

* The Japanese version is the authoritative version, and this English translation is intended for reference purposes only. Should any discrepancies or doubts arise between the two versions, the Japanese version will prevail.

The University of Tokyo Rules for the Treatment of Inventions

(April 1, 2004, University of Tokyo Rules No. 130)

CHAPTER 1 PURPOSE

1. Purpose

The purpose of the University of Tokyo Rules for the Treatment of Inventions (these “**Rules**”) is to provide for the treatment of Inventions (as defined in Article 2) made by Faculty Members (as defined in Article 2) of the University of Tokyo (the “**University**”), to protect the rights of Inventors (as defined in Article 2), and to provide incentive for Inventions and increased enthusiasm for research.

2. Overseas Applications

These Rules shall apply to Inventions (as defined in Article 2) that are the subject of overseas intellectual property rights.

CHAPTER 2 DEFINITIONS

3. Definitions

In these Rules, the following terms shall have the meanings set out below.

(1) “**Invention(s)**” means the following:

- (a) inventions, for items that are the subject of patent rights;
- (b) devices, for items that are the subject of utility model rights;
- (c) works of design, for items that are the subject of design rights;
- (d) the cultivation of plant varieties, for items that are the subject of plant breeder’s rights; and
- (e) circuit layout creations, for items that are the subject of circuit layout rights.

(2) “**Inventor(s)**” means, collectively, inventors, devisers, creators of designs and circuit layouts, and cultivators of plant varieties.

(3) “**Patent(s)**” means, collectively, patents, registered utility models, registered designs, registered circuit layouts, and registered plant varieties.

(4) “**Patent Right(s)**” means patent rights under the Patent Law (Law No. 121 of 1959), utility model rights under the Utility Model Law (Law No. 123, of 1959), design rights under the Design Law (Law No. 125 of 1959), plant breeder’s rights under the Seeds and Seedlings Law (Law No. 43 of 1999), circuit layout rights under the Law Concerning the Circuit Layout of Semiconductor Integrated Circuits (Law No. 43 of 1985), and their respective overseas equivalents.

(5) “**Application(s)**” means the carrying out of prescribed procedures required for the protection of rights related to Inventions as provided by law, such as patent applications, applications for utility model registration, applications for design registration, execution of registrations of circuit layout rights, and applications for plant variety registration.

(6) "**Utilization**" with respect to Inventions means the actions provided in Article 2.3 of the Patent Law, Article 2.3 of the Utility Model Law, Article 2.3 of the Design Law, Article 2.3 of the Law Concerning the Circuit Layout of Semiconductor Integrated Circuits, and Article 2.4 of the Seeds and Seedlings Law.

(7) "**Employment-related Invention(s)**" means Inventions created by Faculty Members through work carried out with public research funds or money or other support from the University, or work carried out using facilities controlled by the University.

(8) "**Other Invention(s)**" means Inventions created by Faculty Members that are excluded from the category of Employment-related Inventions.

(9) "**Faculty Member(s)**" means any of the following persons:

(a) officers, full-time faculty members, contract-based faculty members, reemployed faculty members, contract-based part-time staff, and contract-based part-time faculty members of the University;

(b) other personnel who have contracts with the University that relate to Employment-related Inventions.

(10) "**Other Researcher(s)**" means personnel, other than Faculty Members, who are taken on by the University for the purposes of education, training, and research.

CHAPTER 3 SUCCESSION AND OWNERSHIP OF RIGHTS

4. Principle of Organizational Ownership

4.1. The University may succeed to the right to obtain a Patent of an Employment-related Invention made by a Faculty Member.

4.2. If an Employment-related Invention has two or more Inventors, the University may succeed to the Faculty Member's share of the right to obtain a Patent.

4.3. If the University decides that it is not necessary to succeed to the right to obtain a Patent of an Employment-related Invention, the right may belong to the Faculty Member concerned.

4.4. A Faculty Member who has made an Invention shall not dispose of the right to obtain a Patent of the Invention by way of assignment or otherwise unless the University has decided not to succeed to such right.

4.5. If deemed necessary by the University, the University may succeed to the right to obtain a Patent of Other Invention by obtaining the agreement of the Faculty Member concerned.

4.6. The right to obtain Patents of Other Invention that the University does not succeed to shall belong to the Faculty Member concerned.

4.7. This Article 4 shall not apply to research results with respect to which it is considered that the exercise of the right to obtain a Patent would not be an appropriate contribution to society.

5. Treatment After Resignation

These Rules shall govern the treatment of Inventions that fall into the category of Employment-related Invention, even after the Faculty Member concerned has resigned from

the University.

6. Confidentiality Obligation

The University and the Faculty Member shall maintain the confidentiality of the content of the Invention concerned and other details thereof during the period necessary to secure the right to obtain a Patent for the Invention; however, this shall not apply in the case where the Invention will be published upon agreement between the University and the Faculty Member concerned, or in the case where it was publicly known through no fault of the University or the Faculty Member.

7. Inventions of Other Researchers

7.1. The University may require, by such means as rules or contracts, that any Other Researchers give notice of Inventions to the University.

7.2. The Other Researchers that fall under Article 7.1 above shall give notice to the department to which they belong, in accordance with Article 15, if they made any of the following Inventions:

- (a) Inventions made in collaboration with a Faculty Member;
- (b) Inventions involving results of their own research at the University; and
- (c) Inventions relating to research in a laboratory to which they currently belong, or have belonged to in the past.

7.3 Other Researchers who fall under Articles 7.1 and 7.2 shall give notice in accordance with Article 7.2 of Inventions they made within six (6) months of the end of their period of affiliation.

7.4 Article 6 shall apply to Inventions with respect to which Other Researchers have given notice in accordance with Article 7.2 or 7.3.

7.5 The University may succeed to the right to obtain a Patent upon the agreement of the Other Researcher who is the Inventor.

7.6 If the University succeeds to rights under Article 7.5, it shall pay compensation in accordance with Articles 5.23 and 5.24, the same as for Inventions of Faculty Members.

7-2. Receipt of Patent Rights and Rights to Obtain Patents

7-2.1 When Faculty Members or Other Researchers offer to the University to assign a Patent Right or a right to obtain a Patent with respect to which the Application has already been made, the University may, where considered necessary by the Office of Intellectual Property of the University as set forth in Article 8, receive those rights with the approval of the Faculty Members or Other Researchers.

7-2.2 In order to promote the technology transfer of Inventions of the University, the University may, where considered necessary by the Office of Intellectual Property receive a Patent Right or a right to obtain a Patent from any persons other than Faculty Members and Other Researchers, and any organizations other than the University.

CHAPTER 4 STRUCTURE FOR THE HANDLING OF INVENTIONS

8. Office of Intellectual Property

The University established the Office of Intellectual Property as a university-wide organization to conduct affairs under these Rules.

9. Decision on Organizational Ownership

The Office of Intellectual Property shall determine whether or not it is necessary for the University to succeed to the right to obtain a Patent for of an Invention made by a Faculty Member (including cases in which notice has been given by Other Researchers in accordance with Article 7.1 or 7.2).

10. Consultation Regarding Application

Where necessary, the Office of Intellectual Property shall conduct a consultation with an Inventor regarding matters such as the novelty of an Invention and the scope of the rights with respect to the Invention.

11. Tasks Relating to Assignment, Application, Intermediary Handling, and Registration

11.1. For those Inventions that the Office of Intellectual Property determines the University will succeed to the rights to obtain Patents for, or the Patent Rights to, the Office of Intellectual Property shall determine the necessary procedures for the transfer of the rights from the Inventors, the applications for registration, or the maintenance of the rights, and shall immediately take the necessary procedures.

11.2. The Office of Intellectual Property may delegate all or a part of the procedural tasks provided in Article 11.1 to a third party.

12. Tasks Relating to Technology Transfer

12.1. The Office of Intellectual Property shall promote the practical use of the rights to obtain Patents, or the Patent Rights that the University owns, and may transfer technology with respect to such rights to corporations and other parties when the Office of Intellectual Property considers it necessary to do so.

12.2. The Office of Intellectual Property shall select a method of technology transfer that it considers will give society the greatest benefit from the Invention, whether a grant of an exclusive license, a grant of a nonexclusive license, or an assignment of rights.

12.3. The Office of Intellectual Property may delegate all or a part of the tasks provided in Article 12.1 to a third party, such as a technology licensing organization.

13. Tasks Relating to Disputes

The University shall take legal measures to protect its rights to obtain Patents and the Patent

Rights that it owns.

14. Faculty Administration of Intellectual Property

14.1. The faculty to which an Inventor belongs shall determine whether or not the Invention made by the Inventor is an Employment-related Invention.

14.2. Faculties may establish the organizations necessary for the determination provided in Article 14.1, such as an intellectual property office.

CHAPTER 5 HANDLING PROCEDURES

15. Notification of Inventions

15.1. Any Faculty Member who has made an Invention shall immediately give notice to the faculty to which they belong using a form to be separately prescribed.

15.2. The Faculty Member shall note any other intellectual property relating to the Invention (such as an employment-related work or trademark) in the notice provided in Article 15.1.

16. Identification of Inventions Related to Employment

16.1. Upon receipt of a notice made under Article 15, the faculty shall determine whether or not the Invention is an Employment-related Invention based on that notice.

16.2. The faculty shall make the determination relating to the Invention provided in Article 16.1 within ten (10) days (excluding holidays) from the receipt of the notice under Article 15, and shall notify the Faculty Member.

16.3. After making the determination provided in Article 16.1, the faculty shall immediately send cases of Inventions which it has determined to be Employment-related Inventions, and cases of Inventions with respect to which the Inventor wishes the University to secure rights, and like cases to the Office of Intellectual Property.

16.4. Upon receipt of a case under Article 16.3, the Office of Intellectual Property shall immediately notify the Faculty Member concerned that it has received the case.

16.5. If the faculty cannot make the determination provided in Article 16.1 within ten (10) days (excluding holidays) from receipt of the notice under Article 15, it shall send the case to the Office of Intellectual Property, noting that it defers the determination of the case to the Office of Intellectual Property.

16.6. Upon receipt of a case under Article 16.5, the Office of Intellectual Property shall inform the Faculty Member concerned that it has received the case, as well as immediately determine whether or not the Invention is an Employment-related Invention.

16.7. After making the determination provided in Article 16.6, the Office of Intellectual Property shall immediately notify the faculty and the Faculty Member concerned.

17. Succession of Rights and Submission of Assignment Form

17.1. The Office of Intellectual Property shall determine whether or not the University will succeed to rights to obtain Patents of Inventions with respect to which cases have been sent

under Article 16.3, or those that the Office of Intellectual Property has judged to be Employment-related Inventions under Article 16.6.

17.2. The Office of Intellectual Property shall make the determination in accordance with Article 17.1 within ten (10) days (excluding holidays) from the date of notice made under Article 16.4 or 16.7, and shall notify the Faculty Member concerned.

17.3. If the University decides to succeed to the right to obtain a Patent of the Invention, the Faculty Member concerned shall submit a rights assignment form, in a form to be separately prescribed, to the Office of Intellectual Property. Further, in the cases provided in Articles 4.5 and 7.5, the University shall request the submission of the rights assignment form from the Faculty Member or Other Researcher.

18. Objections to Faculty Determinations

18.1. If a Faculty Member objects to a determination of the faculty made under Article 16, the Faculty Member may file an objection with the faculty within two (2) weeks of the date of receipt of the notice of the determination.

18.2. If an objection is filed, the faculty shall determine whether or not to accept the objection.

18.3. The faculty shall notify the Faculty Member concerned of the determination it makes in accordance with Article 18.2.

19. Objections to the Office of Intellectual Property

19.1. If an Inventor objects to a determination of the Office of Intellectual Property under Article 17.1, the Inventor may file an objection with the Office of Intellectual Property within two (2) weeks of receipt of the notice of the determination.

19.2. If an objection is filed, the Office of Intellectual Property shall determine whether to accept the objection.

19.3. The Office of Intellectual Property shall notify the Inventor concerned of the determination it makes in accordance with Article 19.2.

20. Special Exception for a Late Determination of Succession by the Office of Intellectual Property

20.1. If a decision under Article 17.1 is not made within ten (10) days from receipt of the notice under Article 16.4 or 16.7, the Faculty Member may seek to secure the Patent Rights themselves as if a decision provided in Article 4.3 had been made, provided that this exception is not applied to the case where it is necessary for the University to decide whether to succeed to the rights on or after eleven (11) days from receipt of the notice under 16.4 or 16.7, and the Faculty Member agrees with it.

20.2. In the case provided in Article 20.1, the Faculty Member shall report to the Office of Intellectual Property that they are seeking to secure the Patent Rights themselves, and shall also bear the duty to report specified in Article 21.

21. Duty to Report for an Employment-related Invention

If a Faculty Member obtains the right to obtain a Patent under Article 4.3 and seeks to secure the Patent Right, the Faculty Member shall report to the Office of Intellectual Property on the progress of that process.

22. Special Exception for the Need for Expeditious Handling

22.1. In cases where it is necessary to make research results public or secure priority rights to an Invention, a Faculty Member may undertake an Application as their own responsibility before receiving the notice provided in Article 17.2 by notifying the Office of Intellectual Property of the grounds rendering the expeditious handling necessary. In such a case, the Faculty Member concerned shall not hinder the procedure provided in Article 22.4.

22.2. In the case provided in Article 22.1, the prohibition on assignment and other disposal under Article 4.4 and the confidentiality obligation under Article 6 shall still apply.

22.3. Faculty Members who fall under Article 22.1 shall bear an obligation to report to the Office of Intellectual Property on the progress of the process.

22.4. If a determination is made under Article 17.1 that the University will succeed to the rights to an Invention, the University may succeed to the right to obtain a Patent of, or the Patent Right to, an Invention with respect to which the Faculty Member has undertaken an Application under Article 22.1.

22.5. If the University succeeds to the rights to an Invention under Article 22.4, it shall reimburse the Faculty Member for the fees paid for the Application.

CHAPTER 6 COMPENSATION AND DISTRIBUTION OF INCOME, INCLUDING LICENSE FEE

23. Payment of Compensation for the Assumption of Rights

23.1. If the University succeeds to the right to obtain a Patent of, or Patent Right to, an Invention in either of the cases below, it shall pay the Faculty Member who made the Invention a separately prescribed amount of compensation:

(a) the University succeeds to the right to obtain a Patent and it is subsequently registered (Compensation for Registration);

(b) the University receives the Patent Rights under Article 7-2.1 (including the rights to obtain a Patent with respect to which an Application has already been made) (Compensation for Assignment).

23.2 When under Article 7-2.2 the University receives rights to obtain Patents or Patent Rights from any person other than Faculty Members and Other Researchers, and any organizations other than the University, the University may pay compensation in accordance with Articles 23.1 and 24.

24. Compensation in Accordance with Profit from Utilization and License Fee Income

If the University gains a profit from the utilization of the Patent Rights that it owns, or if the University receives income from a licensing or assignment to a third party of the rights to obtain Patents or the Patent Rights that it owns, it shall as a general rule pay compensation to

the Faculty Member who made the Invention concerned in accordance with Articles 25 and 26, in proportion to the profit gained or license fee income.

25. Subtraction of Costs

The University shall calculate the total distribution amount after subtracting necessary costs from the profit gained or license fee income.

26. Distribution of Total Distribution Amount

26.1. The University shall distribute the total distribution amount (annual amount), calculated in accordance with Article 25 in the following proportions:

(a) 40% (forty percent) of the total distribution amount to the Faculty Member as compensation who made the invention; and

(b) 60% (sixty percent) of the total distribution amount divided equally between the faculty that received the notification of the Invention and the Office of Intellectual Property.

26.2 If, in the case provided in Article 26.1(b), two or more Faculty Members who made the Invention belong to different faculties, payment of the distribution amount may be distributed between the faculties which respective Faculty Members belong to if all of the Faculty Members who made the Invention agree.

26.3 By giving notice to the University, a Faculty Member who made the invention may waive all or a part of the right to receive compensation under this Article 26 and may make the compensation amount regarding the waiver be distributed to a laboratories, departments, divisions, faculties, or equivalent organizations that he or she nominates.

27. Compensation and Distribution for Joint Inventors

If two or more Faculty Members have the right to receive compensation under Article 23 or 24, the University shall as a general rule pay compensation in proportion to their respective shares.

CHAPTER 7 MISCELLANEOUS PROVISIONS

28. Amendment or Abolition of Rules

Amendment or abolition of these Rules shall be conducted through the deliberation of the Research and Education Council.

29. Contracts with Other Organizations

29.1. If entering into a contract or agreement relating to research with another organization, the University shall explain the content of these Rules to the other organization, and shall make an effort to ensure that the content of that contract or agreement protects the rights of the University and the Faculty Members provided by these Rules.

29.2. Article 29.1 notwithstanding, if the University enters contracts or agreements with other

organizations that have content that conflicts with these Rules, Faculty Members must comply with the content of such contracts or agreements.

30. Existing Contracts

If an agreement has already been made between the University and Faculty Members, Other Researchers or other third parties as to the treatment of Inventions by way of a contract entered into prior to these Rules taking effect, the parties concerned shall comply with the terms of that contract.

SUPPLEMENTARY PROVISION

1. Effective Date

These Rules are effective as of April 1, 2004.

2. Revocation of Rules

The University of Tokyo Invention Rules (established April 17, 1979) are revoked.

3. Interim Measures

(Omitted)

4. Revision of Interim Measures

(Omitted)

SUPPLEMENTARY PROVISION

These Rules are effective as of September 30, 2004.

SUPPLEMENTARY PROVISION

These Rules are effective as of April 1, 2005; however, the revised understandings provisions shall apply from March 1, 2005.

SUPPLEMENTARY PROVISION

These Rules are effective as of January 30, 2006.

SUPPLEMENTARY PROVISION

These Rules are effective as of January 30, 2007.

SUPPLEMENTARY PROVISION

1. These Rules are effective as of April 1, 2015.
2. With respect to the distribution of the compensation for Inventions upon receipt of notice prior to the effective date of these Rules, notwithstanding this revised provisions of

Article 26.3, the provisions then in force shall remain applicable.

UNDERSTANDINGS

These Rules shall apply to Inventions made on and after April 1, 2004, and the former University of Tokyo Invention Rules (including the Guidelines for Payment of Compensation for Employee Inventions by MEXT Employees (Minister of Education, Culture, Sports, Science and Technology Decision, 2002 Research Promotion Bureau No.718, dated January 29, 2003)) shall apply to Inventions made on or before March 31, 2004.

Further, applications involving a priority claim based on an Application for an Invention made before April 1, 2004, divisional applications and converted applications based on such applications involving such a priority claim, and divisional applications and converted claims whose original application is an Application for an Invention made before April 1, 2004 shall be similarly treated as pre-existing.

However, these Rules relating to compensation and similar matters may apply to any assignment to the University of rights to obtain Patents of, or the Patent Rights in, Inventions after these Rules take effect, or any bearing of expenses by the University on or after April 1, 2004 for the protection or maintenance of, or technology transfer to corporations and other organizations with respect to, rights to obtain Patents of, or Patent Rights to, Inventions made on or before March 31, 2004 succeeded by the government under the former Tokyo University Invention Rules.