



**COUNCIL FOR SCIENTIFIC AND INDUSTRIAL
RESEARCH - GHANA**

INTELLECTUAL PROPERTY POLICY

CSIR - INTELLECTUAL PROPERTY POLICY

Copyright © CSIR-Ghana
1st March, 2021

Author: Kweku Ofosu-Tenkorang, Esq
Email: kwasolawyer@yahoo.co.uk

All rights reserved. No portion of this book may be reproduced in any form without permission from the publisher

Published by CSIR-Ghana
For any information please contact CSIR-Head Office
Tel: 0302-777651/2

ISBN: 978 – 9988 – 3 – 4381 – 1

Printed in Ghana by CSIR-INSTI (0303 780708/9)

Acknowledgements

The development of an Intellectual Property Policy for the Council for Scientific and Industrial Research (CSIR) has spanned several phases. These eventually led to the establishment of an Intellectual Property Office (CSIR IP Office) in 2012 under the West Africa Agricultural Productivity Programme (WAAPP) and the inauguration of institutional IP sub-committees in 2014. The IP policy was first drafted by Lawyer K. Ofosu Tenkorang (CSIR IP Office) in 2014. Subsequent revisions to the draft IP policy were made by Dr. Rita Abban (CSIR IP Office), with inputs from the institutes and management. More recently, it involved a review and update of the Draft IP Policy with technical assistance from the World Intellectual Property Organization (WIPO).

The contributions of all participants in the development of the CSIR IP Policy are acknowledged. Special mention goes to the WAAPP for its financial support; and to WIPO and the Senior Counsellor of the WIPO Regional Bureau for Africa, Mrs. Loretta Asiedu, for their technical support and guidance and Prof. Tom Ogada, International IP Consultant, for finalization of the IP policy.

Immense gratitude is expressed to officials of the CSIR for their commitment to and support of the project, and in particular, the former Director-General, Prof. Victor Agyeman; Prof. Rose Emma Mamaa Entsua-Mensah; and the immediate past Deputy Director-General, Prof. Paul Bosu.

For their technical guidance, appreciation is extended to Prof Paul Kuruk for reviewing the Draft IP Policy, Mr. Emmanuel Sackey, IP Development Executive at ARIPO, Mrs. Grace Issahaque, Chief State Attorney of the Registrar-General's Department; Mr. Samuel Anum, coordinator of the Swiss-Ghana IP Development Project of the Ministry of Trade and Industry; Prof. Paa Nii Johnson, former director of the CSIR Food Research Institute.

Prof. Paul P. Bosu

Director-General, CSIR

Contents

1.	PREAMBLE	1
2.	PURPOSE OF IP POLICY.....	2
3.	OBJECTIVES	2
4.	DEFINITIONS	2
5.	COVERAGE	8
6.	INSTITUTIONAL FRAMEWORK	9
7.	ADMINISTRATION	12
8.	NOTIFICATION AND COMPLIANCE	13
9.	OWNERSHIP OF INTELLECTUAL PROPERTY	14
10.	OBLIGATIONS AND RESPONSIBILITIES	26
11.	TANGIBLE RESEARCH PROPERTY.....	20
12.	COMMERCIALISATION OF INTELLECTUAL PROPERTY.....	22
13.	REVENUE DISTRIBUTION	23
14.	EQUITY PARTICIPATION.....	25
15.	WAIVER OF CSIR RIGHTS	30
16.	CONFLICT OF INTEREST	30
17.	RELATIONSHIP TO CONDITIONS OF SERVICE.....	31
18.	GOVERNING LAWS.....	32
19.	DISPUTE RESOLUTION	32
20.	DISCIPLINARY ACTION.....	32
21.	AMENDMENT.....	33
22.	EFFECTIVE DATE	33

T

T

THE COUNCIL FOR SCIENTIFIC AND INDUSTRIAL RESEARCH

INTELLECTUAL PROPERTY POLICY

1. PREAMBLE

The Council for Scientific and Industrial Research (CSIR) was established by National Liberation Council Decree 293 of October 10, 1968 and re-established in its present form by CSIR Act 521 of November 26, 1996 to promote, encourage and regulate research and the application of science and technology in development. The mission of the CSIR is to become the force for accelerated social and economic development for Ghana through examining, exploring and creating science and technology catalysts for public and private wealth creation. The CSIR is mandated to perform the following functions among others:

- a. To pursue the implementation of government policies on scientific research and development;
- b. To advise the Minister on scientific and technological advances likely to be of importance to national development;
- c. To encourage in the national interest scientific and industrial research of importance for development of agriculture, health, medicine, environment, technology and other service sectors and to this end to encourage close linkages with the productive sectors of the country;
- d. To co-ordinate all aspects of scientific research in the country and to ensure that the Council, the research institutes of the Council and other organizations engaged in research in Ghana, co-ordinate and operate in their research efforts;
- e. To encourage and promote the commercialization of research results;

CSIR - INTELLECTUAL PROPERTY POLICY

- f. To undertake or collaborate in the collation, publication and dissemination of the result of research and other useful technical information.

2. PURPOSE OF IP POLICY

To realize its mandate, the CSIR has developed this Intellectual Property (IP) Policy to regulate and encourage creativity as well as to protect and disseminate the results of the CSIR's research activities in diverse fields of Intellectual Property for the benefit of the public. It is hoped that the creation and development of Intellectual Property at the CSIR would encourage new business ventures through licensing, technology transfer and commercialization.

3. OBJECTIVES

The objectives of the Policy are as follows:

- (a) To protect the rights of the CSIR, its innovators, inventors, research sponsors and the public;
- (b) To optimize the environment and incentives for research and for the creation of new IP;
- (c) To promote creativity and innovation; and
- (d) To make available the IP assets created by the CSIR's employees and to commercialize them to the public.

4. DEFINITIONS

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

Assignment means an agreement by the holder of intellectual property rights for the transfer of title and interest in intellectual property to another party.

Author means any individual who creates a work that is protectable under the Copyright Act.

Background IP means IP that was generated before the commencement of research and development collaboration.

Commercialization means the process by which any Intellectual Property assets may be adapted or used for any purpose that may provide any benefit to society or commercial use on reasonable terms. It includes assignment, licensing and establishment of spin-offs to offer the Intellectual Property as a product or service.

Confidential Information means any IP, information or data of a confidential nature, including all oral and visual information or data, and all information or data recorded in writing or in any other medium or by any other method, and all IP, information and data which CSIR is under obligation, whether contractual or otherwise, not to divulge.

Copyright means an original work of authorship which has been fixed in any tangible medium of expression from which it can be perceived, reproduced or otherwise communicated, either directly or with the aid of a machine or device, such as books, articles, journals, software, computer programs, musical works, dramatic works, videos, multimedia products, sound recordings, paintings, pictorial, sculpture or graphical works.

Creator/Inventor means any person, who creates, conceives, reduces to practice, authors or otherwise makes a substantive intellectual contribution to the creation of IP and who meets the definition of “inventor” as implied in Ghana’s Patent Act of 2003 or the definition of “author” as generally applied in Copyright Law.

CSIR means the Council for Scientific and Industrial Research and includes all the Institutes and wholly owned companies of the CSIR.

CSIR Resources means funds, supplies, equipment, physical facilities, personnel, and/or other services or property of the CSIR. The resources include all tangible resources made available by CSIR to inventors, including office, laboratory and studio space and equipment; computer hardware, software and support; secretarial services;

CSIR - INTELLECTUAL PROPERTY POLICY

research, teaching and laboratory assistants; supplies and utilities; funding for research and teaching activities, travel and other funding or reimbursements.

CSIR Staff means all those employed by CSIR to undertake R&D activities including - researchers, scientists, employees, and technologists, employed by CSIR permanently or temporarily.

CSIR Student means a bona fide student of the CSIR Graduate School, CSIR staff on study leave and sponsored by CSIR who are studying in tertiary institutions both in Ghana or elsewhere.

Equity means shares of stock or securities including, but not limited to, stock options, warrants or any other rights to purchase stock or securities. For the purpose of this Policy, equity means shares owned by the CSIR and its Inventors in joint venture companies or other entities arising from commercialization of CSIR IP rights.

Geographical Indications means indications which identify a good as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of a good is essentially attributable to its geographical origin.

Gross Revenues means all income received by the CSIR arising from commercialization of IP rights

Independent Contractors or Consultants means persons hired by CSIR on a limited basis, and for a limited purpose as specified in a contract.

Industrial Design: Industrial design refers to the right granted to protect the original, ornamental and non-functional features of a product that result from design activity. The right concerns merely the appearance (the ‘design’) of a product, not the product itself. An industrial design has a term of protection of five years. It can be renewed for two consecutive periods of five years.

Innovation is an idea that has been transformed into practical reality. This means doing something new that improves a product, process or service. Many innovations can be protected through intellectual property rights.

Innovator means a person who transforms ideas into practical reality in the form of products, process or service.

Intellectual Property (IP) means all outputs of creative endeavor in any field for which proprietary rights may be obtained or enforced pursuant to any law, including the laws of Ghana, and includes, but is not limited to: Inventions (whether patentable or not), all forms of copyrighted works, designs (whether registered or unregistered), patents, new plant varieties, traditional knowledge, trademarks, know-how, trade secrets, domain names, information, data, discoveries, mathematical formulae, specifications, diagrams, expertise, techniques, research results, computer software, programming code, algorithms, compositions of matter and devices, techniques, processes, procedures, systems, formulations, databases and compilations of information, laboratory notebooks, business and research methods, the name of the CSIR, badge and other marks associated with the CSIR, Tangible Research Property, and such other property as may be specified by the CSIR in writing.

Invention means the 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. In order for an invention to be patentable, it must be novel, non-obvious and industrially applicable. All inventions are innovations.

Invention Disclosure means the written submission to the Authorized Office such as Intellectual Property Office (IPO) on the standard or prescribed invention or innovation disclosure forms available from IPO, of a written description of any Invention that an Innovator claims he or she has made.

CSIR - INTELLECTUAL PROPERTY POLICY

Invention Disclosure Form means the official form for disclosure of IP made available, or provided on submission of a written request to the CSIR Intellectual Property Office (IPO).

Inventor means a person who discovers, invents, develops, designs, or breeds

Know-how means any methods, techniques, processes, discoveries, inventions, innovations, unpatentable processes, specifications, recipes, formulae, designs, plans, documentation, drawings, data and other technical information and actual human artistic or technical skills derived from experience in working a certain art or technology.

Material Transfer Agreement means a contract covering transfer of physical possession and use of tangible research material into or out of the CSIR.

Neighboring or related rights are related or auxiliary to copyright and include sound recordings, audiovisual works, broadcasts and performances.

Net Revenue means gross revenue received less expenses incurred in protecting or promoting or commercializing the innovation or invention.

Non-Disclosure Agreement means an agreement or section of an agreement that prevents parties to the agreement releasing knowledge or information without the other's permission.

Non-employees of the CSIR means persons who are not employed by the CSIR, but who use CSIR funds, facilities and other resources or participate in CSIR-administered research, regardless of their obligations to other companies or organizations.

Patent means an exclusive right granted for an invention which provides the inventor with the exclusive right to prevent others from possessing, using, selling, manufacturing and importing the patented invention or offering to do any of these things within a definite geographical area. In Ghana, a patent is granted by the Registrar-General's Department for a period of 20 years from the filing date of application.

Plant Varieties comprise of given genotype or combination of genotypes distinguished from any other plant groupings by at least one characteristic. To be protected as intellectual property, the plant varieties must be new, distinct, uniform or stable.

Publications means books, textbooks, journal articles, booklets, bulletins, circulars, pamphlets, reports, information releases, exhibits, demonstrations, and other scholarly or popular writings regardless of medium.

Royalties mean revenue received by CSIR from a third party that is exploiting CSIR IP rights through licensing agreement.

Significant use of CSIR resources means the use of CSIR facilities including the use of office space, laboratories, equipment, computers and library facilities, human resources (including supervision) or Background IP but excludes use for which the CSIR is compensated.

Tangible Research Property means research results that are in a tangible form and have a physical embodiment. Examples of tangible research property include cell lines, software, devices, compositions of matter, biological materials, engineering drawings, integrated circuit chips, prototype devices, circuit diagrams, and equipment irrespective of whether or not protectable under any intellectual property regime. Tangible research property may be distributed without securing IP protection by using some form of contractual agreement, such as formal contract, loan agreement, letter agreement, or user license.

Trademark means any word, phrase, logo, name, symbol, device, sign or any combination thereof, used by a person or which a person has a bona fide intention to use in commerce and uses or applies to register, to identify and distinguish his goods from those of others which includes the container of the products or the packaging.

Trade Secret means any device or confidential data, information or compilations used in research, business, commerce and industry which is not generally known or accessible, and confers competitive advantage on one having the right to use it. The

CSIR - INTELLECTUAL PROPERTY POLICY

information has commercial value because it is secret or confidential. Trade secret protection requires the owner to take reasonable steps to protect the secret such as limiting access to the secret. Trade secret may last indefinitely, but will be lost when the information becomes generally known. No filing or registration is required for trade secret protection.

Traditional Knowledge or Indigenous Knowledge refers to the knowledge encompassing a wide variety of areas held by traditional, indigenous or local groups or communities or knowledge acquired in a non-systematic way which has significance and relevance not only to its holders but also to the rest of humanity.

Utility Model means an invention that is new and industrially applicable and is usually sought for technically less complex inventions or for inventions that have a short commercial life and normally do not meet the patentability criteria. A utility model has a term of protection of seven years which cannot be renewed.

Visitor(s) means all persons who are neither employees nor staff of CSIR and includes visiting researchers, scientists, professors, lecturers, volunteers, and any other individuals who engage in work or participate in research or teaching sponsored or hosted by the funds or other resources of the CSIR.

Work for Hire means a work prepared by an employee or contractor within the scope of his or her engagement and includes expressly commissioned works for instructional, public service, or administrative use.

5. COVERAGE

(a) IP assets and rights covered

Subject to the definitions ascribed under this Policy, and the laws governing the same in Ghana, and without limiting the generality of the term IP, this Policy shall cover all types of Intellectual Property Rights recognized under Ghana Law including patents,

utility models, trademarks and service marks, copyrights and related rights, industrial designs, trade secrets, new plant varieties, integrated circuits and designs, geographical indications, and traditional knowledge.

The policy shall also cover all research and creative activities, tangible research properties with or without IP protection, whether for commercial or non-commercial purpose, undertaken by CSIR, and including all technology transfer arrangements.

(b) Persons covered

Persons covered by this Policy include:

- (i) Current CSIR staff and students
- (ii) Former CSIR staff and students
- (iii) Independent contractors or consultants of CSIR
- (iv) Non-employees of the CSIR

6. INSTITUTIONAL FRAMEWORK

STRUCTURES

(a) CSIR Intellectual Property Office

The policy provides for the establishment of an Intellectual Property Office (CSIR IP Office) at the CSIR Head Office to administer and manage the development, protection, and commercialization of CSIR's IP Assets.

In carrying out its functions for the management of IP through the Intellectual Property Office as provided for under this Policy, the CSIR IP Office will collaborate with the CSIR Legal Office, CSIR Commercialization Unit and Spin-off companies. A framework for collaboration and coordination will be worked out and reviewed from time to time however, the CSIR IP Office may consult with or notify the CSIR Legal

CSIR - INTELLECTUAL PROPERTY POLICY

Office about the terms of agreements the CSIR IP Office negotiates for the management of CSIR IP assets.

The CSIR IP Office will report to the CSIR IP Committee.

(b) CSIR IP Committee

The Policy provides for the establishment of a CSIR IP Committee to oversee the handling and management of CSIR IP assets.

The CSIR IP Committee shall comprise not more than 15 members as follows:

- (i) Chairman appointed by the Director General in consultation with the Director's Management Committee.
- (ii) IP Focal Points from each of the 13 institutes.
- (iii) The CSIR IP Officer.
- (iv) The CSIR Legal Officer – Ex-Officio, Secretary.

(c) Institutes Intellectual Property Desks

The Policy provides for the establishment of an Intellectual Property Desk (IP Desk) in each Institute to liaise with the CSIR IP Office and coordinate activities for the management of CSIR IP assets generated in the Institute. The Institutes IP Focal Point, who will be appointed by the Institute's Director, will serve as the head.

FUNCTIONS

(d) CSIR Intellectual Property Office

The functions of the Intellectual Property Office are to:

- (i) Promote Intellectual Property in a manner consistent with the CSIR's mandate, vision and mission.

- (ii) Review, negotiate and advise on all agreements that convey or affect the CSIR's right to intellectual property.
- (iii) Attend to all aspects of IP transactions associated with the commercialization of the IP, including marketing, the negotiation of license to, or assignment of CSIR IP.
- (iv) Receive disclosure of potential IP through the submission of an IP Disclosure Form by a Creator, analyze the disclosures; and decide on an appropriate course of action.
- (v) Advise on the measures necessary to facilitate access to IP assets of the CSIR.
- (vi) Process patent, trade mark, utility model and other intellectual applications with relevant national, regional and international organizations.
- (vii) Create awareness of the importance and role of IP rights.
- (viii) Administer the IP Fund, the proceeds of which are to be used on IP related issues as specified by the Director-General.

(e) CSIR Intellectual Property Committee

The duties of the CSIR IP Committee include, but are not limited to the following:

- (i) Advise the Director-General on policy matters relating to IP.
- (ii) Oversee and evaluate the IP management program.
- (iii) Propose amendments considered necessary to the IP Policy.
- (iv) Receive and review the annual report of the IP Office(r).
- (v) Review procedures and practices and make recommendations for future

CSIR - INTELLECTUAL PROPERTY POLICY

directions and achievements of the objectives of the CSIR.

- (vi) Advise the CSIR on matters relating to the establishment of spin-out companies and the share in equity of the founders of such companies.
- (vii) Resolve conflicts of interest, disagreements involving revenue distribution, and any other disputes that may arise from the interpretation of this IP Policy.
- (viii) Issue an annual report to the Director-General on its activities, the status of CSIR's IP holdings, and the implementation of the IP Policy.
- (ix) Recommend any exception from this Policy.

(f) CSIR Intellectual Property Desks

The duties of the CSIR IP Desk are to:

- (i) Liaise with the CSIR IP Office and coordinate the issues that arise regarding the identification and protection of Intellectual Property within the Institute.
- (ii) Perform such tasks as may be delegated by the CSIR IP Committee or CSIR IP Office.

7. ADMINISTRATION

The administrative authority over all matters of IP in the CSIR is vested in the Director-General who may issue administrative procedures as are necessary or desirable for the implementation of this Policy. The Director-General shall be responsible for ensuring that information related to the existence and terms of the Policy is regularly disseminated or made available to CSIR staff.

The Director-General shall have final authority to act for the CSIR in all matters involving Intellectual Property issues of the CSIR.

8. NOTIFICATION AND COMPLIANCE

- (a) All staff and Institutes shall be notified of the provisions of this policy within thirty (30) days of its adoption.
- (b) All persons covered by this Policy shall comply with its provisions.
- (c) All persons covered by this Policy shall be required to sign the CSIR Intellectual property Policy Acceptance Agreement Form within 60 days of the adoption of this Policy for existing staff, students and visitors; and on the date of hire, enrolment, or visit as the case may be, for new staff, students or visitors. In the Form the signatories will agree to commitments on innovations, inventions and proprietary information in accordance with this Policy and such Form shall be placed in appropriate personnel files with a copy to the Head of the relevant Institute and the CSIR IPO.
- (d) Where an external researcher is already subject to the terms of an intellectual property policy of his or her parent institution, he or she shall inform the CSIR of such an obligation in a timely manner. The Council shall then proceed either to negotiate a waiver of the parent institution's policy or to agree to the waiver of the terms of this policy. Where issues arise which are not covered by the terms of the agreement between the CSIR and external researcher, the provisions of this Policy shall apply.

9. OWNERSHIP OF INTELLECTUAL PROPERTY

CSIR Owned Intellectual Property

(a) *Intellectual Property Generally*

All rights in intellectual property created by CSIR staff, in the course and scope of their employment, and by students and visitors, shall be owned by the CSIR, unless the intellectual property was developed without significant use of facilities, resources or funds owned or administered by the CSIR.

(b) *Copyrights*

- (i) Any copyrightable work created by CSIR staff within the scope of employment or commissioned by the CSIR from its staff, students and visitors shall be deemed “work for hire” and CSIR shall own the copyright.
- (ii) Copyrightable works in which the CSIR may claim ownership rights as works of hire include software, textbooks, course materials, scholarly papers, publication and articles, technical designs as well as integrated circuit designs, photographs and digital images taken by CSIR staff for the CSIR website and social media, formulas and codes describing any compound or materials whether biological or not and research data arising from CSIR research.

(c) *Trademarks*

The CSIR shall have the sole ownership and right to register and display trademarks domain names using the name and logo of CSIR. No person, institution or organization shall use or alter the name, trade mark, service mark or logo of the CSIR or any combination thereof for any application or process whatsoever except as provided for under the provisions of this Policy as follows:

CSIR - INTELLECTUAL PROPERTY POLICY

- (i) Attaching or using the CSIR's name, trademark and logo or any combination thereof in connection with any application, process, event, activity, publication, product or service is permitted ONLY if the application, process, event, activity, publication, product or service is one for which the CSIR has formally accepted institutional responsibility.
- (ii) CSIR staff may use the CSIR name, marks and logo ONLY for official CSIR business. Staff using the CSIR name, logo and marks in connection with activities conducted outside the scope of their employment must use their exact title and must not imply that the CSIR endorses the product or activity.
- (iii) Personal letters may not be written on stationery bearing the CSIR names, marks and logo, especially in matters that may involve controversy, endorsements or solicitations for non-CSIR purposes.
- (iv) CSIR will own all trademarks registered by the institutes on products that are developed and commercialized by these institutes.

Assignment of Intellectual Property Rights

- (a) Where the CSIR possesses rights of ownership in intellectual property, it will be the duty of the CSIR to acknowledge CSIR ownership and to execute the documents required to demonstrate CSIR ownership.
- (b) If any intellectual property is determined, in accordance with this Policy to be owned by CSIR, the Creator will execute an assignment of rights, wherein they assign all rights, title and interests to CSIR. Formal execution of this assignment may be accomplished when disclosure is made with the CSIR IP Committee, or with the CSIR IP Office or relevant CSIR IP Desk as may be authorized by the CSIR IP Committee.

CSIR - INTELLECTUAL PROPERTY POLICY

- (c) If the CSIR cannot, or decides not to, proceed in a timely manner to protect an innovation or innovation using an intellectual policy regime and/or to license or commercialize the invention, it may reassign ownership to the innovator or inventor at the latter's request.
- (d) Rights of ownership claimed by or assigned to the CSIR will be managed by the CSIR-IP Office and overseen by the CSIR IP Committee.

Creator Owned Intellectual Property

(a) *Intellectual Property Generally*

CSIR staff, students and visitors may own intellectual property in the following circumstances:

- (i) Where there has not been significant use of CSIR resources.
- (ii) Where the innovator or inventor had disclosed the nature and scope of his or her research and has been allowed to compensate the CSIR for the use of the CSIR's facilities and equipment as charged by the CSIR to outsiders.
- (iii) Where the CSIR is involved in collaborative research with another person, institution, or business entity, in which case the intellectual property may be jointly owned and the distribution of royalties shall be governed by the contractual arrangements between the parties.
- (iv) Where it has been expressly provided for between the CSIR and the research sponsor; and
- (v) Where it has been expressly provided for between the CSIR staff, students and visitors.

(b) *Copyrights*

- (i) The ownership of copyrights to works of literary and artistic works such as novels, poems, paintings, musical compositions or other such

works of imagination produced by the CSIR staff who have a general obligation to produce such works, where the specific choice, content, course, and direction of the effort is determined by the staff member without direct assignment or supervision by the CSIR 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 CSIR.

- (ii) For the purpose of commercializing works for which CSIR staff are recognized as Authors, the CSIR may at any time and under special circumstances require assignment by CSIR staff of copyrights in their works and the CSIR employees shall take such action as required to complete the assignment provided that the assignment of copyright will contain terms which will enable the CSIR staff 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.
- (iii) Upon request by the CSIR, the Creator(s) shall grant the CSIR a non-exclusive, free of cost, worldwide right and license to exercise all copyright rights in and to the work.
- (iv) CSIR research contracts shall protect the right of the staff, students and visitors to publish the results of their work, but may allow some time for the filing of patent applications or other moves to protect intellectual property.

Sponsored Research

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

CSIR - INTELLECTUAL PROPERTY POLICY

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 CSIR IP Committee.

Collaborative Research

The rights of any Intellectual Property that is made, discovered, or created in the course of collaborative research, shall be jointly owned unless otherwise specified in the contract.

Privately sponsored Research

The rights any Intellectual Property that is made, discovered, or created from privately sponsored research shall be jointly owned unless otherwise specified by the contract.

CSIR-Industry Partnership

- (a) A private entity, organization or company may become a licensee of CSIR IP if such private entity or organization has the capacity to manage and commercialize the IP in a manner that benefits the public.
- (b) Any private entity or organization may become a co-owner of the CSIR IP if:
 - i) there has been a contribution of resources, which may include relevant Background IP by the private entity or organization.
 - ii) the IP is jointly created by the entity or organization and the CSIR.
 - iii) appropriate arrangements are made for benefit-sharing for IP creators at the CSIR.
- (c) The CSIR and the private entity or organization conclude an agreement for the commercialization of the IP.
- (d) Should the private entity or organization mentioned above in subsection 11(b) not commercialize the IP, CSIR may take appropriate measures to terminate the agreement and ensure that the IP is re-assigned to the CSIR.

Student Work

- (a) Students of CSIR shall be required to recognize the full rights of the CSIR during their course of study in respect of any IP developed using CSIR's resources where they:
 - (i) Hold awards such as scholarships or fellowships through CSIR under which the funding body has placed restrictions as to IP developed during the course of the award
 - (ii) Are co-inventors or co-creators with a party or parties required to assign the IP rights to CSIR
 - (iii) Utilize proprietary know-how provided by a party or parties required to assign their IP to CSIR
 - (iv) Are assigned, directed, specifically funded, or commissioned by the CSIR to develop the IP.
- (b) Students shall own any intellectual property that they make, discover, or create in the course of their research unless:
 - (i) The student has received financial support from the CSIR in the form of wages, salary, stipend or grant funds for the research in which case the ownership shall be negotiable
 - (ii) The student has made significant use of CSIR resources in connection with the research
 - (iii) The research has been funded by a sponsor under a grant or sponsored research agreement, or is subject to a materials transfer agreement, confidential disclosure agreement or other legal obligation that restricts ownership of the intellectual property.
- (c) The texts of all student theses and dissertations, and works derived from such works, are considered exempted scholarly works. The students shall own

CSIR - INTELLECTUAL PROPERTY POLICY

copyright in the scholarly work subject to a royalty-free license to the CSIR to reproduce and publish the work. Students shall be allowed to publish their theses and dissertations unless they have agreed in writing to restrictions that preclude or delay publication.

Claims and Disputes

- (a) When there is a dispute between the CSIR and Creator(s), or between Creators over ownership of Intellectual Property, the dispute shall be resolved as per the Dispute Resolution section of this Policy.
- (b) Any employee/staff researcher or scientist of CSIR who wishes to claim or contest a right involving IP shall provide to the relevant CSIR IP Desk the following information in writing:
 - (i) the circumstances under which the IP originated.
 - (ii) the scope of the claimant's employment and duties at the time it originated.
 - (iii) any other documentary evidence supporting the claim.
- (c) The claimant shall bear the burden of proving his or her ownership or rights to IP. Any disputes that cannot be resolved by the CSIR IP Desk shall be referred to the CSIR IP Committee.
- (d) Irrespective of who is determined to own the IP, the inventor/author/creator shall be mentioned/named/associated with the work and the inventor/author/creator shall enjoy his or her moral rights in perpetuity.

9. TANGIBLE RESEARCH PROPERTY

- (a) All the tangible research property leaving the CSIR shall be governed by a Material Transfer Agreement (MTA). Any proprietary information accompanying tangible research property will be governed by a Non-Disclosure Agreement.

- (b) The CSIR-IPO will lay down the guidelines and procedures and prepare agreements for the distribution or sharing of all information and materials related to tangible research property.
- (c) If an employee/researcher 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 CSIR form of MTA, which is provided by the CSIR-IP Office together with instructions for the use of each form. The various forms of MTA will establish rights and responsibilities regarding the materials between the CSIR and the third party researcher in order to minimize future confusion and controversy regarding the use of the materials and ownership of Intellectual Property and Inventions based on the supplied materials.
- (d) 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 CSIR through the IP Office under the procedures set forth in this IP policy.
- (e) If a CSIR Employee receives materials from a third party organization (non-profit or commercial), the other organization may impose serious use and transfer restrictions on the materials and may claim an ownership interest in Inventions, Copyrightable Works, or other Intellectual Property that arise in the course of research performed with such materials. For this reason, only the Director-General is authorized to approve and execute agreements governing receipt of materials from other organizations. In addition, the researcher/employee is encouraged to consult with the CSIR-IP Office through the relevant CSIR IP Desk regarding the restrictions applicable to a particular material from a third party researcher before proceeding to use the said material in their research.

- (f) If any tangible research property developed by CSIR as a result of research activities is to be distributed to outside users for commercial purposes, the distribution agreement must contain provisions negotiated by CSIR IP Committee or CSIR IP Office covering the terms under which the property may be used, limits on CSIR's liability for the property or products derived therefrom, and disposition of any royalty income to CSIR from the licensing of intangible property rights associated with the use of the tangible property.
- (g) If the tangible research property results from sponsored research, the CSIR IP Committee and/or CSIR IP Office should be consulted through the relevant CSIR IP Desk regarding contractual obligations and regulations affecting ownership, notices, acknowledgments, disposition of various rights, and restrictions on the distribution and use of the tangible research property and any associated income.

10. COMMERCIALISATION OF INTELLECTUAL PROPERTY

- (a) General Provisions
 - (i) The CSIR may sell or license inventions, innovations or other IP in which it has ownership rights.
 - (ii) The CSIR may create spin-offs for the exploitation or management of IP assets it owns.
 - (iii) The CSIR may negotiate with Government the terms of access to CSIR IP which is of public interest.
 - (iv) The CSIR may collaborate with a third party regarding joint commercial exploitation of CSIR IP.

11. REVENUE DISTRIBUTION

- (a) Revenues received as a result of licensing agreements or technology transfer income and other non-equity revenue derived from the commercialization of the CSIR's Intellectual Property in the form of cash royalties and/or equity holdings shall be distributed at the end of each accounting period in such a manner as to encourage the development of intellectual property, technology development and technology transfer in the CSIR.
- (b) For the avoidance of doubt, "revenues" shall not include funds received for research support.
- (c) The CSIR costs for drafting, filing and processing intellectual property applications and maintaining these rights and in evaluating and marketing CSIR Intellectual Property rights obtained shall be reimbursed from gross revenue prior to distributing royalties to innovators and inventors.
- (d) The revenue distributable shall be net of all the expenses incurred by the CSIR in protecting and commercializing the intellectual property, and defending or prosecuting any and all infringement suits that might arise.
- (e) Where the CSIR prevails in an infringement suit and receives a financial settlement, the relevant innovator, inventor and the CSIR shall be reimbursed for their shares of royalties used by the CSIR in prosecuting or defending the infringement. Any funds received in excess of the royalties shall be distributed in accordance with the formula or scheme under this Policy.
- (f) The CSIR must apportion part of the net revenue for funding, among other things, more research and development, the operations of the CSIR IP Office, and statutory protection of CSIR IP.

CSIR - INTELLECTUAL PROPERTY POLICY

- (g) The CSIR shall create and maintain an IP Endowment Fund in which shall be paid gifts, contributions, and donations to support research and development in accordance with this Policy.
- (h) The distribution of Net Revenues shall be made quarterly, half-yearly or annually as determined by the CSIR IP Committee and in accordance with the following scheme:

UNIT	Copyrights PERCENTAGE	Patents/Plant Varieties PERCENTAGE	Other IP PERCENTAGE
Innovators/ inventors	40%	55%	50%
Corporate CSIR	15%	10%	10%
CSIR Institute	25%	20%	20%
CSIR IP Office	10%	5%	10%
IP Fund	10%	10%	10%
Total	100%	100%	100%

- (i) Where there are 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.
- (j) The innovator's personal share shall survive the termination of affiliation with the CSIR and in the event of the death of the innovator his or her share shall go to the beneficiary(s) identified (in absence of a will, CSIR form specifying next of kin).
- (k) Revenue distribution will continue as long as there is a revenue stream.
- (l) Disagreement involving revenue distribution will be reviewed and resolved by the CSIR IP Committee; and relevant parties may appeal the IP Committee resolution to the Director-General.

12. EQUITY PARTICIPATION

The CSIR may at times accept equity from a corporate licensee as part of the licensing or joint venture agreement.

- (a) Subject to the CSIR's rules and regulations, the CSIR may accept an equity in lieu of full or part payment of royalties in addition to monetary consideration for intellectual property in a company, corporation, partnership or enterprise pursuant to the provisions of this Policy. If the CSIR receives equity shares in connection with the commercialization of the Intellectual Property, such equity will be held on behalf of the CSIR by the Director-General.
- (b) CSIR acceptance of equity in consideration of licensing a CSIR innovation or joint venture shall be based upon the principles of transparency, objectivity and fairness in decision-making and the pre-eminence of the research and public service missions of the CSIR over financial or individual personal gain. Such licensing activity shall be conducted in accordance with this and other related CSIR policies and guidelines.
- (d) The terms of license of Intellectual Property Right, other than those related to the acceptance of equity in the company by the CSIR shall be consistent with CSIR transactions for comparable innovations.
- (e) When the CSIR accepts equity in a company as partial consideration for a license, the CSIR shall take into account any legal restrictions and the wishes of each innovator or inventor involved.
- (f) The CSIR shall pay the Innovator's share of equity consistent with the formula established under this Policy for the distribution or royalties.
- (g) The CSIR shall distribute cash upon conversion of equity to cash, in accordance with the royalty distribution formula under this policy.

13. OBLIGATIONS AND RESPONSIBILITIES

(a) Obligations and Responsibilities of the Creator/Inventor

The Creator shall have the following obligations and duties:

- (i) To report and disclose research activities as soon as possible to the relevant CSIR IP Desk which shall subsequently relay the report to the CSIR IP Committee.
- (ii) To offer effective cooperation with the CSIR IP Office in evaluation of the research to assess its potential.
- (iii) To disclose all potential conflicts or interest to the CSIR IP Office through the relevant CSIR IP Desk.
- (iv) To abide by all commitments made in a license, sponsored research and other agreements, laws relating to privately funded research.
- (v) To arrange for the safe keeping of all records and documents necessary for the protection of the CSIR's interest in the intellectual property.
- (vi) To provide such assistance as may be necessary throughout the technology transfer process, to protect and effect the transfer or the intellectual property.
- (vii) To take precautionary measures against public disclosure of the said research results until the evaluation process is completed and a decision whether to pursue IP protection or not has been made.
- (viii) To retain appropriate records of their research such as through the use of laboratory notebooks and the records of inventions in the form of original research data.

- (ix) To disclose the development of any IP to the CSIR IP Office through the relevant CSIR IP Desk as early as possible, but within 90 days of the discovery, by means of an IP Disclosure Form.
- (x) To review their work prior to any Public Disclosure to assess whether it contains any protectable IP, in particular a patentable invention, and if so to timeously disclose it to the relevant CSIR IP Desk on an IP Disclosure Form ahead of the planned public disclosure so that if warranted the IP can be protected.
- (xi) To take steps to maintain confidentiality of protectable IP until protection has been obtained.
- (xii) To conclude in a timely manner, all assignments of IP necessary to give effect to the ownership provisions set out in this Policy and to allow for the use and commercialization of the IP by the CSIR in accordance with this Policy.
- (xiii) To co-operate with CSIR IP Office to assist in preparing, receiving, signing, and abiding by the terms of all documents necessary for the protection and exploitation of an invention (including but not limited to patent specifications, official forms, marketing materials, technical descriptions, confidentiality agreements and license agreements).
- (xiv) To ensure that the IP rights relating to their work have been classified in writing prior to any sabbatical visit or exchange program and that any contractual arrangements are approved and authorized by the CSIR IP Office(r).
- (xv) To ensure that the CSIR IP Office(r) or relevant CSIR IP Desk is in receipt of their current address details for the purpose of revenue/royalty sharing.
- (xvi) To contact the CSIR IP Office to negotiate terms for continued access to IP

and Tangible Research Property even if he/she is a creator of it, on leaving the CSIR.

- (xvii) Prior to, or on, or within three (3) months of, arrival at the CSIR, to declare Background IP to the relevant CSIR IP Desk.

(b) Obligations and Responsibilities of the CSIR

The CSIR through the CSIR IP Committee, the CSIR IP Desks and the CSIR IP Office, shall have the following obligations and duties:

- (i) To exercise due diligence in handling all matters pertaining to the disclosure of research activities.
- (ii) To provide effective and practical measures and procedures for the disclosure of IP and ensure that IP emanating from CSIR is appropriately protected before results of such research and development are published or publicly disclosed by other means.
- (iii) To ensure that CSIR staff make a disclosure to it within 90 days or such a period as may be prescribed, of identification by such staff of possible IP and before the IP is made public.
- (iv) To assess the IP to determine whether it merits statutory protection and, where appropriate, apply for and use best efforts to obtain statutory protection in the name of the CSIR.
- (v) To raise awareness among staff on IP issues.
- (vi) To manage revenues due to the CSIR from IP transactions and the commercialization thereof, including managing the revenue-sharing arrangements with IP creators at the CSIR.

CSIR - INTELLECTUAL PROPERTY POLICY

- (vii) To negotiate and enter into IP transactions with third parties on IP belonging to CSIR.
- (viii) To provide incentives to CSIR Staff or creators to reward them for proactively securing protection for IP and commercializing it and generally, for promoting innovation.
- (ix) To develop guidelines for IP transactions and manage the implementation of such guidelines.
- (x) To provide support, where necessary, in terms of monetary consideration and infrastructural facilities in order to foster effective administration of IP.
- (xi) To obtain legal protection for the IP for the interests of the CSIR and creator of the IP against unauthorized use by a third party
- (xii) To advertise and commercialize the IP assets as deemed appropriate for the interest of the CSIR, researcher and the general public.
- (xiii) To assist the Creator where necessary, in finding an external partner or financial support.
- (xiv) To endeavour to negotiate and manage IP-related agreements to the best advantage of the author/inventor/researcher and the CSIR.
- (xv) To ensure that such agreements are consistent with IP policy and respective guidelines.
- (xvi) To ensure that a system is put into place that will oblige persons covered under this Policy to disclose any information with IP potentials which is acquired, developed or accessed while dealing or using CSIR resources.

CSIR - INTELLECTUAL PROPERTY POLICY

- (xvii) To ensure that IP Disclosure Forms are designed and are available for inventors and researchers.
- (xviii) To ensure that the information disclosed is kept confidential.
- (xix) To ensure that those who access or deal with the information disclosed sign a separate undertaking which binds them not to disclose the said information to third parties unless otherwise authorized in writing by the CSIR IP Committee in consultation with the researcher.
- (xx) To ensure that the awareness campaign on IP issues is set and is carried out at all levels through seminars, workshops and brief lectures by IP experts or any other available means as circumstances dictate.
- (xxi) To notify CSIR visitors of this Policy and obtain written acknowledgement from the Visitors that they are aware that they are bound by this Policy in the absence of any written agreement to the contrary.

14. WAIVER OF CSIR RIGHTS

- (a) Waivers of the provisions of this Policy may be granted by the CSIR IP Committee on a case-by-case basis, giving consideration to among other things, the CSIR's obligations to sponsors, whether the waiver would be in the best interest of technology transfer, whether the waiver would be in the best interest of CSIR, and whether the waiver would result in a conflict of interest.

15. CONFLICT OF INTEREST

- (a) CSIR employees are expected to accord the CSIR their primary professional loyalty and to ensure that outside obligations, financial interests and activities do not conflict with their commitment to the CSIR. In particular, employees should not seek to influence the CSIR's IP

commercialization decisions in such a way as to promote personal gain or advantage to their associates or that may lead to reduced income for the CSIR.

- (b) Where an employee is, or may potentially be in a position of conflict of interest in respect to commercialization of IP by the CSIR, the employee must promptly disclose this situation to the CSIR in order for a strategy that resolves the conflict of interest to be negotiated.
- (c) An employee who has an economic interest in a commercialization project of the CSIR shall still be entitled to receive benefits due to them as a Creator of the IP. However, an employee shall disqualify himself or herself from participating in any licensing negotiations or other matters of technology transfer where the CSIR is likely to be disadvantaged in circumstances such as:
 - (i) Where the employee of the CSIR is an interested party and by virtue of his or her position is likely to influence the decision.
 - (ii) Where an employee has an external relationship with a company that itself has a financial interest in a CSIR project or
 - (iii) Where the CSIR official serves on a board of a company that has financial transactions with the CSIR or
 - (iv) Where an employee has equity holding or royalty expectations that could influence the decision.

16. RELATIONSHIP TO CONDITIONS OF SERVICE

The terms of this IP Policy are considered as part of the contractual relationship of the CSIR with the employee. This Policy, as amended from time to time, shall be deemed to

be part of the conditions of employment of every CSIR employee. All employees/staff must know and comply with the requirements of this IP Policy.

17. GOVERNING LAWS

This Policy shall be interpreted in accordance with the CSIR Act 521 and all applicable national laws, regulations and policies made there under.

18. DISPUTE RESOLUTION

- (a) Any party aggrieved by the decision of the CSIR IP Office or CSIR IP Committee shall have a right of appeal to the Director-General, upon which the Director-General shall appoint a five-member independent panel comprising of persons knowledgeable with the discipline.
- (b) The panel shall elect its Chair and Secretary.
- (c) The panel shall hear both parties to the dispute and any other person they deem fit.
- (d) In the event of any party being dissatisfied with the decision of the panel he or she shall have a right of appeal to the full CSIR Council through the Council Chairman. The Council shall set up an independent panel to hear the appeal and report back to Council with its recommendations by the Council's next regularly scheduled meeting. The Council shall then determine and communicate its decision on the matter within one month from the date of receipt of the panel report.

19. DISCIPLINARY ACTION

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

20. AMENDMENT

- (a) This policy shall be reviewed every five (5) years in the light of legal, policy and institutional development in IP at the national and international levels.
- (b) The evaluation team shall include members of the CSIR IP Committee and also members from IP frontiers, including, but not limited to government agencies, academia, and law enforcement agencies.
- (c) The IP Officer shall act as the focal point for the review.
- (d) Broad CSIR input should be solicited as part of this review.

21. EFFECTIVE DATE

This CSIR Intellectual Property Policy shall become effective upon adoption and approval by the CSIR Council.

