

IP Clauses, Ownership, Joint Ownership, MoU's

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Typical Tech Transfer Agreements

- Non-Disclosure Agreement (NDA)
- Materials Transfer Agreement (MTA)
- Option Agreement
- License Agreement
- Assignment
- Joint Invention Administration Agreement (JIAA)
- Research and Option Agreement
- Sponsored Research Agreement (SRA)

Ownership within Organizations

- NDA with R & D staff
- Signing of confidentiality agreements from students/contract researchers
- Rights generally rests with the parent /funding organizations
- Options of Waiver

MoU

- Each party bearing its own research costs (academic research)
- Parties sharing costs/resources
 - Parties receiving funds from national funding agencies(Government bilateral programs)

Broad Structure of MoU

- *Scope of work* to be conducted
- Management and staffing of the research project
- Schedules and deliverables
- Publication of the research results
- Care of data and confidential information exchanged during the research
- Transfer of materials among the collaborating organizations
- Agreement to formalize an agreement about administration of IP out of the collaborative research.
- Compliance with export control and other laws and regulations
- Rights and procedures to terminate the project
- Taxes, insurance, warranties, liability, governing law, and other items necessary for contracts

License Agreement

- Technology licensed to a company for product development and sale
- Licensing rights are either **exclusive** or **non-exclusive**
- Paybacks include upfront fee, annual minimum royalty, running royalty on net sales, equity, milestone payments

IP related clauses - Licenses

- **Exclusive or Non-Exclusive Rights**
 - Limited by geography, application
- **Patent Prosecution**
 - Research institute prosecutes patent applications
 - Licensee pays for patent expenses
- **Patent Infringement**
 - Licensee is responsible for suing infringers
 - Research institute gets a share of any damages

Assignment vs. License

Assignment

- Change in ownership of patent
- Cannot be terminated by notice; the new owner needs to sign off on a legal document to return the rights to the original owner
- Upon commercialization, the original owner may not receive credit/recognition
- In the USA, assignment is not applicable to government funded inventions; however, in India, assignment is practised
- No obligation to develop technology or launch product

License

- No change in ownership of patent
- Can be terminated by providing notice
- Upon commercialization, the licensor receives recognition
- Can be practised freely in India and the USA
- Licensee is obligated to develop the technology and launch a product

Sponsored Research Agreement

- Research is sponsored by company at a university or research institute
- The scope of the project and deliverables are well defined
- The sponsor is granted the **first right of refusal** on any new inventions created during the course of the project
- The university or the research institute retains the right to publish and file patent applications, while keeping the sponsor in the loop

IP clauses - SRA

- **Disclosures**

- Reporting disclosures and election to manage IP
- Confidentiality

- **Ownership**

- Solo IP
- Joint IP
- Background IP
- Project IP
- Tangible Research Property (TRP)
- Knowhow

Sample Clauses

DEFINITIONS

- 1. Background means all confidential information and intellectual property rights owned by a Party other than Foreground and contributed to the collaborative project hereof. A list of the Parties' background is provided in annex [...] to this agreement;
- 2. Foreground means any inventions, improvements and other innovations relating to [a subject matter], developed by either Party in connection with the collaboration project hereof and all confidential information and intellectual property rights therein.

IP related clauses – SRA

- **Patent prosecution**
 - Administration
 - Filing and Expenses
- **License rights**
 - Right of First Refusal
 - Assignment
- **Copyright**
 - Right of first refusal
 - Ownership
 - License rights

OWNERSHIP OF INTELLECTUAL PROPERTY RIGHTS

- 1. Each Party retains exclusive property of its background.
- 2. The modifications to or derivative works of the Parties' background shall be the sole property of the contributing party.
- 3. Foreground developed in connection with the collaboration project hereof shall be jointly owned in equal shares by Parties.
- [sample clauses]




Joint Invention: Clauses

- Declaration of all the back ground IP by both the parties
- Scope of the project/research work covered under agreement
- Patent Prosecution
- Prosecution Cost sharing
- Know-how rights
- Confidentiality
- Publication rights
- Lead for commercialization
- Benefit/Reward sharing between collaborative organizations

Check list

- Assignment of shares
- Conditions of use
- Condition of exploitation
- IP protection and maintenance
- IP monitoring and infringement
- Governing law and jurisdictions







Employee Invention Report (EIR)

Employee Discovery and Invention Report (NIH, FDA)	
Employee Discovery and Invention Report (CDC Only)	
Additional Contributor Document	

Confidential Disclosure Agreement

Confidential Disclosure Agreement	 
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Inter-Institutional Agreements

NIH-University (NIH Lead)	 
NIH-University (University Lead)	 
NIH-University Patent Cost Sharing	 

License Application

Development Stage

- Any -

Technology

- Any -

Agency/Institute

- Any -

Collaboration Sought

- Any -

RESOURCES

- [Forms & Model Agreements](#)
- [Fellowships](#)
- [International Mentoring](#)
- [Internship](#)
- [Online Training](#)

You are here: [IITB & Industry](#) -> [Appendix 2](#) -> [Research Agreement Template](#)

APPENDIX 2 RESEARCH AGREEMENT TEMPLATE

This Agreement is made and entered into as of _____ by and between _____ a Company incorporated under the Companies Act 1956 and having its office at _____, hereinafter referred to as "COMPANY", of the FIRST PART,

AND

Indian Institute of Technology, Bombay, a research and educational institution in technology and engineering disciplines established by a special act of Parliament of Republic of India having its office at Powai, Mumbai-400 076, India, hereinafter referred to as 'IITB', of the SECOND PART.

Company and IITB are collectively referred to herein as 'Parties'.

Whereas Company is engaged in the business of _____.

Whereas IITB is among the premier research and development (R&D) institutions in India and a centre of excellence in higher learning, research and development.

Whereas both Parties hereto have agreed to jointly work on Projects in topics of mutual interest as defined below and develop Products under terms and conditions mutually agreed upon by the Parties and

Whereas the Parties desire to record the broad terms and conditions that are jointly accepted and agreed to in this Agreement as contained hereunder.

1. DEFINITION

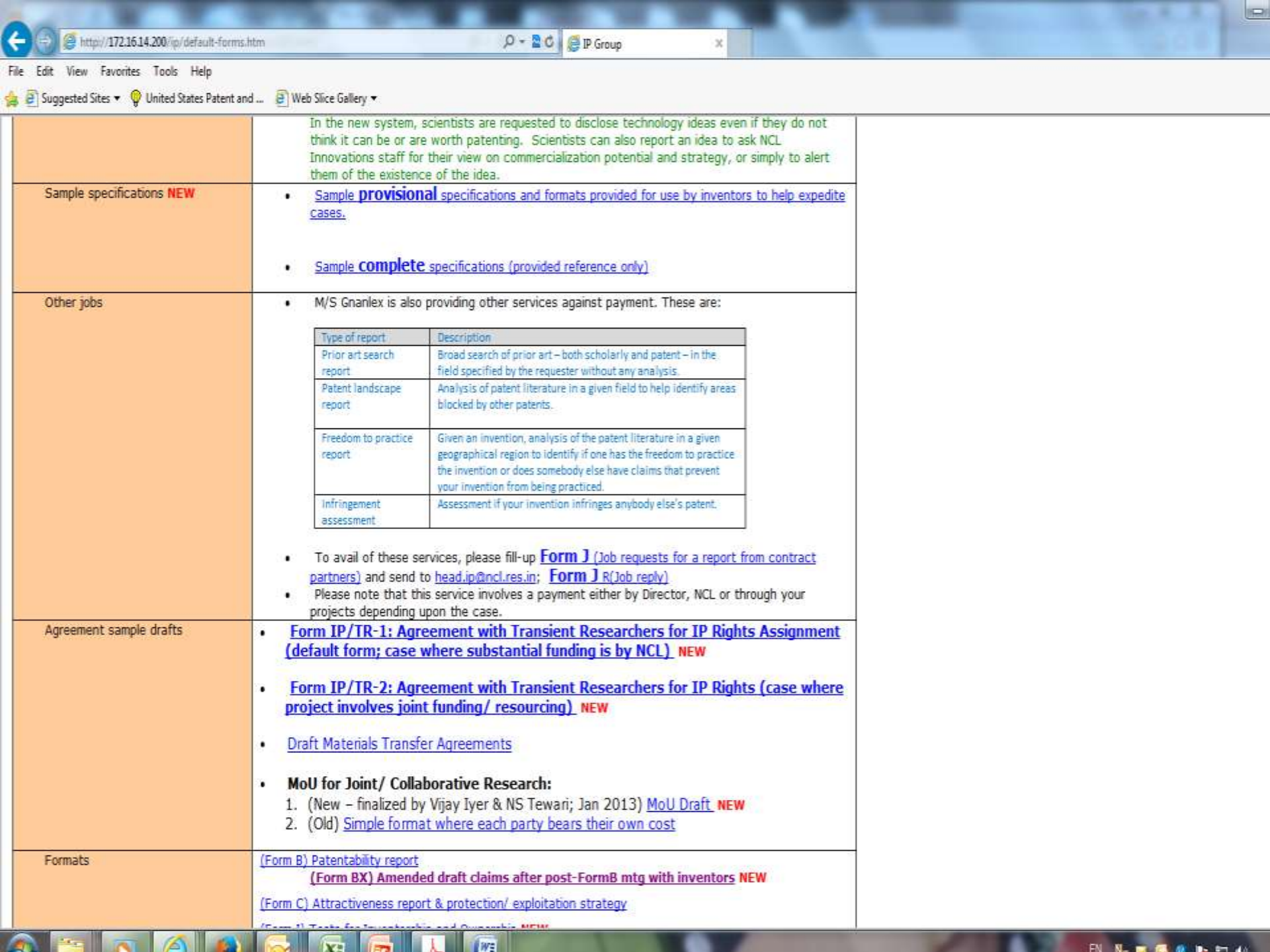
(a) 'Projects' shall mean and include the individual Projects under the Agreement, the terms and conditions for execution of each of which shall be jointly agreed upon, in writing.

(b) 'COMPANY know-how' shall mean and include all know-how of methods, material, software, designs, patterns, formats, proprietary technical literature, and information developed, owned and provided by COMPANY, which are required for the Projects.

(c) 'IITB know-how' shall mean and include all know-how of methods, material, software, designs, patterns, formats, proprietary technical literature, and information developed, published or otherwise owned and provided by IITB, which are required for the Projects.

(d) 'COMPANY Personnel' shall mean the personnel or research and development engineers of the Company deputed for the Projects.

(e) 'IITB Personnel' shall mean the faculty members and / or scientists and / or students and / or staff of IITB deputed for the Projects.



Sample specifications **NEW**

In the new system, scientists are requested to disclose technology ideas even if they do not think it can be or are worth patenting. Scientists can also report an idea to ask NCL Innovations staff for their view on commercialization potential and strategy, or simply to alert them of the existence of the idea.

Other jobs

- [Sample provisional specifications and formats provided for use by inventors to help expedite cases.](#)
- [Sample complete specifications \(provided reference only\)](#)

- M/S Gnanlex is also providing other services against payment. These are:

Type of report	Description
Prior art search report	Broad search of prior art – both scholarly and patent – in the field specified by the requester without any analysis.
Patent landscape report	Analysis of patent literature in a given field to help identify areas blocked by other patents.
Freedom to practice report	Given an invention, analysis of the patent literature in a given geographical region to identify if one has the freedom to practice the invention or does somebody else have claims that prevent your invention from being practiced.
Infringement assessment	Assessment if your invention infringes anybody else's patent.

- To avail of these services, please fill-up [Form J \(Job requests for a report from contract partners\)](#) and send to head.ip@ncl.res.in; [Form J R\(Job reply\)](#)
- Please note that this service involves a payment either by Director, NCL or through your projects depending upon the case.

Agreement sample drafts

- [Form IP/TR-1: Agreement with Transient Researchers for IP Rights Assignment \(default form; case where substantial funding is by NCL\) NEW](#)
- [Form IP/TR-2: Agreement with Transient Researchers for IP Rights \(case where project involves joint funding/ resourcing\) NEW](#)
- [Draft Materials Transfer Agreements](#)
- **MoU for Joint/ Collaborative Research:**
 1. (New – finalized by Vijay Iyer & NS Tewari; Jan 2013) [MoU Draft](#) **NEW**
 2. (Old) [Simple format where each party bears their own cost](#)

Formats

- [\(Form B\) Patentability report](#)
- [\(Form BX\) Amended draft claims after post-FormB mtg with inventors](#) **NEW**
- [\(Form C\) Attractiveness report & protection/ exploitation strategy](#)
- [\(Form D\) Tests for Inventorship and Ownership](#) **NEW**