

Hiroshima University Regulations for Employee Inventions

Regulation No. 112 of April 1, 2004

Hiroshima University Regulations for Employee Inventions

(Purpose)

Article 1 These Regulations prescribe the matters necessary for handling of intellectual property rights in connection with inventions, etc. of employees of Hiroshima University (hereinafter referred to as the University), for the purpose of promotion of academic research and social utilization of the outcomes of such research, in accordance with the provisions of Article 18 of the Hiroshima University Policies and Regulations (Regulation No. 1 of April 1, 2004).

(Definitions)

Article 2 In these Regulations, the meanings of the terms listed in the following items shall be as defined in those respective items.

- (i) Invention, etc. means any the following:
 - (a) An invention for which any patent right may be granted;
 - (b) A device for which any utility model right may be granted;
 - (c) Creation of any matter for which any design right, trademark right or layout-design exploitation right may be granted, or creation of any matter for which any copyright to a computer program, etc. may be granted;
 - (d) Breeding of any matter for which a variety registration may be obtained; or
 - (e) Contrivance which may be classified as know-how.
- (ii) Employee, etc. means a person falling under one of the following items:
 - (a) An officer or employee of the University;
 - (b) A person other than officers or employees of the University, whose employment is based on a contract binding the person to these Regulations;
 - (c) A non-university member who uses the facilities of the University and has executed a contract to comply with these Regulations; or
 - (d) A student or postdoctoral fellow of the University, who engages in research under the instructions of an employee.
- (iii) Inventor, etc. means an employee, etc. who has produced an invention, etc.
- (iii)-2 Department, etc. means any of the Graduate Schools, the Attached Research Institutes, the University Hospital, the Libraries, the National Joint Usage Facilities, the Joint Usage Facilities for National Universities in the Chugoku/Shikoku Area, the Joint Education and Research Facilities on Campus, the Joint Usage Facility on Campus, the Attached Schools, the President's Office, the University Administration Planning Office, the Office of Global Initiatives, the Audit Office, the Executive Office, the Higashi-Hiroshima Campus Management Support Office, or the Kasumi Campus Management Support Office.
- (iv) Employee invention means an invention, etc. produced by an employee, etc. on the

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basis of research, etc. conducted at the expense of, or with any other support from, the University, or research, etc. that utilizes the facilities and equipment managed by the University.

- (v) Patent right, etc. means any the following:
 - (a) The right to the grant of a patent, or a patent right, in Japan, or a right equivalent to these rights in a foreign country;
 - (b) The right to the grant of a utility model registration, or a utility model right, in Japan, or a right equivalent to these rights in a foreign country;
 - (c) The right to the grant of a design registration, or a design right, in Japan, or a right equivalent to these rights in a foreign country; or
 - (d) A right generated through application for trademark registration, or a trademark right, in Japan, or a right equivalent to these rights in a foreign country.
- (vi) Layout-design exploitation right means the right to a registration of establishment of a layout-design exploitation right for semiconductor integrated circuits, a layout-design exploitation right for semiconductor integrated circuits, or a right equivalent to these rights in a foreign country.
- (vii) Copyright to a computer program, etc. means one or more of the copyrights prescribed in Article 21 to Article 28 of the Copyright Act (Act No. 48 of 1970) in connection with the computer program works under Article 2 (1) (x)-2 of the same Act or the database works under item (x)-3 of the same paragraph, or a right equivalent to these rights in a foreign country.
- (viii) Breeder s right means the right to a variety registration of a new plant variety, a breeder s right to a new plant variety, or a right equivalent to these rights in a foreign country.
- (ix) Know-how means technical information with a proprietary value that can be concealed, irrespective of whether any of the rights prescribed in item (v) to item (viii) may potentially be acquired with such information.
- (x) Right to use know-how means a right to use specific know-how.
- (xi) Intellectual property right means any patent right, etc., layout-design exploitation right, copyright to a computer program, etc., breeder s right, or right to use know-how.

(Attribution of Rights)

Article 3 Intellectual property rights associated with employee inventions shall belong to the University.

(Notification of Inventions, etc.)

Article 4 In cases where an employee, etc. produces any invention, etc. (excluding any layout-design exploitation right, the creation of such matters as computer programs, and the contrivance of any know-how) in the course of duties, he/she shall promptly notify, with the prescribed form, the President to that effect through the head of the department, etc. to which the inventor, etc. has been assigned or belongs (hereinafter referred to as the head of the affiliated

department, etc.).

Article 5 In the case where a semiconductor integrated circuit layout (hereinafter referred to as a circuit layout) created by an employee, etc. in the course of duties falls under any of the following items, the employee, etc. shall notify, with the prescribed form, the President to that effect through the head of the affiliated department, etc. of the employee, etc.:

- (i) The circuit layout is versatile and valuable as a circuit layout;
- (ii) The circuit layout contains certain know-how for producing other inventions, etc.;
- (iii) The circuit layout pertains to certain technology subject to a technological transfer;
- (iv) A circuit layout whose economic value has become evident; or
- (v) Any other circuit layout regarding which the President regards the above notification as necessary.

Article 6 In the case where a computer program, etc. created by an employee, etc. in the course of duties falls under any of the following items, the employee, etc. shall notify, with the prescribed form, the President to that effect through the head of the affiliated department, etc. of the employee, etc.:

- (i) The computer program, etc. is intended to be used by any party other than employees, etc. (hereinafter referred to as a third party);
- (ii) A computer program, etc. whose proprietary value has become evident;
- (iii) A computer program, etc. whose copyright is suspected of being violated; or
- (iv) Any other computer program, etc. regarding which the President regards the above notification as necessary.

Article 7 In the case where know-how contrived by an employee, etc. in the course of duties falls under any of the following items, the employee, etc. shall notify, with the prescribed form, the President to that effect through the head of the affiliated department, etc. of the employee, etc.:

- (i) Know-how whose right to use is required to be granted to a third party together with a certain patent right, etc. that the University owns;
- (ii) Know-how that is required to be disclosed to the other parties of joint research in the implementation thereof;
- (iii) Know-how whose proprietary value has become evident; or
- (iv) Any other know-how regarded as particularly important by the President.

(Approval and Succession of Invention, etc.)

Article 8 (1) Upon receipt of the notification specified in any of Article 4 to the preceding Article, the President shall determine whether the relevant invention, etc. is an employee invention and whether to succeed to its intellectual property right(s), on the basis of discussion by the Board of Invention Review of the Hiroshima University Center for Collaborative Research & Community Cooperation (hereinafter referred to as the Board of Invention Review).

(2) Upon making a decision under the preceding paragraph, the President shall promptly notify the relevant inventor, etc. of the decision through the head of the affiliated department, etc. of

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the inventor, etc.

(Succession to Invention, etc.)

Article 9 (1) With regard to employee inventions, the intellectual property rights of which the President has decided to succeed to pursuant to the provisions of paragraph (1) of the preceding Article, the University shall promptly succeed to such intellectual property rights.

(2) With regard to employee inventions, the intellectual property rights of which the President has decided not to succeed to, their inventors, etc. are at their own discretion to dispose of such intellectual property rights.

(3) The inventors, etc. of computer programs, etc. to which the University has succeeded pursuant to the provisions of paragraph (1) shall not exercise the moral rights of authors prescribed in Article 18 to Article 20 of the Copyright Act, or any right equivalent thereto in any foreign country.

(Filing of Objection)

Article 10 (1) An inventor, etc. who has an objection concerning a decision under Article 8 (1) may file such objection with the President through the head of the affiliated department, etc. of the inventor, etc. within two weeks of the day of receipt of the notification of the decision concerned.

(2) Upon receiving an objection as under the preceding paragraph, the President shall make a decision on whether to accept or reject such objection on the basis of discussion by the Board of Invention Review where necessary, and notify the inventor, etc. concerned of the decision through the head of the affiliated department, etc. of the inventor, etc. within 30 days of the decision.

(Transfer to the University)

Article 11 (1) In cases where an employee, etc. notifies the University of his/her intention to transfer the intellectual property rights of an invention, etc. that does not amount to an employee invention to the University, the President shall determine whether to succeed to such intellectual property rights on the basis of discussion by the Board of Invention Review.

(2) The University shall promptly succeed to inventions, etc. to which the President has decided the University's succession pursuant to the preceding paragraph.

(Application and Management)

Article 12 (1) With regard to employee inventions, the intellectual property rights of which the University has succeeded to pursuant to Article 9 (1), and inventions, etc. to which the University has succeeded pursuant to paragraph (2) of the preceding Article, the President shall promptly take application procedures and other relevant procedures and appropriately manage them.

(2) The application procedures and other relevant procedures in the preceding paragraph shall be implemented on the basis of discussion by the Board of Invention Review.

(3) In the case where an employee invention, the intellectual property right(s) of which the

University has succeeded to pursuant to Article 9 (1), or an invention, etc. to which the University has succeeded pursuant to paragraph (2) of the preceding Article, is shared with a third party, the University shall execute a contract for joint application with the third party.

- (4) Inventors, etc. shall cooperate with the University in dealing with application procedures, any trial for invalidation brought by a third party, or other relevant matters, upon the request of the University.
- (5) In principle, the University shall bear costs required for its implementation of application procedures and costs required for its maintenance and management of rights.
- (6) In the case where an inventor, etc. wishes to obtain a patent right, etc. or a breeder's right in a foreign country, he/she shall state to that effect when issuing a notification of his/her invention, and whether to permit an overseas application and the specific details of such application shall be deliberated by the Board of Invention Review.

Article 13 When creating programs, etc., employees, etc. shall properly manage such programs, etc.

Article 14 The University shall properly manage programs, etc. to which it has decided to succeed pursuant to the provisions of Article 9 (1).

Article 15 (1) The University shall properly manage the know-how to which it has succeeded (hereinafter referred to as important know-how).

(2) Inventors, etc. of important know-how shall strictly manage such important know-how, and shall not disclose or divulge it to any other party, except in one of the cases specified in the following items:

- (i) Where important know-how is disclosed to a party on whom the duty of confidentiality concerning that know-how is imposed under a contract with the University;
- (ii) Where important know-how is disclosed to a third party incidental to a transfer of technology to that third party;
- (iii) Other than the two preceding items, where the permission of the President for disclosure of important know-how is obtained; or
- (iv) Where the President judges that the value of important know-how has remarkably declined.

(3) An employee, etc. who comes to know important know-how shall strictly keep that know-how secret and manage it, except in the case prescribed in item (iv) of the preceding paragraph.

(4) The provisions of the preceding two paragraphs shall remain applicable to inventors, etc. of important know-how and employees, etc. who have come to know important know-how even after their retirement.

Article 16 Employees, etc. shall properly manage the know-how that they themselves contrived.

(Obligation of Utilization of Intellectual Property Rights)

Article 17 (1) The University shall make its best endeavors to ensure that its intellectual property

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rights are utilized in society.

- (2) Inventors, etc. shall cooperate in activities that the University conducts pursuant to the preceding paragraph.
- (3) Upon the request of the University, employees, etc. shall offer maximum cooperation to it in utilizing its intellectual property rights.

(Granting and Transfer of License, etc. to Third Party)

Article 18 (1) The granting of a license, etc. for any intellectual property rights that the University owns to a third party shall be determined by the Executive (Industry-Academia-Government and Community Collaboration) upon hearing opinions from the Director of the Center for Collaborative Research & Community Cooperation.

- (2) Any transfer of intellectual property rights that the University owns to a third party shall be determined by the President on the basis of discussion by the Board of Invention Review.
- (3) In addition to the provisions of the preceding two paragraphs, other matters necessary for the granting of any license, etc. for the intellectual property rights that the University owns, and any transfer of such intellectual property rights shall be established separately.

(Exception Concerning Exploitation by Inventor, etc.)

Article 19 In cases where an inventor, etc. starts up a business after retirement or as a subsidiary business to utilize his/her own invention, etc. and disseminate its outcome, the President may take special measures in relation to the intellectual property rights associated with the invention, etc.

(Reward for Inventor, etc.)

Article 20 (1) The University shall pay a reward to an inventor, etc. when he/she falls under any of the following items:

- (i) In relation to an invention, etc. or a patent right, etc. to which the University has succeeded, the University has gained income, such as a license fee, as a result of granting a license, etc. to, or transferring such patent right, etc. or the right to the grant of a patent, etc. to, a third party;
 - (ii) In relation to a circuit layout to which the University has succeeded, the University has gained income, such as a license fee, as a result of granting or transferring such layout-design exploitation right to a third party; or
 - (iii) In relation to important know-how to which the University has succeeded, the University has gained income, such as a license fee, as a result of granting the right to use such know-how to, or transferring such know-how to, a third party.
- (2) The amount of a reward to be paid pursuant to the provisions of the preceding paragraph shall be calculated on the basis of the amount obtained by deducting direct costs incurred for the application, etc. for the relevant invention, etc. from the relevant income, such as a license fee.
 - (3) In the case where there are a number of inventors, etc. to receive a reward pursuant to the preceding paragraph, the reward shall be distributed to them in proportion to their respective

shares.

(4) Matters necessary for the payment of rewards to inventors, etc. and the reward distribution procedure, etc. of the University pursuant to the preceding two paragraphs shall be established separately.

(5) The provisions of Article 10 (1) and (2) shall apply mutatis mutandis to the filing of any objection by inventors, etc. concerning the payment of rewards pursuant to paragraph (2) or paragraph (3). In such case, a decision under Article 8 (1) in Article 10 (1) shall be replaced with a reward.

(6) In the case of cross-licensing of a patent right, etc. with a third party, a separate reward may be paid on the basis of evaluation of the value of the patent right, etc.

(Succession to Right to Receive Reward)

Article 21 The right of inventors, etc. to receive rewards as prescribed in paragraph (1) of the preceding Article may not be succeeded to by any third party other than their rightful heirs.

(Handling of Retirees, etc.)

Article 22 (1) The provisions of Article 20 (1) to (3) shall also apply to persons who have lost the status of employee, etc. due to retirement, graduation, the expiration of the contract term, or any other relevant reason (hereinafter referred to as a .

(2) The University may pay the reward prescribed in Article 20 (2) and (3) to a successor of the right to receive a reward under the preceding Article or a retiree, etc., upon his/her request.

(Maintenance of Confidentiality and Appropriate Management of Personal Information)

Article 23 (1) With regard to intellectual property rights, employees, etc. shall maintain the confidentiality of matters concerning the contents of such rights and concerning the interests of the University and inventors, etc. during the required period of time.

(2) Employees, etc. shall not divulge any personal information that they have come to know in the course of duties without reasonable grounds.

(3) The provisions of the preceding two paragraphs shall apply to retirees, etc.

(Restitution of Intellectual Property Rights)

Article 24 (1) With regard to any intellectual property rights, such as patent rights, etc., that the President has decided not to continue to retain, the President shall promptly notify the relevant inventor, etc. to that effect.

(2) Upon the request of the inventor, etc. associated with the intellectual property rights under the preceding paragraph, the President shall return such intellectual property rights to the inventor, etc.

(Administrative Work)

Article 25 The Hiroshima University Center for Collaborative Research & Community Cooperation shall be responsible for administrative work concerning inventions, etc.

(Miscellaneous Provisions)

Article 26 In addition to the provisions prescribed herein, other matters necessary for the

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implementation of these Regulations shall be established separately.

Supplementary Provisions

1. These Regulations shall come into force on April 1, 2004.
2. Upon the request of employees, etc. who individually own intellectual property rights, the University may succeed to such intellectual property rights prior to the date of enforcement of these Regulations (hereinafter referred to as the enforcement date).
3. In the case referred to in the preceding paragraph, the University shall pay costs that such employees, etc. incur in relation to the intellectual property rights that the University is to succeed to.
4. These Regulations shall apply to the intellectual property rights that belong to the University prior to the enforcement date, and those to which the University has succeeded pursuant to paragraph (2).

Supplementary Provisions (Regulation No. 76 of April 1, 2005)

These Regulations shall come into force on April 1, 2005.

Supplementary Provisions (Regulation No. 44 of March 31, 2006)

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

Supplementary Provisions (Regulation No. 28 of March 31, 2008)

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

Supplementary Provisions (Regulation No. 70 of March 31, 2010)

These Regulations shall come into force on April 1, 2010.

Supplementary Provisions (Regulation No. 34 of March 31, 2011)

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

Supplementary Provisions (Regulation No. 1 of February 3, 2014)

These Regulations shall come into force from February 3, 2014.

Supplementary Provisions (Regulation No. 60 of July 14, 2014)

These Regulations shall come into force on July 14, 2014, and the provisions of the Hiroshima University Regulations for Employee Inventions after revision by these Regulations shall apply from June 1, 2014.

Supplementary Provisions (Regulation No. 76 of April 1, 2015)

These Regulations shall come into force on April 1, 2015.

Supplementary Provisions (Regulation No. 91 of April 1, 2016)

These Regulations shall come into force on April 1, 2016.

Supplementary Provisions (Regulation No. 60 of March 31, 2017)

These Regulations shall come into force on April 1, 2017.