

Authority: Approved by the President

Chapter 14 INTELLECTUAL PROPERTY AND TECHNOLOGY TRANSFER

14.1 Policy

The University endeavors to contribute to the advancement of science and technology in Japan and throughout the world and to the [sustainable development of Okinawa](#) through technology transfer of Intellectual Property.

The University is committed to connect the Intellectual Property resulting from its activities to the society at large and also to generate additional income to support the University's research, education and innovation missions.

After its Employees and Students, University IP is the University's most important asset and the University strives to both protect and use it effectively.

The University respects other organizations' Intellectual Property Rights. Policy Subjects shall ensure that their University activities do not infringe on such rights.

14.2 Definitions

The following capitalized terms shall have the meaning set out below for the purpose of this Policy.

Background IP means any pre-existing Intellectual Property created before a Policy Subject becomes subject to this Policy.

Contractor means a person who has entered into a service agreement with OIST SC, including, without limitations, an [External Researcher](#), [Transitional Professor](#), [Adjunct Professor](#), [External Professor](#), contracted consultant or external vendor.

Creator means a person, who creates, conceives, reduces to practice, authors, or otherwise makes a substantive intellectual contribution to the creation of University IP or who meets the definition of 'inventor', 'author' or 'breeder' as generally implied in the Intellectual Property laws of Japan and **Create** shall be construed accordingly.

Creators' Collective Share of IP Revenues has the meaning given to it in 14.7.4.1.

Disclosable University IP means University IP that has foreseeable commercial value.

Employee means (i) a person who is under an employment agreement with OIST SC, such as a [Professor, Associate Professor, Assistant Professor, Researcher, Technician, Research Support Employee or Administrative Employee](#); (ii) an [Officer of OIST SC](#); or (iii) a [Constituent \(External\) Staff](#) member.

Intellectual Property means all outputs produced by individuals through creative activities for which legal rights may be obtained or enforced pursuant to applicable laws, including, without limitations, inventions, devices, authored works (such as software and databases), designs, new plant varieties and biological organisms, industrial applications of discovered or solved laws of nature or natural phenomena, utility models, trademarks, trade names, trade secrets, knowhow and any other mark or technical or business information that is useful for business activities.

Intellectual Property Rights means the proprietary rights that may be granted for an Intellectual Property, should the statutory requirements for protection be met, including, without limitations, a patent right, a utility model right, a plant breeder's right, a design right, a copyright, a trademark right, any other right on Intellectual Property that is stipulated by applicable laws and any other right pertaining to an interest in Intellectual Property that is protected by applicable laws.

IP Evaluation Committee means a committee established by TDIC to evaluate Intellectual Property disclosed to the University.

IP Revenues means all revenues actually received by the University, and to which the University is undisputedly entitled to as owner or co-owner, through commercialization of any University IP from, without limitations, outright sale, option payments, license fees, evaluation fees, upfront and milestone payments, royalty payments, share of profits, dividends, commissions, income through disposal of Proprietary Interests.

IT Resources has the meaning given to it in [Chapter 17](#) of the University's Policies, Rules & Procedures.

More Than Incidental Use Of University Resources means (i) more than minimal use of specialized, research-related facilities, equipment, supplies, staff or IT Resources provided by the University for academic purposes; or (ii) significant use of "on-the-job" time. It excludes the occasional and infrequent use of (i) routinely available, office-type IT Resources, such as desktop/laptop computers and commercially available software, provided that such use complies with [Chapter 17](#) of the University's Policies, Rules & Procedures; and (ii) reference materials or other resources collected on the University campus, and which are generally available in non-University locations.

OISTIR means the [Okinawa Institute of Science and Technology Graduate University Institutional Repository](#).

OIST SC means Okinawa Institute of Science and Technology School Corporation.

Policy means this Chapter 14 of the University's Policies, Rules & Procedures.

Policy Subject means an Employee, Student, Contractor or Visitor.

Previous Policy means Chapter 14 of the University's Policies, Rules & Procedures in effect prior to November 07, 2022.

Proprietary Interests means any right of any kind, whether or not negotiable or listed for trading on any stock exchange, in any entity including, without limitations, shares, equity, stocks, warrants, loan notes, options, debentures, securities convertible into shares or share options and any other instrument conferring upon its holder or beneficiary any right in any entity and any option to receive any such right.

Public Disclosure means any non-confidential communication of information relating to University IP to external parties. Public Disclosure includes, but is not limited to, disclosure in written or oral form; communication by email; posting on a web blog; disclosure in a news report, press release or interview; publication in a journal, abstract, poster, or report; presentation at a conference; public presentation during or in relation to the examination of a thesis; demonstration of an invention at a trade show; or the industrial application of an invention.

Public Domain means a freely accessible public area in which Intellectual Property that is not protected by Intellectual Property Rights is held by the public at large and available for all to use without permission from the Creator(s) or owner(s).

Student means a person who has been admitted to the University's graduate program as a [full-time degree candidate](#).

Tangible Research Property or **TRP** means tangible items produced in the course of research projects, including, without limitations, biological materials (such as microorganisms, cells, plasmids, microbes, antibodies, proteins and, in each case, any part thereof), new materials, soil, rocks, new breeds of plants, lab animals, engineering drawings, software, integrated circuit chips, computer databases, prototype devices, circuit diagrams, equipment, paper or electronic media containing research data. TRP is separate and distinct from Intellectual Property and Intellectual Property Rights. An individual item of TRP may be associated with one or more Intellectual Property and Intellectual Property Rights.

TDIC means the University's Technology Development and Innovation Center.

Team Agreement means an agreement relating to one or more University IP that is entered into between the Creators of such University IP and the University to regulate the respective rights and obligations of the parties in relation to matters pertaining to such University IP.

University means [OIST SC and/or Okinawa Institute of Science and Technology Graduate University](#), as applicable.

University Authored Work means an authored work that is a University IP.

University IP means Intellectual Property and Intellectual Property Rights owned or co-owned by OIST SC.

Visitor means a person who (i) is not an Employee, Student or Contractor; and (ii) engages in work at the University, independent of the length of the visit and whether or not such person receives any compensation from the University.

14.3 Scope and Binding Effect of the Policy

14.3.1 Unless agreed otherwise in writing by the Executive Vice President for Technology Development and Innovation, this Policy applies to all Intellectual Property conceived, created, developed, or first reduced to practice by Policy Subjects in connection with their University responsibilities or with More Than Incidental Use Of University Resources. Policy Subjects who are on leave, including, without limitations, sabbatical or paid leave, are subject to this Policy and shall abide by it.

14.3.2 This Policy does not apply to, and the University does not claim ownership of, (i) Background IP; and (ii) Intellectual Property conceived, created, developed, or first reduced to practice by Policy Subjects outside of University responsibilities and without More Than Incidental Use Of University Resources. Individuals with approved external activities, such as faculty members with “[External Appointment or Employment](#)”, shall not work on University IP in connection with such activities without a formal agreement with the University and shall consult TDIC to put such an agreement in place.

14.3.3 Upon commencing employment, enrollment, a contract or an appointment with the University, Policy Subjects shall declare any Intellectual Property they wish to treat as Background IP for the purpose of excluding them from the application of this Policy by completing and submitting a [Background IP Disclosure Form](#) to TDIC.

14.3.4 The University ensures that the agreement establishing its relationship with each of its Policy Subjects includes a provision placing such person under the scope of this Policy. Visitors, or their University’s host, shall consult with TDIC if there is uncertainty about whether they and their activities are covered by this Policy.

14.3.5 Rights and obligations under this Policy shall survive any termination of employment, enrollment, contract or appointment with the University.

14.4 Ownership of Intellectual Property

14.4.1 Unless provided otherwise in this Policy or agreed otherwise in writing by the Executive Vice President for Technology Development and Innovation, the University shall own all Intellectual Property conceived, created, developed, or first reduced to practice by Policy Subjects in connection with their University responsibilities or with More Than Incidental Use Of University Resources. Policy Subjects shall assign such Intellectual Property to the University by way of (i) a general assignment included to the agreement establishing their relationship with the University; or (ii) at the University's request, a specific assignment agreement.

14.4.2 The contribution of a third party to the development of any University IP may result in such University IP being co-owned by the University and the third party or his/her employer. The terms applying to the ownership, protection and maintenance costs (e.g., patent filing costs) and income distribution of such University IP shall be agreed contractually between the University and the co-owner(s) on an ad hoc basis, in accordance with 14.6.1.

14.4.3 The University does not claim copyrights in the authored works of its Policy Subjects (such as books, articles, video clips, webinars, theses, papers, novels, poems, musical compositions, and similar works), which are solely intended to disseminate the results of academic research and scholarship, except (i) authored works created at the direction of the University for a specific University purpose; and (ii) software and databases.

14.4.4 Although the University intends to respect moral rights conferred by applicable laws on the Creator of a research-related authored work, such Creator shall not be entitled to claim moral rights on such authored work against the University and its designees.

14.5 Evaluation and Protection of Intellectual Property

14.5.1 Responsibility to Disclose

Creators shall disclose promptly to the University each University IP that they determine, in good faith and using their best judgement, is a Disclosable University IP, by completing and submitting an [IP Disclosure Form](#) to TDIC. In case of doubt, Creators should complete and submit an IP Disclosure Form and consult with TDIC.

Creators shall complete the [IP Disclosure Form](#) with enough information to allow the accurate evaluation of the technical and related features and functions, co-ownership, co-creatorship (including details of all Creators and their relative

contributions in percentage), commercial value, legal protections and any pre-existing conflicting rights relating to such Disclosable University IP.

Creators shall complete and submit the [IP Disclosure Form](#) and give the University the opportunity to protect a Disclosable University IP before making any Public Disclosure of such Disclosable University IP. Failure to do so may result in loss of Intellectual Property Rights and subsequent commercialization potential.

14.5.2 Evaluation by the University

TDIC manages the evaluation of University IP disclosed in accordance with 14.5.1 and arranges for the IP Evaluation Committee to conduct an evaluation of such University IP for patentability and registration purposes, commercialization potential, and other assessment.

14.5.3 Protection of University IP

TDIC administers all filing and registration processes and other legal protections, such as litigation, in relation to University IP that the University has determined to protect.

The Creators of University IP shall provide TDIC with all reasonable support and work with TDIC jointly and cooperatively with regard such processes and protections, including, without limitations, by confirming in writing upon the University's request the correctness of the information submitted in an IP Disclosure Form or by signing all documents that the University requests them to sign.

All filings and registrations shall be in the University's name or, where the University determines that the law of the relevant jurisdiction so requires, in the name of the relevant Creators and then assigned to the University at the University's request.

Subject to 14.7.4.1, the University shall pay for all costs relating to the protection, administration and maintenance of University IP.

14.5.4 University IP Abandoned or Not Commercialized

The University may assign any University IP to its Creator(s) if the University determines (i) not to protect or to abandon the protection of such University IP; (ii) that the commercialization of such University IP does not give rise to any reasonable prospect of commercial success; or (iii) that such an assignment would enhance the transfer of such knowledge for the benefit of the public; and provided in each case that such an assignment is consistent with the University's obligations to third

parties, in particular any sponsor(s) of the research from which such University IP is derived. Upon such an assignment, the Creator(s) will be entitled to seek to protect and/or commercialize such Intellectual Property at their own expenses.

Unless agreed otherwise by the Executive Vice President for Technology Development and Innovation, such an assignment of University IP shall be subject to each Creator undertaking in writing (i) to pay to the University one quarter of any revenue and/or Proprietary Interests such Creator receives in connection with the commercial exploitation of the relevant University IP, after deduction of verified ownership, protection and maintenance expenses; (ii) not to assign or otherwise transfer without the prior written consent of the University any of the rights or obligations of such Creator in relation to the relevant University IP; (iii) to provide periodically to the University certified accounts of any such revenue and/or Proprietary Interest they receive or become entitled to; and (iv) not to enter into any agreement with any entity or person with which the University conducted negotiations relating to the commercialization of the relevant University IP, or any entity or person affiliated with such entity or person, during the period of 2 years starting on the date on which such negotiations ceased.

TDIC oversees the negotiations and implementation of such assignments and undertakings.

14.6 Permitted Uses of University IP

14.6.1 Agreements with Third Parties

As part of their University activities, Policy Subjects may (i) be requested to enter into agreements with third parties; or (ii) seek that the University enters into agreements with third parties. By way of example, such agreements include material transfer agreements (MTAs), collaborative/joint research agreements, sponsored research agreements, consulting agreements, visiting scientist agreements, non-disclosure agreements, assignments of Intellectual Property Rights, or donation agreements tied to University IP or future University IP.

In addition to their review by the General Counsel Office, TDIC shall review all agreements relating to University activities that stipulate terms on Intellectual Property prior to their signing and the Executive Vice President for Technology Development and Innovation shall have authority to approve terms that differ from those set out in this Policy, including, without limitations, terms relating to ownership, assignment or otherwise.

Once the University has entered into an agreement with a third party that stipulates terms on Intellectual Property, all Policy Subjects who are involved with the performance of such an agreement shall act in accordance with its terms. The Policy Subject(s) heading the performance of the agreement shall be responsible for informing all other relevant Policy Subjects of the aforementioned terms.

Although non-disclosure agreements may conflict with the University's [Openness in Research Policy](#) and the objectives of [OISTIR](#), the University may enter into limited non-disclosure agreements for Intellectual Property protection and commercialization. In negotiating non-disclosure agreements, the University endeavors to minimize restrictions on the publication of the research carried out in the University's laboratories.

14.6.2 Public Domain

Creators wishing to see any University IP they Created placed in the Public Domain shall address a joint written request to TDIC, which may, at its sole discretion, place such University IP in the Public Domain.

The University will not assert its rights over any University IP thus placed in the Public Domain.

University IP shall not be placed in the Public Domain if doing so may violate the terms of any agreement that supported or governed the research from which such University IP is derived.

14.6.3 Public Disclosure

Consistent with the University's [Openness in Research Policy](#) and the objectives of [OISTIR](#), the University supports the publication of research results for research and educational purposes and Policy Subjects can make a Public Disclosure of such results for the exclusive purposes of research and/or education; provided that, a Policy Subject shall not make any Public Disclosure relating to, or including any reference to, University IP, without having first (i) disclosed and given the opportunity to protect such University IP to the University in accordance with 14.5; and (ii) confirmed that the Public Disclosure is permitted under the terms of any agreement relating to such University IP.

14.6.4 Distribution of University Authored Works

Policy Subjects shall ensure that all University Authored Works are published or distributed with the following notice:

Copyright © [year of publication] Okinawa Institute of Science and Technology Graduate University. All rights reserved.

No other institutional or divisional name is to be used in the notice, although the name and address of the relevant OIST section or research unit to which the audience can direct inquiries may be listed below it.

The year in the copyright notice should be the one in which the relevant version of the University Authored Works is first published or distributed.

14.6.5 Additional Rules for Software

Creators shall consult TDIC prior to distributing a University-owned software for research purposes where (i) such software has commercialization potential; (ii) the Creators want to control subsequent uses of such software; or (iii) an agreement governs the research from which such software is derived.

The University supports the exploration of open-source software solutions in any areas of application for research use. The University encourages all Policy Subjects involved in software development for research purposes to make University-owned software available under open-source license terms (for example, the GNU General Public License), and to contribute, as appropriate, to existing open source software projects. However, Creators shall consult TDIC in relation to the license terms prior to making a software that they determine, in good faith and using their best judgement, is a Disclosable University IP so available.

University-owned software developed or to be developed under open-source license terms may be commercialized and used in industrial applications. Creators shall consult TDIC as soon as such opportunities or intentions arise.

14.6.6 Additional Rules for Trademarks

Policy Subjects shall consult the Office of Communication and Public Relations for information concerning the use of trademarks representing the University, such as its name and logo.

Policy Subjects shall consult TDIC for information concerning the registration or use of any other trademarks that relate to University IP.

14.6.7 Additional Rules for Tangible Research Property (TRP)

14.6.7.1 Control of TRP

Each faculty member (or project head, if TRP is developed as part of a cross-units project) shall control the development, storage, use, and distribution of TRP made in the course of his/her research activities, subject to applicable laws, the University's policies and the terms of any agreement with sponsor(s) of the research from which such TRP is derived. Such control includes determining if and when distribution of the TRP is to be made beyond the University for use by others.

14.6.7.2 Dissemination of TRP

The Office of the Provost administers all agreements relating to the distribution of TRP to, and receipt of TRP from, non-commercial entities, such as other universities, research institutions, government bodies, and not-for-profit organizations. TDIC administers all agreements relating to the distribution of TRP to, and receipt of TRP from, commercial entities.

Agreements relating to the distribution of TRP, whether with commercial or non-commercial entities, may only be entered into in accordance with the provisions of 14.6.1.

The normal course of business to provide any University's TRP to a third party for commercial purposes shall be through a licensing agreement, from which the University may receive license fees and/or royalties. However, subject to the prior written consent of the Executive Vice President for Technology Development and Innovation, the University is entitled to sell TRP for commercial purposes.

The University distributes TRP for non-commercial research and educational purposes free of charge, provided that the actual costs necessary to prepare and distribute TRP may be charged to the receiving party.

14.7 Commercialization

14.7.1 Purpose of Commercialization

The University encourages the commercialization of University IP for public use and benefit and TDIC is responsible for such activities.

In no case shall the purpose of commercialization of University IP be related to any unethical, illegal or criminal matters.

14.7.2 Assistance of Creator(s)

Commercializing University IP successfully often requires the cooperation of the Creators or other relevant Policy Subjects. The University may request from time to time the Creator(s) of University IP or other relevant Policy Subjects to work with

TDIC and relevant third parties (such as commercial entities) to commercialize relevant University IP. Each such Creator or Policy Subject shall provide TDIC with all reasonable support and work with TDIC jointly and cooperatively. TDIC shall attempt to minimize the assistance required.

14.7.3 Team Agreement

If the University signs an agreement with a third party for the commercial exploitation of a single University IP or more than one University IP or that may result in the creation of further University IP, then, at the same time, the University and the Creators of all relevant University IP shall enter into a Team Agreement.

The agreement shall include, without limitations, (i) a confirmation from the Creators in relation to each relevant University IP, that to the best of their knowledge all of the people entitled to be included in the Team Agreement are party to it; (ii) a record of the allocation amongst all relevant Creators of the Creators' Collective Share of IP Revenues issued from such commercial exploitation; and (iii) an acknowledgement that the allocation amongst all relevant Creators of the Creators' Collective Share of IP Revenues may be subject to amendment in the future if there is a material change in the direct contributions of the Creators to the relevant University IP or if new University IP is added to the underlying agreement with the third party.

If the relevant Creators fail to agree on the allocation for the purpose of a Team Agreement or the revision of a Team Agreement, then the Executive Vice President for Technology Development and Innovation shall decide on such allocation, having consulted with such persons and/or entities as he/she deems fit, and the notice of his/her decision to the relevant Creators shall be deemed the relevant Team Agreement.

14.7.4 Distribution of Revenues

14.7.4.1 General Rules

The University shall distribute IP Revenues issued from the commercial exploitation of University IP accruing from agreements entered into prior to the date of adoption of this Policy according to the distribution rules specified in the Previous Policy.

The University will share with the Creators of University IP the monetary benefits that may accrue to the University from the commercial exploitation of such University IP by allocating to such Creators (collectively) one third of the Net IP Revenues generated by such University IP (the "**Creators' Collective Share of**

IP Revenues"). The University shall be entitled to the remaining two thirds of such Net IP Revenues.

The "**Net IP Revenues**" relating to a University IP shall be determined by the University by deducting from the relevant IP Revenues:

- (i) all extraordinary out-of-pocket expenses incurred by the University in relation to such University IP (such as legal fees incurred in a dispute connected to such University IP or their commercialization or material maintenance costs); and
- (ii) any tax that it is required to deduct and/or withhold by applicable laws.

14.7.4.2 Collectively Created Intellectual Property

IP Revenues generated by collectively created University IP, whose creatorship cannot be attributed to one or a discrete number of Creators but rather result from simultaneous or sequential contributions over time by multiple individuals, shall be fully allocated to the University, unless there is a written agreement to the contrary. For example, software developed and improved over time by multiple Policy Subjects where authorship is not appropriately attributed to a single or defined group of Creators would constitute a collectively created Intellectual Property for the purpose of this section. However, the mere fact that multiple individuals have contributed to the creation of Intellectual Property does not, in-and-of-itself, compel the conclusion that the Intellectual Property constitutes a collectively created Intellectual Property.

14.7.4.3 Frequency of Distribution

The University will distribute the Creators' Collective Share of IP Revenues to eligible individuals on an annual basis.

Where an annual distribution is administratively inefficient, TDIC may decide on an alternative distribution frequency with the approval of the Executive Vice President for Technology Development and Innovation.

Where TDIC determines in good faith that IP Revenues may (i) be disputed or (ii) require the University to incur extraordinary out-of-pocket expenses, TDIC may decide to withhold all or part of such IP Revenues for as long as necessary with the approval of the President.

14.7.4.4 Creator's Estate

A Creator's estate, heirs, legatees or assignees will be entitled to such Creator's share of relevant Creators' Collective Share of IP Revenues for as long as the

University receives any IP Revenues from the commercialization of the relevant University IP and shall be deemed Creators for the purpose of this Policy.

14.7.4.5 Contact and bank details

The onus is upon each Creator to ensure that the University has their up-to-date contact and banking details for the purpose of distributing IP Revenues. In the absence of up-to-date banking details, the University shall keep a Creator's share of Creators' Collective Share of IP Revenues in reserve for a maximum period of three years after which all rights of such Creator to receive such payment will be forfeited. If the University pays an amount into an incorrect account as a result of information supplied to it being outdated or incorrect, the University shall not have any further obligation or liability in respect of such payment, which shall be deemed to have been duly and properly made.

14.7.4.6 Proprietary Interests

The University may at times accept Proprietary Interests from a corporate licensee as consideration for the license of any University IP.

For so long as it holds such Proprietary Interests, the University shall manage them at its sole discretion. Any acquisition or issuance of further Proprietary Interests on the basis of rights arising from the holding by the University of Proprietary Interests that the University accepted as consideration for the license of any University IP (such as anti-dilution rights) shall be for the sole benefit of the University.

When IP Revenues are earned from the holding of Proprietary Interests that the University accepted as consideration for the license of any University IP, such as the payment of dividends or the receipt of proceeds from the sale of Proprietary Interests, the University shall distribute them in accordance with the provisions of 14.7.4.

14.7.5 Startups

The University proactively encourages entrepreneurship and the development of startups as ways to commercialize University IP and promote new business and industry creation.

TDIC oversees the University's entrepreneurship initiatives, including, without limitations, by operating its Proof-of-Concept Program, Innovation Square Startup Accelerator Program and Innovation Square Incubator. The University provides

support services to startups, which license any University IP or which are part of any of the programs associated with the University's entrepreneurship initiatives.

Policy Subjects shall consult TDIC for details about the University's entrepreneurship initiatives and associated programs, the terms and conditions of use of the Innovation Square Incubator and/or to license any University IP for a startup.

14.8 Disputes

14.8.1 Breach

Breach of the provisions of this Policy shall be dealt with under the normal procedures of the University, and in accordance with applicable laws.

14.8.2 Dispute Resolution

Any dispute (including between Policy Subjects) or question of interpretation arising under this Policy shall in the first instance be referred to the Executive Vice President for Technology Development and Innovation who will attempt to informally resolve the matter within 20 working days.

Failing that, the Executive Vice President for Technology Development and Innovation shall appoint an ad hoc panel comprised of at least 3 members, which may include external experts. The panel shall be formed and convened to review the matter within 15 working days. The Executive Vice President for Technology Development and Innovation shall appoint the chair. If additional time is needed to form and convene the panel, the 15 working days period may be extended by the Executive Vice President for Technology Development and Innovation. The panel shall, within 20 working days from the date on which it first convened, conduct an impartial and confidential review of the facts and circumstances of the matter and make recommendations to resolve it. If additional time is needed to complete the review, the period may be extended by the chair of the panel. The chair of the panel shall notify the President in writing of the recommendation of the panel, copying the Executive Vice President for Technology Development and Innovation, within 5 working days.

The President, or his/her designee, shall make a final determination on the matter and inform the parties of such determination within 15 working days.

14.9 Forms

[Background IP Disclosure Form](#)

[IP Disclosure Form](#)

[MTA Application Form](#)

14.10 Contacts

14.10.1 Policy Owner

Executive Vice President for Technology Development and Innovation

14.10.2 Inquiries

The University encourages all Policy Subjects to consult TDIC in relation to inquiries regarding this Policy and for information about registration and protection of University IP or entrepreneurship.

For inquiries relating to entrepreneurship or collaboration with industry:
bd@oist.jp

For inquiries relating to Intellectual Property and any other inquiries: tls@oist.jp