



# **UNIVERSITI BRUNEI DARUSSALAM**

## **INTELLECTUAL PROPERTY POLICY**

**15 March 2010 (Final)**

# **UNIVERSITI BRUNEI DARUSSALAM INTELLECTUAL PROPERTY POLICY**

This Intellectual Property Policy (“the IP Policy”) of Universiti Brunei Darussalam (“the University”) sets out the terms and rules of the creation, development, management, protection, exploitation and ownership of Intellectual Property rights (IPR) created by the University’s employees, students and associates including visitors to the University (“employees and students”). This IP Policy may be supplemented or varied from time to time by guidelines made in accordance with the University’s rules, procedures and regulations as and when necessary.

This IP Policy shall come into effect from the date hereof (“the implementation date”) and shall apply to the University’s employees and students as well as those who have beneficial, legal or contractual relationship with the University.

## **1. Introduction**

It is the University's intention to implement an IP Policy that will regulate and encourage creativity through Inventions, innovative works and other intellectual creations as well as the protection and dissemination of the results of the University’s research activities in diverse fields of Intellectual Property for the benefit of the public.

The creation and development of Intellectual Property (IP) at the University would encourage new business ventures through licensing, technology transfer and commercialization as well as facilitate University-Industry links.

It is therefore in the best interest of the University to adopt an IP Policy that encourages disclosure of discoveries, innovations and Inventions so as to reward such creative activities. The University acknowledges that all Intellectual Property rights must be protected under the relevant IP laws currently in force before publication or disclosure to the public.

As such, this IP Policy is intended to protect the interests of all the University’s Intellectual Property by ensuring that the benefits of such Intellectual Property accrue to the public, to the University and to the Inventor. The protection or rewards may include monetary returns or rewards and recognition, as applicable.

This IP Policy is therefore intended to safeguard, protect, exploit and facilitate the commercial development of Intellectual Property created at the University. It is also to provide an incentive to the University's employee and students as well as associates to participate in such innovation and Invention, while acknowledging the University's ownership and role in the discovery and dissemination of knowledge.

## **2. Objectives**

The objectives of the University’s IP Policy concerning Intellectual Property assets and rights

including patents, trademarks, copyright, industrial designs, industrial circuits, layout designs, creative works, trade secrets, know-how, discoveries and confidential information shall be in accordance to the following:

- i. To pursue the mission of the University's academic policy as an established institute for learning and scholarship, professional development and excellence in research as an embodiment of the aspirations of the Brunei Darussalam people and the global community;
- ii. To make available all the Intellectual Property assets created by the University's employees and students to be commercialized to the public;
- iii. To provide reasonable incentives, rewards, income generation and recognition to the University's faculty, employees and students, through proceeds derived from the exploitation of the University's Intellectual Property assets;
- iv. To protect the rights of the University, its employees and students as the innovators and inventors and, in some cases, to protect the University's associates, research sponsors and the public;
- v. To regulate the infringement, improper exploitation and abuse of the Intellectual Property assets belonging to the University;
- vi. To optimize the environment and incentives for research and for the creation of new Intellectual Property;
- vii. To promote linkages with industry and stimulate research through developing and utilizing novel technologies and creative works for commercialization and by ploughing back resources to the University and to the inventors;
- viii. To promote creativity and innovation; and
- ix. To ensure fair and equitable distribution of all benefits accruing from all innovations, Inventions and breeding activities.

### 3. Definitions

In this IP Policy, unless the context otherwise requires, the following terms, without limitation, shall have the meanings assigned to them:

- i. **AVC (R&I)** means the University's Assistant Vice Chancellor for Research and Innovation.
- ii. **Creator** means the person(s) responsible for the contents of the Invention and has participated in the creation of the Intellectual Property thereof. A person shall not be

considered a Creator unless he or she has substantially influenced the original or novel aspects of the Invention.

- iii. **Copyrightable Work** means any original creative work or authorship which has been fixed in any tangible medium of expression from which it can be perceived, reproduced or communicated, that is protectable under the Brunei Darussalam Copyright Order 1999. Copyright protection shall include all literary, musical, dramatic and other types of creative works, including books, articles, journals, reports, software, computer programs, teaching materials, videos, multimedia products, sound recordings, paintings, pictorial, sculpture or graphical works.
- iv. **IEO** means the University's Innovation and Enterprise Office responsible for administering and managing the development, protection, exploitation and commercialization of Intellectual Property through licensing, technology transfer or other modes of commercialization.
- v. **Intellectual Property** means all rights relating to scientific discoveries, technological advances, compilations, and original works of art, literature or music, and shall include patents, trademarks, copyright, industrial designs, layout designs, creative works, trade secrets, know-how, discoveries and confidential information. Intellectual Property shall also include other intellectual assets such as Inventions and discoveries and any other product or attribute of intellectual or academic activity, whether or not formal property rights subsist or are capable of subsisting therein, such as knowledge and expertise, skills, techniques and the results of experiments, tests or calculations.
- vi. **Invention** means a creation of new, useful, and non-obvious ideas and/or their reduction to practice that result in, but are not limited to, new products, devices, processes, and/or methods of producing new and/or useful industrial operations and materials, any article useful in trade or any composition of matter that is industrially useful or that has commercial potential, new varieties of plants, new designs in the production or manufacture of an article, databases, circuit designs, prototype devices, equipment and any improvement upon existing processes or systems.
- vii. **Inventor** means scientists, researchers, authors or performers and includes the University's employees, researchers and non-researchers, undergraduate and graduate students and postdoctoral fellows, and shall include any person employed by the University, whether full-time, contract or part-time, emeritus staff while at the University, visiting researchers, adjunct staff and professors, company representatives, administrators and any other persons who create or discover applicable Intellectual Property rights using the University's resources and facilities or receive funds or other rewards for their services, work done through research, whether or not funded by the Brunei Darussalam Government, or those who voluntarily assign their Intellectual Property to the University.

- viii. **IP Committee** means the committee chaired by the AVC (R&I), and members of this committee shall consist of the IEO director, Dean of Postgraduate Studies and Research, the University's legal representative(s) or attorneys, business experts and one or two scientists or research experts in the relevant fields as appointed by the Vice Chancellor.
- ix. **Significant use of University resources** means the use of University resources including the use of office space, computers and library facilities, but excludes use for which the University is compensated.
- x. **Tangible Research Materials** means tangible biological, chemical and physical materials or equipment whether or not patentable or copyrightable.
- xi. **University** means Universiti Brunei Darussalam and shall include all the faculties, centres, institutes and wholly owned companies of the University.
- xii. **Vice Chancellor** means the Vice Chancellor of Universiti Brunei Darussalam.

#### 4. Applicability, Principles, Scope and Waiver

##### 4.1 Applicability

This IP Policy applies to the University's employees and students, researchers and non-researchers, undergraduate and graduate students, postdoctoral fellows and shall include any person employed by the University, whether full-time, part-time or under contract or part-time, emeritus staff while at the University, visiting researchers, adjunct staff and professors, company representatives, administrators and any other persons who create or discover applicable Intellectual Property making Significant use of University resources and facilities or who receive funds or other rewards for their services or work done through research whether or not funded by the Brunei Darussalam Government. This IP Policy also applies to Intellectual Property developed under a contract between the University and a third party.

##### 4.2 Principles

4.2.1 The principles underlying this IP Policy are:

- i. The University owns all the Intellectual Property created by the University's inventors, employees and students except to the extent this IP Policy provides otherwise.
- ii. The University employees and students who have their Intellectual Property and Inventions commercialized shall receive a fair share of the commercial benefits, as provided in this IP Policy subject always to the final decision by the University authorities.

- iii. Whenever Significant use of University resources, funds, facilities, personnel or other resources are involved in creating Intellectual Property which is exploited commercially or for undertaking other commercial activities, the University shall obtain a reasonable value for the University's investment.
- 4.2.2 The University may, in special circumstances, allow ownership of the Intellectual Property in the following circumstances:
- i. Where there has not been Significant use of University resources.
  - ii. Where the Inventor or Creator had disclosed the nature and scope of his or her research and has been allowed to compensate the University for the use of the University's facilities and equipment as charged by the University.
  - iii. Where it has been expressly provided for between the University and the research sponsor.

### **4.3 Scope**

The Intellectual Property rights covered by this IP Policy shall include the following:

- i. Patents;
- ii. Trademarks;
- iii. Copyright;
- iv. Industrial design;
- v. Layout design;
- vi. Trade secrets and know how;
- vii. Tangible research property and genetic resources; and
- viii. Traditional knowledge.

### **4.4 Waiver**

- i. The University may waive Intellectual Property rights to the Inventor or Creator if the University determines not to protect, license or commercialize the said Intellectual Property.
- ii. Subject to written confirmation, the University may also waive Intellectual Property rights to the Inventor or Creator if the University decides to abandon all efforts to protect or commercialize the Intellectual Property.

## **5. Ownership of Intellectual Property**

Further to the principles set out in Section 4.2 above, the University shall own the Intellectual Property created, discovered or invented by the Inventor or Creator particularly in the situations as follows:

### ***5.1 Use of University Resources***

The University shall own all the Intellectual Property that is made, discovered, or created by an Inventor and/or Creator who has made Significant use of University resources, including the University-administered funds or the University-funded time, facilities or equipment, in connection with the development of such Intellectual Property.

### ***5.2 University Commissioned Works***

The University shall own all Intellectual Property that is made, discovered, or created by an Inventor and/or Creator who is specifically hired or commissioned by the University for that commissioned purpose, unless otherwise provided by written agreement between such party and the University.

### ***5.3 Contractual Obligations***

The ownership of any Intellectual Property that is made, discovered, or created in the course of research funded by a sponsor pursuant to a grant or research agreement, or which is subject to a materials transfer agreement, confidential disclosure agreement or other legal obligation affecting ownership, may be governed by the terms of such grant or agreement, as approved by the University but subject always to this IP Policy.

### ***5.4 Scholarly/Aesthetic Works***

5.4.1 The ownership of copyrighted works including software, textbooks, course materials, scholarly papers, publication and articles, technical designs as well as integrated circuit designs, formulas and codes describing any compound or materials whether biological or not and research data arising from University research shall be owned by the University.

5.4.2 The ownership of copyrights to works of artistry or such as novels, poems, paintings, musical compositions or other such works of artistic imagination produced by the University's employees who have a general obligation to produce such works, where the specific choice, content, course, and direction of the effort is determined by the employee without direct assignment or supervision by the University shall reside with the Creators and the works shall not be deemed as works made for hire under this IP Policy unless they are also sponsored/contracted works or specifically assigned by the University.

5.4.3 However, the University may at anytime and under special circumstances

require assignment of the University employees and students of all copyright authored work for the purposes of commercializing the authored work and the University employees shall take such action as required to complete the assignment provided that the assignment of copyright will contain terms which will enable the University employee to retain the rights to reproduce the text of their authored works to ensure that their careers benefit from publishing the results of their work.

5.4.4 However, upon request by the University, the Creator(s) shall grant the University a non-exclusive, free of cost, worldwide right and license to exercise all copyright rights in and to the work.

5.4.5 If a use of the work by the University is reasonably determined by the Creator to impair the exercise of such rights, the University shall discontinue the impeding use but otherwise shall remain free to use the work as provided in this IP Policy.

5.4.6 Subject to the approval of the IP Committee, the University may assist any University employee or students wishing to commercially exploit a scholarly/aesthetic work through the IEO. In such cases, the Creator shall assign to the University the copyright of the work and the provisions of this IP Policy shall apply.

## **5.5 *Student Works***

The ownership of Intellectual Property assets and rights produced by the University's enrolled students with or without the use of University funds and or Significant use of University resources, other than that are produced outside any University studies and are not sponsored or commissioned works, shall reside with the University.

Provided however, in all cases a student's graduate thesis or dissertation shall be deemed to be a student's work under this IP Policy, but as a condition of enrollment and awarding of a degree, the University reserves the right to reproduce in any medium and distribute to the public, on a commercial or non-commercial basis, copies of the said thesis and dissertations.

## **6. Administrative Procedures**

### **6.1 *Disclosure to the University***

The University requests that the Inventors and/or Creators disclose their Inventions and Intellectual Property works promptly to the IEO and/or IP Committee, in order to allow the University an opportunity to evaluate the commercial potential and to preserve or protect the Intellectual Property rights by filing a patent application or obtaining any reasonable mode of registration and protection.



The University has outlined the following procedures in order to accomplish the dual objectives of disseminating knowledge and maximizing the economic value and protection of the Intellectual Property.

**i. Intellectual Property Developed with University Resources**

The Inventors and/or Creators are to disclose promptly to the IEO Director all Intellectual Property rights that are developed with the use of University resources. Disclosure is required reasonably before the Inventor and/or Creator takes any action to publish, present at conferences, enter competition or exhibition or commercialize such Intellectual Property.

**ii. Intellectual Property Subject to Contractual Obligations and/or Sponsored Research Agreements**

In case of Intellectual Property rights developed in the course of research funded by a sponsor pursuant to a grant or research agreement, or which is subject to a materials transfer agreement, confidential disclosure agreement or other legal obligation requiring disclosure, the disclosure of such Intellectual Property will be governed by the terms of such grant or agreement, as approved in writing by the University, if such terms differ from this IP Policy.

**6.2 Evaluation and Disposition of Disclosures**

The IP Committee will review, evaluate and make a disposition of all Intellectual Property disclosures and applications.

The evaluation shall be conducted by the IP Committee chaired by the AVC (R&I) for the time being in charge of Research and Innovation. Other members of the IP Committee shall comprise the IEO director, Dean of Postgraduate Studies and Research, legal representative(s), business experts and one or two other scientists or research experts in the relevant fields under consideration to establish whether:

- i. The application of the Inventions is the product of University research as defined in this IP Policy.
- ii. The Invention is protectable under the relevant Intellectual Property law by identifying the Invention's novelty, inventive steps, industrial applicability and prior arts.
- iii. The Invention has potential to be commercialized.
- iv. The Invention has attracted interest from the public and/or industry.

## **7. Commercialization**

- i. In the event the Inventor or Creator of the Intellectual Property collaborates with a third party for the commercial exploitation of the Intellectual Property, the matter must be notified in writing to the IP Committee and/or IEO. Failure to do this entitles the University to use its discretionary power to render the contract derived from such negotiation null and void.
- ii. Once the IP Committee is notified that the Inventor or Creator is seeking to exploit the Intellectual Property commercially, the University shall then decide whether or not it wishes to become involved in the process of commercial exploitation.
- iii. In making a decision under sub-clause (b) above, the IP Committee shall, at its own discretion, consult in confidence with the Inventors and any other relevant parties.
- iv. Among the available modes for commercialization of an Invention are:
  - a) Licensing of the Invention to industry and/or third parties to provide for the further development and/or commercialization of the Intellectual Property;
  - b) Technology transfer through royalty, consultancy and commission agreements with the industry;
  - c) Establishment of a spin off or start- up company;
  - d) Outright sale; and
  - e) Combination of any of the above modes of commercialization.

## **8. Tangible Research Materials**

While potential commercial value should not inhibit the free exchange of the University's own Tangible Research Materials for research purposes, the University nonetheless recognizes that such Tangible Research Materials may have significant commercial value. As such, this IP Policy provides that all the Tangible Research Materials leaving the University shall be governed by a Material Transfer Agreement (MTA) in accordance with this IP Policy and other relevant University policies.

In addition, Tangible Research Materials received by the University employee may be subject to contractual restrictions that may limit the use and transfer of such materials, to the detriment of University researchers. The University has therefore established the following procedures to allow the free exchange of Tangible Research Materials, while at the same time respecting the ownership rights of the University, protecting the rights of its Inventors and Creators and limiting the liability of the University and its researchers.

### ***8.1 Transfer to Outside Researchers for Basic Research***

If an employee or student desires to transfer materials to a third party researcher for use in

internal basic research and not for the development or sale of commercial products, the said employee or student must use the appropriate University form of MTA, which is provided by the IEO together with instructions for the use of each form.

The various forms of MTA will establish rights and responsibilities regarding the materials between the University and the third party researcher and will minimize future confusion and controversy regarding the use and transfer of the materials and ownership of Intellectual Property and Inventions based on the supplied materials.

### ***8.2 Transfer for Commercial Use***

Materials shall not be transferred to any third party researcher for commercial uses or any use other than internal basic research unless the third party researcher has obtained written consent from the University through the IEO under the procedures set forth in this IP Policy.

### ***8.3 Receiving Materials from Outside Researchers***

If an employee or student under this IP Policy receives materials from a third party organization (non-profit or commercial), the other organization or researcher may impose serious use and transfer restrictions on the materials and may claim an ownership interest in Inventions, Copyrightable Works, or Intellectual Property that arise in the course of research performed with such materials. For this reason, only the IEO Director is authorized to approve and execute agreements governing receipt of materials from other organizations.

The employee and students are encouraged to consult with the IEO Director regarding the restrictions applicable to a particular material from a third party researcher before proceeding to use the said material in their research.

## **9. Publication and Confidential Information**

While the academic tradition of publication and free dissemination of knowledge for the public benefit is recognized by the University to be of paramount importance, it may be necessary or desirable, under some circumstances, to restrict disclosure of confidential information to a sponsor, company or third party.

The general rule in relation to publication is no individual shall publish, in any form, any information relating to the Intellectual Property, Invention or research for which an innovation or Invention disclosure has been submitted without the express written consent of the IP Committee and/or IEO, provided that the consent shall not be unreasonably denied or delayed and the decision shall be communicated within a reasonable period of not more than two months from the date of application.

The University has developed the following procedures to protect confidential information

interests as follows:

### ***9.1 Guidelines Regarding Public Disclosure of Inventions***

Any disclosure of an Invention to the IEO Director will not interfere with the ability to patent the Invention. However, public disclosure of an Intellectual Property or Invention prior to filing for a patent application will preclude the availability of patent protection in Brunei Darussalam and in most countries. This rule applies to any non-confidential written or oral disclosure that describes the Intellectual Property and/or Invention.

Accordingly, the University strongly encourages individuals concerned to disclose Inventions to the IEO Director as soon as possible and to delay public disclosure of the Intellectual Property and Invention until the evaluation process organized by the University is completed and a patent application is filed.

### ***9.2 Receiving Confidential Information from Outside Researchers***

If an employee or student under this IP Policy receives confidential information from a third party researcher or organization (non-profit or commercial) in relation to research performed by the said employee or student, the other organization or researcher may impose binding non-disclosure and non-use obligations on the confidential information and may claim an ownership interest in Inventions, Copyrightable Works, or materials that arise in the course of research performed with such confidential information.

To prevent such circumstances occurring, only the IEO director is authorized to approve and sign the confidentiality agreement from other researchers or organizations on behalf of the University.

### ***9.3 Sponsored Research with Commercial Organizations***

The AVC (R&I) in consultation with the IEO director shall have responsibility for negotiating, executing and administering funded research agreements between the University and commercial organizations, in accordance with the University policies on sponsored research.

The AVC (R&I) may delegate all or some of these responsibilities to the IEO director. IEO approval is required for any terms of such agreements that affect rights to Intellectual Property (e.g., option rights, license rights, or assignment of ownership).

## **10. Commercialization and Revenue Derived from the University's Intellectual Property**

### ***10.1 Distribution of Non-Equity Revenue Derived from Commercialization***

Royalty, licensing or technology transfer income and other non-equity revenue derived from the commercialization of the University's Intellectual Property will be distributed at

the end of each accounting period as follows:

- i. The University will be reimbursed for any out-of-pocket expenses incurred in obtaining and maintaining Intellectual Property rights especially in patent protection and annual maintenance and in evaluating and marketing such Intellectual Property.
- ii. The remaining net income will be distributed as follows:
  - a) Forty five percent (45%) to the Inventor or Creator.
  - b) Fifty five percent (55%) to the University.

In case of multiple Inventors or Creators of the commercialized Intellectual Property, their shares will be distributed as they unanimously agree or, in the absence of an agreement, in such reasonable portions to be decided by the IP Committee.

For clarity, “revenues” shall not include funds received for research support.

The Inventor or Creator’s royalty rights shall not cease upon the termination of employment with the University and/or death of the Inventor or Creator and in the event of the death of the Inventor or Creator his or her share shall inure to the benefit of his or her estate.

### ***10.2 Acceptance of Equity***

Subject to the University’s rules and regulations, the University may accept an equity interest in a company, corporation, partnership or enterprise. If the University receives equity shares in connection with the commercialization of the Intellectual Property, such equity will be held on behalf of the University by the University “Tabung” and/or a special purpose vehicle.

The University’s acceptance of equity in consideration of licensing University Intellectual Property shall be based upon the principles of transparency, objectivity and fairness in decision-making and the pre-eminence of the education, research, and public service missions of the University over financial or personal gain.

## **11. Authority**

The IEO’s director shall regularly report all the University’s IP activities to the AVC (R&I) and the Vice Chancellor. The Vice Chancellor, upon recommendation of the AVC (R&I) and advice from the Attorney General, may grant exceptions to the IP Policy in appropriate cases. The Vice Chancellor shall have full discretion to waive or amend any or all of the terms in this IP Policy as and when necessary.

## **12. Contractual Terms**

The terms of this IP Policy are considered as part of the contractual relationship of the University with the employee and student. This IP Policy, as amended from time to time, shall be deemed to be part of the conditions of employment of every University employee or a part of the conditions of enrollment and attendance of every student at the University.

## **13. Breach of Policy or Guidance**

Any breach by the University's employees and students of this IP Policy or of any guidance made in accordance with the procedures hereof may amount to a disciplinary matter and / or an infringement of the University's rights, and consequently may lead to disciplinary or legal action being taken by the University.

## **14. Implementation and Dispute Resolution**

The responsibility for the implementation and administration of this IP Policy shall lie with the AVC (R&I), who may delegate that responsibility to another person.

If the AVC (R&I) has a personal interest in any matter related to the University's Intellectual Property or has some other conflict of interest with the University related to any commercial matter, then the functions of the AVC (R&I) under this IP Policy shall be exercised by such independent person or persons as the Vice Chancellor may determine.

In the event a University employee or student alleges that the University has not complied with this IP Policy and its procedures, he or she may request that the matter be resolved by an arbitrator mutually agreed by the University and the University employee or student concerned.

The decision of the arbitrator shall be binding on the University and its staff members and the costs (if any) shall be borne as decided by the arbitrator. Either party is free to bring proceedings in the courts in order to seek mandatory, declaratory or other relief which is not available from an arbitrator.

End of Document