

# **Getting it right from the beginning**

**Some (mostly IP) issues that can arise during collaboration**

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## Firstly, a disclaimer...

- This talk isn't legal advice – just some personal observations and general discussion points
- If you need formal advice on IP in collaborations or other legal issues around collaboration, your university's tech transfer department is the place to start.
- They may have the required expertise themselves, or you may be referred to:
  - A patent (or trade mark) attorney engaged to advise your university
  - A solicitor engaged to advise your university
  - Other bodies who can help, for example Innovation Centres

## Talk overview

- Some good things about collaboration, and some problems that might arise
- Making a plan and getting it in writing
- Some aspects of IP to consider
- From a personal point of view, what good collaboration might look like

## Good things that can occur through collaboration

- Make use of another party's skills, experience, specialist knowledge (including intellectual property) or facilities
- Use your own skills, experience, specialist knowledge (including intellectual property) or facilities in a new context
- Achieve things that you couldn't do alone
  - Advance research/development
  - Take a product to market
- Funding (e.g. matched funding, European funding)
- Impact

## But what if...

- ...you disagree about which knowledge/IP belongs to which party?
- ...your collaborator publishes something before you are ready?  
...or you want to publish but your collaborator disagrees?
- ...everybody wants to apply for a patent but nobody wants to pay for it?
- ...the company you're collaborating with gets taken over by another company?
- ...one party wants to leave the collaboration?

## Structuring your collaboration

- Will be planning the research goals of the collaboration, and the roles of the collaborating institutions or companies
- Also important to consider other issues such as IP, even (or especially!) if they will arise only rarely during the collaboration
- A lot of time and difficulty can be saved by making a plan upfront
- Funders may require a formal collaboration agreement as a condition of funding
- Universities/companies/funders may also have standard conditions for use of IP, facilities, materials etc.

## Collaboration agreements

I don't work on collaboration agreements - this information is from my colleague Simon Portman's chapter in [The Innovation Handbook](#) (the relevant chapter is also available on [www.marks-clerk.com](http://www.marks-clerk.com))

- Written agreement laying out:
  - Each party's obligations
  - Rights and remedies if another party fails to meet its obligations
- Gives you a written document to refer to if there is a misunderstanding or a dispute
- Grant funders may require that parties enter into a research collaboration agreement with specified terms

## Collaboration agreements

- Who are the contracting parties
- Scope of project and each party's role
- Non-disclosure agreement
- What background IP each party is applying to project (+ licence terms)
- How IP generated will be owned and used
- Whether parties can use subcontractors
- What happens if a party leaves the project or a new one joins, or if funding is no longer available
- What happens if a party sells its business or undergoes a change of control
- What contractual breaches merit a party being expelled from the collaboration, e.g. failing to perform role in project, disclosing another party's confidential information, becoming insolvent

## Get it in writing!

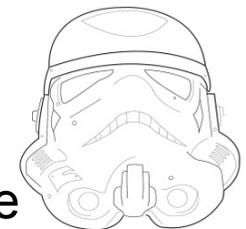
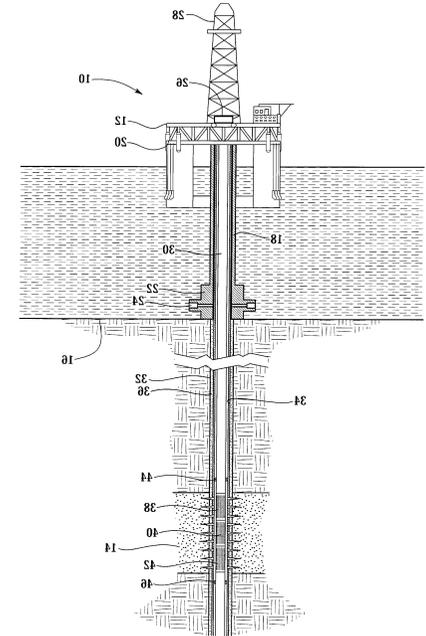
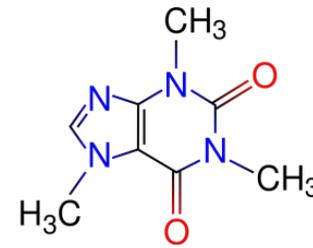
- Sets out expectations
- Puts all parties literally 'on the same page'
- Can refer to it months or years later

## Turning to IP...

- Intellectual property is far from the only issue that needs to be considered when starting a collaboration, but it provides some clear examples of when it's useful to get things right from the start

## What is intellectual property (IP)?

- Patents
  - technical: products, apparatus, manufacturing methods
- Trade marks
  - company name, logo, product name
- Designs
  - industrial design: shape/ornamentation
- Copyright
  - software, drawings, operation manuals, website, marketing literature
- Know how and confidential information
  - trade secrets, staff knowledge, manufacturing methods



## What do you bring into the collaboration (background IP)?

- Each party to the collaboration will bring in their own knowledge and experience, including intellectual property (that's often why they want to collaborate!)
- Before entering a collaboration, it's important to know what your IP is – whether it's protected by patents etc. or kept secret
  - May choose to file a patent application before entering collaboration to define your IP
- Collaboration agreement may allow other collaborating parties to use your IP for the purposes of the collaboration (but may limit other use)

## IP generated during the collaboration (foreground IP)

- The collaboration may be intended to invent or develop IP, or IP may arise incidentally
- In technical fields, the mostly likely type of IP might be a patentable invention or know-how, but designs and copyright also possible
- If moving towards a commercial product, trade marks may also become relevant
- A patent usually takes years to grant and can last for 20 years, which is probably longer than the collaboration

## IP generated during the collaboration (foreground IP)

- Issues to consider include:
  - Who owns any IP generated? One party? Jointly owned?
    - Some options include: everything joint, divide by technology, divide by inventors
  - Who can use any IP generated?
  - Who pays for IP to be protected?
    - Obtaining a patent can cost many thousands, especially if you want wide geographical coverage
  - Who decides on IP strategy?
    - Which patent applications to file?
    - Which countries to file in?
    - What if party A loses interest in the IP – can party B take it over?

## Managing IP in a collaboration

- Normal for one person/institution to take the lead on IP, with an agreement on how others will contribute (e.g. financially)
- Invention capture process
  - May be a standard process in place in your university and/or in a collaborating company
  - Record what invented, who inventors are
  - Some collaborations have IP as standing item at collaboration meetings
- Approval process for publications (early publication can kill a patent)

## Publish or patent?

- If an invention has been ‘disclosed to the public’ then, in most countries, it can no longer be patented
  - ‘Disclosure’ can include not only papers but conference presentations, posters, or even just telling someone who isn’t bound by confidentiality
- Important to get a patent application on file before disclosing, but choose time carefully – starts the clock ticking
- Good collaborations have a review process for both publications and patent applications, to pick up on and resolve possible conflicts

## Authorship ≠ inventorship ≠ ownership

- Academics are usually familiar with the conventions of their field on authorship
- Misunderstandings can arise when it is assumed that the inventors of an invention are the same people that would be authors of the paper
  - Specific legal standards for inventorship – talk to your tech transfer department
- Ownership of a patented invention is initially related to who invented it, but can be transferred
  - e.g. in a partnership with industry, may agree that IP belongs to the industrial partner even if invented by academic

## From my point of view, what does good collaboration look like?

- Excellent communication
- Respect the other parties in the collaboration and understand their point of view
- Good processes: meetings, invention capture, record-keeping, publication approval
- Enough knowledge of possible issues to spot when something might be going wrong - know who to turn to, and address issues early
- Both/all parties are clear on what they want, and have a plan to get there

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