

POLICY ON
INTELLECTUAL PROPERTY

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PART I. INTRODUCTION

1.1 General Statement

- (a) The aim of the University in conducting research is the pursuit of knowledge for enriching the minds and lives of staff and students, and for the benefit of society as a whole.
- (b) The University depends upon financial support primarily from the government and other organisations for its research activities. Consistent with this premise, the University seeks to ensure that any resultant intellectual property is administered in the public interest.
- (c) As IP issues can be fairly complex and there cannot be rules to address every single possible situation, the IP Policy seeks to provide guidelines that can be applied consistently to arrive at a position that is as equitable as possible to all parties concerned.
- (d) The main objective of the IP Policy is above all to facilitate the transfer of technology from the University to industry in order that research conducted at the University results in applications that benefit the public.

1.2 Definitions

In this IP Policy, the following expressions shall have the following meanings:

“Confidential Information” means any IP, information or data, including all oral and visual information or data, and all information or data recorded in writing or in any other medium or by any other method, which is confidential or proprietary to the University or a University-related company or which the University or the University-related company is under an obligation, whether contractual or otherwise, not to divulge.

“Intellectual Property” or **“IP”** means any patentable invention, Know-How, copyright, design, layout design of integrated circuits, Tangible Research Property, rights relating to computer software, trade mark and any other industrial or intellectual property rights, registrable, registered or otherwise.

“Inventor” means (a) for a patentable work, the Staff Member or Student who is considered the legal inventor of the work under patent law, generally a person who is the actual deviser of the invention or who has made an intellectual contribution to the conception of the invention; and (b) for a copyrightable work or an unpatentable invention, the Staff Member or Student who is the author of or has created the work or who has made substantial creative contributions to the unpatentable invention.

“IP Policy” means the University’s “Policy on Intellectual Property” as amended from time to time.

“Know-how” means any methods, techniques, processes, discoveries, inventions, innovations, unpatentable processes, specifications, recipes, formulae, designs, plans, documentation, drawings, data and other technical information and identified or identifiable in a tangible form.

“**Staff Member**” shall mean all University employees, including all faculty, administrative and research staff, whether part-time or full-time, and shall also include visiting and adjunct staff members and other researchers carrying out research at the University, unless the University specifies other arrangements in such person’s letter of appointment with the University.

“**Student**” shall mean all matriculated undergraduate and graduate students at the University, whether part-time or full-time.

“**Tangible Research Property**” shall mean research results that are in a tangible form and that include items such as materials, drawings, integrated circuit chips, computer software, computer and other databases, processes, prototypes and circuit diagrams.

“**University Unit**” shall mean an institute, college, school, centre, department or office under the University.

“**Works**” shall mean books, manuscripts, educational course materials and academic papers.

1.3 Administration

- (a) The University has appointed NTUitive Pte Ltd (“**NTUitive**”), a subsidiary company of the University as the commercialisation arm for the University.
- (b) NTUitive shall be responsible for the following:
 - (i) administering the IP Policy;
 - (ii) evaluating and commercialising University IP;
 - (iii) managing the University’s patent portfolio and the drafting, filing and prosecution of patent applications and the maintenance of granted patents;
 - (iv) negotiating and signing commercialisation agreements for University IP; and
 - (v) distributing any revenue from commercialisation of IP in accordance with Part 3.3 below.

PART 2. INTELLECTUAL PROPERTY OWNERSHIP
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2.1 IP Ownership by the University

- (a) With the exception of rights to Copyright of Works which are dealt with under Part 2.2 below, rights in IP made or created by Staff Members and Students are owned by the University when any of the following applies:
 - (i) The IP was developed in the course of or pursuant to University Research, as defined further in Part 2.1 (b) below;
 - (ii) The IP was developed with substantial use of University’s resources, as defined further in Part 2.1 (c) below.

- (b) University Research includes:
- (i) in the case of a Staff Member, all research conducted in the course of the employment of the Staff Member with the University as part of his duties or in fulfilment of his contract of employment;
 - (ii) in the case of Students, all research for which the Student receives financial support in the form of wages, allowances, salary, stipend or grant from funds administered by or through the University; and
 - (iii) all research conducted pursuant to a research grant or agreement between the University and an external party, subject to the terms on IP ownership set out in the relevant research grant or agreement.
- (c) The following shall be deemed to be substantial use of University's resources:
- (i) Where University funds are used to specifically support the development of the IP;
 - (ii) Where there has been use of resources at the University that are not ordinarily available to most Staff Members or Student. The use of office, library, computers and storage servers constitutes resources that are ordinarily available to Staff Members and Students and do not constitute substantial use of University's resources.
- (d) The University shall be entitled to approach, negotiate and enter into any binding IP agreement with any third party on such terms and conditions as the University, being the legal and beneficial owner of such IP, shall in its sole and absolute discretion deem fit.
- (e) The University shall be entitled to assign rights or grant licenses, whether exclusive or not, in respect of the IP for such periods as it shall deem fit, or make such other arrangements relating to such IP as it may deem appropriate in order to facilitate technology transfer or research collaborations while protecting the rights of the University and the Inventors.

2.2 Copyright of Works

- (a) Copyright ownership of Works by Staff Members or Students shall vest in the Inventor subject to Part 2.2 (b) below, except under the following circumstances where ownership shall vest in the University:
- (i) If the Work is created in the course of or pursuant to a grant or agreement between the University and an external party, copyright ownership is subject to the terms on IP ownership set out in the relevant grant or agreement; or
 - (ii) If the Work is created by a non-faculty Staff Member or Student in the course of his or her employment with the University; or
 - (iii) If the Work is commissioned by the University or is created at the direction of the University for a specific University purpose; or
 - (iv) If the Work is created using funds provided by or through the University for such purpose.

- (b) The University shall have the right to use, publish, reproduce or distribute such Works worldwide, including translations of such Works, in whole or in part and in whatever form, electronic or otherwise, in relation to its teaching, research, academic purposes or for the advancement of knowledge.
- (c) Copyright with respect to software is dealt with as per other IP rights under Part 2.1 above.
- (d) If there is an intention by a University Unit to compile certain course materials for further distribution and sale, it is advisable that the University Unit obtain an assignment of the copyright from each Inventor beforehand.

2.3 Student Thesis

- (a) A Student shall own the copyright of his or her thesis subject to any commitments under any grant or agreement with external parties. The Student shall grant to the University a royalty-free permission to use, publish, reproduce or distribute the thesis worldwide, in whole or in part and in whatever form, electronic or otherwise.
- (b) If a thesis contains information on an invention that may be patentable, the thesis may be required to be withheld in accordance with the University procedures for withholding of thesis.

2.4 Outside Consultants and Independent Contractors

Persons who are non-University employees but contracted to perform certain work (such as outside consultants and independent contractors) could own the IP of any works created by them. It will be essential to have in place a written agreement with such persons to provide for ownership by the University of any IP created under the contract if the University does require ownership of the IP. Assistance on such agreements can be obtained from NTUitive.

2.5 Staff Member- or Student-owned IP

- (a) All IP developed by Staff Members or Students which are neither connected to University Research nor developed with substantial use of University's resources, shall belong to such Staff Members or Students as Inventors.
- (b) However, prior to any patent filings or commercialisation by a Staff Member in respect of IP under Part 2.5(a) above, the Staff Member shall make full and frank disclosure to NTUitive for clearance by submitting a Declaration of Mandatory Disclosure to NTUitive in accordance with the procedures for such disclosures as set by NTUitive.

PART 3. DISCLOSURE, EVALUATION AND COMMERCIALISATION OF UNIVERSITY IP

3.1 IP Disclosure and Evaluation Process

- (a) If an Inventor has developed any IP the ownership of which is vested in the University under Part 2, or pursuant to any obligation to disclose such IP under any agreement the University may have with an external party, the Inventor(s) must promptly disclose the full details of the IP to NTUitive by submitting a Technology Disclosure Form in accordance with NTUitive's technology disclosure process.
- (b) NTUitive will normally seek patent protection in order to pursue commercialisation of the invention. NTUitive will not seek patent protection for inventions that are not commercially attractive, even though the invention may be scientifically meritorious.
- (c) The Inventor(s) shall at all times maintain confidential the details of the invention in accordance with the Confidentiality policy set out in Part 5.1 below, in particular during the period when NTUitive is assessing the viability of commercialisation and/or patenting the invention. Any publication (even verbal disclosure) which describes an invention prior to filing for a patent may jeopardise the patenting process.
- (d) All Inventors shall disclose to NTUitive the identity of any party interested in the commercial exploitation of the IP in sufficient detail and as soon as practicable after the relevant facts have come to their knowledge. All Inventors are also required to disclose any conflict of interest as set out in Part 5.2 below.

3.2 Commercialisation and Protection of University IP

- (a) NTUitive shall be entitled to assign rights or grant licenses, whether exclusive or not, in respect of University IP for such periods as it shall deem fit, or make such other arrangements relating to such IP as it may deem appropriate in order to facilitate technology transfer while protecting the rights of the University and the Inventors.
- (b) NTUitive may use any means whatsoever, as it shall in its sole and absolute discretion deem fit, to protect any IP under its management, including but not limited to instituting proceedings concerning patent and licence infringements
- (c) The support and cooperation of the Inventors are usually critical for successful commercialisation. The Inventor(s) shall provide all information and render all assistance to NTUitive in all phases of the patent application and/or commercial exploitation of the Invention as NTUitive may from time to time require, including but not limited to, assessment of the IP, making amendments to the specification and claims of the patent applications, negotiations with third parties for the licensing of the IP, and any proceedings concerning patent and licence infringements.

3.3 Distribution of Commercialisation Revenue

- (a) Subject to any agreement with a third party such as a joint owner or grant agency, NTUitive shall distribute to the University and the Inventor(s) of the IP any Commercialisation Revenue [as defined in Part 3.3 (b) below] received by NTUitive in the following ratio:

University (50%): Inventor(s) (50%)

- (b) Commercialisation Revenue is defined as the gross revenue received by NTUitive from the commercialisation of the IP (including all royalties, fees and other benefits). NTUitive shall be entitled to deduct up to 20% of gross revenue before each distribution of Commercialisation Revenue under Part 3.3(a) above to reimburse NTUitive for its out-of-pocket expenses incurred for the protection and commercialisation of the IP until such time as all such out-of-pocket expenses have been reimbursed from gross revenue.
- (c) If NTUitive receives shares in a company in exchange for a license or assignment of the IP to the company, the shares NTUitive obtains shall be held by NTUitive and the proceeds from the liquidation of the shares shall be distributed to the Inventors according to the same ratio as set out in Part 3.3 (a). An Inventor may also request to hold his/her portion of the shares in his/her own name, in which case such Inventor shall no longer be entitled to any proceeds from the liquidation of the remaining shares by NTUitive.
- (d) The Inventors' share of Commercialisation Revenue under Part 3.3 (a) shall be distributed equally amongst any joint Inventors unless NTUitive has been previously notified in writing of any different sharing arrangement agreed upon between the joint Inventors.
- (e) It is the responsibility and obligation of each Inventor to keep NTUitive updated of his/her current contact number and address in order for NTUitive to distribute his/her share of the Commercialisation Revenue.
- (f) The University's share of the Commercialisation Revenue shall be distributed as follows:

University Unit (50%) : Royalty Account under NTUitive (50%)

Where there are multiple Inventors from different University Units, the University unit's share of Commercialisation Revenue shall be distributed amongst the University Units in accordance with the number of Inventors from each University Unit.

- (g) NTUitive shall distribute to the Inventor(s) the proportion of the Commercialisation Revenue due to them in such manner and at such times NTUitive shall, in its sole and absolute discretion, deem fit. For the avoidance of doubt, NTUitive shall not be liable to pay interest for any deferred or late payment of the proportion of the Commercialisation Revenue due to the Inventor(s).

3.4 Return of IP to Inventor(s)

- (a) The Inventor(s) may request in writing to NTUitive for the return of the IP for commercial exploitation by the Inventor(s) in accordance with NTUitive's process for the return of IP.

NTUitive shall have the discretion to decide whether such IP should be returned to the Inventor(s).

- (b) Where NTUitive returns the IP to Inventor(s) under Part 3.4 (a) above, the Inventor(s) shall sign an agreement with NTUitive which shall include the following terms and conditions for the return of the IP:
 - (i) The Inventor(s) shall be entitled to file for patent rights in their own name and at their own expense.

- (ii) The Inventor(s) shall account to NTUitive 15% of any commercialisation revenue received by the Inventor(s) from the commercial exploitation of the IP, including 15% of any proceeds from the liquidation of equity or shares that the Inventor(s) may have received in consideration for the license or assignment of the IP to a third party. The Inventor(s) may deduct any actual and out-of-pocket patent and legal expenses that the Inventors have incurred for the commercialisation of the IP prior to accounting to the University its share of the commercialisation revenue.
 - (iii) The Inventors shall submit to NTUitive an annual report on the status of (A) any patent applications filed in connection with the IP; and (B) any commercialisation of the IP.
 - (iv) NTUitive may, but is not obligated to, request for the IP to be returned back to NTUitive if the Inventors fail to commercialise the IP after 3 years from the date the IP is returned to the Inventors.
- (c) The 15% of commercialisation revenue accounted to NTUitive by the Inventors under Part 3.4 (b) (ii) above shall be distributed as per Part 3.3 (f) above.

PART 4. IP OWNERSHIP UNDER RESEARCH COLLABORATIONS WITH EXTERNAL PARTIES

4.1 General Statements

- (a) The University undertakes many research collaborations with external parties, such as other universities, research institutions, government agencies and industry.
- (b) General guidelines are required to ensure that the University's interests are not compromised and also for consistency and uniformity in the University's dealings with external parties.

4.2 Research Collaborations with Non-Commercial Parties

- (a) Non-commercial parties include other universities, research institutions and government agencies.
- (b) In a collaboration with a non-commercial party, IP will generally be jointly owned where both parties have jointly developed the project IP (i.e. where employees/students of both parties are involved in creating, developing or generating the IP). Usually the parties will have the right to jointly commercialise the jointly-owned IP.
- (c) Where the IP is solely developed by the University, the University will retain the ownership of the IP but the non-commercial party will have free internal use of the project IP. Any commercial use of the project IP by the non-commercial party can be negotiated.

4.3 Research Collaborations with Industry

- (a) Collaborations with industry are encouraged as interaction with industry ensures that research at the University remains relevant and they also provide exposure to students to possible future employers. Companies will also benefit as they obtain access to the University's expertise, facilities and resources not otherwise available elsewhere.

- (b) The guidelines below lay down the factors that are taken into consideration in determining the IP terms in order to provide consistency in decision-making. The guidelines also recognise the different types of projects that can be undertaken with industry, which can range from exploratory research (where the application is not known), technology development (where the application is known) to product design and problem solving. The guidelines also provide for recognition of the University's contributions in the form of license fees payable by the Company as the Company obtains commercial benefits from IP generated with the help of the University.
- (c) The following guidelines on IP ownership and commercial use and licensing of project IP will apply to all research projects with industry:
- (i) Sole Ownership of IP by the University
- (A) This will be the default position taken for all research collaborations with industry unless the scope of the project and the contributions by the Company can be shown to fall under (ii) or (iii) below.
- (B) The Company will have a first right to negotiate a fee-based license for the commercial exploitation of the project IP.
- (ii) Joint Ownership of IP by the University and the Company
- (A) The University will consider joint ownership where the Company will be contributing background IP to the project or will have intellectual contribution to the project IP, that is, employees of the Company are also involved in creating or generating the IP together with the University. The Company must also be providing cash funding for a significant portion of the total project costs.
- (B) The Company will have a first right to negotiate a fee-based license for the exclusive commercial exploitation of the jointly-owned IP.
- (iii) Sole Ownership of IP by the Company
- (A) The University will consider this position only on a case-by-case basis.
- (B) The project must meet the following criteria:
- The project is focused mainly on product development or improvements to the Company's existing products or services and only the Company's background IP is involved;
 - The project has unambiguous known objectives and the Company lays down a defined way of performing the study;
 - The University's existing IP is not involved as the Company requires mainly access to the expertise and know-how of the University's staff members;
 - The University must benefit from the project and acquiring relevant industry experience through the exposure provided by working with the Company.
- (C) The Company will be required to bear the full project cost, which includes full University manpower and facilities/equipment costing.

- (D) The University may reserve ownership of or rights to any project IP generated in fields of application outside of a specified Company field and in such cases the University will be free to exploit the IP in such fields of application.

PART 5. GENERAL OBLIGATIONS

5.1 Confidentiality

- (a) All Staff Members and Students shall at all times maintain confidential all Confidential Information, whether made/developed on his/her own, in collaboration with University colleagues, or acquired through discussions (whether formal or informal) with University colleagues or external parties.
- (b) The above confidentiality obligations shall not apply in any of the following circumstances:
- (i) where disclosure is required by law or any government agency;
 - (ii) where the information is in the public domain or becomes generally available to the public; or
 - (iii) where disclosure is made with the prior consent of the University.

5.2 Disclosure of Conflicts of Interest

- (a) All Inventors who have any interest, whether directly or indirectly, in any party interested in the commercial exploitation of University IP, shall make full and frank disclosure of the nature and extent of their interest to NTUitive, as soon as practicable and to the best of their knowledge. Without prejudice to the generality of the foregoing, an Inventor shall be deemed to have an interest if he/she (or a person over whom he/she has control) is a director of, or a shareholder with a material shareholding in the organisation or company interested in the commercial exploitation of the University IP.
- (b) Failure to declare his/her interest in the commercial exploitation of the University IP and/or to seek approval from NTUitive as required in Part 5.2 (a) above shall subject the Staff Member liable to disciplinary or other actions which the University shall, in its sole and absolute discretion, impose.

PART 6. OTHERS

6.1 Consultancies

- (a) Consulting is a private arrangement between the company and the individual Staff Member, who has to abide by the rules set out under the "Scheme for Faculty to Undertake External Consultation and Specialist Work (Including Non-Executive Company Directorship)", the Research Staff Handbook and any other requirements that may be imposed by the University in granting its permission to the Staff Member to engage in consultation.
- (b) The individual Staff Member shall ascertain that such consulting work does not commit to the disclosure or transfer to the company of any IP belonging to the University. The individual Staff Member shall also ensure that a separate agreement is entered into with the appropriate University Unit if he will be utilising any University facilities, equipment or resources for such consulting work.

- (c) In any consulting service, the individual Staff Member shall not breach the confidentiality obligations to which he/she is subject by virtue of being an employee of the University. The Staff Member shall not be entitled to disclose to the company to which he/she provides consulting services, any Confidential Information which relate to University IP or any research which is being carried out at the University.

6.2 Directorship of Companies (Including University Spin-Off Companies)

Subject to the conditions as laid down in “Scheme for Faculty to Undertake External Consultation and Specialist Work (Including Non-Executive Company Directorship”, faculty Staff Members may be given approval to accept appointment to non-executive directorships in companies, including companies to be formed, that will commercialise their inventions.

PART 7. GENERAL

7.1 Waiver of Policy

The University shall have the discretion to waive or vary any or all of the provisions of these rules in a particular case. A waiver on one occasion and for a particular case shall not be deemed to be a waiver or variation of the same or any other provision on a future occasion or for a future case.

7.2 Settlement of Disputes

Any dispute with respect to the interpretation of this IP Policy shall first be referred to the CEO (Innovation) for resolution. If the matter cannot be resolved by the CEO (Innovation), such matter shall be referred to the President for his decision, which will be final and conclusive.

7.3 Commencement and Application of IP Policy

This Policy is effective from 1st April 2014 and for the avoidance of doubt shall be applicable to all University IP commercialised after the effective date. The rules set out in the IP Policy are subject to the terms of any agreement with external parties that the University may enter into.

7.4 Amendments to the IP Policy

The IP Policy may be amended by the University from time to time. The University shall undertake to notify Staff Members and Students as soon as is practicable of the amendments so made. In any case, the amendments shall be in full force and effect on the date the amendments have been announced by the University to take effect.

PART 8. RESPONSIBLE PARTIES AND CONTACT INFORMATION
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Policy Owner: Dr Lim Jui, CEO (NTU Innovation)

Responsible Office: NTUitive

For clarification on this policy, please contact:

Name	Designation	Email
Ms Christina Gee	DD (IP Management)	christinagee@ntuitive.sg