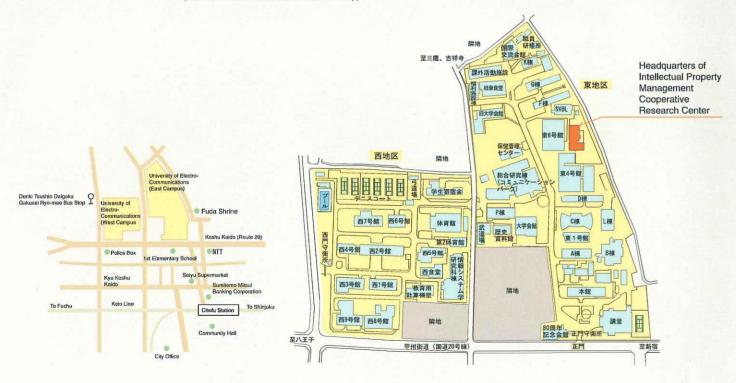
#### ntellectual Property Office Staff Director Visiting Professors Tetsuya Miki Sadakazu Igeta (Patent attorney) Assistant Director Tadahiko Ito Kenji Hori (Visiting professor) Minoru Kudo (Patent attorney) Intellectual Property Managers Shingo Tsuii (Patent attorney) Shigeyuki Yoneyama (Visiting professor) Shigeo Naruse (Patent attorney) Takako Hashimoto (Patent attorney) Hidekazu Miyoshi (Patent attorney) Syoko Ito Toyomaro Yoshida (Patent attorney) Reiji Aihara (Patent attorney) Kyota Endo (Patent attorney) Hidehisa Sawai (Attorny of Law) Syunichi Kubo Clerical Directors Miyuki Kinoshita Aiko Kobayashi

Keio Line: From Shinjuku Station to Chofu Station (North Exit) (14 min. by Special Express, 19 min. by Express), 7 min. walk to University Keio Inokashira Line: (From Shibuya or Kichijoji Stations) go to Meidaimae Station, then change trains for the Keio Line toward Chofu, then to Chofu Station (North Exit), 7 min. walk to University

From JR Kichijoji Station (South Exit): Take the "Shinkawa via Shiyakusho bound for Chofu" bus, getting off at "Denki Tsushin Daigaku Gakusei Ryo-mae" stop

(takes 25 minutes from station to bus stop)
From JR Mitaka Station (South Exit): Take the "Chofu" bus, getting off at "Denki Tsushin Daigaku Gakusei Ryo-mae" stop
(takes 20 minutes from station to bus stop)





National University Corporation The University of Electro-Communications Intellectual Property Office:

1-5-1 Chofugaoka, Chofu-shi Tokyo 182-8585 Tel: 0424-43-5838 Fax. 042-43-5839 http://www.uec.ac.jp



## **TOWARD AN INTELLECTUAL PROPERTY OFFICE FOR** A UNIQUE UNIVERSITY OF ELECTRO-COMMUNICATINS









**An Introduction to Intellectual Property Office How Intellectual Property is to be managed** 

National University Corporation The University of Electro-Communications

# **University of Electro-Communications Intellectual Property Office Overview**

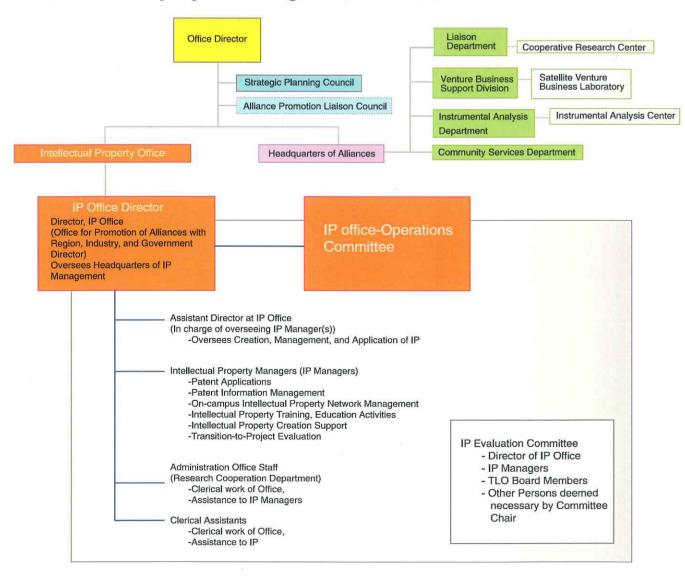
### **■** About the Intellectual Property Office

Intellectual Property Office for our university was adopted as a "University Intellectual Property Maintenance Project" in August 2003 by the Ministry of Education, Culture, Sports, Science, and Technology, established for the purpose of maintaining a strategic implementation system which generates, manages, and applies the intellectual property of Universities, etc.

Intellectual Property Office currently positioned as a sub-organization of the "Office for Promotion of Alliances with Region, Industry, and Government". The purpose of Intellectual Property Office is to quickly and effectively manage, cultivate, and apply the intellectual property resulting from research. The Office not only manages, cultivates, and applies the intellectual property of our school, but also manages such specialized functions as utilization of personnel with specialized knowledge, dealing with matters related to intellectual property policy and the fruits of research, as well as the finalization of joint research agreements. It also deals in technology transfers of industrial intellectual property rights, with the aim of cooperation with such entities as Trade Licensing Organizations (TLO).

In July 2005, the Ministry of Education, Culture, Sports, Science, and Technology undertook a mid-term evaluation of the aforementioned "University Intellectual Property Maintenance Project" after two years had passed since its inception, for the purpose of its efficient and effective implementation, and publicized the results. Our university's Intellectual Property Office received the highest rank of "A" in the mid-term evaluation, out of the 34 institutions that were evaluated, and the Office continues its activities to the present.

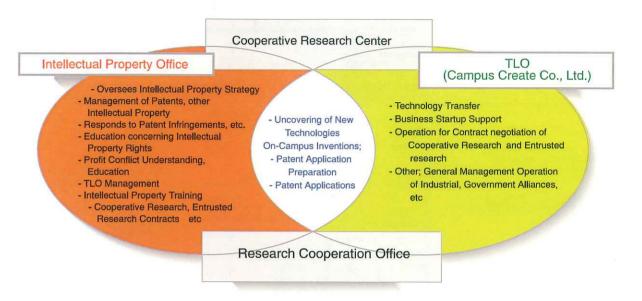
### Office for Promotion of Alliances with Region, Industry, and Government; Intellectual Property Office - Organizational Chart



# **Division of Roles and Operations Affiliation**

### **■** Division of Roles between Intellectual Property Office and TLO

Intellectual Property Office and Campus Create Co., Ltd. cooperate to uncover on-campus inventions and perform patent applications, etc., while also receiving backup support from the Cooperative Research Center and the Research Cooperation Office.

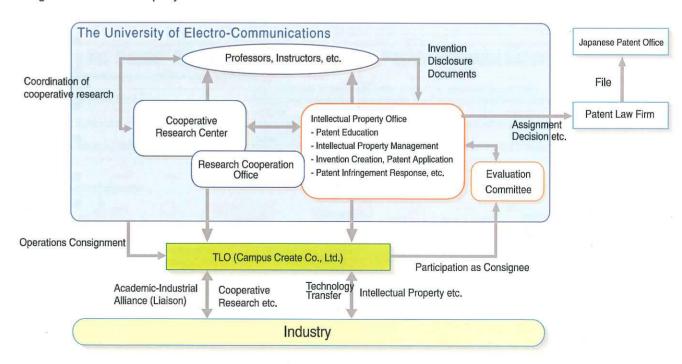


## About Operational Alliances Managed by Intellectual Property Management

When an invention is made, Intellectual Property Office works closely with the inventor, IP-Evaluation Committee, and TLO (Campus Create Co., Ltd.). Especially when involving the transfer of technology of a right that is patent that is pending or the rights to use a patent which has been obtained, Intellectual Propaty Office acts in a unified manner wihe Campus Create Co., Ltd.

After evaluation of the invention submitted from the inventor(s) by the IP-Evaluation Committee, the University of Electro-Communications succeeds the right to obtain a patent right from the inventor(s).

Following that, the patent law firm prepares a Patent Application From including a Patent Specification in cooperative with IP manager at Intellectual Property Office.

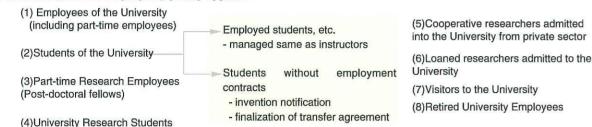


# **Intellectual Property Policy**

Intellectual Property Strategy - In conjunction with becoming a National University Corporation on April 1, 2004, the University of Electro-Communications has been directed to manage its intellectual property.

## **■ Intellectual Property Policy (Outline)**

#### I. Persons to whom intellectual property policy applies



#### II. Management of and Rights Possession, Transfer Pertaining to Research Results

- 1. Inventions and Utility Model
- (1) Policy regarding Possession of Invention

From the perspective of academic research development and the proper use of intellectual rights, the University will, going forward, be re-evaluating its range of rights transfer of patents, etc. related to employee inventions. In addition to this, the University will, as a principle, make those rights the property of the University by contract between the inventor and University, managing it centrally in the Headquarters of Intellectual Property Management, and applying it through TLO, etc.

The above policy will be applied to University employees, as well as students who are in employment status at the University. With regard to students of the University who are not under employment contract, if, upon receiving the notification of invention established under University rules, the University should determine to assume the patent rights thereof to itself, it will finalize a transfer agreement between the student or other party and the University.

Further, items regarding this transfer agreement shall be established separately.

#### (2) Invention Notification

Those to whom the Intellectual Property Policy applies shall, when an invention occurs which could be thought of as an employee invention, notify Intellectual Property Office of such prior to writing research papers or making announcements at academic conferences, etc. (Though Article 30 of the Japanese Patent Law excludes such as cause for lack of novelty, it is necessary to keep in mind that this system only guarantees that such papers, etc., will not be cited when rejecting the invention as public knowledge, as well as the fact that a patent will not be obtainable when another person has applied prior to the original inventor, and in states and organizations such as European Patent Offices, an individual's publishing of an academic paper can cause an invention to be deemed lacking poyelty.)

#### (3) Evaluation and Assessment of Inventions, etc., by the IP- Evaluation Committee

The Evaluation Committee of the University is established to evaluate and assess intellectual property such as inventions which are related to the University's possessions. The IP- Evaluation Committee is positioned in association with Intellectual Property Office, and consists of intellectual property specialists, patent attorneys, and TLO board members commissioned by Intellectual Property Office.

#### Overview of the Invention Evaluation and Transfer Process



#### (4) Invention Evaluation and Transfer Process

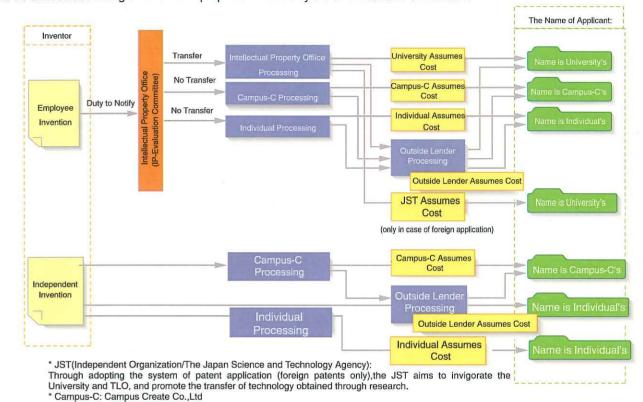
In the event that after evaluation, the IP- Evaluation Committee assesses that the University should assume the rights to itself, Intellectual Property Office will file

a patent application, and the TLO to which the work has been entrusted will directly start preparing the technology transfer destination. The right to obtain a patent right will remain with the applicable inventor in cases where it has been assessed that the University cannot assume the rights.

Articles or items pertaining to inventions, etc. researched through outside funding shall be provided separately.

# **Processes, Cost-Bearing, Rights Possession of Intellectual Property**

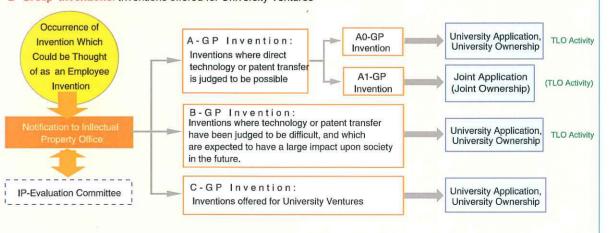
This chart shows the cost-bearing, etc., and rights possession and patent applications process management of inventions made at the University. The route of patent application, etc. for an invention reported to Intellectual Property Office-will be chosen according to evaluation preparation made by the IP-Evaluation Committee.



## **■ Policy Concerning University-owned Patent Applications and Applicable Licensing Activities**

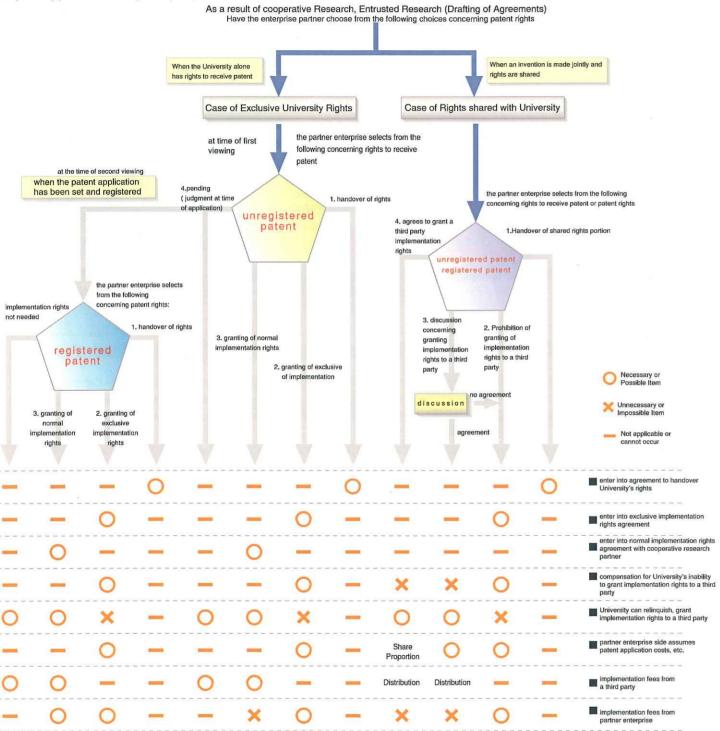
Upon patent application, the IP-Evaluation Committee will classify inventions belonging to the University as the rights into the following three categories:

- A- Group Inventions: Inventions where technology transfer or patent right ( or application to obatain a patent) have been judged to be possible, and they are divided into the following subsets:
  - A0 Group Inventions: Among A-Group Inventions, those where the patent application thereof will be applied solely by the University, and can be transferred by the independent judgment of the TLO.
  - A1—Group Inventions: Among A-Group Inventions, those where the patent application thereof will be applied jointly by the University and enterprise, etc., and the agreement of the joint applicant is necessary for transfer of the right, etc.
- **B- Group Inventions:** Although the inventions where technology or patent patent right (or application to obatain a patent) have been judged to be difficult, those are expected to have a large impact upon society in the future.
- B- Group Inventions: Inventions offered for University Ventures



# How Cooperative Research Agreements and Entrusted Research Agreements Should Be (basic concepts of agreements)

The University of Electro-Communications has researched from early on concerning how cooperative research agreements and entrusted research agreements between enterprises, etc. and universities should be. Because the situations and conditions in each agreement's content vary, it is difficult to establish the same conditions for each "Cooperative Research Agreement" and "Entrusted Research Agreement", but standard agreements have been established for cases in which there are no special circumstances. Shown below are such standard contents concerning handling of patents within standard cooperative research agreements. but they are only provided to define general principles:



1) Possession of Rights
In cases where an invention is made in the course of cooperative research between the University and an enterprise, the rights holder (patent applicant) shall be the side with which the inventor is associated. In other words, if the inventor is the University, the University alone shall make an application, and if the inventor is both the University and the enterprise, a joint application shall be made.

2) Management of Exclusive University Rights
When the University makes an application alone, it shall preferentially inquire of the enterprise partner's wishes. If the partner enterprise should desire, the University may hand over those rights (including cases where the application is pending), or license exclusive or normal implementation rights (for compensation, as a principle) to the partner

periong), or license exclusive or normal implementation rights (for compensation, as a principle) to the partner enterprise.

3)Management of Shared Rights

- With shared rights as well, if the partner should desire, the University may hand over its portion (for compensation, as a principle) to facilitate an exclusive application by the partner enterprise.

- With shared rights, if the partner enterprise has previously agreed to allow the University to license to a third party, the University will not require implementation fees from the partner enterprise.

- With shared rights, in cases where the University licenses to a third party, and the partner enterprise's agreement to this is required, the University will require implementation fees from the partner enterprise.

In cases where an invention occurs within cooperative research

 Confirmation of agreement conten Please confirm how the invention is to be managed under the cooperative research agreement. Agreement content can differ from standard agreements in each case.

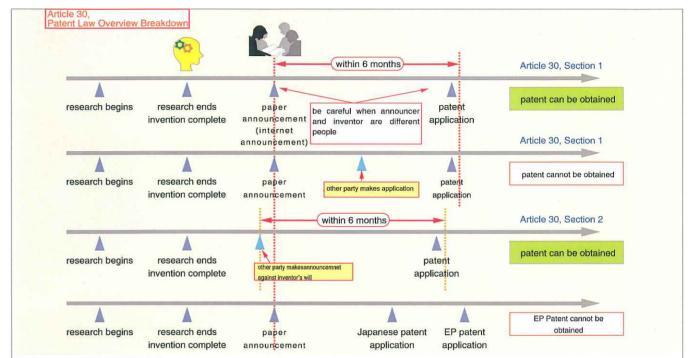
· Possession of invention and determination of share

As a principle, make a determination according to the degree of contribution to the invention, and obtain the approval of the partner. Invention notification

Please notify the Headquarters of Intellectual Property Management immediately upon the occurrence of an invention, so as to facilitate patent application completion before paper announcement.

## **Concerning Paper Announcement, Public Exhibition, and** the Patent Application Process

Important Points Concerning Research Papers, Announcements with regard to Applications (Method According to the Japanese Patent Act. Article 30)



B) Patent Act, Article 30 Regulation "Loss of Novelty Established Exceptions"

Article 30 of the Patent Law states that cases where "written announcement is made at a research meeting of an academic body sanctioned by the Director of the Japanese Patent Office" shall be established as exceptions to loss of novelty.

Therefore, announcements made at research meetings of "the University of Electro-Communications", which is a sanctioned academic body, shall be handled in the same manner as an academic announcement.

However, this system only guarantees that such papers, etc., will not be cited when rejecting the invention as public knowledge. Because of this, a patent cannot be obtained when another party has applied for a patent in the interim. Also, it is necessary to keep in mind that in such bodies as the European Patent Agency, those of the countries of Asia, and other countries not including the U.S. and Canada, no such exception regulation exists, applications made after an announcement will be handled as loss of novelty cases because of that announcement,

Further, while graduate thesises from the University of Elrctro-Communications are within the application of the Article 30 exception regulation, but in order to make clear that graduate thesis announcement meetings, etc. are officially put on by the University, the University requests that announcement meetings

> (Ex.) The University of Electro-Communications [Name] Paper Announcement Meeting [Year], [Department], [Chair], [Name] Paper Announcement Meeting Program

## Process for Patent Applications close to the Paper Announcement

One selects the appropriate way of application from the following:

A) Normal Application Use of this route for patent application is the most preferable as a principle.

B) Application under Article 30 Regulation Though an invention might be applicable, it will be impossible to obtain patent in countries other than U.S.,

C) Apply using U.S. Provisional Application This is used when there is a high possibility that application will be made in countries other than Japan, the U.S., and Canada.

D) Obtain Confidentiality Agreement at Announcement -Meeting Obtaining a confidentiality agreement from those present at a thesis announcement meeting is one way to avoid official publicity.

