

USEK Technology Transfer Office Rules and Procedures Guidelines

Introduction and general provisions

Article 1. Objectives

- 1.1. The Technology Transfer Office (herein the TTO) at the Holy Spirit University of Kaslik (USEK) operates under the umbrella of the DP for Research. Its main objective is ensuring the development of USEK innovative research and discoveries by facilitating collaborations with entrepreneurial and industrial networks through licensing, sponsorship, and new ventures.
- 1.2. The TTO also provides a procedure to resolve disputes regarding IP ownership and conflicts of interest.
- 1.3. The TTO supervises all agreements signed by USEK or USEK affiliated entities with third parties related to Intellectual property or Transfer of technology.

Article 2. Applicable laws and interpretation guidelines

- 2.1. The TTO abides by the USEK Intellectual Property policy. The TTO Guidelines are to be read and interpreted consistently with the USEK Intellectual Property Policy, including the definition of the used terms and expressions.
- 2.2. The TTO also abides by applicable Lebanese laws and regulations, as well as international conventions related to Intellectual property.
- 2.3. Wherever the word “*technology*” is used in these guidelines, it refers to both Industrial property and Copyright.

Article 3. Composition of the Technology Transfer Office (TTO)

- 3.1. The TTO is composed of a director and at least three staff members.
- 3.2. Staff members are of two categories:
 - Experts in IP Law and/or Entrepreneurship, industry and business.
 - Administrative support
- 3.3. The director and staff members of both categories are appointed and repealed by an Act of the President of USEK.
- 3.4. The director can designate an assistant director among the staff members of the TTO. He can designate a member of the TTO as a project manager.

Article 4. Duties of the TTO

- 4.1. TTO members must disclose any conflict of interest, existing or potential.
- 4.2. TTO members are required to preserve the confidentiality of the technology they come to know about as part of their work, before the technology is patented or legally protected.

- 4.3.The TTO must organize periodical trainings and workshops for its staff. TTO staff are obliged to attend the trainings and workshops organized for them.
- 4.4.The TTO will organize sensibilization and visibility campaigns among USEK to familiarize USEK community with its actions, and to foster better communication between USEK Schools and offices, and the TTO.
- 4.5.The TTO can negotiate and implement cooperation agreements with national and/or international Technology transfer offices from universities or other institution, within the larger framework of USEK.
- 4.6.The TTO can join any national or international associations or networks of Technology Transfer entities
- 4.7.The TTO will present an annual report about its activities to the DP for Research?

Article 5. Internal Procedure

- 5.1.The Director of the TTO decides on the modus operandi of the office. He calls for and directs meetings and decides about matters related to the internal functioning of the TTO.
- 5.2.The TTO can ask for the assistance and expertise of USEK Faculty members or external experts and professionals.

Procedure of technology transfer

The general process for technology transfer passes through the following phases, but not necessarily through all of them:

Article 6. Disclosure of technology

6.1.Duty of Disclosure

- 6.1.1. Inventors, subject to the provisions of section 3 of the USEK IP policy, must disclose to the TTO the technology they conceive or reduce to practice as soon as practicable after the date of first conception or discovery.
- 6.1.2. If the delay in disclosure resulted in prejudice to the patenting procedure, the concerned inventor, subject to section 3 of the USEK policy, will be responsible toward the University and reimburse recurrent expenses.
- 6.1.3. Creators, subject to the provisions of section 3.9 of the USEK IP Policy, must disclose to the TTO their project in a timely manner.
- 6.1.4. Inventors and creators must keep record of their disclosure and update it as necessary.
- 6.1.5. USEK Faculty members shall provide the TTO, for its review and comment, a draft copy of any proposed publication or presentation relating to or stemming from any research activities conducted by them within the scope of their employment relationship with USEK at least thirty (30) days in advance of submission for publication or presentation. In case the publication or presentation contains confidential information

or patentable applications, the TTO can request an extension of the delay for 60 days for the purpose of removing confidential Information and/or filing patent applications in the appropriate jurisdiction.

6.2.Procedure of submission

- 6.2.1. The inventor or the creator fills and signs a Disclosure Form workflow submitted to the TTO, in which he describes the technology, and provides all necessary information such as funding sources, names of co-inventor(s) or co-creator(s), any public disclosures or publications, and especially the department which supported the development of the invention or creation (cf. Section 5 of the USEK IP Policy).
- 6.2.2. The Disclosure forms are given a number and date of registration and kept at the TTO. They shall remain confidential until they are legally protected.
- 6.2.3. Disclosure can also take the form mentioned in paragraph 6.1.5 above.

Article 7. Evaluation of the disclosure by the TTO and decision

7.1.Evaluation process and critters

- 7.1.1. The Director of the TTO will review the Disclosure Form and will set up a meeting with the researcher within 2 weeks from the submission of the disclosure form. The TTO must reach its decision within 60 days from the submission of the Disclosure form.
- 7.1.2. In case of an incomplete disclosure, the TTO will require of the researcher any missing or additional information related to the disclosure.
- 7.1.3. The Office internally evaluates the disclosure for:
 - its patentability, according to applicable laws, in case of patentable material;
 - its potential commercial value;
 - its clarity and completeness.
- 7.1.4. The TTO, in evaluating the technology, can seek the assistance of relevant USEK Faculty members, USEK's attorney, patent attorney or any other professional.

7.2.Evaluation decision

- 7.2.1. Depending on the results of the evaluation, the Director of the TTO will decide :
 - to proceed with acquiring patent protection, if the invention is patentable and commercially valuable, or any other kind of legal protection.
 - or, to transfer intellectual property rights in the technology to the research sponsor, if the research agreement requires it;

- or, to waive ownership in the technology, and in this case, provisions of section 9.10 of the IP Policy might apply if the President gives his approval, upon the assessment of the TTO.
- 7.2.2. The TTO notifies its motivated decision to the President of USEK, and to the inventor or creator in a period of 5 working days starting the day of the decision.
- 7.2.3. The decision of the TTO may be appealed according to article 16 of the present guidelines.

7.3. Duty of confidentiality prior to obtaining the legal protection

- 7.3.1. Once the decision to proceed with the legal protection is notified, the inventor or creator must refrain, directly or indirectly, by himself or by others, from any publicity, publication or disclosure concerning the invention until patent applications have been filed, in order not to jeopardize the rights to patent protection, nationally or internationally (cf. Section 3.3 of the USEK IP Policy). The inventor or creator who infringes this obligation will be liable to disciplinary sanctions.
- 7.3.2. Inventors and creators are invited to sign and submit Non-Disclosure Agreements even if it is not mandatory (cf. Section 6 of the USEK IP Policy).
- 7.3.3. Inventors or creators concerned about advertent disclosure must notify the TTO in order to assess and take proper measures.

7.4. Transfer of material

- 7.4.1. Inventors are invited to transfer their non-commercial property to USEK or any other institution or person designated by USEK.
- 7.4.2. In case the TTO decides to patent the invention, it will evaluate the need of signing a Material Transfer Agreement with the inventor(s) according to section 4.2 of the USEK IP Policy.
- 7.4.3. Material Transfer Agreements are necessary when they involve human material and/or concern ethical matters. Researchers are required to comply with the Code of Ethics of USEK and to obtain all necessary authorizations from USEK's IRB.
- 7.4.4. Failure of any person to sign a MTA shall not affect USEK's rights under the IP policy.

Article 8. Obtaining the legal protection for the technology

8.1. Choice of the legal protection

- 8.1.1. As stated in 9.1.1 above, when the TTO decides to proceed with the legal protection process, it chooses the most adapted and most efficient form of legal protection, taking into consideration the nature of the technology (industrial property or copyrighted

material), the cost factor, the commercialization prospects of the technology and other relevant factors.

- 8.1.2. In case the technology can be protected by more than one form of legal protection, the TTO will choose the most efficient form, or pursue both forms if they are compatible.
- 8.1.3. The TTO may seek the assistance of expertise from USEK Faculty members or external experts.
- 8.1.4. The choice of the form of legal protection must be approved by the President.

9.2.Procedure

- 9.2.1. The TTO will initiate the procedure to obtain the legal protection (patent or other forms) within 30 days after the approval decision.
- 9.2.2. The TTO will prepare the necessary documents for the pursuit of the patent. It may seek assistance from other USEK offices, faculty or staff. The completed documents shall be submitted to the President or his designee for signature.
- 9.2.3. The University will file the application through the TTO office, or through its attorney, or by contracting with an IP management agency, taking into consideration the best interests of the University.
- 9.2.4. According to section 3.2 of the USEK IP policy, the inventor will always have his name on the patent irrespective of the rights of IP ownership, except for Sponsored Research Agreements where the University will always retain the status of inventor.
- 9.2.5. USEK, through the TTO, will assume all necessary costs for the patenting procedure, patenting fees, legal fees, and the yearly annuities when applicable.

9.3.If USEK does not proceed to protect the technology in a timely manner, and in case the inventor or creator requests the reassignment of the ownership according to section 9.10 of the IP Policy, the TTO will evaluate the situation in light of the best interest of the public, and will assess the extent of the reassignment. In such case, the inventor must reimburse USEK of all the expenses fees and annuities (when applicable) related to the patenting procedure.

Article 10. Assessment and Marketing

10.1.Marketing prior to Licensing to external actors

- 10.1.1. In case USEK decides to license the technology to third parties, it may conduct a non-confidential marketing of the technology.
- 10.1.2. The TTO will decide about the best ways to conduct this non-confidential marketing of the technology over a period of 4 months after its patenting, to ensure fair and open access to potential licensees.
- 10.1.3. The TTO can ask for the assistance of other USEK offices and can contract with external actors to this end.

10.1.4. The TTO will avoid disclosing the invention's details during the marketing period.

Article 11. Licensing

11.1.Licensing of Patents and other IP Rights

11.1.1. The TTO will decide on granting an exclusive licensing agreement depending on what is most suitable for achieving a successful commercialization of the IP and for the best benefit of the public.

11.1.2. The TTO will take into consideration the specialization, capability, expertise, and resources of potential licensees as well as the potential benefit granted to USEK in terms of research opportunities and royalty payments. In all cases, the TTO will negotiate to secure the optimal deal for USEK.

11.1.3. The TTO will decide on the procedure of licensing the patent to external actors: competitive solicitation, or direct selection of the licensee.

11.1.4. All licensing agreements negotiated by the TTO must be signed by the University President.

11.1.5. All licensing agreements should mention USEK's rights to monitor the licensee's business for compliance with USEK's by-laws and regulations, especially the IP Policy.

11.1.6. The TTO will evaluate the necessity of signing an outgoing Material Transfer Agreement with the licensee.

11.2.Competitive solicitation

11.2.1. If the TTO decides to resort to a competitive solicitation, provisions of section 9.2 of the IP Policy, and section 16 of the TTO guidelines will be respected.

11.2.2. The TTO will strive to conduct the competitive solicitation in the most transparent and equitable way.

11.2.3. The TTO will select the candidate licensee according to USEK's best interest, and according to the terms of the competitive solicitation.

11.3.Direct negotiation

11.3.1. Instead of a public competitive solicitation, the TTO might decide to negotiate directly with a determined licensing candidate for a commercial partnership.

11.3.2. The TTO will evaluate the candidate based on the criteria laid out in § 17.2 above.

11.3.3. The TTO will take into account the opinion of the inventor or creator and will make sure there is no conflicts of interest between the licensing candidate and the inventor or creator.

11.4.Direct Commercialization by USEK

11.4.1. USEK may decide to commercialize the technology itself or through affiliated actors. The TTO will send a report to the President in which it determines the availability of

funds to pursue the operation, the costs of the operation, legal risks, and other pertinent information, with a recommendation to pursue the commercialization internally or to license it to external actors.

- 11.4.2. USEK may commercialize the technology through a legal entity created and fully owned by it; or through a spin out, a start-up or any legal entity created by USEK and the inventors or creators (Associated company).
- 11.4.3. In case of an associated company (cf. §10.1 of the USEK IP Policy) formed by inventors with basic support from USEK, the TTO will negotiate on behalf of USEK, with the inventors, the distribution of dilutable equity, starting at a minimum of 50/50 between the inventors and USEK.
- 11.4.4. The TTO will play an advisory role during the creation of the above-mentioned entities (drafting of by-laws and other documents).
- 11.4.5. The TTO retains a control right over the entities created by USEK and/or USEK affiliated inventors and creators during the commercialization of the technology.

Article 12. Commercialization

12.1. Monitoring of commercialization

- 12.1.1. During the commercialization phase, the University, through the TTO, retains its right to monitor the licensee's business development and compliance to the USEK IP Policy, to other USEK fundamental texts, and to the licensing agreement itself.
- 12.1.2. In case the TTO observes any actions or behavior or statements from the licensee that do not comply with the Licensing agreement or the USEK IP Policy or other fundamental texts, it will file a report to the President.

12.2. Withdrawal of copyrighted material

If the University deems that a copyrighted material owned by it, has become obsolete or inappropriate, it can ask for its withdrawal by the licensee, in consultation with the author.

Article 13. Provisions related to Sponsored research Agreements (SRA)

13.1. Provisions related to Technology Transfer in the SRA

In case of a sponsored research, the sponsoring agreement must detail the extent of implication of the sponsor in the technology transfer process, from disclosure to commercialization. The terms of the negotiated SRA will prevail over USEK IP Policy provisions.

13.2. Absence of provisions related to Technology transfer in the SRA

- 13.2.1. In the absence of an agreement between USEK and the sponsor over the transfer of technology, the following provisions will be applicable: (cf. Section 3.4 of the USEK IP policy)
- 13.2.2. The University retains the status of inventor.
- 13.2.3. The University retains the ownership over the technology, unless negotiated otherwise.

13.2.4. Disclosure of the technology by the research should be also submitted to the sponsor's designated representant.

13.2.5. The Sponsor's designated representant joins the TTO in evaluating the technology for its commerciality.

13.2.6. Income distribution is negotiated between the TTO and the Sponsor.

Conflict resolution

Article 14. General competency of the TTO

14.1. The TTO is the competent authority to interpret the provisions of the USEK IP Policy and the TTO guidelines, in case of any conflict related to them.

14.2. The TTO is the competent authority to apply the provisions of the USEK IP Policy and the TTO guidelines, and to resolve all conflicts arising from their application.

14.3. The TTO is the competent authority to determine ownership of IP produced by University Researchers, Faculty, Staff, Students and Associates, according to the USEK IP Policy provisions, and for resolving disputes arising from this ownership.

Article 15. Ownership Disputes

15.1. Filing an Ownership dispute request

15.1.1. Inventors or creators who question a TTO decision regarding the ownership of a technology, shall submit their request to the Director of the TTO within 30 days starting the date of issuance of the decision.

15.1.2. The request shall be in a written form, and must include the facts, arguments, demands and all necessary documents.

15.1.3. If the dispute is between researchers among themselves, they are encouraged to reach an amical resolution. Their agreement should be written and signed by them and submitted to the President for approval.

15.2. Procedure to solve ownership disputes

15.2.1. The TTO will review the complaint and issue its decision about the ownership in a reasonable delay, not longer than two months.

15.2.2. The TTO is not bound by a formal procedure yet will strive to respect the basic principles of transparency and contradictory.

15.2.3. The TTO decides ownership dispute cases according to the USEK IP policy, especially section 3; to the TTO guidelines and to all applicable laws and regulations.

15.2.4. In order to decide the case, the TTO may use all kinds of evidence, and ask for the expertise of USEK faculty members or external experts and professionals.

- 15.2.5. If the TTO decides that a third party has a right in the ownership, it will notify the third party and negotiate the percentages of respective inventorship and/or ownership, in the best interest of the University, and pending the approval of the President.
- 15.2.6. The TTO submits its final decision to the President for approval. After the President's approval, the decision will be notified to the plaintiff and the Provost.
- 15.2.7. The decision, the minutes of the sessions and all documents produced in the dispute shall be archived in the TTO.
- 15.2.8. Until the dispute is resolved, the technology will be managed as though the University owns the copyright.

Article 16. Appeal of TTO decisions

- 16.1. Decisions of the TTO may be appealed within 30 days starting the day of their issuing before the DP for Research, who will assign an ad-hoc committee to look into the appeal.
- 16.2. The ad-hoc committee must be formed of an odd number of specialists and experts in the field of IP and Industry.

Article 17. Conflicts of interest

17.1. Disclosure of Conflicts of interest

- 17.1.1. According to § 9.3 of the USEK IP Policy, the TTO will review any actions to prevent potential conflicts of interest, chiefly between USEK Faculty members, staff and students, from one side, and the licensee from another side.
- 17.1.2. Researchers, inventors, creators, associates, and other stakeholders must disclose to the TTO any situation of conflict of interest, even if potential or perceived, related to the licensing and commercialization of the technology. The disclosure of conflict of interest must be submitted to the Director of the TTO.
- 17.1.3. Researchers, inventors, creators, students, associates, and other stakeholders who conduct at the same time, any activity at USEK and at the licensee (whether a third party, or a USEK affiliated entity), must disclose to the TTO the information required by § 9.5 of the USEK IP Policy:
- How they will manage the separation between their contractual or academic duties from work being conducted for their associated companies.
 - The measures that will avoid the use of the University resources for the purpose of their associated companies though this will be properly regulated in the licensing agreement.
- 17.1.4. In executing its mission stated in § 9.3 of the USEK IP Policy, the TTO is not only bound by the disclosures submitted by the concerned researchers, but can look out for potential conflicts of interest by all means, and can be informed of such conflicts by third parties.

17.2.Management of Conflicts of interest by the TTO

17.2.1. The TTO assess the disclosures of conflict of interest to evaluate whether there is indeed a conflict of interest.

17.2.2. In case the TTO finds there is a conflict of interest, it applies the provisions of section 9 of the USEK IP Policy, and takes the necessary measures to insure transparency, and independence of research. It may take or recommend the following measures:

- Separation of activities of the researcher between USEK and the licensee.
- Reduction of commitment of the researcher in USEK activities.
- Exclusion from decision making whether at USEK or the associate company or the licensee.

17.2.3. The TTO may make any other suitable arrangement in conformity with section 9 of the USEK IP Policy.

Article 18. Final Provisions

18.1.All documents submitted to the TTO are registered, given a number and date and filed at the TTO.

18.2.The correspondence from and to the TTO is achieved via emails.

18.3.Submission of required forms can be made online through appropriate workflows.

18.4.All decisions of the TTO must be notified to the DP for Research and the Director of the Higher Center of Research.

18.5.All agreements to be passed by USEK related to Intellectual property and Technology transfer must be assessed by the TTO before they are signed by the competent authorities.

18.6.The TTO will regularly recommend to the competent authorities in USEK the modifications it sees fit to the USEK IP Policy and to the TTO Guidelines, in order to keep these texts practical, functional and up-to-date.