

1 Intellectual Property Rights

This is 1st in a set of 5 guidance notes aimed at supporting low capacity research organisations in negotiating the terms of a collaborative research contract with a better capacitated partner.

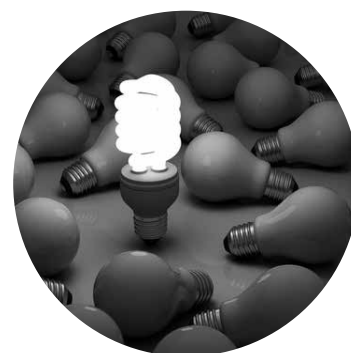
INTELLECTUAL PROPERTY can be complex, and is often viewed as a specialist field. Despite this it is important that this area is directly engaged with, as deciding how ownership of the inputs and outputs of collaborative research are most fairly distributed is critical for a solid, successful partnership. The risks and benefits for all parties with respect to the available intellectual property rights (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 it at all possible, the advice of an external expert should be sought concerning contractual terms

► KEY QUESTIONS TO CONSIDER

1. Has the nature and purpose of the research been identified and described?
2. Have the interests of all parties been discussed upfront, such as the acquisition of IP rights, benefit sharing and the risks associated with IP?
3. Is there any existing IP (background IP), anticipated IP (foreground) and new unanticipated IP (side ground) from the project?
 - How will these be disclosed (if necessary) and discussed and rights agreed?
4. Has ensuring equitable downstream access to the outputs of the research endeavour been discussed?
5. Have you familiarised yourself with a template contract, and identified the kinds of terms which will be negotiated?
6. Have you discussed who will own the various types of IP, possibly exclusive ownership with royalty-free license?
7. Who and how will the various types of IP be protected (i.e. will there be rights and responsibilities inferred over owners of the IP)?
8. Is there a need for confidentiality or privacy agreements over the IP?
9. Are there cost implications for the acquisition and protection of IP rights and who will be responsible for covering these costs?
10. Have you considered which jurisdictions the IP rights should be protected in? (IP rights are jurisdictional in nature)
11. 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 arise)?
12. 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 IP rights) and are there any international laws and treaties that your country subscribes to that will aid the enforcement and protection of the IP rights where there is no national legislation to assist?



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 IP (intellectual property) rights, inter-institutional and international collaborations and scientific partnerships. Their philosophy, entrenched in their overall mission, is not to infringe or misuse the IP rights or materials entrusted to them. This is evidenced in the way they draft agreements. Accessible via <http://www.iphandbook.org/handbook/ch17/p10/>

▶ KEYWORDS



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.

CREST Expert Group on IPR (2006). CREST cross-border collaboration decision guide.

Hagedoorn, J., Cloudt, D. & van Kranenburg, H. (2005) Intellectual property rights and the governance of international R&D partnerships. *Journal of International Business Studies*, 36: 175-186

Mahoney, L. Nelson et al. (Eds.) *Intellectual property management in health and agricultural innovation: A handbook of best practices* (pp. 675-687). MIHR: Oxford, U.K., and PIPRA: Davis, U.S.A. (See www.ipHandbook.org)

Lambert Toolkit for university-industry collaboration: <http://www.ipo.gov.uk/lambert> (in high income settings)

Ramsden, P. (2011). *A guide to intellectual property law*. Cape Town: Juta & Co. Review, 11, Article 5.

Simons, J.J. (1999). Cooperation and coercion: The protection of intellectual property in developing countries. *Bond Law Swiss Commission for Research Partnership with Developing Countries, Guidelines for Research in Partnership with Developing Countries, 1998*, see principle 9.

WIPO (2004). *Intellectual property handbook: Policy, law and use*. Geneva: WIPO.

WIPO (n.d.). *A brochure on intellectual property rights for universities and R&D institutions in African countries*. Geneva: WIPO.

WIPO (n.d.). *Guidelines on developing intellectual property policy for universities and R&D organizations*. Geneva: WIPO.

Zhao, M. (2006). Conducting R&D in Countries with Weak Intellectual Property Rights Protection. *Management Science* 52(8): 1185-1199.

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 IP rights and responsibilities;

Understand the different kinds of IP which are involved.

Get educated about the international, national legal frameworks and institutional policies around aspects relating to IP.

While a partner may be dependent on external funding (in most instances from high-income funders), a low- or middle-income is free to negotiate IP rights unconditionally.

Be clear about what you are contributing to the partnership, even though it may be 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, 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. For example 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

We would value your feedback, comments or suggestions on whether this guidance note has been useful to you. Contact: cohred@cohred.org