

COLLABORATIVE R&D & IP ISSUES IN TECHNOLOGY TRANSFER IN UNIVERSITY SYSTEM

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IPR Group-DRDO Our Activities

*Formulating
DRDO Perspective
on National
International IPR
Issues*

**IPR Group
DRDO HQR**

*Promoting IPR
Culture among
DRDO Scientists*

*Providing Legal
Protection on
Innovations/Inven-
tions of DRDO
Scientists*

*Litigation &
Legal Notices*

*IP Issues in
Collaborative
Research*

- 50 Labs working in array of technologies
- 5000 Scientists and 25000 Support staff

THOMSON REUTERS
INNOVATION
AWARDS 2011



DRDO Received Thomson Reuter India Innovation Award-2011 In The Category OF Hi-Tech Academic & Government.

Four metrics used to assess the level of innovation

1. Size of portfolio
2. Success rate
3. Extent of globalization
4. Influence of innovation



TECHNOLOGY

- Practical application of information for the creation or modification of useful products are processes
- Refers to inventions & know-how
- A product may involve number of technologies
- A technology may involve number of patents



INTELLECTUAL PROPERTY RIGHTS

- Intellectual property refers to creations of human mind
- Legal system of intellectual property rights converts these creative outputs into tradable property
- Technology transfer assumes 'ownership of technology'



Journey From Innovation to Market-Role of Contract

IP generated by employee as a part of duty

In-house development

Customer defines the deliverables & other party delivers on payment

Outsourcing

Consultant Work
Work Product developed by vendor
Contract Research- - 'Made for hire' basis
Work of authorship' (source code/moral rights ?

Innovation to Market

Parties having specific background intellectual property joining hands for common goal

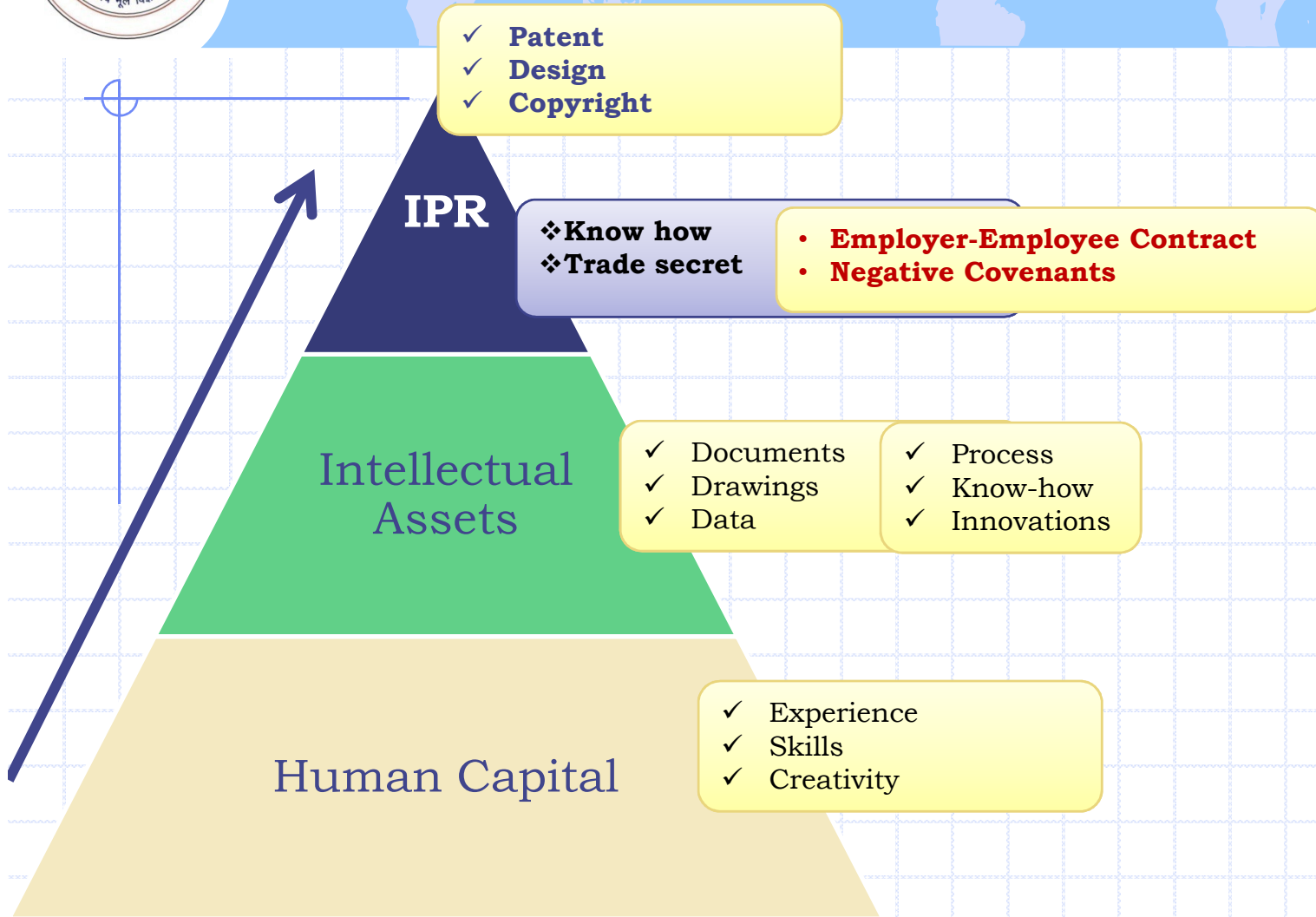
Collaborative Development

Technology Transfer

Owner of IP permitting licensing to use its IP on payment basis



Contract- In-house Development





Contract- Outsourcing

Vendor specifically agrees that Work Product shall be owned exclusively by the customer.....

Vendor hereby agrees that the Contract effectively transfers, grants, conveys, assigns exclusively to customer all rights, title and interest in and to all ownership rights in Work Product including all intellectual property rights.....



Contract Research

Terms in CARS Scheme in DRDO

“The ownership of intellectual property, whether or not legally protected, generated by contract research performed under this contract shall vest in DRDO. However, the RSP shall receive, upon demand by it, a royalty-free license from DRDO to use these intellectual properties for its own purposes, which purposes specifically exclude sale or licensing to third parties”



Why Collaboration?

- **New technologies becoming complex**
 - **involving huge investment -financial as well as manpower**
- **Different positioning at technology chain**
 - **university – basic sciences**
 - **industry - production**
 - **R&D - developmental /prototype level**
- **Multidisciplinary research**
- **Core competence in different sectors**
- **Product diversification**
- **Market diversification**



Collaborative R&D

Joint Venture

Consortium Approach

Strategic Partnership

Sponsored Research

Material Transfer Agreement
Non-disclosure Agreement



Policy Framework

IPR ISSUES CAN NOT BE TREATED IN GRAND ISOLATION

- **Align with the mission of the organisation**
university-public mission- access to third parties
industry-profit motive
- **Align with the mission of the collaborator**
- **Nature of funding**
- **Involvement of employees**
- **Job responsibilities**
- **Overall context**
- **Is the collaborator IP savvy ?**



Collaborative Research Agreement

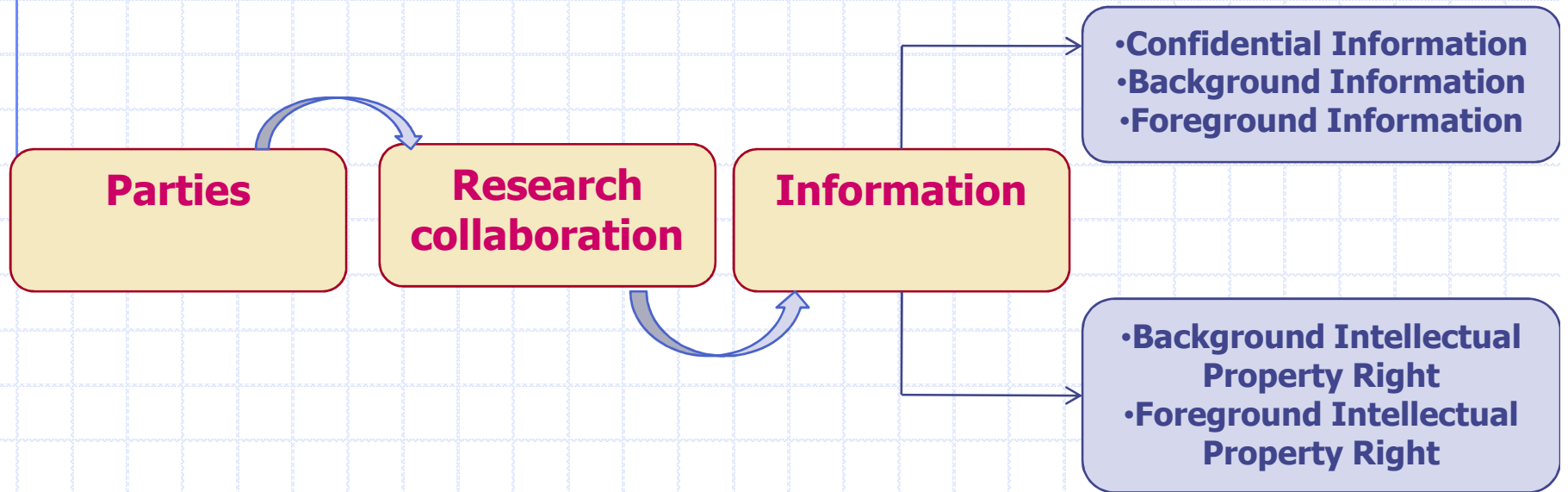
A Check List- Intellectual Property Rights Issues:

- Definitions**
- Publication policy**
- Ownership of intellectual property rights**
- Responsibility for Filing & subsequent prosecution, maintenance of IP applications**
- Expenditure related to filing etc. of IP applications**
- Licensing**
- Infringement**



Intellectual Property Rights

For the purposes of this part of Agreement, the following terms shall have the indicated meanings:





Definitions

- **Information :**
means any information, knowledge or data, regardless of its form and characteristics, including but not limited to that of a scientific or technical nature, experimental and test data, designs, improvements, photographs, software including source code, all kinds of documentation, reports, manuals, specifications, technical writings, sound recordings, drawings and other graphic representations, developed products, parts, units, components, samples, mockups, manufacturing processes, technologies, materials, models, methods of operation, methods and tools , methods of testing, know-how.



Collaboration with Production & Development Agency

- **Parties can use all Background Information/Background Intellectual Property Rights for research purposes**
- **Parties to jointly own the Foreground Information/Foreground intellectual Property Rights - ownership on Foreground Information/Foreground Intellectual Property Rights developed solely by employees of one of the Party?**
- **Parties to consult each other before licensing Foreground Information/Foreground Intellectual Property Rights**
- **Royalties generated by licensing Foreground Information/Foreground Intellectual Property Rights to be shared equally**



Collaboration with Production & Development Agency

- **The prices stated in the Contract shall be deemed to include all amounts payable to the Agency for the use of any and all Background Information and Background Intellectual Property Rights as well as Foreground Information and Foreground Intellectual Property Rights, whether legally protected or not, including but not limited to patents, copyrights, designs, etc. for the purposes of Development and Production work performed under the Contract including for the purposes as provided in Article ---- above**



Licensing & Commercial Use

- **Notwithstanding any provisions mentioned above or any future licensing agreements, Party shall be deemed to have all rights including a nonexclusive, irrevocable and royalty-free license for the commercial development, series production, continuing engineering support, product improvement, or have developed, any Background Information and Background Intellectual Property Rights as well as Foreground Information and Foreground Intellectual Property Rights , whether or not legally protected, for the purposes of Government Applications or to seek a licensee and to negotiate, execute and administer any license agreement for the commercial development, series production, continuing engineering support, product improvement, or have developed, any Background Information and Background Intellectual Property Rights as well as any Foreground Information and Foreground Intellectual Property Rights, whether or not legally protected, for the purposes of Government Applications.**



Sponsored Research

Terms in Grants-in-aid Schemes in DRDO

- **The ownership of intellectual properties to vest in the grantee institution. The grantee institution shall promptly report to DRDO its intention to protect legally any such intellectual properties**
- **DRDO to have royalty free license to use such intellectual properties**
- **Grantee institution to consult DRDO before contracting any License Agreement involving such intellectual properties**
- **DRDO not responsible for any liability arising from infringement by the grantee institution of the Intellectual property rights of third parties**



Material Transfer Agreement (MTA)

- **Legal contract between two parties**
- **Required when exchange of biological material is involved for test, evaluation or research purposes**



Material Transfer Agreement

Definition

- Provider, Recipient, Material

Purpose of Exchange

- Test/Evaluation/Research

Ownership over material

- Requirement of written permission from Provider for commercial purpose use of the material by recipient

Publication of Research

Ownership over intellectual property rights resulting from research over material

Warranties from Provider about the correctness about the data/ safety of material (Provider should not take any responsibility)

Term of the Agreement



Non-disclosure Agreement

- **Also known as Confidential Disclosure Agreement (CDA)**
- **Legal contract between two parties**
- **Required when parties are willing to share confidential information for certain purposes**
 - **Typically required when any research organisation is interested in providing data about any developed technology for evaluation purposes to a party interested in commercialisation**
 - **Important for protecting know-how and/or IP rights related to technology**



Non-disclosure Agreement

Definition: Parties, Confidential Information, (provide exceptions)

Purpose of Exchange: Test/Evaluation/Research

Ownership over Information (ownership with the disclosing party)

Ownership over intellectual property rights resulting from Information (ownership with the disclosing party)

Warranties from disclosing party about the correctness of Information (disclosing party should not take any responsibility)

Use of Information by Recipient in a manner so as to protect confidentiality of the Information

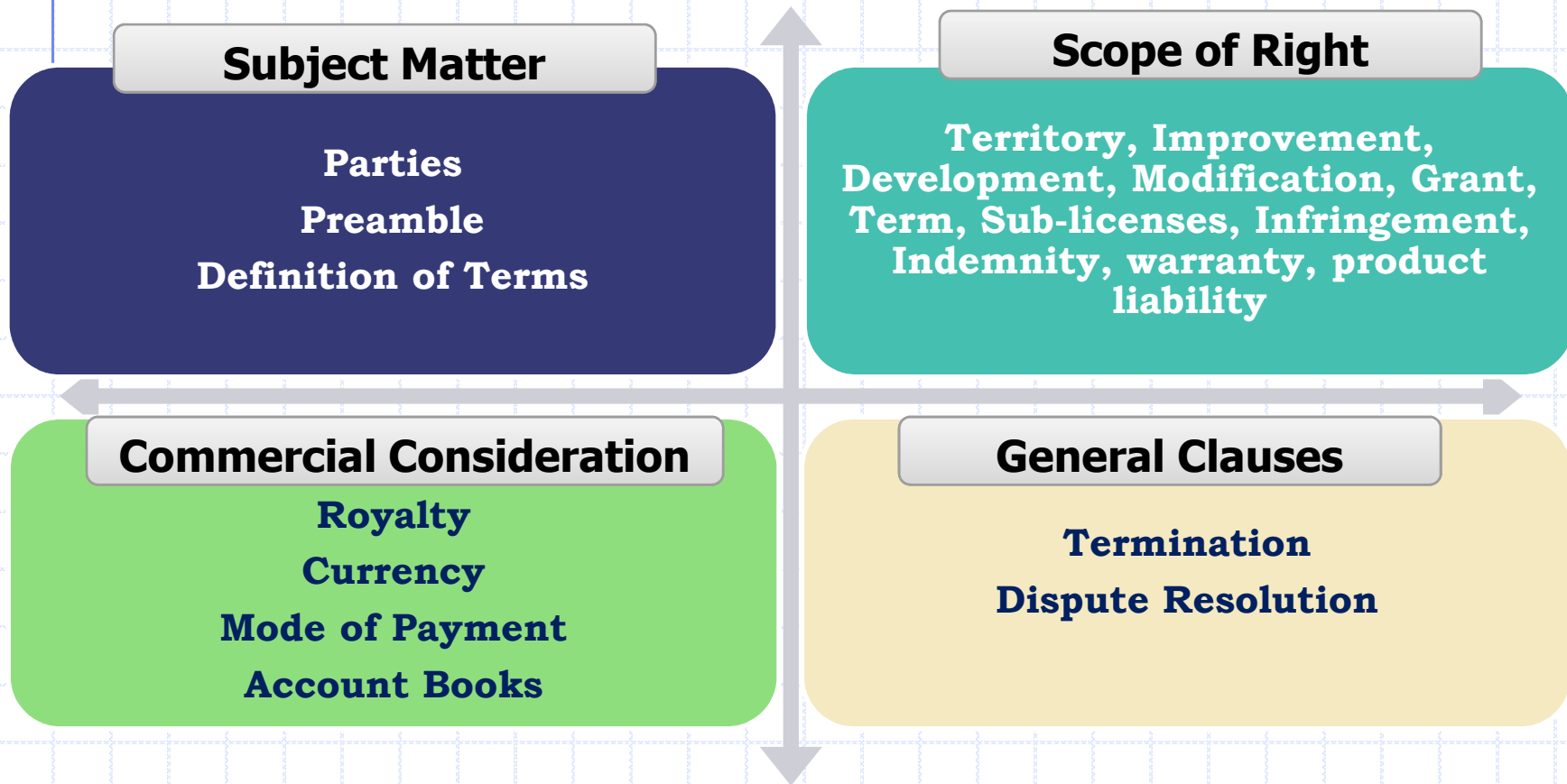
Requirement of written permission from disclosing party for commercial purpose use of the Information by recipient

Remedies in the event of disclosure of the Information

Term of the Agreement: may include return of the Information to the disclosing party

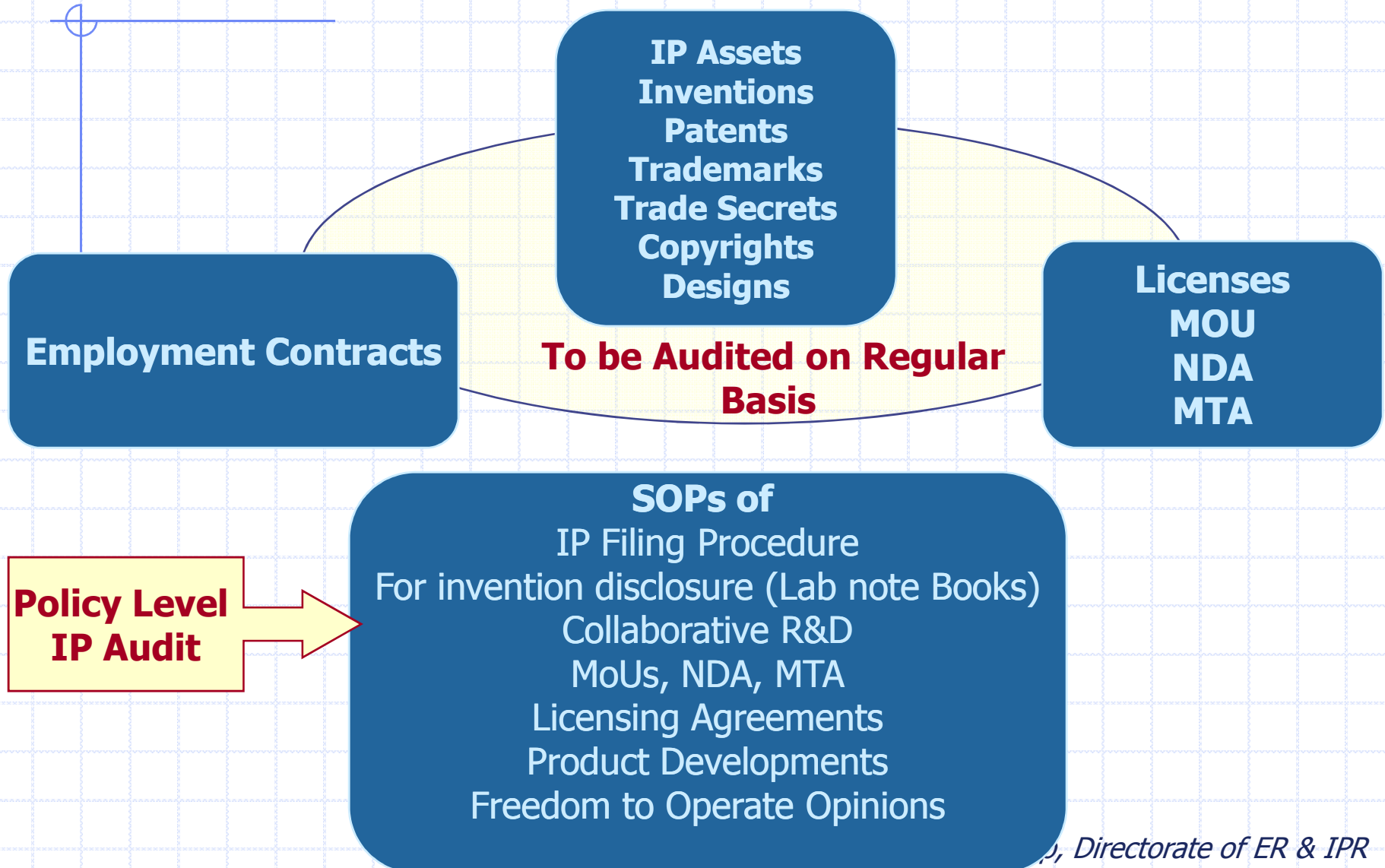


Licensing Agreement: Anatomy





Monitoring.....





- Thanks