

National University Corporation Okayama University Regulations for Handling Employee Inventions, Etc.

April 1, 2004

Okayama University Regulation No.17

Amendments: Reg. No. 21 of March 9, 2006

Reg. No. 30 of March 30, 2007

Reg. No. 5 of March 31, 2008

Reg. No. 6 of March 31, 2011

Reg. No. 11 of March 30, 2012

Reg. No. 93 of September 17, 2015

Chapter I General Provisions

(Purpose)

Article 1

On the basis of the provisions of Article 63 of the National University Corporation Okayama University Personnel Work Rules (Okayama University Rule No. 10 of 2004; hereinafter, “Personnel Work Rules”), these Regulations aim to stipulate the manner in which inventions, etc. by employees of National University Corporation Okayama University (hereinafter, the “University”), shall be handled, guarantee the rights of inventors, implement proper management of intellectual property rights, and thereby promote inventions, etc., enhance research motivation, and disseminate outcomes.

(Definitions of Terms)

Article 2

In these Regulations, the following terms have the meanings given below.

(i) “Intellectual Property Rights” mean the following.

- (a) Patent rights under the Patent Act (Act No. 121 of 1959), utility model rights under the Utility Model Act (Act No. 123 of 1959), design rights under the Design Act (Act No. 125 of 1959), layout-design exploitation rights under the Act on the Circuit Layout of Semiconductor Integrated Circuits (Act No. 43 of 1985), breeder’s rights under the Plant Variety Protection and Seed Act (Act No. 83 of 1998), and foreign rights equivalent to the foregoing respective rights
- (b) Rights to obtain patents under the Patent Act, rights to register utility models under the Utility Model Act, rights to register designs under the Design Act, rights to register the establishment of layout-design exploitation rights under paragraph 1 of Article 3 of the Act on the Circuit Layout of Semiconductor Integrated Circuits, rights to register varieties under Article 3 of the Plant Variety Protection and Seed Act, and foreign rights equivalent to the foregoing respective rights
- (c) Copyrights under Articles 21 to 28 of the Copyright Act (Act No. 48 of 1970) concerning

computer program works under item 10-2 of paragraph 1 of Article 2 of the same Act and concerning database works under item 10-3 of the same paragraph, and foreign rights equivalent to the foregoing copyrights

(d) Among items of technical information not subject to the rights under (a), (b) or (c), rights concerning those items which can be concealed and also are of proprietary nature (hereinafter, “Know-how”)

(ii) “Inventions” mean the following:

- (a) Inventions leading to patents;
- (b) Devices leading to utility models;
- (c) Designs leading to design rights;
- (d) Circuit layouts leading to layout-design exploitation rights;
- (e) Varieties leading to breeder’s rights;
- (f) Computer program works and database works; and
- (g) Know-how.

(iii) “Employee Inventions” mean any Inventions that employees produce on the basis of research, etc. for which the University provides costs or any other assistance, or research, etc. for which facilities managed by the University are used.

(iv) “Employees” means the persons prescribed in Article 2 of the Personnel Work Rules.

(v) “Inventors” mean employees who have produced the Inventions.

(vi) “Applications” mean the prescribed procedures required for the protection of rights as provided for in laws and regulations in connection with Intellectual Property Rights, such as patent applications and applications for registration.

(vii) The “Exploitation” of Intellectual Property Rights means the acts prescribed in paragraph 3 of Article 2 of the Patent Act, the acts prescribed in paragraph 3 of Article 2 of the Utility Model Act, the acts prescribed in paragraph 3 of Article 2 of the Design Act, the acts prescribed in paragraph 3 of Article 2 of the Act on the Circuit Layout of Semiconductor Integrated Circuits, the acts prescribed in paragraph 5 of Article 2 of the Plant Variety Protection and Seed Act, the acts prescribed in items 15 and 19 of paragraph 1 of Article 2 of the Copyright Act, and the use of Know-how.

(Attribution of Rights)

Article 3

The University shall succeed to and possess part or all of Intellectual Property Rights pertaining to Employee

Inventions; provided, however, that the University may attribute such rights to employees if the University finds it proper under special circumstances.

Chapter II Notification, Judgment on Attribution, and Application

(Notification of Inventions)

Article 4

When producing an Invention, the employee shall immediately notify the President to that effect using the separately prescribed form.

(Deliberation, Decision and Notification Concerning Inventions)

Article 5

1. Upon receipt of the notification under the provisions of the preceding article, the President shall refer matters concerning the Invention to the Invention Review Committee prescribed in Chapter IV, and determine whether the Invention concerned amounts to an Employee Invention, whether the University is to succeed to the relevant Intellectual Property Right, and the ratio of shares in the Intellectual Property Right pertaining to the Invention concerned, on the basis of the report of the Committee.
2. Upon making decisions concerning the Invention in accordance with the provisions of the preceding paragraph, the President shall notify the employee concerned of such decisions.

(Submission of Assignment)

Article 6

In relation to the Employee Invention's Intellectual Property Right which the University decides to succeed to in accordance with the provisions of the preceding article, the Inventor shall submit the separately prescribed assignment to the President.

(Objection)

Article 7

1. In the event that the employee wishes to raise an objection to a decision made in accordance with paragraph 1 of Article 5, he/she may raise an objection addressed to the President within two (2) weeks of the day of receiving notification.
2. When an objection is raised, the President shall decide whether to accept or reject such objection with reference to the opinion of the Invention Review Committee.
3. On making a decision in accordance with the preceding paragraph, the President shall notify the objecting

person and the Invention Review Committee of the decision.

(Applications Concerning Intellectual Property Rights)

Article 8

In relation to Intellectual Property Rights for Employee Inventions which the University decides to succeed to in accordance with the provisions of Article 5, the President shall seek the opinion of the Invention Review Committee, and manage Application procedures and rights after they have been established and registered.

(Voluntary Transfer)

Article 9

1. In the event that the University decides that an Invention notified by an employee is not an Employee Invention, and if the employee requests a transfer of the Intellectual Property Right associated with the Invention to the University, the President shall make a decision on such transfer after obtaining the opinion of the Invention Review Committee.
2. If the University is to succeed to an Intellectual Property Right in accordance with the preceding paragraph, the provisions of Articles 6 and 8 shall apply mutatis mutandis.

(Joint Applications)

Article 10

In the event that the University is to share Intellectual Property Rights with a third party, the University and the sharing party shall jointly make Applications.

(Restrictions)

Article 11

Unless after the University decides that the Invention of the Inventor concerned is not an Employee Invention, or decides that such Invention is an Employee Invention but will not succeed to the relevant Intellectual Property Right, the employee shall not make any Application concerning the Invention, or transfer to any third party or pledge as collateral any Intellectual Property Rights concerning the Invention.

Chapter III Compensation

(Payment of Compensation)

Article 12

1. In the event of any of the following items, the University shall pay compensation to the employee who created the Invention associated with the Intellectual Property Right concerned in accordance with the separately established guidelines for payment of compensation for Employee Inventions (hereinafter, the

“Compensation Payment Guidelines”):

- (i) Where the University succeeds to or comes into possession of the Intellectual Property Right; or
- (ii) Where the University obtains the establishment and/or registration of a statutory right in relation to the Intellectual Property Right that the University has succeeded to.

2. When the University gains any proceeds (income) from its Exploitation of an Intellectual Property Right in its possession, granting a license thereof or transfer thereof to a third party, or disposal thereof, the University shall, after deliberation by the Invention Review Committee, pay compensation to the employee who made the Invention associated with the Intellectual Property Right concerned in accordance with the Compensation Payment Guidelines.

(Compensation to Joint Inventors)

Article 13

In the case where two or more employees are entitled to receive the compensation prescribed in the preceding article, the compensation shall be paid in proportion to their respective shares before the University's succession.

(Compensation in the Case of Job Change, Retirement or Death)

Article 14

1. The entitlement to receive the compensation prescribed in Article 12 shall remain effective even after the entitled employee has changed his/her job or has retired.
2. In the event of the death of the employee with the entitlement prescribed in the preceding paragraph, his/her successor will succeed to the entitlement.

Chapter IV Invention Review Committee

(Establishment of an Invention Review Committee)

Article 15

To deliberate upon matters concerning Employee Inventions and concerning research results materials under Chapter IV of the National University Corporation Okayama University Regulations for Handling Research Results Materials (Okayama University Regulation No. 26 of 2004), the University shall establish the Invention Review Committee (hereinafter, the “Review Committee”) within the Organization for Research Promotion & Collaboration.

(Duties of the Review Committee)

Article 16

1. The Review Committee shall deliberate on the matters in the following items pertaining to Employee Inventions, and report to the President on the results of such deliberations:
 - (i) Review whether Inventions notified in accordance with the provisions of Article 4 fall under Employee Inventions;
 - (ii) Perform a technical evaluation of Employee Inventions;
 - (iii) Review whether Intellectual Property Rights satisfy the registration requirements;
 - (iv) Review whether to succeed to Intellectual Property Rights;
 - (v) Make a decision on a request for examination concerning the patent applied for;
 - (vi) Respond to the office action concerning the patent applied for;
 - (vii) Evaluate the patent strategies of the University;
 - (viii) Evaluate the payment of compensation; and
 - (ix) Other matters that the President finds necessary.
2. The Review Committee shall deliberate on the matters in the following items pertaining to tangible outcomes, and report to the President on the results of such deliberations:
 - (i) Review the attribution of ownership of research results materials;
 - (ii) Review whether to provide and accept research results materials; and
 - (iii) Other matters that the President finds necessary.
3. The Review Committee may, as required, seek opinions from employees and other stakeholders.
4. In order to specifically deliberate upon evaluation of the patent strategies of the University under item (vii) of paragraph 1, the Review Committee shall set up the Technical Committee for Patent Management Evaluation (hereinafter, the "Evaluation Committee").
5. Matters required for the Evaluation Committee shall be separately established.

(Composition of the Review Committee)

Article 17

1. The Review Committee shall be composed of the persons in the following items:
 - (a) Director of the Intellectual Property Department;
 - (b) Leader of the Intellectual Property Group;
 - (c) Members of the Intellectual Property Group;
 - (d) Intellectual Property Managers; and
 - (e) Other persons whom the committee chairperson finds necessary.
2. The Director of the Intellectual Property Office shall serve as the committee chairperson of the Review Committee.

3. The committee chairperson shall convene Review Committee meetings and serve as the chairperson of the meetings.
4. In the event that the committee chairperson is unable to so act, a committee member appointed by the chairperson in advance shall act for him/her.
5. On the basis of designation by the committee chairperson from among persons in and outside the University depending on review details, the President shall appoint the committee members under item (v) of paragraph 1.
6. Upon obtaining the permission of the committee chairperson, employees may attend Review Committee meetings and offer their opinions.

Chapter V Miscellaneous Provisions

(Maintenance of Confidentiality)

Article 18

Inventors and members of the Review Committee must keep such matters as the contents of relevant Inventions confidential throughout the required period of time, unless such matters are published on the basis of agreement between the University and the relevant employee, or unless such matters enter the public domain for reasons not attributable to the University or the relevant employee.

(Handling after Retirement)

Article 19

Even after the employee retires from work, the handling of his/her Inventions falling under Employee Inventions shall be as provided for in these Regulations.

(Handling of Overseas Applications)

Article 20

These Regulations shall apply mutatis mutandis to Inventions leading to Intellectual Property Rights in countries other than Japan.

(Administrative Work)

Article 21

The administrative work set out in these Regulations shall be carried out by the Industry Cooperation Promotion Division of the Research Cooperation Department.

(Other)

Article 22

Aside from the matters set out in these Regulations, other matters necessary for the implementation of these Regulations shall be stipulated separately.

Supplementary Provisions

(Enforcement Date)

Article 1

These Regulations shall come into force on April 1, 2004.

(Provisional Measures)

Article 2

1. The Okayama University Rules for Inventions (Okayama University Regulation No. 35 of November 25, 1978; hereinafter, the “Former Rules”) shall apply mutatis mutandis to the handling of Inventions that are deemed not to fall within paragraph 1 or 2 of Article 6 of the Former Rules until the rights associated with such Inventions expire.
2. These Regulations shall apply mutatis mutandis to the handling of Inventions that the national government has succeeded to in accordance with the Former Rules.
3. The separately established Compensation Payment Guidelines shall apply to the handling of compensation for Inventions prior to March 31, 2004.
4. These Regulations shall apply to the databases, etc. that have come to belong to the national government in accordance with Article 2 or paragraph 1 of Article 3 of the Okayama University Regulations for Handling Databases, Etc. (Okayama University Regulation No. 9 of December 28, 2000; hereinafter, the “Former Regulations for Handling Databases, Etc.”).
5. The Former Regulations for Handling Databases, Etc. shall apply mutatis mutandis to the databases, etc. that have come to belong to employees in accordance with paragraph 3 of Article 3 of the Former Regulations for Handling Databases, Etc.

Supplementary Provisions

These Regulations shall come into force on April 1, 2006.

Supplementary Provisions

These Regulations shall come into force on April 1, 2007.

Supplementary Provisions

These Regulations shall come into force on April 1, 2008.

Supplementary Provisions

These Regulations shall come into force on April 1, 2011.

Supplementary Provisions

These Regulations shall come into force on April 1, 2012.

Supplementary Provisions

These Regulations shall come into force on September 18, 2015.