

The Hong Kong Polytechnic University

Regulation on the Management of Intellectual Property (RMIP)

1. Introduction

- 1.1 PolyU endeavors to become a vibrant place where students, academia, business people and the wider community interact to ensure that our knowledge and expertise are made available to society. PolyU strives to promote and facilitate the creation and timely transfer of PolyU community's knowledge and technology to society for the purpose of social, economic or technological advancement.
- 1.2 Based upon the aforementioned policy, this Regulation provides operational and implementation guidance for the management of Intellectual Property made by Staff members or students of the University. It follows the principles set out in the University's Policy on Ownership of Intellectual Property.
- 1.3 This Regulation is effective as of 1 September 2021, and supersedes all regulations on the same subject matter previously issued.

2. Definition

For the purposes of this Regulation, the definitions used in The Policy shall apply. 'The Policy' means the University's Policy on Ownership of Intellectual Property (PIP) currently in force.

3. Implementation

The President will appoint a Designated Senior Executive (DSE) to be responsible for the implementation and enforcement of this Regulation.

4. Disclosure of Invention

Staff Member or student must disclose to the University any and all the invention, discovery, creation and any Intellectual Property made by him/her while in the employment of the University or registered with the University as a student, whether or not such invention, discovery or creation may be patentable or have potential for commercialization as soon as such invention, discovery or creation comes into existence.

Disclosure must be made by submitting the 'Invention Disclosure Form' to Knowledge Transfer and Entrepreneurship Office (KTEO) which is the administrative unit in charge of management of Intellectual Property under the purview of DSE.

5. Protection of Patentability and Confidentiality of Invention and Other Intellectual Property

- 5.1 To protect the patentability and novelty of an invention or other types of Intellectual Property, the Inventor should not publish or make public disclosure of the subject matter prior to filing an application for patent or other form of protection. The Inventor should seek advice from KTEO on the suitability of disclosure.
- 5.2 The Inventor must not publish or disclose to any unauthorized party any Intellectual Property he/she has developed in any project funded by the University for the purpose of commercialization.
- 5.3 To protect the patentability and potential for commercialization, the Inventor must vigorously defend the confidentiality of the subject matter. If there is any possibility of collaboration, licensing or joint ventures with outside parties, these outside parties should be requested to sign a Non-Disclosure Agreement agreeing to keep all information confidential and to clarify the responsibilities and liabilities of the University and the parties before disclosing any information to them.
- 5.4 The Staff Members and students shall use their best endeavour to keep and maintain full records of all Materials (including but not limited to drawings, sketches, conceptual drawings and specification drawings, etc) and other works used for designs (e.g. hand samples or prototypes), identifying the name of the author, the date of creation or amendment of such works. In the event that the Materials are created on the computer, the Staff Members and students should keep a copy of all versions of the work to evidence the creation process.

6. Patent and Registration

- 6.1 After making the disclosure according to paragraph 4 above, the Inventor shall inform the University whether he/she wishes to apply for patent or other type of protection. He/she shall execute such assignments, waivers, confidentiality undertaking, patent evaluation and other documents as the University may require for the purpose of conducting clearance searches, preparing, filing, prosecuting and maintaining any application for patent or other registration and/or patents relating to the invention and/or commercial exploitation.
- 6.2 DSE will determine whether the University should at its expenses apply for patent or other type of protection for the Intellectual Property concerned.
- 6.3 In making his/her decision, DSE shall seek the advice of an Assessment Committee comprising of both academic and external members who will consider the patentability, viability of technology transfer and market value of the invention concerned and then advise the DSE. The composition and terms of reference of the Assessment Committee will be defined at institutional level and made known to Staff members and students.

- 6.4 KTEO will provide assessment support and information to the Assessment Committee and DSE during the decision-making process. To enhance the effectiveness of the assessment process, the University will build a network of expertise appropriate for the technologies concerned to participate in the process. DSE and the Assessment Committee shall consider how to proceed with the patent application and, the extent of coverage. The assessment process will be transparent and takes into account the overall interest of the University, Inventor and the society at large.
- 6.5 Due to the high costs of filing and maintaining a patent, KTEO may seek potential licensees or investors for financial support before filing the patent application.
- 6.6 The following are the criteria which are used to assess an invention's suitability for applying for a patent:
- whether the invention is genuinely new, useful and not obvious;
 - whether it has reasonable prevailing commercial value or substantial intellectual value;
 - whether the invention is viable to be transferred;
 - whether the invention has been publicly divulged, if so, when and how;
 - whether a patent infringement is detectable;
 - whether a patent could be enforced;
 - whether the available patent claims would justify investment in commercialization and cost of patenting;
 - whether international patents are necessary to derive value from the invention.
- 6.7 In the event the University decides not to apply for patent or other type of protection at its expenses for an Intellectual Property, the Inventor may at his/her discretion and at his/her own expenses, apply for patent or other type of protection. However, the patent or other type of protection applied for shall clearly indicate the University as its owner or assignee whichever is legally appropriate.
- 6.8 KTEO shall be the office authorized to apply or cause to apply patents or similar protections for any Intellectual Property owned by the University. It will instruct a law firm or patent agent to draft and file the patent application with the approval of DSE.
- 6.9 KTEO shall maintain an updated record of patents applied for and granted as well as relevant records of the Assessment Committee documenting their approval for patent application or otherwise.
- 6.10 All costs incurred for the purpose of maintaining or defending a patent, inclusive of defending alleged infringement of other patents, shall be borne by the party who chooses to pay for the filing of the patent concerned, unless the University elects not to further maintain a patent it files. For the latter case, provisions in paragraph 7 shall apply.

7. Maintenance of patents

In the event the University decides not to maintain a patent over time, the Inventor may elect to maintain the patent at his/her own discretion and expenses. Otherwise, the University, as the owner of the patent, can decide not to maintain the patent concerned and let it lapse or expire. In so doing, the University will ensure that such arrangement is transparent and balanced for the interests of all parties concerned.

8. Commercialization

- 8.1 Unless otherwise authorized by the President upon the recommendation of the DSE, commercialization or exploration for opportunities to commercialize the Intellectual Property owned by the University by means of licensing or consultancy (including industrial consultancy stipulated as contracted research) shall be conducted by the PolyU Technology and Consultancy Company Limited (“PTeC”) whether the Intellectual Property is patented or not. For their service in exploring or effecting commercialization, PTeC shall be entitled to charge a reasonable management or handling fee as approved by the DSE. No contracts or agreements for commercialization shall be signed and entered into without the written authorization of the DSE in his/her capacity as the Chairman of the Board of Directors of PTeC.
- 8.2 In contemplation of commercialization of specific Intellectual Property, KTEO will consider, together with field experts as required, the merit of the engagement using a set of criteria including but not limited to factors concerning commercial viability, cost, impact, technological fit, and commercialization capacity of the technology recipients. The process of selecting and reaching relevant commercialization agreements will be transparent and publicly accountable, under the guidance of the Technology Transfer Management Committee (“TTMC”) comprised of both senior University staff and external members. Guidelines for licensing and assignment will be published for observation and compliance by University staff.
- 8.3 Under prevailing policies and regulations governing outside practices and all other things being equal, the Inventor and his/her research personnel will be given priority to actively pursue commercialization of the Intellectual Property concerned. DSE, in consultation with TTMC, will also consider providing certain Intellectual Property to society gratis for the benefit of the society at large, provided that there is no objection from the Inventor.
- 8.4 Notwithstanding the above, for commercial exploitation of Intellectual Property by the Staff Members by way of authorship engagement (e.g. newspaper columns, publication of hobby books not related to academic discipline), the Regulations Governing Outside

Activities and Consultancy Work, including sharing of commercial proceeds, shall apply.

9. Distribution of Net Revenue

Net Revenue received by the University upon commercialization of any Intellectual Property owned by the University shall be distributed in the manner described below:

- 9.1 If the University pays for the cost of obtaining and maintaining a patent or any form of registration for the Intellectual Property concerned:
 - A. 35% to the Inventor(s) concerned.
 - B. 10% to the department of the Inventor(s) concerned.
 - C. 55% to the University.
- 9.2 If the Inventor(s) pays for the cost of obtaining and maintaining a patent or any other form of registration for the Intellectual Property concerned:
 - A. 70% to the Inventor(s) concerned.
 - B. 10% to the department of the Inventor(s) concerned.
 - C. 20% to the University.
- 9.3 Subject to paragraph 8.4 above, if no direct cost of protection of Intellectual Property is involved, distribution under paragraph 9.1 shall apply.
- 9.4 If the Intellectual Property concerned is made by more than one inventor, the Inventors concerned shall share equally their share of the Net Revenue unless a written agreement by all Inventors on the method of sharing has been agreed upon in advance is filed with KTEO. In the case when applying for a patent or obtaining other form of registration of the Intellectual Property is sought, such agreement must reach KTEO in advance of the filing of the application.
- 9.5 If the Intellectual Property concerned is made by more than one inventor belonging to more than one department, the departments concerned shall share equally their share of the Net Revenue unless a written agreement on the method of sharing has been agreed upon in advance of filing the application by the departments concerned and filed with KTEO.
- 9.6 Inventor(s) will continue to enjoy their entitlement to commercialization proceeds regardless of their employment status with the University.
- 9.7 For cases other than those under paragraphs 9.1, 9.2 and 9.3, TTMC shall evaluate such cases to recommend which distribution mode will prevail. The guiding principle is that the party responsible for the ultimate cost of maintenance of the Intellectual Property is entitled to the larger share of the commercialization proceed.

10. Implementation and Management

- 10.1 The implementation of this Regulation shall be the responsibility of the respective

executives and offices named in the Regulation unless otherwise authorized by the DSE.

10.2 Notwithstanding the University's support to facilitate knowledge transfer undertakings through activities such as consultancy and licensing, there are occasions that the commercial or reputational risks of such undertakings outweigh any possible benefits to PolyU. In principle, PolyU does not support any knowledge transfer undertakings which commercial risks are unmanageable or such undertakings may probably affect PolyU's finance or reputation adversely. In the event that the commercialization conditions of any Intellectual Property would expose PTeC or PolyU to commercial risks and liabilities that cannot be reasonably managed, the University and/or PTeC shall refrain from such engagement.

11. Operating Procedures

Supplementary operating procedures governing the implementation of this Regulation may be established by the administrative units concerned upon the authorization of the DSE.

12. Revision and Substitution

This Regulation may be revised or substituted upon approval of the President.