

POLICY ON
INTELLECTUAL PROPERTY,
TECHNOLOGY TRANSFER
AND
RESEARCH COLLABORATIONS

FEBRUARY 2005

CONTENTS

PART I. INTRODUCTION

- 1.1 General Statement
- 1.2 Definitions
- 1.3 Administration
 - (a) Innovation & Technology Transfer Office
 - (b) Intellectual Property Management Committee

PART 2. INTELLECTUAL PROPERTY OWNERSHIP

- 2.1 IP Ownership by the University
- 2.2 Copyright of Works
- 2.3 Student Thesis
- 2.4 Outside Consultants and Independent Contractors

PART 3. DISCLOSURE, EVALUATION AND COMMERCIALISATION OF IP

- 3.1 IP Disclosure and Evaluation Process
- 3.2 Academic Thesis Containing Information on Patentable Inventions
- 3.3 Commercialisation and Protection of University IP
- 3.4 Distribution of Commercialisation Benefits
- 3.5 Return of IP to Inventors

PART 4. RESEARCH COLLABORATIONS WITH EXTERNAL PARTIES

- 4.1 General Statements
- 4.2 Research Collaborations with Non-Commercial Parties
- 4.3 Research Collaborations with Industry
- 4.4 General Policies on Other Terms in Research Agreements
- 4.5 Other Types of Agreements
 - (a) Memorandums of Understanding
 - (b) Master Research Agreements
 - (c) Confidentiality Agreements
 - (d) Material Transfer Agreements
 - (e) License Agreements

PART 5. GENERAL OBLIGATIONS

- 5.1 Confidentiality
- 5.2 Disclosure of Conflicts of Interest

PART 6. OTHERS

- 6.1 Consultancies
- 6.2 Conflict of Interest
- 6.3 Directorship of Companies

PART 7. GENERAL

- 7.1 Waiver of Policy
- 7.2 Settlement of Disputes
- 7.3 Commencement and Application of IP Policy
- 7.4 Amendment of the Rules and Guidelines of the IP Policy

ANNEXES

ANNEX A	Invention Disclosure Form
ANNEX B	Declaration of Mandatory Disclosure under Part 2.1 (e)
ANNEX C	Letter Agreement for Return of IP to Inventors
ANNEX D	Overview of Intellectual Property in General

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 the University becomes increasingly active in technology transfer, and staff and students increasingly participate in entrepreneurial activities, the University's "Policy on Intellectual Property, Technology Transfer and Research Collaboration" needs to be reviewed periodically to ensure that it can continue to meet the needs of the University and the community that it serves.
- (d) 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.
- (e) 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 of a confidential nature, 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, and all IP, information and data which the University 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 has made substantial creative or authorship contributions.

"IP Policy" means the University's "Policy on Intellectual Property, Technology Transfer and Research Collaboration" 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.

“Staff Member” shall mean all University employees, including all academic, 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 higher degree 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.

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

1.3 Administration

(a) Innovation & Technology Transfer Office (ITTO)

- (i) The ITTO is responsible for administering the IP Policy and the evaluation and commercialisation of University IP.
- (ii) The ITTO is also responsible for managing the University’s patent portfolio and the drafting, filing and prosecution of patent applications and the maintenance of granted patents.
- (iii) The ITTO administers the Innovation Fund, which funds are used for patenting and activities related to the protection and commercialisation of University IP.

(b) Intellectual Property Management Committee (IPMC)

- (i) The Intellectual Property Management Committee (IPMC) is the oversight committee set up to oversee the handling and management of the University’s IP by the ITTO.
- (ii) The IPMC will be responsible for resolving any dispute that may arise from the interpretation of this IP Policy. The IPMC will also review and endorse license agreements negotiated by the ITTO as well as periodically review the patent management and licensing practices of the University.

PART 2. INTELLECTUAL PROPERTY OWNERSHIP

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 either 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 agreement between the University and an external party, subject to the terms on IP ownership set out in the relevant research 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) All IP developed by Staff Members or Students in their own personal time, 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.
- (e) However, prior to any patent filings or commercialisation by a Staff Member in respect of IP deemed owned by the Staff Member under Part 2.1(d) above, the Staff Member shall make full and frank disclosure to the University by submitting the Declaration of Mandatory Disclosure as set out in Annex B.

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:

- (i) If the Work is created in the course of or pursuant to an agreement between the University and an external party, copyright ownership is subject to the terms on IP ownership set out in the relevant agreement; or
 - (ii) If the Work is created by a non-academic 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 and reproduce such Works in whatever form, electronic or otherwise, for its teaching, research and academic purposes.
- (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 School or Centre to compile certain course materials for further distribution and sale, it is advisable that the School or Centre 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 agreement with external parties. The Student shall grant to the University a royalty-free permission to reproduce, publish and publicly distribute copies of the thesis, 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 procedures under Part 3.2.

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 the ITTO.

<p style="text-align: center;">PART 3. DISCLOSURE, EVALUATION AND COMMERCIALISATION OF UNIVERSITY IP</p>

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 the ITTO by submitting a Technology Disclosure Form (substantially in the same form as set out in Annex A), with a copy to his/her Dean of School.
- (b) The ITTO will evaluate the commercial potential and patentability of the IP. The ITTO may consult with other Staff Members or independent experts who are competent in the field to assist in the evaluation if appropriate or necessary in the opinion of the ITTO.
- (c) The ITTO shall, within three (3) months from the date that the Technology Disclosure Form is received by the ITTO, confirm in writing to the Inventor(s) whether or not the University will be pursuing the commercialisation and/or patenting of the IP, subject to any obligations that may be owed to external parties [see further Part 3.1 (e)].
- (d) The ITTO will normally seek patent protection in order to pursue commercialisation of the invention. The ITTO will not seek patent protection for inventions that are not commercially attractive, even though the invention may be scientifically meritorious.
- (e) If there are obligations owed to an external party under the terms of a grant or research agreement in respect of the IP, the ITTO will contact the external party and proceed with the management of the IP in accordance with the terms of the agreement with such party.
- (f) 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 the ITTO 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.
- (g) All Inventors shall disclose to the ITTO 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 Academic Thesis Containing Information on Patentable Inventions

- (a) To safeguard the interest of the University, the following outlines the steps taken to withhold a Student's thesis containing information on a patentable invention:
 - (i) The supervisor of the Student concerned shall inform the Office of Academic Services (OAS) and the Dean of the School concerned that

the subject matter dealt with in a thesis has been or will be disclosed to the ITTO, and shall request OAS to withhold public access to the thesis;

- (ii) OAS will inform the examiners that the thesis is of a confidential nature and request that it not be freely circulated. OAS will also withhold the thesis from being placed and catalogued in the library;
- (iii) If the ITTO decides to pursue commercialisation and proceed with a patent application, the thesis will be withheld until such time the patent application is filed. Once ITTO informs the Inventors that a patent has been filed, the supervisor shall inform OAS that it can proceed to release the thesis in accordance with OAS' normal procedures;
- (iv) If the ITTO decides not to pursue commercialisation of the invention and informs the Inventors of its decision in accordance with Part 3.1(c), the supervisor shall inform OAS that it can proceed to release the thesis in accordance with OAS' normal procedures.
- (v) If the Inventors request for the return of the IP under Part 3.5 and wishes to pursue patent protection for the invention themselves, the Inventors may instruct OAS to withhold the thesis for no more than three (3) months from the date of return of the IP in order for the relevant patent application to be filed.

3.3 Commercialisation and Protection of University IP

- (a) 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.
- (b) 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 while protecting the rights of the University and the Inventors.
- (c) The University will not negotiate contracts for consulting services for individual Inventors as part of a license arrangement. Individual Inventors are free to negotiate such contracts on a personal basis.
- (d) The University may use any means whatsoever, as it shall in its sole and absolute discretion deem fit, to protect any IP owned by it, including but not limited to instituting proceedings concerning patent and licence infringements
- (e) 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 the University in all phases of the patent application and/or commercial exploitation of the Invention as the University 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.

3.4 Distribution of Commercialisation Benefits

- (a) The University shall share with the Inventor(s) of the IP any Net Revenue [as defined in Part 3.4 (b) below] received by the University in the following ratio:

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

- (b) Net Revenue is defined as the gross consideration (including all royalties, fees and other benefits) received from the commercialisation of the IP less all Expenses incurred in the commercialisation of that IP. Expenses shall include all patent filing and legal fees, marketing and licensing costs, administrative expenses and fixed overhead costs and any other expenses necessarily incurred for patenting and commercialising the IP.
- (c) If the University receives shares in a company in exchange for a license or assignment of the IP to the company, the shares the University obtains will be held by the University 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 3.4 (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 the University.
- (d) The Inventors' share of Net Revenue under Part 3.4 (a) will be distributed equally amongst any joint Inventors unless the University 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 the University updated of his/her current contact number and address in order for the University to distribute his/her share of the Net Revenue.
- (f) The University's share of the Net Revenue shall be distributed as follows:

School (50%) : Innovation Fund (50%)

Where there are multiple Inventors from different Schools, the School's share of Net Revenue will be distributed amongst the Schools in accordance with the number of Inventors from each School.

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

3.5 Return of IP to Inventor(s)

- (a) The Inventor(s) may request in writing to the ITTO for the return of the IP for commercial exploitation where:
- (i) The ITTO has informed the Inventor(s) that the University does not wish to pursue the commercial exploitation and patenting of the IP under Part 3.1 (c); or

- (ii) The ITTO does not inform the Inventors within 3 months of the acknowledgment of receipt of the Technology Disclosure whether the University wishes to pursue commercial exploitation and/or patenting of the IP; or
 - (iii) The University has not commercialised the IP after 3 years from the date of receipt of the Technology Disclosure and there are no on-going discussions with any interested parties.
- (b) Where the University returns the IP to Inventor(s) under Part 3.5 (a) above, the Inventor(s) shall sign the Letter Agreement (in substantially the same form as that set out in Annex C), 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 University shall be entitled to a percentage of any benefits received by the Inventor(s) from the commercial exploitation of the IP as follows:
 - (A) The Inventors shall account to the University 15% of any Net Revenue that the Inventors receive for the commercial exploitation of the IP. Net Revenue in this context shall mean the gross consideration (including all royalties, fees and other benefits, but excluding shares in a company), received less all Expenses incurred in the commercial exploitation of the IP. Expenses in this context shall mean all patent filing, licensing, legal, and any other reasonable and necessary expenses incurred for patenting and commercially exploiting the Invention.
 - (B) Where the Inventors receive shares in a company in return for the license or assignment of the IP to the company, the University shall be entitled to 5% of the Inventors' shares. Such percentage may be reviewed on a case-by-case basis if there are justifications for a lower percentage to be applied.
- Where the Inventors will be receiving shares in a start-up company that the Inventors found, NTU or its nominee will further have a first right to invest in up to 15% of the total equity of the company at the initial formation of the company.
- (iii) The Inventors shall submit to the University an annual report in substantially the same form as that set out in Schedule 2 of Annex C, and will keep the University informed of the status of each and every patent application filed in connection with the IP.
 - (iv) The Inventors shall disclose, furnish or otherwise make available to the University all information relating to or in connection with such patent application(s) and/or the commercial exploitation of the IP as and when requested by the University.
 - (v) The University may, but is not obligated to, request for the IP to be returned back to the University if the Inventors fail to commercialise

the IP after 3 years from the date the IP is returned to the Inventors.

- (c) The University's share of the Net Revenue received under Part 3.5 (b) (ii) above shall be distributed as per Part 3.4 (f) above.

PART 4. 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 non-commercial parties, 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 NTU, NTU 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 either a non-exclusive or exclusive fee-based license on commercial terms. An exclusive license may not be available where a key platform technology is involved.
- (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) As a joint-owner which has contributed significantly to the development of the project IP, the Company will have a non-exclusive royalty-free right to commercially exploit the project IP. As the Company is free to commercially exploit the project IP on its own without accounting to the University, the University will also retain the right to give out non-exclusive licenses without accounting to the Company.
- (C) The Company will have the right to license the project IP non-exclusively to third parties but is required to account to the University a percentage of any licensing revenue it receives.
- (D) If the Company wishes to commercially exploit the project IP exclusively, the Company will also have a first right to negotiate a royalty-bearing exclusive license with the University on commercial terms.
- (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 Company's ownership of IP will however be limited to the Company's Field of Application as specified in the project agreement. The University will reserve ownership of any project IP generated in the fields of application not specified in the project agreement and will be free to exploit the IP in those other fields of application.

4.4 General Policies on Other Terms in Research Agreements

(a) Publications

The University reserves the right to publish or present the findings of the project, subject to only the right of the external party to require the delay of any publication or presentation in order to remove any of its confidential information or for the filing of any patents in accordance with the term of the research agreement for the project.

(b) Warranties

As the research is only conducted on a reasonable efforts basis, the results are provided "as-is" and without any representation or warranty of merchantability or fitness for any particular purpose or any warranty that any use will not infringe or violate any patent or other proprietary rights of any other person.

(c) Indemnities

The University requires the external party to indemnify the University from any claim, loss, cost, expense or liability of any kind that may be incurred by the University due to the external party's use (commercial or otherwise) of the results or IP generated from the project.

(d) Overhead Charge

- (i) A fifteen percent (15%) overhead charge will apply to all research projects to take into account the overhead costs in providing the facilities and resources to carry out research at the University. The overhead charge shall be distributed in the following ratio:

University (50%) : School(s) (50%)

- (ii) The overhead charge will be imposed on all direct cash funding received from the external party.

- (iii) The overhead charge does not apply to unrestricted or outright grants or to government grants that do not allow such overhead charges. Usually for such grants, no specific results are required or expected from the sponsor and no rights to any IP accrue to the sponsor.

4.5 Other Types of Agreements with External Parties in Relation to Research Collaborations

(a) Memorandums of Understanding (MOU)

- (i) A Memorandum of Understanding (MOU), also sometimes referred to as a Letter of Intent, is generally entered into to set out the intentions of the parties to undertake certain collaborative activities but the details of the activities have yet to be worked out.
- (ii) The University generally requires such MOUs to be non-legally binding other than for the confidential obligations. The specific arrangements for each collaborative activity are to be set out and agreed upon in separate legally-binding project or research collaboration agreements.

(b) Master Research Agreements (MRA)

- (i) A Master Research Agreement can be entered into between parties which plan to collaborate on many different research projects, usually in one particular area of research. The MRA will set out all the terms that will apply to each research project that comes under it. Individual project agreements will still be required for each research project that will mainly deal with the particular research proposal and any specific terms that may apply to that project.
- (ii) MRAs are usually acceptable for collaborations where the nature of and the level of contributions by both parties to each research project are expected to be similar.
- (iii) Due to the nature of an MRA, the School or Centre should consult with the ITTO on the appropriateness or necessity to sign such an agreement with a party.

(c) Confidentiality Agreements or Non-Disclosure Agreements (NDA)

- (i) Confidentiality Agreements or Non-Disclosure Agreements (NDAs) are agreements that impose obligations on the handling of information received from the other party regarded as confidential. NDAs usually require confidential information to be kept secret and not to be shared with any third party.
- (ii) If the University's confidential information is required to be disclosed to an external party, an NDA should be in place to cover such disclosure.
- (iii) However, the University generally does not encourage the receipt of any confidential business or technical information from a company due to the obligations that will be imposed on the University unless absolutely necessary for the purposes of evaluating the feasibility or

the carrying out of a project with the company.

(d) Material Transfer Agreements (MTA)

- (i) A Material Transfer Agreement (MTA) is an agreement to cover the provision of materials, such as software, engineering prototypes or cell lines, from one party to the other for the purpose of research.
- (ii) Where the University is providing materials to an external party, an MTA would be required to set out the terms of use under which the materials are provided. These terms are important in ensuring that the University does not open itself to potential liability from the recipient's use of the materials provided. The materials are provided without any warranties of any kind and the recipient will be solely liable for any of its use of the materials. The MTA will also include terms to protect NTU's IP in the materials as there may be implications if the materials are distributed freely.
- (iii) Where the University is receiving materials from an external party and an MTA is required to be signed, Staff Members and Students should adhere to the terms of use covering such materials. The Staff Member should consult with the ITTO if the terms of the MTA provide for the external party to obtain rights to the IP generated from research conducted at the University with the materials or if there are any doubts as to the appropriateness of any other terms in the MTA.
- (iv) If materials are being provided in the context of a research collaboration with the external party, the project agreement covering the research collaboration would usually already cover the points raised in (ii) above. The materials should be used only for the project and Staff Members and Students working on the project should take note of any restrictions that may be imposed by the relevant project agreement.
- (v) The ITTO must be consulted for all transfers of materials to companies interested in commercially using the materials.

(e) License Agreements

- (i) A license agreement is an agreement whereby the University grants certain rights to a company to use the University's IP for compensation, usually in the form of cash or equity in the company.
- (ii) All license agreements for University IP are to be negotiated by the ITTO and signed by Director, ITTO.

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.

- (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 the University, 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) In addition, all Staff Members shall make full and frank disclosure and seek the approval of the University in the event of any situation where a conflict of interest may arise, as highlighted by Part 6.2 below.
- (c) Failure to declare his/her interest in the commercial exploitation of the University IP and/or to seek approval from the University as required in Part 5.2 (a) and (b) 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 Academic Staff to Undertake External Consultation and Specialist Work (Including Non-Executive Company Directorship” (OHR/4/2004), and the IP Policy, both as amended from time to time, and any 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 School/Centre 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 Conflict of Interest

- (a) Conflicts of interest may arise in various situations relating to technology transfer interactions with industry. To minimise or prevent such conflict of interest situations, Staff Members must make full and frank disclosure to, and seek approval of, the University in the following situations:
- (i) undertaking sponsored or collaborative research with a company that has licensed IP from the University, where the research is related or in the same area as the IP licensed;
 - (ii) deployment of Students by the Staff Member to do product and/or process research and development for a company in which the Staff Member has an interest. In cases where a Staff Member supervises final-year projects and higher degree students, this includes working on thesis topics in which the Staff Member has a commercial interest in the research area;
 - (iii) transmitting to a company information that is not generally available to the public. This includes withholding or reducing publications after transferring technology to the company, or failing to attend to industry visitors from competing companies;
 - (iv) undertaking or changing the orientation of the Staff Member's research (whether supported by University funds or external grants) to serve the research, product development or other needs of a company;
 - (v) use of the Staff Member's position in the University to participate in company activities;
 - (vi) purchasing of equipment, instruments, materials or other items for University teaching and/or research from a company in which the Staff Member has an interest;
 - (vii) engaging in consultation with a company in which the staff member or any person related to him (including without limitation, his parent, spouse, brother, sister, son, daughter, or any person who is holding legal title for the benefit of the staff member) has an interest, whether legal, beneficial or otherwise.

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

Subject to the conditions as laid down in "Scheme for Academic Staff to Undertake External Consultation and Specialist Work (Including Non-Executive Company Directorship)" (OHR/4/2004), 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 IPMC for resolution. If the matter cannot be resolved at the IPMC, 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 23 February 2005 and for the avoidance of doubt shall be applicable to all NTU IP licensed 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 Amendment of the Rules and Guidelines of the IP Policy

The rules and guidelines set out in 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.