

University Business Development Cell
Sabaragamuwa University of Sri Lanka



Intellectual Property Policy

1. Introduction

The Sabaragamuwa University recognizes the need for encouraging the practical Application and economic use of the results of research carried out at the Institute for the benefit of the general public; therefore it adopted the following Policy on Intellectual property of the university. The present Policy relates to the ownership, protection and commercial exploitation of Intellectual Property created by Researchers/academics in the course of their duties or activities at the university. The document sets out the rules of the university for Cooperation with industrial and business organizations and provides guidelines on the sharing of the economic benefits arising from the commercialization of Intellectual Property.

This policy aims to:

- i) Promote encourage and aid scientific investigation and research.
- ii) Provide legal certainty in research activities and technology-based relationship with third parties outside the university.
- iii) Set out the University's procedures on identification, ownership, protection and commercialization of intellectual property.
- iv) Ensure the timely and efficient protection and management of Intellectual Property.
- v) Facilitate the recording, monitoring and maintenance of the university's Intellectual Property portfolio.
- vi) Ensure economic benefits arising from commercialization of intellectual Property are distributed in a fair and equitable manner recognizing the contributions of the inventors, the university as well as any other relevant stakeholders.
- vii) Enhance the reputation of the university as an academic research institution and a member of society as well as the reputation of the Researchers through bridging the research results to public use and benefit to the society.

2. Definition of Terms

Commercialization:

Means any form of exploitation of Intellectual Property, including assignment, licensing, exploitation within the institute and commercialization via a spin-off-enterprise.

Copyrighted works:

Means literary, scientific and art works including academic publications, scholarly books, articles, lectures, musical compositions, films, presentations and other materials or works other than software, which qualify for protection under the copyright law.

Institute Resources:

Means any form of funds, facilities or resources including equipment, consumables and human resources provided by the university either in a direct or indirect way.

Intellectual Property:

Means inventions, technologies developments, improvements, materials, compounds, processes and all other research results and tangible research properties, including software and other copyrighted works

Intellectual Property Rights (IP Rights):

Means ownership and associated rights relating to intellectual Property, including patents rights in utility model, plant breeders rights, rights in designs, trademarks, topography rights, know-how, trade secrets and all other intellectual or industrial property rights as well as copyrights, either registered or unregistered and including applications or rights to apply for them and together with all extensions and renewals of them, and in each and every case all rights or forms of protection having equivalent or similar effect anywhere in the world.

Inventor:

Means the Researcher who contributed to the creation of the intellectual property.

Research Agreement:

May refer to Research Service Agreement, Cooperative Research and Development Agreement, Material Transfer Agreement, Confidentiality Agreement, Consultancy agreement and any other type of agreement concerning research pursued by Researchers and/or intellectual Property created at the university.

Researcher means:

- i. Persons employed by the university, including student employees and technical staff.
- ii. Students, including graduate and postgraduate students of the university.
- iii. Any persons, including visiting scientists.

Who use the university resources and who perform any research activity at the university or otherwise participate in any research project administered by the university, including those funded by external sponsors.

Spin-off:

Means a company established for the purpose of exploiting Intellectual Property originating from the university.

Visiting Researcher:

Means individuals having an association with the university without being either employees or students. Visiting Researchers includes academic visitors, individuals with honorary appointments in the university and emeritus professors.

3. Scope of the Policy

The policy document of the Sabaragamuwa University of Sri Lanka covers the following aspects.

- 3.1. This policy shall apply to all intellectual property created on or after **2018.09.01** and all IP Rights associated with them.
- 3.2. This Policy shall apply to all Researchers who have established legal relationship with the university based on which the researcher is bound by this policy. Such a 3 legal relationship may arise pursuant to the provision of law, collective agreement or individual agreement.
- 3.3. The Present policy shall not apply in cases in which the Researcher entered into an explicit arrangement to the contrary with the university before the effective date of the Policy, or the university previously entered into an agreement with a third party concerning rights and obligations set out in this policy.

4. Legal Issues Concerning the Status of Researchers.

- 4.1. The person exercising the authority of employment on behalf of the institute shall ensure that the employment contract or other agreement establishing any type of employment relationship between the university and the Researcher includes a provision placing the Researcher under the scope of the Policy.
- 4.2. Students of the university shall be required to sign an agreement to be bound by this policy before commencing any research activity.
- 4.3. Postgraduate students enrolling in research doctoral programs shall be required to sign an agreement to be bound by this policy upon registration.
- 4.4. The person authorized to enter into an agreement on behalf of the university shall ensure that Researchers not employed by the university including visiting Researchers shall sign an agreement to be bound by this policy and an assignment agreement in respect of ownership of IP created by them in the course of their activities that arise from their association with the university before commencing any research activity at the university.
- 4.5. Notwithstanding paragraph 4.4, special arrangements may be needed to meet prior obligations of Visiting Researchers. Any such request special arrangements shall

be assessed and decisions shall be taken on a case-by-case basis by the person or committee designated by the university.

- 4.6. Special arrangements may be needed for research activities pursued by a Researcher employed by the university but working in another institution as academic visitor. In such cases the Researcher may be required by a third party to sign any document which might affect the Institute's IP Rights. In order to avoid any subsequent disputes, the Researcher is not permitted to sign any such documents without the written approval of the person or committee designated by the university. The approval shall not be denied if no Institute IP Rights are being affected. If such a document affects the university's IP Rights, the university shall initiate negotiations to enter into an agreement with the third party, as described in Section 5.
- 4.7. Rights and obligations under this Policy shall survive any termination of enrollment or employment at the university.

5. External sponsorship, research collaboration with third parties

- 5.1. It is the responsibility of the Researcher to ensure, that prior to commencing any research activity in collaboration with any third party, the terms and conditions of cooperation be set forth in a written agreement (herein after referred to as Research Agreement.)
- 5.2. Researchers shall not have the right to enter into a Research Agreement with third parties on behalf of the university unless they are authorized to do so by an official representative of the university.
- 5.3. Persons acting for, and on behalf of, the university shall exercise all due diligence when negotiating agreements and signing contracts that may affect the university's IP Rights.
- 5.4. In certain cases it may be beneficial to the university to enter into Research Agreements that are exceptions to the provisions of this Policy with external sponsors of research and other third parties.
- 5.5. Depending on the relative intellectual and financial contributions of the university and the third party to the conception of the Intellectual Property, it may be appropriate for either cooperating party to obtain certain IP Rights and/ or share in the revenue generated from its commercialization.
- 5.6. In the absence of such an agreement defined in Paragraph 5.1., it is the policy of the university that IP Right shall be distributed among the cooperating parties in the proportion that reflects the proportions of contributing to the creation of the Intellectual Property.
- 5.7. In order to enable the cooperating parties to establish such proportions defined in Paragraph 5.6. And to prevent subsequent disputes. It is expedient that the parties

maintain regular, well-documented records of the research activities pursued, signed by all of them.

- 5.8. The agreement set forth in Paragraph 5.1. Shall include, inter alia provisions with respect to the following.
 - 5.8.1. IP and associated rights already existing at the university prior to entering into the agreement;
 - 5.8.2. IP and associated IP Rights arising from research activities set out in the agreement, after entering into it;
 - 5.8.3. Confidentiality requirements;
 - 5.8.4. Terms of public disclosure;
 - 5.8.5. Other relevant provisions.
- 5.9. Any confidentiality provision of a Research Agreement aiming at the delay of public disclosure for the purpose of protection should not usually of the intent to publish.
- 5.10. Before signing, the full copy of the proposed agreements and other legal statements concerning the university's IP Rights shall be submitted to the person or department designated by the university for advice and approval.

6. Ownership of Intellectual Property

- 6.1. Employees of the university
 - 6.1.1. All rights in Intellectual Property devised, made or created by an employee of the university in the course of his or her duties and activities of employment shall generally automatically to the university.
 - 6.1.2. If an employee of the university creates Intellectual Property outside the normal course of his or her duties of employment, with the significant use of university Resources he or she will be deemed to have agreed to transfer the IP Rights in such Intellectual Property to the university as consideration for the use of Institute Resources.
 - 6.1.3. Intellectual Property as defined in Paragraph 6.1.1., created in the course of, or Pursuant to a sponsored research or other type of agreement with a third party, Shall initially belong to the Institute and then ownership shall be determined according to the terms of such agreements (in accordance with Section 5). Section 6.1. shall apply to student employees of the university.
- 6.2. Employees pursuing research activities at other institutions/universities
 - 6.2.1. Rights related to Intellectual Property that is created during an academic visit by the employee of the university to another institute/university shall

be governed by an agreement between the university and the other institute/university (in accordance with Paragraph 4.6.). If the university's IP Rights are not affected, the IP created during the visit shall belong to the other institute/university unless otherwise provided in an agreement.

6.3. non-employees

6.3.1. Visiting Researchers are required to transfer to the university any Intellectual Property they create in the course of their activities arising from their association with the university. Such individuals will be treated as if they were university employees for the purposes of this Policy.

6.4. Students

6.4.1. Students who are not employed by the university shall own all Intellectual Property and associated IP Rights they create in the normal course of their studies. However, the following exceptions shall apply.

6.4.1.1. If a student is offered a studentship sponsored by a third party under a separate agreement, under which the third party has a claim on Intellectual Property shall initially belong to the university and ownership will then be determined in accordance with the terms of the agreement concluded with the third party.

6.4.1.2. Intellectual Property created by students in the course of, or pursuant to, a sponsored research or other agreement with a third party shall initially belong to the university and ownership will then be determined in accordance with the terms of the agreement concluded with the third party.

6.4.1.3. If a student creates Intellectual Property with the significant use of university Resources in connection with his or her research activity, he or she will be deemed to have agreed to transfer the IP Right in such Intellectual Property to the university as consideration for the use of university Resources.

6.4.1.4. The university shall claim ownership of all Intellectual Property created in the course of postgraduate (doctorate) students' research activity.

6.4.2. Students shall be given the option to assign IP Rights to the Institute and shall then be granted the same rights as any employee Inventor as set out in this policy. In such cases students should follow the procedures set out in this Policy. All right in Copyrighted Works is owned by their creators regardless of the use of Institute Resources. Copyrighted Works specifically commissioned by the university or developed in the performance of a sponsored research or other third party agreement shall constitute an exception where the provisions of such agreement shall be

taken into account. If the university cannot, or decides not to, exploit any Intellectual Property to which it lays claim, it shall forthwith notify the Inventor(s). The notification shall be made at least one month prior to any act or any intentional omission liable to prevent the obtainment of protection. In such cases the Inventor(s) shall have the option to acquire related IP Right; however, the university may claim a share from the income of any subsequent exploitation of the Intellectual Property to the extent equaling the verified expenditures of the university incurred in connection with the protection and commercialization of such IP. The university may also claim for a perpetual non-exclusive royalty-free license for research purposes without the right to business exploitation and without the right to sub-license. The university may also claim for a 20% percentage of any net income generated by the Inventor(s) from the commercialization of the Intellectual Property. The university shall not unreasonably withhold or delay an assignment of the IP Rights to the Inventor(s); however it reserves the right to delay exploitation where it is in interests to do so. Requests for any transfer of rights from the university to the Inventors(s) or any other Third party should be made in the first instance to the person or department designated by the Institute.

7. Conflict of interest and confidentiality

- 7.1. A Researcher's primary commitment of time and intellectual contributions as an employee of the university should be to the education, research and academic programs of the university.
- 7.2. It is the responsibility of each Researcher to ensure that their agreements with third parties do not conflict with their obligations to the university or this Policy. This provision shall apply in particular to private consultancy and other research service agreements concluded with third parties. Each Researcher should make his or her obligations to the university clear to those with whom such agreements may be made, and should ensure that they are provided with a copy of this Policy.
- 7.3. Researchers shall keep the university's affairs in confidence. In terms of this Policy, inter alia, every fact, information, solution or data related to the research carried out at the university, whose public disclosure, or its acquisition or exploitation by unauthorized persons could damage or endanger the university's lawful financial, economic or market interest shall qualify as university business affairs diligence regarding confidentiality provisions.
- 7.4. Should any doubt arise concerning conflict of interest or department designated by the university.

- 7.5. Researchers shall promptly report all potential and existing conflict of interest to the Director UBL in order to reach solution satisfactory to each concerned party.

8. Identification, disclosure and commercialization of Intellectual Property

- 8.1. The Institute encourages its Researchers to identify research results with potential commercialization value and which may enhance the reputation of the university through bringing them to public use and benefit.
- 8.2. The Director of the UBLC of the university is responsible for the protection and commercialization of the Institute's Intellectual Property. The Inventor(s) however, shall be consulted in each phase of the procedure.
- 8.3. Researchers shall be required to present in writing the draft publications containing scientific results to the relevant Head of Department before publishing them, and shall state in writing that, to the best of their knowledge such works do not contain any results for which protection may be obtained or which can be exploited in any way.
- 8.4. Researchers, including employees, students and Visiting Researchers are obliged to disclose all Intellectual Property falling within the scope of Paragraph 6 to Director of the UBLC.
- 8.5. Copyrighted Works shall be excluded from the disclosing obligation set out in Paragraph 8.3., except for those which were developed in the performance of a sponsored research or other third party agreement.
- 8.6. Since protection and successful commercialization of Intellectual property might depend on prompt and efficient administration, Inventors are required to disclose all potentially exploitable Intellectual Property as soon as they become aware of them. The disclosure must be made in writing by completing the Intellectual Property disclosure form available in the UBLC to the Director UBLC.
- 8.7. Inventors shall fully disclose all research activities and results relevant to the Intellectual Property and provide information about themselves, Property and the circumstances under which it was created. The detailed description of the Intellectual Property shall be presented in such a manner that the inventive activity involved and its novelty as well as its susceptibility of industrial application become explicit and clear-cut for a person skilled in the art.
- 8.8. In case of incomplete disclosure, the form may be sent back to the Inventor(s) requesting for additional information. The date of disclosure shall be the day on which the Director UBLC receives the full disclosure signed by all Inventors.
- 8.9. If an Inventor is in any doubt whether an Intellectual Property falls within the scope of Paragraph 6 or it is potentially commercially exploitable, then the Inventor should submit a disclosure to Director UBLC for consideration prior to making public disclosure of the Intellectual Property.

- 8.10. Premature disclosure may compromise the protection and commercialization of Intellectual Property. To avoid any loss of potential benefits, Researchers are required to make reasonable efforts to identify Intellectual Property early in the development process and consider the consequent impacts of any public disclosure.
- 8.11. After full disclosure of all relevant information the Director UBLC shall record the Intellectual Property in its register.
- 8.12. The Director UBLC shall determine whether any agreement provided for the sharing of IP Rights or other obligations overriding those set out in this Policy. Provisions of related Research Agreements may require the assignment of certain IP rights in full or in part. In case of assignment, the procedure for protection and commercialization shall be governed by a separate agreement concluded between the university and other concerned parties. In all other cases the procedure set out in this Policy shall apply.
- 8.13. The Director UBLC shall notify the relevant Head of Department about all disclosures. The notification involves a short abstract of the Intellectual Property and the name of the Inventor(s).
- 8.14. After the date of disclosure, the Director UBLC of the university shall immediately commence the evaluation of the Intellectual Property. As a first step, a pre-evaluation shall be carried out to identify any major obstacles, which could hinder the protection and commercialization of the Intellectual Property. Based on the results of the pre-evaluation a recommendation on whether to protect and exploit the Intellectual Property shall be forwarded to the person or committee taking the final decision on behalf of the university. Such a recommendation shall be forwarded within 14 days from the date of disclosure. The final decision shall be taken within 21 days from the date of disclosure.
- 8.15. The Inventor(s) shall be informed of the decision within 30 days from the date of decision in writing. If the Institute decides not to commercialize the disclosed Intellectual Property, then the provisions of paragraph 6.6. shall apply.
- 8.16. The Director shall carry out a complete evaluation of the Intellectual Property with particular attention on possible methods of the protection of the Intellectual Property and its business opportunities.
- 8.17. The Inventor(s) shall closely cooperate with the Director UBLC. Inventor(s) are required to give reasonable assistance in protecting and commercially exploiting the Intellectual Property by providing information, attending meetings and advising and advising on further development.
- 8.18. The Director UBLC shall, within reasonable time, commence the process for acquiring legal protection, if needed, and he/it shall proceed with all due diligence to obtain protection. Public disclosure of research results made before obtaining the right of priority concerning a specific Intellectual Property application, highly

jeopardize the proper protection of the related IP Rights. Therefore Inventor(s) are requested to avoid any public disclosure of research results prior to filing such applications. The Institute shall endeavor to avoid undue delays in publications.

- 8.19. The Director UBLC and the Inventor(s) shall jointly determine an appropriate commercialization strategy as part of the evaluation process within 3 months from the date of institute's decision. The strategy will outline the tasks of each concerned party in the commercialization process and establish deadlines for the specific actions.
- 8.20. The Director UBLC of the university shall be responsible to carry out the commercialization plan and it shall submit specific proposals, such as draft agreements or business plans, to the person or committee appointed by the Institute, for decision.
- 8.21. Commercial decisions, such as the ones concerning the terms of an assignments/licensing agreement or establishment of a spin-off enterprise, shall be taken on a case-by case basis by the UBLC advisory board of the university, giving due consideration to all circumstances.
- 8.22. The university may decide not to apply for registered industrial property protection or may withdraw an unpublished application, if it is more appropriate for the purpose of commercialization to treat the Intellectual Property as a confidential know-how. In such cases Inventor(s) shall be requested in writing to refrain from any public disclosure of the Intellectual Property. When choosing this option, however, the university shall take the Researchers' freedom to publish as well as public interest into account.
- 8.23. If the university decides to discontinue an application, to withdraw it, or not to maintain a granted or registered right, the provisions of Paragraph 6.6. shall apply. Such decisions shall be taken by the person or committee designated by the University.
- 8.24. Intellectual Property not falling within the scope of Paragraph 6 may also be disclosed to the university by Researchers under the terms of this Policy. In such cases the university shall decide, within 14 days from the full disclosure of all relevant information, whether to exploit the Intellectual Property. If the university decides to undertake the protection and commercialization of the Intellectual Property, the rules set out in this Policy shall apply.
- 8.25. Expenses incurring in connection with the protection and commercialization of Intellectual Property shall be borne by the university in agreement with the Director UBLC.
- 8.26. During the evaluation and commercialization period the full description of the Intellectual Property shall be disclosed to third parties under a confidential agreement.

9. Recording and maintenance of the Institute's Intellectual Property portfolio

- 9.1. The Director of UBLC of the university shall maintain records of the university's Intellectual Property in an appropriate form and in sufficient detail. It shall monitor the deadlines for the payment obligations related to the maintenance of protected Intellectual Property, and shall, within reasonable time, inform the Director of UBLC of the university.
- 9.2. The Director of UBLC of the university shall maintain accounting records on each Intellectual Property. He or she shall ensure that the Intellectual Property be recorded in the accounting records, that any costs incurred be paid in due course and that the revenues from exploitation be distributed.

10. Distribution of revenues, motivation Researchers

- 10.1. The university provides an incentive to Inventor(s) by distributing revenue generated from the commercialization of the Intellectual Property.
- 10.2. The expression 'net income' shall mean all license fees, royalties and any other monies received by the Institute, arising from the commercialization of Intellectual Property less all the expenses incurred in connection with the protection and commercialization of the Intellectual Property at the university.
- 10.3. The share of revenues from Net income shall be as follows.

| Net income | Inventors | Department | Institute |
|-------------------|------------------|-------------------|------------------|
| Inventions | 80% | 15% | 5% |
| Consultancy | 85 % | 10% | 5% |

- 10.4. In cases where there is more than one Inventor, the Inventor's share is divided between the Inventors in a proportion which reflects their respective contribution as provided in the signed Invention Disclosure Form.
- 10.5. In certain cases the university reserves its right to negotiate special terms concerning revenue distribution, in particular when income is generate through sale of shares or payment of the dividend of shares in cases where shares have been allocated to the Institute in an entity to which the Intellectual Property is Licensed or assigned but which is not a spin-off enterprise.
- 10.6. In case of establishing a spin-off enterprise, an individual agreement between the university and the Inventor(s) shall be applicable regarding the share of equity. The conditions of the agreement shall be negotiated on a case-by-case basis

having due regard to the contribution of the Inventors to any further development and the exploitation beyond the creation of Intellectual Property and to any funding provided by the Inventor(s), the university or any third parties acquiring a share of equity in the new enterprise. The decision concerning the conditions of a spin-off establishment shall be taken by the university council.

- 10.7. In case of exploitation of trademarks and other indicators, the Inventor(s), taking into consideration the proportion of their contribution to the exploitation, may benefit from the revenue as set forth in an individual agreement. The advisory board of the UBLC of the university shall decide on such issues on a case-by-case basis.

11. Breach of the rules of this Policy

- 11.1. Breach of the provisions of this Policy shall be dealt with under the normal Procedures of the university in accordance with the relevant provisions of law.

12. Dispute and appeals

- 12.1. In the first instance, disputes shall be dealt with by the UBLC advisory board and decisions will be referred to the university council. A decision shall be taken within 30 days from the submission of the concern. Over and beyond the above, with respect to any legal dispute arising in connection with the rules of this Policy, the relevant provisions of law shall be applicable.

13. Entry into force of the Policy

- 13.1. This Policy shall come into effect on from the date of council approval is granted
- 13.2. All agreements concluded by the university and Researcher(s) at an earlier time shall be governed by the provisions of the Policy in effect at the time of the signing of such contracts.

Professor DAI Dayaratne
Director/ University Business Linkage Cell
Sabaragamuwa University of Sri Lanka