

IP Management and Technology Transfer
Prof. Gouri Gargate
Rajiv Gandhi School of Intellectual Property Law
Indian Institute of Technology, Kharagpur

Lecture - 26
IP Policy

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A very warm welcome in module 1 of week 4 of the course, Intellectual Property Management and Technology Transfer titled IP Policy. Now, in what we have seen? In week 2 we have just taken a look related to intellectual property management system. Then in week 3, we have seen how the IPMS; that is, the intellectual property management system models can be applied to develop the IP system.

Now, in that model in one of the model, we have seen that there are 15 IPM related major processes. And in that the first process we have mentioned there is a IP policy and then there is a security system contracts and all other things are there. So, we will just focus on one of that 15 processes that is the IP policy here. So, that you can get idea how the IP policy of organization or a start up or industrial organization is drafted and what are the issues, which probably we can handle in the IP policy.

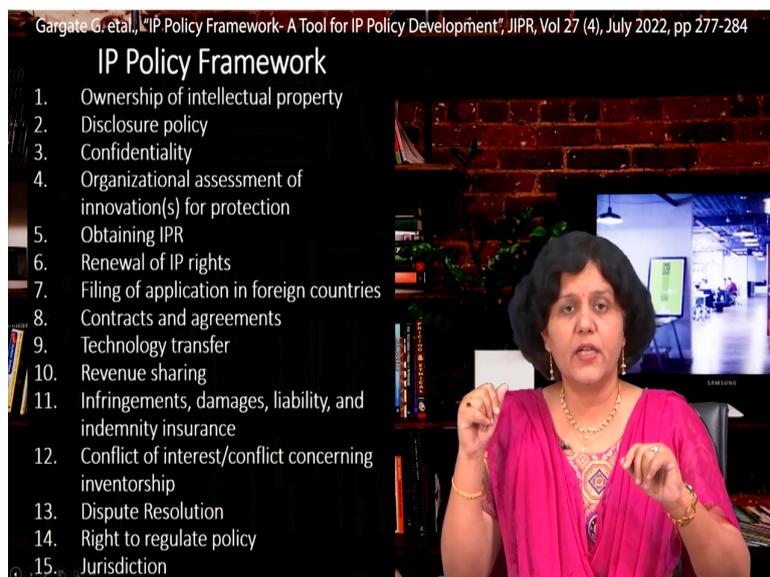
Now, just before starting we know what is policy. So, generally policy is a document which helps help us to give the guidelines regarding if any particular situation is there, how it should be handled, that guidelines are there. So, for example, suppose you are doing a technology transfer, then what probable issues may arise in that technology transfer.

Or if you are creating IP that who will own the IP, whether faculty will own the IP, whether student will own the IP or whether the any other person the trustee or something is there and they will own the IP, who is the owner of that IP? So, that questions are answered in the IP policy sothat there is a clarity regarding this particular aspects.

So, now in this session, we will focus on more or less the policy which is related to the academic institutes, ok. So, and then we can modify that means, if you are a start up, you just take that points and try to modify it for your start up. If industrial organization is there probably, I will say that this will be the all together a different IP policy actually. Because the structure, the objective, the strategies are totally different when we are talking about the business or the big empires or a industrial organization.

But probably I can say that the few points which are discussed here will be helpful to draft the policy for start up, MSMEs or any small setup, ok. So, let us start actually and we can just change means for example, when we will go pointwise, we will see that what probable the differentiation or difference points we have to consider related to that particular aspect and probably considering that we can modify customize this policy according to our name. So, let us start now. So, now let us go into details of the IP policy.

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So, when we deal with this IP policy framework you can look this IP policy framework, as a tool as a kind of a guideline it will help you like a guiding star to develop your IP policy. So, here you can see a some points, which are or aspects which are taken into consideration, then we will develop the policy framework.

There are so many documents available, so many policy documents are also available, so probably you might have gone through that policy documents. But if not, you just check this a few points probably this will help you easily draft the IP policy. Now, what will happen that if faculty members are there, then they will say that yes, definitely it will be useful to us to consider or develop our IP policy.

But if you are a student, you will say how this IP policy is helpful to me, I am not going to draft that particular thing. So, what is the benefit of learning this IP policy framework for me

actually? So, the point here we have to remember as a student we are a stakeholder of that particular academic institute. And now whenever you are developing your IP, especially when you are doing a project activity it is expected that you are developing some IP. And at that time, you should know that who is the owner of that IP?

What are the different types of IPs you are creating in the academic institute? Who will own the rights for that particular thing? If you leave the academic institute what will be the scenario? So, all such questions will be answered in policy and therefore, definitely this will be useful to you as a student also, ok.

Now, you can see here that 15 points are there. So, see here that 1st point is like ownership of an intellectual property, then you can say check here that there is a disclosure policy, then there is a confidentiality, the next there is a 4 point is organizational assessment of innovation for IP protection. Next is obtaining IPR, so how the decisions are taking related that we will go into details of each of this.

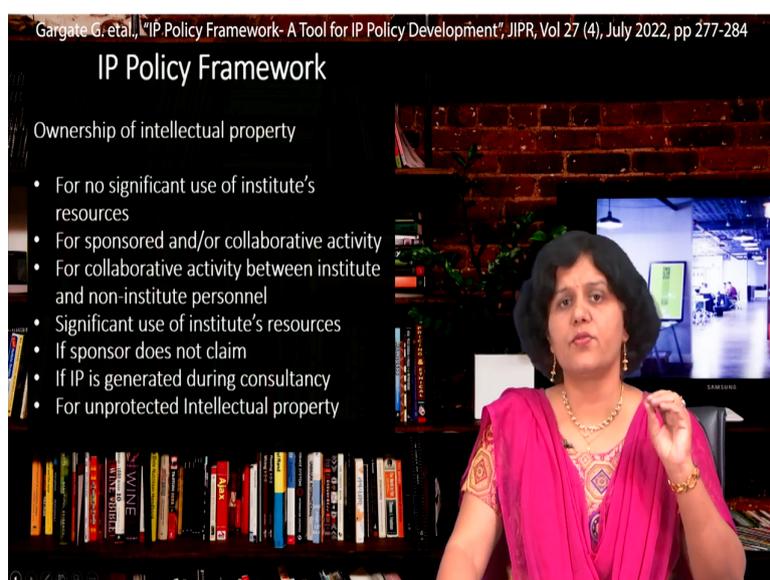
Next is related to renewal of IP rights, next filing of application in foreign countries because that is the very costly activity and therefore, we have to focus on that who will take care of the budget or a fund for that particular thing. And how the ownership will be handled in such cases.

Contracts and agreements related to IP development and transfer and other related aspects, technology transfer, then revenue sharing is there, then you can check here the infringement, damages, liability and indemnity, insurance and other the this related causes which is a very standard in any IP; any policy actually I should say. Then there is a conflict of interest or conflict concerning the inventorship, how to handle that thing, dispute resolution all guidelines are there.

But in spite of that if there is any dispute, who or how you are going to handle that thing, that point is important, then you can see here there is a right to regulate the policy and the last point is a jurisdiction.

In any unfortunate event, which is the jurisdiction, where you can sort or seek that particular justice if you feel that yes, your rights are like a infringed or your rights are not taken care of that particular thing, where is the; what is the jurisdiction, ok. Because that is very important and this policy document should be very clearly note down that, what is the jurisdiction?

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So, let us focus on the first one that is the ownership of a intellectual property. Now, before going into details of that, let me know as a academic institute which are the different types of IPs you create? We have seen in one of the sessions earlier. So, the lecture preparation that lecture material whatever is created, then student notebook, question papers, video recordings right, then there is a manuals which are created, then lab notebooks are there.

So, so many things we are creating in academic institute, so many photographs, so much like the documentation whatever we are doing related to the may be our customers, vendors or

maybe your student list or the processes which are followed by the academic institute within institute what are the different processes we are following.

There are extracurricular activities and there at that we are creating so many different kinds of especially the copyright material we are creating, may be drama original drama, may be there original poetry. So, all this kind whatever are created. So, we have to identify first that what is the creation, which are the IPs which are created in our institute.

If suppose you are a MSME, you have to just check into consider take into consideration, your customer list, your probable the further idea inventories and all that thing again you are keeping it as a confidential. So, that is again your trade secret probably, then the technology which you are developing. So, you are developing the patents especially trademarks.

So, all this kind of IPs will be created, then how you are handling that thing, whether stuff is getting any right over that thing, then who is whether only the owner is getting the right, whatever it may be. You have to try to develop your guidelines for that particular thing because the employees which are there in the in your system, they should know that.

If you are a starter you have to be very very careful actually because what happens, I can just share the scenario so that you will appreciate that why in the start up it is important. That you feel that we are starting with only one patent or that two patents and we do not have that big portfolio and how does it matter and all that thing.

Please remember that what happened, that if you do not have IP policy, what happen that you put the name this happen because it is a very small setup, maybe 2, 3 founders are there and then the few employees like maybe 2, 3 employees are there. Now, only 6 or 7 people are working on that idea and you are trying your develop that, whatever the technology under consideration is that you are trying to develop that thing

Now, you are so friendly with each other during that setup, that you feel that no he is my friend or she is my friend. So, I should put his or her name as a as a applicant ok, in the patent document, ok. And there we make a mistake many times actually. So, I am I am saying this

because I have handled or I have come across such kind of a cases when I was doing the practice.

So, please remember be careful, do not get carried away with the emotions or the relationships in this particular scenario, make a policy documents which will be clear cut guideline for the your start up, although it is in a small scale Google started as a start up and it is a big giant and that one patent, which they have developed during their PhD studies page.

And brain in Stanford University when they have taken the whole rights Google whenever they have taken the whole right over that university received something millions of dollars actually.

So, you just remember that is a probability that your start up may grow like that scale and we never know. So, be careful when we are doing the giving the rights because and therefore, policy is very important. I guess you appreciate this particular thing, same thing with MSME same thing with academic institute we have to be very careful because you are giving the legal rights actually, applicant is having the right actually therefore, be careful, ok.

So, this ownership whenever we are talking there are different points actually, these are indicative in nature this is not exhaustive kind of a thing you can customizes, but these are the few points like, for no significant use of a institute resources. If I have already told you this is related to academic institute.

So, if institutes resources are not used, what will be the scenario? If sponsors and collaborative activities there, scenarios totally different. Because you have sign MOU with that collaborating organization or sponsor organization there probably you have mentioned, who will own the rights and you have already negotiated depending on your IP policy.

Next is for collaborative activity between institute and non-institute, personal because maybe some consultant is involved. So, how if that IP is created during that activity, who will own that particular IP significant use of institute resources, what is the scenario, if sponsors does not claim many times government when give the funding like MHR discipline funding or a

DST is giving funding, that government funding generally they do not claim the IP most of the times actually.

So, what is the scenario at that time? Then if IP is generated during the consultancy. So, if you if the there is a consultancy services which are provided and IP is created, how we are going to handle that thing and then the next one is a for unprotected intellectual property.

Because potential IP is always there, how exactly we are handling that further processes to convert that potential IP into the IP and further commercialization. So, these are the some points which are mentioned here, but depending on say MSME and all the scenario will be totally different, ok.

So, you can consider this points related to ownership these are indicative in nature, you can use it and you have to address these issues, what will be the issue. These are the issues how you are going to so given the solution. So, for example, the first point if we take, that for no significant use of institute resources. And in the leisure time faculty have developed something or a student have developed something.

So, leisure time it is not a working hours, beyond working hours the person who have not used any institute resources they have developed he or she has developed that particular invention whatever it may be, ok. Then at that time obviously, institute will not expect or it is not expected that institute will hold the right for that particular thing.

So, if no resources are used of the institute obviously, the applicant will be the person who have developed it using his or her own resources and obviously, not during working hours leisure time, ok. So, that points are very important or generally for sponsor or collaborative activities there, then generally that is a joint ownership is there.

So, such a way you have to just understand that particular the you have to handle this particular issues, ok. Let us move further and just check that the next point that is a disclosure

policy, that by students by the confidentiality assignments of rights and by a inventors actually.

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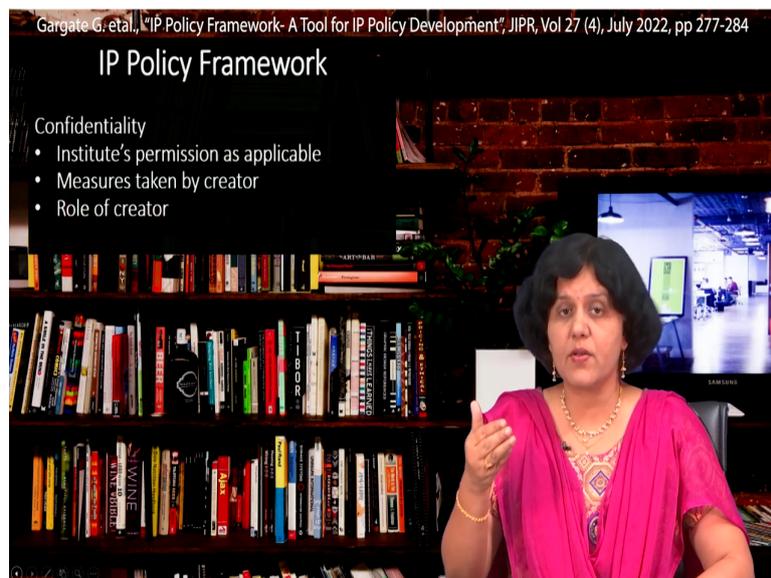
So, how exactly the process is to be followed, what is the procedure student should follow, what is the procedure faculty should follow, then what are the what is the administrative guidelines for that.

So, we have to give that little bit idea about that particular thing, about the in the policy document. That say for example, generally during the project work is going on or a student is doing a is PhD actually is going on that research work is going on. And especially the patent chances are there, when student is doing a his research scholar or he is a MTech student working on a project sign.

Pretty well time is like a generally means many times it is a luck factor accuracy within 6 months time also you can get some good outcome. So, it again depends. So, at a time how student should do that thing, you that that guideline must be there, that ok research scholar is there he should discuss with a guide and then they should they should submit the invention disclosure form, where exactly that is that is that details will be given in the other document.

But the point like a if such kind of thing happen, student mandatorily should disclose it and should have a discussion with the guide something like that. So, that points must be considered in the policy document. Let us move further and we will focus on the next point that is the confidentiality.

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Now, what happens that the confidentiality related to this IP development, at least before filing the IP is mandatory. Once IP is filed, we need not to worry about that particular thing.

Or many times what happens after filing also we do not want to disclose that particular thing. Especially for the next 18 months say for example, if patent is there we are expecting at least 18 months the confidentiality should be mentioned maintained actually.

Or many times what happen, some work is like so important and so much trade secret possible and at that time how the thesis will be handled, whether it will be made open to the public or it is not made to the open to the public what procedure should be followed. So, all these things are important actually.

Because student is spending his 5 years, 4 years for his work, faculties investing his time and if something very promising is coming obviously, institute should have some guidelines relative to maintaining that confidentiality aspect and that must be covered in the IP policy.

So, what are the majors creator should take obviously, that when they are taking a seminar giving the seminar, when they are doing the publications and all that thing, whether that awareness is created or not that another point is there. But the majors which whatever are there, probably the hints can be given into the policy document. Then what is the role of creator because sometimes inventor himself or faculty student himself or herself as a not aware about the IP related aspects actually.

Probably they only disclose the things in the public domain and how you can avoid that particular thing. So, that is a that is a another point of discussion, but some clue point something guidelines can be covered into the IP policy the policy framework related to that particular scenarios actually, ok.

Because you institute cannot take a responsibility, if inventor himself or herself have disclosed that particular thing into the public domain. So, that that particular that that kind of scenarios are there, that we have to handle it obviously, in the policy framework only. Next is like a related to the organizational assessment of innovations for the protection.

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Generally, in academic constitute they set up a review committee actually, but nowadays they that also is avoided to because many times there is I should not say that thing, but this issue is like a your colleague is your competitor in IP obviously, this is the kind of a scenario because and we have to accept that thing, right. And if that person is a review person probably you do not like that thing right or you may not feel safe in that particular scenario.

And so, generally this is this is the scenario and therefore, generally in academic institute it is avoided review and all that thing. If Indian patent is the generally the institute or a academic institute will take a decision to file the patent immediately. And nowadays so, many schemes are available for filing patent by MOE, innovation sale.

So, the filing fee is like if that that scheme is there and for availing obviously, that certain guidelines are there obviously, conditions are there. And therefore, IP filing is done actually and nowadays it is very smooth actually, ok.

So, no reviews there, but if it is a foreign filing. So, we will come to that point later in a few minutes, but when we are talking about this assessment actually, if I go for the industry there is a kind of a very very stringent assessment is there. And that guidelines or parameters are very clearly said because they want to develop, they want to commercialize that thing. It cannot they cannot take it as a burden for the organization.

So, the assessment is a very very you can say stringent, very different parameters are there and definitely that process is a like a long cumbersome process. Cumbersome in a sense it is not affecting inventor anyway, but the process which is followed is a very critical in a sense.

The caution is taken because you just imagine, if we miss the important invention, it is a big loss to organization. And if you do the wrong IP protection, it is a burden to the organization because we have to give a maintenance fee. So, both is not allowed and therefore, organizations take a very good care of that.

Considering MSME generally the portfolio is a manageable. So, assessment is generally directly means generally, market based actually the decisions are taken. And that idea is generally there to the owner because they are working in that domain for a longer time actually means they are expert in the domain and they are pretty well aware about the scenario. So, they have their own ideas, but obviously, documentation is necessary in the policy format, ok. I guess this much information is good enough for this point.

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Let us move further obtaining IPR. Now, for obtaining IPR you can have a, you should have the guidelines like many a times actually there are it is outsource activity, the law firms are doing that particular activity. So, related to that whatever points are there we can cover into under this point.

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Moving further renewal of IP rights. So, who will give the renewal fee and how the IP will be maintained, especially after grant of a patent that costing is there. So, that decision making is important. So, maybe academic institute should take a call that, when they have, they are going to do give the maintenance fee, whether they are sharing 50, 50 percent with inventor because some burden should be there.

So, that the commercialization possibility will be there. Because many times what happened that, if you do not have to give that maintenance fee. Probably we may we will just see that oh application is done, now my patent is filed on my bio data that application is there. I have I am getting the benefit for that particular thing. So, it is not good actually, in one sense that is my personal opinion.

So, maybe we can say that yes, the sharing of that maintenance fee if we can do. Probably inventor will look into the possibility of a commercialization and all. Because commercialization is important when we are creating IP, ok.

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Let us move further and we will focus on this foreign filing actually. It is again a very costly activity. So, this decision is generally we have to take very judiciously many times inventor especially shares the 50 percent cost with the institute that is a general idea. But it depends on the institute, but this is the scenario. PCT filing or foreign filing, if it is the 50 percent cost is like a shared actually with the inventor and the institute that is a scenario, ok.

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Next like next that is related to contracts and agreements. Now, somewhere in academic institute, we may be not so alert about this contracts and agreements actually. So, I will suggest that, we have to be very careful about this contracts and agreements. Because nowadays obviously, the awareness is good and problem arises when revenue generation starts still that everything is fine.

So, it is better to avoid that scenario before that only if we have a proper agreement proper contract, then probably that will save the time and energy and money whatever is required to handle that conflicts. So, therefore, if contracts and agreements it should be properly drafted and there should be the proper documentation of that particular thing.

Whatever the scenario it may be start up, MSME, industry whatever it may be these are the this is the most important point when we are talking about the contracts that that aspect

contracts and agreements. Let us move further and just check there is a technology transfer again.

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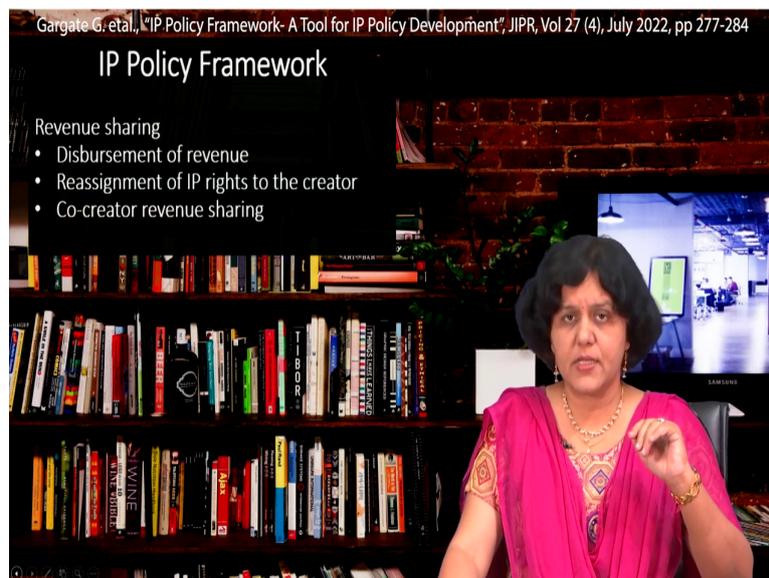


This is something a very challenging it is good to it is a very nice to say that do commercialization of IP and all that thing, but this is very challenging when we go for actual implementations. But there are so many entrepreneurial activities built around a patent in academic institute. So, if that is the scenario.

What will be the equity stake, what is what is the revenue sharing between academic institute and the inventor or to whom so ever, we are transferring the rights actually. So, that equity sharing and the revenue sharing all this will be covered in the technology transfer related aspect, ok.

And obviously, at that time we have to take care of who will give the maintenance fee and who will take care of a renewal if it is a trademark and all that thing. So, all these points are covered in the technology transfer aspect actually. Let us move further and we just focus on the revenue sharing.

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I have just given you idea just that yes, disbursement of revenue, reassignment of IP rights to the creator, how exactly it will be done. And the thing is like that once you have documented it very properly, academic institute generally they do the although you leave as a student means your student ship is over, you have left the institute still if you have given the proper address and everything obviously.

If something revenue generation will be there, you will get the revenue from the academic institute because it is a policy of the institute and obviously, there is a contract and

agreements and therefore, it is taken care actually properly, but that must be mentioned in the policy that how the revenue sharing is there, ok.

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Now, the next point is infringement damages liability, indemnity, insurance etcetera. Now, these are the very common points actually. So, if something like this happen infringement and if damages liability. Nowadays, if any important IP is there insurance is taken that that I am talking about IP insurance actually. Here that indemnity clauses we are talking about in this aspect the insurance actually.

So, whether institute is doing that particular thing if it is that is there then probably that point, we have to cover that to insurance how much amount will be or because of that probably how much if infringement happen is there any sharing between the handling that legal cost or if you have to do enforcement actually.

If your your your IP is infringed by somebody who will do the and because the enforcement itself is again the litigation and sending notices and all other thing who will take the sharing of that particular budget and all that thing. So, that also is required in the IP policy. Because probability is there that there is a chances that your IP is infringed by someone. So, that that points must be covered actually, ok. So, this is particularly about these points, let us move further dispute resolution.

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So, if any there is any dispute between inventors, between the that collaboration is there and two institutes are involved ok, and some unfortunately that disputerizes, how it should be handled. What is the arrangement in the organization? So, it should be like either the head of the institute will take care of is decision will be final or there will be the IP committee and the decision of that IP committee will be final.

So, that internally we can sort out any dispute which is arise. Because this these are there are many problems, there are the conflicts actually that between two faculty or between if two faculty are the inventors, then there are issues arise or student and faculty is there in between them the conflict is there.

So, how that internal conflicts can be handled, then that clauses should be that clauses and related to that the points must be covered into the policy document actually, ok. And if it is like two institutes or funding agencies, how that that particular thing handled all the probably you can cover these points here.

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Now, right to regulate the policy, that IPR policy may be reviewed every 3 years or earlier. Actually, I can just share with you that an industry, it is so dynamic IP policy like maybe today they will issue that ok, this amendment is made tomorrow also they can give the

another amendment. So, or every 15 days they will give or every 3 months they will do the updating that amendment. Sometimes if any case comes immediately that update is there.

So, it is so dynamic in industry actually in academic institute the observation is right. Once we make a policy then we are so relaxed, so now to 10 years I need not to see a towards that policy and we keep it as it is and all that, but that is not a good thing. Because in that 10 years actually, so many cases we come across so many issues we handled.

So, probably the good idea is not 3 years is also not a good idea actually, every year probably we have to handle the whatever the issues are faced in that year probably that can be addressed through the policy actually. And if any urgency or any major cases there probably you may require to do that within 6 months also, we never know. But it is a good idea to do the update of that particular thing and every version of that policy must be maintained properly.

And obviously, one more important thing, I just remember that we have to keep this IP policy on the website of the institute so that anybody can access that thing, not only the stakeholders of the institute, but outsiders also should get access to that particular thing it should be open document, anybody should able to easily access that particular thing. So, that there will be they can take the caution regarding that particular thing, ok.

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So, this is the regarding this point. And then the last point jurisdiction in any if unfortunate event happen and if it is not able to handle in the institute within the organization which will be the jurisdiction. So, generally whatever the address of institute is there, in that area whatever court means will come.

So, for example, if IIT Bombay is there, Bombay I means that court in Mumbai the court that jurisdiction will be there, if you are in a this Kharagpur probably Kolkata is a like high court is a jurisdiction. So, we have to give that jurisdiction very clearly into the policy document.

Address is very important and generally whatever that service address is there, that area whatever the court is there that is the jurisdiction. Generally, you may be a MSME, you may

be start up, so you have that address. So, accordingly your jurisdiction will be there, ok. So, this is the last point.

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And then now what we will do, its lot of information we have seen 15 points let us take a break and watch this video. Today we have with us Mr. Srivastav, he is a head of semiconductor integrated circuit layout design registry and he is in IPO Delhi, welcome sir.

Thank you.

So, today we are going to focus on semiconductor integrated circuit layout design and the provisions in the act. In the week 7 you have got idea, little bit idea only one session is dedicated for a semiconductor integrated circuit layout design. Now, here you will get a

detailed understanding about the practical aspects and how exactly that examination or registration of a semiconductor related the applications are there that is done.

So, I will request sir that just give a brief idea about say that act and the provisions so that we can get the idea overall kind of idea about that semiconductor integrated circuit layout design. Then we will go in the details of that particular thing.

Sure ma'am. So, to begin with I will just touch upon the history of semiconductor integrated layout circuit layout design and it dates back to 1989. In 1989 Washington Treaty was signed and later it was incorporated in tips. So, section 6 articles 35 to 38 they actually tell about production of integrated circuit topography or layout design.

In India in the year 2000, SICLD act was promulgated and associated rules were came into being in year 2001. To begin with semiconductor integrated circuit layout design is basically layout of transistors and other circuitry elements lead connecting wires etcetera, in a semiconductor integrated circuit expressed in any manner. So, basically, we can also call it topography.

A semiconductor integrated circuit is defined, as transistors and other sacred circuitry elements in a product and inseparably formed, in or inside semiconductor material or an insulating material and designed to function in a certain manner. So, in that sense, a semiconductor integrated circuit layout design the IPR is different from patents in the sense that it is a layout design that is being protected

And it is different from designs in the sense that it does not have any aesthetic appeal.

Exactly.

It is basically the function, the technical function that the layout design is performing and therefore, a new act.

Exactly so.

Came into being.

Right.

So, other differences are there for instance term of protection of semiconductor integrated circuit layout design is for 10 years. As opposed to 20 years for patents, 10 plus 5 years for designs.

Yes.

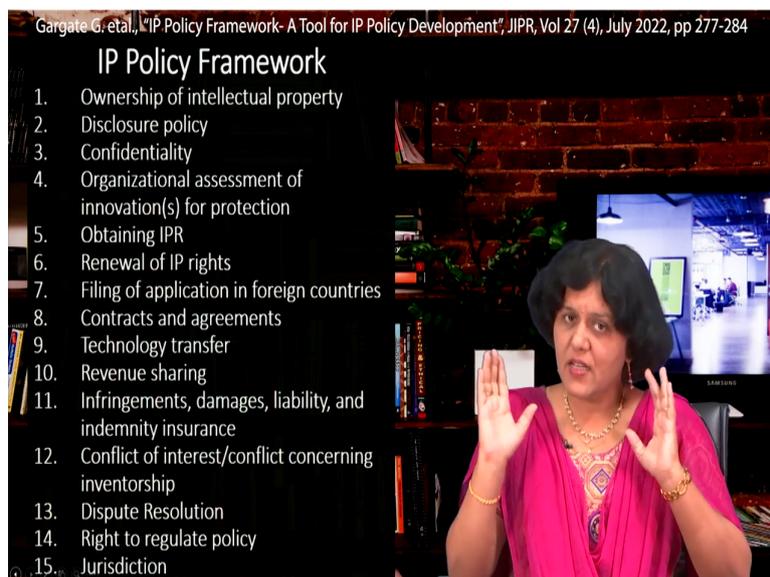
And another difference is that the creator of the layout design has the right to apply.

Yes.

For application.

Yes.

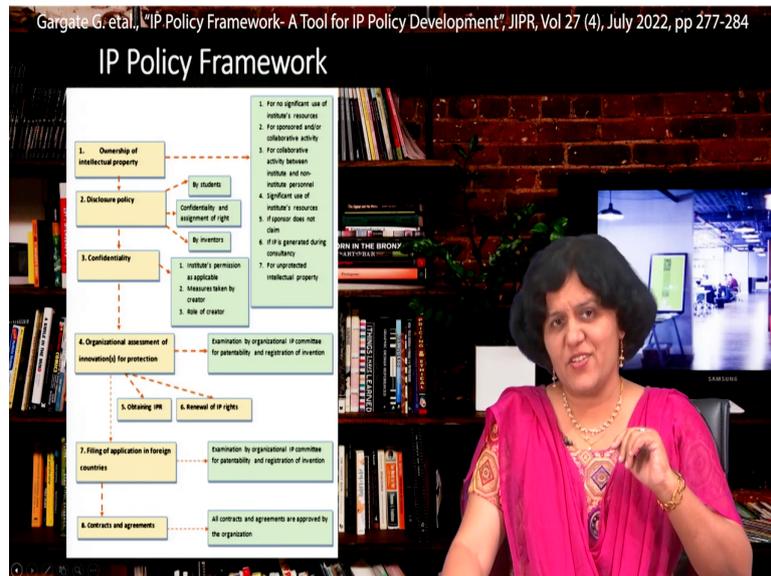
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Ok. So, let us summarize. So, the points which we have covered you can just see here, ownership, disclosure policy, confidentiality, organizational assessment of innovation, obtaining IPR, renewal of IP rights, filing of application in foreign countries, contracts and agreements, technology transfer, revenue sharing, infringement, damages, liability and indemnity insurance, conflict of interest or conflict concerning inventorship, dispute resolution, right to regulate policy and jurisdiction.

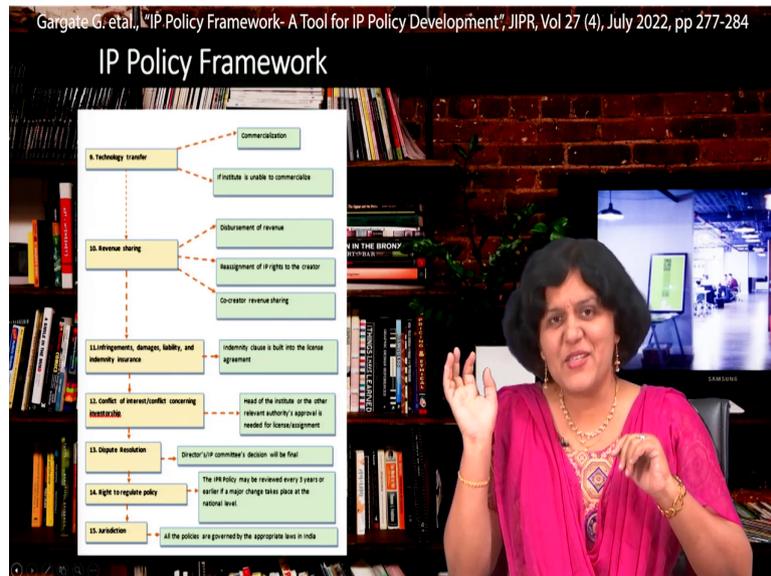
All these points are there indicative you can add that and make your policy very full proof. So, that we will not have to invest time on unfortunate or events or any conflicts actually.

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And now you can just see here, the framework actually and you just check that this points and we have to just add the points related to that particular head whatever that heading is there, ok. This is the first few points and then this is the next points actually, ok.

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So, you can just check here and let us move and now we have a quiz time ok, based on this.

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So, what would you what would you like to answer actually, ok. 15 points are there, I will just say that which point out of 15 you feel very important. Obviously, all 15 points are important, but which is the point which you feel that is very important according to you. Again, I have I repeat that all 15 points are important you have to add so many points into that, this is the points which we have shared is the just broad framework you can customize it.

So, just write two or three points which out of that 15 into the comment box which you feel that is very tricky, very means there they require a major attention. So, let us see which you feel is difficult to handle actually in the policy document, ok. So, please write down into the comment box.

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Gargate G. et al., "IP Policy Framework- A Tool for IP Policy Development", JIPR, Vol 27 (4), July 2022, pp 277-284

IP Policy Framework

References :

- <https://www.wipo.int/portal/en/index.html>
- <http://www.ipindia.nic.in/>
- <https://www.google.com/>



The image shows a woman with dark hair, wearing a pink sari, speaking in front of a bookshelf. The bookshelf is filled with books and has logos for Swayam and NPTEL. A screen in the background displays a presentation slide. The text on the slide includes the title 'IP Policy Framework', a reference to a paper by Gargate G. et al. in JIPR, and three URLs: https://www.wipo.int/portal/en/index.html, http://www.ipindia.nic.in/, and https://www.google.com/.

And let us conclude the session here; see you in the next session.

Thank you.