

**Workshop**

Research Collaborations & Research Agreements

**For Tech Transfer Offices****For Research Offices****Level****Advanced****Duration****1 day** – 8.45am to 5.00pm.**Program**

A detailed description of the workshop program is below.

How this workshop helps IP professionals

A major focus of this skills building workshop is negotiating the ownership of IP in research agreements, including:

- IP ownership models in Research Agreements
- IP ownership models in Collaboration Agreements between a university / research institute and company
- IP ownership models in Collaboration Agreements between two or more universities / research institutes
- Joint ownership of IP and its downsides, and
- How to manage joint ownership when joint inventorship requires joint ownership.

In particular it focuses on strategies that equip you to:

- Resist demands for you to concede the ownership of the IP you create
- Resist demands for you to concede the joint ownership of IP you solely create.

Also covered are

- Managing the risk of unpaid research monies
- Managing the participation of
 - Students, and
 - Visiting Scientistsin research projects subject to contractual obligations.
- Terms in Collaboration and Research Agreements that you should expect
- Terms in these agreements that are not so common and which you should avoid.

Presenter

Philip Mendes

Delivery style

Interactive workshop style.

Emphasis on discussion, participants asking questions, contributing their comments, and sharing their experiences.

We find that this interactive workshop style keeps participants alert and achieves a more effective learning and skills building outcome.

Learning Outcomes

At the conclusion of this workshop, participants will have:

- Knowledge of laws affecting the ownership of IP
- In particular, knowledge of the laws affecting the joint ownership of IP in key countries including the US
- Appreciation of the operation of those laws in the context of technology transactions and in particular in research agreements and collaboration agreements

- Knowledge and resources to be alert to IP ownership models that are disadvantageous when raised in negotiations and other pre-contract discussions
- Knowledge of alternative models / approaches for IP ownership arising under Collaboration Agreements
- Knowledge of the legal and practical operation of options to negotiate a license under the laws of their own jurisdiction, as well as the implications in the US
- Strategies to negotiate the ownership of IP to avoid sole ownership to a company, or joint ownership with a company, particularly SMEs
- An excellent knowledge of
 - How to manage the risk of non payment of research monies
 - How to manage students and visiting scientists and the IP they create
 - The terms of Collaboration Agreements and Research Agreements to expect, or to avoid

Materials

Each participant receives a set of bound workshop materials which will be an ongoing reference resource.

Certificate of Completion

A Certificate of Completion is provided to each participant.

RESEARCH COLLABORATIONS & RESEARCH AGREEMENTS

[Times are approximate. Please expect that the duration of breaks may be shortened throughout the day]

8.45	Arrive	
9.00	Joint ownership of IP, its unexpected implications, and why joint ownership is not necessarily an attractive concession	Joint ownership of IP suggests that the joint owners have equal and mutual rights over the jointly owned IP. But that is not the case. A joint owner that lacks the capacity to manufacture and sell (like a university, research institute, or start-up) will be disadvantaged compared to the joint owner that has that capacity. Why you must know the joint ownership laws that operate in those countries (not just your own country) where you have patents, and the impact of unharmonised joint ownership laws.
	IP Ownership Models in Research Agreements	<i>(where a university / research institute undertakes research, and a company provides funding but makes no inventive contributions)</i> Should a company that only provides funding for research, but makes no inventive contribution own the IP? Or even jointly own the IP? Strategies to negotiate sole ownership to the university / research institute that creates the IP. Strategies to persuade a company that this is the customary model in research agreements. What rights to confer upon the company that funds research that it will accept in substitution for an ownership interest
10.30	Morning Tea	
	IP Ownership Models in Collaboration Agreements with a Company	<i>(where a university / research institute and a company jointly undertake research together, and are jointly inventive)</i> A company that contributes to research not solely with funding, but inventively as well, legitimately expects to have an ownership interest in the IP: Models to consider – inventorship model; improvements model, category model, joint ownership model, joint venture company model. Advantages and disadvantages of each model. Criteria for selecting one model over another. What you must do if you must have a joint ownership model.
	IP Ownership Models in a Collaboration Agreement between two or more universities / research institutes	<i>(where two or more universities / research institutes undertake research together, and are jointly inventive)</i> Models for IP ownership in collaborations between universities / research institutes. Criteria for allocating joint ownership proportions. When to have Inter-Institutional Agreements to deal with the protection and commercialisation of the IP, and what these agreements provide for.
12.30	Lunch	
1.30	Negotiating an alternative to IP ownership: Rights of First Refusal and Options to Negotiate a License	How these are used in IP ownership negotiations. Their legal status considered in various countries including Australia, United States, Europe (and when this workshop is presented in Singapore, Malaysia, and Hong Kong, in those countries as well). Implications of unharmonised laws in relation to rights of first refusal and options to negotiate. Why these rights must be used. Potential liabilities to be aware of. Bargaining implications to be mindful of.
	Terms of Collaboration Agreements and Research Agreements	Usual terms of Collaboration Agreements and Research Agreements. Terms that you should make sure that these agreements contain. Terms to watch out for and avoid.
3.00	Afternoon Tea	
3.30	Managing the risk of unpaid Research Monies	How to deal with research money payment obligations in the event of milestones not being achieved, early termination, expenditure that has been committed despite termination, and how to treat unspent monies.
	Certainty and Completeness in Collaboration and Research Agreement Schedules	Preparing Schedule 1: Research Program; Schedule 2: Research Funds; Schedule 3, Milestones. The legal requirements of Certainty and Completeness that Schedules must meet. Consequences of the requisite Certainty and Completeness not being achieved.
	Background IP Traps	What is and what is not Background IP. Consequences and risks of classifying expertise or industry knowledge as “Background IP”. The boundary between a researcher’s expertise and an employer’s Background IP. How to describe Background IP effectively, Warranties concerning Background IP to bear in mind when describing Background IP.
	Participation of Students and Visiting Scientists in industry funded research	Students will own the IP that they create. Implications for student participation in industry funded research and collaborative research. Visiting Scientists cannot assign the IP they create to their host institution. Best practice to secure the ownership and rights over student and visiting scientist generated IP.
5.00	Close	