

2 Intellectual Property Rights

This is the second in a set of five guidance notes aimed at supporting research institutions with limited access to research contracting expertise in negotiating the terms of collaborative research contracts.



COHRED
Council on Health Research for Development

INTELLECTUAL PROPERTY (IP) refers to creations of the mind, such as inventions, original literary and artistic works, designs and symbols, names and images used in commerce. Intellectual property rights (IPRs) are legally recognised exclusive rights to IP. Common types of IPRs include patents, copyrights, industrial design rights, trademarks, trade dress and trade secrets.

Intellectual property can be complex, and is often viewed as a specialised field. IP can also be highly valuable, enabling people to earn recognition or financial benefit from what they invent or create. It is important that this area is directly engaged with,

as deciding how ownership of the inputs and outputs of collaborative research are most fairly distributed is critical for a solid, successful partnership. The risks and benefits for all parties with respect to the available IPRs needs to be addressed up front in the formal contract, to avoid conflict downstream.

All partners should therefore ensure that they have a level of awareness about IP and IPRs in general, and how they relate to the specific research proposal at hand. If at all possible, the advice of an external expert should be sought concerning contractual terms that relate to IPRs.

▶ KEY QUESTIONS TO CONSIDER

- What legislation and policies will influence **how the IP is managed** (for example, if your partnership is cross-country, whose national legislation will govern the protection and enforcement of the IPRs) and are there any international laws and treaties that your country subscribes to that will aid the enforcement and protection of the IPRs where there is no national legislation to assist?
- Have you considered which jurisdictions the IPRs should be protected in? (IPRs are jurisdictional in nature)
- Has the **nature and purpose of the research** been identified and described?
- Have the **interests of all parties** been discussed upfront, such as the acquisition of IPRs, benefit sharing and the risks associated with IP?
- Is there any **existing IP (background IP), anticipated IP (foreground) or new unanticipated IP (side ground)** coming from the project? How will these be disclosed, if necessary, discussed and rights agreed?
- Has ensuring equitable downstream access to the outputs of the research endeavour been discussed?
- Have you familiarised yourself with a template contract, and identified the kinds of terms which will be negotiated?
- Have you discussed who will own the various types of IP, including the possibility of exclusive ownership with a royalty-free license?
- How will the various types of **IP be protected** (i.e. will there be rights and responsibilities inferred over owners of the IP)? Who is responsible for securing protection, maintenance of rights (payments of annuities) and enforcement of rights?
- Are there **cost implications** for the acquisition and protection of IPRs and who will be responsible for covering these costs?
- What **mechanisms** (for example, availability of technology transfer office, research or legal offices) are needed to manage all aspects relating to IP (such as dispute resolution procedures described in the contract in the instance where a dispute over IP arises)?



The Donald Danforth Plant Science Center (Danforth Center) is a not-for-profit research institute with a global vision to improve the human condition through plant science. Their best practice model is based on respect for protection of IPRs, inter-institutional and international collaborations and scientific partnerships. Their philosophy, entrenched in their overall mission, is not to infringe or misuse the IPRs or materials entrusted to them. This is evidenced in the way they draft agreements.

▶ KEYWORDS

BACKGROUND IP

is IP generated before the research collaboration.

FOREGROUND IP

is IP generated during the research collaboration.

SIDE GROUND IP

is IP generated during the research collaboration, but not directly connected to the project objectives.

COPYRIGHT

is a legal concept that gives the creator of an original artistic work the exclusive rights to its use and distribution.

A PATENT

is a set of exclusive rights granted to an inventor for a limited time in exchange for disclosure of the invention. It must meet certain patentability criteria such as novelty and inclusion of an 'inventive step'.

REGULATORY DATA PROTECTION

is the protection of (clinical trial) data which has been submitted to a regulatory authority for the purposes of marketing approval, from 'unfair competition'.

A TRADEMARK

is a recognisable sign that is used as a marketing tool for consumers to distinguish one kind of goods or service from another.

WHERE TO GO FOR ADDITIONAL HELP

- Andanda, P. (2008). Human Tissue Related Inventions: Ownership and Intellectual Property Rights in International Collaborative Research in Developing Countries. *Journal of Medical Ethics*, 34(3), 171-179. <http://psychology.ukzn.ac.za/Libraries/publications/9.sflb.ashx>
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- Krattiger, A. et al. (2007) *Intellectual property management in health and agricultural innovation: A handbook of best practices*. MIHR: Oxford, U.K., and PIPRA: Davis, U.S.A. www.ipHandbook.org
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- WIPO (2004). *Intellectual property handbook: Policy, law and use*. Geneva: WIPO. <http://www.wipo.int/about-ip/en/iprm/>
- WIPO (n.d.). *A brochure on intellectual property rights for universities and R&D institutions in African countries*. Geneva: WIPO. http://www.wipo.int/export/sites/www/freepublications/en/intproperty/849/wipo_pub_849.pdf
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- Zhao, M. (2006). Conducting R&D in Countries with Weak Intellectual Property Rights Protection. *Management Science* 52(8), 1185-1199. <http://www.jstor.org/discover/10.2307/20110593?uid=3738032&uid=2129&uid=2&uid=70&uid=4&sid=21103761425671>

See also <http://www.cohred.org/FRC> where you will find a useful guidance tool on developing and implementing guidance on research contracting, entitled: Where there is no lawyer: Guidance for fairer contract negotiation in collaborative research partnerships.

▶ TIPS

- It is important to negotiate, at the outset, between research collaborative partners, issues and expectations relating to IP before it is formalised into a contract.
- Know that a fair research contract includes the apportionment of benefits as well as risks.
- Understand your IPRs and responsibilities.
- Understand the different kinds of IP which are involved, and be prepared to negotiate IPRs.
- Get educated about the international and national legal frameworks and institutional policies around aspects relating to IP.
- Be clear about what you are contributing to the partnership, even if it is non-monetary.
- Seek external support and capacity, where possible, to facilitate fair negotiation of IP issues in the research partnership. Secure access to professional knowledge from established institutional offices, perhaps in neighbouring countries, such as technology transfer, research and innovation or legal offices where it involves issues of Intellectual Property, contracting or research collaborations. Recognise the need to take tailored guidance, wherever possible. There are *pro bono* legal networks who may be able to review your contract and your questions, such as the network of Public Interest Intellectual Property Advisors (PIIPA). <http://www.piipa.org>

QUOTE FROM A CONSORTIUM MEMBER



"Intellectual property should be viewed as a toolbox from which collaborating researchers can freely pick the specific tool that suits their needs."

PROFESSOR PAMELA ANDANDA, ASSOCIATE PROFESSOR OF LAW, UNIVERSITY OF THE WITWATERSRAND

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FEEDBACK

This is the first version of this guidance note, and we constantly strive for improvement. In the next phase, we will be transforming these generic guides into a web-based decision support system. We would be pleased to receive your feedback, comments or suggestions for further improvement to these guides, or for the future of this project, to cohred@cohred.org

