

# **INTELLECTUAL PROPERTY POLICY AND GUIDELINES**



**NATIONAL INSTITUTE OF TECHNOLOGY  
DURGAPUR**

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## 1. PREAMBLE

National Institute of Technology Durgapur (NITD), an institute of national importance is dedicated to excellence in teaching and research over the years. Excellence in research and education, exchange, and dissemination of knowledge are guiding principles of NITD. These activities may lead to generation of Intellectual Property (IP), which needs to be protected, developed, transferred and commercialized for the benefit of the society. Our country will highly be benefited socioeconomically due to commercial exploitation of such IPs. National Institute of Technology Durgapur, therefore, encourages due recognition, protection and utilization of such inventions through patenting and subsequent technology transfer to potential organizations for commercial exploitation. This is expected to yield economic benefits to the Institute thereby strengthening financial support base for research activities and economic incentive to the inventors. This will eventually ignite the passions for research and innovations and contribute to maintain the country's growth trajectory in innovation and to improve India's ranking in Global Innovation Index (GII).

The policy laid down in this document is expected to fulfill the commitment of the Institute for constant encouragement towards innovation and appreciation of the innovators. It will also enable the Institute to make beneficial use of such developed intellectual property for the greatest possible benefit to the public, the Institute, and the creators/inventors involved.

## 2. DEFINITIONS

- **Agreement** is the document created with mutual consent of involved parties defining the rights, roles and responsibilities of each of the parties, for example, Research Agreement, Consultancy Agreement, Non Disclosure Agreement (NDA), etc.
- **'Creator'** refers to an individual or a group of individuals at the Institute, who make, conceive, reduce to practice, author, or otherwise make a substantial intellectual contribution to the creation of any intellectual property. 'Creator' includes an 'inventor' in the case of inventions under Patent Law, an 'author' in the case of works falling under the Industrial Designs Law and/or Copyright Law.

- **'Copyright'** means the exclusive right granted by law for a certain period of time to an author to reproduce, print, publish and sell copies of his or her creative work.
- **'Conflict of Interest'** or a potential 'Conflict of Interest' exists when an inventor/author is or may be in a position to use either creative work or influence for unmerited personal or family gain.
- **'Collaborative Activity'** is the research undertaken by NIT Durgapur personnel in cooperation with industry and/or another researcher(s) who are not from NIT Durgapur.
- **'Director'** means the Director of the National Institute of Technology, Durgapur.
- **'Employee'** of the Institute is defined as any person receiving compensation for service, or any person volunteering services for the benefit of the Institute. The uncompensated activities of students in furtherance of their education shall not be considered service within the meaning of this policy, even if such activities benefit the Institute. A scholarship, fellowship, assistantship or any other payment received by a student during the course of his studies does not classify him as an employee.
- **'Institute'** means the National Institute of Technology Durgapur.
- **'Institute personnel'** means part-time and full-time members of the faculty, technical, administrative or the supporting staff and employees, undergraduate and postgraduate students, doctoral and postdoctoral fellows of the Institute.
- **'Institute Resources'** mean facilities such as office space, standard laboratory facilities, library, normal access to software, computers and networks, standard secretarial services, salary and perquisites.
- **'Intellectual Property'** broadly includes any property generated out of intellectual effort of the creator(s). Intellectual Property Right (IPR) includes but is not limited to copyrights and copyrightable materials, patented and patentable inventions, tangible research results, trademarks, service marks and trade secrets.
- **'Invention'** includes but is not limited to any new and useful process, formula or machine conceived or first reduced to practice in whole or in part, defined within the purview of the Patent Act. Invention means the Invention as defined by The Patent Act, 1970 (as amended). Inventor(s) are person(s) who produce an invention.
- **'Licensing'** is an authorization to permit the IP right by the owner under certain consideration.

- **Non Disclosure Agreement (NDA)/Confidentiality Agreement-** The agreement intends to protect proprietary or confidential information among the parties involved in executing a NDA.
- **'Patent'** means a patent granted under the provisions of the Indian Patents Act, 1970
- **'PCT Application'** A PCT (Patent Cooperation Treaty) is a system of filing a patent application in several countries through a single application keeping the priority of the first filing in any of the countries within the PCT system. This is administered by the World Intellectual Property Organisation (WIPO) in Geneva. It is not a patent granting system.
- **'Public disclosure'** is any non-confidential communication which an inventor or invention owner makes available to one or more members of the public, revealing the existence of the invention and enabling an appropriately experienced individual ("person having ordinary skill in the art") to reproduce the invention.
- **'Intellectual Property Management Committee'** is the committee constituted by the Director from time to time to evaluate and make recommendations regarding IPR related issues.
- **'Revenue'** is any payment received as per an agreement by the Institute usually for legal use of a patent through a license.
- **'Royalty'** is the payment made to an inventor/author or an institution usually for legal use of a patented invention or any Intellectual Property when licensed.
- **'Sponsored research'** shall be taken to mean a specific research project funded by an outside agency, whether non-profit or for profit, governmental or private, national or international. The term 'sponsored research' will not apply to funds awarded by an external agency to a student, scholar, fellow or trainee for the support of education or research.
- **'SRCC'** is the sponsored research and consultancy cell under Dean (R&C) of NIT Durgapur
- **'Trade Mark / Service Mark'** is a distinctive word, symbol or picture or a combination of these, which is used by a business entity to discriminate its products and services from those of other business entities.
- **'Trade Secret'** refers to some information such as know-how of commercial or strategic value that is not disclosed to all and is used in a restricted manner.

- **Work for hire**-The work (or a product) originated from NITD and is meant for the specific purpose of NITD and produced by (a) an author during his/her employment at NITD or (b) non-employee under contracted work by NITD.
- **Work Commissioned/Outsourced**- work commissioned by NITD to a creator or group of creators either employed by NITD or invited from outside NITD with or without any consideration in cash or kind. Typical examples of NITD commissioned works are: (a) Design work, (b) Artistic Work, (c) Engineering/Architectural Models, (d) Computer Software,(e) Reports based on surveys and analysis, (f) Video works.

### **3. SCOPE OF THE POLICY**

The policy has made to encourage and appreciate the innovative ideas and creative works of the Institute personnel. Policy also thinks about the utilization of their expression of ideas and creative works for the betterment of the society. It describes how to develop an idea [inventive] and creative works for utilization of the public interest without ignoring the benefit of individual inventors, authors, and Institutions. This policy though suggests taking the ownership or control over scholarly work, but it will not hinder the right of scholar to publish book or article. This policy is applicable to all the Institute personnel who have used the resources of the Institute.

### **4. OBJECTIVES**

Through this Intellectual Property (IP) Policy and Guidelines, the National Institute of Technology Durgapur, intends to put in place a system that brings order to the process of protection of inventions, and the utilization of inventions through processes of technology transfer and entrepreneurship for the public interest. Within the above broad objectives, the specific objectives of this Policy are as follows:

- (a) Encourage, create awareness, and facilitate the process (es) of securing and protecting the IP rights generated at NITD.
- (b) Initiating and pursuing all actions and deeds to maintain, prosecute, and keep in vogue the secured IP rights of the Institute
- (c) Pursue all the necessary procedures and actions to facilitate, catalyse, and bring to bear the Transfer of Technologies, including the commercialization, licensing, and other means of disseminating the technologies developed by the Institute.

## **5. DEFINITION OF IP**

The term “intellectual property” used herein broadly means any property generated out of the intellectual effort of the creator, either having proprietary value or protected by statute. In the case of copyrightable works, it must be fixed in a tangible form, and the creator or rights-holder is empowered by law to prevent others from copying this form.

### **5.1 TYPES OF IP**

The intellectual properties can be broadly listed as:

- (a) Patents
- (b) Copyrights
- (c) Trademarks including service marks
- (d) Industrial designs
- (e) Integrated Circuit (IC) layout designs
- (f) New plant variety
- (g) Traditional knowledge and Geographical Indications
- (h) Undisclosed information

The policy is further applicable to IP as listed above along with non-patented technology & new Biological material.

### **5.2 ACTIVITIES FOR GENERATION OF IP IN NITD**

There are different types of Research and Development (R&D) activities in NITD, which may generate IP.

- i. Research carrying out by a faculty/staff/student/research scholar in the normal course with funds coming from NITD (this may include research projects undertaken by students under the supervision of the faculty member).
- ii. Research carrying out by a faculty/staff/student/research scholar sponsored by Central/ State Government, International agencies.
- iii. National collaborative research with Government institutions/agencies/public sector and private companies.
- iv. International collaborative research with institutions and companies.
- v. Research & consultancy sponsored by private companies/ organizations.

- vi. Any combination(s) of the above

The ownership definitions for different types of IP and other relevant aspects are described in Section 3.

### **5.3 OWNERSHIP OF INTELLECTUAL PROPERTY (IP)**

#### **5.3.1 Patent, Copyright on Software, Industrial design, IC layout design and New plant variety**

**(A) IP is owned wholly or exclusively by NITD if:**

- i. It is generated either through sponsored/facilities exclusively provided by NITD or with sponsored/facilities provided by NITD and external agencies but without any agreement or contract.
- ii. It is generated through sponsored research and consultancy projects without any agreement or contract.
- iii. It is generated under any agreement including “work for hire”, “work commissioned” and/or outsourced exclusively by NITD.
- iv. It is generated through an assigned agreement in that case ownership shall be transferred to NITD (such as work of programmers, writers for publications of NITD, etc.)
- v. It is generated by different individuals of/for NITD with their contribution (such as software or technology or process development etc.) over a period of time which is not assigned.

**(B) IP can be owned by Third party(ies) (exclusively or jointly with NITD) if:**

- i. It is generated through external funding from Third party (ies) including sponsored research, consultancy projects and other collaborative activity (ies) with an agreement.
- ii. It is generated through collaborative project(s) or activity(ies) with Third party(ies) with agreement (s) without any external funding.
- iii. It is generated through the contribution of NITD faculty/staff/student/research scholar during their visit to a Third party Institution/organization.
- iv. It is generated through the contribution of Third party who visits to NITD.

For sharing of IP in case of sponsored research and consultancy projects or any other collaborative activity, the following guidelines shall be followed:



- (a) NITD may share its rights for IP owned by NITD with other Third party (ies) subject to their respective contribution through a separate agreement.
- (b) In case of Government sponsored project, the ownership shall be decided according to the ownership clauses of the funding agencies.
- (c) In case of multi-country/multi-institutional collaborative project, the ownership of IP must be explicitly defined in the agreement.
- (d) In case of collaborative activity with foreign institutions involving indigenous biological material, IP ownership has to take into account restrictions as per the prevailing 'Biological Diversity Act 2002' of India.

**(C) IP can be owned by the Inventor(s) if:**

Institute personnel of NITD can own IP which does not belong to the situations defined above. IP can be owned by an employee of NITD, if it is generated outside of one's normal working hours of NITD without using institute resources.

**(D) Copyright in Software, Design(S), Integrated Circuit Layouts:**

The Institute shall be the owner of all invention(s) including software, design, and integrated circuit layouts, created by a team of the Institute and non-Institute personnel associated with any activity of the Institute. Non-Institute personnel, who can create invention(s) including software, design, and integrated circuit layouts at the Institute without any intellectual contribution of the Institute personnel and use of the Institute resources, shall be the owner of such invention(s). In that case Non-Institute personnel should sign an agreement with the concerned institute personnel.

**(E) Copyright other than Software:**

**i. The copyright owned by the author(s):**

The copyrights for textbooks, research materials, articles, monographs, teaching-learning resource materials and other scholarly publications can be owned by the authors unless restricted by the agreement. These may also include popular novels, poems, musical composition, other works of artistic imagination, etc.

## **ii. The copyright owned by NITD:**

- (a) The copyright can be owned by NITD if the work is developed under any contract (same as described (under Clause A of Section 3.3.1).
- (b) Where copyright has not been assigned to the Institute, the Institute will be entitled to a non-exclusive, non-transferable license to use the work within the Institute for non-commercial educational and research purposes, or to possess a limited number of copies for such purposes, whichever is relevant.

## **iii. Copyright owned by student**

- (a) Authorship of thesis, dissertations, laboratory records, and of other documents that are produced by a student during the course of his/her study can be claimed by the student/supervisor but, the copyright ownership should be assigned to NITD. The same is not applicable to research publication.
- (b) If there is any possibility for generation of IP from thesis, concerned supervisors/inventors should take steps to protect the IP. Thesis which will generate the IP may be recommended for award.

### **5.3.2 Trade Marks**

Trade and service marks related to goods and services involving NITD (including Incubation centre) will be owned by NITD. NITD would allow the use of its name and trademarks owned by it to the Third party (ies) to whom IP has been licensed/assigned through a signed agreement on following conditions:

- (a) IP is intended to be used for the benefit of society.
- (b) IP is licensed/assigned with an undertaking from the licensee/assignee that IP will be used-
  - i. in a responsible manner to create a product/process conforming to environmental safety, and good manufacturing practices promoted by the Government of India and its regulatory bodies.
  - ii. without any liability to NITD in case of misuse of IP or accidental damage accruing due to use of IP.
- (c) In no case IP will be used against the interest of India.

In all such cases, the licensee/assignee must take prior approval of NITD about the manner in which the name of NITD and its trademarks are to be used in any media including print and electronic media.

## 6. IPR ADMINISTRATION

This policy shall be applicable to all the institute and non-Institute personnel associated with any activity of the Institute such as, but not limited to outcomes of research, consultancy or continuing education programmes, and covers different classes of Intellectual Property-Patents, Designs, Trademarks, Copyright, unpatented technology & biological materials, Integrated Circuits Layout and other creative works.

### 6.1 LEGAL STATUS OF IPR POLICY

This policy shall be applicable from the date to be notified by the Institute. Any addition, insertion and/or deletion from the policy document, which curtails the rights of a creator, will not operate retrospectively. Any alterations in this policy will not take effect until the Institute Intellectual Property Management Committee (IPMC) takes a decision and subsequently is ratified by chairman senate. Such changes would be effective for inventions and other research results arising out in the future. Institute personnel are required to observe the institute's policy on Intellectual Property Rights as may be decided by the IPMC& chairman senate from time to time.

### 6.2 CONSTITUTION OF INSTITUTE INTELLECTUAL PROPERTY MANAGEMENT COMMITTEE

An Institute Intellectual Property Management Committee (IPMC) will be as follows:

Dean (R&C)	Chairman
Faculty member nominated by Director	Coordinator
Faculty Representative-1 from physical science(Physics, Mathematics, Civil, Mechanical) nominated by the Senate	Member
Faculty Representative-2 from chemical science( Chemistry, Chemical and Metallurgy) nominated by the Senate	Member
Faculty Representative-3 from Biological science	Member

nominated by the Senate	
Faculty Representative-4 from (Electrical, Electronics & Computer science)nominated by the Senate	Member

For the evaluation of any invention, Dean (R&C) will nominate (with consultation with inventors) two domain experts who are qualified enough to evaluate the creative work and who may be called as invitee members during the meeting of IPMC. The IPMC shall be responsible to administer all decisive issues related to IP policy and such other relevant matters as shall be determined from time to time. The Dean (R&C) shall be responsible for the implementation of all the recommendations and decisions through IPMC.

## **7. DISCLOSURE**

When the creators/inventors finds that they have generated intellectual property for which ownership would be with NITD as per policy laid out here, they shall report it promptly in writing (through prescribed format (FORM NO: NITDGP/P-1)) along with relevant documents, data and information, to the SRCC using the 'Intellectual Property Disclosure Format (IPDF)' (FORM NO: NITDGP/P-2). Disclosure is a critical part of the IP protection process for claiming the inventor-ship. The information shall constitute a full and complete disclosure of the nature, particulars and other details of the intellectual property, identification of all persons who constitute the creator(s) of the property, and a statement of whether the creator believes he or she owns the right to the intellectual property disclosed, or not, with reasons. Where there are different creators of components that make up a system, the individual creators and their contributions must be identified and treated separately. In case of the sponsored and/or collaborative work the provisions of the contract pertaining to disclosure of the creative work is applied. By disclosure the inventor(s) shall assign the rights of the disclosed invention to the institute.

## **8. CONFIDENTIALITY**

Every creator in the group as well as everyone involved in the protection process will not disclose the details of the IP to any person/organization without prior written permission of the Institute [IPMC]. In case of thesis and other such written documents containing details of patentable invention, all measures need to be taken on behalf of the inventors

as well as the institute to avoid attracting the public disclosure clause leading to denial of patent right. The creator(s) in such cases may request the Institute not to place the concerned thesis for a certain period in the public domain. The Institute on receiving written request will take measures for protection of intellectual property of the inventors.

## **9. LICENSING OF IP**

Institute, through SRCC, will approach external agencies for licensing of IP owned by it. License agreement form (NITDGP/P-3) shall be signed by the Dean(R&C), and the creator(s) of the IP being transferred, on behalf of the Institute. In case of IP involving more than one creator, a coordinator among the creator(s) shall be identified by the IPMC for IP protection purposes. At this stage, all members of the group of creators shall sign a revenue sharing agreement (Section 9, Form no. NITDGP/P-4) for the PATENT being transferred. This revenue sharing agreement may be modified at any time on mutual consent among the creators and intimated to the sponsored research and consultancy cell (SRCC). Any conflict with regard to revenue sharing among the creators will be resolved by the Institute which is binding on all the creators of the IP.

## **10. REVENUE SHARING**

The revenue generated by licensing/assigning of IPR or on receipt of royalties associated with technology transfer/specific innovation programs shall be divided as follows:

- (a) 60% (sixty percent) of the revenue will be given to the Inventor(s).
- (b) 10% (ten percent) would go to the institute
- (c) 20% (twenty percent) to SRCC for promotion of IPR activities
- (d) 10% (ten percent) to the department

Creators of IP shall sign at the time of disclosure, a distribution of IP Earnings Agreement, which shall specify the percentage distribution of earnings from IP to each co-inventor/co-creator.

NITD reserves the right to determine the share of the different stakeholders involved in IP creation and dissemination from time to time.

## 11. STEPS FOR FILING PATENT AT NIT DURGAPUR

### 11.1 PROCEDURE

- In order to proceed with the Patent filing, creators/Inventors are advised to do search from the following search engines:
  1. <https://patents.google.com>
  2. <http://www.uspto.gov/patents/process/search>
  3. <http://ep.espacenet.com>
  4. <http://patentscope.wipo.int/search/en/search.jsf>
  5. <http://ipindia.nic.in/ipr/patent/patents.htm>
  6. [http://www.google.co.in/advanced\\_patent\\_search](http://www.google.co.in/advanced_patent_search)
  7. [www.sciencedirect.com](http://www.sciencedirect.com) for non-patent literature

Inventors must ensure from the search results that the Invention does not previously exist in the form of Patent or Non-Patent Literature.

- For filing a Patent, creator/Inventor should submit (i) request letter for patent filing in prescribed format (FORM NO: NITDGP/P-1) & (ii) 'Intellectual Property Disclosure Form (IPDF)' (FORM NO: NITDGP/P-2) in hard copy as well as soft copy along with the positive patent search report, to SRCC. If someone wants to file 'provisional Patent' please refer to FORM NO: NITDGP/P-7.
- The proposal will be evaluated by 'Intellectual Property Evaluation Committee' (IPMC) of SRCC which will be chaired by Dean (R&C). If the proposal is OK in all respect, IPMC will recommend it for filing the patent.
- IPMC may give any following recommendation: (i) Proposal is recommended for processing and filing. (ii) Proposal is recommended for revision & (iii) Proposal is rejected.
- If the recommendation is positive, the invention will be sent to one of the empanelled Patent attorneys of NIT Durgapur. The decision regarding the selection of attorney will be the internal administrative decision at SRCC (subject to area of Invention).
- If any revision is recommended then inventor has to revise and resubmit it to SRCC. The inventor may be requested to give a presentation and/or show the patentable product to the IPMC.

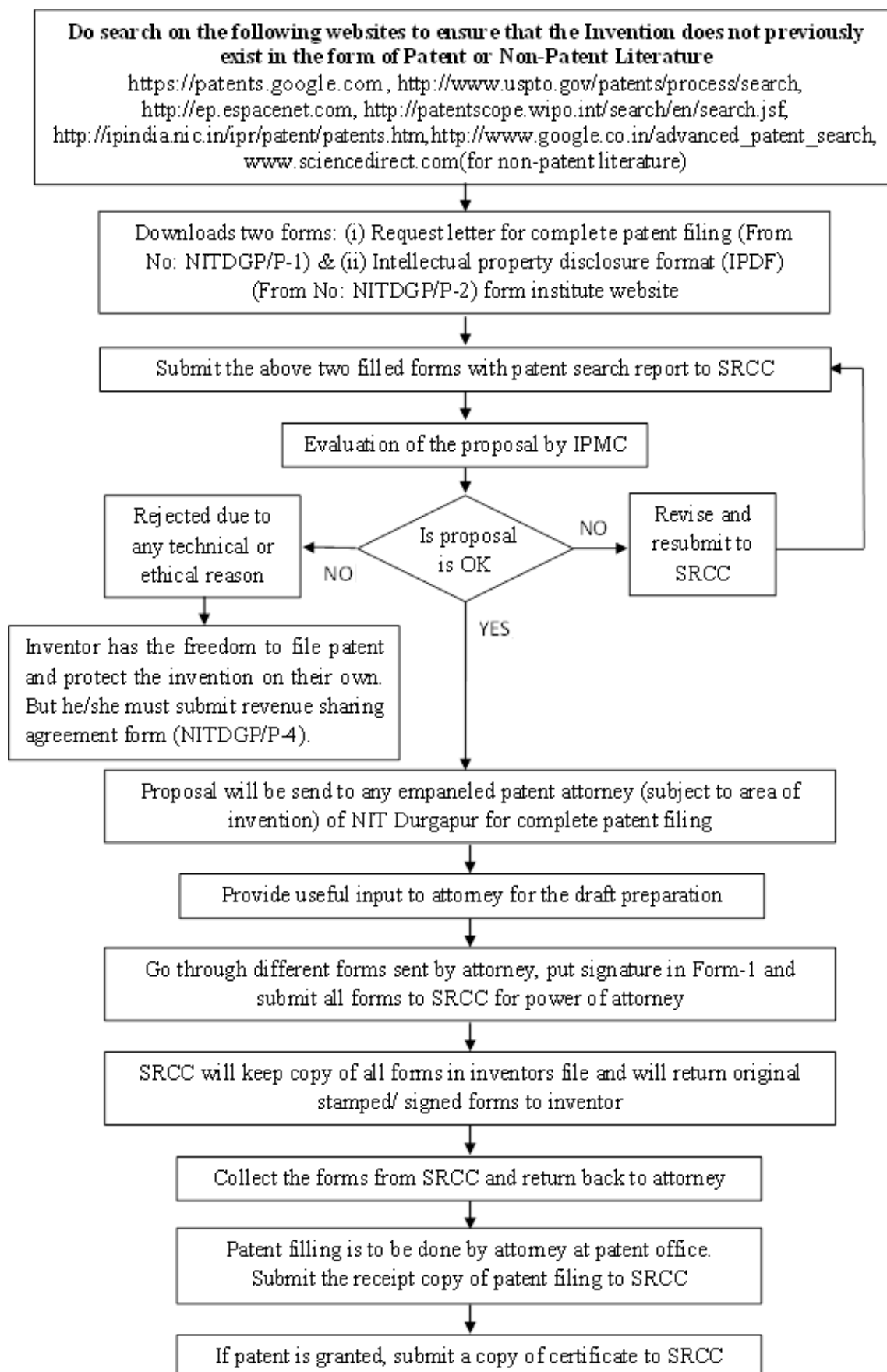


Fig. 1 Flowchart for Patent Filing Procedure

- At the time of draft preparation of Patent application, the attorney may contact the Inventors/creators regarding draft approval of the application; the inventor may provide his input to the attorney and ask for any modification/rectification in the draft.
- To file the patent application at patent office, attorney will provide the different Forms. The Inventors are supposed to go through all forms & return it to SRCC for power of attorney. Form-1 should be originally signed by inventors, Photocopy/ scanned signatures on Form-1 are liable for rejection of patent. In every case NIT Durgapur will remain the applicant for the patent filing and Dean (R&C) will be power of attorney and signatory in Form-1.
- Patent filing and grant of certificate is a long procedure, after the submission of patent application at patent office, it takes around 18 months for the patent application publication under normal route. Further, the application will proceed through the stages of pre-grant opposition (if any), examination, and post-grant opposition (if any) , Patent Certificate is being Granted subsequently. On receiving patent right the inventor should submit a copy of the corresponding document to the SRCC.
- Other forms of intellectual property generated during the course of research and development, such as copyrights, design registrations, trademarks, etc. will essentially follow the same procedure as above.
- In case of the contract/agreement / MOU with a sponsor specifies that the sponsor will manage the process of filing of patents and bear the associated costs, the creators will provide information to the SRCC of each such filing/application. Details of the invention need not to be provided in such cases in the interest of confidentiality, if so desired. Progress of the application through various stages will be informed to the SRCC by the creators as and when the creators become aware of such progress.
- If any proposal is rejected by IPMC, the creator has the freedom to file patents and protect the invention on their own. But he/she must sign and submit revenue sharing agreement form (NITDGP/P-4).
- The complete flowchart of aforesaid procedure is given in Fig.1.



## **11.2 FUNDING**

Attorney charges and official Govt. fees for the following (as and when needed) may be granted from Department development fund (DDF)/Institute fund subject to approval from competent authority of NIT Durgapur. In case of sole student/staff may apply to the competent authority for necessary funding.

Application filling by the patent attorney;

- ❖ Early publication ;
- ❖ Examination ;
- ❖ Filing responses after examination & hearing;
- ❖ Patent maintenance for first 10 years;
- ❖ Attorney charges for commercialization.
- Patent maintenance fees (Annuity fees) are being made annually from 3rd year onwards for the granted Patents. Annual fees are to be provided for 10 years. After 10 years, annual fees will only be paid on the basis of commercialization aspect of the technology. In that case Inventor may renew the IP in his own cost and he may claim the ownership.
- If the institute/creator chooses to file IP applications in other countries, then the cost of application and other associated costs may be claimed from DDF/Institute fund as mentioned before. The Institute shall be free to enter into agreements with overseas institutions for protection and licensing of the IP.

## **11.3 FILING OF INTERNATIONAL PATENT**

Subject to provision of section 39 of the Patent Act, 1970 the Institute shall, decide on the suitability of protection of the invention in foreign countries within six months of filing the Complete IP Application in India if no secrecy direction is received from Patent Office. If the Institute opts not to undertake such protection in any specific country requested by the inventor(s) relating to the application where no secrecy has been imposed by the Patent Office, the Institute shall assign rights of the IP in that country to the creator(s) for the purpose of such protection.

## **11.4 RENEWAL OF IP RIGHTS**

Though, creators/inventors may apply for renewal of their Patent Rights, but IPMC will take a decision on the same in case where the institute is sole owner. If the Institute

decides not to renew the IPR, then creator/inventor has the freedom to renew IPR on their own.

## **11.5 TECHNOLOGY TRANSFER**

The Institute shall strive to market the IP and identify potential licensee(s) for the IP to which it has ownership. The creator(s) are expected to assist in this process. The Institute may involve in commercialization of IP through the Technology Management Agencies (Government/Private), which manages the commercialisation of the IP.

For the IP for which exclusive rights have not been already assigned to a third party, the creator(s) may also contact potential licensee(s) on their initiative maintaining confidentiality and taking all necessary care so as not to affect the value of the IP through appropriate agreements such as Non-Disclosure Agreement (NDA) with the potential licensee(s) during technology marketing discussions.

In case NDA does not cover material transfer clause, an appropriate Material Transfer Agreement (MTA) such as in the case of biotechnology inventions shall be signed between the donor and the recipient of the material regarding the use of the subject material.

## **12. AGREEMENTS AND CONTRACTS**

### **12.1 AGREEMENT CATEGORIES AND AUTHORIZED SIGNATORIES**

All agreement including but not limited to the following categories, undertaken by any NIT Durgapur personnel and students need to be approved by NIT Durgapur.

- i. Allegiance, Affirmation & Confidentiality Agreement
- ii. Consultation Agreement
- iii. Evaluation Agreement
- iv. Research and Development Agreement
- v. License Agreement
- vi. Technology Transfer Agreement
- vii. Alternative Dispute Resolution Agreement
- viii. Classified Information Non-disclosure (specific) Agreement
- ix. Revenue Sharing Agreement

Dean (R&C) will act as a final signing authority in all the categories of agreements listed above. SRCC will facilitate the process of framing such agreements by way of providing templates and services of professional consultants.

## **12.2 INFRINGEMENTS, DAMAGES, LIABILITY AND INDEMNITY INSURANCE**

In any contract with the licensee, Institute shall obtain indemnity from legal proceedings against the Institute including its employees, without limitation, due to reasons including but not limited to manufacturing defects, production problems, design guarantee, up-gradation and debugging obligation. Generally Institute shall obtain, through appropriate agreement, indemnification from the organization to which IP is transferred, against any direct or third party legal liability arising out of commercial exploitation of IP. Any computer software developed and distributed by the Institute either through public domain or commercially, shall have explicit disclaimer against any liability arising out of the use of software by any user. Institute shall retain the right to engage in any litigation concerning patents and license infringements.

## **13. CONFLICT OF INTEREST**

All creators/inventors are responsible for compliance with government rules and NITD's policies and ordinances related to development and use of IP generated. In all activities arising out of implementation of IPR policy of the Institute, all faculty members/creators/inventors are expected to avoid potential and mutual conflicts of interest.

## **14. DISPUTE RESOLUTION**

In case of any disputes between NIT Durgapur and the creator(s) regarding the implementation of the IP policy, the creator(s) may appeal to the Director of NIT Durgapur. The Director's decision in this regard would be final and binding on both institute and creator.

## **15. JURISDICTION**

As a policy, all agreements to be signed by NIT Durgapur will have the jurisdiction of Kolkata High Court and shall be governed by appropriate laws in India.

## **16. FORMS FOR PATENT-RELATED APPLICATIONS**

NITDGP/P-1: REQUEST LETTER FOR PROVISIONAL PATENT FILING

NITDGP/P-2: INTELLECTUAL PROPERTY DISCLOSURE FORM

NITDGP/P-3: LICENSE AGREEMENT FORM

NITDGP/P-4: REVENUE SHARING AGREEMENT FORM(Institute & Inventor)

NITDGP/P-5: INSTITUTE APPROVAL TO A PATENT APPLICATION

NITDGP/P-6: PATENT-RELATED FUNDING REQUEST FORM

NITDGP/P-7: NOC/INSTITUTE APPROVAL FOR PROVISIONAL PATENT FILING



**NATIONAL INSTITUTE OF TECHNOLOGY DURGAPUR**  
**REQUEST LETTER FOR COMPLETE PATENT FILING**

I ..... [Name] working as.....  
[Designation] in Department of  
.....have developed a  
technical know-how

Titled: ....., which I feel has  
immense commercial potential, and can benefit the Institute (Please attach positive patent  
search report)

The source of funding for development of technical know-how in question is:  
.....

[If the source of funding is other than NIT Durgapur, then please attach the consent letter and/or  
no-objection from the funding agency and Memorandum of understanding or Agreements, if any]

I will abide by the rules and regulations for filing patent at NIT Durgapur

I am submitting the Intellectual Property Disclosure Format (IPDF) along with the  
application.

I also declare that by filing this Patent I am not voiding any agreement/MoU with any third  
party

.....  
Signature with Date and Name in Capital



FORM NO. NITDGP/P-2

**To**  
**Dean (R&C)**

**NATIONAL INSTITUTE OF TECHNOLOGY DURGAPUR**  
**INTELLECTUAL PROPERTY DISCLOSURE FORM**

**1. APPLICANTS:**

- (a) National Institute of Technology Durgapur, M G Avenue, Durgapur- 713209  
(b)  
(c)  
(Relevant MoU / Letter of request to be appended)

**2. TITLE OF THE INVENTION:**

- 3. TYPE OF THE PATENT APPLICATION: Provisional/ Complete/PCT/Foreign filing**  
(Please tick mark the relevant option)

**4. NAMES OF THE INVENTORS (Add /Delete, if applicable):**

Name:

Affiliation and Address:

Email ID:

Contact Mobile No:

Name:

Affiliation and Address:

Email ID:

Contact Mobile No:

**5. PUBLICATION OR DISCLOSURE OF THE INVENTION:**

(a) Whether the invention is disclosed before in public by  
publication/presentation/poster/display/launch

(b) Please provide details of such publication including title, date, etc.  
(Kindly append documents supporting the same)

**6. SPONSORING AGENCY DETAILS:**

(Kindly append any Terms & Conditions, MoU/Agreement therewith)

**7. INFORMATION ON STAGE OF THESIS (UG/PG/Doctoral):**

- (a) Thesis has been submitted and date of submission:
- (b) Expected date of thesis submission:

**8. USE OF BIOLOGICAL MATERIAL & INVOLVEMENT OF TRADITIONAL KNOWLEDGE:**

(Kindly give the details if any use of biological material has been made for the invention or any traditional knowledge is involved.)

**9. BACKGROUND:**

- (a) What led you to create this invention / what are the problems intended to be solved by your invention?
- (b) Current technologies /products/processes that provide solution(s) for the same problem(s)
- (c) How does your invention address/improve on the drawbacks and deficiencies of available solutions?

**10. DETAILS OF INVENTION:**

(Kindly enclose a brief abstract of the Invention highlighting the novel features thereof along with a few keywords in order to facilitate a patent search on the subject.)

- (a) 3-4 relevant keywords related to the invention
- (b) Whether your invention relates to a Product / Process / Both
- (c) Novel Features of the invention
- (d) Use /Applications of invention.
- (e) Alternatives to your invention (if any)

**11. COMMERCIALISATION DATA**

(Kindly give the names and complete addresses of different companies which could be interested in the commercial use of this technology.)

I / We hereby CERTIFY that the particulars herein given by me are correct to the best of my knowledge and belief.

Signature of Inventor(s) with date



To  
Dean (R&C)

FORM NO. NITDGP/P-3

## NATIONAL INSTITUTE OF TECHNOLOGY DURGAPUR

### LICENSE AGREEMENT

#### 1.0 THE AGREEMENT

1.1 THIS AGREEMENT made and entered into on this..... of ....., **Two Thousand**..... between **National Institute of Technology Durgapur, Mahatma Gandhi Avenue, Durgapur-713209, West Bengal** (hereinafter called **LICENSOR**) of the one part; AND

1.2 **M/s** .....a Company/Firm having its registered office in India at .....(her einafter called the **LICENSEE** which expression shall where the context so admits include its successors and permitted assignees) of the other part.

#### 2.0 PREAMBLE

2.1 WHEREAS National Institute of Technology Durgapur, A Government of India-funded Institute of National Importance,(hereinafter called the **LICENSOR**) has developed and is in full proccession of the patent right through .....an employee/student of the Institute to “.....” as detailed in Technology Document (hereinafter called **KNOW-HOW**) for production and sell of “.....” as specification laid down in Technology Document.

2.2 And whereas LICENSOR at the request of the LICENSEE has agreed to grant LICENCE to the LICENSEE for utilization the KNOW-HOW on terms & conditions hereinafter contained.

#### 3.0 SCOPE OF AGREEMENT

3.1 This Agreement details the modalities and the terms and conditions for the grant of LICENCE by LICENSOR to the LICENSEE for utilizing the said KNOW-HOW, the rights and obligation of either party hereto and the financial agreement between the parties.



**4.0 GRANT OF LICENCE**

- 4.1 In consideration of the payment as provided for in Clause 5.1 of this agreement and performance by the LICENSEE of the covenants herein contained LICENSOR hereby grants to the LICENSEE the LICENCE to utilize the KNOW-HOW to make, use and sell the PRODUCT.
- 4.2 LICENSOR is the owner of technologies, including the patents, copyright, trademark and trade secrets relating to ..... The LICENCE hereby granted to the LICENSEE by LICENSOR for utilization of KNOW-HOW **in India on Non-exclusive basis** and NIT Durgapur reserves the right to grant similar LICENCE as its discretion to others.
- 4.3 The LICENCE shall come into force from ..... (hereinafter called the EFFECTIVE DATE) and shall remain valid for the **period of five (05) years thereafter**.

**5.0 FINANCIAL AGREEMENTS**

- 5.1 In consideration of the LICENCE hereby granted and the transfer of KNOW-HOW by LICENSOR to the LICENSEE, the LICENSEE shall pay to LICENSOR as hereunder :

**LICENCE Fee :**

- 1) Lump sum premium of Rs. .... (Rupees ..... Lakh only) plus prevailing Service Tax on the date of signing Agreement (lump sum premium to be decided based on consensus among the inventor(s), Institute (IPR cell) and the licensee considering the invention and market.
- 2) Royalty: @ .....% of sale value on each product plus S.Tax at actual. The terms & conditions governing the payment of royalty as in revenue sharing clause(5). The % of royalty will be decided following the same mechanism as detailed under clause 1) of License Fee following the provisions of terms and conditions of Royalty payment as in ANNEXURE-I of this agreement.

**6.0 RESPONSIBILITIES OF LICENSOR**

- 6.1 Transfer of Know-how  
NIT DURGAPUR (LICENSOR) shall within 60 days of the EFFECTIVE DATE handover to the LICENSEE Technology Transfer Document (TTD) consisting of (a) Technical Specifications (b) manufacturing process (c) Bought-out Items containing list of materials used with specifications & list of necessary equipments & their specifications (d) Operational Manual containing Process Manual, Schematic list & necessary drawings etc.
- 6.2 The Transfer of Know-how shall be deemed as completed on performance by LICENSOR the task stipulated in Clause 6.1
- 6.3 LICENSOR shall guide the LICENSEE for successful commercialization of the Technology at the Lab.

**7.0 RESPONSIBILITIES OF LICENSEE**

- 7.1 The LICENSEE shall employ its best endeavor to work the KNOW-HOW and sell the PRODUCT on a commercial sell. The LICENSEE shall

commercialize the KNOW-HOW within a period of **twelve (12) months from the date of transfer** of KNOW-HOW as defined in Clause No.6.2. If the Licensee is unable to set up production within stipulated period, viz. **12 months** due to unavoidable circumstances and causes beyond the control of the Licensee, the LICENSEE shall make a request in writing for extension of the time limit before the expiry of the date, giving detailed reasons. The request will be carefully examined and considered by the Licensor and then decided on by the Licensor. The decision of the Licensor in this regard shall be final and binding on the Licensee.

- 7.2** Fulfillment of all procedural, legal, operational requirements for the commercial implementation of the KNOW-HOW shall be the responsibility of the LICENSEE.
- 7.3** The LICENSEE acknowledges the absolute ownership of KNOW-HOW by CSIR and shall not dispute the legality, validity or enforceability of LICENCE granted.
- 7.4** It shall not be opened to the LICENSEE to claim the KNOW-HOW in his / its own name on the plea of having affected any improvements/modifications upon the KNOW-HOW or upon the PRODUCT. All PRODUCTS manufactured by the LICENSEE shall be deemed to have been manufacture under the LICENCE hereby granted.
- 7.5** The LICENSEE shall permit the personal of LICENSOR or its attorneys or duly authorized persons, at all convenient time to enter into and upon any premises of LICENSEE where PRODUCTS under this LICENCE, are manufactured/stocked/ sold/used for the purpose of inspecting the same and manufacture thereof, generally to ascertain that the provision of this LICENCE are being completed with and quality of the PRODUCT maintained.
- 7.6** The LICENSEE shall not, at any time, assign, mortgage, charge, grant sub LICENCE or otherwise deal with possession or control of the LICENCE hereby granted.
- 7.7** The LICENSEE shall not directly or indirectly and either by itself or by its agents use the KNOW-HOW otherwise then in accordance with these presents.
- 7.8** The LICENSEE shall not file any application for seeking Intellectual Property Rights in its own name or in the name of other person(s) on any matter relating to the information disclosed to it by LICENSOR under this agreement, save with the written prior approval of CSIR.
- 7.9** The LICENSEE shall not oppose or direct or cause any person(s) to oppose any application seeking Intellectual Property Rights relating to the PRODUCT and/or KNOW-HOW filed by LICENSOR.
- 7.10** The LICENSEE shall treat as strictly confidential all information/knowledge obtained from LICENSOR in connection with or relating to the LICENCE hereby granted.

## **8.0 GENERAL PROVISIONS**

- 8.1** During the currency of the agreement both parties shall promptly disclose to each other in writing, all or any improvements or modifications made on the KNOW-HOW / PRODUCTS. All such improvements/modifications shall then formed an integral part of the KNOW-HOW.
- 8.2** These presents shall not be construed as a warranty by LICENSOR of the novelty, utility, sale ability and work ability of the KNOW-HOW / PRODUCT.
- 8.3** The agreement shall be the sole repository of the terms & conditions agreed to herein by and between LICENSOR and the LICENSEE and no amendment thereof shall take effect and be binding on either of them except as provided for in Clause 16.0 hereunder.
- 8.4** LICENSOR (NIT DURGAPUR) shall not be responsible for any damage to property/ plant/material/personnel of Licensee (.....)or a third Party during the course of or consequent to implementation of results of the KNOW-HOW by or on behalf of the LICENSEE (.....)

## **9.0 ACKNOWLEDGEMENT**

- 9.1** The LICENSEE shall affix in a conspicuous manner upon every PRODUCT and / or mode of packaging containing the PRODUCT a level or plate bearing the inscription "LICENSOR KNOW-HOW" in letters of size not less than half the nominal size of the largest size of letters given either the name of LICENSEE or its brand name or trade mark for the PRODUCT. The LICENSEE shall not sell PRODUCT without such level or plate being affixed thereon. Similarly every advertisement, hoarding, technical literature publicity and the like material in respect of or relative of the PRODUCT issued by the LICENSEE shall include the same inscription as aforesaid in a prominent manner.
- 9.2** LICENSEE should exhibit the **Logo of LICENSOR** prominently either on front or rear in all LICENCED PRODUCTS manufactured and sold.

## **10.0 FORCE MAJEURE**

- 10.1** Neither PARTY shall be held responsible for non-fulfillment of their respective obligations under this agreement due to the exigency of one or more of the force majeure events such as but not limited to acts of God, War, Flood, Earthquake, Strikes, Lockouts, Epidemics, Riots, Civil Commotions etc., provided on the occurrence and cessation of any such event the LICENSEE effected thereby shall give a notice in writing to the other PARTY within one month of such occurrence or cessation. If the force majeure conditions continue beyond six months, the PARTIES shall jointly decide about the future course of action.

## **11.0 INDEMNITY**

- 11.1** LICENSOR hereby agrees to authorize and to empower the LICENSEE to Institute and prosecute such suits or proceeding as the LICENSEE may deem expedient, to protect the rights hereby conferred and for the recoveries of damages and penalties for the infringement of such rights and to secure to the LICENSEE full benefits of this LICENCE and for any such purpose to use the name of LICENSOR. The LICENSEE in its term

shall indemnify the LICENSOR against damages, costs and expenses occasioned by such proceedings, and the LICENSOR shall in any such proceedings, at the expense of the LICENSEE afford to the LICENSEE all proper and or reasonable assistance in providing and defending its title to the grant of the rights hereby conferred.

- 11.2** The liability of the Licensor (NIT DURGAPUR), if any shall be limited only to the extent of the amount paid by the LICENSEE (.....)to LICENSOR (NIT DURGAPUR).

**12.0           TERMINATION OF AGREEMENT**

- 12.1** This agreement may be terminated by either of the PARTIES forthwith if the other PARTY commits breach of any of the terms hereof and shall have failed to rectify such breach within sixty (60) days of the notice in this behalf having been served of it by the other LICENSEE.

- 12.2** In addition to the reasons for termination as set forth above, this agreement may be terminated forthwith if either of the PARTIES voluntarily or involuntarily enters into composition, bankruptcy or similar reorganization proceedings or if applications invoking such proceedings have been filed.

**13.0           SETTLEMENTS**

- 13.1** Upon termination of the Agreement  
All rights granted to and the obligation undertaken by the PARTIES hereto shall cease to exist forthwith except the obligation of the LICENSEE to keep KNOW-HOW in confidence vide Clause No.7.10 herein and pay royalty as per Clause No.5.1(ii) above accrued on or prior to the date of such termination, make written reports and keep records, files and books hereto and the right of LICENSOR to inspect the same.

- 13.2** The LICENSEE or its assigns will not utilize the KNOW-HOW to manufacture the PRODUCT and the LICENSEE shall immediately deposit with LICENSOR the original and all copies TTD, and other documents/data related to this LICENCE received from LICENSOR.

- 13.3** The LICENSEE shall immediately pay to LICENSOR all amounts of money due from it up to the date of termination. Also all sums of money hereto paid by the LICENSEE under the terms of this LICENCE shall be forfeited to LICENSOR and the LICENSEE shall not be entitled to any credit or allowance in respect thereof.

- 13.4** The LICENSEE will not be debarred from disposing off the PRODUCTS which are already manufactured or in the process thereof by sale or otherwise. Such disposal will, however, not be effected unless and until the LICENSEE remits to LICENSOR the entire amount of royalty due, in accordance with Clause No.5 above including the PRODUCT sougheed be disposed off.

**14.0           NOTICES**

- 14.1** All notices and other communications required to be served on the

LICENSEE under the terms of this agreement, shall be considered to be duly served if the same shall have been delivered to, left with or posted by registered mail the LICENSEE at its last known address of business. Similarly, any notice to be given to NIT DURGAPUR shall be considered as duly served if the same shall have been delivered to, left or posted by registered mail to NIT DURGAPUR.

## **15.0 AMENDMENTS TO THE AGREEMENT**

**15.1** No amendment or modification of this agreement shall be valid unless the same is made in writing by both the parties or their authorized representatives and specifically stating the same to be an amendment of this agreement. The modifications/changes shall be effective from the date on which they are made/executed unless otherwise agreed to.

## **16.0 ASSIGNMENTS TO THE AGREEMENT**

**16.1** The rights and/or liabilities arising to any party to this agreement shall not be assigned except with the written consent of the other party and subject to such terms and conditions as may be mutually agreed upon.

## **17.0 CONFIDENTIALITY**

**17.1** During the tenure of this Agreement, all the parties undertake on their behalf and on behalf of their employees / representatives / associates involved in the joint project (s) to maintain a strict confidentiality and refrain from disclosure thereof, of all or any part of the information and data exchanged / generated under this Agreement for any purpose other than in accordance with this Agreement. Disclosure thereof for any purpose other than in accordance with this Agreement shall be a breach of this Agreement.

## **18.0 ARBITRATION**

**18.1** Except to hereinbefore provided any dispute arising out of this Agreement, the same shall be referred to the arbitration of two arbitrators, one to be appointed to each party to the dispute, and in case of difference of opinions between them to an umpire appointed by the said two arbitrators before entering on the reference, and the decision of such arbitrators or umpire, as the case may be, shall be final and binding on both parties. The venue of arbitration shall be at such place as may be fixed by such arbitrators or umpire and the arbitration proceedings shall take place under the Indian Arbitration Act, 1996 or any statutory modification thereof. Each party shall bear and pay its own cost of arbitration proceedings unless the arbitrator, otherwise, decides in the award (or shall be shared equally). The provision of this clause shall not become in-operative notwithstanding this Agreement expires or ceases to exist or if terminated or revoked.

**19.0 SEAL OF PARTIES**

**19.1** This agreement has been executed in two originals one of these has been retained by LICENSOR and the other by the LICENSEE. In witness whereof the parties hereto have signed this agreement the day, month and year mentioned hereinbefore.

*For and on behalf of LICENSOR*

*For and on behalf of LICENSEE*

Dean ( R&C).....

M/s .....  
.....  
.....

Main Inventor .....

**National Institute of Technology  
Durgapur  
Mahatma Gandhi Avenue,  
Durgapur-713209, West Bengal**

Seal:

Seal:

Date:

Date:

Signed at:

Signed at:

1. Witness (Name & Address)

1. Witness (Name & Address)

2. Witness (Name & Address)

2. Witness (Name & Address)



FORM NO. NITDGP/P-4

**NATIONAL INSTITUTE OF TECHNOLOGY DURGAPUR**  
**REVENUE SHARING AGREEMENT FORM**

I/We .....of the Department of....., National Institute of Technology Durgapur, being the main inventor/ inventors of the invention titled '.....under theIP Application No....., do hereby agree to abide by the revenue sharing clause(9 ) of the IPR Regulations of National Institute of Technology Durgapur.

Name(s) of the main inventor/Inventors .....

Signature(s) .....

Date: .....

Place.....



FORM NO. NITDGP/P-5

**NATIONAL INSTITUTE OF TECHNOLOGY DURGAPUR**  
**INSTITUTE APPROVAL TO A PATENT/IP APPLICATION**

I/We .....of the Department of....., National Institute of Technology Durgapur, being the main inventor/ inventors of the invention titled '.....under theIP Application No....., do hereby agree to abide by the revenue sharing clause( 5) of the IP Regulations of National Institute of Technology Durgapur.

Name(s) of the main inventor/Inventors .....

.....

Signature(s) .....

Date: .....

Place.....

**APPROVAL**

National Institute of Technology Durgapur is pleased to accord approval to the patent application on the invention entitled .....under Application No.....by the main inventor.....of the Department of ....., National Institute of Technology Durgapur.

Signature of Dean (R&C): .....With seal





FORM NO. NITDGP/P-6

**NATIONAL INSTITUTE OF TECHNOLOGY DURGAPUR**  
**PATENT/IP-RELATED FUNDING REQUEST FORM**

To

The Director, NIT Durgapur

Sir,

I/We .....of the Department of....., National Institute of Technology Durgapur, being the main inventor/ inventors of the invention titled '.....under the Patent Application No....., do hereby agree to abide by the revenue sharing clause( 5) of the Patent Regulations of National Institute of Technology Durgapur and request the Institute for kind consideration of sanction of Rs.....(Rupees)to reimburse expenses(bill attached)in connection with filing patent application/filing response to examination reports/early publication and examination/maintenance fee/commercialization/...../ of patent application (No. ) on the invention titled.....

A copy of the positive patent searching report/Patent application proof/ patent grant certificate is attached herewith for your kind consideration.

With regards,

Name(s) of the main inventor/Inventors .....

Signature(s) .....

Date: .....

Place.....



FORM NO. NITDGP/P-7

**NATIONAL INSTITUTE OF TECHNOLOGY DURGAPUR**

**NOC/INSTITUTE APPROVAL FOR PROVISIONAL PATENT FILING**

I/We..... holding the position of .....  
(designation) in the Department of..... NIT Durgapur  
and being the main inventor/inventors of the invention titled as  
..... and as invented in NIT  
Durgapur, request the Institute to issue NOC/ accord approval for provisional filing of  
application for patent right where I/ we agree to personally bear the cost of such  
provisional filing of patent application. I/We shall abide by the revenue sharing provisions  
as per NIT Durgapur IPR regulations.

Signature(s).....

**NOC/Approval from NIT Durgapur for Provisional Patent Filing**

National Institute of Technology Durgapur is pleased to accord approval to the above-  
mentioned provisional filing of patent application.

.....

Signature of Dean (R&C), NIT Durgapur with Seal