

# **Regulation governing the management of National Sun Yat-sen University research and development results and technology transfer**

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## **I. Purpose**

This regulation is established to properly manage the research and development results of NSYSU personnel and to assist in the licensing and promotion of technology transfer between the NSYSU and regional organizations and to create high added value of intellectual property rights.

## **II. Rights and Interests**

1. Where the NSYSU personnel use school resources to achieve results from research and development, including patents, technologies, products, intellectual property rights, and the rights derived from them, the ownership of these rights, unless otherwise stipulated by laws and contracts, belongs to the NSYSU.
2. Matters related to the management of research and development results and the application, maintenance, rights and interests allocation (including technology transfer) of patents and other intellectual property rights) shall be handled in accordance with this regulation. Matters not covered here shall be handled in accordance with other relevant laws and regulations.

## **III. Organizational unit responsible for these matters**

The organizational unit responsible for the management and promotion of NSYSU research and development results is the Technology Transfer Center.

## **IV. Technical Review Committee**

To handle these matters, the Technology Transfer Center has established a Technical Review Committee and appointed seven scholars and experts as its members. The chief of Global Industry-Academe Collaboration and Advancement and the chief of the

Technology Transfer Center are ex officio members, and the chief of Global Industry-Academe Collaboration and Advancement is the convener. Two NSYSU faculty members are recommended by the chief of the Technology Transfer Center and approved by the president for a two-year term. They may be reappointed. For the remaining three members, the chief of the Technology Transfer Center appoints experts from inside and outside the NSYSU depending on the nature of each case.

#### **V. The responsibilities of the Technical Review Committee**

1. Evaluation of the appropriate patterns of the protection of research and development results, the burden of expenses, the declassification of confidential information on research and development results, the review of the patentability of technology and patent applications.
2. The review of the necessity of patent maintenance.
3. The review of the pricing of NSYSU research and development results, the pricing of technology transfers, the pricing of technology in exchange for equity stakes, and other terms of licensing agreements.
4. The consultation of the operation and development of the Technology Transfer Center and the evaluation of the effectiveness of mechanisms for the announcement and promotion of research and development results.
5. Handle matters about the avoidance of conflicts of interest and information disclosure.
6. Other relevant matters.

#### **VI. Forms of the protection of and the application procedures for the intellectual property rights of research and development results**

1. Research and development results should be properly protected in the form of patents (invention patents, new patents, design patents), business secrets, know-how, trademarks, new plant varieties, publication works, integrated circuit circuit layouts, etc. When there are questions about the form of protection, the Technical Review Committee shall evaluate and approve the situation. If the relevant intellectual property rights need to be approved or registered with the competent authority, they shall be handled in accordance with relevant regulations.
2. For patent applications, the inventor or creator should attach complete information and fill out the relevant forms for the application. The patent applications shall be submitted to the Technical Review Committee for consideration except for patent applications that are 100% self-funded by the inventor or creator, or applications for R.O.C. patents for research and development results attributed to Ministry of Science and Technology projects. The Technical Review Committee shall hold a meeting every quarter as a general rule, and additional meetings may be convened depending on individual cases.

The Technical Review Committee should complete its review of a case within 30 working days of the date of receipt to optimize the timeliness of the application.

3. After the application is reviewed and approved by the Technical Review Committee, the Technology Transfer Center should proceed with the formal external application procedures as soon as possible, and the inventor or creator should get all the required documents ready. After obtaining the patent, the inventor should be notified.
4. The patent is applied for in the name of the NSYSU as the owner, and the inventor or creator should jointly sign the application. If there are two or more inventors or creators, they should all jointly sign unless they have agreed to appoint a representative.
5. If the patent application is not approved by the Technical Review Committee, the inventor or creator can still assign the NSYSU as the patentee and, after advising the Technology Transfer Center of such action, apply for the patent at his own expense.

## VII. Allocation of intellectual property rights application fees

The ratio of application fees for intellectual property rights, except for patents, to be allocated to the inventor or creator is determined by the Technical Review Committee. Application fees, certificate fees, and annual patent fees, handling fees for external services, and other patent fees payable in accordance with laws and regulations (hereinafter referred to as patent application fees) should be allocated to the patent applicants (including patents approved by the Technical Review Committee on a case-by-case basis) shall be apportioned according to the following guidelines:

1. Before obtaining the patent certificate and after deducting the amount subsidized by the funding agency, the inventor or creator may at the time of application choose one of the following allocation options:

Patent expenses allocation table:

Options for patent expenses allocation ratio	Inventor or creator allocation ratio	NSYSU and funding agency allocation ratio
A	10%	90%
B	30%	70%
C	50%	50%
D	100%	0%

After obtaining a patent certificate, patent fees (including certificate fee and the annual maintenance fee for the first three years) are all borne by the NSYSU. The patent fee subsidy applied for and received from the funding agency is transferred to the patent

fund account to be used by the NSYSU for the maintenance and promotion of patents.

2. If a patent is jointly owned by the NSYSU and other schools or research institutions, the portion of application fees applicable to the NSYSU before the patent certificate is issued and after the subsidy from the funding agency is deducted, to be allocated to the inventor or creator may be based on, besides the above options, the following additional option.

Options for patent expenses allocation ratio	The ratio of application fees applicable to the NSYSU to be allocated to the inventor or creator	The ratio of application fees applicable to the NSYSU to be allocated to the NSYSU and funding agency
E	0%	100%

3. If the research funding is provided by a foundation or private enterprise, the funding provider may apply for patents on its own and the NSYSU does not bear any expenses. The ownership of the intellectual property rights is still handled in accordance with the stipulations of item 2.

When a case is rejected, the method for apportioning the defense cost is the same as that listed in item 1 in the first paragraph of this point. If rejected more than 3 times, the following methods shall be applied:

- 3.1 For patents of the Republic of China: Beginning from the fourth time, the defense fee shall be borne by the inventor. If the inventor does not wish to bear this fee, the patent application is deemed given up.
- 3.2 For foreign patents: Inventor will bear the defense costs beginning from the 4th time. If the inventor does not wish to bear this fee, the patent application is deemed given up. If the patent is finally approved, the inventor may apply to the NSYSU for a subsidy for defense fees. Use receipts to request the subsidy which is capped at NT\$50,000.

### **VIII. The maintenance and transferring of patents**

1. If the patent is owned by the NSYSU, the school maintains the patent for three years. (If the patent authority stipulates that the first maintenance payment covers more than three years, the NSYSU maintains the patent for the stipulated length of time, but no longer than 5 years). Before the expiration of the NSYSU's patent maintenance period, the inventor should evaluate whether the patent still offers them the benefit of licensing or

technical service and decide whether to maintain the patent at their own expense. If the inventor does not intend to maintain the patent by themselves, the inventor must sign an agreement with the NSYSU to authorize NSYSU to handle the patent at its sole discretion.

2. If the NSYSU has full authority to handle the patent, the school should announce for a period longer than three months that the patent is eligible for transferring to new owners. When a third party requests a transfer, the request must be evaluated and approved by the Technical Review Committee. If the patent is for research and development results resulting from government-sponsored projects, the request and relevant information should be evaluated and approved by the government agency and the patent transferring process should be handled in accordance with the relevant rules.
3. If no third party requests a transfer, and even after the promotion efforts put forth by the agency that promotes NSYSU patents, no case has been established to transfer this patent, the Technical Review Committee may assess the situation and agree to terminate the maintenance of the patent. If the patent is based on the creation or invention of job-related efforts of NSYSU personnel rather than the result of a government-sponsored project, patent maintenance can be terminated directly. If the patent is for research and development results resulting from government-sponsored projects, the request and relevant information should be evaluated and approved by the government agency and the patent maintenance termination process should be handled in accordance with the relevant rules.

#### **IX. Patent infringements handling**

1. The Technology Transfer Center has enlisted the service of attorneys to centrally deal with infringements against NSYSU patents, and all NSYSU units and the inventors shall provide their full assistance to the attorneys as needed.
2. The inventor or creator of the patented object shall provide specific facts for the infringements. After the Technology Transfer Center has obtained the necessary technical appraisals, the files are sent to the attorneys for further actions. However, before notifying the attorneys, all NSYSU units concerned shall contact the infringer to ask the latter to obtain legal license or coordinate how to stop the infringements.

#### **X. Managing information and files that are related to research and development results**

1. During the patent application period and before the receipt of the patent certificate, all materials about the NSYSU research and development results should be managed confidentially.
2. The Technology Transfer Center should regularly organize the patents that have been obtained for ready reference.

3. Research and development results-related documents and patent application documents are filed and kept by the Technology Transfer Center, and stored permanently in an appropriate form after the expiration of the patent validity period.

#### **XI. Obligations of the inventor or creator**

1. The inventor or creator shall be responsible for responding to issues concerning the content of the invention in legal proceedings such as patent application, review, opposition, petition, administrative litigation, and judicial litigation.
2. The inventor or creator shall cooperate with the Technology Transfer Center to implement the promotion and application of their invention.
3. When an inventor or creator has obtained a patent by illegal means, such as plagiarism, that infringe on the rights of others, the inventor or creator shall bear all responsibilities.

#### **XII. Guidelines on technology transfer of research and development results**

All research and development results completed with NSYSU resources, regardless of whether a patent is obtained, should be protected through school administrative procedures and contracts signed by the school and commercialized through timely technology transfers.

The guidelines for handling technical transfers are as follows.

1. Done in a fair, open and compensated manner.
2. For public schools, public research institutions, public enterprises, legal persons or organizations.
3. The geographical areas in which licensed manufacturing or use are to occur should be governed by the regulation of the research and development results' subsidy or commission funding agency as well as by the "Government Scientific and Technological Research and Development Results Ownership and Utilization Regulation", "Investment in Mainland China or Technology Collaboration Licensing Regulation", "Investment in Hong Kong and Macao or Technology Collaboration Review and Processing Regulation", and other relevant regulations.
4. Generally licensing is non-exclusive, but exclusive licensing may be applied on a case-by-case basis for any of the following situations.
  - 4.1 To avoid unfair competition in the industry that may hinder the development of the industry.
  - 4.2 The transfer of research results must undergo long periods of government scrutiny before becoming marketable products.
  - 4.3 The product from technology transfer requires huge sums of investments to continue to develop commercialized technology.
5. The exclusive licensing arrangement in the previous item still allows NSYSU faculty and students to use the research and development results for free in academic research and

development, notwithstanding the exclusive licensing.

6. For those whose technology transfer licensing is through the pricing of technology in exchange for equity stakes, the licensing fee may be determined by reference to the technology pricing (excluding business tax), and the licensee of the technology licensing should pay the business tax and 2.5% of the amount of Technology Shares to the NSYSU. These requirements, however, do not apply if the research and development results' subsidy or commission funding agency have special rules on them.

### **XIII. Distribution of benefits from technology licensing or transfer**

1. The licensing fees and royalty from research and development results are allocated in accordance with the "Enforcement rules of National Sun Yat-sen University Research and Development Results and Technology Transfer".
2. When full-time faculty members engage in part-time profit-making activities, if they convert their job-related information or professional results into business activities (including self-employment), they should notify the Technology Transfer Center. The licensing fees and royalty from research and development results to be allocated to them may be handled in accordance with the first item of these enforcement rules.

### **XIV. Avoidance of conflicts of interest and disclosure of information**

The handling of conflicts of interest avoidance and information disclosure in the use of National Sun Yat-sen University research and development results should be handled in accordance with the "Regulation governing the handling of conflicts of interest avoidance and information disclosure in the use of National Sun Yat-sen University research and development results".

### **XV. Resource Sharing in School**

If it is necessary to use NSYSU patents for teaching purposes, the NSYSU unit may apply to the Technology Transfer Center, obtain the consent of the inventor or creator, and use the patents free of charge.

**XVI.** The Technology Transfer Center may be commissioned by public or private colleges and universities or other organizations to carry out research and development results promotion. The fee schedule is established separately.

**XVII.** If for special needs the rights and interests of the NSYSU research and development results cannot be executed in accordance with this regulation, a separate case must be established and submitted to the president for approval in order to make adjustments.

### **XVIII. Taking effect and implementation**

This regulation was adopted at Administrative Meeting and submitted to the president for approval and implementation. Revisions shall follow the same procedure.