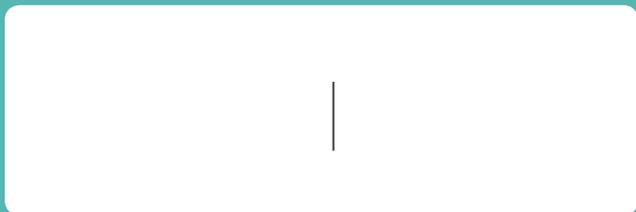


INTELLECTUAL PROPERTY AGREEMENTS

A University of Bristol guide for Collaboration and Knowledge Exchange



Who should use this guide and why

The guide has been developed for academics (or Project Managers) who are looking to engage in a collaborative research project with an external partner (or partners) who are working with the University of Bristol. All collaborative projects with external partners need some form of contractual agreement, however unnecessary it may feel at the outset.

The guide will help you think through your collaboration with your partner(s), agree clear expectations and, most importantly, identify what type of contractual agreement you both need to ensure everyone has the permission to do what they need to do at the end of the project.

The guide has been designed to provide you with helpful resources that you can use with your partner(s) to create a common understanding of both/all parties position on Intellectual Property (IP) and how best to handle the IP in your project. The guide contains diagrams to help you map out decisions around IP and contributions, an FAQ section and guides to contracts. We have also included links to other resources you or your partner(s) may find useful.

Ownership of Intellectual Property (IP) is not in itself important. What matters is what each partner wants to do with the IP invested in or created by the project, whether they have the rights to do that, and how to ensure that what they do is fair to all collaborators.

 **Ownership of IP is not in itself important. What matters is what each partner wants to do with the IP invested in or created by the project.**

Edited by Katherine Dunleavy and Esther Brown

With thanks to Nathan Eisenstadt, Gail Lambourne, Vivienne Ozobialu, Sue Sundstrom and Nikki Hicks for their contributions

Designed by Carruthers Tanner
www.carrutherstanner.uk

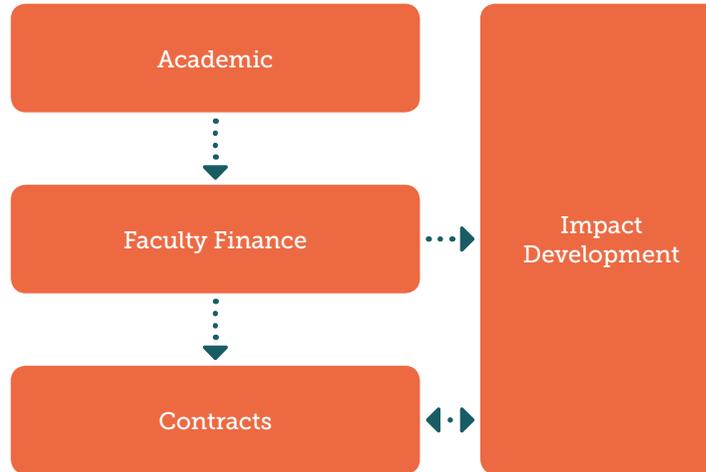
Contents

Where do I start?	4
What is Intellectual Property (IP)?	5
Why does this matter?	6
How is IP protected?	7
Reaching an agreement	8
Key Points	9
Do I need a collaboration agreement?	10
Background IP	11
Mapping IP in your project	12
FAQS	14
Useful Contacts and Resources	16

Where do I start?

The University has centralised staff who will be able to support you.

The first point of contact is **Faculty Finance**, partly to get the project properly costed but they also trigger the process internally with the relevant teams who will be well-placed to advise you. This may include staff who are based in the Research, Enterprise and Development Department who specialise in **Impact Development** and Contracts. Both teams can help you think through the details around shared intellectual property and support you to agree on the most suitable arrangement for your collaboration. This will help you to avoid issues later down the line.



! The first point of contact is Faculty Finance, partly to get the project properly costed but they also trigger the process internally with the relevant teams who will be well-placed to advise you.

What is Intellectual Property (IP)?

Intellectual Property (IP) is defined as “creations of the mind” or the manifestation of an idea. It’s easier to think of it as knowledge or know-how that you have rights to. In a collaborative project, the University and its partners will bring together a wealth of expertise, experiences and skills to produce new knowledge and insight. This may lead to a new product, service, training course, co-authored guide or toolkit, or a new way of doing things – all of which would constitute IP.

In this guide, we have included a decision guide to help you and your partner(s) identify what could be defined as IP in your project - see Do I need a collaboration agreement? (page 10), Background IP (page 11) and Mapping IP in your project (page 12).

Collaborative research usually means an equitable partnership between different people and organisations, which recognises that knowledge creation and expertise exists both within and beyond universities.

So, whether your project involves co-producing new knowledge, exchanging existing knowledge or both, it’s important to identify who is bringing what knowledge to the collaboration and what shared knowledge may be created during the project.

The question of who owns what and who can do what with the shared knowledge at the end of the project is something that, to a certain extent, can be considered as soon as you start to plan how to work together. It can then be formalised into a contractual agreement, which can also be revisited during the project.

Sometimes the project work is experimental and the outputs or outcomes are hard to predict. In these circumstances, it’s worth revisiting the decision-making activities regularly to see what your conclusions indicate for the IP. If the project takes place over several years it is important to review the IP in regular catch ups that are scheduled as the project develops and circumstances change.

 In this guide, we have included a decision guide to help you and your partner(s) identify what could be defined as IP in your project.

Why does this matter?

From a legal perspective, if you wish to do something with the outcome of a collaborative project, you must be able to demonstrate you have the rights or permissions to do so. If the IP is shared (collaboratively produced) and there is no contractual agreement in place, then neither the University nor the partner(s) can do what they want to with the outcomes of the project, at least in the UK. Therefore, a lack of clarity, whether at the end or during the project, could be damaging for the relationship, the collaboration and the individuals.

It matters what each project partner wants to do with the IP, whether they have the rights to do that, and that this is fair for all involved. It's important that you talk to your partner to ensure everyone has the rights to do what they need to do in a commercial context, IP can become the foundation upon which the partner(s) and/or the University will be able to seek investment, secure competitive advantage and generate economic wealth. In a non-commercial context, the outcome of the project might be something that has some sort of public value that needs to be communicated or shared freely.

In some cases, the funder of the collaborative project may require specific arrangements, particularly where public funding is involved (e.g. research councils). It is worth reading the terms and conditions of any grants and sharing these with your partner(s). You can request these from Faculty Finance.

A collaboration agreement will normally include the following functions:

- The terms of any payments between the parties
- The scope of the work agreed between the parties
- What to do if something goes wrong when working together
- Who has legal and financial liability for what
- How ownership of new knowledge will be determined, assigned, protected and shared

It is generally advisable to avoid joint ownership of IP, even where initially this sounds like a fair arrangement. This is because it inevitably means that all decisions relating to protection and/or use of the IP need unanimity. Where possible, it is better to be clear from the beginning on who will be able to do what. Once this is clear, it is often evident where ownership should rest.

The University uses a set of nationally-agreed best practice templates called the **Lambert Agreements** and adapts them to the needs of the project. See page 10 for a decision tree to help you identify the information needed to decide what suits your project.

 **It matters what each project partner wants to do with the IP, whether they have the rights to do that, and that this is fair for all involved.**

How is intellectual property protected?

Below are some of the terms the agreements use to protect and share the IP brought to the project and/or produced by it.

Copyright – Copyright deals with works of creative authorship such as books, music, movies, software, artwork, photography, etc. and arises automatically. Copyright gives the copyright holder, usually the creator, the right to control who can copy, distribute, publicly display/perform a work. Copyright lasts the life of the author plus 70 years and 95 years for works of corporate authorship.

Design rights – these cover the look of a design, for example the appearance, physical shape, configuration and decoration. There are two types of design rights: the registered design right (Registered Design Act 1949) and the unregistered design right. A registered design right provides up to 25 years protection in UK law. The unregistered design right is similar to **copyright** in that it attaches automatically when a new design is created. However, its length is much more limited.

Patents – Patent is an area of law that deals with technology, ideas and inventions. A patent gives the inventor/owner the right to stop others, for a limited period, from making, using or selling the invention without permission. If an employee creates an invention in the course of their duties then the invention will be owned by the employer. Patents must be applied for as all patents must be approved by the government. Patents last for 20 years.

Trademarks – Trademark deals with names, slogans, logos and other things used to identify a business, product or service in the marketplace and should be formally registered.



IP can be shared through a license that acts as a stand-alone contract to grant legal rights of use, in certain geographical territories or markets.

The Creative Commons suite of licenses, may be appropriate to your project, if you wish to share your work openly, give others the right to share, use or build upon the work you have created.

There are different kinds of Creative Commons licenses:
www.creativecommons.org/share-your-work/licensing-types-examples

Reaching an agreement

You should discuss IP with your partner(s) as soon as possible. The following set of questions is designed to help you to discuss IP with your partner(s), and inform the contracts process, saving you time and misunderstandings in the long run. It also highlights the information needed to help the Contracts team work with you on your project's collaboration agreement.

? What are the terms set by the funder that need to be considered? For example, many funders expect project findings to be made public. These terms may mean the university can't be as flexible as you'd like in the agreement with your partner(s).

? Which partner has the funds (or access to funding) to put the IP to good use?

? Who is bringing what knowledge to the project?

? Who is getting paid, how much, for what and when?

? Which partner is in a good position, or has the expertise, to manage the legal contracts and make sure all partners are able to use the outputs as needed?

? Are there any restrictions to access to data throughout and beyond the project or any ethical and data protection issues that need to be taken into account during and beyond the project? For more detail see the Ethics guide in this series.

? What new knowledge might be created and what form will this take (e.g. outputs)?

? Who will need access to what at the end of the project?

? What are we trying to achieve together?

? How will you stay in touch if problems arise?

? How/When will you review this agreement?

Key Points



The purpose of a contractual agreement is to ensure any differences in understanding are addressed before the project starts, to provide clarity and rules that all parties will abide by and to make the delivery of the project as risk free as possible.



Co-producing does not affect anyone's underlying rights. Existing IP that's brought into the collaboration is already owned by the person bringing it to the collaboration, or by the organisation the person represents.



What is jointly created during the project becomes shared IP but it is best to agree which partner is best placed to be the owner.

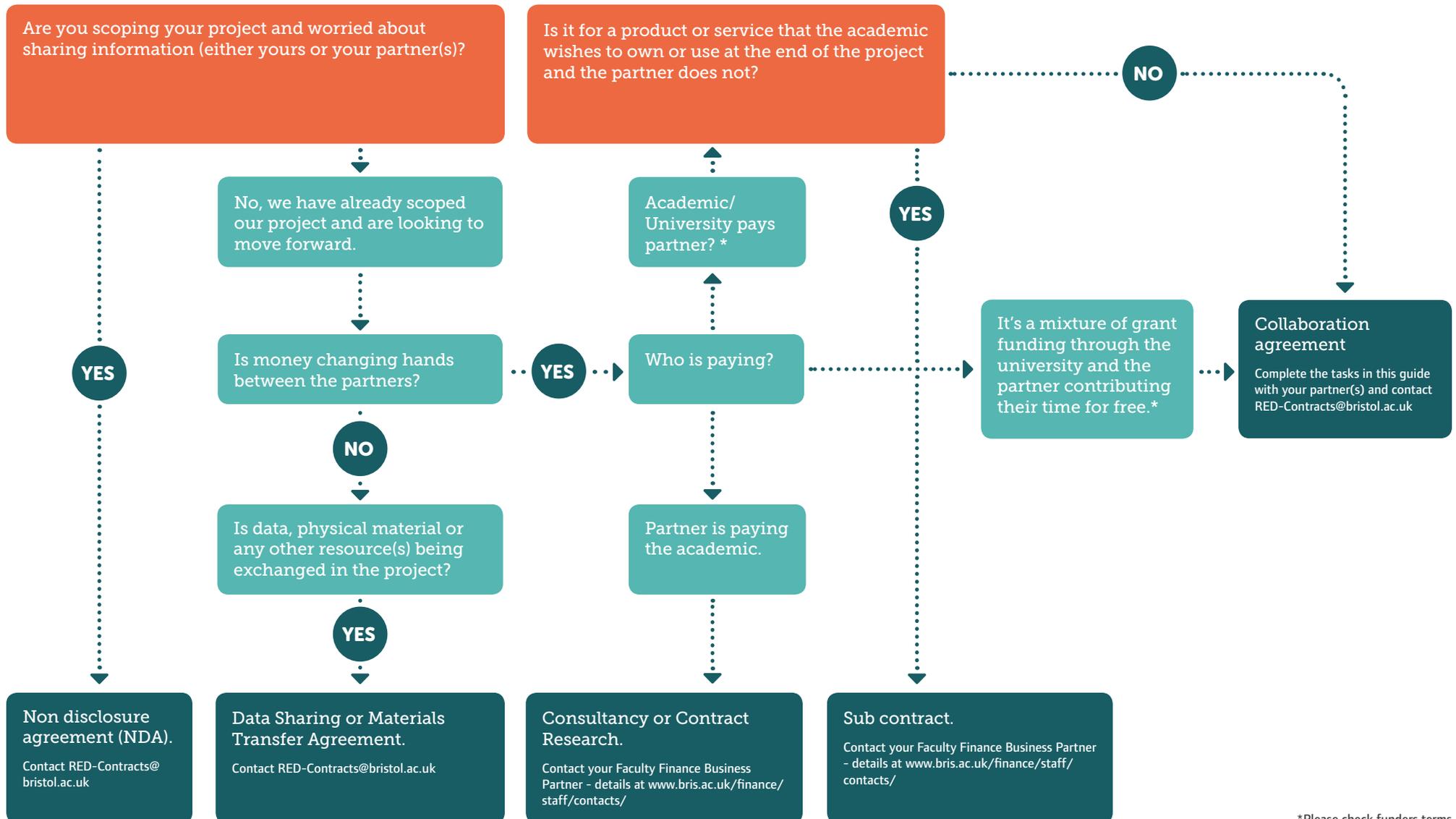


If the output is a small improvement on existing IP, such as a small improvement to a product or service that's already been developed, the IP should remain with the originator as that partner will be best placed to put it to use.



If a partner wants to do something with the outputs or ideas coming from the project, they need the permission of the other partner(s). Any contract will need to stipulate how long this right is granted for and outline the criteria these rights are granted under (eg. for commercial sale in the UK to care homes for two years).

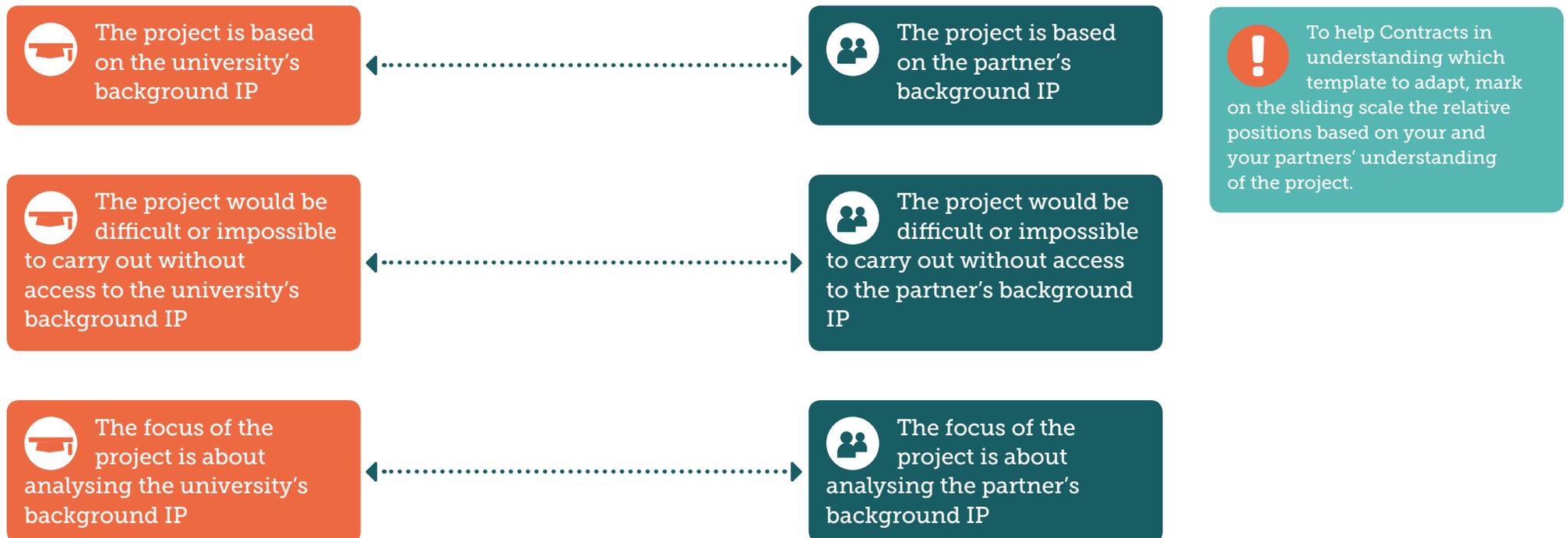
Do I need a collaboration agreement?



Background IP

The university has different template agreements depending on the needs of the collaboration and what the different partners bring to the project. The relative positions of the partner(s) and the university are different in each, depending on the project.

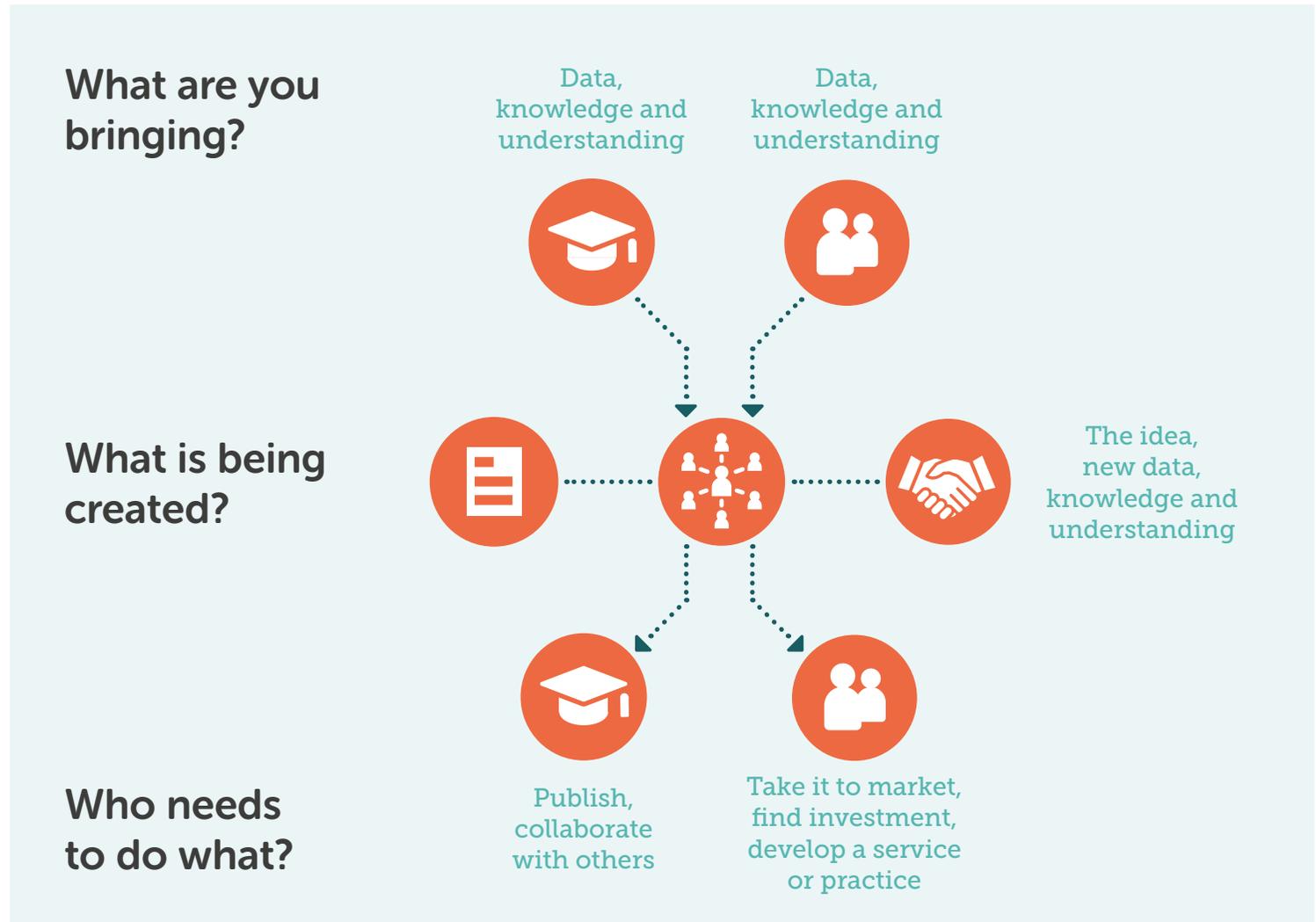
Think about where your project sits on these sliding scales with your partner(s) before you draw up an agreement with the contracts team.



Mapping IP in your project

This diagram suggests three key questions that you should discuss with your partner(s) to identify the key parts of your project that will inform what you agree about the IP and so what is reflected in an agreement.

We suggest that you use the blank template on the next page to map your discussion with your partner(s), we have provided some possible answers in the diagram below.



What are you bringing?



What is being created?



Who needs to do what?

FAQs

Why does the academic IP belong to the University?

The academic works for the University and research is part of their contracted duties. The University has a revenue share policy for those academics who have potential commercially valuable IP and wish to exploit this. If you want to explore this further, contact the RED Commercialisation team.

How does the contracts process get triggered?

Many collaborative projects are grant-funded (if yours is not, please talk to RED to see what is the best way forward for you). At the point where the grant is awarded, a budget code will be set up by Faculty Finance. The academic is responsible for discussing the need for a contract with Finance, who can then trigger the process even if there is no financial payment to or from the University or from the partner(s).

Can the University provide my partner(s) with legal advice?

The University is in a difficult position and cannot provide partners with legal advice as this would amount to a conflict of interest. However, we aim to ensure that our contracts are designed to mirror the needs of the collaboration and not conflict with the spirit of collaboration. Any agreement (contract) that you are presented with should be clear to understand and we encourage partners to seek independent legal advice if they feel they require this.

Will working with the University affect the partner's existing IP?

No. When a partner, including the University, participates in a collaborative research or knowledge exchange agreement or project proposal, it does not mean that they are signing over the rights to their existing ideas or know-how within their organisation. By agreeing to work together collaboratively on a project both parties agree to share and/or exchange pre-owned ideas for the purpose of the project for a period of time. You can see from this why it's important for each partner to understand this and to be clear about the IP they are bringing to the project (and so to the agreement).

 **By agreeing to work together collaboratively on a project, both parties agree to share and/or exchange pre-owned ideas for the purpose of the project for a period of time.**

What if the agreement needs changing partway through the project?

The University is keen to avoid disputes between partners both during the project and at the end of the project – that’s one of the reasons for an agreement in the first place. Working together means having an ongoing dialogue and part of that is handling new factors as they arise during the project, agreements and contracts can be modified where all partners agree to the change.

Why is the University concerned about what goes into a partnership agreement?

Universities are custodians of public funding to conduct research for public good. As such they are very conscious of reputation, risk and compliance with laws, statutes and regulations such as charity laws and State Aid rules. Alongside this is their responsibility to secure value for money for the public investment made through the funding they control, while being fair to the external partner(s) involved in any project.

For example, if the IP is tied to a partner(s) who is/are not in a position to do what they intended with it, then the value cannot be realised. Universities will always feel obliged to guard against this, especially if the risk is high. A partner may be asked to agree that if they do not use the IP within a reasonable time frame, they will grant the right for the University to use it or to work with someone else to develop it.

 **Working together means having an ongoing dialogue and part of that is handling new factors as they arise during the project.**

Useful Contacts and Resources

Online resources

Several Connected Communities Projects have published on issues of collaborative research, their reports can be found in the resources section of the website (http://connected-communities.org/index.php/project_resources/) along with information about the projects. Here are a selection relevant to the advice in this book:

Making Media with Communities Guidance for Researchers: http://connected-communities.org/index.php/project_resources/making-media-with-communities-guidance-for-researchers/

Community-based Participatory Research: Ethical Challenges: http://connected-communities.org/index.php/project_resources/community-based-participatory-research-ethical-challenges/

Creating Living Knowledge Report: https://connected-communities.org/index.php/project_resources/creating-living-knowledge-report/

Beyond the Creative Campus: Reflections on the evolving relationship between higher education and the creative economy: https://connected-communities.org/index.php/project_resources/beyond-the-creative-campus-reflections-on-the-evolving-relationship-between-higher-education-and-the-creative-economy/

Other useful online resources

GW4 Alliance guide to collaboration: <http://gw4.ac.uk/guidetoresearchcollaboration/>

National Institute for Health Research: <http://www.invo.org.uk/resource-centre/payment/> - useful for those involved in NHS, public health and social care research

Centre for Social Justice and Community Action: <https://www.dur.ac.uk/beacon/socialjustice/toolkits/> - provides toolkits and case studies for both academics and community partners

Know yourBristol toolkit: <http://www.knowyourbristol.org> - a variety of practical advice based on the projects' experiences of working with community partners.

University of Bristol

RED – Research and Enterprise Development – can offer advice on a range of research issues such as contracts, impact and funding opportunities. (<http://www.bristol.ac.uk/red/>)

CPE – Centre for Public Engagement – can offer advice on engagement beyond the university and help with engagement events. (<http://www.bristol.ac.uk/public-engagement/>)

NCCPE – National Co-ordinating Centre for Public Engagement – is joint hosted by the University of Bristol and the University of the West of England. They run events and provide training for academics and community partners and have a good range of resources and information on their website. (<http://www.publicengagement.ac.uk/>)

Research Data Service – provide advice on data planning, management and sharing. (<https://data.bris.ac.uk/>)



The other guides in this series are available from the Connected Communities website.

So you want to do collaborative research...
A University of Bristol guide to the practicalities
https://connected-communities.org/index.php/project_resources/so-you-want-to-do-collaborative-research-a-university-of-bristol-guide-to-the-practicalities

Getting Paid – A guide to claiming payments from the University of Bristol
https://connected-communities.org/index.php/project_resources/getting-paid-a-guide-to-claiming-payments-from-the-university-of-bristol

So you want to do collaborative research...
A University of Bristol guide to the ethical considerations
<https://connected-communities.org/wp-content/uploads/2016/05/UoB-CLK-guide-3-AW.pdf>