

Primer on Governing Principles and Policies on Intellectual Property Rights of the University of the Philippines

1.0 Rationale and General Principles

1.1 *Why has the University formulated its own guiding principles and policies on Intellectual Property Rights (IPR)? (Isn't RA 8293, the IP Code of the Philippines, adequate to guide the University in protecting its IPR?)*

The University of the Philippines' original mandate as defined by the First Philippine Legislature Act No. 1870 in the year 1908 was to provide advanced instruction in Literature, the Sciences and Arts and to give professional and technical training. After more than six decades, upon the establishment of the University of the Philippines System In 1972, the important task to serve as a more effective instrument of national development while maintaining its commitment to the pursuit of truth and the highest standard of academic excellence was clearly invoked.

To be an effective contributor to the nation's development, its graduates are prepared, trained and honed to assume leadership in public and private entities priming the engines of growth for national development. Too, university technologies from its researches and other creative endeavors are translated into products, services and processes for the public good.

The University of the Philippines, has now evolved into an academic institution with a large pool of intellectual and creative resources, which encourages and supports research among its faculty, students and staff. Complementary to its pedagogical tasks, the University is engaged in various research activities to expand its stock knowledge thereby enriching its ability to implement its educational programs and to do significant socially responsive extension work.

The University's research activities may result into inventions, materials, designs, technology solutions and related intellectual property which may serve the public good. In many instances, recognition of intellectual property rights may become incentives to further research, ensure accessibility of research output and materials, and increase accountability. Protection of intellectual property rights may also contribute substantial financial resources for the sustainability of the research activities of the University and its various units as well as of the individual faculty, staff or student involved.

On the other hand, the University is also cognizant of its role in providing intellectual output for the public good - i.e. not unduly influenced by the agenda of the current government administration and other commercial as well as private interests. Clearer guidelines on intellectual property rights therefore can result to better protection of the University's constitutionally mandated right to academic freedom as an institution. It can also provide the standards within which to mediate between competing interests of its various constituencies vis a vis the public market at large (i.e. between research collaborators, between faculty adviser and students, between university administration and individual faculty interests et al.)

The "Governing Principles and Policies on Intellectual Property Rights of the University of the Philippines" (UP IPR Policy), approved by the Board of Regents at its 1171st Meeting on 30 May 2003, therefore are based on the current perception by the University constituents of its mission. It is bounded by the constitutional mandate

to maintain the academic freedom of its faculty and of the university as a whole and the provisions of the Intellectual Property Code (Rep. Act No. 8293, 1997) and other laws pertaining to intellectual property rights such as the Plant Variety Protection Act.

Operationally, the UP IPR Policy:

- 1) interprets the Intellectual Property Code in a manner that ensures and maintains the academic freedoms of both faculty and the University;
- 2) provides a more effective and efficient mechanism that will resolve conflicts between research collaborators;
- 3) effectively documents and registers intellectual property rights;
- 4) defines procedures for technology transfers, assignments, licensing and the like; and
- 5) clarifies the relationship of these rules to other related University policies such as those governing conflict of interests.

Incidentally, the protection of “Intellectual Property Rights” (IPR) was an item long ago included in the General Agreement on Tariffs and Trade during the Uruguay Round (1986-94). The rapid internalization of the global economy and of technology has pointed to the problems that result from differing approaches to the protection of intellectual property. Over the years, various international agreements and organizations, including the Berne Convention (1971, literary and artistic works); the Geneva Conventions (1971, phonograms); the Rome Convention (1961, neighbouring rights); the Universal Copyright Convention (1971); the Paris Convention (1979, industrial property); the International Convention for the Protection of New Varieties of Plants (UPOV, 1991); and the World Intellectual Property Organization (WIPO, 1995) have sought to address these differences, with a view to promoting global standards and procedures.

The Uruguay Round Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) successfully consolidates most of these disciplines into a single undertaking, backed up with enforceable dispute settlement measures. The TRIPS Agreement is an attempt to fill the gaps in the way IPRs are protected around the world. It seeks to create common international rules in IPR protection by establishing the minimum levels of protection that each government has to give to the intellectual property of fellow WTO members. The end goal is to strike a balance between the long-term benefits and short-term costs to society of IPR protection.

In fulfillment of its GATT-WTO commitments, the Philippines in June 1997 enacted Republic Act No. 8293 or what is otherwise known as the "Intellectual Property Code of the Philippines".

The University of the Philippines IPR Policy is in line with Article XIV, Section 5, No. 2 of the Philippine Constitution on Academic Freedom; and Article XIV, Sec. 13 on the rights of scientists, artists, inventors and other gifted citizens. However, some of the provisions of the Philippine Intellectual Property Code are not fully applicable to an academic institution.

1.2 *What general principles govern the University's IPR Policy?*

The UP IPR Policy are based upon the following general principles:

- 1) respect for academic freedom,
- 2) cognizance of the public good,

- 3) sustaining a favorable environment for the University's research tradition.

The Governing Principles and Policies on Intellectual Property Rights of the University of the Philippines (UP IPR Policy) have been formulated and are being implemented, enforced and continually reviewed and refined in order to:

- 1) promote and support the University's research function which complements its mandate of instruction and enrichment and expansion of knowledge as an academic institution;
- 2) provide an institutional mechanism for recognition of research output and protection of IPR resources to propel and sustain further research; and
- 3) establish a protocol for resolving competing interests among various constituencies and markets.

1.3 *How is this Primer organized?*

The UP IPR Policy Primer is organized as follows:

- Coverage
 - Copyright
 - What is "Copyright"?
 - Works Covered by Copyright
 - General Policy on Copyright
 - Exceptions: Institutional Works
 - Joint Ownership
 - Waiver by the University of Copyright Ownership
 - Illustrative Cases
 - Patent
 - What is "Patent"?
 - Works Covered by Patent
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 - Other Intellectual Property Rights
 - Trade and Service Marks
 - Proprietary Information
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 - Waivers and Authorities
 - Royalties
 - University Contracts
 - Dispute Resolution
- Penalties
 - Rules of Construction
 - UP Technology Licensing Office (TLO)

- References

2.0 Coverage

Who are covered by the UP IPR Policy?

All University of the Philippines faculty, researchers, administrative personnel, and students, whether permanent or visiting, are covered by the UP IPR policy. Visiting researchers, faculty and students are likewise covered by the UP IPR policy.

3.0 Copyrights

3.1 *What is "Copyright"?*

Copyright is the exclusive and legally secured right to the matter and form of literary, scholarly, scientific and artistic works resulting from intellectual creation, as provided for under the Intellectual Property Code of the Philippines (Chapter V, Sec. 177).

3.2 *What works are covered by Copyright?*

All literary, artistic and derivative works collectively referred to in the UP IPR Policy as "works" (as defined in Sections 172 and 173 of the Intellectual Property Code of the Philippines), including course materials for e-learning and distance education, regardless of format in which it was created or produced, shall be covered by the UP IPR Policy on Copyright. "Work" includes the "Material Object".

3.3 *Who owns the Copyright of a particular work?*

As a general principle under the UP IPR Policy, Copyright of all works shall remain with the creator, except in cases of institutional or collaborative works.

3.4 *What is a copyright owner entitled to?*

A copyright owner is entitled to the following:

- Reproduction of the work or substantial portion of the work;
- Dramatization, translation, adaptation, abridgment, arrangement or other transformation of the work;
- The first public distribution of the original and each copy of the work by sale or other forms of transfer of ownership;
- Rental of the original work or a copy of an audio-visual or cinematographic work, a work embodied in a sound recording, a computer program, a compilation of data and other materials or a musical work in graphic form, irrespective of the ownership of the original or the copy which is subject of the rental;
- The public display of the original or a copy of the work;
- Public performance of the work; and,
- Other communication to the public of the work. [Sections 177, 177.1-177.7 IP Code]

3.5 *What is the "material object"?*

The material object is the original physical form in which the creation/work is rendered.

3.6 *Is copyright distinct from the other property rights over the “material object”?*

The copyright is distinct from the other property rights over the material object. Consequently, the transfer or assignment of the copyright shall not necessarily constitute a transfer of the material object. Nor shall a transfer or assignment of the sole copy or of one or several copies of the work necessarily imply transfer or assignment of the copyright. [Section 181 IP Code]

3.7 *What are Institutional Works?*

Institutional Works include:

- 1) works that are supported by a specific allocation of University funds or other resources other than the usual salary and resources made available to every faculty, student or staff;
- 2) works created at the direction and control of the University through its officials or designates for the purpose of a specific project or purpose;
- 3) works whose authorship cannot be attributed to one or a discrete number of authors (despite the application of the processes prescribed in the UP IPR Policy; and
- 4) works whose authorship cannot be attributed to one or a discrete number of authors because it is the result of simultaneous or sequential contributions over time by multiple authors.

The University shall have exclusive ownership of copyright in case of institutional works.

3.8 *How does the University deal with unauthorized use of University resources for personal gain?*

As a punitive measure, the University shall claim Copyright of unauthorized works, created through substantial use of University resources such as libraries, research facilities, buildings, utilities, equipment, tools and apparatus, including services of its employees working within the scope of their activities not for University purposes but for the personal gain or advantage of the faculty, research staff or student involved.

3.9 *Is Joint Ownership in Copyright with the University possible?*

Yes. If the work is the result of collaborative efforts between the University, outside entity and the creator(s), absent any contractual stipulation to the contrary, the copyright shall belong in joint ownership between the University, the creators and the outside entity.

3.10 *How is authorship determined in cases of contributed efforts?*

Determination of Authorship in Cases of Contributed Efforts - In cases of work resulting from the contribution of efforts coming from different persons, authorship, whether sole or collaborative, shall be determined as follows:

- 1) by stipulation in the research contract;
- 2) by application of the rules for joint, primary and sole authorship as determined by a publication for which the work was intended;
- 3) through alternative modes of dispute processing including mediation and arbitration to be facilitated by the Vice-Chancellor for Academic Affairs if the

work originated from the efforts of faculty, research staff and students in a single Constituent University or by the Vice-President for Academic Affairs if otherwise.

3.11 *May the University waive Copyright ownership?*

Yes. In case of institutional works and works in joint ownership with the University, the University through its designated officials, may waive copyright in favor of the creator if:

- 1) it would enhance the transfer of technology or improve the access of the works by the public in general;
- 2) it does not violate any existing contractual obligation to third parties; and
- 3) the participation of the University in the work is acknowledged by the creator in all publications of the work, whether local or international.

Also, in the event that the University fails or decides not to publish or exhibit a work within one year from its disclosure, its copyright is automatically waived in favor of the creator. The one-year period may also be waived by the University at the request of the creator if the work is to be published in a reputable international or local journal relevant to the academic discipline to which the work belongs. In all cases, the contribution of the University shall be duly acknowledged in all publications or exhibitions of the work.

3.12 *Is a computer program protected under the IP Code?*

Yes. A computer program is considered “work” under the IP Code and is protected from the moment of its creation. [Section 172.1(n)] The Intellectual Property Code of the Philippines defines a ‘computer program’ as “a set of instructions expressed in words, codes, schemes or in any other form, which is capable when incorporated in a medium that the computer can read, of causing the computer to perform or achieve a particular task or result.” (Sec 171.4. IP Code of the Philippines).

ILLUSTRATIVE CASES

3.13 *For instance, the University commissioned Painter X, a freelance painter, to produce a painting of the incumbent University president.*

What is the ‘material object’ or ‘work’?

The ‘material object’ or ‘work’ is the painting of the incumbent university president, unless the commissioning contract stipulates otherwise.

Who owns the painting and the copyright thereto?

The university shall own the material object (painting) while the copyright thereto would remain with Painter X, unless the commissioning contract stipulates otherwise. The IP Code provides, “In case of a work commissioned by a person other than an employer of the author and who pays for it and the work is made in pursuance of the commission, the person who so commissioned the work shall have ownership of the work, but the copyright thereto shall remain with the creator, unless there is a written stipulation to the contrary. [Section 178.4 IP Code]

- 3.14 *The University again commissioned Painter X to produce a painting of the façade of the Administration building. The contract stipulated that the copyright shall wholly belong to the University.*

Who owns the material object and the copyright?

The university shall own the material object and the copyright since there is a contractual stipulation pertaining to the ownership of copyright, i.e., contrary to the general rule that the copyright shall belong to the author of the work.

By owning the copyright to the painting, what rights may be exercised by the University, against Painter X and the rest of the world?

The University has exclusive right to carry out, authorize or prevent the following acts:

- Reproduction of the work or substantial portion of the work;
- Dramatization, translation, adaptation, abridgment, arrangement or other transformation of the work;
- The first public distribution of the original and each copy of the work by sale or other forms of transfer of ownership;
- Rental of the original work or a copy of an audio-visual or cinematographic work, a work embodied in a sound recording, a computer program, a compilation of data and other materials or a musical work in graphic form, irrespective of the ownership of the original or the copy which is subject of the rental;
- The public display of the original or a copy of the work;
- Public performance of the work; and,
- Other communication to the public of the work. [Sections 177, 177.1-177.7 IP Code]

- 3.15 *Mr. X is employed by the University as Information Technology Officer at the UP Computer Center. He was contracted by the University to write three (3) Linux Training Modules, the payment of which was chargeable against the UP System Administration Excess Income. The contract does not stipulate on ownership of work and copyright. Who owns the work and copyright?*

Since the work was supported by a specific allocation of University funds or other resources other than the usual salary and resources made available to every faculty, student or staff, (chargeable against the UP System Administration Excess Income) it is considered an “institutional work”. As such, the University shall have exclusive ownership over the work. [Article 4(2)(b) of the UP IP Guidelines]

- 3.16 *Prof. X is given a Creative Work Grant entitled “Semi-kalbo at Iba pang Kwentong Scifi”, with specific allocation of university funds. Who owns the work and copyright?*

Since the work was supported by a specific allocation of University funds or other resources other than the usual salary and resources made available to every faculty, student or staff, it is considered an “institutional work”. As such, the University shall have exclusive ownership over the work. [Article 4(2)(b) of the UP IP Guidelines]

- 3.17 *During the semester, Prof. X, a faculty at the computer science department, develops a software program that processes student registration for the University. Who owns the computer program and the copyright thereto?*

If the work was not specifically commissioned by the University, Prof. X shall own the computer program and the copyright thereto.

- 3.18 *Prof. Y, faculty of the National College of Public Administration and Governance, UP Diliman, enters into a commissioned work through a research agreement with Z Foundation, a private non-stock non-profit organization. The research agreement is silent on the ownership of the work and copyright. Who owns the work and the copyright?*

Since there is no stipulation pertaining to the ownership of the work and copyright, Z Foundation shall own the work and Prof. Y shall own the copyright thereto. In the case of a work commissioned by a person other than an employer of the author and who pays for it and the work is made in pursuance of the commission, the person who so commissioned the work shall have ownership of the work, but the copyright thereto shall remain with the creator, unless there is a written stipulation to the contrary. [Section 178.4 IP Code]

- 3.19 *A student wants to publish a book based on her Master's thesis in history, to be sold to the public. Can the University claim the compensation as co-owner of the work?*

No. The work belongs to the student because it is the result of her intellectual creation.

- 3.20 *A faculty member writes a book not for University purposes and without the benefit of a contract. The book was produced using University research funds, facilities and equipment, and involved related work assigned by said faculty member to a University-employed research assistant. To whom does the work belong?*

Absent any contractual stipulation to the contrary, the University shall claim copyright over the work. The book shall be construed as unauthorized work created through substantial use of University resources, not for University purposes but for personal gain or advantage of the faculty member involved.

- 3.21 *A Creative Writing student writes a novel as part of the academic requirements for an English course. Who shall own said novel?*

The student shall own the work because it is the result of her intellectual creation.

- 3.22 *In an elementary physics course, a faculty member assigns a research problem on electroplating to a student group. The faculty member provides the project prerequisites, design and methods of research. The group subsequently decided to publish the result of their research. Who owns the copyright to the research output?*

Absent any contractual stipulation to the contrary, the case falls under contributed efforts where authorship shall be determined by application of the rules for joint, primary and sole authorship as determined by the publication for which the work was intended.

4.0 Patent

- 4.1 *What is "Patent"?*

Patent is an intellectual property right granted to an inventor by the government through its appropriate agency (Intellectual Property Office of the Philippines). This

right gives the grantee the opportunity to exclude others from making, using or selling the invention for a limited period from the date of filing the application. This period of exclusivity is granted in exchange for the inventor's disclosure of the details of invention so that others may seek improvements or new uses. Thus, the inventor has monopoly control of the invention and the society also gains through the further advancements that may be made on the technology (Chapter VIII, Sec. 71)

4.2 *What works are covered by Patent?*

All inventions which may be or may relate to a product, process, or an improvement of any of the foregoing, that is new, involves an inventive step, is industrially applicable, including utility models and industrial designs, referred to in the UP IPR Policy as "inventions" shall be covered by the rules on patent.

4.3 *In the University, to whom does Patent of a particular work belong?*

As a general principle under the UP IPR Policy, the right to patent for all works created with substantial use of University resources shall belong to the University. Nevertheless, the sharing in revenues derived from the licensing or transfer of patents on the works of UP personnel shall be as in No. 6.4, below.

4.4 *What constitutes "substantial use of University resources"?*

"Substantial Use of University Resources" is a matter that can be established on a case-to-case basis. (For example, making a single local call through the University telephone system does not constitute substantial use of University resources.)

4.5 *What are "Commissioned Inventions" and who shall own them?*

Commissioned inventions are:

- 1) inventions that are supported by a specific allocation of University funds or use of other University resources;
- 2) inventions produced at the direction and control of the University in pursuit of a specific project or purpose regardless of the source of funding;
- 3) works whose inventorship, despite the application of processes provided in the UP IPR Policy, could not be attributed to one or a discrete number of inventors; and
- 4) those that may be stipulated by contract as commissioned inventions. The University shall own all commissioned invention.

Disclosure and Assignment - Creators of commissioned inventions should disclose and assign the patent to these works to the University in accordance with the IPR Policy and the implementing guidelines which may be promulgated by the President of the University.

4.6 *Why is there a difference in the presumption of ownership in copyright as compared with patent?*

The difference lies in the fact that the University is expected to generate ideas which are copyrightable, while it is not created to make inventions, the subject of patents.

4.7 *When is Patent required to be assigned to the University?*

Regardless of the source of funding, patents to the following inventions shall be assigned to the University:

- 1) those conceived or first reduced to practice by employees, faculty or students in the University in the course of the performance of their duties;
- 2) those created through substantial use of University resources such as libraries, research facilities, buildings, utilities, equipment, tools and apparatus, including services of its employees, as well as visiting researches and students, working within the scope of their employment.

4.8 *Is Joint Ownership of Patent with the University possible?*

Yes. In the case of work resulting from the collaborative efforts of the University, an outside entity and the creator(s), involving substantial use of University resources, the patent may belong in joint ownership among the University, the creator(s) and the outside entity, only with the prior written consent of the University.

4.9 *How is inventorship determined?*

The identification of inventorship, whether sole, primary or joint, shall be determined as follows:

- 1) by contractual stipulation;
- 2) by application of the rules and standards of a publication primarily intended by the collaborative effort;
- 3) by alternative modes of dispute processing including mediation and arbitration to be facilitated by the Vice-Chancellor for Academic Affairs if the persons contributing their efforts belong only to one Constituent University or by the Vice-President for Academic Affairs if otherwise.

4.10 *How shall the University handle inventions funded by outside entities?*

In the event that the funding for the research and creation of the invention is sourced by the University, wholly or partially, from outside entities, the University shall negotiate with the funding entity with respect to the ownership of the invention, patent rights and royalty sharing subject to confirmation by the Board of Regents. The agreement shall bind all parties including the inventors. In default of a negotiated agreement all patents to inventions the research funds for which was sourced from or by the University shall be owned by the University.

4.11 *May the University waive its Rights to Patent?*

Yes. In the absence of existing contractual obligations to third parties, the University may release patent rights to inventors if:

- 1) the University elects not to file a patent application and the inventor is prepared to do so. It shall be presumed that the University elects not to file a patent application if no application is filed one year after the disclosure of the invention or from the time that the University is reasonably presumed to have known of its existence.
- 2) the waiver would facilitate the transfer of technology or its access to the general public.
- 3) the equity of the situation clearly indicates that such release should be given.

No waiver shall be given unless there is a written commitment by the inventor that no further development of the invention shall be made involving the financial support or resources of the University nor shall any waiver be made in violation of any contractual obligation of the University.

4.12 *When is a waiver on patent not allowed?*

No waiver shall be given unless there is a written commitment by the inventor that no further development of the invention shall be made involving the financial support or resources of the University nor shall any waiver be made in violation of any contractual obligation of the University.

ILLUSTRATIVE CASES

4.13 *Prof. Z with his graduate students, using the facilities of the University laboratories, re-agents, computers, computer programs, experimental garden plots, equipment, communication, photocopying facilities, libraries, internet access, etc., developed a biological control product for the control of nematode pests attacking roots of vegetables, e.g., tomato, eggplant, ampalaya, and fruit crops, e.g., banana, citrus, etc. Since the product is deemed to have significant commercial potential if licensed to agricultural supply companies, the University and Prof. Z deemed it important to patent the product. Who owns the patent to the biological control product?*

The University shall own the patent to the biological control product since there was substantial use of University resources. The UP IP Code provides that, “regardless of the source of funding, patents to the following inventions shall be assigned to the University: those created through substantial use of University resources such as libraries, research facilities, buildings, utilities, equipment, tools and apparatus, including services of its employees working within the scope of their employment”. [Article 5 Section 3(c)]

4.14 *An investor demands exclusivity in licensing a University-patented invention with a manufacturer. Is such an arrangement allowable under the UP IPR Guidelines?*

No. Article 7 (Common Provisions) Sec. 3 (Use of copyright, patents and other intellectual property rights of the University) of the Governing Principles and Policies on Intellectual Property Rights of the University of the Philippines (UP IPR Policy) states that pursuant to its public function, the University shall not enter into exclusive licensing arrangements, nor shall the University enter into any kind of contractual arrangement that would deter the public in general from having reasonable access to the works or inventions.

4.15 *An investor funds the pilot testing for a University-developed technology. Since the pilot run involves substantial use of third-party financial resources, the funder wants to enter into a contract with the University that would provide for the investor's exclusive ownership of patent as well as the investor's exclusive licensing of the technology. Are such arrangements allowable under the UP IPR Guidelines?*

No. Article 7 (Common Provisions) Sec. 3 (Use of copyright, patents and other intellectual property rights of the University) of the Governing Principles and Policies on Intellectual Property Rights of the University of the Philippines (UP IPR Policy) states that pursuant to its public function, the University shall not enter into exclusive licensing arrangements, nor shall the University enter into any kind of contractual arrangement that would deter the public in general from having reasonable access to the works or inventions. Article 5 (Patents) Sec. 8 (Collaborative Efforts Between

Institutions) further states that if the work is the result of collaborative efforts of the University, an outside entity and the creator/s, the copyright shall belong in joint ownership among the University, the creator/s and the outside entity.

5.0 Other Intellectual Property Rights

5.1 What are the other types of Intellectual Property Rights?

- a. Trade and Service Marks - Trade and service marks are distinctive words or graphic symbols long associated with the University (e.g. Oblation, UP Seal, etc.) registered by the University with the Intellectual Property Office (IPO). The University shall own trade or service marks relating to goods or services distributed by the University. These include names and symbols used by the University in conjunction with its computer programs or University activities and events.
- b. Proprietary Information - Proprietary information which includes information arising from University work. These include processes which may fall under the concept of "trade secrets".
- c. Tangible Research Property (TRP) - or research results which are in a tangible form (i.e. integrated circuit chips, computer software, biological organisms, engineering prototypes) which cannot be the subject of any other kind of Intellectual Property protection are presumptively considered as owned by the University. All TRPs may not be used by outside parties without the consent of the University. In no case shall biological material in any form be the subject of patents or any form of acquisition.

5.2 What are the exceptions to IPR?

Public Domain - Proprietary information such as proposed terms of research agreement, and financial agreements shall be covered by existing rules relating to the constitutional duty of a state university to public disclosure.

5.3 Are research information in processes part of public domain?

Research information and processes used for academic purposes shall be presumptively considered as part of the public domain and shall not be considered as "trade secrets", except when:

- 1) necessary in order to pursue an academic research project to its completion;
- 2) the information is necessary in order to protect intellectual property rights of the University on an invention;
- 3) upon the determination of the President, circumstances are such that well-defined interests of the general public will better be protected by temporarily claiming legal protection of research processes as "trade secrets".

6.0 Common Provisions

6.1 What are the common provisions that govern University IPR?

The common provisions that govern University IPR are as follows:

- a. Waivers and Authorities
- b. Royalties

c. University Contracts

6.2 *Who has the authority to waiver?*

Except in cases of failure to publish or failure to file an application for a patent, all waivers of ownership of intellectual property rights shall be confirmed by the Board of Regents upon recommendation by the President of the University.

6.3 *Who has the duty to determine compliance to the UP-IPR?*

Except in cases of failure to publish or failure to file an application for a patent, all waivers of ownership of intellectual property rights shall be confirmed by the Board of Regents upon recommendation by the President of the University.

The President or the Chancellors shall periodically report to the Board of Regents Intellectual Property Rights owned by the University which have been impliedly or unintentionally waived immediately upon their discovery, in order that the Board of Regents may be guided in laying down appropriate policies to prevent similar mistakes, oversights and lapses in the future.

6.4 *How shall royalties be shared?*

In the absence of contractual stipulations to the contrary, royalties derived from institutional works, commissioned inventions, patents and other Intellectual Property of the University shall be shared by the University with the authors or inventor(s) as follows:

- 1) One-third (1/3) of the net income shall be given to the University.
- 2) One-third (1/3) of the net income shall be given to the constituent unit from where the author or inventor(s) originated.
- 3) One-third (1/3) of the net income shall be given to the author(s) or inventor(s).

This is without prejudice to such policies or arrangements that the constituent unit may have with respect to sharing its proportion of the net income with the department(s) or unit(s) from where the author(s) or inventor(s) originated.

6.5 *What is net income?*

Net income shall mean gross income less applicable taxes.

6.6 *Who will shoulder the other expenses?*

All other expenses such as administrative costs, filing fees, costs relating to the production, distribution, advertising, maintenance, and similar expenses of the work or invention shall be for the account of the University and shall be taken from its share in the royalty income.

6.7 *How are royalties shared among joint authors?*

Joint authors or inventors shall share equally in the royalties.

6.8 *What are the basic provisions of all University research contracts in accordance with the UP IPR Policy?*

All contracts for research, regardless of source of funding, should provide for the means for determination of authorship or inventorship in accordance with the UP IPR Policy. No allocation of research funds from the University shall be made in cases of works to be produced by collaborative efforts until and unless the provisions for ownership of copyright and ownership of resulting tangible materials including processes for settling disputes on ownership shall be clearly provided in a contract.

7.0 Dispute Resolution

7.1 What mechanisms for dispute resolution does the IPR Policy provide?

a. Determination of authorship in cases of contributed efforts

In case of works resulting from the contribution of efforts coming from different persons, authorship, whether sole or collaborative, shall be determined as follows:

- 1) by stipulation in the research contract;
- 2) by application of the rules for joint, primary and sole authorship as determined by a publication for which the work was intended;
- 3) through alternative modes of dispute processing including mediation and arbitration to be facilitated by the vice chancellor for academic affairs if the work originated from the efforts of faculty, research staff and students in a single constituent university or by the vice president for academic affairs if otherwise. No dispute pertaining to authorship of any work shall be referred for legal action unless any one of these processes have been availed.

b. Identification of inventorship as a result of collaborative efforts

The identification of inventorship, whether sole, primary or joint, shall be determined as follows:

- 1) by contractual stipulation;
- 2) by application of the rules and standards of a publication primarily intended by the collaborative effort;
- 3) by alternative modes of dispute processing including mediation and arbitration to be facilitated by the vice chancellor for academic affairs if the persons contributing their efforts belong only to one constituent university or by the vice president for academic affairs if otherwise. No dispute pertaining to inventorship of any work shall be referred for legal action unless any one of these processes have been availed.

7.2 How is authorship in cases of contributed efforts determined?

In the case of works resulting from the contribution of efforts coming from different persons, authorship, whether sole or collaborative shall be determined as follows:

- a. By stipulation in the research contract;
- b. By application of the rules for joint, primary and sole authorship as determined by a publication for which the work was intended; or

Through alternative modes of dispute processing including mediation and arbitration to be facilitated by the Vice Chancellor for Academic Affairs, if the work originated from the efforts of faculty, research staff and students in a single

constituent university, or by the Vice-President for Academic Affairs if otherwise. [Article 4 (6) UP IP Guidelines]

In case of conflict, may it be referred for legal action?

Yes but only in the event of failure of these modes of dispute resolution may a conflict pertaining to the authorship or copyright of a work be referred for legal action. [Article 4(6)(b) UP IP Guidelines]

8.0 Penalties

What penalties shall be imposed for violation of the UP IPR Policy?

In addition to penalties which may arise from the violation of any other law or university policy or guideline, any persons found to have violated any of the provisions of these guidelines shall suffer the following penalties:

- 1) ineligibility from receiving research funds from the university or any of its affiliated foundations for a period not to exceed five years;
- 2) automatic removal of research load credits and ineligibility to receive these benefits for a period not to exceed five years;
- 3) disqualification and/or removal from any university administrative position for a period not exceeding five years;
- 4) ineligibility for outside teaching activities of the privilege to practice profession for a period not exceeding five years.

The foregoing shall be without prejudice to such penalties, liabilities, or charges under existing contracts and agreements.

9.0 Rules of Construction

What are the "Rules of Construction" set forth in the UP IPR Policy?

The UP IPR Policy stipulates that nothing in these rules shall be construed:

- 1) to prevent university administration from implementing rules relating to the enforcement of academic standards such as plagiarism and dishonesty;
- 2) to alter existing university policy affecting conflict of interest including guidelines for outside teaching activities or practice of profession;
- 3) to limit the University's ability to negotiate and to meet obligation for deliverables under any contract, grant, or other arrangements with third parties, including sponsored research agreements, collaboration agreements, license agreements and the like if these terms are more beneficial to meet the purposes and principles of these guidelines;
- 4) to limit the interpretation of the Code of Ethics for Faculty as approved by the Board of Regents during its 1129th meeting on 25 February, 1999;
- 5) to interfere with the discretions of editorial boards, textbook committees and the like to publish works.

10.0 Technology Licensing Office

10.1 *What unit or office in the University of the Philippines is tasked to administer and implement the UP IPR Policy?*

The Technology Licensing Office (TLO) under the Office of the Vice President for Development shall spearhead the technology licensing activities of the University.

The Vice President for Development through the chancellor may request for assistance from any department or unit of the university that can provide expert advice on any trade or discipline that will be the subject of any patent application, litigation, evaluation of the commercial value of the work or invention or any aspect of the work or the Technology Licensing Office.

10.2 *What are the functions of the Technology Licensing Office?*

The TLO shall have the following functions:

- 1) Supervise the disclosure of works created and inventions conceived or first reduced to practice by all university personnel;
- 2) Facilitate the execution of agreements, affidavits, applications, complaints and other documents relating to works and inventions necessary to facilitate the university's intellectual property rights;
- 3) Coordinate with the appropriate legal office of the UP System or any of its constituent universities in order to request for the filing of cases to ensure the university's intellectual property rights;
- 4) Register copyrights and patents with the Intellectual Property Office (IPO) on behalf of the university;
- 5) Evaluate the commercial potential of the works and or inventions and negotiate contracts for its production, distribution and marketing;
- 6) Monitor the progress of royalty payments;
- 7) Review and settle disagreements that may arise from royalty distribution or sharing in accordance with the provisions of these guidelines;
- 8) Negotiate with university personnel with respect to the development of independently owned technologies after a determination of its commercial potential for the potential use of university resources for purposes of registration, licensing or joint venture arrangements;
- 9) Review and recommend, upon consultation with the appropriate units of the constituent universities, appropriate intellectual property policies for the university, including possible legislative initiatives in this area;
- 10) Undertake activities in coordination with the constituent universities such as workshops and symposia to familiarize UP personnel with these guidelines as well as to continually solicit feedback on its directions and implementation.

10.3 *Who has the jurisdiction to prosecute and defend actions relating to the University's Intellectual Property Rights?*

The Office of Legal Services of the UP System and the Legal Offices of the Constituent Universities shall have sole jurisdiction to prosecute and defend actions relating to the university's intellectual property rights. Legal interpretations of the University General Counsel of constitutional, statutory and university regulations shall be binding on the university unless overturned by the President of the University or the Board of Regents.

10.4 *Who has the jurisdiction to lobby or advocate for any possible executive issuance or legislation?*

The Office of the Vice President for Public Affairs shall continue to have jurisdiction to lobby or advocate for any possible executive issuance or legislation.

References

1. Intellectual Property Code (Republic Act No. 8293)

2. The Revised Code of the University of the Philippines
3. Governing Principles and Policies on Intellectual Property Rights of the University of the Philippines
4. Agreements on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) (1994), World Intellectual Property Organization (WIPO)
5. 1987 Philippine Constitution