



IP POLICY 2020

Office of AVC (Innovation and
Enterprise)
Universiti Brunei Darussalam
Brunei Darussalam

WHAT IS IP

INVENTIONS

Intellectual
Property (IP)
refers to
**Creation of
Mind**

DESIGNS

LITERACY &
ARTISTIC
WORKS

SYMBOLS,
NAMES AND
IMAGES
USED IN
COMMERCE

TYPES OF IP

Patents

- Inventions

Trademarks

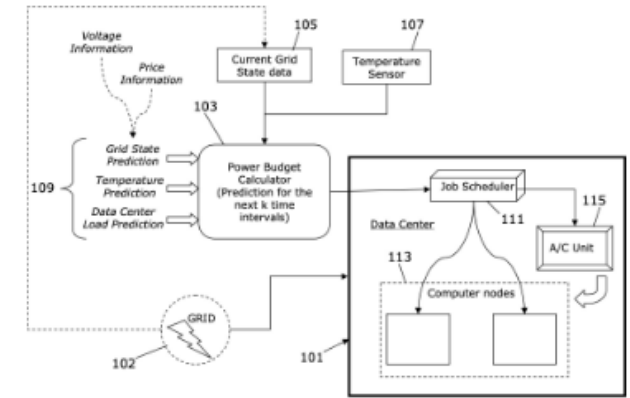
- Identify source of a product or service

Copyrights

- Expressions of ideas

Trade Secrets

- Secret information with commercial value



UNIVERSITIES IPS

IP and Research

Inventions, scholarly publications, databases, new plant varieties, confidential information, computer programs, etc.

IP and Teaching

Print publication, lecture notes, theses, software, films, sound recordings, computer presentations, etc.



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SCOPE OF THE POLICY

- This Policy applies to all IP generated at the University, in particular by Staff Members, Students and Visitors

- Binding effect of the Policy

**STAFF
MEMBERS**

STUDENTS

VISITORS

GOVERNANCE AND OPERATION

IP Committee

- Chaired by the AVCIE
- Advisory body in the determination of IP management and commercialisation strategy for University IP

Office of Assistant Vice Chancellor Innovation and Enterprise(OAVCIE)

- Assists the IP Committee in managing and commercializing its IP
- Responsibilities:
 - Outreach/awareness to Creators
 - Relationship management with Creators
 - IP management
 - Technology marketing and IP contract negotiation
 - IP contract management
 - IP costs and revenue distribution.

OWNERSHIP OF IP AND RIGHTS OF USE

IP created
by Staff
Members

IP created
by Students

IP created
by Visitors

Special rules
for Course
Materials

Special rules
for Scholarly
works



IP created by Staff Members

University Ownership

- The University owns all IP emanating from any University study project created by a Staff Member:
 - in the course of and within the scope of his other employment; or
 - making Substantial Use of the University's resources.
- Different terms may be applicable for Sponsored Project

Staff Member Ownership

- Staff Members will either own or co-own the IP they have created when such IP:
 - is created outside the course and scope of their employment and without Substantial Use of the University's resources;
 - vests in Scholarly Works (see Paragraph 5.5); or
 - for which the University does not wish to claim ownership and the University has communicated as such in writing

IP emanating from Sponsored Project

- Terms of the Sponsored Project Contract will regulate ownership of IP created by Staff Members.
- In the absence of IP terms in a Sponsored Project Contract or in the absence of a Project Contract, the University owns the IP created under Sponsored Project.

Appointment of Staff Members at another university

- It is the responsibility of each Staff Member that holds an honorary or other academic or research appointment at another institution (Host University) to negotiate a suitable IP arrangement with the Host University prior to the tenure at the Host University so that the University owns the IP fully or partially based on intellectual contribution of the Staff Member.
- To the extent that the Host University's IP Policy makes a claim on IP created by the Staff Member pursuant to such appointment, the Staff Member shall bring to the attention to the AVCIE to get a waiver of applicability of this Policy by VC.



IP created by Students

University ownership

- The University owns all IP emanating from University Study Project created by a Student when:
 - in the course and scope of his/her study; or
 - making Substantial Use of the University's resources.

Student ownership

- Student will own or co-own the IP they have created when such IP:
 - is outside the course and scope of their course or study and without Substantial Use of the University's resources;
 - vests in Scholarly Works (see Paragraph 5.5); or
 - for which the University does not wish to claim ownership and the University has communicated as such in writing.

IP emanating from Sponsored Project

- Terms of the Sponsored Project Contract will regulate ownership of IP created by Students. In the absence of IP terms in a Sponsored Project Contract or in the absence of a Project Contract, the University owns the IP created under Sponsored Project.

Theses or dissertations.

- The Student must submit his or her final thesis or dissertation to the University repository. The Student also grants a royalty-free license to the University to reproduce his or her thesis or dissertation and to distribute copies thereof to the public. Any IP derived from Theses or dissertations shall be owned by the University as set out in Paragraph 5.2.1.

IP emanating from Discovery Year Project.

- IP emanating from a Student's Discovery Year Project shall be owned by Discovery Year Sponsor

Bursaries/scholarships

- An external party that grants a bursary or scholarship to a Student may elect to own the IP created by that Student in the course of his/her study at the University provided the student, and the University have consented to the assignment of IP ownership in writing.

IP created by Visitors

University ownership

- Unless otherwise agreed to in writing by the University and the Visitor prior to the tenure at the University, the University owns IP created by Visitors when:
 - created in the course and scope of their appointment at the University; or
 - created by making Substantial Use of the University's resources.

University IP

- On departure from the University, a Visitor must sign and submit an IP Disclosure Form to AVCIE disclosing any IP created, whilst at the University.

Special rules for course materials

University ownership

- The University will own the IP in Course Materials
 - created by a Staff Member or a Visitor, with the exclusion of Course Material that is created from or for Open Educational Resources

Licensed by the University

- The University grants the Creators of Course Materials
 - a royalty-free, non-exclusive license to use the Course Materials created by them.



Special rules for scholarly works

Publication

- The University recognises and endorses the rights of Staff Members, Students and Visitors to publish their Scholarly Works, provided
 - that any Scholarly Work which may disclose any possible University IP shall first be cleared by OAVCIE after having an opportunity to protect such University IP

Licensed to the University

- Staff Members, Students and Visitors
 - grant to the University non-exclusive, royalty-free license to use their Scholarly Works for the University's administrative, promotional, Research and teaching purposes

PUBLICATION, NON-DISCLOSURE AND TRADE SECRETS



Right of publication

- The University encourages and supports the right of Creators to decide if and when to publish their Research results.

Non-disclosure for IP protection

- Creators should be aware that premature Public Disclosure may result in loss of IP protection rights.
- Therefore, they are strongly encouraged to make all reasonable efforts to identify any protectable IP as early as possible, and shall consult OAVCIE by completing IP Disclosure Form when required before making any Public Disclosure of potential University IP.

Trade Secrets

- All Creators will be obligated to maintain the confidentiality of the Trade Secret and to follow the direction for management of the Trade Secret by OAVCIE.

SPONSORED PROJECT CONTRACT



Authority

- Staff Members, Students and Visitors shall not have the right to enter into a Sponsored Project Contract with external parties on behalf of the University unless they are authorised to do so by the VC.

Basic Principles

- The IP clauses in all Sponsored Project Contracts shall be governed by the following basic principles:
 - **Concluded from the outset**
 - must be executed in writing and signed by the University and the external party(ies)/sponsor(s) prior to the commencement of the Project
 - **Background IP**
 - Background IP of the University, belongs to the University and use of such Background IP requires expressed written permission in the contract.
 - **Foreground IP (IP arising from the Project Contract)**
 - shall be co-owned by the University and external party(ies)/sponsor(s) as mutually agreed contractually.
 - **Serendipitous IP**
 - Any IP created during the course of the Project Contract which falls outside of the scope of the Project Contract shall be owned by the University or the external party(ies)/sponsor(s) which developed such IP unless agreed contractually otherwise in the Project Contract.
 - **Right of first refusal to the IP**
 - The Sponsored Project Contract may include provisions giving the external party(ies)/sponsors, a right of first refusal to Commercialise the IP emanating from the Sponsored Project Contract, through a license or joint venture arrangement or assignment.
 - **Publication delay**
 - delay will not exceed 90 calendar days from the date AVCIE is notified of the intent to publish unless authorised by the AVCIE.
 - **Use of IP for Research and teaching**
 - where the University IP is licensed exclusively or assigned as part of the Sponsored Project Contract, all efforts should be made to secure a royalty-free license for the use of the IP for on-going Research and teaching purposes



DETERMINATIONS BY THE OAVCIE

Responsibility to Disclose IP

- **Recording**
 - creators shall keep appropriate records of their Research
- **IP Disclosure**
 - disclose potential IP to AVCIE promptly by means of an IP Disclosure Form
- **Complete disclosure**
 - Creators must provide full, complete and accurate information of potential IP

Creatorship and Ownership

- **Creatorship**
 - Creators shall, upon request, sign the appropriate legal documents provided by OAVCIE that attest to creatorship
- **Ownership**
 - Once creatorship has been determined, the Creators shall be required to assign any right formally, title or interest they may have in that IP to the University in the form of a contract.



Determination As To IP Protection And Commercialisation

Evaluation and recommendation

- OAVCIE will analyse the information disclosed in the IP Disclosure within **90 days** of formal receipt.
- The analysis will include:
 - subject matter is protectable as IP;
 - economic viability or marketability; and
 - determination of any rights of external parties, such as a funder or collaborator.

Decision to protect/Commercialise

- The University will decide, as soon as reasonably practicable, whether or not it wishes to protect or Commercialise the IP.

University's obligation to notify Creators of its decision

- OAVCIE will notify the Creator(s) of the decision of whether the University will or will not pursue IP protection and Commercialisation of their IP Disclosure.



University elects not to protect/commercialise the IP

IP abandoned or not Commercialised

- The University reserves the right not to protect or Commercialise IP that it owns if after consultation with the Creators:
 - there is no reasonable prospect of commercial success; or
 - it is not deemed to be in the best interest of the University; or
 - it is not deemed to be in the public interest.

Transfer of Ownership

- If University decides not to pursue IP protection or Commercialisation, it will take steps to return said IPRs to the Creator(s).

Written notification

- If the University is unable to or decides not to protect or Commercialise the University IP, it should notify the relevant Creator(s).

No prejudice to IP protection

- The Creator(s) should receive the written notification in a timely manner that enables the relevant Creator(s) to take any formal steps to ensure the protection of IP, should they so desire.

Assignment

- If the Creator elects to take an assignment of the IP, the University shall ensure that a deed of assignment is executed without delay.

Terms and conditions

- If the University assigns IPRs to the Creator, the assignment may be subject to one or more of the following terms and conditions:
 - that upon Commercialisation, the University be compensated for any expenditure it may have incurred in connection with the protection and Commercialisation of such IP;
 - that the University be granted a non-exclusive, royalty-free licence to use the IP for Research and teaching purposes.

COMMERCIALISATION OF IP

Commercialisation Pathways

- exclusive or non-exclusive license, and variations thereof, with preference for licensing to start-ups, small and medium-sized companies or businesses;
- assignment or sale;
- formation of a Commercialisation Entity to which the IP is licensed or assigned in terms of this Policy;
- non-profit use or donation;
- joint ventures;
- royalty-free access on humanitarian or other grounds; or
- various combinations of the above

INCENTIVES AND DISTRIBUTION OF REVENUES

Calculation of Gross IP Revenue

- revenue received from, outright sale of IP, option payments received, licence fees received, evaluation fees received, upfront and milestone payments received, royalty payments received, share of profits received, dividends received, commissions, income through disposal of equity, and direct sale of products or services.

IP Expenses

- expenses that relate to (i) the University's expenses incurred by payment to external entities for securing, maintaining and enforcing IP protection, such as patenting and litigation expenses; (ii) costs incurred by the University in the licensing/assignment of IP, including marketing costs, contract negotiation and drafting costs; and (iii) costs in making, shipping or otherwise distributing products, processes or services that embody the particular IP, but not including staff time or general administrative costs.

Calculation of Net IP Revenue

- Net IP Revenue is calculated as the Gross IP Revenue less IP Expenses and Enabler's share.

Co-owned IP

- Where the IP is co-owned by the University and an outside organisation, the Gross IP Revenue received by the University will be shared in accordance with a pre-determined formula as per a contractual arrangement.



Sharing Of Revenues – Creators/Enablers

Standard Creator's share

- Forty-five percent (45%) of the Net IP Revenue received from commercialisation of University-owned IP will be allocated to the Creators.

Standard Enabler's share

- The University may elect to set aside predetermined percentage of the Gross IP Revenue for an Enabler.

Disputes

- In the event of a dispute or uncertainty, the issue shall be brought for a resolution to an independent body.

Payment

- Payment to the Creators or Enablers will be made by the University on a periodic basis as agreed in writing, after receipt of the Gross IP Revenue.

Taxes

- Payments made are subject to personal tax if applicable .

Entitlement

- Creators or Enablers and their heirs will be entitled to IP revenue sharing for as long as the University receives Gross IP Revenues.
- The entitlement will survive any resignation or termination of employment or death of the creator.

Banking details

- Creator or Enabler to ensure that the University has the current banking details of the Creator or Enabler.

Sharing of revenues

- University. The University's share of Net IP Revenue is fifty-five percent (55%).



DISPUTE

Dispute Resolution

- Any internal disputes or questions of interpretation or application of this Policy will be referred to OAVCIE first for consideration and mediation by the IP Committee
- If the matter cannot be resolved by the IP Committee within six months, then the dispute or question of interpretation must be referred to the VC
- The VC may at their sole discretion refer the matter to University's Senior Management Team or an independent committee for resolution of any dispute for final determination

Appeal

- Individuals covered by this Policy shall have the right to appeal the application of any aspect of this Policy to the VC

AMENDMENT

Revision

- This Policy may be amended at any time. In this case:
 - all IP disclosed on or after the effective date of such amendment
 - shall be governed by the Policy as amended; and
 - all IP disclosed prior to the effective date of the amendment
 - shall be governed by the Policy prior to such amendment, provided that the provisions of the Policy (as amended) shall apply to all IP licensed or otherwise Commercialised on or after the effective date of any such amendment regardless of when the IP is disclosed.



THANK YOU

Office of AVC (Innovation and Enterprise)
Universiti Brunei Darussalam
Brunei Darussalam



NET IP REVENUE

= Gross IP Revenue – (IP Expenses + Enabler's Share)





DEFINITIONS

Creator

- Creates, conceives, reduces to practice, authors, or otherwise makes a substantive intellectual contribution

Enabler

- Who have indirectly contributed to the creator of IP by Creators – without whose practical contribution the commercialization would not have been possible

Substantial Use

- Extensive unreimbursed use of the University's resources which include but are not limited to facilities, equipment, Background IP that is not publicly available, human resources or funds. Use will be deemed not substantial for routine use of library, office space, or laptop, desktop computer

Sponsored Project

- a project that is partially or fully funded either by an external party or the University. It includes a consultancy or a collaborative project but excludes Discovery Year Projects

Sponsored Project Contract

- Agreement between the University and the external party or sponsor regulating Sponsored Project, including IP terms

University Study Project

- A project undertaken by a Student or a Staff Member or both whether funded or not by the University. It does not include Sponsored Project