

## NATIONAL UNIVERSITY OF SINGAPORE

### Policies Relating To Inventions, Innovations And Other Works

#### A. Introduction

1. The University is a publicly funded organisation with a dedicated mission to create, disseminate and apply knowledge through research and education for the benefit of Singapore and its people and the global community as a whole.
2. In the process of creating, disseminating and applying knowledge, Intellectual Property is developed or created by University Members primarily in the form of patents to inventions and innovations as well as copyright to written and audio visual and other works.
3. In order to ensure that the knowledge created through research and education in the University will reach and benefit the wider community in Singapore and the world, the University encourages publication and/or application of such knowledge. One of the methods to apply the knowledge is through commercialisation of this Intellectual Property for the greater good.
4. Consistent with the University's mission, the University wishes to ensure that the dissemination and application of Intellectual Property through commercialisation is properly administered for the benefit of the University, the University Members and the Singapore and global communities.
5. The main purposes of the IP Policies set out in this document are:
  - (a) to clarify and regulate the protection, management and commercialisation of University Intellectual Property;
  - (b) to delineate the rights and obligations of the University and the University Members with respect to the Intellectual Property created or developed in the course of University Research;
  - (c) to motivate the creation, development and dissemination of Intellectual Property by providing appropriate financial rewards to the creators and the University.

#### B. Definitions

1. In these Policies, unless the context otherwise requires, the following expressions shall have the following meanings:-
  - (a) "Authored Work" means an original work of authorship produced by University Members including:

- (i) Student theses and dissertations,
  - (ii) books, journal articles, texts, glossaries, bibliographies, study guides, syllabi, tests, proposals,
  - (iii) teaching materials including lectures recorded on audio and/or visual recordings and lecture notes,
  - (iv) examination scripts, project reports submitted by a Student;
  - (v) musical or dramatic compositions and unpublished scripts,
  - (vi) films, film strips,
  - (vii) charts, transparencies and other visual aids,
  - (viii) audio-visual material, live video or audio broadcasts and programmed instruction materials and sound recordings,
  - (ix) choreographic works, and
  - (x) pictorial, graphic and sculptural works.
- (b) "Copyrighted Work" means an original work of authorship, which has been fixed in any tangible medium of expression, now known or later developed, from which it can be perceived, reproduced or otherwise communicated either directly or with the aid of a machine or device. Copyrighted Works include, but are not limited to, Authored Works, Software, technical designs, formulas and codes, designs and mask works and research data.
- (c) "Electronic Medium" shall include but not be limited to digital optical and magnetic information storage and retrieval platforms or systems (including but not limited to videos floppy disk-based software CD-ROM CD-I DVD-ROM DVD-RAM interactive software compact discs, ROM-card silicon chip and any other similar or dissimilar offline platforms or systems) on-line electronic or other transmission (including but not limited to satellite or microwave transmission video-on-demand and/or near near-video-on-demand and the Internet) and the Digital Library (or any such digital online collection developed and maintained by the University) whether now known or subsequently developed.
- (d) "Integrated Circuit Design" means the layout design of an integrated circuit protected under the Layout-Design of Integrated Circuits Act 1998.
- (e) "Intellectual Property" means any new and useful invention (whether patentable or not), discovery, process, machine, composition of matter, life form, article of manufacture, patents, Copyrighted Work, Integrated

Circuit Design, design rights, Software, Trade Mark, Tangible Research Property, know-how, Trade Secrets, new or improved devices, circuits, chemical compounds, drugs, genetically engineered material (including but not limited to plasmids, virus, bacteria and cell lines), data sets, musical processes, unique and innovative uses of existing inventions and any other intellectual property right.

- (f) “ILO” means the University's Industry Liaisons Office.
- (g) "Invention Disclosure Form" means the Invention Disclosure Form substantially in the form attached to these Policies as amended from time to time.
- (h) “Inventor” means a person who
  - (i) has conceptualized the invention or has made intellectual contributions to the conception of a piece of Intellectual Property or
  - (ii) has made creative contributions leading to the said piece of Intellectual Property.
- (i) "Net Revenue" means the Revenue less the expenses referred to in Policy H3.
- (j) “Public Disclosure” means a disclosure to the general public including, but not limited to, journal publication, magazines libraries, internet, student theses, e-mail, published grant proposals, poster presentation, oral presentations at the university, at conferences, and at companies, advertisement, sale, demonstration or use in public, that is in sufficient detail to allow your scientific peers, or someone that is “skilled in the art,” to understand and recreate the Intellectual Property. It can also mean disclosure of the Intellectual Property to any other person not bound by express confidentiality obligations under a written Non Disclosure Agreement.
- (k) "Revenue" means all consideration received by the University pursuant to the commercialisation of the Intellectual Property including:
  - (i) license fees, including upfront fees, running royalty, license maintenance fee, commissions and sublicensing fees arising from the license of the Intellectual Property; and/or
  - (ii) proceeds arising from the sale of the Intellectual Property, to a Third Party, whether in the form of cash or Shares but does not include any reimbursement of expenses (including patent costs, patent maintenance fees received under any license agreement), or research funds.

- (l) "Policies" means these Policies Relating To Inventions And Innovations And Other Works as the same may be amended from time to time.
- (m) "Shares" means "share" as defined in section 4(1) of the Companies Act (Cap. 50).
- (n) "Software" means any computer software or program whether in source or object code and other technologies used to support the electronic capture, storage, retrieval, transformation and presentation of digital data and information or to interface between digital forms and other communications and information media.
- (o) "Student" means any registered student of the University and includes all undergraduate and postgraduate students and exchange students, whether studying full-time or part-time at the University, regardless of whether the student receives financial support from the University or from Third Party sources.
- (p) "Third Party Contract" means any contract or agreement between the University and a Third Party for the conduct of research, teaching or student exchange programmes, license agreements, contracts of assignment or contracts of sale, etc.
- (q) "Third Party" means any person other than the University and the University Member and includes funding agencies, another research institution or a commercial company.
- (r) "Trade Mark" means a trade or service mark as defined as such under the Trade Marks Act 1998.
- (s) "Trigger Date" means the date to be determined by the University from which the University Member may freely deal with his/her Shares.
- (t) "University Member" means NUS Staff and/or Students, as the context so requires.
- (u) "NUS Staff" means any employee who is under a contract of employment with the University including academic research and administrative staff, adjunct and part time staff
- (v) "University Research" means all and any activities conducted:
  - (i) in the course of the University Member's employment or study at the University (where applicable); and/or
  - (ii) with the use of University Support.
- (w) "University Support" means

- (i) financial and other support either directly from or channeled through the University regardless of origin; and/or
  - (ii) substantial use of the University Resources (the use of the University's office space, personal computers and libraries shall not be considered as "substantial use"); and/or
  - (iii) supervision of NUS Staff and/or intellectual input in the form of know how or other background information of NUS Staff,  
  
for the development of the Intellectual Property.
- (x) "University Resources" means University's facilities, personnel, equipment or confidential information and Intellectual Property owned by or licensed to the University;
  - (y) "Visitor" means any person other than a University Member who takes part in any research project or scholarly activity which is conducted by a University Member as a visitor of the University or who visits any part of the University in which research or scholarship, or any related activity, is conducted at the time they create Intellectual Property.
2. In these Policies words importing the singular shall include the plural and vice versa and words importing the masculine shall include the feminine and neuter and vice-versa.
  3. References to person shall include bodies corporate and incorporated associations and partnership.

### **C. Responsibilities of University Members**

1. All University Members, including all persons receiving funding administered by the University or receiving other compensation from the University, all undergraduate students and all graduate students and post-doctoral fellows regardless of funding or employment status, have a responsibility to:
  - (a) adhere to the guidelines embodied in these Policies;
  - (b) create, retain, and use Intellectual Property according to the applicable local and international laws and University policies;
  - (c) maintain confidential all confidential information, whether made/developed on his/her own, in collaboration with University colleagues or students, or acquired through discussions (whether formal or informal) with University colleagues or students or Third Parties where the University Member is aware or should reasonably be aware that the information was obtained subject to an obligation of confidentiality;

- (d) disclose promptly in writing Intellectual Property owned by the University pursuant to these Policies or created pursuant to funded research or other contractual arrangements with Third Parties and in accordance with Article D1(a). Where required by the University, the University Member shall formally assign all title and interests to such Intellectual Property to the University or its designee to enable the University to satisfy the terms of any applicable Third Party Contracts or patent application or other regulatory requirements. Failure by the University to formally obtain an assignment of the University Member's interests in any Intellectual Property belonging to the University does not negate the University's rights to the Intellectual Property under these Policies;
- (e) promptly disclose to ILO the identity of
  - (i) any party who has made an inventive contribution to the Intellectual Property; and
  - (ii) 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;
- (f) promptly disclose any conflict of interest as required by the University and set out in the HR Guidelines for Conflict of Interest Policy for NUS Staff;
- (g) provide all reasonable assistance and co-operation with the University to secure, protect and commercialise the Intellectual Property, including:
  - (i) providing information and executing documents which may be required to obtain patent, copyright, or other suitable protection for the Intellectual Property developed by the University Member;
  - (ii) providing assistance in legal actions taken in response to infringement prosecutions and defences; and
  - (iii) assist, when Intellectual Property protection is secured, in the marketing and promotion of Intellectual Property as and when required;

2. If the Student or Visitor is also an employee of a Third Party, then it is the responsibility of the Student or Visitor to:

- (a) promptly disclose to the University any potential conflicts of policies in respect of Intellectual Property created or developed by

the Student or Visitor at the University between the University and the Third Party; and

- (b) work with the University to resolve any potential conflicts of policies between the University and the Third Party.

#### **D. Disclosure of Intellectual Property**

1. If a University Member becomes aware of Intellectual Property first conceived or reduced to practice in the course or furtherance of University Research which the University Member:

- (a) is of the opinion can be commercialised; and
- (b) wishes to commercialise, then

the University Member shall promptly report the Intellectual Property to ILO .

2. All reports to ILO shall be made on the Invention Disclosure Form which must be accompanied with all relevant details of the Intellectual Property. Signed copies of the Invention Disclosure Form should be concurrently submitted to the University Member's project supervisor and/or Head of Department. The Invention Disclosure Form may be obtained from the ILO website at [www.nus.edu.sg/ilo](http://www.nus.edu.sg/ilo).
3. As any public disclosure of information can potentially jeopardize the patenting rights of the University, the University Member is prohibited from making any form of public disclosure (including verbal disclosures) of the University's Intellectual Property until such time as the University has:
  - (a) filed a protection for the Intellectual Property in question; or
  - (b) made the determination not to file for protection for the Intellectual Property in question.

#### **E. Ownership of Intellectual Property**

1. Unless otherwise expressly specified in the Policies, all rights, title and interest in Intellectual Property discovered, created or developed in the course or furtherance of University Research shall vest in and belong to the University.
2. Intellectual Property discovered, created or developed in the following circumstances shall be deemed to have been discovered, created or developed using University Support and thus deemed to be in the course or furtherance of University Research:

- (a) Intellectual Property developed by the University Member in the course of his/her participation in a research project funded by or through the University;
  - (b) Intellectual Property developed by the University Member with the assistance of funds provided by or through the University;
  - (c) Intellectual Property developed with the substantial use of University Resources.
3. In addition, Intellectual Property discovered, created or developed in the following instances shall be deemed to be discovered, created or developed in the course of University Research:-
- (a) Intellectual Property discovered, created or developed by the University Member in fulfilment of his/her contract of employment as a staff member even if discovered, created or developed without use of University Support; or
  - (b) Intellectual Property discovered, created or developed by the University Member for the purpose of commercial exploitation if such Intellectual Property falls within the area of expertise of the University Member for which he/she was hired by the University or is related to his/her duties as a University Member.
4. Intellectual Property discovered, created or developed by a University Member in his/her own time and outside the scope of University Research is not owned by the University. The University shall be the sole arbiter as to whether any Intellectual Property is discovered, created or developed in the course of University Research. In making any such determination, the University will consider whether:
- (a) there has been use of University Support to justify owning the Intellectual Property discovered, created or developed by the University Member.
  - (b) the Intellectual Property is in an area outside the University Member's broad field of expertise;
  - (c) the University Member is able to show evidence that the activities leading to the invention is conducted outside the scope of University Research; and
  - (d) the University Member is able to show evidence (eg. receipts, invoices, contracts, etc) that the Intellectual Property was discovered, created or developed solely with his/her own resources and without the use of University Support.

## **F. Exceptions to Policy E**

1. Notwithstanding Policy E, the following exceptions are applicable:
2. **Authored Works:**
  - (a) The copyright to an Authored Work shall be owned by the University Member who authored it except under the following circumstances:
    - (i) If the Authored Work is created in the course of or pursuant to a specific agreement between the University and University Member or between the University with another institution or entity, copyright ownership is subject to the terms on Intellectual Property ownership set out in the relevant agreement; or
    - (ii) If the Authored Work is created by a non-academic University Member in pursuance of the terms of his employment with the University; or
    - (iii) If the Authored Work is commissioned by the University or is created at the direction of the University for a specific University purpose; or
    - (iv) If the Authored Work is created using funds provided by or through the University for the specific purpose of creating that Authored Work.
  - (b) In the interests of clarity, the University Member agrees and accepts that except for Authored Works, copyright ownership of all other Copyrighted Works, including:
    - (i) Software;
    - (ii) technical designs including Integrated Circuit Designs;
    - (iii) formulas and codes describing any compounds or material whether biological or not;
    - (iv) mask works;
    - (v) Integrated Circuit Designs, and
    - (vi) research data arising from University Research,shall be owned by the University, even if such Copyrighted Works form part of an Authored Work which is owned by the University Member.

3. **Student theses and/or dissertations:**

- (a) The University acknowledges the Student's ownership of copyright to his/her theses and/or dissertations. However, where the Student's theses and/or dissertations were submitted to the University to meet course requirements, the following provisions shall apply:-
- (i) If the Student's theses and/or dissertations contains patentable ideas or other Intellectual Property the University deems useful, then the University shall be the owner of such ideas or Intellectual Property.
  - (ii) If the Student's theses and/or dissertations contain research data arising from University Research, then the Student's copyright will only extend to the form of expression of the data in the theses. Ownership of the research data and the data base itself remains with the University pursuant to Policy E.
4. The physical document and/or device on which the Student's Authored Work was recorded or stored or printed, which was submitted to the University (for example, the thesis document, the examination scripts, term papers, CDs, DVDs, tapes, etc.) will become the property of the University unless returned to the Student by the University.
5. The University Member shall be deemed to have granted to the University an irrevocable, unconditional, perpetual, transferable, sub-licensable, royalty free license to use, print, publish, reproduce, copy and publicly distribute the University Member's Authored Work, in whatever form, including without limitation the right to publish on the internet or through an Electronic Medium, for the University's teaching, research and academic purposes and any business usual to a university or institution of research and/or higher learning (such as publishing and licensing activities), provided that:
- (a) the University shall acknowledge the copyright ownership of the University Member;
  - (b) the University may, at its absolute discretion, elect to limit its use of this license on such terms as it sees fit.
6. The University may at any time, require an assignment of the University Member's copyright over an Authored Work for the purposes of commercialising the Authored Work and the University Member shall take such action as required to complete the assignment PROVIDED THAT the assignment of copyright will contain terms which will enable the University Member to retain the right to reproduce the text of their Authored Work to ensure that their careers benefit from publishing the results of their work.

7. If the University was to commercialise an Authored Work (for example, through the University's subsidiary NUS Press Pte Ltd or its Centre of Instructional Technology), then the University and the University Member who owns the copyright to the Authored Work shall enter into appropriate agreements to share revenue or make payments in accordance with standard practices and guidelines usual to educational institutions.
8. The University Member shall ensure that he/she:
  - (a) is not in breach; and/or
  - (b) has obtained the consent,

of Third Party owners of copyright or other intellectual property rights to use their works as incorporated in the University Member's Authored Work and a licence back to the University for teaching, research and academic purposes. The University Member shall use reasonable efforts to assist the University to obtain the consent of Third Party owners of copyright and other intellectual property rights if the University seeks to commercialise the Authored Work.

#### **G. Protection and Commercialisation of Intellectual Property**

1. Upon receipt of a full and true disclosure in the Invention Disclosure Form, the University may, in its sole and absolute discretion, determine such means to protect the Intellectual Property or any part thereof including whether to seek patent protection for the Intellectual Property disclosed in the Invention Disclosure Form. The University will usually seek patent protection in order to pursue commercialization of the Intellectual Property. The decision to file for patent protection and the scope of the patent application is based solely on the commercial potential of the Intellectual Property as determined by ILO and not on its scientific merits.
2. The University shall within 3 months from the date of ILO's receipt of the Invention Disclosure Form and full details of the Intellectual Property, notify the University Member whether the University will apply for patent or other protection for the Intellectual Property and/or commercialise the same.
3. For the avoidance of doubt, the University shall not be obliged to seek any such patent or other protection or institute legal or other proceedings with regards to intellectual property infringement or otherwise in respect of the Intellectual Property. If however, the University does decide to seek patent protection for the Intellectual Property, then the University Member who made the inventive contribution to the Intellectual Property shall be named as inventor in the patent in accordance with the applicable patent laws.

4. The University shall be entitled to approach, negotiate and enter into any binding agreement to license, transfer, assign or sell the Intellectual Property owned by the University with any Third Party on such terms and conditions as the University shall in its sole and absolute discretion deem fit.
5. If the Intellectual Property is conceived as a result of a collaboration with and/or funding from a Third Party, then the Intellectual Property will be managed in accordance with the terms of the Third Party Contract.
6. The University Member shall provide all information and render such assistance to the University (and/or its nominees) in respect of the patent or other applications and/or commercialisation of the Intellectual Property as the University may from time to time require, including but not limited to, execution of documents (including assignments), furnishing additional or further information and details, providing assistance in the further formulation of the Intellectual Property, amendments to the patent or other applications, and negotiations with regards to commercialisation of the Intellectual Property. If ILO is of the opinion that insufficient information to assess the commercial potential of the Intellectual Property has been disclosed in an Invention Disclosure, the University, through ILO, may in its absolute discretion, hold the Intellectual Property indefinitely until sufficient information emerges to assess its commercial potential.
7. Where the University Member has submitted or intends to submit an Invention Disclosure, the University Member shall at all times maintain confidentiality of the information relating to the Intellectual Property in accordance with Policy D until such time when informed that the evaluation process has been completed and a decision is made with regards to the protection of the Intellectual Property. Any public disclosure (including verbal disclosure) is strongly discouraged during this period of evaluation as it may potentially jeopardize the patenting process.

#### **H. Revenue from Intellectual Property**

1. Revenue received by the University from the commercialization of Intellectual Property shall be shared between the University Member and the University in the manner and on the terms set out below. For the avoidance of doubt, the term "Revenue" shall not include funds received for research support even if
  - (a) such funds are to be used in connection with the Intellectual Property or the further development thereof; and
  - (b) the commitment to provide such funds is obtained or negotiated together with the agreement in respect of the commercialization of the Intellectual Property.

2. The following costs shall be deducted from all Revenue received prior to distribution in accordance with Policy H3:-
  - (a) First, a proportion of the ILO's overhead costs in relation to administration, utilities, materials, premises and manpower expenses incurred in respect of the relevant Intellectual Property as reasonably determined by the ILO in its sole discretion. Such overhead costs shall not be less than 15% of the total Revenue received; and
  - (b) Second, all costs related and incidental to:
    - (i) the preparation, filing, prosecution and maintenance of patent and other applications in respect of the Intellectual Property;
    - (ii) the commercialization efforts in relation to the Intellectual Property including but not limited to legal costs and marketing expenses; and
    - (iii) defending the Intellectual Property including legal expenses relating to prosecuting infringements of the Intellectual Property, defending allegations of intellectual property infringement, licensing enforcement and contract related proceedings.
3. All Revenue after deductions for expenses and costs as set out in Policy H2 above ("Net Revenue") shall be divided between the University, the University Member and his/her centre, institute or faculty, as the case may be (collectively "Faculty"), as follows:-
  - (a) University Member - 50%
  - (b) Faculty - 30%
  - (c) the University - 20%
4. The University may from time to time, in its absolute discretion, amend or revise the above sharing proportions, provided that any new or amended sharing ratio shall not be applied to Revenue received prior to the amendment or revision.
5. Where the Net Revenue is in the form of Shares the University Member will not be entitled to sell, transfer, trade in, dispose of, charge, mortgage or otherwise encumber his/her part of the Shares until after the stipulated Trigger Date. The University shall have the discretion to distribute such Net Revenue in the form of Shares or the cash value thereof standing as at the date the Shares are issued to the University.
6. The University Member's Shares (if the cash value thereof is not distributed in accordance with Policy H3 above) will be held by the University as legal

owner thereof until the Trigger Date. All voting rights in respect of such Shares shall be exercised by the University in its absolute discretion.

7. The University Member will from time to time be notified, at his/her last known address, of any portion of the Net Revenue due to him. The University Member shall be responsible for collecting all monies due to him from the University and keeping the University updated of his/her most current address and contact details. All monies due to the University Member which are not collected within 12 months of the date of the relevant notification (as evidenced by the University's records) will be forfeited and retained by the University and the University shall not be liable to account thereafter to the University Member or any Third Party.
8. For the purposes of clarity, where a Student has assigned his/her Intellectual Property to the University he/she is entitled to be treated in the same way as NUS Staff for the purpose of sharing in commercial benefits, including financial returns, from the commercialization of the Intellectual Property.
9. In the application of Policy H8, the University shall determine the equitable allocation of financial returns between the Inventors, taking into account:
  - (a) the degree of intellectual input from the supervisor, other NUS Staff and Third Parties;
  - (b) the nature and extent of any University or Third Party Intellectual Property accessed or used by the Student; and
  - (c) the nature and extent of any use a Student makes of University Support; and
  - (d) any other factors which the University considers relevant in making its determination.

#### **I. Assignment Back of Intellectual Property to the Inventor**

1. For the purposes of this Policy I, the Intellectual Property referred to herein shall mean the particular piece of Intellectual Property which the Inventor had conceptualised or to which conception the Inventor had made intellectual contributions to or to which the Inventor had made creative contributions leading to the said piece of Intellectual Property.
2. An Inventor may, at any time, request that the University assigns the Intellectual Property owned by the University to him/her. The University through ILO may make a determination in its absolute discretion whether to assign the Intellectual Property to an Inventor. In determining whether to assign the Intellectual Property to the Inventor under this provision, the University may take into consideration the following:

- (a) Whether it has elected, in its absolute discretion, not to commercialise the Intellectual Property;
- (b) Whether all other Inventors of the Intellectual Property agree in writing to the assignment of the Intellectual Property to the assignee Inventor; and
- (c) Whether the assignee Inventor has agreed to commercialise the Intellectual Property and has submitted a business plan that is satisfactory to ILO.

The University wishes to clarify that it values its Intellectual Property for its educational, as well as commercial, value. Even if the University chooses not to commercialise a particular piece of Intellectual Property, it believes that such Intellectual Property may form one of the building blocks for future research, development and education.

- 3. The terms and conditions of any assignment of the Intellectual Property to the Inventor will be dealt with on a case by case basis by ILO. The University may in its absolute discretion, elect to hold the Intellectual Property owned by it, indefinitely.
- 4. Without prejudice to the generality of Policy I2, the general conditions pursuant to which ILO may agree to assign the Intellectual Property to the Inventor are listed below.
  - (a) The Inventor agrees to develop and commercialise the Intellectual Property in a manner which will benefit the public.
  - (b) The Inventor agrees to reimburse the University for all and any of its costs determined in accordance with Policy H2 if and when the Inventor receives income from exploitation of the Intellectual Property.
  - (c) The Inventor shall not further assign or sublicense the Intellectual Property to any Third Party without the prior written consent of the University;
  - (d) The Inventor agrees to keep the University informed of the progress of development on and commercialisation of the Intellectual Property in accordance with the terms of any assignment agreement.
  - (e) The Inventor shall, at the reasonable request of the University, from time to time allow the University or its agent (or procure that the University or its agent is allowed) to inspect those records and books of account and maintained by the Inventor and/or such other person through whom the Intellectual Property is commercialised and, to the extent that they relate to the calculation of those payments due to the University under the terms of the assignment agreement or these Policies, to take copies of them.

- (f) The Inventor agrees to fulfil any obligations that may exist under any Third Party Contracts which led to the development of the Intellectual Property, e.g. the grant of royalty-free, non-exclusive licences to the sponsor or the sharing of royalty income with the sponsor.
- 5. If the University, after consideration of all the information, has elected not to file patents to protect the Intellectual Property prior to assigning the Intellectual Property to the Inventor under this Policy I, the Inventor shall have full discretion as to whether he/she wishes to file patent or other applications to protect such Intellectual Property. All such patents and other applications, if any, shall be filed in the name of the Inventor and the Inventor shall have full control over the prosecution and maintenance thereof at his/her own cost and expense;
- 6. The Inventor shall indemnify and hold the University harmless from any expense, claim, proceeding, judgment, damages, cost (including legal costs on a full indemnity basis) arising from any intellectual property infringement or product liability claims relating to any assigned Intellectual Property and the Inventor shall ensure that all licences and other agreements with any Third Party relating to such Intellectual Property shall provide for such an indemnity from the Third Party in favour of the University;
- 7. The Inventor shall grant to the University an irrevocable, unconditional, transferable, perpetual, sub-licensable, royalty-free right to use the assigned Intellectual Property for academic and research purposes. In addition, the Inventor agrees to negotiate where necessary, in good faith and on reasonable commercial terms, the grant of a sub-license of the assigned Intellectual Property to a third party licensor of the University's other Intellectual Property, for the third party licensor to use the assigned Intellectual Property as part of its background Intellectual Property.
- 8. The University may require a reversion of the Intellectual Property from the Inventor if:
  - (a) the Inventor fails to perform its obligations; or
  - (b) the Inventor fails to meet its commercialisation milestones,within the agreed period and in accordance with the terms of the assignment agreement.
- 9. The Inventor shall pay to the University license fees and revenues of:
  - (a) up to 15% of gross sales of all products, processes or services which use, embody, incorporate, are based on or derived from the Intellectual Property sold, provided or otherwise disposed of by the Inventor, or his/her sub-licensee or any agent or distributor to end-users; and

- (b) up to 15% of any income including upfront fees, milestone payments and other fees not accounted for by royalty payments (whether in the form of cash, Shares or otherwise) received by the Inventor less any legal and licensing expenses associated with the protection and commercialization of the Intellectual Property incurred by the Inventor;

provided that the University shall be entitled to:

- (i) require that the Inventor pays a greater sum of the license fees and revenue than the amount paid or payable or declared by the Inventor; or
- (ii) terminate the assignment agreement to the Inventor,

if the University takes the view, on reasonable grounds, that any or all sales and/or licensing transactions undertaken by the Inventor are not on arms length basis.

- 10. If an assignment of Intellectual Property to the Inventor was effected under this Policy I, the assignee-Inventor specifically waives any and all rights to receive from the University in connection with the technology, any additional consideration pursuant to the terms of Policy H, with respect to any payment, consideration or benefit derived by the University in connection with the assignment of the Intellectual Property.
- 11. For the purposes of clarity, if an Inventor wishes to license Intellectual Property which the University views as having commercial potential, the University may, at its absolute discretion, enter into a licensing agreement with the Inventor on arms-length commercial terms.

#### **J. Relations with Third Parties**

- 1. If research leading to any Intellectual Property has been funded by a Third Party, whether government or private, or has been conducted in some other form of association with such Third Party, the terms of the Third Party Contract shall override any of these Policies which are to the contrary. If the question of ownership of the Intellectual Property was not established in advance as part of the terms of the Third Party Contract, these Policies shall apply in relation to the said Intellectual Property.
- 2. The provisions of Policy H shall apply to any Revenue which the University may receive pursuant to any such Third Party Contract.

#### **K. Intellectual Property Arising from Consultancy Works**

1. The Consultation Work Scheme of the University encourages NUS Staff who are of the grade of Assistant Professor or above (“Qualified NUS Staff”) to undertake consultation work for Third Parties. Usually, under these consultation arrangements, the Intellectual Property developed or created by the Qualified NUS Staff are owned by the Third Party. The University is concerned that these consultancy work arrangements may:
  - (a) result in leakage of Intellectual Property from the University; and/or
  - (b) restrict the future research progress and direction of the Qualified NUS Staff and, indirectly, that of the University.
2. The Consultation Work Scheme provides that Qualified NUS Staff may undertake consultation work using University facilities and materials subject to the prior approval of the Head of Department. The Head of Department shall notify ILO if the consultation work of the Qualified NUS Staff will involve the substantial use of Intellectual Property owned by the University.
3. If, on ILO’s assessment, the consultation work for the Third Party to be undertaken by the Qualified NUS Staff will require substantial use of the Intellectual Property owned by the University, the Head of Department shall require that the Third Party enter into a research collaboration agreement with NUS to enable the Third Party to access and use the Intellectual Property owned by the University and the research collaboration agreement will include provisions which cover:
  - (i) a license for the University to use the Intellectual Property created under the research collaboration agreement for academic and research purposes; and
  - (ii) ownership of Intellectual Property created under the research collaboration agreement in accordance with inventive contributions of the parties; and
4. The Qualified NUS Staff may enter into a separate consultancy agreement with the Third Party for consultation services.
5. The University shall not normally negotiate or be included in any consultancy agreements on behalf of any Qualified NUS Staff. The Qualified NUS Staff shall be required to follow the Consultancy Work Scheme guidelines.

**L. Publications**

1. The University encourages the prompt publication and presentation of research findings.
2. However, the University may require:

- (a) a delay of up to three (3) months (subject to reasonable extension where the University deems necessary) of any publication or presentation for the filing of any patents; and/or
- (b) the removal of any of its or a Third Party's confidential information in accordance with the terms of a confidentiality agreement or the research agreement for a project.

**M. Administrative Procedures**

1. ILO shall advise the University as to whether the University should take up the commercial exploitation of any Intellectual Property developed by a University Member and shall carry out such other functions as may be allocated to it from time to time.
2. In the event of dispute or disagreement arising between the University and the University Member in relation to the commercial exploitation of any Intellectual Property developed by a University Member or in relation to the receipt of Revenue, fees or commissions from such commercial exploitation, the President and/or his/her nominee shall be empowered to make a ruling on such dispute or disagreement and his/her decision shall be accepted as final by the University Member involved.
3. If a University Member fails to execute any documents and take all actions necessary or desirable to give full effect to the Policies herein, the President or the Provost may execute all such documents and do all such acts as the University Member's attorney. The President or the Provost may exercise this power even if the University benefits from such power.

**N. Settlement of Disputes**

If any dispute arises in the interpretation or application of these Policies, the same shall be referred to the President for his/her decision. The President may appoint an ad hoc committee to investigate the dispute and submit its findings and recommendations to him. The committee shall consist of a combination of University administrators, faculty and/or industry experts as the President deems appropriate given the nature of the dispute, but shall include at least the CEO (NUS Enterprise) or his/her delegate, and it may take all steps necessary to investigate, including interviewing the parties involved in the dispute. The President may take into consideration the committee's findings and recommendations in arriving at his/her decision, which shall be final.

**O. Amendment of Policies**

These Policies or any part of them may be amended by the University in its absolute discretion from time to time and the Policies as amended shall apply to all Intellectual Property disclosed by University Member after the effective date of such amendment. All Intellectual Property disclosed prior to the amendment shall be governed by the Policies prior to such amendment provided that the provisions of Policy H (as amended) shall apply to all Intellectual Property licensed or otherwise commercialised on or after the effective date of any such amendment regardless of when the Intellectual Property is disclosed.

**P. Policies for Visitors**

Visitors shall be bound by the Policies unless specifically exempted or varied by written agreement with the University. Visitors are therefore required to disclose any Intellectual Property with commercial potential that he/she creates or develops while at the University. The commercialisation of that Intellectual Property and sharing of any net commercial benefits will be negotiated on a case-by-case basis, with the Visitor and the Visitor's employer and any relevant Third Party. The University will recognise the publication rights of Visitors subject to any overriding commercial imperative.

**Q. Waiver of Policies**

The President shall have the discretion to waive any or all of the provisions of these Policies in a particular case.