

## JST-Mirai Program

# Intellectual Property Management Basic Policy



**Japan Science and Technology Agency**

Department of Research and Development Reform

Department of Intellectual Property Management

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## Intellectual Property Management Basic Policy for JST-Mirai Program

### 1. Purpose

The JST-Mirai Program (“the Program”) is an initiative that promotes high-risk, high-impact research and development in bold new experiments with the aim of actively generating non-continuous innovation that has an economic and social impact.

The purpose of this basic policy (“the Basic Policy”) is to (1) effectively create and secure rights for research outcomes such as intellectual property rights (“the Research Outcomes”) centered on intellectual creations occurring in research publications, etc., and patents derived from the selected research projects (“Selected Projects”) in the Program; (2) promote the determination of comprehensive guidelines related to the publication, confidentiality, and utilization of the Research Outcomes; and (3) integrate research and development with intellectual property creation, etc., activities. Accordingly, the Basic Policy aims to support activities that contribute to the innovation targeted by the Program.

### 2. Entities Subject to Basic Policy

The Basic Policy shall apply to the entities outlined in (1) and (2) below.

- (1) Research institutions that have concluded an R&D Agreement with the Japan Science and Technology Agency (JST) regarding R&D management for various Selected Projects.
- (2) Joint cooperation institutions that have not concluded an R&D Agreement, etc., with JST, but that conduct research and development either jointly or in cooperation with the contracted research institution specified in the R&D Plan for the Selected Projects.

For all Selected Projects, (1) and (2) shall be referred to collectively as Participating Institutions.

### 3. Applicable Period for Basic Policy

The Basic Policy shall apply from June 7, 2017.

The Basic Policy shall be revised on August 10, 2017.

The Basic Policy shall be revised on October 31, 2017.

The Basic Policy shall be revised on April 1, 2018.

The Basic Policy shall be revised on May 29, 2019.

The Basic Policy shall be revised on October 1, 2021.

Subsequent revisions shall apply to projects started after the revision date.

### 4. Definitions Used in Basic Policy

Definitions are included in the reference section at the end of this document.

## 5. Duties of Research and Development Representatives

Project leaders and program managers who serve as representatives for each Selected Project of the Program (“R&D Representatives”) shall in principle implement the following intellectual property management to promote the respective Selected Project (“the Project”) they are working on (including partial or application-stage examinations, etc.).

### (1) Clarification of Policy on Intellectual Property Creation, Protection, Management, and Utilization

[1] R&D Representatives shall steadily and effectively secure rights for Research Outcomes to ensure the latter lead to economic and social value, and thus secure and maintain reliability and superiority of the Research Outcomes.

[2] To achieve the objectives of the Project, the R&D Representatives shall plan and implement research and development to create intellectual property with a high potential for technology transfer, and protect and utilize the intellectual property rights that have been established as rights to the highest extent. In other words, they shall aim to integrate research and development activities and intellectual property activities, and develop mutual activities.

[3] In securing rights for the Research Outcomes, the R&D Representatives shall aim to strengthen, etc., the intellectual property rights within the necessary scope to achieve the objectives of the Project.

In addition, if the Research Outcomes are expected to be developed in overseas markets, rights shall in principle be secured in foreign countries for which the securing of such rights is deemed necessary after considering the market size and the state of competition with other companies, etc.

[4] The R&D Representatives shall examine their “basic thinking on intellectual property management” as described below, and indicate such thinking at the application stage.

#### [Basic Thinking on Intellectual Property Management]

- Basic thinking of R&D Representatives on intellectual property management, particularly on issues such as what type of management framework to establish and how many members it should have.
- Basic thinking on the classification of Research Outcomes expected to be generated by the Project into those requiring the securing of rights as intellectual property and those without such a requirement. In addition, basic thinking on announcement and non-publication of Research Outcomes.
- Basic thinking on securing and maintaining intellectual property rights (including how to arrange financing) during the Project implementation period and following Project completion, waiving rights, transferring rights, etc.

[5] When promoting research and development for their Project, R&D Representatives shall examine intellectual property management so that it is integrated with the promotion of research and development of the Project while considering the matters specified in the Basic Policy.

## (2) Strengthening of Intellectual Property Management

[1] Based on the intellectual property management they examined for their project, the R&D Representatives shall conclude agreements with Participating Institutions (“Joint Intellectual Property Agreements”) based on discussions and coordination with Participating Institutions, and submit such agreements to JST.

The timing of the submission and other matters to be specified in these agreements shall be prescribed separately.

[2] If deemed necessary, the R&D Representatives shall set up an Intellectual Property Executive Committee with the cooperation of the Participating Institutions. The Intellectual Property Executive Committee shall serve as an organizational structure for (1) organizational development and promotion, etc., with the aim of creating Joint Intellectual Property Agreements, and generating, protecting, and utilizing intellectual property; (2) establish related agreements and resolve problems, and (3) support various coordination work.

## (3) Management of Confidentiality and Disclosure to Third Parties

[1] Within the scope necessary for the implementation of the Project, the R&D Representatives shall sufficiently consider the potential for (and resulting impact of) leaks of Research Outcomes caused by the participation or withdrawal of Participating Institutions, or by the participation, employment, transfer, or departure (return to home country) of researchers, etc., affiliated with Participating Institutions. If deemed necessary, R&D Representatives shall with the cooperation of Participating Institutions conduct thorough management and measures to counter confidentiality leaks and information outflows.

[2] Within the scope necessary for the implementation of the Project and from the perspective of preventing information leaks, etc., the R&D Representatives shall make decisions on the publication or non-publication of the Research Outcomes generated by themselves or by researchers, etc., affiliated with Participating Institutions, as well as of various reports or equivalent materials, etc., and they shall aim to appropriately manage the related content and publication or non-publication periods while coordinating with related parties.

## (4) Implementation of External Evaluation, etc., and Subsequent Reflection

With regard to the application of the Policy to the promotion of research and development, the R&D Representatives shall obtain the confirmation and evaluation, etc., of external evaluators for the “basic thinking on intellectual property management” at the preliminary evaluation for the Project, and for the Joint Intellectual Property Agreements and their implementation status at the interim evaluation, etc., and they shall reflect the results in subsequent activities. In addition, instructions, etc., received at the time of progress analysis by the R&D Supervisor, etc., after selection shall also be reflected.

## 6. Matters Applicable to Contracted Research Institution Prescribed in R&D Agreements

### (1) Ownership of Intellectual Property

In accordance with the thinking underlying Article 17 of the Industrial Technology Enhancement Act, JST shall not take over the intellectual property rights attached to the Research Outcomes (“Foreground IP”) from the contracted research institution provided the latter complies with the items specified below. However, this shall not apply if the contracted research institution waives the Foreground IP.

- [1] Where deemed necessary for the public benefit and if so requested by JST after clarifying the underlying reasons, the contracted research institution shall provide a free license to utilize the foreground IP to JST.
- [2] If it is found that the contracted research institution does not utilize the Foreground IP within a reasonable time and that there are no justifiable grounds as to why the Foreground IP has not been utilized within a reasonable time, and if JST deems it necessary to promote utilization of the Foreground IP and makes such a request after clarifying the underlying reasons, the contracted research institution shall provide a license to utilize the Foreground IP to parties designated by JST.
- [3] When transferring the ownership of Foreground IP, or establishing or approving the transfer of an Exclusive License, Etc., for the Foreground IP to a third party (“Establishment, Etc., of Exclusive License, Etc.”), the contracted research institution shall obtain prior approval from JST. However, this shall not apply to transfers resulting from mergers or spinoffs or transfers corresponding to the items (i)–(ii) outlined below.

In addition, Article 17-1-4 of the Industrial Technology Enhancement Act and Article 2-3-1 of the Order for Enforcement of the Industrial Technology Enhancement Act stipulate that prior approval is not required for transfers, etc., between a parent company and its subsidiary. However, in the R&D Agreements for the Program, JST shall request prior approval in the case of such transfers.

- (i) In the event of a transfer or Establishment, Etc., of Exclusive License, Etc. by the contracted research institution to an accredited technology licensing organization (TLO; business operator accredited based on Article 4-1 of the Act on the Promotion of Technology Transfer from Universities to Private Businesses (Act No. 52 of 1998) (including parties accredited after implementing a change in accordance with Article 5-1 of the same Act) or a certified TLO (business operator certified based on Article 11-1 of the same Act).
  - (ii) In the event of a transfer or Establishment, Etc., of Exclusive License, Etc. by a contracted research institution that is a technology research cooperative to a partner.
- [4] If the contracted research institution is merged, spun off, or turned into a subsidiary of a third party (including if the parent company of the contracted research institution changes), it shall promptly notify JST accordingly. In this case, if deemed necessary to utilize the Foreground IP owned by the applicable contracted research institution or to commercialize the Research Outcomes, and if so requested by JST after clarifying the underlying reasons, the applicable contracted research institution shall provide a free non-exclusive license with re-license rights for the applicable Foreground IP to JST.

(2) Free Transfer

If JST deems that the contracted research institution does not or will not comply with the matters specified in 6. (1) above without justifiable grounds, or if the grounds for cancellation prescribed in the R&D Agreement apply to the contracted research institution, and if so requested by JST after clarifying the underlying reasons, the applicable contracted research institution shall transfer its owned Foreground IP to JST free of charges.

(3) Free License

Even if the contracted research institution complies with the matters specified in 6. (1) above, if JST deems the contracted research institution does not or will not comply with this Basic Policy or the matters prescribed in the R&D Agreement without justifiable grounds, or if the grounds for cancellation prescribed in the R&D Agreement apply to the contracted research institution, and if so requested by JST after clarifying the underlying reasons, the applicable contracted research institution shall provide a free license for its owned Foreground IP to JST.

7. Joint Intellectual Property Agreements Among Participating Institutions and Matters Prescribed in Applicable Agreements

(1) Obligation to Submit Joint Intellectual Property Agreements

Participating Institutions shall conclude a Joint Intellectual Property Agreement among Participating Institutions within six months of the start of the Project, and the R&D Representatives shall submit a copy of the agreement to JST.

The applicable agreement may take the form of a joint research agreement among Participating Institutions or be part of the Comprehensive Agreement, etc. If no such agreement is concluded, JST may terminate the participation of the Participating Institutions, or cancel the R&D Project.

(2) Preparation of Intellectual Property Management Implementation Structure

To appropriately implement intellectual property management in accordance with this Policy, the R&D Representatives shall designate individuals to participate in the established Intellectual Property Executive Committee.

The Intellectual Property Executive Committee shall promote the creation, protection, and utilization of intellectual property rights, and support establishment of agreements, resolution of problems, and coordination for various issues.

The Intellectual Property Executive Committee shall coordinate, etc., on the determination of policies, etc., while considering the conclusion of Joint Intellectual Property Agreements and the content of such agreements, and on process decisions related to the securing of rights, confidentiality, publication, etc. If deemed necessary, it shall also assume a coordinating role in the event coordination among related parties related licensing proves difficult.

The Intellectual Property Executive Committee shall consist of the R&D Representatives, the research and development members, intellectual property experts, JST employees, etc.

### (3) Confidentiality

Participating Institutions shall agree on the necessary confidentiality procedures and scope in advance to ensure confidentiality is maintained when disclosing proprietary technology information, etc., to other Participating Institutions.

### (4) Prior Approval to Disclose Research Outcomes to Third Parties

Participating Institutions may not disclose the Research Outcomes to third parties other than Participating Institutions without the approval of the R&D Representatives, or otherwise leak the Research Outcomes. The necessary procedures and scope, etc., for approval of publication or disclosure of the Research Outcomes (including research publications and oral presentations, etc.) shall be agreed upon in advance among the participating institutions.

### (5) Procedure When Foreground IP Is Not Taken Over

If Participating Institutions do not take over the Foreground IP prior to the filing, they shall notify the details of the Foreground IP and their intent not to take it over to JST at least two months before the information becomes public knowledge.

### (6) Utilization of Shared Foreground Intellectual Property

Participating Institutions may in principle freely utilize Foreground IP shared with other Participating Institutions free of charges.

However, if the Foreground IP is shared with a University, Etc., that cannot work the Foreground IP, compensation deriving from the absence of a function to work the Foreground IP at the University, Etc., shall be as follows.

- If the University, Etc., can provide free licenses to third parties regardless of the intent of joint rights holders, or if the joint rights holders fully bear the costs required for the Foreground IP, the University, Etc., shall not seek compensation.
- However, this shall not preclude handling methods other than the one specified above provided an agreement is reached among the Participating Institutions and approved by the R&D Supervisor.

### (7) Licensing of Intellectual Property

The licensing of intellectual property rights shall be as prescribed below. However, this shall not preclude other handling methods provided an agreement is reached among the Participating Institutions and approved by the R&D Supervisor.

[1] Limitations on the Exercise of Rights for Research and Development Activities during the Project Implementation Period



Participating Institutions shall cooperate to support a smooth execution of the Project by not exercising intellectual property rights for owned Foreground IP and background IP in research and development activities conducted under the Project by other Participating Institutions during the Project implementation period.

[2] Licensing of Research Outcomes for Business Purposes

- If a license for Foreground IP owned by a Participating Institution is requested by another Participating Institution, the terms, etc., of the license shall be discussed accordingly.
- When a Participating Institution licenses its owned Foreground IP to another Participating Institution, it shall do so on equivalent or more favorable terms than those offered to parties other than Participating Institution.
- When a Participating Institution receives a license request for owned background IP from another Participating Institution, the terms, etc., of the license shall be discussed accordingly.
- If discussions regarding licenses between the related parties prove difficult and risk interfering with the commercialization of the Research Outcomes, the Intellectual Property Executive Committee shall coordinate the discussions and endeavor to work out a reasonable solution.
- If the coordination of discussions by the Intellectual Property Executive Committee proves difficult, or if the discussions occur after the Project implementation period has expired and the Intellectual Property Executive Committee has been dissolved, JST may coordinate the discussion regarding licensing.
- If various parties who are competitors are expected to participate, the R&D Representatives may introduce the following arrangements to ensure the competitors can mutually secure a degree of freedom in pursuing their business objectives.

[Examples of Arrangements]

(i) Institutions Eligible for Free Licenses of Foreground IP

- The R&D Representatives shall specify institutions eligible for free licenses for all Foreground IP until the Project implementation period expires, and create a Table of Institutions Eligible for Free Licenses of Foreground IP.
- Institutions eligible for free licenses for Foreground IP must be institutions that have participated in the Project from before the application date for the applicable Foreground IP, and have made significant contributions to the Project. The Table of Institutions Eligible for Free Licenses of Foreground IP shall not be published, and shall be submitted to JST along with the Completion Implementation Report.

(ii) Licensing to Institutions Eligible for Free Licensing

- If institutions eligible for free licensing request a license for Foreground IP designated to be received under a free license, the owner of the Foreground IP

shall provide a free license accordingly.

- The scope and term of the free license shall be discussed between relevant parties (i.e., the Foreground IP owner and the party requesting the license).
- However, if the aforementioned Foreground IP owner is a University, Etc., that cannot work the Foreground IP
- , a license fee may be requested within a reasonable scope.

(iii) Licensing to Participating Institutions other than Institutions Eligible for Free Licensing

- If institutions other than those eligible for free licensing request a license for Foreground IP, the terms, etc., of the license shall be discussed among the relevant parties.

(8) Take-over of Foreground IP Obligations by Transferee

When the Foreground IP is transferred, the Participating Institution shall transfer the obligations associated with the licenses, etc., applicable to the Foreground IP to the transferee. The obligations to be transferred shall be prescribed in the Joint Intellectual Property Agreement.

(9) Response to Changes in Implementation Framework for Project

If a Participating Institution withdraws from the Project, that Participating Institution shall continue to comply with the obligations imposed on it by the Joint Intellectual Property Agreement, but it shall not retain the rights arising during the Project participation period based on the Joint Intellectual Property Agreement.

(10) Validity Term for Joint Intellectual Property Agreements

To ensure there is no interference with the commercialization of the Research Outcomes, a validity term for agreed matters shall be prescribed within the necessary scope and extending beyond the end of the Project implementation period.

(11) Participation by External Institutions

The R&D Representatives may appoint an external institution as a Participating Institution.

External institutions appointed as Participating Institutions shall comply with the relevant Joint Intellectual Property Agreement.

Participating Institutions that wish to appoint external institutions as Participating Institutions shall require the approval of the R&D Representatives.

(12) Review of Joint Intellectual Property Agreement Details

The details agreed among Participating Institutions may be reviewed and renewed based on changes in circumstances. The results of such a review shall be submitted to JST.

#### 8. Promotion of Utilization of Unused Outcomes, etc.

With the aim of maximizing the effects derived from the Research Outcomes, JST or the R&D Representatives may aim to promote the utilization of unused outcomes among findings that can be provided or licensed to third parties (samples, intellectual property rights, etc.). Participating Institutions shall cooperate with activities to promote such utilization.

#### 9. Collective Management of Licensing

When a party appears that requests licenses in bulk, and if the rights holders of the applicable intellectual property agree to the licensing in bulk, the intellectual property owners may issue a free non-exclusive license with sublicense rights to JST, and JST can provide the non-exclusive licenses in bulk, and distribute the corresponding fees to the owners of the applicable intellectual property.

#### 10. Alternative Procedure or Policy to This Basic Policy

However, the provision in the preceding paragraph shall not preclude consideration or adoption of methods deemed to be even more effective from the perspective of actively generating non-continuous innovation that has an economic and social impact in accordance with the purpose and significance of the Policy.

Any implementation of an alternative procedure or policy shall require prior approval of JST and the R&D Supervisor.

#### 11. Revision History

June 2017 Version 1

August 2017 Version 1.1

October 2017 Version 1.2

April 2018 Version 1.3

May 2019 Version 1.4

October 2021 Version 1.5

(Reference)

#### Definitions Used in this Policy

- (1) Intellectual Property Rights shall collectively refer to the following.
  - (i) Patent rights prescribed in the Patent Act (Act No. 121 of 1959) (“Patent Rights”) and the rights to obtain patents.
  - (ii) Utility model rights prescribed in the Utility Model Act (Act No. 123 of 1959) (“Utility Model Rights”) and the rights to obtain utility model registrations.
  - (iii) Design rights prescribed in the Design Act (Act No. 125 of 1959) (“Design Rights”) and the rights to obtain a design registration.
  - (iv) Layout-design exploitation rights prescribed in the Act on Layout-Design of Semiconductor Integrated Circuits (Act No. 43 of 1985) (“Layout-Design Exploitation Rights”) and the rights to obtain registration of establishment of layout-design exploitation right.
  - (v) Breeder's rights prescribed in the Plant Variety Protection and Seed Act (Act No. 83 of 1998) and obtain a variety registration.
  - (vi) Overseas rights equivalent to the ones in (i) to (v).
  - (vii) Copyright prescribed in the Copyright Act (Act No. 48 of 1970) (including all rights prescribed in Articles 21–28) and overseas rights equivalent to the applicable copyright (“Copyright”).
  - (viii) With regard to technology information that is not subject to the rights outlined in (i) to (vii), among technology information that can be kept confidential and has proprietary value, the rights to use information specified by JST and Participating Institutions based on discussion between the two parties (“Know-how”).
- (2) Inventions, Etc., shall refer to the following: (1) in the context of patent rights, the invention; (2) in the context of utility model rights, the device; (2) in the context of design rights and layout-design exploitation rights, the creation; (3) in the context of breeder’s rights, the breeding; and (4) in the context of rights that use Know-how, the concept.
- (3) The Working of Intellectual Property Rights shall refer to the conduct prescribed in Article 2-3 of the Patent Act, the conduct prescribed in Article 2-3 of the Utility Model Act, the conduct prescribed in Article 2-2 of the Design Act, the conduct prescribed in Article 2-3 of the Act on Layout-Design of Semiconductor Integrated Circuits, the conduct prescribed in Article 2-5 of the Plant Variety Protection and Seed Act, and the usage, conduct, and utilization of Know-how based on rights prescribed in Articles 21 to 28 of the Copyright Act.
- (4) Exclusive License, Etc. shall refer to (1) exclusive licenses (including provisional exclusive licenses) for patent rights, utility model rights, or design rights; and (2) exclusive exploitation rights, copyright, or exclusive authorization to use Know-how for layout-design exploitation rights and breeder’s rights.
- (5) Foreground IP shall refer to intellectual property rights pertaining to the Research Outcomes of the Program.
- (6) Background IP shall refer to intellectual property rights acquired before start of the Program or intellectual property rights acquired regardless of the Program after the start of the Program.

(7) Universities, Etc. shall collectively refer to the following research institutions.

- (i) Incorporated educational institutions such as national university, public universities, and private universities
- (ii) Public research institutions such as national and public research institutions, public experimental research institutions, and incorporated administrative agencies.
- (iii) Institutions with a public character such as public interest corporations and institutions recognized byJST.