP developed at the Institute, the employee or student is required to inform the Institute and give the Institute the ability to enter into a licencing agreement with the company in which the employee or student is temporarily employed.

b) Copyrightable Works

A. With the following exceptions, the author of the original work must retain ownership of all copyrights associated with copyrightable works, including books and publications:

a. The ownership of the copyright will be determined by particular IPR terms contained in contracts controlling such activity if the work was created while participating in sponsored and/or collaborative activity.

B. Any work, including software, generated with a considerable amount of Institute resources shall be the Institute's sole property.



C. All instructional materials created as part of Institute's academic or distance learning programmes should belong to Institute exclusively. The author(s) will, however, be permitted to utilise the content for professional purposes.

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

The Institute shall be the owner of all trade mark(s), service mark(s), and logo(s) developed for the Institute. The Institute greatly desires to retain a non-exclusive, free, perpetual licence to reproduce and utilise all intellectual property created at the Institute only for instructional and research purposes, in accordance with any confidentiality agreements the Institute may have entered into. This will allow the Institute to utilise the intellectual property (IP) produced by its employees and students in the course of its teaching and research activities.

4. Evaluation and Management of IP

The IP developed at the Institute is evaluated, safeguarded, licenced, and managed by the IPC of the Institute. The IP's developers are required to give IPC all the data it needs to decide whether or not the Institute wants to own and administer the IP. Even if it is not immediately feasible, an invention will normally be patented by the Institute if it has strong commercial potential. The creator(s) may apply for patents and independently protect the IP if the Institute decides not to acquire and manage the IP. But as stated in Section 9, the employee's or student's share of the Institute's income from licencing such IP will be decided. Prior to publication or disclosure of the patentable IP in any other way that would place it in the public domain, it is crucial to petition for patent protection for such IP. The IPR Committee will review the IP application before providing detailed suggestions regarding the Institute's proposal's patentability and registration. For this, the committee may enlist the aid of specialists. The secrecy of the IP must be properly protected in all of these endeavours. The authors will inform the Patent Cell/Office of each such filing or application if the contract/agreement/MOU with a sponsor state that the sponsor will oversee the process of filing patents and incur the related costs. If confidentiality is sought, specifics of the invention need not be disclosed under such circumstances. The creators will advise the Patent Cell/Office of the progress of the application through various phases, such as the PCT, national phase, etc., as and when the creators become aware of such progress.

5. Registration of patents/Copyrights:

a) Filing of Applications in India

Creators of know-how, designs, instruments, techniques, processes, specimens, and other types of intellectual property who wish to obtain a patent for such property must submit an application to the Chairman of the IPC in accordance with the procedure established by the Institute at the time. After alerting the Patent Cell/Office that a sponsor of the study that produced the IP has contractually agreed to be responsible for filing applications, the creator may work with the sponsor to complete the submission. As the application moves through its various stages, the creator must tell the Cell/Office of its progress. Although the invention details are not required to be supplied as long as they are not made publicly known during the patenting process, the application's specifics, such as the title and names of the inventors, must be provided. The creator(s) are urged to apply for a provisional



patent as soon as possible to safeguard their IP rights. To aid the creator(s) in their choice regarding the submission of an application, a search report of existing patents that may be related to the important contributions of the proposed invention can also be received as part of this process. If the creator(s) can cover the cost of the provisional filing out of (a) the research project funds that resulted in the IP, (b) the creator(s)' PCF(s), (c) the department(s) of the creator(s)' DDF with the approval of the concerned department Heads, (d) or (e) the creator(s)' personal financial resources, the permission for the provisional filing will be granted automatically prior to the IPR Committee evaluating the creator(s). In these situations, the Patent Cell does not need to be informed of the invention's technical details at this time out of respect for privacy. The provisional application will expire, unless the creator(s) choose to proceed with the succeeding phases on their own, should the Institute decide after careful consideration not to handle the IP. In certain situations, the Institute will renounce its ownership of the patent rights. Institute will be responsible for paying all filing and protection fees starting on the day it decides to jointly or solely own and manage the IP. If the creator(s) used PCF or personal funds to pay for the provisional filing, they will be refunded when the Institute decides to take ownership of and management of the IP. The disclosure of IP-related information shall either be completely avoided or limited to those employees who truly need to know. All Institute workers involved in Institute activities are required to treat all IP-related information they may come into contact with while performing their official duties as confidential. Unless such information is in the public domain or generally accessible to the public, such confidentiality shall be preserved for the period of time specified by the Institute or by the applicable contract, if any, between the Institute and the parties in question.

b) Filing of Applications in Foreign Countries

Depending on the value of the IP, the Institute may take requests for international patent registration into consideration. The typical procedure to be followed in these situations entails the filing of a provisional application, a thorough assessment of the commercial potential of the IP in the countries proposed for filing, the filing of a PCT application in the event that such potential is present, and then the filing of national phase applications in the chosen countries. The commercial potential will be continuously evaluated during the period before the procedure enters the national phase, and if at any point it appears that the commercial potential in a foreign country looks to be poor, Institute may choose not to file in that particular country. The creator(s) are also invited to seek for financial support for filing internationally, which is offered by several ministries to public institutions, at this time. The creator(s) will be given the rights to the IP in the nation if the Institute decides not to submit a patent application there. This will allow the creator(s) to pursue IP protection there on their own or in collaboration with a sponsor. The regulations for sharing revenue with the Institute that are applicable to the creator(s) as per their employment/enrolment contracts will apply to any income the creator(s) receive as a result of the exploitation of the rights granted to the creator(s) in that nation. Before sharing the money with the Institute, the creator(s) may ask for compensation for the expenses they incurred to defend the IP in that nation. The Patent Cell only needs to be kept updated on the development of the international patent application(s) through various stages such as PCT, national phases, etc. in the event that the expenses of patenting are carried by the sponsor of a research project as stipulated in the contract/agreement. Any law firm of the



sponsor's choosing may be used for the filing. The creator(s) must hire one of the law firms regularly approved for filing if the Institute decides to take on the filing.

6. Renewal of Patents

In every instance when the Institute obtains a patent, the Institute will cover the first seven years' worth of patent fees. The fees of obtaining the patent may be split equally if it is a joint patent with a sponsoring agency. The Institute must cover the Patent Fees for the remainder of the patent's life if the patent has been used commercially within the first seven years. The subsequent instalments of renewal costs will be split 50/50 between the Institute and the patent creator(s) if the patent is not economically exploited during the first seven years. The creator(s) are allowed to use their PCF to cover their proportion of the expenses. The Institute has two options if the creator does not express interest in such renewals: the Institute can either continue maintenance of the patent by paying the fees for its full term or withdraw application for Patent protection at its discretion.

7. Confidentiality of IP

Without the Institute's prior written consent, none of the group's creators or anyone engaged in the IP protection procedure will divulge any information about the IP to anybody or any organisation. Creators may take all necessary precautions to prevent triggering the public disclosure clause that could result in patent denial in the case of theses and other written publications containing information about patentable IP. Prior to describing the specifics of the IP in theses, papers, and other documents, it is better if the creators file provisional patent applications.

8. Licensing of IP

Institute may approach outside organisations for licencing of IP owned by it through its Patent Cell, its agents, or the creator(s). On behalf of the Institute, all contracts must be signed by the Chairman, the IPC, and the IP creator(s) whose work is being transferred. For the purpose of protecting their intellectual property, creators of IP with many creators must choose a coordinator from among themselves. A revenue sharing agreement for the transferred intellectual property must now be signed by each member of the group of creators. This revenue-sharing arrangement may be changed at any time with the creators' approval and notice to the IPC Chairman. Any disagreements between the creators regarding revenue sharing will be settled by the Institute, which is binding on all the creators of the IP.

9. Revenue sharing

a) According to the Institute's current IPR revenue sharing policies in effect at the time of the agreement's signing, the income will be distributed among the creators. The creator can first deduct the costs incurred in this regard and in regard to maintaining such patents from the income received by the creator from the commercial exploitation of the patent in those countries if the Institute does not cover the costs of patent filing and registration for one or more countries. Any additional earnings over these recouped expenses will be shared with the Institute in accordance with its current policies. Any MoU signed by the Institute with the sponsoring agency based on which the IP is generated, or with any patent filing organization, may supersede provision under this clause.



b) The creator(s) may begin a new research project with the money they receive from such revenue, i.e., they may invest the full amount or a portion of their share in a new research project for additional advancement of the patent topic or additional study in a related field. The Institute will provide an equal portion upon request from the creator(s), but the maximum share of such contribution by the Institute shall not exceed 50% of the revenue coming to the Institute.

10. Exception in case of IP unrelated to official work

When such IP is unrelated to the creator(s)' formal tasks and functions in the Institute, they may ask the Institute for permission to patent or licence it to organisations on their own. Such IP will often be in a field completely unrelated to the creator's area of expertise, even though the Institute has hired him or her. The IPR Committee will review the request and provide a recommendation regarding whether or not the creators' request should be granted. The creator(s) will be the only beneficiaries of all earnings from such IP, and the creator(s) will not be required to pay any money from such earnings to the Institute, if the Director grants the creator(s) permission to own, protect, and licence the IP independently based on the Committee's recommendations.

11. Copyright

a) The technical reports, review works, may be copyrighted, if the author wishes to copyright.

b) The author of a report may also request to copyright on behalf of the Institute, any other material such as B.Tech. and M. Tech project reports.

c) While copyrighting the thesis it is the responsibility of the creator to ensure that the contents do not violate any copyright rules. If diagrams, tables and text are reproduced from any other copyrighted work, prior permission is to be obtained by the creators from the owner of the copy right document from where the material is taken.

d) If information from some other sources are included, appropriate acknowledgement has to be given to this source, as per copyright law.

e) Exceptions:

1. The ownership of the copyrights by the Institute in no way deprives the claims of the creators/authors to publish the contributions in scholarly and intellectual work, and their authority to improve, publish and propagate the work. When a journal that accepts a paper submitted by an employee/student requires copyright for the paper to be given to them before publishing the said paper, the employee/student may do so.

2. The Institute may waive ownership of copyrights it owns in favour of the author(s), contributor(s) on request.

3. Students and scholars may be allowed ownership of the copy rights to their works provided

a) they do not result from works for which they had received financial or supervisory support of any form from or through the Institute



- b) the work does not include any material generated entirely or partially with the help of Institute facility or ongoing research programme or the intellectual input of any employee of the Institute.

12. Computer Software

a) Depending on the IP Content, software may or may not be protected by copyright. A computer programme may only be given by its author to researchers, teachers, and students in other institutions for the purpose of research and instruction after the recipient has signed a document stating that they will not use it for commercial gain or transfer it to another party without the creator's or institution's express permission. The programme retains its IPR protections after this transfer. In an effort to spread scientific information, the inventor of the programme may elect to release IPR-protectable software into the public domain, establish standards, or solicit user comments to progress the research. To safeguard the intellectual property of such software, however, as is customary, the author is encouraged.

b) The legal and IPR restrictions by the suppliers of the software in the use of all software procured by the creators shall be clearly understood and adhered to.

c) Since licence limitations impede the Institute's ability to create and share the R&D work, the Institute encourages adoption of license-free software in research and development projects carried out by its staff and students.

d) The terms and conditions are to be established with the owners of the copyright of the original software platforms, on which the new software may have been produced, before copyright and patent for software ownership are sought for by the creator(s).

13. Publication based on IP

a) Faculty members, scientists, and research scholars publish their original works through mediums for which they typically have complete creative control. A small portion of the body of knowledge developed is represented by publications. The goal of the Institute is to promote the transmission and diffusion of information in the most comprehensive way possible, with the following limitations.

1. Publications based on externally financed work may occasionally be subject to contractual requirements that the supporting agency provide approval. According to the terms of the Institute's contract with the sponsor, the sponsor must act promptly to grant the permission to publish and this permission cannot typically be denied, save to protect any tangible intellectual property that may have commercial value or security interests for the sponsor.

2. The sponsor's support for the work reported in any publications based on funded projects must also be acknowledged.

3. In the event of IP created through sponsored work, all contractual commitments must be upheld by the creators.

b) Before such IP is published or traded, it is preferable to secure patent protection at least in the form of a provisional application to ensure that the IP's academic and commercial value is safeguarded.



c) Before sharing information about any IP, participating parties may sign a particular confidentiality agreement in order to safeguard its commercial value without hindering information interchange.

14. Agreements and Contracts

a) Agreement categories and authorized signatories

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

1) Classified Information Nondisclosure (Specific) Agreement and Confidentiality Agreement are simply included to help the Institute make sure that it is not held responsible in any way for any violations of the agreement. The Institute will act fast if the Agreement is wholly between the external party and the employee or student and the Institute is not in any way rendered liable by the Agreement, as such agreements frequently need to be entered into rapidly to facilitate progress in collaboration/interaction.

2) Revenue Sharing Agreement, Indemnity agreement.

3) Evaluation Agreement, Consultation Agreement, Research and Development Agreement (R&DA/ MOU)

4) Technology Transfer Agreement, License Agreement, IP assignment agreement

5) Alternative Dispute Resolution Agreement

All of the aforementioned categories of agreements, with the exception of the confidentiality agreement, which may be signed by the inventor with the Chairman, IPC's permission, must have the Chairman, IPC, as selected by the Director, as the final signing authority.

b) Infringements, Damages, Liability and Indemnity Insurance

1) In any agreement with the licensee, the Institute must receive indemnification from any legal actions taken against it, including its employees, for whatever cause, including but not limited to manufacturing flaws, production issues, the guarantee of the design, upgrades, and debugging duties.

2) In general, Institute shall secure indemnity from the organisation to which IP is transferred through an appropriate agreement, protecting it from any direct or third-party legal liability arising out of commercial use of IP.

3) The Institute must expressly disclaim any liability for any software usage by any user in any computer programme it develops and distributes, whether for free or for a fee.

4) The Institute will continue to have the option to take part in any legal actions involving patent and licencing infringements.

c) Conflict of Interest



1) Any actual or potential conflict of interest must be disclosed by the creator(s). The creator(s) must declare any ownership interests they may have in a licensee or potential licensee company if they do so, as well as any ownership interests of their immediate family members.

2) Taking this into account, the Chairman of the IPC must approve any licencing or assignment of IP rights to a business in which the inventors own stock.

15. Dispute Resolution

In the event of a disagreement about IPR policy, the Institute's judgement shall be considered final and binding.

16. Jurisdiction

As a general rule, all agreements that the Institute enters into will be subject to the jurisdiction of the courts in Kolkata and governed by the relevant Indian laws. The Institute might make an exception in some circumstances.

