

Workshop

Negotiating IP Ownership

Level**Intermediate****Duration****1 day** – 8.30am to 5.00pm.**Program**

A detailed description of the workshop program is below.

How this workshop helps tech transfer professionals

The ownership of intellectual property is often a controversial issue when negotiating collaboration agreements and R&D Agreements.

Amongst the controversies:

- Should IP be owned by one party, or the other?
- Can IP rights to one party be negotiated instead of ownership?
- What types of IP rights might be an acceptable substitute for IP ownership?
- What models to resolve IP ownership controversies are there?
- What are the advantages and disadvantages of particular models?

Sometimes parties agree to joint ownership in the expectation that joint ownership gives them equal and mutual rights.

But, unharmonised joint ownership laws around the world affecting patents, copyright and confidential information more typically result in the parties having unequal rights.

Often, joint ownership operates to the disadvantage of one joint owner, or even to the disadvantage of all the joint owners.

How should ownership of IP be allocated in collaborative research relationships?

- Should it be based on inventorship?
- Should it be based on whose IP is improved?
- Should ownership be based on the type or category of IP?
- Should ownership be joint?
- What models are available to allocate ownership in a collaborative research relationship?
- What influences one model being preferred over another?

This one day workshop focuses entirely on the controversial question of the ownership of intellectual property. It will answer all these questions, and develop your knowledge and skills to negotiate this often controversial issue.

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.

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

8.30	Registration	Overview of the day.
9.00	Joint ownership of IP, its unexpected commercial implications, and why joint ownership is not necessarily an attractive solution	Joint ownership of IP suggests that the joint owners have equal and mutual rights over the jointly owned IP. But unharmonised laws in different countries result in one joint owner being disadvantaged, or even all the joint owners being disadvantaged. Why joint ownership laws in other countries must be considered. Implications of joint ownership of patents, copyright, confidential information in various countries considered. Potential adverse financial and bargaining implications of joint ownership. Recommendations for managing and dealing with joint ownership.
10.00	IP ownership models in joint ventures and R&D collaborations	Models for IP ownership in JVs and R&D collaborations – inventorship model; improvements model, category model, joint ownership model, joint venture company model. Criteria for selecting one model over another. Models for allocating joint ownership proportions between the joint owners.
11.00	Morning Tea	
11.30	IP Ownership and rights models in R&D Contracts	Models for IP ownership when contracting research and development with Contract Research Organisations (for-profit companies), and non-for-profit universities, research institutes, and polytechnics. Factors influencing one model over another.
12.15	Negotiating an alternative to IP ownership: Rights of First Refusal for a license and Options to Negotiate a License	How these are used in IP ownership negotiations. Their legal status considered in Singapore, Malaysia, United Kingdom, Australia, United States and Europe. Implications of unharmonised laws in relation to rights of first refusal and options to negotiate. Liabilities if obligations are breached. Adverse financial and bargaining implications of rights of first refusal and options to negotiate.
1.00	Lunch	
2.00	IP chain of title defects that arise. How to avoid them. How to fix them	When you don't own the IP that you think you do: IP created by employees, academic scientists, company directors, visiting scientists, students, contractors, etc. Laws that place IP ownership otherwise than where would be expected. Particular chain of title issues arising in the software industry. R&D contracting generally.
3.00	Afternoon Tea	
3.30	IP Ownership due diligence	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.
4.00	Negotiating IP Ownership warranties	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	Close	