

NAIST Intellectual Property Policy

INTRODUCTION

NAIST's Mission and Its Commitment to Becoming a Pro-Patent University

The Nara Institute of Science and Technology (hereinafter referred to as “NAIST”) is a national university composed solely of graduate schools and which has as its objectives:

- to conduct advanced basic studies in the fields of science and technology;
- to implement organizational development of capable human resources engaged in research and development in the field of science and technology at colleges, universities, private companies and other entities.

Since its founding NAIST has not only been deeply committed to research and education, but based on the achievements of this effort the Institute has promoted a distinctive style of management in order to return to society the benefits it has gained, create a new culture, and press ahead with close cooperation and collaboration with external organizations and institutions.

Against the backdrop of the harsh economic environment surrounding our country in the 21st century, the Japanese government has adopted a policy of building up the country on the foundation of intellectual property in order to enhance the nation's industrial competitive abilities by both creating and making the most of intellectual property. Universities, which must take the lead in the “century of knowledge,” are expected to play a pivotal role in this governmental initiative. There is a growing social expectation that as knowledge bases universities will, in addition to research and education, utilize the achievements of research, return them to society, and contribute to the advancement of society.

In these circumstances, NAIST has taken the opportunity of its conversion to an independent corporate entity to arrive at a fresh awareness of returning its research achievements to society (making a social contribution) as one of its priority missions. Toward the fulfilment of this mission, NAIST will step up its commitment in every aspect of research and education at NAIST and other university activities to enhance its engagement from the perspective of emphasizing intellectual property (being a pro-patent university).

1. Basic Principles

1.1 NAIST's Mission and Registering/Eliciting Intellectual Property Rights from

Research Achievements

In addition to research and education, returning its research achievements to society is a vital mission for NAIIST, with the objective of finding industrial and other applications for our research achievements and thereby contributing both to improving people's lives and expanding employment opportunities. Achieving this will require our rendering a technical contribution to the industrial sector through the promotion of industry-government-academia collaboration, and registering intellectual property rights from research achievements is crucial in this respect. Based on this recognition, NAIIST will press ahead with registering and eliciting intellectual property rights from research achievements. We will educate staff members about the necessity of protecting intellectual property rights for research achievements, and make this requirement generally known throughout the Institute.

1.2 Combining and Matching Academic Freedom with Becoming a Pro-Patent University

In university research, the self-direction, independence and autonomy of researchers, as well as the freedom of publication of research, must be respected (academic freedom). NAIIST respects the self-direction, independence and autonomy of researchers in regard to disclosure of research achievements and the protection of intellectual property rights for these achievements, and is working to combine and match both academic freedom and a pro-patent university policy simultaneously in the research at the university, while cultivating and raising researchers' consciousness of intellectual property.

1.3 Establishment of a Centralized Management and Utilization System for NAIIST's Intellectual Creation Cycle

In order to register and maintain intellectual property rights for research achievements at NAIIST, an intellectual property support program, including an electronic intellectual property management system, internal rules and other infrastructures will be formulated. The Intellectual Property Division has been established within NAIIST to serve as a centralized point of contact, both internally and externally, for NAIIST's intellectual property, and is tasked with receiving notifications of intellectual property, managing

intellectual property, maintaining intellectual property rights, utilizing intellectual property, and promoting various activities associated with the university intellectual creation cycle.

1.4 Duties of Staff Members and the Institute's Ownership of Research Achievements

Taking the opportunity of NAIST's conversion to an independent corporate entity, the staff members (researchers) of NAIST will be held responsible for discharging their duties related to research, education and social contributions conducted using NAIST's facilities, equipment, funds, human and other resources, and any research achievements they have obtained in the course of discharging these duties shall belong not to the said staff members or other individuals but to the Institute as a corporation. Thus the work-related inventions program has been introduced.

1.5 NAIST's Contribution to Society and Industry: the Government-Industry-Academia Collaboration

NAIST will engage in making a social contribution with priority given to the tasks of utilizing the achievements of advanced basic studies in the field of science and technology for the advancement of science and technology, developing capable human resources through advanced education based on these research achievements, and in addition to sending them out into the academic and industrial sectors, transferring technologies from research achievements to industry in future to enable them to play a useful role in the industrial sector.

Moreover, NAIST will raise awareness among researchers that one attitude they should hold when carrying out studies research is that its achievements should have a role to play in industry, to ensure that the achievements of research carried out at NAIST will contribute to creating new business enterprises and industries that could take flight from Nara into the world. In addition, NAIST will promote cooperation with entities both inside and outside the Institute, as well as actively pressing ahead with activities designed to find industrial applications for research achievements while evaluating the achievements of basic studies.

The functions of NAIST's technology licensing organization (TLO) will be expanded and enhanced in order to facilitate the technology transfer of

research achievements (intellectual property rights) to the industrial sector. NAIST will work to engage in multifaceted, strategic industry-government-academia collaboration by such means as actively promoting collaborative and commissioned research with private companies for applied research on NAIST's research achievements, and will promote the effective technology transfer of such research achievements.

1.6 The Promotion of NAIST's Intellectual Creation Cycle to Afford Incentives to Staff Members and Revitalize Research Projects

The intellectual creation cycle will be promoted effectively in order to create intellectual property from the achievements of research carried out at NAIST, maintain intellectual property rights, utilize research achievements, earn revenue from these achievements, and use it to provide research funds. A portion of the proceeds will be passed on to the staff members who are inventors and will be counted toward their research performance evaluation. Incentives such as this for staff members will revitalize NAIST's research and education.

2. Internal Regulations to Shape Intellectual Property Policy

Based on the basic principles set out above, fundamental matters concerning the handling of research achievements and intellectual property rights will be codified as the following regulations so as to shape intellectual property policy:

(1) Regulation for Handling of Research Achievements

This regulation provides for particulars required for the handling of research achievements obtained in the course of their research process, including intellectual property and research materials (tangible assets).

(2) Regulation for Employee's Inventions Management

This regulation provides for particulars required for the handling of intellectual property (intellectual property rights).

(3) Regulation for Handling of Research Materials

This regulation provides for particulars required for the handling of research materials (tangible assets).

(4) Regulations for Handling of Licensing Transactions

These regulations provide for particulars required for the handling of transferring of technologies to private companies, etc. (in the form of

licensing or transfer agreements) and collaborative research projects with private companies and other organizations in relation to the intellectual property rights owned by NAIST.

To enforce the above regulations, the required procedures and forms will be formulated to enable these regulations to be implemented smoothly within the Institute.

3. Handling of Staff Members and Students in the Enforcement of the Regulations (under Intellectual Property Policy)

3.1 Staff Members

These regulations basically apply to professors, assistant professors, research associates, faculty members, and staff who are in employment relationships with NAIST (whether full-time or part-time), as well as the President and other corporate officers of NAIST.

3.2 Students

Because students are not in employment relationships with NAIST, these regulations essentially do not apply to them. Considering, however, that students may engage in research at NAIST under the supervision of a professor, they shall be treated as follows (Persons associated with NAIST who are neither students nor in employment relationships with NAIST shall be treated similarly to students).

If students or others engage in research conducted by NAIST under the guidance or supervision of a professor, for the purposes of the provisions of the Regulation for Employee's Inventions Management set out in Section 2 they shall be treated similarly to staff members, who shall make an agreement with the students in advance as long as they are engaged in such research.

4. Handling of Research Achievements

4.1 Definition of Research Achievements

- (1) papers and other similar documents;
- (2) reagents, materials, experimental animals, plants, cell strains, bacteria strains, genes, chemical substances, prototypes, experimental apparatus and other research materials obtained in the course of research that can be used for research purposes, and which are tangible and have added value

from the technical viewpoint; and

- (3) inventions, ideas, authorship of computer programs/databases, technical know-how and other intellectual property obtained as the achievements of research conducted at the Institute (whether or not these items are included in the achievements mentioned in (1) and (2) above).

4.2 Notification of Research Achievements

The staff members who have created the research achievements shall notify the President of these in accordance with the following regulations:

- (1) notification of papers presented at external meetings pursuant to the Regulation for Handling of Research Achievements;
- (2) notification of inventions and other intellectual property pursuant to the Regulation for Employee's Inventions Management; or
- (3) notification of research materials pursuant to the Regulation for Handling of Research Materials.

4.3 Ownership by the Institute of Research Achievements Obtained in the Course of Duties

As a general rule, research achievements created by staff members in the course of their duties shall belong to NAIST.

4.4 Ownership by NAIST of Proceeds from Research Achievements and Their Return to Staff Members

If NAIST has earned revenue from research achievements created by staff members in the conduct of their duties, this revenue shall belong to NAIST. A portion shall be returned to the staff members who created the said research achievement in accordance with the Regulation for Employee's Inventions Management and the Regulation for Handling of Research Materials.

4.5 Staff Members' Obligation of Confidentiality With Regard to Research Achievements

Staff members shall observe confidentiality with respect to the unpublished achievements of research, except for those for which disclosure is permitted, and may not disclose or provide the said unpublished research

achievements to other parties.

4.6 Obligation and Responsibility to Manage Research Achievements

- (1) Staff members shall keep the achievements of research in proper and strict custody in order to prevent them from being known to third parties or being taken off the premises.
- (2) Research achievements generated in collaborative research projects with private institutions or in commissioned research projects must be managed so as to ensure that obligations (including the obligation of confidentiality) imposed on NAIIST in accordance with any agreement into which it has concluded with private institutions for the said research projects can be fulfilled by the Institute.
- (3) Dean of the Graduate school or other responsible person shall be held responsible for managing research achievements (including managing the research achievements specified in (1) and (2) above) generated in the graduate school or other part of the organization over which he/she has supervision.

4.7 Presentations of Research Achievements at External Meetings of Academic Societies and Protection of Intellectual Property Rights

- (1) If the staff members who created the research achievements determined by themselves that the said research achievements have a value as intellectual property (insofar as they are novel, patentable, and serve industrial uses), they should present at external meetings the said research achievements after having completed the procedures for submitting a patent application.
- (2) If the staff members who created the research achievements determine that disclosing the said research achievements without registering any rights thereto would contribute to society for the sake of the advancement of science and technology as well as the progress of education, they may refrain from protecting intellectual property rights.
- (3) The Intellectual Property Division should assist staff members in making decisions on matters (1) and (2) above.

4.8 Providing Research Achievements to Third Parties

- (1) If staff members intend to provide research achievements they have obtained in the conduct of their duties to third parties, they must:
 - (a) obtain the consent of interested parties to provide the said research achievements;
 - (b) check to ensure that provision of the said research achievements does not violate NAIST's Code of Regulations; and
 - (c) obtain the approval of the President before making an agreement on provision of the said research achievements to the recipient private companies.
- (2) Particulars concerning handling of provision of the research materials to third parties are provided for in the Regulations for Handling of Research Materials (refer to Section 8: Handling of Research Materials).

4.9 Receiving Research Achievements from External Institutions

If staff members intend to receive research achievements from external institutions, it shall be treated similarly to the provisions in 4.8 above.

4.10 Efforts to Protect Intellectual Property Rights and Support by the Intellectual Property Division

- (1) If research achievements obtained in the conduct of staff members' duties are deemed to have a value as intellectual property, efforts must be made to protect the said research achievements by registering intellectual property rights thereto.
- (2) The staff members who created the research achievements should determine whether the said research achievements have a value as intellectual property or not, or whether the said research achievements must be protected by registering intellectual property rights thereto self-directly, independently, and autonomously with the support of the Intellectual Property Division.
- (3) Particulars concerning handling of intellectual property rights are provided for in the Regulations for Handling of Inventions Produced in the Conduct

of Duties (refer to Section 5: Handling of Intellectual Property Rights).

5. Handling of Intellectual Property Rights

5.1 Definition of Intellectual Property Rights [Rights (1) to (5)]

(1) Patent and other rights [rights (a) and (b) mentioned below]:

(a) patent rights, utility model rights, design rights, and trademark rights;
and

(b) rights to obtain industrial property rights, including the right to obtain patents (hereinafter referred to as the “right to obtain patents”).

(2) Copyright [rights (a) and (b) mentioned below]:

(a) copyright on authorship of programs as specified in the Copyright Law;
and

(b) copyright on authorship of databases as specified in the Copyright Law.

(3) Circuit layout rights:

Circuit layout rights to the layout of semiconductor integrated circuits as specified by law.

(4) Breeder’s right:

Breeder’s right as specified in the Seeds and Seedlings Law.

(5) Rights to use technical know-how:

Rights to use technical information that can be kept secret and that have a value as property (hereinafter referred to as “technical know-how”).

6. Patent Rights and Other

6.1 Handling of Inventions and Others (Steps of Procedure from Notification, Verification of Succession to Rights, Submission of a Certificate of Transfer to Utilization of Inventions)

(1) If a staff member has produced an invention in connection with NAIST’s research and education, he/she shall notify the President of this.

(2) The President shall entrust the Director of the Intellectual Property Division with the task of verifying whether notified inventions fall under

the category of work-related inventions (refer to Section 6.2. Handling of work-related inventions) and whether NAIST should succeed to the right to obtain patents thereon.

- (3) The President shall inform the inventing staff member of the results of verification by the Director of the Intellectual Property Division, and if the staff member is informed to the effect that NAIST shall succeed to the rights to obtain patents thereon, he/she should submit a certificate of transfer to the President and submit the documents required to apply for patents to the Intellectual Property Division.
- (4) The Intellectual Property Division shall hold primary responsibility for carrying out patent application and the procedure for obtaining intellectual property rights, maintaining these rights, granting licenses to private companies, and utilizing the rights to inventions for which it has been determined that NAIST shall succeed to the right to obtain patents (accountability for management of intellectual property rights).
- (5) If the inventor has any objection to a decision made by NAIST not to succeed to the right to obtain patents on inventions that he/she has produced, he/she may file a protest with the President (refer to Section 6.7).

6.2 Handling of Employee's inventions and Voluntary Transfer

- (1) "Employee's inventions" shall mean inventions that are produced by staff members, fall within the range of NAIST's activities, and for which involved in the production of the invention belonged to the said staff members' current or previous duties at NAIST. Inventions created by staff members using NAIST's funds, facilities, equipment and other resources (including human resources) in the course of research in which they are engaged in principle fall under the category of work-related inventions, and NAIST must be notified of these without fail.
- (2) In regard to inventions that do not fall under the category of employee's inventions but which are connected with NAIST's activities, the staff members may consult with NAIST about the transfer of the right to obtain patents by submitting a notification (this transfer is referred to as "voluntary transfer").

6.3 Ownership of the Right to Obtain Patents

- (1) The right to obtain patents on employee's inventions produced by staff members belongs to NAIST.
- (2) If joint development or other such collaborative research projects are carried out in accordance with an agreement with a private company, the ownership of the right to obtain patents on the inventions produced in such research projects should be determined in accordance with the provision of the said agreement; provided, however, that inventions produced independently by staff members in principal belong solely to NAIST and inventions produced collaboratively with the employees of private companies belong both to NAIST and the private companies.

6.4 Notice of Application of Article 30 (Exceptions to Lack of Novelty of Invention) of the Patent Law

Inventions should not be disclosed before applying for a patent, but if an invention should lose its novelty under unavoidable circumstances such as its presentation at a meeting of an academic society or other similar circumstances as specified in Article 30 of the Patent Law, the staff member who produced the said invention should immediately notify the Director of the Intellectual Property Division to this effect.

6.5 Staff Members' Obligation to Cooperate in Registering Rights

In the procedure toward acquisition of patent right on an invention produced by a staff member, if the staff member is requested by the Intellectual Property Division or an attorney at law to advance opinions or answer inquiries, he/she should comply with such requests in good faith and cooperate aiming at the acquisition of such right.

6.6 Returning the Right to Obtain a Patent to the Staff Member

If notice of NAIST's decision not to succeed to the right to obtain a patent on an invention has been given to the staff member who produced the said invention, the right to obtain a patent thereon should be considered to have been returned to the said staff member unless other provisions apply.

6.7 Notice of Opposition

- (1) If a staff member has received notice of NAIST's decision not to succeed to

the right to obtain a patent on an invention for which he or she submitted a notification, and if he/she has an objection to this decision, he/she may file a protest with the President within 20 days of receiving the said notice.

- (2) In the event that the President receives a protest, the President shall make a decision on whether to succeed the right to obtain a patent on the said invention after holding a deliberation of the Intellectual Property Council, and shall give notice of the decision to the person who filed the protest.

6.8 Compensation for Inventions

- (1) If NAIST has succeeded to patent or other rights on an invention, compensation will be paid to the staff member who produced the said invention:
 - (a) patent application compensation: ¥6,000 per patent applied for;
 - (b) licensing compensation: an amount equivalent to 40% of the proceeds from licensing a patent right;
 - (c) transfer compensation: an amount equivalent to 40% of the proceeds from transferring a patent right.
- (2) If there are two or more inventors are eligible for a patent application compensation, unless otherwise agreed among the inventors, in principle the proportion of their contributions shall be equal and the compensation shall be divided equally among the inventors.
- (3) The President shall entrust the Director of the Intellectual Property Division with the task of verifying the person or persons who are eligible for compensation and the amount thereof.

6.9 The Intellectual Property Council

- (1) Composition

Chair: President of NAIST

Members: Executive Directors designated by the President, the Director of the Intellectual Property Division, the Dean of the Graduate School and other persons whom the President deems to be required as members of the Council

(2) Functions

(a) to deliberate decisions made by the Director of the Intellectual Property Division concerning the NAIST's succession to the right to obtain patents in accordance with the provisions of the Regulation for Employee's Inventions Management, the Regulation for Handling of Research Materials, and the Regulation for Handling of Licensing Transactions, as well as concerning protests filed against the decisions; and

(b) to deliberate matters related to intellectual property.

6.10 Handling of Staff Members After Retirement

The Regulations Employee's Inventions Management apply to inventions produced by staff members in active service, and compensations will be paid to staff members who have lost their status as staff members owing to retirement after they have retired.

7. Intellectual Property Rights Other Than Patent Rights

7.1 Copyright

In regard to works of authorship created at NAIST, in light of their industrial utility and NAIST's fields of research, copyright to the authorship of computer programs (Article 2, Section 1, Item 10-2 of the Copyright Law) and databases (Article 2, Section 1, Item 10-3 of the same law) will be treated similarly to patent rights as intellectual property rights specified in the Regulation for Handling of Inventions Produced in the Conduct of Duties.

- (1) Considering that authorships of programs and databases serve industrial uses and are created in connection with inventions, and that during technology transfer a license to use these works of authorship may therefore be granted as a package deal with related patent rights, works of authorship produced by staff members in the course of their duties in principle shall (whether or not they fall under the category of works produced by juridical persons under the Copyright Law) be treated similarly to employee's inventions, which means that NAIST may succeed to the right to obtain patents on the said works of authorship upon receipt of notification from the staff members who produced the said works of authorship.

(2) Notifications, verification of employee's inventions, succession to rights, compensations, and handling of licensing transactions shall be treated similarly to patent rights.

7.2 Circuit Layout Rights and Breeder's Rights

Original works produced by staff members in the course of their duties in relation to circuit layouts and species shall be treated similarly to employee's inventions, which means that NAIST may succeed to rights on the said original works upon receipt of notification from the staff members who produced the said original works. Notifications, verification of work-related inventions, succession to rights, compensations, and handling of licensing transactions shall be treated similarly to patent rights.

7.3 Rights to Use Technical Know-how

Research achievements may include technical information that can be kept secret and that has a value as property (technical know-how). Because technical know-how is protected not by patent rights but as trade secrets (under the Unfair Competition Prevention Law) and is useful in industrializing patented technologies for transfer, it may be possible or necessary for rights to use technical know-how may need to be granted as a package deal with other rights. The technical know-how for which technology transfer to private companies may be envisaged that is produced by staff members in the course of their duties shall be treated in the same way as employee's inventions, which means that NAIST may succeed to the right to use the said technical know-how. Notifications, verification of work-related inventions, succession to rights, compensations, and handling of licensing transactions shall be treated similarly to patent rights.

8. Handling of Research Materials (Tangible Assets/Materials)

8.1 Definition of Research Materials

Reagents, materials, experimental animals, plants, cell strains, bacteria strains, genes, chemical substances, prototypes, experimental apparatus, and other research materials produced by staff members and others that can be used for research purposes, and which are tangible and have added value from the technical viewpoint.

8.2 Ownership by the Institute of Research Materials

Research materials produced by staff members produced in the course of their duties shall in principle belong to NAIST.

8.3 Management and Notification

- (1) If staff members have produced research materials, they must manage them appropriately.
- (2) If any of the following circumstances pertains to a research material, a staff member shall notify the Dean of the Graduate School to this effect:
 - (a) the staff member provides a research material to a third party;
 - (b) it becomes evident that value has been added to the research material from a technical viewpoint; or
 - (c) other circumstances that require notification.

8.4 Verifying Eligibility by the Dean of the Graduate School and Reporting to NAIST

- (1) When the Dean of the Graduate School has received notification of the research material, he/she shall verify whether or not the research material is eligible for a research materials transfer agreement [whether it pertains to (a) or (b) in Section 8.3 (2) above].
- (2) If the Dean of the Graduate School has certified that the research material of which notification has been given is eligible for a research materials transfer agreement, he/she shall immediately report this to the Institute.

8.5 Concluding a Materials Transfer Agreement (MTA)

If a staff member provides a research material to a third party, he/she shall conclude a research materials transfer agreement. The President shall entrust the Director of the Intellectual Property Division to assist him/her in executing a written research materials transfer agreement and conducting negotiations in relation thereto.

8.6 Ownership by the Institute of Proceeds from Research Materials and Grants for the Encouragement of Provision of Research Materials

- (1) Any revenue earned from research materials belongs to NAIST.

- (2) If NAIIST earns revenue from providing a research material, the President shall award the staff member who has produced the said research material compensation for providing research materials.
- (3) The amount of and the method for awarding a compensation for providing research materials shall apply pursuant to the rules for handling of patent rights.

9. Licensing and Transfer of Intellectual Property Rights (Transfer of Technology to the Industrial Sector)

9.1 Principle of Licensing Intellectual Property Rights Owned by NAIIST

- (1) NAIIST may license intellectual property rights it owns to private companies and others in principle on payment of a fee, except for those intellectual properties that it decides will not be industrialized.
- (2) NAIIST may collectively license a range of intellectual property rights to research achievements related to the transfer of technologies if this is useful for industrialization of the achievements of research at NAIIST and for technology transfer to private companies (that is, it may license authorship of programs and technical know-how that are of use in commercializing patented technologies under a package deal agreement).

9.2 Intellectual Property Rights Owned Jointly by NAIIST and Companies or Other Organizations

If a company that is a co-owner intends to use intellectual property rights owned jointly by NAIIST and the company, because NAIIST does not undertake commercial transactions, NAIIST must conclude a licensing agreement with the company setting out that the company shall be permitted to use the said intellectual property rights at a reasonable cost.

9.3 Concluding a Licensing Agreement with Companies or Other Organizations

- (1) Authority to conclude a licensing agreement at NAIIST shall rest with the President, who shall encourage the Director of the Intellectual Property Division to contact with companies or other organizations, to execute a written agreement, to conduct negotiations and to do other duties required to conclude an agreement at the initiative of NAIIST.

- (2) A licensing agreement shall provide for the terms and conditions of a contract related to:
 - (a) specification of intellectual property rights that are to be licensed;
 - (b) whether licensing is priority or non-priority;
 - (c) range of licensing;
 - (d) term of licensing; and
 - (e) the amounts of the license fee and other royalty, and methods of payment of them.

9.4 Priority Licensing

Priority or partly-priority may be given to concluding a licensing agreement under any of the following circumstances, and additionally if priority licensing is rational and required to promote the use of intellectual property rights or to facilitate the widespread use of research achievements provided by using the intellectual property rights:

- (a) persons who are co-owners of intellectual property rights owned jointly with NAIST desire to be given priority in concluding a licensing agreement for the said intellectual property rights;
- (b) companies that have carried out a collaborative research project with NAIST desire to be given priority in concluding a licensing agreement for intellectual property rights owned solely by NAIST;
- (c) a company that has commissioned for NAIST to carry out a research project desires to be given priority in concluding a licensing agreement for intellectual property rights owned solely by NAIST; or
- (d) the creator (inventor) of intellectual property for which NAIST owns the intellectual property rights intends to commercialize the said intellectual property.

9.5 Transfer of Intellectual Property Rights

- (1) NAIST may transfer intellectual property rights it owns to companies or other organizations under the circumstances described in (a) to (d) in Section

9.4 (1) above, and additionally if transferring the said intellectual property rights to companies or other organizations is rational and required to promote the use of intellectual property rights or to facilitate the widespread use of research achievements provided by using the intellectual property rights.

- (2) In the event of the transfer of intellectual property rights owned by NAIIST to a company or other organization, NAIIST shall conclude a transfer agreement with the company or other organization.

9.6 Exception for Licensing Intellectual Property Rights to Academic Research Institutions (Academic Use)

If intellectual property rights owned solely by NAIIST are licensed to an academic research institution at its request, notwithstanding the provisions of the Regulation, exceptional licensing terms and conditions regarding to the license fee and royalty may be provided for. However, the said academic research institution shall pledge that:

- (a) it shall not use licensed intellectual property rights for purposes other than academic research;
- (b) it shall not sublicense the licensed intellectual property rights, whether for commercial or noncommercial purposes, to a third party without obtaining the consent of NAIIST; and
- (c) it shall license NAIIST the intellectual property right owned solely by the said academic research institution, if NAIIST desires to use such intellectual property rights for academic purposes.

9.7 Ownership by the Institute of Licensing Fees and Other Proceeds and compensation for the inventor(s).

- (1) Licensing fees and other proceeds from the licensing of NAIIST's intellectual property rights shall belong to NAIIST.
- (2) Some part of the licensing fees and other proceeds shall be given back to the inventor(s) as a compensation.

9.8 Outsourcing of Services to Technology Licensing Organizations (TLOs)

NAIIST may outsource all or some of the activities required for licensing

intellectual property rights owned by NAIST to an external technology licensing organization (TLO) if this is deemed effective for the transfer or spread of achievements of research at NAIST to the industrial sector.

10. Response to Patent Infringement Problems and Other Troubles

10.1 Response to Infringement Problems of NAIST's Patent Rights

- (1) If there is an infringement problem of NAIST's patent rights, the Intellectual Property Division shall play a central role (as a Secretariat) in collecting information about the said case of infringement (the identity of the infringer, the subject matter of infringement, patent analyses, the scale of the damage [the number of cases and the amount of damage]), holding a hearing with inventors and other internal interested parties, coordinating related activities, working in cooperation with lawyers, conducting negotiations with the infringing party or parties, concluding an agreement on an out-of-court settlement, and handling matters associated with legal proceedings.
- (2) NAIST's final decision on a case (out-of-court settlement or legal proceedings) shall be made by the President after consideration of the views of the Director of the Intellectual Property Division (if necessary after a deliberation by the Intellectual Property Council).

10.2 Response to Disputes Raised Against NAIST

Disputes raised by an external institution against NAIST in connection with its infringement problems of third parties' patent rights shall be resolved in accordance with the provisions of Section 10.1.

CONCLUSION

The above intellectual property policy and the internal regulations intended to give shape to this policy will be revised from time to time in order to meet changes in the climate surrounding intellectual property rights and the Institute, including amendments to laws and ordinances, trends in judicial precedents, trends in the conversion of national universities to independent corporate entities, and the advancement of NAIST's intellectual property infrastructure. In so doing, NAIST's intellectual property rights will be expanded and used more vigorously.