

IP Policy 2020

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

Intellectual Property

Intellectual property (IP) refers to creations of the mind, such as inventions; literary and artistic works; designs; and symbols, names and images used in commerce.



Patent

A patent is an exclusive right granted for an invention, which can be a product or a process, that gives a new technical solution to a problem.



Trademark

A trademark may consist of words, designs, letters, numerals or the shape of goods or their packaging.



Industrial Design

An industrial design is the features of shape, configuration, pattern or ornament which, when applied to a product, it gives the product the unique appearance.



Plant Varieties Protection

Plant variety protection (or plant breeder's right) gives the breeder of a new plant variety exclusive control over the variety, rights to use the variety, and development into new breeding techniques.



Copyright

Copyright is the exclusive right given to creators of creative works to use and reproduce the works. The creative works are literary, musical, dramatic, artistic, films, sound recordings, broadcasts, cable programmes, and published editions.

Scope of Policy

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

Ownership of IP

University Ownership

The University owns all IP emanating from any University study projects created **by staff members, students and visitors** in the course of and within the scope of their **employment, studies or tenure**; or when they are making **Substantial Use** of the University resources.

Staff Member and Student Ownership

created outside the course and scope of their employment or study and **without Substantial Use** of the University's resources

vests in Scholarly Works

the University does not wish to claim ownership and the University has communicated as such in writing

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

Visitor 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

created by making **Substantial Use** of the University's resources

Leaving the University

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.

Appointment of Staff Members at another University

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.

In the case of Host University's IP Policy makes a claim on IP created by the Staff Member during their appointment, the Staff Member shall bring to the attention to the AVCIE to get a **waiver of applicability** (relinquishment) of this Policy by VC.

Ownership of IP

Theses/ 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 of a student shall be owned by the University.

IP from Discovery Year Project

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 emanating from Sponsored Projects

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.

Sponsored Projects

Sponsored Project is 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

Special Rules

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.

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

Creators

those who create, conceive, reduce to practice, author, or otherwise makes a substantive intellectual contribution

PUBLICATION, NON-DISCLOSURE AND TRADE SECRETS

R ight of publication

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

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.

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.

Sponsored Project Contracts

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.

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.**

Responsibility and Decision to Protect

IP Disclosure

creators shall keep appropriate records of their Research

IP Disclosure

Creators 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.

Evaluation and recommendation

OAVCIE will analyse the information disclosed in the IP Disclosure within 90 days of formal receipt.

The analysis will include:

- If 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.

Relinquishment of 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

Formation of a Commercialisation Entity to which the IP is licensed or assigned in terms of this Policy

Royalty-free access on humanitarian or other grounds

Non-profit use or donation

Assignment or sale

Joint ventures

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.**

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.**

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.

Net IP Revenue

$$\text{Net IP Revenue} = \text{Gross IP Revenue} - (\text{IP Expenses} + \text{Enabler's Share})$$

Enablers

those who have indirectly contributed to the creation of IP - without whose practical contribution the Commercialisation would not have been possible.

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

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**

all IP disclosed prior to the effective date of the amendments 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