# University of Delhi
# Intellectual Property Rights Cell

## Guidelines for intellectual property protection, its licensing and collaborative research with Industry participation

(These guidelines do not constitute legal advice. For help with a particular legal problem, advice from an intellectual property lawyer may be sought)

## Guidelines for intellectual property protection and its licensing

1. An IPR facilitating cell, an interface between the DU faculty and the Patent/copyright attorney shall guide and help the faculty and students of Delhi University in patentability assessment and to apply for patents / copyright/ trademark applications.

2. The University faculty desirous of filing a patent or copyright or trademark application would be advised to contact the IP cell regarding these issues.

3. An internal approval form (available at IP cell) filled by the PI wherein names of the inventors/authors shall be mentioned, is to be signed by the PI and forwarded by the HOD for approval of the Dean Research of the respective subject with recommendation of the IPR Chair.

4. Invention disclosure description (in invention disclosure format) is to be forwarded along with the duly signed approval form to the IP cell for further action.

5. Invention disclosure/ Patent/Copyright/Trademark and similar documents are to be treated as confidential and would be placed under special duty to maintain confidentiality by the signing of a Non-Disclosure Agreement by personnel of the IPR cell.

6. Since patenting is expensive, efforts should be made to get the patent filed through other funding agencies such as DBT, NRDC and DST (TIFAC).

7. The IP cell shall help the inventor in drafting of the patent specification / copyright or trademark application and filling of relevant forms.

8. The draft application along with the relevant forms shall then be forwarded to a patent attorney present on the panel of University of Delhi.

9. The IPR cell shall correspond with the attorney and the inventors on IP matters.

10. The committee for approval for patent filing would consist of: Concerned HOD, Dean Research of the subject, the IP Chair and Finance Officer or his nominee in case where DU funds need to be utilized.

11. The inventors would be required to cooperate with the IP cell to expedite furnishing of information for timely actions since delay would mean payment of extra fee to the patent office and the attorney.

12. Any work sought to be filed by a faculty member and or students arising out of R&D work done at the University will required to be filed in joint names as inventors or authors while University shall be to the owner of IP.

13. After filing of the application for IP protection, the inventors shall inform the IPR cell of any further development, if any, in the related R&D work.

14. The IPR Cell and inventors in collaboration with Research Council shall work together for dissemination of the Intellectual property to public and industry to aid in commercialization.

## Guidelines for collaborative research with Industry participation

The Collaborative R&D Projects constitute the projects wherein there are two or more agencies are the participants. These projects are partially funded by a private entity (client) and/or supplemented by the university and/or by a Government R&D funding agency. These projects can be for up scaling & validation of lab level knowhow or for technology development.

To smoothen the process of collaborative R&D with Industry and tech transfer, robust and broad guidelines are required to be formulated by the University for:

- Project costing/costing of technology/know-how,
- Permissions required by the PI for collaborative research with industry and tech transfer and authorized signatories for the same,
- Modalities of IP protection and its maintenance,
- Source of the funds required for IP protection and maintenance,
- Modalities of IP protection (whom to approach, authorized department/officer/committee),
- The terms and conditions of MOA for collaborative R&D and authorized signatories,
- Evaluation of technology/know-how.
- Ownership of the patents, if any, generated out of the collaborative research
- Modalities of tech transfer/IP licensing from identification of private partner, negotiations, MoA finalization to finalization of terms and conditions etc.)

A committee must be constituted for approval of Technology Transfer. It may consist of the inventor, The Head of the respective Department, Dean Research of the concerned subject, Dean of the faculty and the IPR Chair.

**Salient features of the terms and conditions for the collaborative R&D projects to be built up in the Memorandum of Agreement for collaborative R&D**

**IPR Issues**

1. Non-disclosure agreement may be signed with the private party prior to discussions and negotiations.
2. The responsibilities and deliverables expected from all the participating agencies should be clearly mentioned in the MoA for collaborative work.
3. Back ground Knowledge: The background knowledge is the know-how already developed by the university which is to be either further developed or validated by the company on implementation of the collaborative project. The background knowledge document/s is to be clearly mentioned in the MoA and appended as an annexure.
4. The exit and arbitration clauses for all the participating agencies should be well formulated in the MoA so as to avoid future legal disputes in case of premature project closure.
5. The IP rights for the IP generated out of the collaborative project shall be jointly shared among the participating agencies.
6. The intellectual property, product, prototype or process generated out of such projects shall be co-owned among the participants on mutually decided terms.
7. Costs of IP protection and its maintenance to be equally shared among the participating agencies.

**Terms and conditions to be taken care of for licensing of the know-how developed from the collaborative work**

i. The private party (company) shall have first right to license and commercialize the developed know-how and resulting IP, if any.

ii. In case the company is not interested to license the IP/know-how developed, the university and the Government agency (funding body) shall be free to license and transfer the know how to another suitable party.

iii. The non-exclusive technology transfer should be preferred but in case the private party insists, technology may be transferred on exclusive basis at a higher rate for fixed time duration.

iv. Liability/Indemnity: The licensee shall indemnify Delhi University (Licensor) against any harm or suit brought about by the third party relating to technical knowhow or the products developed by the Licensee.

v. Any liability to the licensor in connection with licensed know-how/IP* shall be up to a ceiling of the sum received from the client.
(* These refer to special conditions such as failure of licensed know how and/or false claims for the licensed knowhow).

vi. The cost of the developed know how is to be calculated based on direct expenses, intellectual fee and service tax etc. incurred by the University. Direct expenses comprise manpower costs, cost of consumables & chemicals, infrastructural services, equipment usage cost and contingencies.

vii. Intellectual fee would comprise a percentage (in a range of 30-50%) of total expenses incurred by the university and would also include a component of patent protection & maintenance costs per country where the company wishes to commercialize the know-how. The patent charges to be decided on mutual negotiations and agreement.

A**n outline of the protocol for this purpose can be as below:**

1) The investigator should be asked to make a presentation to establish before the committee the nature of technology and whether it is ready for transfer.
2) The committee should also discuss the worth of the technology in terms of royalties etc. (maximum and minimum) before putting the advertisement.
3) Subsequently, Advertisement can be put on the DU website to call for letter of interest. The advertisement should have link to details of technology, minimum value asked for etc.
4) Once the letter of Interest are received by the PI or University authorities, the interested companies can be asked to present their strengths in commercializing the technology before the translational committee.
5) Shortlisting of Companies as per the decision of the committee.
6) Negotiation for upfront amount and royalties.
7) MOA signing and technology transfer
8) Commercial validation by the company
9) Finalization of commercial product
10) Launching of product by company.

**Elements of costing of collaborative R&D project with Industry participation**

The main components here would be:

1. **Direct expenses** that comprise manpower costs, cost of consumables & chemicals, infrastructural services, equipment usage cost and contingencies.
2. **Intellectual fee can** range from 30 to 50 % of total expenses. This cost reflects the intellectual capability developed by the project implementing scientists/technologists.

**Details:**

(1) **Man-day costs:** These constitute charges based on the actual time spent on the project (man-days) for the S&T manpower deployed for the project. There would be different costs for different levels of manpower for example Faculty, Research associate, Research/project assistants/ Senior Research fellow, Junior Research Fellows etc. based on actual time spent on the activity

| S. No. | Category of Staff | Man Power rates, Rs. | |
|---|---|---|---|
| | | Per day | Per year |
| 1. | Professor | 7000 | 14 Lakh |
| 2. | Associate Professor | 5000 | 10 Lakh |

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|---|---|---|---|
| 3. | Assistant Professor | 4000 | 8 Lakh |
| 4. | Technician | 2500 | 5 Lakh |
| 5. | Research Associate/ Research Assistant/JRF/SRF | Actual salary with 40% overheads | |

(2) **Costs of Chemicals and Consumables**: 100% cost plus 20% overheads
(3) **Equipment usage costs**: these reflect yearly usage charge and can be 20% of the cost of equipment (in case of old equipment, depreciation at the rate of 20% per annum may be taken).
(4) **Contingencies:** Any unforeseen expenditure required for implementing the project (travel, stationary, other research expenses such as photography work, sundry small purchases etc.).
(5) **Intellectual fee:** Intellectual fee comprises efforts and expenses incurred over a period of time for capacity and expertise build up.