

IP MANAGEMENT POLICY (IPMP)

INDIAN COUNCIL OF FORESTRY RESEARCH & EDUCATION (ICFRE)

DEHRADUN

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1. Introduction/Objectives

1.1. The Indian Council of Forestry Research and Education (hereafter "ICFRE") is a registered society founded in 1986 and functions now as an autonomous body under the Ministry of Environment and Forests, Government of India. Being the apex body in the national forestry research system, it undertakes a wide variety of forestry research through several of its institutes.

1.2. ICFRE wishes to evolve a comprehensive policy governing the generation and management of intellectual property emanating from ICFRE and its various institutes (hereafter "ICFRE institutes").

1.3. ICFRE shall strive to expeditiously disseminate and share research results in an open access manner, as far as practicable. At the same time, ICFRE recognizes the importance of protecting its technologies under Indian and other applicable foreign intellectual property laws, and commercializing them in a manner befitting its commitment to public good and welfare.

1.4. The commercialization of inventions through appropriate means including the registration of intellectual property rights and the transfer of technology to the private sector should not in any way derogate from the principal aim of education and research. Therefore, the policy will attempt to ensure that the dissemination of information must not be delayed beyond the minimal period necessary to define and protect the rights of the parties. The proceeds of any technology transfer and/or commercialization are to be equitably shared between ICFRE, the local institute where the IP was generated and the concerned scientist/researcher. Further such proceeds accruing to the institute should be utilized as far as possible to fund further research and development.

1.5. A description of the various terms and definitions used for the purpose of these guidelines has been provided below.

2. Definitions

For the purpose of the ICFRE IP Management Policy (hereafter "IPMP"), the following definitions shall apply:

2.1. Exclusive License of an intellectual property means a license granted in favour of a certain person to the exclusion of all others, that allows only that person to work with the intellectual property in question and commercialize/use it as per the terms of the license.

2.2. ICFRE: Unless specified otherwise, the term ICFRE shall include ICFRE institutes.

2.3. ICFRE Institutes mean the network of institutions of the Indian Council of Forestry Research & Education (ICFRE), including 9 research institutes and 3 advanced research centres, through which ICFRE conducts its research activities. The names and location of these institutes and centres are given below:

Research Institutes under the Council: Forest Research Institute (FRI), Dehradun, Institute of Forest Genetics and Tree Breeding (IFGTB), Coimbatore, Institute of Wood Science and Technology (IWST), Bangalore, Tropical Forest Research Institute (TFRI), Jabalpur, Rain Forest Research Institute (RFRI), Jorhat, Arid Forest Research Institute (AFRI), Jodhpur, Himalayan Forest Research Institute (HFRI), Shimla, Institute of Forest Productivity (IFP), Ranchi and Institute of Forest Biodiversity (IFB), Hyderabad.

Advanced research centres under the Council: Centre for Social Forestry and Eco-Rehabilitation (CSFER), Allahabad, Centre for Forestry Research and Human Resource Development (CFRHRD), Chhindwara, Advanced Research Centre for Bamboo and Rattans (ARCBR), Aizawl. These also include the Coordinating Units of All India Coordinated Research projects/All India Network Projects and the Van Vigyan Kendras.

2.4. ICFRE Work shall mean all work protectable as intellectual property generated in the course of employment by employees of ICFRE. In case of non-employees, it shall, subject to

contractual stipulations to the contrary, mean and include any work generated by such non-employees pursuant to directions from ICFRE or under its control or supervision or by using any of its resources.

2.5. Institutional works include works that are supported by a specific allocation of ICFRE funds or that are created at the direction of the ICFRE for a specific purpose. Institutional works also include works whose authorship cannot be attributed to one or a discrete number of authors but rather results from simultaneous or sequential contributions over time by multiple scientists/researchers. For example, software tools developed and improved over time by multiple researchers where authorship is not appropriately attributed to a single or defined group of authors would constitute an institutional work. The mere fact that multiple individuals have contributed to the creation of a work shall not cause the work to constitute an institutional work.

2.6. Intellectual Property (hereafter "IP") means and includes any invention/work/creation protectable as intellectual property under any of the law(s) in existence in India or any other part of the world. It will include but not be limited to patents, plant variety protection, copyright, trade-mark, design, trade-secrets/confidential information etc.

2.7. Intellectual Property Management Offices (hereafter "IPMO") are IP management offices established at ICFRE institutes by the ICFRE Director. IPMOs will pursue all IP management and technology transfer/commercialization at the institute level as per these guidelines and any other administrative or policy decisions taken in the ICFRE from time to time. They will seek any specific, case-to-case basis advice/assistance from the CIPMO at the ICFRE headquarters.

2.8. Central IP Management Office (hereafter "CIPMO") is the nodal office established to oversee the ICFRE IP policy. Located at the ICFRE headquarters and chaired by a person designated by the Director General, it will oversee the work of the IPMOs and be the overall decision-making body for all matters pertaining to the IP management.

2.9. In the course of research shall mean in the course of employment as far as ICFRE employees are concerned. In the case of non-employees, it shall, subject to any contractual stipulation to the contrary, mean and include any research work undertaken by them, pursuant to directions from ICFRE or under its control or supervision or using any of its resources.

2.10 License means the permission granted by the intellectual property owner (licensor) to a third party (licensee) to use a particular intellectual property right in accordance with terms outlined in an Agreement.

2.11. Non-exclusive License of an intellectual property means a license granted in favour of a certain person, without in any way affecting the ability of the IP owner to grant similar licenses to others.

2.12. Scientist/Researcher: The term scientist/researcher shall include:

- i) any scientist/researcher employed by ICFRE;
- ii) all students of ICFRE;
- iii) non-employees who work at the direction of ICFRE or under its control and supervision or those who use ICFRE resources.

2.13. True and First Inventor/Creator/Designer means a scientist/innovator who has generated/created/designed the patentable (or protectable in any other recognized form of intellectual property) research and whose name is recorded in the patent/design/plant variety application as appropriate.

3. Intellectual Property Protection

3.1. IP Categories: The conduct of research at any of the ICFRE institutes may result in intellectual property subject matter capable of protection under any of the recognized

intellectual property regimes whether in India or abroad. The term intellectual property has been widely defined to include patents, copyright, plant variety, trade marks etc. in Section 2 above. However, given that the focus of this policy is on the results of scientific/technological research, the main IP categories dealt with are patents, plant varieties, trade secrets and designs (hereafter "Principal IP" or "PIP"). Other categories such as copyrights and trademarks will be referred to as "Other IP" (or "OIP") and separately dealt with.

3.2. Institutional Arrangement: Pursuant to this policy and in accordance with the definition in Section 2, ICFRE will designate/establish IP Management Offices at each of the institutes (hereafter "IP Management Offices" or "IPMO"s). These offices will be chaired by a person designated by the Director of the Institute concerned and will be the key nodal agency at the relevant institute for all matters pertaining to this policy. A Central IP Management Office (hereafter "CIPMO") established at the ICFRE headquarters and chaired by a person designated by the Director General will oversee the work of the IPMOs and be the overall decision-making body for all matters pertaining to the IP management. The IPMOs will take steps to coordinate, harmonize and synergize their activities with the CIPMO, working under its close supervision and guidance.

3.3. IP from collaborative work: The regulation of intellectual property generated from research results pertaining to collaboration/partnership between ICFRE and third parties shall be governed by the terms of the contract between the parties.

3.4. Progress Reports: ICFRE institutes shall maintain proper and authenticated records in relation to all IP generated and disclosed/reported by the scientists/researchers, protected under various intellectual property regimes, and commercialized/shared thereafter. They shall periodically submit progress report to ICFRE headquarters.

3.5. Monitoring and IP/Market Watch: The IPMOs at the respective institutes, in consultation with the CIPMO at the ICFRE headquarters will regularly monitor all IP and

technology transfer/knowledge management activities. A monitoring system will be developed with the help of bioinformatics units at the ICFRE institutes.

3.6. Dispute Resolution Mechanism: In the event of any dispute arising out of or in relation to this policy, the same shall be resolved amicably at the first instance through mediation by the Director of the relevant institute. If the dispute involves the Director in some way, it shall be mediated by the Director General, ICFRE. If the dispute involves the Director General, ICFRE in some way, it shall be mediated by an external mediator appointed by the Chief Justice of the Uttarakhand High Court at Dehradun. Provided that all mediators above shall aim to mediate in a fair and unbiased manner and have the dispute settled between the parties within three months of the dispute being brought to their notice. All mediators have the freedom to enlist the help of experts, whether legal or otherwise for helping them mediate. The settlement shall be recorded in writing with the signatures of the parties and the mediator.

Should the matter remain unresolved, the matter is to be referred to an arbitrator to be appointed by the Chief Justice of the Uttarakhand High Court from a panel of arbitrators maintained by the ICA (Indian Council of Arbitrators). Once appointed, the arbitrator shall issue his/her award within 6 months of the taking up the dispute. It is understood that the exclusive governing law for any dispute arising from or in relation to this policy shall be Indian law.

4. Principal IP (PIP)

4.1. Applicability: This section (3) shall only apply to Principal Intellectual Property (PIP) as defined earlier. Subject to any contract to the contrary, the below provisions shall apply to all PIP generated in the course of research by scientists/researchers of ICFRE.

This policy shall apply to all research that is generated on or after the date of commencement of this policy, which shall be_____.

4.2. Timely Disclosure: Any registrable PIP generated in the course of research by scientists/researchers shall be disclosed by the scientist/researcher on a timely basis to the respective IPMO. Such disclosure shall be made through a “disclosure statement” outlining information about the creator(s)/designer(s), what was created/designed, circumstances leading to the creation/design, and its technological/commercial potential. Among other things, such a document provides the basis for a determination of the potential for registrability as a patent or plant variety or design.

4.3. Evaluating IP Protection: The IPMO shall, in consultation with the concerned scientist (s)/researcher (s), decide whether or not to proceed with the IP registration or whether to simply disclose it through publications or other open access formats. The evaluation shall be based *inter alia* on costs of protection, the commercial potential of the technology in question, the likely strength of the concerned IP and whether or not the research is better left in the public domain, free of any legal encumbrance. In order to make this evaluation, the IPMO could also consult with an expert under a confidentiality agreement including a patent attorney/IPR expert and/or other technology expert. A panel of experts may be created for this purpose. The IPMO will duly record the reasons for their final determination in this regard and such information will be placed in an online repository and linked to a central database.

In case of a decision to proceed with the IP registration, the IPMO will forward the proposal to the CIPMO.

4.4. IP Ownership: Upon deciding to protect the research through an intellectual property registration, applications for IP registration shall indicate ICFRE as the owner of the IP in question and the scientists/researchers who generate the IP in question are the “True and First Inventors(s)/Creators/Designers’ of that IP.

4.5. Licensing/Commercialization: In order to encourage the development of its intellectual property into valuable products useful for society, ICFRE may often have to

partner with third parties including private entities with the requisite technological expertise and financial resources. Such third party partnerships shall be forged keeping in mind the larger public interest in ensuring that the fruits of public funded research are of significant benefit to the public. As far as possible, ICFRE shall enter into non-exclusive licenses to enable such commercialization without necessarily hampering its ability to achieve a wider diffusion of the technology by licensing to others. However, in some cases involving significant investments in developing the technology, an exclusive license may be necessary to provide an incentive for a company to so invest. For all such decisions, the concerned scientist/researcher and the relevant IPMO will have to be consulted. A draft license agreement has been provided for in Annexure B. In so far as the collaboration between ICFRE and third parties involves any transfer of materials, a draft material transfer agreement (MTA) has been provided in Annexure C.

The minimum baseline pricing for commercialization may be arrived at by the concerned Director of the Institute by considering the following, subject to review of pricing every 3 years:-

1. Cost of development of technology or process
2. Comparative cost of imported IP, wherever applicable or available
3. Estimates of net benefits to be derived by the licensee over next 5 years.
4. Estimated size and no. of potential licensees
5. Opportunity value

4.6. Determinant Factors for Commercialization/Technology Transfer: ICFRE recognizes commercialization and technology transfer to be subordinate to education, research and broader knowledge spill overs and will not therefore permit the dissemination of information to be delayed beyond the minimum period necessary to define and protect the rights of the parties involved. The factors to be considered during commercialization/technology transfer will include:

- (i) national priorities relating to food security,
- (ii) sustainable use of natural resources,
- (iii) enhancing the incomes of small and marginal farmers and
- (iv) employment generation.

4.7 Royalties: In all of its licensing arrangements, ICFRE shall, unless circumstances otherwise require attempt to obtain from the licensee(s) either one or more of the following:

- (i) upfront lump sum payment,
- (ii) upfront payment plus royalty on actual sale,
- (iii) royalty on actual sale,
- (iv) in-licensing/cross-licensing of tools of technology generation in frontier areas,
- (v) research capacity building,
- (vi) research chair,
- (vii) research fellowship, etc.
- (viii) cross licensing of technology.

All monetary benefits generated above (after deduction of applicable taxes) shall be distributed as below:

Stakeholder category	Share of net revenue
ICFRE Headquarters (for IP and admin charges)	40%
ICFRE Institutes (s) from where the IP originates	20%
Scientist/Researcher from whom the IP originates (those listed as true and first inventors/creators/designers)	15%
Staff Welfare	10%
Research Funds for team responsible for IP creation	15%

Provided that in case of multiple inventors/creators, the 15% royalty outlined above shall ordinarily be allocated on an equal sharing basis. However, if there is wide discrepancy in the relative contributions of scientists/researchers to the creation of the said intellectual property, then the 15% shall be proportionately divided, based on the relative

contributions of each scientist/researcher, to be determined at the sole discretion of the principal investigator/researcher.

ICFRE will also confer annual awards and prizes upon its scientists and other staff in order to incentivize them further.

4.8. Legal Action: The CIPMO will initiate any legal action in so far as any intellectual property right is concerned. The relevant IPMO shall provide all necessary assistance.

5. Other IP (OIP)

5.1. Subject to any contractual term to the contrary, the procedures for regulating intellectual property other than patents and plant varieties are listed below:

5.2. Copyright Protection

5.2.1. Objective: ICFRE wishes to foster the rapid dissemination of all research works and publications authored by one or more of its scientists/researchers.

5.2.2. Copyright Ownership: Copyright ownership for all ICFRE works except “institutional works” shall vest with the author(s). Ownership of institutional works shall vest with ICFRE. However, in appropriate cases, ICFRE may opt for a joint ownership of such works with the author. An inclusive definition of “institutional works” has been provided in Section 2.

5.2.3. Disclosure: Authors of any ICFRE work protectable by copyright law will disclose the same to the relevant IPMO. The IPMO, along with the author, will decide whether to publish the work, whether to register it as per the Copyright Act, and the quantum of royalty sharing and other terms in case the work is licensed or commercialized.

5.2.4. Author's obligation to issue Non-Exclusive License to ICFRE: Notwithstanding copyright ownership vesting with the concerned scientist/research author, a non-exclusive license shall be granted by the said author to ICFRE as will enable it to reproduce or use in any manner the said works as appropriate.

5.2.5. Use of ICFRE Resources: Resources of ICFRE or ICFRE Institutes are to be used solely for ICFRE purposes and not for personal gain or personal commercial advantage, nor for any other non-ICFRE purposes. Therefore, if the creator of a copyrightable work makes significant use of such resources (including the use of any personnel from ICFRE or ICFRE Institutes) to create the work, he/she shall disclose the work to the relevant IPMO and may be required to assign the sole/joint title over such work to the ICFRE.

5.2.6. Licensing of ICFRE-owned Copyright: CIPMO seeks the most effective means of knowledge transfer for public use and benefit and, toward that end, handles the evaluation, marketing, negotiations, and licensing of ICFRE-owned copyrightable materials. The terms and nature of the license will be jointly decided by the author and the CIPMO.

5.2.7. Sharing Royalties: Royalties for any exploitation of works, whose copyright ownership vests with ICFRE will be allocated as per the ICFRE PIP policy on net revenue/benefit sharing.

5.2.8. Copyright Notice on ICFRE-owned Materials: The following notice shall be placed on all materials over which ICFRE owns copyright: Copyright © [year] ICFRE. All Rights Reserved. No other institutional name is to be used in the copyright notice, although the name and address of the ICFRE institute to which readers can direct inquiries may be listed below the copyright notice. The date in the notice should be the year in which the work is first published, i.e. made available to the public.

5.3. Trade Mark: ICFRE may protect any brand or logo that it uses in relation to any of its technologies/products, as a trademark under the Trade Marks Act, 1999. The ICFRE emblem may also be registered as its Collective Mark under section 63 of the Trade Marks Act. ICFRE shall stipulate conditions governing the use of the collective mark, including the

persons (institutions) authorized to use the mark, conditions for its use and any sanctions against its misuse.

5.4. Other Forms of IP: For addressing any specific matters related to IP in any other form than those described in the aforesaid part of this section, the IPMOs will take case-specific decisions in consultation with the CIPMO.