

Academia Sinica

Regulations for Ownership and Utilization of Scientific and Technological Research and Development Achievements

Promulgated by Office of Public Affairs No. 10205016721 on March 7, 2013

Article 1

These Regulations are stipulated in accordance with Paragraph 3, Article 6 and Paragraph 3, Article 13 of the Fundamental Science and Technology Act for the purpose of efficiently managing the proceeds earned by the Academia Sinica ("Academy") from the intellectual property rights in and achievements of the scientific and technological research and development funded by the scientific and technological project budget of the Academy in accordance with the law.

Article 2

The research and development achievements ("R&D achievements") under these Regulations shall mean domestic or foreign patents, publications of the Academy, other intellectual property rights, and all the derivative rights obtained on the basis of the knowledge, techniques, works, products made in the Academy, layouts of integrated circuits, computer software, trade secrets, know-how, and other technical data derived from performance of the official duties by the researchers of the Academy.

Management and utilization of the R&D achievements shall mean negotiations, consultations, reviews, applications, revenue, utilization, technology transfers, licenses to use, appointments, trusts, lawsuits, maintenance, and the like connected with the rights in the R&D achievements.

The guidelines for managing and utilizing the Academy's publications shall be separately stipulated, while the management and utilization of layouts of integrated circuits, computer software, and works derived from computer software such as user's manuals and instructions are governed by these Regulations.

Intellectual property rights donated to the Academy or managed by the Academy in trust shall be governed by these Regulations.

Article 3

The Academy shall have a research and development result management committee ("Management Committee") comprising members retained by the president of the Academy from members of the Academy or outsiders to assist the president in supervising the management and utilization of the Academy's R&D achievements.

The following matters are subject to review by the Management Committee:

1. Exclusive technology transfers from the Academy to transferees outside the territory of Taiwan.
2. Technology transfers from the Academy free of charge.
3. Waiver or assignment of any patents by the Academy.
4. Decision on the Academy's acceptance of assignment of intellectual property rights.
5. Personal interests to be disclosed, methods of disclosing personal interests, and recusal

due to conflicts of interests, with respect to technology transfer projects and private business-school cooperation projects of the Academy.

In the event of any violations of these Regulations, the Management Committee may conduct necessary investigations, and upon their conclusion, recommend the proper action for the division(s) concerned to take.

Article 4

The Management Committee shall operate in accordance with the following provisions:

1. The Management Committee shall comprise 7 to 15 members (including the convener). Each committee member serves a two-year term. The post is non-paying, but members who are not staff members of the Academy can be paid appropriate review fees. The committee members are eligible for reappointment when their term expires. If there is a vacancy on the Management Committee before the committee member's term expires, the successor shall serve until such term expires.
2. The Management Committee shall have a convener to be nominated by the president from among the vice presidents of the Academy. The convener shall be responsible for convening meetings of the Management Committee and act as the chairperson. If the convener cannot convene or attend a committee meeting with good cause, he/she may designate a committee member to act on his/her behalf.
3. No committee member may appoint a proxy. A committee member shall recuse himself/herself from any cases in which he/she has a personal interest.
4. Resolutions shall be adopted by a majority vote of the members of the Management Committee at a meeting attended by a majority of the members, or by the written consent of a majority of the members in response to the notification from the convener.
5. Before a decision on a routine technology transfer is made, the convener may designate one or two committee members to give assistance and comments.
6. The administrative affairs of the Management Committee shall be handled by the Office of Public Affairs of the Academy.

Article 5

Unless otherwise provided in laws, regulations, or contracts, R&D achievements derived from the research projects funded, commissioned, or financed from the budget of the Academy shall be owned by the Academy.

Unless otherwise provided in laws, regulations, or contracts, R&D achievements made by researchers of the Academy from research projects other than those set forth above and without using the Academy's resources (such as premises, equipment and experience) shall be owned by the inventors, utility model creators, designers, or authors making the achievements (collectively referred to as "Creators"), as the case might be.

If a researcher wants to use the Academy's resources to carry out a research project set forth in the preceding paragraph, the researcher shall obtain the consent of the division(s) possessing such resources and sign a contract with the Academy to stipulate the ownership of the R&D achievements derived from the project and the distribution of proceeds from the rights and interests in such achievements. R&D achievements owned by the Academy shall be governed by these Regulations.

In the event of any dispute over the matters set forth in this Article, the Creator or the chief of the division he/she belongs to may request the Management Committee to decide them.

Article 6

A Creator shall directly or through the division he/she belongs to request the Office of Public affairs of the Academy to handle various matters regarding his/her R&D achievements.

After assessing the value of the R&D achievements if they are put into practice, the possibility of assigning the achievements to others or commercializing them, sharing of expenses, and other factors, the Academy may take any of the following actions for the R&D achievements which should be protected by intellectual property rights:

1. Where the Academy decides to apply for intellectual property rights in an R&D achievement, pay all the costs needed.
2. Where the Academy decides not to apply for intellectual property rights in an R&D achievement, assign the application right to the Creator, who should file the application at his/her own expense. As soon as the Creator is granted the intellectual property rights, he/she shall immediately notify the Academy and assign the rights to the Academy, while the Academy may make either of the following decisions on the assignment:
 - (1) Where the Academy decides to take the assignment of the intellectual property rights, it shall reimburse the Creator for the necessary costs and expenses for the intellectual property right application. If the Academy receives any proceeds from the intellectual property rights after they are assigned to the Academy, the Academy shall give 60 percent of such income to the Creator and 10 percent to the laboratory to which the Creator belongs, reserve 10 percent to the Academy, and pay the remaining 20 percent to the national treasury.
 - (2) Where the Academy decides not to take the assignment of the intellectual property rights, it shall agree to let the Creator retain such rights with or without consideration.
3. Where neither the Academy nor the Creator wants to file the intellectual property right application, the Academy may agree to let the Creator enter into a contract with a third party to have the third party, acting as an agent, file the intellectual property right application. The application agent shall file the intellectual property right application in the name of the Academy. After the intellectual property rights are duly registered, the agent may claim reimbursement for the application expenses from the Academy, or request the Academy to give it licensing priority or allow it to obtain those rights with or without consideration.

Where annual fees or maintenance expenses are payable for certain intellectual property rights owned by the Academy, if such intellectual property rights are not assigned or licensed to others after the Academy has paid such annual fees or maintenance expenses for five years, the Academy may take the following actions after consulting with the Creators or the divisions to which the Creators belong:

- (1) Continue or stop paying the annual fees or maintenance expenses.
- (2) Assign such intellectual property rights to the Creators or third parties with or without consideration.

Article 7

Less any necessary derivative expenses, 40 percent of the proceeds from rights and interests in R&D achievements owned by the Academy may be allocated to the Creator, and up to 20 percent may be allocated respectively to the Academy, the laboratory to which the Creator belongs, and the national treasury/funding agency.

The proceeds from rights and interests under the preceding paragraph include license fees, royalties, prices, equities, proceeds from transfer of materials, and other rights and interests. The Office of Public Affairs shall report derivative expenses (excluding patent application fees and maintenance expenses, which are mostly remittance expenses) to the president for approval of their payment.

If a Creator does not work at the Academy anymore when proceeds from certain rights and interests are about to be allocated to the laboratory the Creator belonged to, such proceeds shall be allocated to the division to which the laboratory is subordinate.

A Creator's proceeds derived from his/her rights and interests may be allocated to the research teams affiliated with him/her. The list of such research teams shall be prepared by the Creator.

Rights or interests other than the proceeds from rights and interests set forth in Paragraph 1 shall be vested in the Academy.

Where R&D achievements are made under the circumstances set forth in Paragraph 2, Article 5, and proceeds from rights and interests in such achievements are vested in the Academy according to the laws or the relevant contracts, the allocation method set forth in Paragraph 1 of this Article shall apply *mutatis mutandis*.

Article 8

The Academy may transfer technologies or grant user licenses regarding the R&D achievements managed by it to other government agencies (entities), manufacturers, other organizations, or individuals, provided that such technology transfers and user licenses are made or granted with consideration and are nonexclusive, and transferees/licensees situated within the jurisdiction of Taiwan have right of first refusal to such technology transfer and user license. Free or exclusive technology transfer or user license may be granted to transferees/licensees situated outside the jurisdiction of Taiwan only for the purposes of promoting scientific and technological development, welfare of the people, or national interests; ensuring the commercialization of the R&D achievements and the intellectual property rights therein; protecting national safety; or complying with international covenants, none of which shall violate the principle of fairness. In addition, a written contract shall be signed to govern the usage of the transferred/licensed R&D achievements, the licensing territory, the licensing term, and restrictions on sublicensing, further transfer, or other matters.

The consideration for technology transfer or license under the preceding paragraph may be paid in the form of license fees, royalties, prices, equities, cross licensing, technology cooperation, or any other means commonly adopted in the industry.

Article 9

Divisions subordinate to the Academy and their staff members may accept commissions from other natural persons, legal persons, organizations, or government agencies (entities) to do research or joint research, as long as such work does not hamper the Academy's academic research or development or rights or interests obtainable by the Academy.

Contracts shall be signed to stipulate the ownership of the R&D achievements derived from the commissioned or joint research under the preceding paragraph and the ratio of allocation of proceeds from rights and interests in such R&D achievements.

Paragraph 1, Article 7 shall apply *mutatis mutandis* to the license fees, royalties, prices, equities and other income derived from rights and interests allocable to the Academy in accordance with contracts.

Prior approval of the Academy is required for entering into commissioned research or joint research contracts for the research projects under Paragraph 2 or 3, Article 5. As soon as any R&D achievements are derived from such research projects, the Academy shall be immediately informed thereof and proceed to manage the relevant state-owned rights and allocate the proceeds from the related rights and interests.

A researcher of the Academy shall obtain the consent of the chief of his/her division and the approval of the Academy before participating in a research project of another division of the Academy or accepting commissions from outsiders to do research if such research is of the type stipulated in Article 5; in addition, paragraphs 1 to 4 of this Article shall apply *mutatis mutandis*.

If a researcher of the Academy intends to provide his/her R&D achievements for use by a party outside the Academy and be eligible to receive interests from such party's utilization of the R&D achievements by acquiring shares in that party or any other means, he/she shall not violate the Civil Servant Service Act and shall obtain the prior consent of the chief of the division to which he/she belong and the prior approval of the Academy; in addition, paragraphs 1 to 4 of this Article shall apply *mutatis mutandis*.

Article 10

Divisions under the Academy may accept research funds, instruments or equipment sponsored by other natural persons, legal persons, organizations, or other government agencies ("sponsors"). Such research funds, instruments or equipment shall belong to the sponsored divisions.

To the extent that their research needs are not compromised, sponsored divisions may permit their sponsors to use research offices, laboratories, books, instruments, equipment, and other auxiliary tools, and pay for the maintenance expenses and other fees incurred from the sponsors' use.

Article 9 shall apply *mutatis mutandis* to sponsored research projects.

Article 11

These Regulations shall come into force from the date of promulgation.