Tokyo Institute of Technology

Intellectual Property Policy

Educational and Research Council Resolution
February 6, 2004

I. Basic Approach

1. Fundamental Missions and Ideals of Tokyo Institute of Technology, and Formulation of Intellectual Property Policy

The fundamental missions of Tokyo Institute of Technology (hereafter, “Tokyo Tech”) are to create intellectual property through education and research, educate superior personnel to lead the next generation, and thus contribute to the development of society and humanity.

Based on these missions, our ideals are to advance academic research centered on creative, leading science and technology; train highly creative, deeply humane scientists and engineers with an international perspective and develop human resources who can serve as leaders in each field at our graduate schools, undergraduate departments, and affiliated laboratories and research centers; gain collaboration between academia and industry and contribute to the development of science and industry inside Japan and throughout the world; broadly gather wisdom from concerned parties worldwide, and play an active role in maintaining world peace and resolving global environmental preservation and other problems for the future of humanity and the earth.

For research in particular, Tokyo Tech’s ideals are to pursue truth and higher knowledge, strive for the sustainable development of science and technology based on sound value judgments, make leading contributions to the development of industry, and contribute to uplifting world culture and improving the welfare of humanity.

The Intellectual Property Basic Act stipulates that universities shall, in light
of the fact that their activities contribute to the creation of intellectual property in all society, voluntarily and positively endeavor to develop human resources and to disseminate research and research results. Moreover, the Act defines as part of national universities’ duties the obligation to disseminate research findings and promote their use.

Based on these missions and ideals, Tokyo Tech is establishing this Intellectual Property Policy stipulating the basic policies for the creation, protection, management and use of intellectual properties at Tokyo Tech and notifies this to parties within and outside campus. Tokyo Tech will advance the creation, protection, management and use of intellectual property in accordance with this Intellectual Property Policy to contribute to the realization of its missions.

Tokyo Tech is also separately formulating a Conflict of Interest Policy to address conflicts of interest* that may occur in conjunction with the creation, protection, management and use of intellectual property rights or with Tokyo Tech’s liaison activities with industries.

*Conflicts of interest refer to situations where there is a conflict between an individual’s duties as a staff member and the individual’s interests or duties under relations with enterprises, etc.

2. **Transition to Institutional Ownership of IP Rights**

In the past, in principle intellectual property rights (IPRs) for inventions by national university faculties belonged to individual faculty members. With the establishment of national universities as legal entities from April 2004, however, in principle such rights will be owned by the institution concerned. The present principle whereby rights belong to the individual was established at a time when there was no system in place for universities to transfer inventions to industry. This principle is being changed based on recognition that with the establishment of TLOs (Technology Licensing Organizations) and the progress in preparing university intellectual property management systems in recent years, the management of intellectual properties by universities as organizations now leads to more effective use of university inventions by industry.
As a national university corporation, Tokyo Tech will actively advance the creation, protection, management and use of intellectual properties, prepare the necessary systems, employee invention regulations and related regulations, have intellectual properties created at Tokyo Tech belong to Tokyo Tech in principle, and work as an organization toward their unified management and utilization.

As part of these efforts, Tokyo Tech will secure appropriate return of profits to the concerned faculty members and other personnel as an incentive for them to create intellectual property and share the fruits of research with society.

3. Basic Approach to the Creation, Protection, Management and Use of Intellectual Properties at the Institute

Tokyo Tech shall make use of its potential as a comprehensive scientific and engineering university and work to create intellectual properties across a wide range of fields. Tokyo Tech will go beyond just patenting, licensing and applying intellectual properties created as research findings, to position intellectual property as the core of academia-industry collaboration, actively build up cooperative relations between Tokyo Tech and industry, and positively pursue joint research to create new industries and contribute to advancing innovation while working to create additional intellectual properties. Considering the role which society expects Tokyo Tech to fulfill, Tokyo Tech will also strongly advance liaison activities with businesses and society in general, precisely match Tokyo Tech’s research resources with enterprise needs, propose research projects which bring together Tokyo Tech’s research resources as seeds, and thus promote close and diverse cooperation with industry and advance highly productive research and development. Moreover, in light of the globalization of enterprise operations, these activities should fully incorporate an international perspective.

To those ends, Tokyo Tech will promote awareness regarding the creation, protection, management and use of the intellectual property of faculty and other staff, positively support the creation of intellectual property by faculty
and other staff, secure appropriate remuneration for the activities of individuals involved with the creation, protection, management and use of intellectual property, and actively disseminate concerned information within and outside Tokyo Tech.

4. **Duties of Faculty and Other Staff**

Faculty and other staff of Tokyo Tech shall positively implement activities for the creation, protection, management and use of intellectual property at Tokyo Tech considering Tokyo Tech’s missions and ideals. Moreover, faculty and other staff shall deal appropriately with any conflicts of interest that may emerge concerning the creation, protection, management or use of intellectual property or regarding industry academia cooperation in accordance with the stipulations of the Conflict of Interest Management Policy.

5. **Consideration of Education**

Considering that the education of personnel who can lead the next generation is one of Tokyo Tech’s fundamental missions, proper consideration will be given to the balance between the education of undergraduate and graduate students and the creation, protection, management and use of intellectual property. In particular, since the presentation of papers at academic conferences and presentation of graduate theses are extremely important as they are closely related to acquisition of academic degrees, points which require coordination between the smooth implementation of student education and the requirements to maintain confidentiality and manage the publication of findings for the creation, protection, management and use of intellectual property will be duly recognized and addressed.

II. **Handling of Research Findings and Ownership and Succession of Rights**

1. **Range of Faculty and Other Staff and Range of Intellectual Properties Where Created Intellectual Properties Belong in Principle to Tokyo Tech**
as Employee Inventions

(1) **Range of Faculty and Other Staff Whose Created Intellectual Properties Belong in Principle to Tokyo Tech**

The range of faculty and other staff whose created intellectual properties belong in principle to Tokyo Tech is as follows.

1. Faculty, employees, special researchers, post-doctoral researchers and other individuals employed by Tokyo Tech (including individuals employed on a part-time basis).
2. Special researchers, post-doctoral researchers and other individuals who have research contracts with Tokyo Tech (excluding those specified in the previous clause).
3. Students (including undergraduate students) who have research contracts with Tokyo Tech.\(^1\)

Hereafter, the range of faculty and other staff stipulated in items 1–3 above are collectively referred to as “Staff.”

(2) **Range of Intellectual Properties Which Belong in Principle to Tokyo Tech**

The following rights created by Staff using research funds or research facilities, equipment or apparatus managed by the Institute, or created by Staff without using such items but in fields deemed to be closely related to their works at Tokyo Tech\(^2\), shall belong to the Institute presuming that appropriate compensation is paid to the Staff concerned.

**(Types of Rights)**


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\(^1\) Tokyo Tech plans to handle inventions by students who do not have research contracts with the Institute on an individual basis when they arise through negotiations and conclusion of contracts with the concerned students.

\(^2\) For example, inventions by a faculty created during joint research (which is their work duty) but without using research funds or research facilities, equipment or apparatus managed by Tokyo Tech (such as research conducted at enterprises which are joint research collaborators).
1959), circuit layout rights as stipulated by the Law Concerning the Circuit Layout of Semiconductor Integrated Circuits (Law No. 43 of 1985), breeder’s rights as stipulated by the Seeds and Seedlings Law (Law No. 83 of 1998) and rights equivalent to the above-stipulated rights overseas.

2. The right to receive patents as stipulated by the Patent Law, the right to register utility models as stipulated by the Utility Model Law, the right to register trademarks as stipulated by the Trademark Law, the right to register circuit layouts as stipulated by Article 3-1 of the Law Concerning the Circuit Layout of Semiconductor Integrated Circuits, the right to register varieties as stipulated by Article 3 of the Seeds and Seedlings Law and rights equivalent to the above-stipulated rights overseas.

3. Copyrights on program works and database works (hereafter, “Programs”) as stipulated by the Copyright Law (Law No. 48 of 1970) and rights equivalent to the above-stipulated rights overseas.

Separate stipulations will be made regarding the handling of “know-how,” which is technological information that can be concealed and has financial value, and of corporeal things as research results.

(Research Funds Managed by the Institute)

In this Policy, “research funds managed by Tokyo Tech” refers to the following items.

1. Operating expenses grants from the national government.
2. Grants, subsidies and other similar types of funds received by Tokyo Tech as the party being subsidized.
3. Funds received by the Institute based on consigned research contracts concluded by Tokyo Tech.
4. Funds received from enterprises etc. for research conducted by Tokyo Tech under joint research with enterprises etc.
5. Funds received by Tokyo Tech as donations.
6. Other funds received by Tokyo Tech from outside parties.
7. Grants-in-Aid for Scientific Research and other research subsidies for
individuals with accounts managed by Tokyo Tech.

8. The research funds for research directly funded and managed by Japan Science and Technology Agency and other outside parties but are conducted inside Tokyo Tech.

(Research Facilities, Equipment and Apparatus Managed by Tokyo Tech)
In this Policy, “research facilities, equipment and apparatus managed by Tokyo Tech” refers to the following items (but excludes facilities, equipment, and apparatus leased to enterprises etc. under contract).

1. Facilities, equipment and apparatus invested, conveyed or transferred to the Institute by the national government.
2. Facilities, equipment and apparatus purchased using funds managed by Tokyo Tech.
3. Facilities, equipment and apparatus being leased using funds managed by Tokyo Tech.
4. Facilities, equipment and apparatus donated to Tokyo Tech.
5. Facilities, equipment and apparatus being loaned to Tokyo Tech (including Tokyo Tech’s Staff) free of charge (items brought into Tokyo Tech with ownership rights remaining with outside parties)

2. Determination of Ownership of Rights and Procedures for Succession to Tokyo Tech

(1) Submission of Invention Notifications
All Staff are required to submit invention notifications under the separately stipulated Employee Invention Regulations or contracts concluded with Tokyo Tech. Staff must submit invention notifications for all of their inventions, regardless of whether or not the Staff member thinks they are employee inventions.

Invention notifications shall be submitted to the Office of Industry Liaison.

(2) Relation between Paper Publications and Invention Notifications

1. Publication of Papers
In cases of scientific research urgency, Staff may publish papers that include
the contents of inventions prior to submitting invention notifications. (It is important to note that such publication might result in a loss of novelty, preventing patent application in countries other than Japan, the U.S. and Canada). In such cases, Staff must promptly submit invention notifications after publication.

In cases when Staff who create inventions desire not to seek intellectual property protection of said inventions, from the perspective of social contributions by Tokyo Tech or for other reasons, Tokyo Tech shall respect those wishes.

2. System Design and Administration Improvement

Tokyo Tech will continue to examine the design and administration of an intellectual property management system that has merit for Staff, so that Staff will cooperate with securing intellectual property rights, as described above.

Tokyo Tech will also strive to provide support for urgent patent applications when academic conference publication deadlines are pending.

(3) Determination of Institutional Ownership

Submitted invention notifications will be examined in accordance with this Policy by Office of Industry Liaison (hereafter, “OIL”), which shall determine if they meet the requirements to constitute employee inventions. For those judged to be employee inventions, the OIL will conduct further examinations on their potential for patent registration and licensing, and decide whether or not to file for patents. Considering the cost-effectiveness, Tokyo Tech may decide not to file for inventions deemed to have little novelty and extremely low potential for licensing.

OIL will notify Staff with the conclusions of these judgments within 30 days after they submit invention notifications. In cases when works for promoting

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3 Under the German Act on Employee Inventions, university researchers must provide advance notice to their universities at an appropriate time (two months prior) for the publication of papers that include employee inventions.
patent use will be consigned to TLOs (Technology Licensing Organizations) or other outside parties, the Headquarters shall seek the opinions of said TLOs or other outside parties in making decisions on whether or not to file for patents.

(4) Rights Succession Procedures
Invention-related rights owned by Staff shall succeed to Tokyo Tech when OIL notifies the concerned Staff that it has decided to apply for patent rights. In such cases Tokyo Tech shall pay a bonus⁴ to the concerned Staff in accordance with separately stipulated regulations.

(5) Measures when Properties Are Not To Be Owned by Tokyo Tech
OIL shall promptly notify Staff submitting invention notifications in cases when it determines that their inventions do not meet the requirements to constitute employee inventions. In such cases, the concerned Staff shall be free to handle said inventions at their discretion.

OIL shall also notify Staff in cases when it determines that while their inventions do meet the requirements to constitute employee inventions, patent applications will not be filed. In such cases no bonuses will be paid, and with this notification said inventions shall be deemed to have reverted from Tokyo Tech to the Staff inventors, who will then be free to handle said inventions at their discretion.

(6) Measures when Staff Disagree with Decisions on Recognition as Employee Inventions or Filing Patent Applications
In cases when Staff inventors disagree with decisions by OIL on recognition as employee inventions or on filing patent applications, Staff may request an examination by an Intellectual Property Examination Committee comprised of experts within Tokyo Tech.

(7) Handling of Individual Patent Applications and Transfer to Enterprises
Staff may not apply for patents as individuals or transfer the rights to receive inventions to enterprises without submitting invention notifications.

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⁴ This bonus is paid to Staff who make inventions when the rights succeed to Tokyo Tech under the provisions of the Employee Invention Regulations, etc.
Staff may apply for patents as individuals and transfer invention rights to enterprises when they have submitted invention notifications and decisions were reached whereby rights will not be institutionally owned. As rights will be institutionally owned after the establishment of national universities as legal entities, inventions arising from research scholarships shall also belong to Tokyo Tech.

8) Procedures for Intellectual Properties Other than Patents
In principle, the procedures for created works that merit protection as intellectual property other than patents shall follow the stipulations of items (1) – (7) above.

III. Promoting the Management and Use of Intellectual Properties

1. Tokyo Tech's Duty for Application of Research Results
Tokyo Tech shall actively work toward the management, maintenance and use of created intellectual properties, duly recognizing that they are the fruits of long years of knowledge accumulation, endeavors, and creativity by Staff.

Accordingly, Tokyo Tech shall actively strive to spread intellectual properties developed at Tokyo Tech to enterprises etc. in accordance with the following policy.

1) Establishment of License Rights and Transfer of Rights
For the effective use of its intellectual properties, Tokyo Tech shall work to effectively and efficiently apply its intellectual properties through such measures as arranging exclusive license rights, partial exclusive license rights and non-exclusive license rights, and transferring intellectual properties.

2) Collection of License Fees
In principle, Tokyo Tech shall collect license fees from parties which apply its intellectual properties (including joint patents arising from collaborative
research with enterprises) because unlike enterprises Tokyo Tech is not in a position and does not have the ability to apply its own research results.

(3) Consideration of Venture Firms and Small and Medium Enterprises
Regardless of the above stipulations, Tokyo Tech may give special consideration to venture firms and to other small and medium enterprises.

(4) Measures When Licenses Are Not Utilized
Licensing contracts, rights transfer contracts and other agreements must incorporate stipulations whereby the contracts can be cancelled, transferred intellectual properties returned, and other appropriate measures taken in cases when intellectual properties are not applied, without justifiable reason, for a long period of time after these agreements are concluded.

2. Management and Use of Intellectual Properties

(1) Intellectual Property Management Responsibility at Tokyo Tech
Intellectual properties shall be managed appropriately at Tokyo Tech. From the perspective of cost-effectiveness, the management options shall include decisions to cease maintaining and managing intellectual properties which have no prospects for licensing.

(2) Return of Intellectual Properties to Staff Inventors
For the effective and efficient use of limited funds, Tokyo Tech may terminate its management of intellectual properties (including the right to receive patents) which it owns and manages that are deemed, after appropriate comparison of the expenses incurred in their management and the prospects for their use, to have no likelihood of application. In such cases, the concerned intellectual properties shall revert to their Staff inventors.

In cases when Tokyo Tech will cease managing intellectual properties, Tokyo Tech shall so notify the Staff inventors well in advance.

The basic specific conditions and procedures for the reversion of intellectual properties shall be separately stipulated.
In cases when Staff inventors disagree with OIL’s decisions to terminate management, they may express their opinions following the procedures stipulated in Section II.2(6) of this Policy, above.

3. Compensation of Inventors for Use of Intellectual Properties
When Tokyo Tech receives income from the use of intellectual properties that are institutionally owned by Tokyo Tech, in principle after deducting the necessary expenses the Institute shall pay 30% of the licensing income to the inventor and 20% to the research unit where the inventor was working when he or she created the concerned intellectual property.

IV. Approach to Ownership of Rights and Licensing Under Collaborative Research, Sponsored Research, Etc.

1. Promotion of Diverse Research Cooperation Formats with Enterprises
The Institute shall actively promote research cooperation with enterprises and other outside organizations (hereafter, “Enterprises”) through sponsored research, collaborative research, and other formats.

(1) Sponsored Research
In sponsored research, Tokyo Tech conducts research at the request of Enterprises and the Enterprises pay all the expenses. In these cases the Enterprises are involved with setting the research themes and research contents, but are not expected to make any contributions in implementing the research aside from their financial contributions.

(2) Collaborative Research
In collaborative research, the Enterprises conduct collaborative research with Tokyo Tech on themes that both sides have agreed upon. The Enterprises are expected to contribute to conducting the research. Moreover, in collaborative research the Enterprises bear the costs for the part of the research which is implemented by Tokyo Tech at their request.
Research Cooperation in Other Formats
In addition to sponsored research and collaborative research, Tokyo Tech is establishing a category for free research cooperation in other formats so it can respond on an individual basis to requests from Enterprises.

Others
Tokyo Tech will also consider other arrangements in the future such as consigned research and other cooperation with overseas Enterprises, and collaborative research by a consortia of multiple universities.

(5) Collection of Indirect Expenses

1. Collection of Indirect Expenses
Tokyo Tech shall ask Enterprises to bear the financial burden of research conducted by Tokyo Tech for sponsored research, collaborative research, and research cooperation in other formats. This shall include both the direct expenses incurred in conducting the research and the burden of indirect expenses. In principle, indirect expenses shall be calculated as 30% of the direct expenses.

2. Tokyo Tech’s Response
In exchange for collecting indirect expenses, Tokyo Tech will further improve negotiation systems prior to concluding contracts, management of ongoing research and management of intellectual properties, and respond flexibly toward Enterprises regarding the terms for licensing intellectual properties.

3. Bases for the Ratio
The bases for setting indirect expenses as 30% of direct expenses are that this ratio is adopted for national competitive research funds and that Tokyo Tech has used this ratio for sponsored research to date. Indirect expenses are viewed as expenses incurred in using Tokyo Tech’s infrastructure for research requested by Enterprises.

4. Fostering Understanding Among Enterprises
Tokyo Tech’s executives will visit Enterprises and provide explanations to seek their understanding regarding the collection of indirect expenses.
5. Temporary Measures
While Tokyo Tech will seek the understanding of the 30% indirect expenses ratio principle among Enterprises, as a temporary measure for the time being, Tokyo Tech will hold individual discussions with Enterprises and make decisions considering the particular characteristics of the individual research.

2. Approach to the Ownership of Rights

(1) Sponsored Research
In principle, inventions by Staff under consigned research shall belong to Tokyo Tech.

(2) Collaborative Research
In principle, joint inventions under collaborative research shall be shared by Tokyo Tech and the Enterprises. In such cases, in principle the ownership ratios shall be determined considering the relative contributions to the inventions.

In principle, inventions solely created by one party under collaborative research shall be solely owned by that party, after receiving confirmation from the other party.

(3) Research Cooperation in Other Formats
In principle, Tokyo Tech will claim its rights whenever it contributes to the creation of intellectual properties, and will give consideration to balance with the handling of intellectual properties under sponsored research and collaborative research. Specifically, Tokyo Tech will examine individual cases in response to requests from Enterprises and respond appropriately in light of this Intellectual Property Policy and related regulations.

3. Approach to Licensing
The approach to licensing shall follow the stipulations of Section III·1, above.

Tokyo Tech may grant exclusive, monopoly or regular licenses to Enterprises
as requested. The license terms shall be negotiated on an individual basis.

4. **Response to the Government and Government Organs**
   If the national government, regional government bodies, independent research institutions or other similar public institutions providing research funds to Tokyo Tech, sponsoring research to Tokyo Tech or conducting collaborative research with Tokyo Tech are unable to conform with the rights ownership or licensing of intellectual properties stipulated under this Policy, these matters may be handled without reliance on this Policy.

V. **Confidentiality Duty of Staff and Students**

   Intellectual properties with registered rights are extremely important for enterprises, which play an important role in the use and application of intellectual properties, from the perspective of securing competitive advantage.

   Therefore Staff will duly recognize the importance of maintaining confidentiality regarding research findings and inventions for rights in the process of being secured, especially under consigned research from enterprises and joint research with enterprises, and act accordingly.

VI. **Intellectual Property Management and System for Implementing Cooperation among Academia, Industry, and Government**

1. **Establishment of Office of Industry Liaison**

   Tokyo Tech is establishing an Office of Industry Liaison with the following duties\(^6\), and with the Vice President for Research as OIL’s Director, to advance the creation, protection, management and use of inventions and other intellectual properties by Tokyo Tech’s Staff, spread Tokyo Tech’s research results among industry, and promote research cooperation with industry.

   (1) Planning and drafting the basic approach to the creation, protection,
management and use of intellectual properties at Tokyo Tech.

(2) Management, protection and use of inventions at Tokyo Tech (aside from those specified under the previous item).

(3) Liaison between Tokyo Tech and Enterprises to advance research cooperation between Tokyo Tech and industry.

(4) Support for contracted works and implementation management works for research cooperation between Tokyo Tech and Enterprises.

(5) Surveys and research concerning the previous items.

(6) Other necessary works for the promotion of academia-industry collaboration.

2. Internal Organization of Office of Industry Liaison

The organization of OIL shall be separately stipulated.

3. Use of External Technology Licensing Organizations (TLOs)

Using the experience in the management and use of intellectual properties accumulated by external Technology Licensing Organizations (TLOs) is important for the effective and efficient use of the Institute’s intellectual properties. Accordingly, Tokyo Tech shall utilize TLOs as appropriate.

In such cases, since it is important to aim at one-stop service whereby a single window for Enterprises can respond to all technology transfer and other industry academia liaison activities, an organic and unified liaison system will be established between Tokyo Tech and the TLO, and the relationship between Tokyo and the TLO will be broadly and explicitly publicized inside and outside Tokyo Tech.

VII. Procedures for Filing and Resolving Objections to the Handling of Intellectual Properties

1. Preparation of a System for Filing Objections

As the criteria for inventions to belong to Tokyo Tech are clarified by this Intellectual Property Policy, the former Invention Committee is abolished and the Headquarters shall promptly reach decisions on recognizing employee inventions and filing patent applications in accordance with this
Policy. Moreover, the Institute shall establish an Intellectual Property Examination Committee (tentative name) comprised of experts within Tokyo Tech and arrange a system for the examination of the contents when Staff object to decisions made by OIL.

The organization of the Intellectual Property Examination Committee shall be separately stipulated.

2. Procedures for Filing and Resolving Objections
When Staff inventors disagree with decisions by OIL on institutional ownership or on filing patent applications, Staff may request an examination by the Intellectual Property Examination Committee.

When requested to conduct an examination, the Intellectual Property Examination Committee must begin the examination without delay. The Committee must also promptly inform the Staff who requested the examination when it reaches its conclusion, and may request the OIL to take required measures when necessary.

When OIL objects to measures requested by the Committee, the OIL may request judgment by the President of Tokyo Tech. In such cases, the President’s judgment shall be final.