

# National Yang Ming Chiao Tung University

## Management Guidelines for R&D Results and Patent Applications

Approved at the 4th Administrative Meeting of the University for the 2020 Academic Year on April 28, 2021

### Article 1 Purpose of Legislation

In order to encourage research, development, and innovation of science and technology by the units and personnel of the University, to improve the technological standard and to benefit the welfare of the nation and society, and to effectively manage and utilize the research and development results (hereinafter referred to as R&D results) and to ensure the rights and interests of the University and the creators, these guidelines have been established in accordance with the governmental regulations and the University's Regulations Governing the Implementation of Academia and Industry Collaboration.

### Article 2 Definition of Terms

1. The term "R&D results" in these guidelines refers to the results of research and development of the creator and the intellectual property rights arising from such results, including but not limited to patents, patent applications, copyrights, integrated circuit layout rights, trade secrets, know-how, computer hardware designs, computer software and its manuals, instructions, genomic database, and other tangible or intangible results.
2. The term "R&D results completed in the course of duties" in these guidelines includes, but is not limited to, the following types:
  - a. Those obtained from research and development conducted with University endowment funds.
  - b. R&D results obtained from research and development carried out by the University through grants, commissions or funding from government agencies.
  - c. R&D results obtained by the University through research and development entrusted to the University by units other than governmental agencies, and which have been agreed to belong to the University.
  - d. Researchers who use the University's resources, the University's existing R&D results, or who conduct research and development during their service in the University.
3. The term "technology transfer" in these guidelines refers to the licensing or transfer of R&D results.
4. The term "patent fee" in these guidelines refers to the patent application and the filing of a defense in the application process, including but not limited to the application fee, certificate fee, annual fee, patent office service fee, and other fees that are required by law.
5. The term "with compensation" in these guidelines refers to the consideration for the technology transfer in the form of contractual fee, license fee, derivative benefit fee, technology share, cross-license, technology cooperation or other common methods in the industry.
6. The term "creator" in these guidelines refers to instructors, staff, researchers, project personnel, contract employees, and students who are actually involved in the research, and who have acquired the moral rights of the creations in accordance with the laws related to intellectual property rights.

### Article 3 Rights

1. Except as otherwise provided in these guidelines or the contract, the patent application, patent rights, and all other intellectual property rights of the creator's R&D results generated in the course of his/her duties shall belong to the University, and the University shall apply for, review, and maintain the patent in accordance with

these guidelines.

2. If the intellectual property rights in the preceding paragraph are rights other than patents, the application and maintenance of such rights shall be made by the creator with the consent of the Office of Research and Development of the University.

#### Article 4 Responsible Authority

1. The patent application, review, maintenance and other related matters of the University's R&D results shall be coordinated by the Office of Research and Development of the University.
2. When performing the duties in the preceding paragraph, the Office of Research and Development shall compile the relevant application and review information and submit it to the University's Research and Development Results Management Committee for consideration.

#### Article 5 Application and Review Procedures

1. When the creator submits a patent application for his/her R&D results, he/she shall first log in to the patent application system of the University, fill in the relevant information of the proposal, and upload the attached information.
2. The creator shall submit the following documents to the Office of Research and Development for application within 14 days after the completion of the procedure described in the preceding paragraph, and any late submission of complete documents shall be considered as withdrawal of the proposal.
  - a. The invention disclosure form of the patent application and its electronic file.
  - b. Electronic files of relevant papers, patents or documents generated from the patent search.
  - c. For R&D results generated from National Science and Technology Council (NSTC) projects, a copy of the "Funding Approval List" shall be attached; for R&D results generated from Ministry of Economic Affairs (MoEA) projects, a copy of the project contract and a copy of the list of principal investigators as contained in the project proposal shall be attached.
  - d. For R&D results generated by non-government subsidies, a copy of the original "National Yang Ming Chiao Tung University Patent Application and Declaration of R&D Results" shall be attached.
3. The procedure for review of internal patent applications is as follows:
  - a. After receiving the complete proposal documents, the Office of Research and Development shall appoint external experts and scholars to conduct preliminary technical evaluation and review (hereinafter referred to as preliminary review). If the preliminary review is not approved, the creator, after being notified in writing by the Office of Research and Development, may submit a reply within 14 days after receiving the above notice if he/she disagrees with the proposal, but is limited to one time.

If the information to be supplemented involves experimental data or other factors that require an extension of the deadline for reply, the creator shall first report to the Office of Research and Development, and failure to do so or failure to submit a reply after the deadline shall be considered as a withdrawal of the proposal.

If the proposal is approved in the preliminary review, it shall be reviewed by the Research and Development Results Management Committee Meeting.
  - b. If the proposal is approved in the preliminary review, after discussion at the Research and Development Results Management Committee Meeting, the proposal shall be approved for patent application, disapproved for patent application or other resolutions. When the Committee resolves to grant a patent application, it shall also resolve the country of the patent application.
  - c. If a proposal is approved in the preliminary review and rejected by the Committee,

the creator may submit a reply to the Committee within 30 days after receiving the notification of the decision. If the information to be supplemented involves experimental data or other factors that require an extension of the deadline for reply, the creator shall first report to the Office of Research and Development, and failure to do so or failure to submit a reply after the deadline shall be considered as a withdrawal of the proposal.

If the proposal is not approved by a resolution of the Research and Development Results Management Committee after the submission of the reply, the proposal shall be confirmed and shall not be objected to. The patent application and patent right still belong to the University, and the creator may not apply for the patent in his own name.

4. If a proposal is approved by the Research and Development Results Management Committee, the Office of Research and Development shall appoint a patent office that has been selected by the University for subsequent patent applications.  
If the creator intends to appoint another patent office to file the application, the patent fee shall be borne by the creator in addition to filing the application in the name of the University.
5. If the patent application is made jointly by an external entity or the creator and the University, and the University does not have to bear the patent fees, the creator may apply for the patent without going through the above-mentioned internal patent application procedures, but must attach the "Agreement on the Sharing of Research and Development Results" or other relevant documents, and report to the Office of Research and Development in writing before filing the patent application.
6. If the creator intends to pay for the patent fees by himself/herself, he/she may not go through the above-mentioned internal patent application procedure, but shall file the application in the name of the University and report the progress of the case to the Office of Research and Development in writing.
7. For creators who are responsible for their own patent costs, if the source of funding is from government agencies or industry-academia collaboration projects, or other sources that are subject to the University's accounting procedures, the relevant regulations of the University shall be followed.
8. In the case of costs covered in the preceding paragraph, the creator shall still be responsible for the subsequent patent costs after the execution of the project or after the costs are exhausted.

#### Article 6 Obligations of Creators

1. When there are more than two creators, all creators shall elect a representative (hereinafter referred to as "representative creator") to supervise all creators to comply with national laws and regulations and relevant regulations of the University. If the creator is not the same person as the principal investigator of the government project, the creator (or representative) shall inform the principal investigator of the project in advance before proceeding with the subsequent patent application.
2. The creator shall fill out the invention disclosure form and various proposal documents of the patent application with academic professionalism and honesty, and the creator shall be responsible for any inaccuracy or infringement of others' rights and interests due to inaccuracy, plagiarism, counterfeiting, or theft of others' trade secrets.
3. The creator shall cooperate with the patent office in convening technical meetings, providing relevant information and follow-up meetings after the proposal is approved by the Research and Development Results Management Committee. If a patent application involves an appeal or an administrative proceeding, the creator shall cooperate fully in advocating or defending the R&D results.
4. Before the certificate of patent is granted, the creator shall keep the content of his/her idea strictly confidential in order not to lose novelty.

5. The representative creator shall make all creators aware that the patent application rights, patent rights and all other intellectual property rights of their R&D results are owned by the University. In the event of a dispute, the representative creator shall be responsible for coordinating and resolving the dispute; if the University is damaged by the dispute, the representative creator shall compensate the University for all losses; after the patent office submits a formal patent application to the official, if the creator needs to change the relevant application documents or information, the creator shall state the reasons in writing and sign the consent of the responsible authority, and the related costs shall be borne by the creator.
6. The creator shall cooperate with the Office of Research and Development in promoting and utilizing the R&D results and the patent.
7. If a third party asserts the invalidity of the R&D results or the acquired patent, files an objection or revocation procedure, the creator shall be obligated to assist the University to make necessary defense without compensation. If the patent is infringed by others, the creator is also obligated to assist the University, without compensation, in the analysis of infringement and other related matters, and to help explain and clarify the technical content.

#### Article 7 Patent Fees Payment

1. If the University and the sponsoring organization agree to jointly or proportionally bear the patent fees, or if the patent is shared, the patent fees shall be paid by the sponsoring organization, and once the patent has yielded revenue, the University and the sponsoring organization shall share the revenue in accordance with the agreed proportion after deducting the patent fees already paid by the sponsoring organization.
2. Unless otherwise specified, the patent fees shall be covered according to the resolution of the Research and Development Results Management Committee.
3. The patent fees for patent applications in the R.O.C. and the U.S. may be borne in full by the University, by the University and the government sponsoring agency in accordance with the project agreement, or by the University and the sponsoring agency jointly.
4. If a patent is applied for in a country or region other than the R.O.C. or the U.S., the representative creator shall coordinate with all creators to pay 30% of the patent fees incurred before the patent is granted.
5. The patent fees for patent applications in countries or regions other than the R.O.C. and the U.S. under the Ministry of Economic Affairs shall be paid in the following manner
  - a. If the institutions under the Ministry of Economic Affairs have agreed that the R&D results are to be managed by the University in accordance with the regulations, the nature of the project, or the circumstances of the case, and have set aside funds in the project to pay for the patent fees, the patent fees derived from the R&D results generated during the implementation of the project shall be fully expended by the funds set aside in the project.
  - b. The principal investigator shall notify the Office of Research and Development in writing upon the expiration of the project period.
  - c. If the patent is not granted before the expiration of the project period, the representative creator shall coordinate with all creators to pay 30% of the patent fees.
  - d. When the patent is granted, the University shall bear the patent costs for the issuance of the patent and the subsequent related patent costs. However, if the project has a provision for reimbursement of expenses, they will still be covered by the project funds.
  - e. If there is no other project funding or funds available to cover patent costs, the principal investigator shall coordinate with all creators to cover 30% of the patent

costs, and then the University shall cover subsequent patent costs after the patent is granted.

6. If the representative creator is the representative of the University with excellent performance in technology transfer and the actual amount of received equity reaches NT\$5,000,000 or more (excluding the advance technology transfer fee), the patent application fee for countries or regions other than the R.O.C. and the U.S. may be considered and approved by the Research and Development Management Committee to increase the proportion of the University's subsidy.
7. The additional costs arising from the patent application that are attributable to the creator shall be borne by the creator.
8. For the defense fee of a patent application, the University will be limited to paying three times. However, in special cases or other circumstances, the Research and Development Management Committee may consider the actual situation and agree to subsidize the application without the aforementioned limit of three times.
9. If the creator fails to obtain a patent due to a false statement in the invention disclosure, including but not limited to a statement on the source of the project, novelty, or other personal factors attributable to the creator, or if the creator withdraws the case before the patent office submits a formal application to the government, the patent fees shall be borne by the creator; the patent fees paid by the University shall also be repaid by the creator.

#### Article 8 Urgent Application

1. If the creator needs to file a patent application before the decision of the Research and Development Management Committee to apply for a patent due to the time limitation factor, he/she may sign the "Advance Patent Application Affidavit" and send it to the patent office entrusted by the Office of Research and Development to prepare and apply for the patent first. If the patent application is filed in a country other than the R.O.C., the Office of Research and Development shall approve the application before the application is filed.
2. The creator shall complete the relevant documents of the proposal within one month after signing the "Advance Patent Application Affidavit", and the proposal shall be deemed to be withdrawn if the deadline is not met.
3. If the proposal of the creator is deemed to be withdrawn due to the provisions of the preceding paragraph, or if the proposal fails to pass the review of the Research and Development Management Committee, the patent fee shall be borne by the creator; the patent fee paid by the University shall also be returned by the creator.

#### Article 9 Transfer of R&D Results

Unless otherwise specified, requests from third parties for the transfer of R&D results owned by the University shall be based on the principles of with compensation, fairness, justice, and openness, and shall be reviewed and approved by the University's Research and Development Management Committee. The proposed transfer of R&D results shall be announced in accordance with relevant regulations. In addition to the aforementioned administrative procedures, the University shall follow the regulations of the granting agency when transferring the R&D results produced by the government agency's grant program to a third party.

#### Article 10 Patent Maintenance

1. After the patent has been granted, the maintenance period shall be eight years (seven and a half years for U.S. patents). If there is no need to transfer the patented technology or create a new business, the Office of Research and Development may request the Research and Development Management Committee to review whether there is a need to continue to maintain the patent. If the Research and Development Management Committee decides that there is no need to continue to maintain the patent, the University may abandon the maintenance of the patent after three months

of announcement and no one has requested for a transfer, with the consent of the government agency.

2. If a patent of the University has exceeded the maintenance period stipulated by the government agency at the time, and there has been no technology transfer or there is no technology transfer at the present time, the Office of Research and Development may request a resolution from the Research and Development Management Committee according to the circumstances. After three months of public notice and no request for transfer, the patent shall be abandoned after the consent of the government agency.
3. Unless otherwise provided in the government grant program, if there is no need for technology transfer or new business, and the patent has been granted for more than eight years (the U.S. patent has been granted for seven and a half years), and the representative creator has not submitted an application for continued maintenance one year prior to the expiration of the said period, the creator shall be deemed to have agreed to abandon the maintenance of the patent. However, if there is a need for patent licensing or new business, the representative creator shall take the initiative to notify the Office of Research and Development in writing and request the Research and Development Management Committee to evaluate whether to continue to maintain the patent.

#### Article 11 Penalty

1. If the creator violates the provisions of these guidelines, he/she shall be punished in accordance with the relevant regulations of the University.
2. If the creator fails to pay or make up for the fees in accordance with the provisions of these guidelines, the University may set off or take legal action to recover the fees if the creator still fails to pay after the University has reminded him/her in accordance with the relevant procedures.

#### Article 12 Others

1. Before the implementation of these guidelines, if a creator has commissioned a patent office to apply for a patent in the name of the University and has incurred patent fees, the creator may submit the original copy of the invention disclosure form and the original bill for the patent application in the name of the University to the Office of Research and Development for a decision by the Research and Development Management Committee on whether to reimburse the expenses. However, the creator shall be responsible for any amount that exceeds the standard patent fee paid by the University.
2. If there is any matter not covered by these guidelines, it shall be supplemented in accordance with the relevant governmental laws and regulations, the relevant regulations of the University, or the resolution of the Research and Development Management Committee in accordance with its authority.

#### Article 13 Date of Entry into Force and Implementation

These guidelines shall come into effect on August 1, 2021 after being approved in the Administrative Meeting of the University, and shall be amended in the same manner.