

A large, stylized graphic of a metallic, purple-tinted cone or tube that tapers from the top left towards the center, set against a blue background.

Managing Intellectual Property in R&D

R & D Forum

10th June 2014

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What is Intellectual Property?

“Creative ideas and expressions of the human mind that have commercial value and receive legal protection in the form of a property right.”



What is an Intellectual Property Right?

Intellectual Property Rights (IPR) allow people / organisations to own their creativity and innovation in the same way that they can own physical property. The owner of IPR can control and be rewarded for its use, and this encourages further innovation and creativity to the benefit of us all.



Types of Intellectual Property Rights

- Patents protect how something works
- Copyright protects expression of ideas, literary works, computer programs
- Database rights protect the organisation of data
- Designs protect how something looks
- Trade marks protect “designation of origin”, reputation



Why Manage Intellectual Property in R&D?

- Capture research outputs in a tangible, protectable manner
- Drives Innovation
- Maximise impact of research
 - Dissemination into healthcare practice
 - Commercialisation
 - Reputation
 - Revenue
- Funding may be easier to obtain with identifiable IP
- Requirements of most grant funders



Grant T & Cs

- General Conditions, Finances, Responsibilities, Liabilities, Termination
- Publication, Publicity & Reporting
 - Acknowledgement of funding
 - Notification of publication
 - Duty to Publish
 - Open Access Repositories
- IP ownership
 - usual to vest in “contractor”
 - copyright in “Materials” assigned to Funder
- IP Management
 - Requirement to manage IP and ability demonstrate IP effectively managed (audit rights)
 - Notification of IP generated to funder
 - Commercialisation – often notification of intention to commercialise IP required
 - Revenue Share – may seek a share of revenues from commercial activity



Managing Intellectual Property in a Research Project

- Terms and Conditions stipulated by the funder
- What IP is being used by the project
 - Background IP - IP already owned by the Trust and/or collaborators or third parties
 - Foreground IP - IP that will be developed during the project
 - Using other people's IP
- Which organisations are involved as employers of collaborators or sub-contractors
- How will IP be managed throughout the project
- Project outputs - what will the project deliver (IP) and how will it be rolled out and made available to others



Collaboration Agreements

- Flow down T&Cs from grant contracts
- Duties & Responsibilities
- Clinical Trial Governance
- Funding
- Publications
- IP Ownership – who owns Foreground IP, Background IP, terms on which it can be used for the project and afterwards
- IP Protection – who protects & who pays for protection
- Commercialisation / Dissemination – who takes the lead, who is best placed to take the lead
- Revenue Sharing – who gets a share of revenue, how much, what for?



Research Project IP

- Background IP
 - IP which is necessary to undertake the project
 - Tools / Questionnaires / Diagnostics / Software
 - Interventions – IMP / Device / Support
 - Can also be used to describe IP developed outside the project
 - Who owns it and do you need permission to use it for the project
- Foreground / Arising IP
 - IP generated by the project
 - New
 - Further developed / refined
 - Improvement on existing IP
 - Exemplified
 - Who created it?
 - Who owns it?



IPR Ownership

- Ownership of IPR is determined by who created it, who employed them and if there are any contractual arrangements in place to over-ride default position
- Substantive Contracts / Honorary Contracts / Joint Appointments
- Many Parties are insistent on owning the IPR:
 - Control / Use
 - Commercialise / Disseminate
 - Kudos
 - Revenue
- Effective management of IPR resulting from research may mean that it is best for one party to own all Foreground / Arising IPR with appropriate licences to Background IP:
 - maximise impact of the research by having one party who is best placed to drive dissemination own IPR
 - make it easier to secure further research funding
 - make it easier to licence / assign IP for dissemination / commercialisation
- Partners who don't own IPR obtain:
 - Licence to use for clinical practice, research & teaching purposes
 - Share of revenue
 - Kudos
 - Less resource required to support dissemination / commercialisation



Revenue Sharing

- Agree share of revenues or “agree to agree”
- Based upon contribution to the creation and development of the IP
 - Contribution to the creation of IP
 - Development through research
 - Access to patients / clinical setting / NHS resources
 - Funding
- Funders requirements for a share of revenue (based on their relative contribution in terms of funding)



Exercise

Managing IP in Research Projects



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