

## Document on Intellectual Property Policy for Indian Institute of Technology Bombay

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Preamble:

The vision of IIT Bombay is 'to be the fountainhead of new ideas and of innovators in technology and science' and its mission 'is to create an ambience in which new ideas, research and scholarship flourish and from which the leaders and innovators of tomorrow emerge'. In fulfillment of its vision and mission, IITB has taken the initiative to promote innovations and to facilitate protection of Intellectual Property

(IP) thus generated at IITB. Consequently, the protection of inventions and other creative works of its faculty, other employees and students as IP has been growing.

Processes to support these efforts have been evolving over time and now have attained a level of maturity. A formal Framework to guide the implementation of these processes is now a clearly-felt need. Towards this goal an Intellectual Property Policy for IIT Bombay has been formulated. This policy aims to lay down, the processes for promotion and support available to innovators at IIT Bombay for translating their creative works into IP. Parties engaged in creations of original and innovative work at IITB include faculty, staff and other employees of IITB, including staff working on various projects, registered students of IITB, students from other institutions, personnel from other organisations or any other individuals working in IITB. This policy also aims to set forth guidelines for ownership of IP developed at IIT Bombay by IITB personnel and non-IITB personnel and its commercialization.

The aim of the IP Policy is to sustain and grow creativity in an ethical environment in IIT Bombay that recognizes the importance of innovations and assists in translating them into products, processes and services for commercial exploitation and to achieve the widest public good.

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#### The Role of IRCC in IP Protection:

The Industrial Research and Consultancy Centre (IRCC) at IIT Bombay provides guidance, support and resources to all IITB personnel and facilitates protection and deployment of intellectual property. In achieving this goal, IRCC creates awareness of the importance and role of IP Rights, implements the IP policy, ensures transparency and fairness of the IP policy to encourage compliance, solicits feedback regarding the fulfillment of the IP policy and periodically reviews the Policy to improve upon any shortcomings, strengthens the infrastructure and resources for protection and exploitation of IP and makes available expert inputs.

Issues of ownership, confidentiality, disclosure, patentability, technology transfer, revenue sharing, and conflict of interest among others play a very important role in any IP management. IRCC conducts workshops to enhance awareness on related issues. IRCC also provides templates and guidelines for the contracts, agreements and MOUs governing the effective exploitation of the IP produced by IITB. All such agreements and matters relating to confidentiality, infringements, damages, liabilities and compliance are administered by IRCC.

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#### The IP Policy:

This policy is applicable to all IITB personnel, as well as non-IITB personnel associated with any activity of IITB such as, but not limited to, Continuing Education Programme and covers different classes of Intellectual Property -- Patent, Copyright, Trade Mark / Service Mark, Design Registration, Trade Secret, Confidential Information and Integrated Circuits Layout.

#### Ownership:

I(a) Invention(s), Designs, Integrated Circuit Layouts and other creative works:

Invention(s) including software, designs and integrated circuit layouts, created by IITB personnel without the use of significant IITB resources and not connected with the profession for which employed at IITB, shall be owned by the creator(s).

For invention(s) including software, designs and integrated circuit layouts, produced during the course of sponsored and/or collaborative activity, specific provisions related to IP made in contracts governing the collaborative activity shall determine the ownership of IP.

IITB shall be the owner of all invention(s) including software, designs and integrated circuit layouts created by teams of IITB and non-IITB personnel, associated with any activity of IITB. Non-IITB personnel, who create invention(s) including software, designs or integrated circuit layouts at IITB but without intellectual contribution of IITB personnel or significant use of IITB resources, shall be the owner of such invention(s).

Except as stipulated above, IITB shall be the owner of all invention(s) including software, designs and integrated circuit layouts created at IITB.

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#### I(b) Copyrightable Work:

Ownership of copyright of all copyrightable work shall rest with the author(s) with the following exceptions:

If the work is produced during the course of sponsored and/or collaborative activity, specific provisions related to IP made in contracts governing such activity shall determine the ownership of IP.

IITB shall be the owner of the copyright of work, including software, created by IITB personnel with significant use of IITB resources.

IITB shall be the owner of the copyright on all teaching material developed by IITB personnel as part of any of the academic programs at IITB. However, the authors shall have the right to use the material in her/his professional capacity. As the traditional exception, IITB shall not claim ownership of copyright on books and publications authored by IITB personnel.

IITB shall be the owner of copyright of work produced by non IITB personnel associated with any activity of IITB with the intellectual contribution of IITB personnel. However, the authors shall have the right to use the material in her/his professional capacity.

#### I(c) Trade Mark(s) / Service Mark(s):

Ownership of trade mark(s) / service mark(s) created for IITB shall be with IITB.

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

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#### (II) Disclosures, Confidentiality and Assignment of Rights:

For sponsored and/or collaborative work the provisions of the contract pertaining to disclosure of creative work are applied.

For all other invention(s) produced at IITB, if the inventor(s) wish to protect the invention(s) they produce, then they are required to disclose the creative work to the IRCC at the earliest date using an Invention Disclosure form (IDF).

Disclosure is a critical part of the IP protection process and it formally documents claims of inventorship, the date of the invention and other details of the invention. The inventor(s) shall assign the rights of the disclosed invention to IITB.

All IITB personnel and non-IITB personnel associated with any activity of IITB shall treat all IP related information which has been disclosed to the IRCC and/or whose rights are assigned to IITB, or whose rights rest with IITB personnel, as confidential. Such confidentiality shall be maintained till the date as demanded by the relevant contract, if any, between the concerned parties unless such knowledge is in the public domain or is generally available to the public.

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### (III) Assessment of Innovation(s) for Protection:

To facilitate assessment, an IP Assessment Committee (IPAC) shall be formed by the Dean (R&D) consisting of a chairperson, the IRCC Technical Officer (Secretary) and at least three additional faculty members with domain expertise or familiarity/experience in areas related to the creative work. The creator(s) would be free to suggest names of faculty who are qualified to evaluate the creative work who may be invited by the Dean (R&D) to be a part of the IPAC.

The IPAC shall assess the disclosure in a timely manner and shall make recommendations to the Dean (R&D) about the patentability of the invention according to the provisions of Section(I) of this policy. The IPAC may make one of the following recommendations:

that IITB shall take the responsibility of protection of the IP, in which case, IITB will initiate appropriate processes.

that IITB shall not take the responsibility of protection of the IP, in which case, the rights to the disclosed invention shall be promptly reassigned to the creator(s). The creator(s) may then choose to protect the creative work on their own.

**Filings of IP Applications in foreign countries:** Within six months of filing the Complete IP Application in India, IITB shall, based on available information decide on the suitability of protection of the invention in foreign countries. If IITB opts not to undertake such protection in any specific country requested by the inventor(s), IITB shall assign rights of the IP in that country to the creator(s) for the purpose of such protection.

**Renewal of IP Rights:** A decision on the annual renewal of IP rights will be taken by a committee constituted by the Dean (R&D). If IITB decides not to renew the IPR in any country, then it will assign the rights of the IP in that country to the creator(s) upon a request to that effect from the creator(s). In case of patents, the process of reassignment will be completed in a period of three months before the due date for its renewal.

In all cases where IP rights in any specific country have been reassigned to the inventor(s), IITB shall not claim any share of proceeds earned through that IP in that country excepting for the costs already incurred by IITB.

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(IV) Support:

(IVA) Contracts and Agreements:

All agreement including but not limited to the following categories, undertaken by any IITB personnel and students need to be approved by IITB.

Allegiance, Affirmation & Confidentiality Agreement

Consultation Agreement

Evaluation Agreement

Research and Development Agreement (R&DA/MOU)

License Agreement

Technology Transfer Agreement

Alternative Dispute Resolution Agreement

Classified Information Non-disclosure (specific) Agreement

Dean R&D acts as a final signing authority in all the categories of agreements listed above. IRCC facilitates the process of framing such agreements by way of providing templates and services of professional consultants.

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#### (IVB) Obtaining IPR:

If IITB opts to protect the creative work, it shall provide an IPR Advisor/Patent Attorney for drafting the IP application as appropriate. IITB shall pay for access to the relevant IP information databases and other associated costs. The inventor(s) shall conduct IP searches, study the prior art and provide the necessary inputs to assist in the drafting of the IP application. IITB shall bear all costs of drafting and filing an Indian IP application. If IITB chooses to file IP applications in other countries, then it shall bear the cost of application and other associated costs. IITB shall be free to enter into agreements with overseas institutions for protection and licensing of the IP.

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#### (V) Technology Transfer:

IITB shall strive to market the IP and identify potential licensee(s) for the IP to which it has ownership. The creator(s) are expected to assist in this process.

IITB may contract the IP to a Technology Management agency, which manages the commercialization of the IP.

For the IP for which exclusive rights have not been already assigned to a third party, the creator(s) may also contact potential licensee(s) on their initiative maintaining confidentiality and taking all necessary care so as not to affect the value of the IP through appropriate agreements such as Non Disclosure Agreement (NDA) with the potential licensee(s) during technology marketing discussions.

If IITB is not able to commercialize the IP in a reasonable time, then it may reassign the rights of the IP to the creator(s) of the IP. Optionally, If IITB has not been able to commercialize the creative work in a reasonable time frame, the creator(s) may approach the Dean (R&D) for the assignment of rights of the invention(s) to them.

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(VI) Revenue sharing:

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

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 IITB at the time of disbursement.

Case

Net Earnings

Inventor(s) share

IITB's share

1

For the first amount Q

70%

30%

2

For the next amount Q

50%

50%

3

For amounts more than 2Q

30%

70%

When ITB reassigns the rights of the IP to its creator(s) for any country, the creator(s) shall reimburse the costs incurred by IITB for the protection, maintenance and marketing and other associated costs from the cumulative earnings from successful commercialization in that country as under:

Case

Cumulative Earnings

Inventor(s) share

IITB's share

A

Upto twice the cost incurred by IITB for protection, marketing and other associated costs.

50%

50%

B

Beyond A

100%

0%

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.

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(VII) Infringements, Damages, Liability and Indemnity Insurance:

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

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

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

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#### (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.

A license or an assignment of rights for a patent to a company in which the inventors have a stake shall be subject to the approval of the Dean (R &D) taking into consideration this fact.

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#### (IX) Dispute Resolution:

In case of any disputes between IITB and the inventors regarding the implementation of the IP policy, the aggrieved party may appeal to the Director of IITB. 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 IITB will have the jurisdiction of the courts in Mumbai and shall be governed by appropriate laws in India.

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#### Glossary:

'Author' means faculty, students, staff or visiting faculty who has/have written or created a creative work.

'Collaborative Activity' is the research undertaken by IITB personnel in cooperation with industry and/or another researcher(s) who are not IITB personnel.

'Confidential Information' Information not in the public domain and declared confidential by parties as such in a MOU/Agreement that has been signed by the parties.

'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.

'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.

'Copyrightable Work' is a creative work that is protectable under copyright laws. 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.

'Creators' are persons who have produced any original work

'Cumulative Earnings' from a patent/patent application are the total earnings to date obtained from the commercialization of the patent/patent application.

'Design Registration' Registration of the novel non-functional features such as shape, or ornamentation of a product.

'IITB personnel' includes but is not limited to the faculty, students, staff or visiting faculty, researchers and scientists at IIT Bombay.

'Intellectual Contribution' means original technical or artistic contributions.

'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.

'IP Assessment Committee (IPAC)' is a committee formed by the Dean (R&D), which decides on the issues of ownership and patentability among others consisting of a Chairperson, the Technical Officer (Secretary) of the IRCC and at least three additional faculty members.

'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.

'Licensing' is the practice of renting the intellectual property to a third party.

'Net Earnings' Earnings resulting from the licensing or commercialisation of the IP, reduced by the outstanding actual expenses incurred in obtaining and commercialization of the IP.

'Patent' means the exclusive right granted by law for making, using or selling an invention.

'PCT Application' A PCT is a system of filing a patent application in several countries through a single application keeping the priority of the first filing in any of the countries within the PCT system.. This is administered by the World Intellectual Property Organisation (WIPO) in Geneva. It is not a patent granting system.

'Protection of Layout of Integrated Circuits' Layout scheme of Integrated circuits that are functionally important.

'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.

'Significant Use of IITB Resources' is any usage of IITB's resources in the creation of the invention(s), excess of the routine use of office facilities, computers, library resources and resources available to the general public.

'Software' means anything executable in a computer.

'Teaching material' means any material that aids the process of teaching

'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.

'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.

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