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GUIDELINE 2.7 OF 2019

GUIDELINES FOR THE OPERATION OF THE INTELLECTUAL PROPERTY FUND

Guideline 2.7 of 2019 is in operation according to the following time lines and with the following submission deadlines:

	ACTIVITY	TIMELINE/DEADLINE
PERIOD OF APPLICATION		
1.	Period of application of Guideline 2.7 of 2019	IP protection and maintenance costs incurred during the review period ¹ of: 1 April 2018 to 31 March 2019
CLAIM PERIOD²: 2019/20 FINANCIAL PERIOD		
2.	Application for a rebate for IP protection and maintenance costs incurred during the review period 1 April 2019 to 31 March 2020	30 July 2019
3.	Cost projections for IP protection and maintenance costs during the period 1 April 2019 to 31 March 2020	30 August 2019

¹ See definition in Appendix A: Glossary of Terms

² See definition in Appendix A: Glossary of Terms

Lefapha la Saense le Thekenoloji • uMnyango wezeSayensi neTheknoloji • Muhasho wa Saints na Thekinoodzhi • Departement van Wetenskap en Tegnolgie • Kgoro ya Saense le Theknolotshi • Ndzawulo ya Sayense na Theknoloji • LiTiko leTesayensi ne Theknoloji • iSebe lezeNzululwazi neTeknoloji • UmNyango wezeSayensi neTheknoloji

1. STRUCTURE OF THE INTELLECTUAL PROPERTY FUND

1.1 Legislative mandate

Section 13(1) to (3) of the IPR Act states:

“There is hereby established an Intellectual Property Fund to be managed by NIPMO.

The purpose of the Intellectual Property Fund is to –

- (a) **provide financial support** to institutions for the statutory protection and maintenance of intellectual property rights.....*

*An **institution** may recover the costs incurred in obtaining statutory protection for the intellectual property contemplated in this Act from the Intellectual Property Fund –*

- (a) to the extent determined by NIPMO; and*
- (b) **on such terms as may be determined by NIPMO.**”*

Furthermore regulation 13(1) and (2) of the IPR Act reads as follows:

*“NIPMO must develop **appropriate policies and procedures** for the effective implementation of the Intellectual Property Fund to ensure that the objects of the Act are met.*

*NIPMO must, in accordance with the objects of the Act, determine the operations of the Intellectual Property Fund, **subject to availability of funding from National Treasury.**”*

1.2 Scope of the Intellectual Property Fund

Financial support will thus be provided for a range of activities which secure IP rights (IPR) for IP which was **generated following publicly financed research and development (R&D) or associated directly with the product, process and/or service which resulted from R&D**. Such IPR includes patents, plant breeders' rights, designs and trade marks, and applications for such rights.

NIPMO may, in turn, grant the rebate when it is satisfied that the granted or pending IPR, for which the rebate is claimed, was generated following R&D conducted using public funds.

2. REQUIREMENTS TO QUALIFY FOR A REBATE FROM THE IP FUND

2.1 *The application for a rebate from the IP Fund*

The requirements for an application for a rebate from the IP Fund are set in Annexure B.

2.2 *The date of creation of the intellectual property*

The intellectual property (IP) must have been created after 2 August 2010. The IP must have been disclosed to NIPMO (see Practice Note 5.1 of 2018) and hence have a corresponding IP7 reference number. Finally, the application or grant number (or similar) for which the invoice has been raised must have already been provided during the biennial IP status update period (for example, if the invoice is for PCT application IB/2016/XXXXXX then this number must have already been provided to NIPMO during a previous biannual reporting period).

2.3 *The claimant for a rebate from the IP Fund*

The claimant must be the institution directly, or the institution's office of technology transfer (OTT) or a designated person or existing structure within the institution that has been formally designated by the institutions' executive to undertake the responsibilities of the OTT in respect of the IPR Act and the regulations thereto.

2.4 *Ownership of IP*

a) *The owner of the IP*

The institution or its OTT (or the wholly owned subsidiary performing the OTT function) must be recorded as the applicant, co-applicant, assignee, co-assignee, patentee or co-patentee (similarly for breeders or proprietors) for all pending and registered IP at the relevant IP registration office.

The IP will not qualify for a rebate from the IP Fund if, for example:

- a current employee or previous employee of the institution is recorded as the sole applicant, assignee or patentee and the institution is also not cited as an applicant, assignee or patentee;
- the IPR belongs to the institution as per an agreement, however, the assignment has not been recorded at the relevant IP registration office; and/or

the IPR is in the process of being assigned to the institution and the institution is responsible for making payments for the protection and maintenance costs, however, the assignment has not been finalised during the relevant period during which the costs are incurred. If the IP is assigned during the review period and reflects at the relevant IP registration office, then any IP protection and maintenance costs incurred during the remainder of the review period will qualify for a rebate. For example, if the review period is 1 April 2018 to 31 March 2019 and assignment takes effect at the IP registration office on 31 October 2018, then all costs incurred between 31 October 2018 and 31 March 2019 may be claimed for in the 2019/20 claim period. Supporting documentation to verify the date assignment was recorded at the IP registration office must be provided.

b) Co-ownership

In the instance where an institution is recorded as a co-applicant, co-assignee or co-patentee (similarly for breeders' or proprietors), supporting documentation should be provided stipulating the percentage of ownership each institution has to the IPR. Accordingly, where the IPR are co-owned by two or more institutions, the institution(s) **must** provide the following:

- Proof to the satisfaction of NIPMO of the percentage of ownership that each institution has to the IPR. The proof may be in the form of a signed agreement between the institutions which indicates the percentage of ownership each institution has to the IPR.
- Where an institution fails to provide satisfactory proof of its percentage of ownership of the IPR, NIPMO will conclude that the IPR are equally shared by the institutions i.e. the institutions each own fifty percent (50%) of the share in the IPR. NIPMO will accordingly grant a rebate based on each institution's share in the IPR. In the case where an institution has misrepresented its percentage of ownership of the IPR, and it later transpires that NIPMO has granted a rebate based on such misrepresentation, the institution will be required to pay back to NIPMO any funds which were incorrectly allocated to it.

NIPMO is granted discretion as to the percentage rebate when IP is co-owned between two or more institutions, in terms of the IPR Act, and particularly when one party is acting in bad faith.

c) Spin out companies

If IPR are recorded at the IP registration office under the name of a spin-out company that is wholly/partly owned by the institution and the institution is

responsible for making payments for the protection and maintenance costs, then that IP will qualify for a rebate under the following conditions:

- the percentage rebate is dependent on the percentage shareholding of the spin out company held by the institution. For example, if the institution holds 70% of the shares in the spin out company, then the institution will qualify for a 35% rebate (i.e. 50% of the 70% shareholding relationship) for the IP prosecution and maintenance costs incurred in question; and
- supporting documentation indicating the percentage shareholding in the spin out company held by the institution must be submitted in support of the application.

3. ELIGIBLE/NON-ELIGIBLE COSTS FOR A REBATE

3.1 *Eligible Costs*

For the purpose of qualifying for a rebate from the IP Fund, costs which are regarded as statutory protection and maintenance costs include:

- a. **Search costs** (including novelty and freedom to operate searches);
- b. **IP attorney fees** (or the like) for drafting the application, filing the application (international or national application), preparation of any formal documents required during filing and/or subsequent prosecution (including an assignment or a power of attorney), and for prosecuting the application to grant (including a correction or amendment; receiving, preparing and responding to an official action, translation fees, validation of a granted application; and all related foreign associate fees and patent office official fees);
- c. **Renewal/maintenance** fees; and
- d. **Overhead charges** (for example, printing, faxing, telephone etc) incurred by the service provider and reflected on their invoice for services rendered.

3.2 *Non-eligible Costs*

The following costs do not qualify as IP protection and maintenance costs for IP generated following a R&D activity using public funds and **cannot** be claimed from the IP Fund:

- a. **Salaries and consultant's fees** (with the exception of IP attorney or consultant fees for drafting and prosecution);
 - b. **Market** reviews;
 - c. **Business** plans;
 - d. Costs incurred during **litigation and opposition** proceedings;
 - e. Company **name searches** and related objections;
 - f. IP protection and maintenance costs which have been borne by a party other than the institution (for example, other public funding bodies or other third parties including a licensee);
 - g. Overhead charges (for example, printing, faxing, telephone etc) incurred directly by the institution;
 - h. **Value Added Tax (VAT)**;
 - i. Fees incurred for the **late** payment of renewal/maintenance costs;
 - j. Drafting of **research collaboration agreements**;
 - k. Trade marks and domain names which are not associated with an R&D activity (for example, trademarks or domain names not associated with products resulting from patents/inventions or plant breeder's rights); and
 - l. **Defensive company names.**
- These lists are not exhaustive. NIPMO reserves the discretion to decide whether a cost falls within either category, namely eligible or non-eligible, bearing in mind the scope and structure of the IP Fund and the mandate of NIPMO as the implementing office of the IPR Act.

4. GENERAL

4.1 *Cost projections*

Each institution must provide NIPMO with realistic cost projections, for NIPMO budgetary purposes, in respect of the IP protection and maintenance costs for which they intend to submit an application for a rebate in the following claim

period. These projections must be prepared in consultation with your service provider (typically your IP attorney(s)).

Failure to provide realistic cost projections may result in your application not been considered by NIPMO in the period under review.

4.2 Over/Under-payments

NIPMO will inform all institutions of under-payments or over-payments made in the previous financial period. NIPMO will then reimburse or deduct the relevant amount along with the rebates paid out in the following financial period. If the institution does not apply for rebate in two consecutive years then the amount due will be settled in the review period in which an application is submitted.

Please do not hesitate to contact Ms Paballo Phiri (paballo.phiri@nipmo.org.za; 012 844 0266) should you have any questions with regards to any matter in these guidelines.



DR KERRY FAUL
HEAD: NIPMO
DATE: 15 April 2019

5. APPENDIX A: GLOSSARY OF TERMS

“benefits”	This term is defined to mean “contribution to the socio-economic needs of the Republic and includes capacity development, technology transfer, job creation, enterprise development, social upliftment and products, or processes or services that embody or use the intellectual property.”
“Claim period”	The financial period during which the application for a rebate from the IP Fund is submitted to NIPMO, for example, the claim period is the 2019/20 financial period for a review period of 1 April 2018 to 31 March 2019. “Claiming period” shall have the same meaning.
“Commercialisation”	This is defined in section 1 of the IPR Act to refer to “the process by which any intellectual property emanating from publicly financed research and development is or may be adapted or used for any purpose that may provide any benefit to society or commercial use on reasonable term; and commercialise(d) shall have a corresponding meaning”.
“IP”	Intellectual Property.
“IP creator”	This is defined in section 1 of the IPR Act to mean “the person involved in the conception of intellectual property in terms of this Act and identifiable as such for the purposes of obtaining statutory protection and enforcement of intellectual property rights, where applicable”
“IPF1 Form”	This term refers to the IP Fund application form, which is populated by claimants when applying.
“Pre-IPR Act”	This term refers to all IP generated, following a research and development activity conducted using public funds, prior to 2 August 2010.
“NIPMO”	National Intellectual Property Management Office.
“not exhaustive”	This term is used to indicate that the list of examples provided is not a complete list and further examples may exist that are equally applicable.
“OTT”	Office of Technology Transfer.
“R&D”	Research and Development.
“research and	This is defined in section 1 of the IPR Act to refer to “research

development using public funds”	and development undertaken using funds allocated by a funding agency but excludes funds allocated for scholarships and bursaries.”
“Review period”	The period during which IP protection and maintenance costs are incurred, for which a rebate will be requested in the next financial period (i.e. the claim period). For example, the review period would be 1 April 2018 to 31 March 2019 and the corresponding claim period 2019/20.
the “IPR Act”	Refers to the Intellectual Property Rights from Publicly Financed Research and Development Act, Act No 51 of 2008. The “Act” shall have the same meaning.

6. APPENDIX B: THE APPLICATION

- a) Each institution applying for a rebate from the IP Fund must submit **one** consolidated application on NIPMO's Knowledge Management System (KIM).
- b) Each institution applying to NIPMO for a rebate through KIM must ensure that the application is submitted by authorized personnel within the TTO.

i) A completed application

The application as populated on KIM must be accompanied by **supporting documents** [(ii) and (iii) below] and the reports set out in (iv), (v) and (vi).

ii) A copy of the invoice for which a rebate is claimed

The invoices indicating clear service for which the invoice was for. Where the IPR are co-owned by two or more institutions, the invoice must clearly show whether the payment represents:

- The full invoice amount paid to the service provider; or
- The full invoice amount in relation to the institution's share in the IPR (for example, the invoice may include the words "Your 50% share").

iii) A supplier payment history report

This report is a financial system printout indicating the exact date for which an eligible payment was made to the service provider (for example, a portable document format ("pdf") print out with the institution's logo or official stamp signed off by the necessary financial authority with the appropriate delegated accountability should be provided.

Alternatively, NIPMO will also accept the following to verify the date on which payment was made:

- Bank statements – institutions may supply copies of bank statements indicating the date on which payment was made (in addition the claim number corresponding with each payment must be clearly indicated on the copy of the statement); or
- Accept/Reject reports – this report indicates the date on which the electronic payment transfer was made by an institution's finance department for a specific claim.

iv) Report of the benefits for society of IP from publicly financed research

Section 5(1)(j) of the IPR Act states that “*A recipient must, in respect of an institution, put in place mechanisms to annually assess, record and report to NIPMO on the benefits for society of publicly financed research conducted in that institution.*”

All applicants for a rebate from the IP Fund are required to provide, as part of their application, a report on the benefits (see definition in Annexure A) to society of publicly financed research.

v) Report of benefit sharing with IP creators

Section 10(1) of the IPR Act mandates benefit sharing with IP creators and states as follows “*Intellectual property creators at an institution and their heirs are granted a specific right to a portion of the revenues that accrue to the institution from their intellectual property in terms of this Act until such right expires.*”

All applicants for a rebate from the IP Fund are required to provide, as part of their application, a report on the benefit sharing with IP creators (see definition in Annexure A) that took place during the review period.

vi) Report of acknowledgement of support received from NIPMO

NIPMO must be acknowledged in all publicity associated with commercialised IP for which financial support was provided through the IP Fund. An annual report of all instances where NIPMO has been publicly acknowledged must be included with the submitted application form. We recommend that an excerpt(s) where NIPMO has been acknowledged is prepared in a consolidated document.

[END]