

The University of Tokyo Rules for the Treatment of Know-How

(Revised Version, Scheduled for Enactment on April 1, 2005)

(December 17, 2004, University of Tokyo Rules No. 263)

CHAPTER 1 PURPOSE

1. Purpose

The purpose of the University of Tokyo Rules for the Treatment of Know-How (these “**Rules**”) is to provide for the treatment of Know-How (as defined in Article 2) created by Faculty Members (as defined in Article 2) of the University of Tokyo (the “**University**”), guarantee the rights of the creator, promote the creation and use of Know-How, and contribute to advancing the returning to society of the benefits from research results generated at the University.

CHAPTER 2 DEFINITIONS

2. Definitions

In these Rules the following terms have the following meanings.

- (1) “**Know-How**” means intellectual property in the form of a body of technological information that is of a confidential nature, has proprietary value, and can be specified or identified in an appropriate way but that is not covered by patent rights or copyrights .
- (2) “**Work-Related Know-How**” means Know-How that is essential to licensing or providing patent rights, copyrights, or tangible deliverables (“**Patent Rights Etc.**”) succeeded to by, assigned to, or belonging to the University and that makes it possible to increase the utility value or overall asset value of intellectual property being transferred by being combined with Patent Rights Etc.
- (3) “**Other Know-How**” means Know-How that is not Work-Related Know-How.
- (4) “**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 entered into agreements with respect to Work-Related Know-How.
- (5) “**Other Researchers**” means personnel, other than Faculty Members who are taken on by the University for the purpose of teaching, training, and researching.

CHAPTER 3 VESTING OF RIGHTS

3. Vesting of Rights

- 3.1 Where Work-Related Know-How has been created by Faculty Members the University may, after specifying or identifying the Work-Related Know-How , succeed to the rights with respect to that Work-Related Know-How.
- 3.2 Where Work-Related Know-How has been created by Other Researchers, the University may, after specifying or identifying the Work-Related Know-How and after obtaining the consent of those Other Researchers, succeed to the rights with respect to that Work-Related Know-How.
- 3.3 Other Know-How in principle vests in the Faculty Members who created it or Other Researchers who created it. However, if Other Know-How has proprietary value by itself and without any regard to Patent Rights Etc., then the Faculty Members who created it or Other Researchers who created it may ask the University to receive it by assignment.

4. Handling Know-How after Resignation

When Faculty Members resign from the University, the treatment of Work-Related Know-How created during their term of employment is governed by these rules.

CHAPTER 4 PROCEDURES FOR PROCESSING

5. Processing Know-How

The Intellectual Property Office of the Division of University Corporate Relations (the **IP Office**) handles the processing of Know-How provided for in these rules.

6. Specifying and Assigning Work-Related Know-How

- 6.1 If, when licensing or providing Patent Rights Etc., Faculty Members or Other Researchers receive a request from the IP Office for assignment of Work-Related Know-How, that Faculty Members or those Other Researchers shall specify and identify the Work-Related Know-How and provide the IP Office with a letter of assignment in the appropriate form, which is determined separately to these rules.
- 6.2 In case of Article 6.1, Faculty Members and Other Researchers shall clearly set out all the creators of the Work-Related Know-How, and if the Work-Related Know-How uses the Know-How of a third party, they shall provide information related to that.

7. Specifying and Assigning Other Know-How

- 7.1 Faculty Members or Other Researchers who wish for the University to receive an assignment of Other Know-How under Article 3.3 shall specify and identify the Other Know-How and promptly notify the IP Office, in the appropriate form, which is determined separately to these rules, through the department to which they belong.

- 7.2 In case of Article 7.1, Faculty Members and Other Researchers shall clearly set out all the creators of the Other Know-How, and if the Other Know-How uses the Know-How of a third party, they shall provide information related to that.
- 7.3 If the IP Office receives a matter as provided for under Article 7.1, the IP Office shall decide whether or not to accept the assignment and notify the applicable Faculty Members or Other Researcher as appropriate.
- 7.4 If the University decides to accept the assignment of the Other Know-How, the Faculty Members or Other Researchers shall submit a letter of assignment to the IP Office in the appropriate form, which is determined separately to these rules.

8. Filing Objections

If a Faculty Member or Other Researcher objects to an assignment being made under Article 6 or a decision made under Article 7, it may file a complaint within 2 weeks of the day the assignment was requested or notice of the decision was given. Procedures for processing such filings of objections are governed by Article 19 of the University of Tokyo Rules for the Treatment of Inventions (2004, University of Tokyo Rules No. 130).

9. Compensation for Assignment

If the University accepts an assignment of Other Know-How under Article 7, it shall pay the appropriate compensation, which is set out separately to these rules to the Faculty Member or Other Researcher who created the Other Know-How.

10. Protecting Rights; Transferring Technologies

- 10.1 The IP Office shall appropriately protect Work-Related Know-How and the Other Know-How assigned to the University, and if it believes an appropriate technology transfer is necessary to promote the active use of either of those types of Know-How, it shall undertake such a transfer.
- 10.2 The IP Office may take legal actions to protect the rights provided for under Article 10.1.
- 10.3 The IP Office may entrust all or a part of the activities provided for under Article 10.1 to a third party of a technology licensing organization or the like.

11. Handling Compensation from Profits

- 11.1 If the University receives profit as a result of, for example, licensing Work-Related Know-How assigned to the University, it shall distribute that profit in accordance with the University's provisions for distributing income with respect to Patent Rights Etc. that were licensed or provided together with that Work-Related Know-How (University of Tokyo Rules for the Treatment of Inventions, Articles 24 through 27; University of Tokyo Rules for the Treatment of Tangible Deliverables (2004, University of Tokyo Rules No. 237), Article 12;

University of Tokyo Rules for the Treatment of Copyright Works (2004, University of Tokyo Rules No. 236), Article 15).

- 11.2 If the University receives profit as a result of, for example, licensing Other Know-How assigned to the University, it shall distribute that profit in accordance with the University of Tokyo Rules for the Treatment of Inventions, Articles 24 through 27.

CHAPTER 5 MISCELLANEOUS PROVISIONS

12. Amendment or Abolition of Rules

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

13. Existing Contracts

If an agreement has been reached with respect to the treatment of Know-How under a contract executed before these rules came into force, the treatment of that Know-How will be governed by that contract.

14. Existing Work-Related Know-How

Faculty Member will decide how to handle Work-Related Know-How that was created before these rules came into force. However, if an event set forth in Article 3 of these rules arises after these rules come into force, or if the Work-Related Know-How is largely altered after these rules come into force, then that Work-Related Know-How will be handled as though it was created after these rules came into force.

SUPPLEMENTARY PROVISION

These rules are effective as of December 17, 2004.

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