

## **Second step : Does the proposed collaboration agreement adequately cover cross-border issues ?**

### **IPR Ownership**

#### ***(1) Is the PRO in control of the IP rights so that they can enter into negotiations with the Industry Collaborator?***

It is reasonable for the industry collaborator to require that any circumstances that mean that the PRO is not the first owner of rights produced on its side will be the responsibility of the PRO to sort out.

This applies equally the other way, though it is less common for businesses not to have direct contractual arrangements with its researchers which cover IPR ownership. You may also have to deal with a situation in which the PRO is required to retain use of its research.

#### ***(2) Is there any arrangement to cover reversion of the IPRs back to the PRO if commercialisation of the invention is not pursued?***

This will have to take account of what the Industry collaborator has paid the PRO for the IPRs

#### ***(3) Is there an agreement on how each partner can have access to the background IPR or confidential information that each bring to the project?***

An arrangement needs to be in place that indicates how each collaborating party may use this background IPR especially where such background knowledge from the industry partner or the PRO is important to the commercialisation of the invention, e.g. knowledge of how machinery using the invention works or knowledge of how to prepare material to get the best results from using the invention.

#### ***(4) Have you checked that there is a suitable project description included with the collaboration agreement?***

Experience at national level has shown that an outline of the project to be performed is most helpful so that it is clear what work, and subsequent IPRs generated from this work, is covered by the agreement. An example of such a project outline in Annex C.<sup>1</sup> The collaboration agreement should refer to the specific project to be performed and include details such as the dates of beginning and finishing of the project or stating how a finish date will be agreed and arrangements for reporting progress and results from the work.

---

<sup>1</sup> This was developed as part of the Lambert Model Agreements Toolkit in the UK to ensure that a suitable project description would be included with the collaboration agreement and has proved very helpful in the UK.

- (5) If it is unavoidable that some of the resulting IP is to be jointly owned, have suitable arrangements been agreed and put in place to ensure that this does not cause obstacles to the exploitation of the results?***

If a joint ownership agreement is unavoidable, arrangements should be included that allow as much flexibility as possible for exploitation, for example, have the joint owners sometimes agreed that each is free to exploit the IP without accounting to the other joint owners? Alternatively, have the joint owners agreed to assign the (jointly owned) IPR to a single party which would be responsible for the exploitation and would account to the joint owners according to agreed shares?

### **Negotiating the IPR contracts**

- (6) Is there a clear statement of who the agreement is between and what their relationship is to parties carrying out the work?***

If further negotiations are to take place over, for example, a licence agreement, who are the parties to carry out the negotiation?

### **Effect of funding**

- (7) Does the collaboration agreement include details of how the partners in the collaboration will take account of any requirements placed on them by funding from a third-party source?***

- (8) If the funding is from a public source and requires that the results from a project funded from this source are published and made available for others to use, does the collaboration agreement indicate how this will be achieved while also taking account of the need for confidentiality until the necessary IPRs have been secured? Has any necessary consent of the funding body been sought and obtained?***

- (9) Have you dealt with any regulatory requirement to commercialise the invention?***

In some states it may be required to have a plan to commercialise the invention in that country. It may also be helpful to consider whether the different parties can have different roles in commercialising the invention in their respective countries.

### **Confidentiality & publication**

- (10) Is there a need to include a clause laying out how the collaborating partners will decide when and who may publish the results from the project?***

This arrangement would need to take account of the time needed for the appropriate partner to secure any IPRs and, possibly, put in place the necessary arrangements to gain commercial benefit from the project, for example, install new equipment.

An alternative arrangement may be for the PRO to secure the IPRs prior to publication but then to receive reimbursement for such expenses from the industry partner.

**(11) *Is there an undertaking that neither partner will disclose to any other third party any of the background confidential information provided by the other party?***

Access and use of background confidential information provided by each party may be essential to use or exploit the results from the collaboration project. It is important that there is a clear understanding what this information is, how it can be used and most importantly, that either party to the project will not reveal it to a third party unless expressly allowed to by the owner of the background confidential information.

**(12) *Is there any arrangement laying out clearly how any legal requirements to publish will be taken into account?***

This might indicate, for example, how long a time period the industry partner has to secure the IPRs before publication of the results by the PRO will take place.

**(13) *If students (postgraduate or undergraduate) or persons without a contract of employment (see definition) with the PRO were involved in the project, has an arrangement been made with them to ensure that the results of the project remain confidential until the IPRs are secured?***

For example, if a postgraduate student was involved in the work, has an arrangement been put in place to indicate that the thesis may only be consulted by third parties who agree to keep the information in the thesis confidential?

## **Protection and enforcement of IPRs**

**(14) *Is there a need for an undertaking from the PRO that they will provide appropriate assistance, for example in the form of expert advice, to the Industry partner if they are taking action to enforce the IPRs generated from their collaboration?***

**(15) *Has it also been make clear how the collaborating partners will handle any disagreements that arise between them during the collaboration project?***

For example, if there is a difficulty over payment of funds to the PRO from the industry partner; how will such a situation be resolved?

***(16) Have you considered under what jurisdiction and applicable law any disputes that arise will be dealt with?***

The nature of a cross-border collaboration means that you have to agree under which jurisdiction any disputes between the parties will be dealt with. This will often dictate the sorts of termination or other normal contractual provisions that should be agreed. You may also have to agree what language the collaboration will work in.

A collaboration agreement may have to give specific recognition to particular requirements from each country for contracts which are distinct from the cross-border issues referred to above regarding the ownership, negotiation and funding of IPRs, confidentiality and publication, and protection and enforcement of IPRs. For example, in contracts in the UK, it is common practice to include a clause which sets out the limitation of legal liability of the parties to the agreement.

## **DISCLAIMER**

The above questions and suggestions are designed to give people an idea of the issues that they should expect to include in a cross-border collaboration agreement. They are designed as a guide to make the process of negotiating a collaboration agreement easier.

They are **not** a comprehensive list of the many other elements that should be included in a collaboration agreement and should in no way be regarded as a substitute for proper legal advice.

Neither the European Commission nor any person acting on behalf of the CREST Expert Group on Intellectual Property Rights or the Commission is responsible for the use which might be made of the following information. The content and views expressed in this report do not necessarily reflect the opinions or policies of the Member States or the European Commission.