

Kyushu University Detailed Regulations for Implementation of the Regulations for Handling Intellectual Property

Kyushu University Detailed Regulation No. 1 of 2015

Established: September 24, 2015

Last amended: September 30, 2019

(Kyushu University Detailed Regulation No. 12 of 2019)

(Purpose)

Article 1 These Detailed Regulations shall provide for necessary matters relevant to compensation for inventors and handling of intellectual property pursuant to the provisions of Articles 11 and 36 of the Kyushu University Regulations for Handling Intellectual Property (Kyushu University Regulation No. 93 of 2004; hereinafter referred to as the "Regulations").

(Definitions)

Article 2 In these Detailed Regulations, the meanings of the terms set forth in the following items are as provided respectively in those items:

- (i) the term "inventor" means an employee, etc. (meaning the employee, etc. provided in Article 2, paragraph 1, item (ii) of the Regulations) who has vested a right to the grant of a patent in Kyushu University (hereinafter referred to as the "University") pursuant to Article 6 of the Regulations;
- (ii) the term "license fee, etc." means income gained by the University from a private organization or other related organization (hereinafter referred to as the "private organization, etc.") in the case where the University exploits its patent right, etc. (meaning the patent right, etc. provided in Article 10 of the Regulations), such as granting a license or transferring a patent right, etc. to the private organization, etc. (if the University also concludes an agreement such as a license agreement or transfer agreement (hereinafter referred to as the "license agreement, etc.") jointly with organizations such as other universities or national research institutes, and the University receives the whole amount of income receivable by all of them, the amount to be allocated to the organizations will be deducted);
- (iii) the term "technology transfer fee" means a fee to be paid to a technology transfer organization in the case where the University has entrusted the organization with the technology transfer work pursuant to the provisions of Article 31, paragraph (3) of the Regulations and has gained a license fee, etc. as a result of the work; and
- (iv) The term "compensation for licensing" means monetary compensation to be paid to an inventor (including an inventor who is no longer an employee of the University due to voluntary termination of employment or for any other reason) when the University receives a license fee, etc.

(Allocation of License Fee, etc.)

Article 3 (1) If the University receives a license fee, etc., it shall allocate the license fee, etc. through the following procedure:

- (i) deducting 25% of the license fee, etc. as an amount equivalent to the technology transfer fee; and
 - (ii) allocating 50% of the amount that remains after the deduction under the preceding item to the inventor and the remaining 50% to the Academic Research and Industrial Collaboration Management Office of Kyushu University (hereinafter the "AiRiMaQ"), respectively.
- (2) The amount equivalent to the technology transfer fee referred to in item (i) of the preceding paragraph shall be allocated to the technology transfer organization if the technology transfer work has been entrusted to the organization, or allocated to the AiRiMaQ, etc. if the technology transfer work has not been entrusted to any technology transfer organization; provided, however, that if the Special IP Management Target provided in Article 32 of the Regulations carries out the technology transfer work, 50% of the amount equivalent to the technology transfer fee that is allocatable to the AiRiMaQ may be allocated to the Special IP Management Target.
- (3) If the University acquires a license fee, etc. in the form of shares, etc. (including share options and bonds with share options), it implements the allocation pursuant to paragraph (1) when the shares, etc. are converted into cash.
- (4) Whenever a license fee, etc. is paid, the University pays compensation for licensing to an inventor promptly.
- (5) The amount of license fee, etc. for each patent right, etc. (patent rights, etc. arising from the same base application (including patent rights, etc. in foreign countries) are treated as one patent right, etc.; the same applies hereinafter) in the case where the University conducts a comprehensive technology transfer (meaning a technology transfer to a private organization, etc. involving two or more patent rights, etc. under an agreement for license or transfer, etc.; the same applies hereinafter) is, in principle, the amount calculated by distributing the total amount of license fee, etc. evenly to each patent right, etc.; provided, however, that the distribution ratio may be determined after hearing opinions from the persons concerned with regard to factors such as the degree of contribution by the University to each patent right, etc.
- (6) If the composition of the patent rights, etc. involved in the comprehensive technology transfer changes after the conclusion of the technology transfer agreement, the University implements the distribution pursuant to the provisions of the preceding paragraph on the basis of the composition of the patent rights, etc. at the time of the payment of the license fee, etc. to the University; provided, however, that this does not apply to cases where otherwise provided.

(Giving Back of License Fee, etc. to Divisions)

Article 4 (1) If the total amount of license fee, etc. for a specific patent right, etc. (if two or more patent rights, etc. arise from the same base application or are involved in a license agreement, etc.: all patent rights, etc. concerned) for one business year is 20 million yen or more, 50% of the license fee, etc. that is allocatable to the AiRiMaQ referred to in paragraph (1), item (ii) of the preceding Article is given back to the division with which an inventor is affiliated (meaning the division specified by an inventor when making a notification of invention; hereinafter referred to as the "inventor's affiliated division").

(2) If expenses for an application, etc. (meaning the application, etc. provided in Article 9, paragraph (1) of the Regulations) for a specific patent right, etc. are paid from a budget managed by a Special IP Management Target pursuant to the provisions of Article 16, the license fee, etc. that is allocatable to the AiRiMaQ referred to in paragraph (1), item (ii) of the preceding Article out of the license fee, etc. for the specific patent right, etc. is given back to the Special IP Management Target.

(3) If, notwithstanding the provisions of Article 9 of the Regulations, expenses for an application, etc. for a specific patent right, etc. are paid from a budget managed by an inventor's affiliated division (excluding the case where the expenses are paid from a budget managed by a Special IP Management Target pursuant to the provisions of Article 16), 50% of the license fee, etc. that is allocatable to the AiRiMaQ referred to in paragraph (1), item (ii) of the preceding Article out of the license fee, etc. for the specific patent right, etc. is given back to the inventor's affiliated division.

(4) In the case referred to in the preceding paragraph, if an agreement necessary for a technology transfer is to be concluded with regard to the specific patent right, etc., and the inventor chooses not to give back the license fee, etc. to the inventor's affiliated division, any expenses for an application, etc. incurred thereafter may be paid pursuant to the provisions of Article 9 of the Regulations. In this case, the expenses for an application, etc. that have already been paid from a budget managed by the inventor's affiliated division are not returned to the inventor's affiliated invention.

(5) In the cases referred to in paragraphs (1) to (3), if two or more inventors are involved in a specific patent right, etc., the amount calculated in accordance with the provisions of the following Article shall be given back to each inventor's affiliated division. If any of the inventors is a student of the University, the relevant amount is given back to the division in which the student is enrolled.

(Calculation of Compensation for licensing)

Article 5 (1) If two or more inventors are involved in the same invention, the University calculates the amount of compensation for licensing in proportion to their shares at the University.

(2) Notwithstanding the provisions of the preceding paragraph, if all inventors give consent in advance on the allocation of compensation for licensing, the University may calculate and allocate the amount of compensation for licensing to each inventor based on their consent.

(3) If a fraction of less than 1,000 yen exists in the amount allocated to each inventor as calculated pursuant to Article 3, paragraph (1), item (ii) or the preceding two paragraphs, it is rounded down to the nearest 1,000 yen.

(Notice of Allocation to Inventor)

Article 6 (1) If the University receives a license fee, etc., it gives notice to an inventor with regard to the allocation of compensation for licensing.

(2) If an inventor changes, due to voluntary termination of employment or for any other reason, the address to which the notice of allocation provided in the preceding paragraph is to be sent, the inventor must submit a form provided separately to the University.

(Use of Compensation for Licensing)

Article 7 An inventor may, at their own will, use all or part of the compensation for licensing to cover expenses for the education and research the inventor carries out at the University, by following the prescribed procedure.

(Procedure for Payment of Compensation for Licensing)

Article 8 (1) The University pays compensation for licensing to an inventor by bank transfer to the bank account designated by the inventor. In principle, the bank account used for the payment of salary to the inventor is used as the bank account for the payment of compensation for licensing.

(2) If an inventor changes the bank account referred to in the preceding paragraph, the inventor must submit a form provided separately to the University.

(3) If the University is unable to pay compensation for licensing by bank transfer due to any cause not attributable to it, it withholds payment of the compensation for licensing.

(4) If, with regard to the compensation for licensing for which the University withholds payment pursuant to the provisions of the preceding paragraph, the inventor makes a claim for payment of the compensation for licensing before the completion of the period of extinctive prescription for the claim, the University shall pay the compensation as claimed.

(Vesting of Right)

Article 9 If an inventor transfers to or vests in a third party a right to receive payment of compensation for licensing, the inventor must submit a document certifying the transfer, etc. to the University.

(Application to Inventions Other Than Employee Inventions)

Article 10 The University may apply these Detailed Regulations if it acquires a patent right, etc. from an employee by a method other than the method provided in Article 6 of the Regulations or acquires a patent right, etc. from a person other than an employee, and the Director of the Academic Research and Industrial Collaboration Management Office of Kyushu University (hereinafter referred to as the "Director of the AiRiMaQ") finds it necessary.

(Application Mutatis Mutandis to Other Payments)

Article 11 (1) The provisions of Article 3 to the preceding Article apply mutatis mutandis to the payment of compensation, etc. for a utility model right, design right or layout-design exploitation right provided in Article 13 of the Regulations which belongs to the University (including rights to receive the registration of these rights).

(2) The provisions of Article 3 to the preceding Article apply mutatis mutandis to the payment of compensation, etc. for a copyright provided in Articles 15 to 21 of the Regulations which belongs to the University.

(3) The provisions of Article 3 to the preceding Article apply mutatis mutandis to the payment of compensation, etc. for know-how provided in Articles 23 to 29 of the Regulations which belongs to the University.

(Application for and Recognition of Special IP Management Target)

Article 12 (1) A person who seeks the application of a Special IP Management Target provided in Article 32 of the Regulations must submit to the President a written application and any other necessary documents prescribed separately by the President.

(2) The recognition of a Special IP Management Target is granted by the President for each research project or organization for which the application of a Special IP Management Target is sought pursuant to the preceding paragraph, following the deliberation at the Academic Research and Industrial Collaboration Management Strategic Committee provided in Article 7-2 of the Kyushu University Regulations of the Future Planning Committee.

(3) The President must give notice to the applicant with regard to whether or not recognition is granted, the period of recognition, and other matters.

(System of Special IP Management Target)

Article 13 (1) If recognition of a Special IP Management Target is granted pursuant to the preceding Article, the following persons must be determined and a notification of the determination must be made to the President pursuant to the operational standards regarding the Special IP Management Target provided in paragraph (4):

- (i) Special IP Management Target representative: one person; and
 - (ii) Special IP Management Target manager: one person.
- (2) The Special IP Management Target representative administers the operations within the Special IP Management Target.
- (3) The Special IP Management Target manager is a person who has knowledge and experience relevant to intellectual property-related work and supervises the intellectual property-related work within the Special IP Management Target.
- (4) The Special IP Management Target representative must develop operational standards regarding the Special IP Management Target and obtain the recognition of the President.
- (5) The Special IP Management Target representative who has obtained the recognition referred to in the preceding paragraph shall submit to the President a written consent stating that the Special IP Management Target will comply with the operational standards and the representative shall assume the responsibility for compliance with the referenced operational standards.

(Approval of Employee Invention of Special IP Management Target)

Article 14 (1) Notwithstanding the provisions of Article 5 of the Regulations, the approval of an employee invention in the case where an employee of a Special IP Management Target has made an invention within the Special IP Management Target shall be deliberated within the Special IP Management Target and the result of the deliberation shall be reported by the Special IP Management Target representative to the Director of the AiRiMaQ.

(2) If the Director of the AiRiMaQ receives a report referred to in the preceding paragraph, the Director shall promptly decide on the approval of the invention and give notice of the decision to the Special IP Management Target representative.

(Succession to Right of Special IP Management Target)

Article 15 (1) Notwithstanding the provisions of Articles 7, 18 and 26 of the Regulations, the succession to a right to the grant of a patent for an employee invention, copyright for works such as a database and a know-how exploitation right which arise in a Special IP Management Target shall be deliberated within the Special IP Management Target, and the result of the deliberation shall be reported by the Special IP Management Target representative to the Director of the AiRiMaQ.

(2) If the Director of the AiRiMaQ receives a report referred to in the preceding paragraph, the Director shall promptly decide on the succession, etc. to the right and give notice of the decision to the Special IP Management Target representative.

(Payment of Expenses for Application, etc. Incurred in Special IP Management Target)

Article 16 Notwithstanding the provisions of Article 9 of the Regulations, expenses for an

application, etc. incurred in a Special IP Management Target shall be paid from a budget managed by the Special IP Management Target.

(Termination of Special IP Management Target)

Article 17 (1) When the period for which recognition of a Special IP Management Target has been granted (hereinafter referred to as the "period of Special IP Management Target") expires, the Special IP Management Target shall be terminated.

(2) Even before the expiration of the period of Special IP Management Target, the Special IP Management Target representative must make a notification to the Director of the AiRiMaQ with regard to the termination of the Special IP Management Target if the Special IP Management Target is no longer needed. In this case, the Special IP Management Target shall be terminated as of the date on which the Director of the AiRiMaQ receives the notification.

(3) If a Special IP Management Target has violated the operational standards established by the Special IP Management Target and failed to correct the violation within the period designated by the AiRiMaQ, the AiRiMaQ may revoke the recognition of the Special IP Management Target. In this case, the Special IP Management Target shall be terminated as of the date on which the AiRiMaQ gives notice of the termination.

(4) Intellectual property managed by a Special IP Management Target after the termination of the Special IP Management Target shall be handled pursuant to the Regulations.

(Making Public of Special IP Management Target)

Article 18 The AiRiMaQ shall make an recognized Special IP Management Target public by posting it on a website.

(Others)

Article 19 The provisions from Article 12 to the preceding Article do not apply to any tangible materials or clinical trial data.

Article 20 If there are any circumstances under which the AiRiMaQ is unable to manage and use intellectual property (excluding tangible materials, breeder's rights and clinical trial data) pursuant to the provisions up to the preceding Article, the Director of the AiRiMaQ shall deliberate with the President and take appropriate measures.

Article 21 Beyond what is provided in these Detailed Regulations, necessary matters are prescribed by the Director of the AiRiMaQ.

Supplementary Provisions

These Detailed Regulations come into effect as of October 1, 2015.

Supplementary Provisions (Kyushu University Detailed Regulation No. 12 of 2016)

These Detailed Regulations come into effect as of April 1, 2017.

Supplementary Provisions (Kyushu University Detailed Regulation No. 3 of 2018)

These Detailed Regulations come into effect as of May 25, 2018, and apply from April 1, 2018.

Supplementary Provisions (Kyushu University Detailed Regulation No. 19 of 2018)

These Detailed Regulations come into effect as of November 26, 2018, and apply from November 1, 2018.

Supplementary Provisions (Kyushu University Detailed Regulation No. 24 of 2018)

These Detailed Regulations come into effect as of December 28, 2018, and apply from December 1, 2018.

Supplementary Provisions (Kyushu University Detailed Regulation No. 31 of 2018)

These Detailed Regulations come into effect as of February 1, 2019.

Supplementary Provisions (Kyushu University Detailed Regulation No. 4 of 2019)

These Detailed Regulations come into effect as of May 31, 2019, and apply from April 1, 2019.

Supplementary Provisions (Kyushu University Detailed Regulation No. 12 of 2019)

These Detailed Regulations come into effect as of October 1, 2019.