

**Workshop**

## Negotiating IP Ownership

**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 participation of

- Students, and
- Visiting Scientists

in research projects subject to contractual obligations.

**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

**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.

## NEGOTIATING IP OWNERSHIP

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

|       |  |  |
|-------|--|--|
| 8.45  | <b>Arrive</b>  |  |
| 9.00  | <b>Joint ownership of IP, its unexpected implications, and why joint ownership is not necessarily an attractive concession</b> | 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.  |
|       | <b>IP Ownership Models in Research Agreements</b>  | <i>(where a university / research institute undertakes research, and a company provides funding but makes no inventive contributions)</i><br><br>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 |
| 11.00 | <b>Morning Tea</b>   |  |
| 11.15 | <b>IP Ownership Models in Collaboration Agreements with a Company</b>  | <i>(where a university / research institute and a company jointly undertake research together, and are jointly inventive)</i><br><br>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.                           |
|       | <b>IP Ownership Models in a Collaboration Agreement between two or more universities / research institutes</b>                 | <i>(where two or more universities / research institutes undertake research together, and are jointly inventive)</i><br><br>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.   |
| 1.00  | <b>Lunch</b>   |  |
| 1.30  | <b>Negotiating an alternative to IP ownership: Rights of First Refusal and Options to Negotiate a License</b>                  | 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.  |
|       | <b>IP chain of title defects that arise. Potential liabilities that arise. How to avoid them. How to fix them</b>              | When you don't own the IP that you think you do: IP created by employees, academic scientists, company directors, visiting scientists, students, contractors, clinicians, etc. Laws that place IP ownership otherwise than where would be expected. Particular chain of title issues arising in the software industry.   |
| 3.00  | <b>Afternoon Tea</b>   |  |
| 3.15  | <b>IP Ownership due diligence</b>  | What an IP ownership due diligence is – what to look for, and how its done. Impact on IP ownership warranties. Preparing for a due diligence. Undertaking a due diligence.   |
|       | <b>Negotiating IP Ownership warranties</b>   | Customary warranties dealing with IP ownership in relation to different types of IP. Why different types of IP need warranties framed differently. When, how, and extent of qualifications to warranties. Approach to warranties in license agreements, collaboration agreements, and R&D agreements.  |
| 5.00  | <b>Close</b>   |  |