

IP MANAGEMENT AT IIT ROORKEE

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1. HOW IS THE IP MANAGEMENT FUNCTION EMBEDDED IN THE INSTITUTION

The IPR Cell has been set up at IIT Roorkee in order to create an environment that shall foster the growth of intellectually capable, innovative and entrepreneurial professionals. Keeping pace with the fast growth of industry and national economy the IPR Cell has especially taken up a wide range of activities from creating awareness, to developing human resource and a framework for IP generation and management in a short span of last 3 years. In view of the professional growth envisaged it is proposed to broaden the functional scope of the IPR Cell by upgrading it as an Academic Service Center to cater the emerging academic and service requirements of the institute and outside community. However, the IP management functions in the institute under the stipulated guidelines of its IPR Policy document. The information pertaining to these activities and achievements is highlighted below.

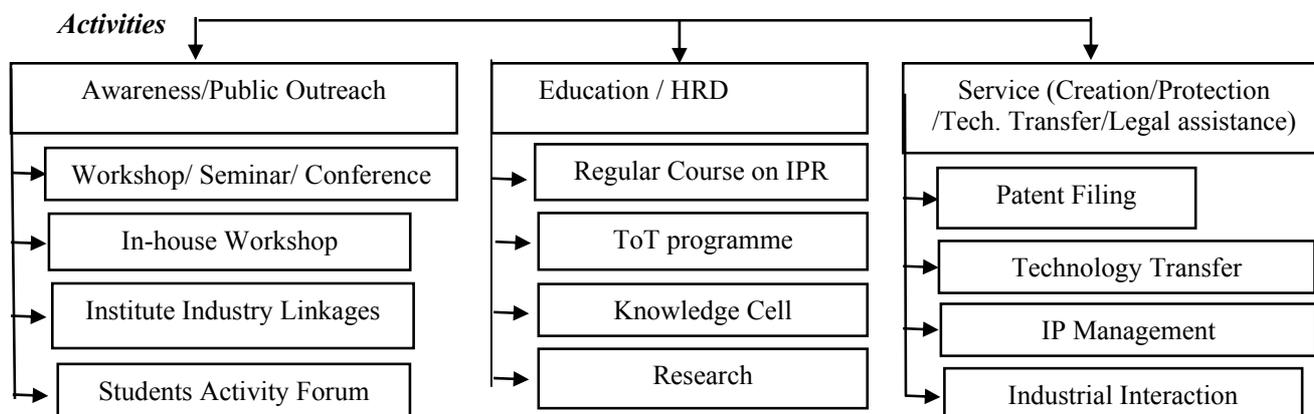
Objective

Provide environment for academic excellence and conduct dedicated academic programs on IPR for the undergraduate and postgraduate students as well as organise regular IPR counselling programme for the research scholars.

Provide a platform to diagnose innovation and research on contemporary issues of national and international relevance leading to creation of IPR.

Promote and establish collaborative frameworks for industry-institute partnerships at national and international scale to initiate research and development of commercial value.

Facilitate, encourage, promote and safeguard Intellectual property.



An Institute Intellectual Property Committee (IIPC) comprising of the Dean, (Sponsored Research and Industrial Consultancy) SRIC as Chairman, Coordinator, IPR Cell, and three additional members nominated by the Chairman of the Senate is responsible to administer all decisive issues related to IP policy and such other relevant matters as shall be determined from time to time. An employee requires to observe the Institute's policy and decisions on Intellectual Property Rights as may be decided by the IIPC from time to time. The Dean (SRIC) is responsible for the implementation of all the recommendations and decisions through IIPC.

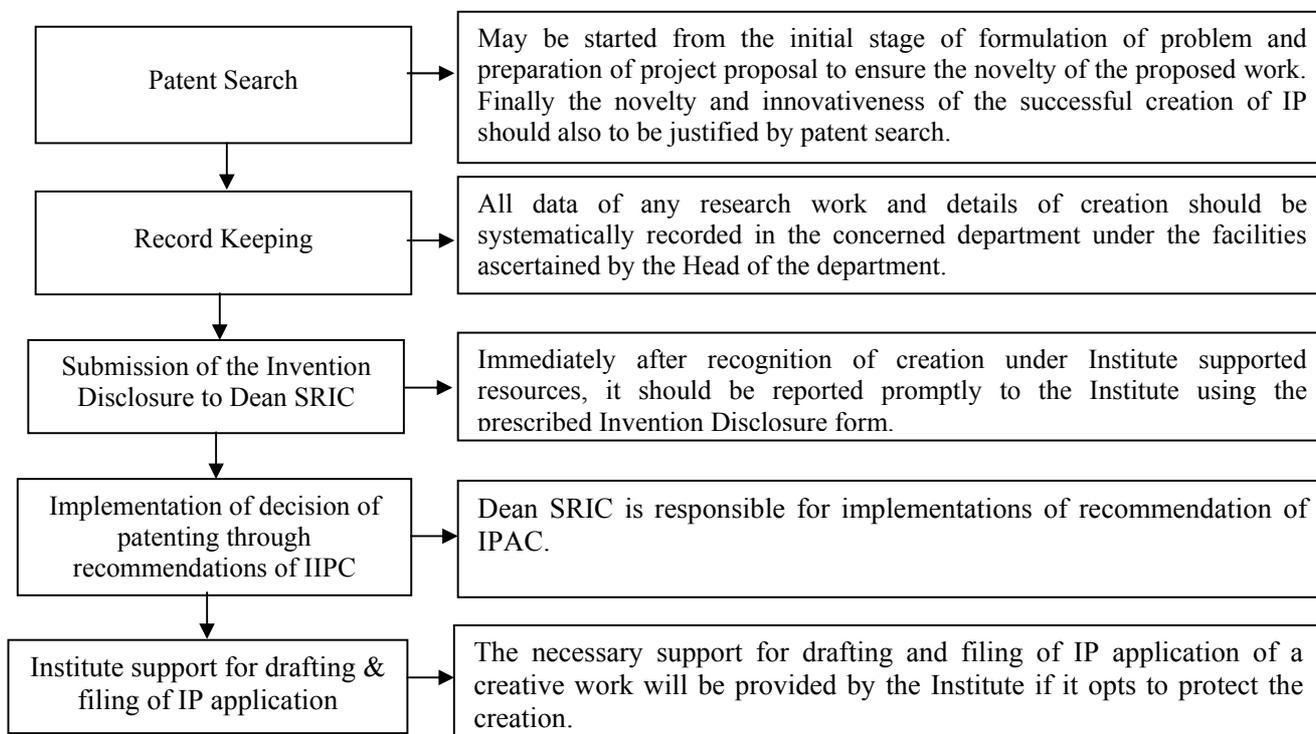
2. PROCESS FROM RESEARCH RESULT TO EXPLOITATION OF IP

- i. The IPR policy of the Institute covers all rights arising from intellectual property devised, created, or made by the staff in the course of their employment by the Institute, irrespective of the eligibility of these rights for registration. The IP arising from academic research includes patents, designs, trademarks, service marks, copyright, know-how and undisclosed information.
- ii. When the creators believe that they have generated patent-able or commercialise-able intellectual property using Institute-supported resources, they reports it promptly in writing along with relevant documents, data and information, to the Institute through the appropriate authority using the Invention Disclosure Form of the Institute.

- iii. The Dean, (Sponsored Research and Industrial Consultancy) (SRIC) forms an IP Assessment Committee (IPAC) consisting of a chairperson, IPR Coordinator, and at least three additional faculty members with domain expertise or familiarity/experience in areas related to the creative work. The creator(s) is free to suggest names of faculty who are qualified to evaluate the creative work and who may be invited by the Dean, SRIC to be a part of the IPAC.
- iv. Institute holds the right to consult on a confidential basis with appropriate experts in the field of IPR in question, in order to assist in the assessment of innovation and its commercial potential in India and abroad.
- v. The IPAC assesses the disclosure in a timely manner and makes recommendations to the Dean, SRIC about the patentability of the invention.
- vi. If the Institute opts to protect the creative work, it provides an IPR Advisor/Patent Attorney for drafting the IP application as appropriate. The Institute pays for access to the relevant IP information databases and other associated costs.
- vii. The inventor(s) conducts IP searches, study the present state of art and provide the necessary inputs to assist in the drafting of the IP application. The Institute bears all costs of drafting and filing an Indian IP application.
- viii. If the Institute/creator chooses to file IP applications in other countries, then it shall bear the cost of application and other associated costs. The Institute feel free to enter into agreements with overseas institutions for protection and licensing of the IP.
- ix. If the IPAC recommends that the Institute shall not take the responsibility of protection of the IP, in that 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 his / her (their) own.

3. STEPS AND RESPONSIBILITIES (E.G. WORK FLOW) OF IP DISCLOSURE PROCESS

The procedure of IP creation follows the guidelines laid down in the IPR policy document of the Institute. Some



basic features of this process in steps are as follows.

4. INSTITUTIONAL RULES ON OWNERSHIP OF IP, REVENUE SHARING

Any revenue generated by the exploitation of IPR, is shared between the creator/inventor, his or her faculty or department/centre and the Institute after deduction of agreed costs borne by the Institute on the prescribed terms and conditions. Sharing of the net earnings generated from the commercialisation of Institute-owned intellectual property is made as per guideline laid down in the IP Policy document of the Institute.

5. WHAT ARE THE MOST FREQUENTLY EMPLOYED WAYS OF COMMERCIALIZATION OF IP

The Institute strives 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.

The Institute may contract the IP to Technology Management Agencies (Government/Private), for its commercialization.

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 the Institute is not able to commercialise the IP in a reasonable time frame, then it may reassign the rights of the IP to the creator(s) of the IP. Alternatively, if the Institute has not been able to commercialise the creative work in a reasonable time frame, the creator(s) may approach the Dean, SRIC for the assignment of rights of the invention(s) to them.

6. HOW DO YOU MANAGE IP ISSUES IN COLLABORATIVE RESEARCH PROJECTS? DO YOU APPLY A SPECIFIC STRATEGY (CONFIDENTIAL AGREEMENTS ETC.)

All Institute personnel and non-Institute personnel associated with any activity of the Institute treat all IP related information which has been disclosed to the IPR Cell and/or whose rights are assigned to the Institute, or whose rights rest with the Institute personnel, as confidential. Such confidentiality is maintained till such date as is 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. Having filled the Disclosure Form, the creator maintains confidentiality, until the Institute has assessed the possibility of commercialisation of the intellectual property.

Subject to the right of academic freedom the Institute staff not directly, except in the proper course of their duties, either during or after a period of their appointment, disclose to any third party or use for their own purposes or benefit or the purposes of any third party, any confidential information about the business of the Institute unless that information is public knowledge or he/she is required by law to disclose it.

The following guidelines are followed when dealing with confidential information in the context of third parties such as commercial organizations:

- i. The amount of information given to prospective licensees before the signing of any confidentiality or secrecy agreement is in no case exceed or fall outside that which is set out in the Technology Profile Form for any particular intellectual property.
- ii. When a third party is interested in commercialising an item of intellectual property on offer after inspecting the relevant Technology Profile, they may apply on the prescribed form and with the deposition of the required fee for transfer of the technology. The Institute is then require the third party to sign contractual confidentiality or secrecy agreements undertaking to maintain the confidentiality of all information disclosed, before any further disclosure is made.
- iii. Third parties must obtain express authorization writing from the Institute to commercialise/exploit the intellectual property. Confidentiality agreements continue in force even if the commercialisation process is aborted at any stage. However, it is recommended that no disclosure should be made if there is any doubt as to the outcome of the commercialisation process.
- iv. If running royalties are to accrue to the Institute and the creator, the licensees must be bound by their contract to take adequate measures to protect that matter from becoming known to others through the licensee's practice, and thereby made available to others whose activities may adversely affect royalty returns.
- v. Access to areas where Institute-owned intellectual property including confidential information is made available, seen or used, and to confidential documents, records, etc. is limited only to those who are creators or are bound by confidentiality agreements.
- vi. Creators and/ or Institute personnel takes care not to disclose confidential details of Institute-owned intellectual property in their publications, speeches, or other communications.

7. WHAT ARE THE MAIN PROBLEMS ARISING FROM COLLABORATIVE RESEARCH PROJECT

Few issues in this regard are presented below :

1. Conflicts with respect to IP ownership and its commercialisation due to difference in perception on IP issues.
2. Delays in decision making with respect to IP ownership.