

Guidelines on Elaboration of Intellectual Property Policy and Strategy

For an effective use of the IP System by Universities and
Research and Development Institutions in Africa



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ABBREVIATIONS/ACRONYMS

ARIPO	African Regional Intellectual Property Organization
FIT	<i>Funds in Trust</i>
GERD	Gross Domestic Expenditure on Research and Development
IP	Intellectual Property
IPMO	Intellectual Property Management Office
IPR(s)	Intellectual Property Right(s)
JPO	Japan Patent Office
OAPI	<i>Organisation Africaine de la Propriété Intellectuelle</i>
R&D	Research and Development
TCEs	Traditional Cultural Expressions
TTO	Technology Transfer Office
WIPO	World Intellectual Property Organization

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1. INTRODUCTION

These Intellectual Property (IP) Policy and Strategy formulation Guidelines are aimed at fostering more effective use of the IP System by universities and research and development institutions in Africa. African societies have always been innovative and have thus developed their knowledge and technological bases, adapting to changing conditions and cultures². However, research institutes and universities on the continent are not providing solutions that adequately address pressing societal challenges. In addition, most African research institutes and universities are still engaged in teaching and basic research activities³. As such, they are, missing out on the opportunity to become the birthplaces of pioneering discoveries, innovations and inventions that can enhance the quality of lives of millions of Africans.

Etzkowitz⁴ and Clark⁵ noted the emergence of an “Entrepreneurial University”. Per the concept of Entrepreneurial Universities, a “Third Mission” where universities and research and development institutes contributed to economic development emerged alongside the “First Mission” of teaching and the “Second Mission” of conducting basic research.

For the Entrepreneurial University, “... *identifying, creating and commercializing intellectual property have become institutional objectives.*” Such universities are epitomized by institutions such as the Massachusetts Institute of Technology (MIT) and Stanford University in the United States of America.⁷

The above activities may be undertaken with the aim of “...*improving regional or national economic performance as well as the university’s financial vantage and that of its faculty*”⁸.

The emergence of this entrepreneurial “species⁹” was not to signify the last chapter in the ever-evolving modern university. In the last 15 years, the physical condition of the planet and natural capital reserves have continued to worsen, threatening the sustainability of global economic activities¹⁰.

In many institutions, local manifestations of the global sustainability crisis are prompting a deviation from the pursuit of income generation and economic development alone. A broader and more ambitious function has emerged: that of a societal transformer and co-creator. Boundaries between ‘town and gown’ are dissolving as university actors collaborate

²<https://books.google.ch/books?hl=en&lr=&id=h9HDYNhYqfAC&oi=fnd&pg=PR3&dq=african+societies+and+knowledge+creation+and+innovation&ots=XYmZ0tvVa1&sig=YaX6TZ4BnwISyGge09XT09d-2X4#v=onepage&q&f=false>

³ https://www.codesria.org/IMG/pdf/Ndri_lumumba.pdf

⁴ Etzkowitz, H. (1998). ‘The norms of entrepreneurial science: Cognitive effects of the new university–industry linkages’, *Research Policy*, 27(8): 823–33.

⁵ Clark, B. R. (1998). *Creating Entrepreneurial Universities: Organizational Pathways of Transformation*. Oxford, UK: IAU Press and Pergamon.

⁶ http://www.finhed.org/media/files/05-Clark_-_Creating_Entrepreneurial_Universities.pdf

⁷ Etzkowitz, H., Webster, A., Gebhardt, C., & Terra, B. R. C. (2000). ‘The future of the university and the university of the future: Evolution of ivory tower to entrepreneurial paradigm’, *Research Policy*, 29(2): 313–31

⁸ Etzkowitz, H., Webster, A., Gebhardt, C., & Terra, B. R. C. (2000). ‘The future of the university and the university of the future: Evolution of ivory tower to entrepreneurial paradigm’, *Research Policy*, 29(2): 313–31

⁹ Martin, B. (2012). ‘Are universities and university research under threat? Towards an evolutionary model of university speciation’, *Cambridge Journal of Economics*, 36(3): 543–565.

¹⁰ Rockstrom, J. W., Steffen, W., Noone, K., Persson, A. *et al.* (2009). ‘A safe operating space for humanity’, *Nature*, 461(7263): 472–475.

with local government, industry and civil society¹¹ to drive the physical and sustainable transformation of a specific locality, region or societal subsector, often with ambitions to influence a much broader geographical area.

Admittedly, many of the methods and approaches adopted in such partnerships appear a little more than an accentuation of more traditional paradigms such as agricultural extension, action and participatory research, transdisciplinary, technology transfer, urban reform and regional development among others.

Moreover, it appears novel in the emerging co-creative function to combine these various modes of societal engagement into a systematic response to localized sustainability challenges and, the integration of values of sustainable development. Thus identifying, Creating and Commercializing Intellectual Property have become institutional objectives in modern universities¹².

However, according to a recent situational IP analysis commissioned by the World Intellectual Property Organization (WIPO)¹³, most African universities and research institutes are still struggling to establish institutional IP policies and strategies that constitute an important step towards protecting their interests. For example, when a research institute/university in Africa commercializes an invention, an IP policy can be used to establish an equitable basis for resolving issues related to ownership, disclosure, and equitable distribution of income resulting from use of the invention.

Further, well-designed IP policies and strategies in line with national or regional socio-economic priorities, rules and regulations will address challenges identified during the aforementioned IP situational analysis commissioned by WIPO. Some of these challenges include; lack of IP awareness and guidelines on the interface between university IP policies and contractual arrangements with other bodies, lack of IP awareness and guidelines on visitors and student internship/apprenticeship and limited access to IP sensitization and hands-on training services for university/research institute stakeholders.

Other challenges include a high number of patent applications that do not satisfy requirements for patentability and/or poorly drafted; higher premium on dissemination of research results through scientific publications (the 'publish or perish ethos').

Yet other challenges include lack of specialized structures in identification of potential IP assets, particularly at universities/research institutes and lack of appropriate mechanisms to detect research outputs with potential to become IP assets.

¹¹ Mero, T. (2011). 'Town and gown unite', *Sustainability*, 4(4): 169–73.

¹² In 2000, universities and scientific research institutes accounted for 13.2% of domestic patent applications in China and in May 2002, China announced that research institutes were to be encouraged to file patents relating to government-sponsored research.

In 2001, India's principal scientific organization, the Council of Scientific and Industrial Research, was the second largest PCT (what's PCT?) applicant from developing country institutions.

¹³ Benchmark Country Study for WIPO-ARIPO Project on Elaboration of Guidelines of Intellectual Property (IP) Policy and Strategy for Effective Use of the IP System by Universities and Research and Development Institutions in Africa. August 2017.

The above and other considerations were used to formulate the guidelines presented herein, with the view to support universities in addition to research and development institutes to establish institutional IP policies and strategies that better support present mission priorities. For example, if an institution or faculty's top priority is education and dissemination of knowledge, then the IP policy should favor faculty ownership or release of IP into the public domain, with less emphasis on IP protection. Conversely, if Research and Development (R&D) activities are the institution's top priority, then the institution should have greater control of IP. For example, more flexible licensing arrangements with industries, encouraging industry funding or more emphasis on industry needs should be pursued.

If the institutional mission emphasizes technology transfer and commercialization, even greater institutional control of IP may be most appropriate; IP strategies geared towards commercialization such as exclusive licensing, flexible royalty sharing with inventors to induce disclosures and choosing the best commercial partners for any given technology should be pursued.

Finally, if the institutional mission priority is socioeconomic development, then a more-balanced IP ownership policy that promotes technology transfer, driven by economic development opportunities, may be preferred. Such an approach might focus on licensing regional companies and encouraging local spin-outs by providing incubator facilities. Since economic policies will drive development and implementation of the IP policy that most supports economic growth, there should also be built-in flexibility to accommodate changes in the economic climate.

These Guidelines are developed to help research institutes/universities in Africa to put in place institutional IP policies and strategies that are in line with prevailing national and regional legal frameworks and address IP Ownership, IP Exploitation and Commercialization, and Benefit Sharing from African perspectives.

The Guidelines further intend to direct research institute/university administrators to establish workable and beneficial IP policies for their institutions. They further aim at promoting reflection and critical thinking and to deepen understanding on how best to address IP issues within the African research institute/university context.

- i. The Guidelines set out the procedure and code of practice governing the management and commercial exploitation of research institute's/university's IP and the use of third-party IP to: Clarify ownership criteria for IP rights and obligations of all parties;
- ii. Streamline roles and responsibilities in relation to the management and utilization of IP;
- iii. Enhance utilization of third-party IP to prevent infringing the rights of others and;
- iv. Specify the code of practice when dealing with distribution of revenue or equity resulting from IP commercialization.

PART 1

2. OBJECTIVES

The core mission of the research institute/university is training and conducting research, problem-solving and developing innovative abilities in addition to promoting the advancement, preservation and dissemination of knowledge among others. In fulfilling the above, the research institute/university must seek to protect the rights and privileges of its stakeholders whilst balancing this role with that of fostering socio-economic transformation through sharing information with the public.

The objectives of developing an institutional IP policy /strategy therefore are to;

- i) encourage the identification, generation, protection and commercialization of IP created by staff, researchers, students, collaborators, visitors and partners;
- ii) ensure research findings, inventions, innovations and creative works are used for public benefit;
- iii) promote progress in research and development and;
- iv) outline modalities and mechanisms through which staff, researchers, students, collaborators, visitors, partners and other stakeholders can equitably/fairly protect the IP they create for their benefit and socioeconomic transformation.

3. SCOPE

Per these Guidelines, unless otherwise specified, reference to IP means all forms of IP rights that are existent, vested or any IP that might arise at a future date, whether arising out of legislation or existing in law as amended or replaced from time to time. This includes, but is not limited to, all rights including the right to registration, in relation to:

- Copyright works as defined by the Copyright Act or Law of the research institute/university's home country;
- Inventions including both products and processes which may be patentable under the Patents Act or Law of the research institute/university's home country;
- Patents, whether standard or provisional as defined in the Patents Act or Law of the research institute/university's home country;
- Utility Models;
- Industrial Designs;
- Plant varieties qualifying for rights under the Plant Breeders' Rights Act or IP law of the research institute/university's home country;
- Trademarks, whether registered or not, as defined by the Trademarks Act or IP Law of the research institute/university's home country;
- Eligible layouts as defined by the Circuits Layouts Act or IP Law of the research institute/university's home country;
- Confidential information protected by either contractual or equitable law;
- Designs as defined by the Designs Act or IP Law of the research institute/university's home country;
- All IP owned or managed by the research institute/university;
- All IP created on or after [date] and all IP Rights associated with them and;
- Any other relevant forms of IP not expressly dealt with in this policy guideline.

These Guidelines are concerned with the management and use of IP owned by, and/or created within the research institute/university, be it in research, teaching, commercialization or other activities. They are also concerned with the use of Third-Party IP to ensure freedom of use for the research institute/university's activities.

4. DEFINITIONS

The definitions herein are indicative. It is recommended that any research institute/university contextualizes them per its mission and goals.

Academic and Artistic Works: Personal art works, books (including textbooks), educational courseware, syllabi, lesson plans, articles, works of non-fiction, novels, poems, musical works, dramatic works including any accompanying music, pantomimes and choreographic works, architectural drawings, design artefacts, pictorial, graphic and sculptural works, software, motion pictures and other similar audio-visual works, and sound recordings.

Benefit: Contribution to a society's socio-economic needs including in the form of capacity development, knowledge and technology transfer, job creation, enterprise development, social empowerment and products, or processes or services that embody or use the IP.

Commercialization: Includes any activity or initiative undertaken with the objective of, or that could contribute to, development or exploitation of IP in ways that might or are intended to generate commercial returns or other material benefits to the owners of the IP.

Commercialization Costs: All expenses incurred for the following: protecting any research institute/university IP; third party expenses in connection with developing, marketing or licensing any research institute/university IP; contractual obligations associated with any research institute/university IP such as distributing revenues to joint owners or joint inventors who are not research institute/university personnel through inter-institutional agreements.

Computer Software: Any computer program including, and without limitation to, microcode, subroutines and operating systems, regardless of form of expression or object in which it is embodied, together with any user manuals and other accompanying explanatory materials and any computer database.

Confidential Information: Any and all written information communicated between participants in the framework of a project clearly identified or marked as being confidential at the moment of its disclosure, except for the information which the receiving party can prove (a) is, at the time of communication, being in the public domain, (b) after the communication, becomes part of the public domain by publication or otherwise, except by breach of this agreement by the receiving party, (c) is obtained from a third party not in breach of any obligation of confidentiality, (d) is known by the receiving party prior to the date of the communication, and (e) is required to be disclosed by the receiving party pursuant to any applicable law or judicial or governmental order, provided that the receiving party shall give immediate written notice of such requirement to the disclosing party with the view to agreeing the timing and the content of such disclosure.

Consulting Agreement: An accord for the provision of consulting or a related service in which the parties include the research institute/university personnel; and a third party that is not affiliated to the research institute/university.

Copyright: An IP right pertaining to the exclusive legal right, given to an author or an assignee of a literary, artistic or scientific work.

Copyrighted Works: Literary, scientific and art works, including academic publications, scholarly books, articles, lectures, musical compositions, films, presentations and other materials or works other than software, which qualify for protection under the copyright law.

Course: A comprehensive set of works that has been developed and combined to substantiate a presentable program of study. Courses often transcend a single faculty member's design, to engage institutional sanction and authority. For example, Rensselaer owns all Courses developed for teaching at Rensselaer Polytechnic Institute.

The use within Course of Course Materials or other Exempted Scholarly Works, standing alone, shall not deprive creators of their ownership of such materials.

Course Material: Any material, whether electronic, digital, written or in any other media format, created by an employee specifically for use in, or in connection with, a course, subject or unit offered by the research institute/university including, but not limited to, all: lecture notes; lecture materials including course outlines and reading materials; audio-visual works; online material; assessment and examination questions; any computer programme written by an employee; any other copyright works created by an employee for the purpose of teaching a course or unit offered at the research institute/university.

Creator / Inventor: Any person or persons to whom this Policy is applicable, who create, conceive, reduce to practice, author, or otherwise make a substantive intellectual contribution to the creation of IP and who meet the definition of 'inventor' as generally defined in Patent Acts and/or the definition of 'author' as generally defined in Copyright Acts.

Dissemination: Disclosure by any appropriate means other than that resulting from the formalities for protection, and including the publication in any medium.

Employee: A person who has entered into an employment relationship with the research institute/university, whether academic or professional, administrative or support staff, paid or unpaid, full-time or part-time, full appointment or joint appointment, affiliation appointments or assistantships.

Expenses: Costs assignable to the management of a research institute/university's IP including those for achieving and maintaining patents or other IP protection, financing costs, loans, marketing, licensing and other legal actions related to the enforcement of IP and contract rights, which do not include staff time or general administrative expenses.

In the course of their employment means any such duties of an employee as set out in and incidental to their Employment Contract with the research institute/university, including involvement in a research institute/university project.

Industrial Design: An IP right that protects the ornamental or aesthetic aspect of an article. An industrial design may consist of three dimensional features such as the shape of an article or two dimensional features, such as patterns, lines or color.

Intellectual Property (IP): All outputs of creative endeavor in any field that can be protected either statutorily or not, within any jurisdiction, including, but not limited to, all forms of copyright, design right, whether registered or unregistered, patent, patentable material, trademarks, know-how, trade secrets, rights in databases, information, data, discoveries, mathematical formulae, specifications, diagrams, expertise, techniques, research results, inventions, computer software and programs, algorithms, laboratory notebooks, business and research methods, actual and potential teaching and distance learning material, research institute/university's name, badge and other trademarks associated with the operations of the research institute/university, Tangible Research Property, and such other items as a research institute/university may from time to time specify in writing.

Intellectual Property Agreement (IPA): Any written contract entered into between an employee, student, or third party and the research institute/university which relates to the ownership and use of any form of IP which may arise.

Intellectual Property Disclosure Form: The form which is completed by a Creator(s) to document their Invention(s) and provide key information regarding the Creator(s), funding used to develop the IP and the rights of third parties, for submission to the IP Committee for assessment of the IP.

Intellectual Property Rights (IPRs): Ownership and associated rights relating to IP, including patents, rights in utility models, plant breeders rights, rights in designs, trademarks, topography rights, know-how, trade secrets and all other intellectual or industrial property rights as well as copyrights, either registered or unregistered and including applications or rights to apply for them and together with all extensions and renewals of them, and in each case all rights or forms of protection having equivalent or similar effect anywhere in the world.

Invention: A new, useful and non-obvious discovery, process, composition of matter, article of manufacture, design, mask work, model, technological development, biological or plant material, strain, variety, culture or portion, modification, improvement, translation, or extension of these items. It includes any discovery, invention or other development of a technical nature, whether or not patentable.

Net Revenues: The Gross Revenue received by the research institute/university, in consideration for a commercial transaction.

Outside Activity: Activity of a research institute/university employee that occurs entirely outside of research institute/university employment and entirely without use of research institute/university resources.

Personnel: A person or a group of people employed by a research institute/university responsible for various organized undertakings of the research institute/university.

Public Disclosure: In the absence of a non-disclosure or confidentiality undertaking, the oral or written communication of information relating to IP to a person, or people, that are external to research institute/university for example, by email, web blog, news report, press release or interview, journal article, abstract, poster, conference presentation and through the submission of a thesis for examination and others. A thesis or dissertation placed in the library constitutes public disclosure.

Public Domain: Works that do not qualify for protection under any IP title, either because the rights have expired or the rights have been forfeited and as such are held by the public at large and are available for anybody to use without permission from the original creator or the original right owner.

Research Agreement may refer to Research Service Agreement, Cooperative Research and Development Agreement, Material Transfer Agreement, Confidentiality Agreement, Consultancy Agreement and any other type of agreement concerning research pursued by researchers and/or IP created at the Research Institute/University.

Research Data: Recorded factual material commonly accepted by the research and scholarly communities as necessary to validate research findings, but not any of the following: preliminary analyses, drafts of scholarly manuscripts, plans for future research, peer reviews or communications with colleagues.

Research Institute/University Resources include, but are not limited to, research institute/university facilities, office space, funds, financial or other administrative support, equipment, personnel, tangible research materials, information that is not freely available to the public, contract or other type of award or gift, any form of funds, facilities or resources, including equipment, consumables and human resources directly or indirectly provided by the research institute/university.

Researcher: Someone who carefully and comprehensively conducts an organized and systematic study or investigation ('research') into a subject to interrogate existing and discover new information that improves the understanding of the subject matter. A researcher may be:

- i) a person employed by the research institute/university, that may be as a student, employee or technical staff;
- ii) a student (graduate or postgraduate) of the research institute/university;
- iii) any person, including a visitor, who uses the research institute/university's resources and who performs any research task at the research institute/university or otherwise participates in any research project administered by the research institute/university, including those funded by external sponsors.

Scholarly Copyrightable Work: Copyrightable work created by any person subject to this policy primarily to express and preserve scholarship as evidence of academic advancement or academic accomplishment. Such works may include, but are not limited to, scholarly publications, journal articles, research bulletins, monographs, books, plays, poems, musical compositions and other works of artistic imagination, and works of students created in the

course of their education, such as exams, projects, theses or dissertations, papers and articles.

Spin-off: A company established for the purpose of exploiting IP originating from the research institute/university.

Sponsored Project: A research institute/university-sanctioned project or research institute/university-sanctioned work that arises out of or is supported by the contribution of funds, equipment, facilities, or other consideration by the research institute/university or an outside party facilitated through the research institute/university. Sponsored projects include, but are not limited to, company-sponsored student courses, projects funded by federal or private grants, work using special resources provided by a third party, and special projects or courses funded by the research institute/university and designated by the research institute/university as a Sponsored Project.

Staff: Personnel/officers employed by the research institute/university and are responsible for the internal and/or external operations of the research institute/university. If a student is also a Research institute/university employee, he or she is considered as staff with regard to IP developed as a result of his or her employment, and as a student with regard to other IP. Staff also includes central administration staff and museum staff working on research institute/university projects.

Stakeholders: Entities, both persons and organizations that have an interest in and/or investment in research and/or IP of the research institute/university and are impacted by and care about the outcomes of research and/or IP at the research institute/university.

Start-up: A company created by people outside the research institution built on a license from a research institute/university.

Student: Any fulltime or part-time graduate or undergraduate student enrolled at the university. This includes persons:

- (i) who have been accepted for admission to or enrolled for any course or programme offered at or in conjunction with the university or;
- (ii) whose body of work, completed while so enrolled (e.g. a research dissertation or thesis), is still under examination.

Substantial Use of Research Institute/University Facilities: Extensive unreimbursed use of a research institute/university's laboratory, studio or computational facilities, IP, funds, or human resources. The use must be requisite or important to the creation of the IP; minimal use of a facility does not constitute substantial use. Extensive use of a facility or equipment commonly available to all faculty or professional staff such as libraries, personal computers, and offices does not constitute Substantial Use of a research institute/university's facilities for purposes of this policy, nor does extensive use of a specialized facility for routine tasks. Whether use constitutes a Substantial Use of a research institute/university's facilities shall be determined in the reasonable discretion of Management, in consultation with the relevant department head(s). While extensive use of a facility or equipment commonly available to all faculty or professional staff does not constitute Substantial Use of a research institute/university's facilities under this policy, other research institute/university policies may limit such use or require reimbursement to the research institute/university.

Teaching and Learning Materials: These include many different forms of IP and IP Rights. As well as traditional paper-based material, teaching and learning materials include digital media, web-based content, broadcasts, video and audio materials, and software. Teaching and learning materials also include copyright for printed materials and software. Further, IP Rights can include performing rights, design rights, database rights and trademarks. Moral rights for the creator of the material also exist for the copyright materials.

Technology: Tangible and intangible results of research and scholarship and related IP rights, whether or not patentable or copyrightable, but excluding copyrightable works as defined above. Technology may include, but is not limited to, Prototype devices; Novel biological materials; New Chemical Compounds; Materials having novel optical or electronic characteristics; and Software and programming code, where software is not excluded as a Copyrighted Work.

Technology Transfer Office (TTO): Research Contracts and IP Services of the research institute/university.

Third Party: Any legal entity which is not party to a contract or a transaction, but has some involvement.

Traditional Knowledge: “Traditional knowledge (TK) is a living body of knowledge passed on from generation to generation within a community. It often forms part of a people’s cultural and spiritual identity. WIPO’s program on TK also addresses genetic resources (GRs) and traditional cultural expressions (TCEs).”¹⁴

Visiting Researcher: An individual or individuals having an association with the research institute/university without being either employees or students. These include academic visitors, individuals with honorary appointments in the research institute/university and emeritus staff.

Visitors: Persons not affiliated to the research institute/university that visit, reside or are present with approval at research institute/university’s premises for academic, research and other relevant approved purposes.

Work Made for Hire: A creation or original work of authorship created by a research institute/university employee within the scope of his or her employment, or specified by agreement and as further defined by specific rules.

5. IMPLEMENTATION & SUPPORT FOR IP¹⁵

An IP Committee and an Intellectual Property Management Office shall be established on commencement of the IP Policy. The Committee and Management Office shall be structured according to the objectives of the Policy and the management system of the research institute/university.

¹⁴ <http://www.wipo.int/tk/en/igc/>

¹⁵ The Committee will perform a review function only. The formulation of policies and the preparation of related documents are the responsibility of the Technology Transfer Office (TTO).

5.1 Intellectual Property (IP) Advisory Committee¹⁶

An IP Advisory Committee shall be established on commencement of the Policy. It shall be structured according to the purposes/principles/objectives of the Policy and the research management system of the institution. The Committee shall include representatives of all key stakeholders.

The IP Advisory Committee shall be the link between the Top Management Organ of the university/research institute and the office responsible for the management of IP rights (TTO). The Advisory Committee will handle policy and governance issues and advise the TTO on technical issues. Specifically, the IP Advisory Committee will have the following functions:

- a) Review directions, issues, and current or proposed policies and documents relating to the management of IP;
- b) Make recommendations on amendments to the IP Policy;
- c) Manage disputes arising directly from the IP Policy;
- d) Manage disputes involving institution/university-owned IP and recommendations concerning their resolution;
- e) Give guidance and assistance to the institution/university in matters involving institution-owned IP;
- f) Resolve issues related to ownership of IP;
- g) Assist in increasing IP awareness among the institution/university's publics; and;
- h) Perform such other responsibilities as required to comply with state laws with regard to the institution/university's intellectual properties and the IP policy.

The IP Advisory Committee shall meet at least quarterly.

5.2 The IP Management Office/Technology Transfer Office¹⁷

The duties and responsibilities of the IP Management Office (IPMO)/Technology Transfer Office (TTO) shall be related to: Disclosure, Protection, Commercialization, Policing (Monitoring) and Raising Awareness. Specifically, the office shall carry out the following functions:

- a) Foster public support for research by showing public benefit (namely, new products);
- b) Stimulate industrial support for research;
- c) Foster community engagement by supporting job and new enterprise creation;
- d) Help researchers and students attain entrepreneurial skills and mindset;
- e) Advise the research institute/university on matters relating to IP;
- f) Recommend amendments to the Policy;
- g) Provide guidance and assistance to the research institute/university in matters involving research institute/university-owned IP;

¹⁶ The Committee may consist of four to five members headed by the Vice-Chancellor/ Director General who will be the Chairperson. The Chairperson may nominate/co-opt additional members with expertise in areas related to the IP concerned.

¹⁷ Identification of who shall administer and enforce the institution/university's IP policy is another key ingredient of the policy. It will be important for potential administrators of the IPMO/TTO to understand the criteria the research institute/university will use to decide when to seek IP (patent) protection and what happens if patent protection is not sought. This role is varied, but one of the first duties is to put in place a method for implementing the policy throughout the research institution/university. The IP Advisory Committee shall conduct an interview with the inventor or author and other persons as needed to make this evaluation.

A patentability evaluation shall in particular include a thorough evaluation of acts by the inventor or items of prior art which would bar patent protection.

- h) Keep a register of any IP that is protected, together with records of any income generated;
- i) Establish a system for providing guidance to staff about IP management at the earliest possible stage in the invention/innovation process to maximize the potential for the appropriate development of IP opportunities which may include commercial exploitation;
- j) Assist all those affected by the IP policy with procedures for recording IP activity to meet internal needs and to satisfy the requirements of external organizations;
- k) Guide all those concerned by the IP policy to IP management tools (advice leaflets, IP registration and evaluation, confidentiality forms, etc.) to ensure the effective management of IP;
- l) Encourage those concerned by the IP policy to issue notice of IP rights related to any idea or other form of IP that they have developed at the earliest opportunity and before disclosure to any third party outside the research institute/university either orally or in writing;
- m) Scrutinize and review all funding and service level agreements for appropriate references to IPR and where appropriate, negotiate agreements relating to IP ownership prior to signing;
- n) Work with external organizations to ensure the effective management and exploitation of IP for purposes of income generation, technology transfer and stimulation of local and regional economic growth;
- o) Ensure compliance with IP provisions of the research institute/university, sponsored research grants and contracts;
- p) Create and distribute systems and procedures for the reporting of IPs in which the research institute/university has a proprietary interest;
- q) Perform initial assessments of the disclosures submitted to the research institute/university to determine the subsequent rights thereto;
- r) Provide procedures for disclosures based on an incentive scheme that specifies an adequate share for researchers in commercial transactions of IP created in terms of the IP policy;
- s) Provide services that facilitate the management, evaluation, protection, marketing and commercialization of the research institute/university IP through internal and/or external resources including, but not limited to, patent management agents, consultants and lawyers.
- t) Ensure that required agreements regarding the administration of IP in which the research institute/university has a proprietary interest, and consequent rights of all parties concerned, are properly executed;
- u) Promote IP awareness and training among the research institute/universities;
- v) Provide annual reports of IP in which the research institute/university has a proprietary interest and;
- w) Perform such other responsibilities that may be required to comply with state laws with regard to the research institute/university IPs and the IP Policy.

6. OWNERSHIP OF IP

6.1 General Principle¹⁸

Research institutes/universities recognize that the research institute/university employees, researchers, visitors, partners and students' activities may result in innovative and creative outputs. National laws provide that the creator of the work is the first owner of the IP rights.

This is why the general principle with regard to ownership of IP created in research institutes/universities is that the IP belongs to the Research Institute/University. However, the inventors/creators will retain the right to be named and share the benefits deriving from exploitation/use of the rights.

6.2 Creator-Owned Intellectual Property

Creators may retain full ownership rights to IP provided that the following conditions are met:

- (a) IP is not subject to a sponsored research or other agreement requiring ownership to reside in other party including a research institute/university;
- (b) IP was not conceived, created, developed, or first reduced to practice with Significant Use of research institute/university support;
- (c) IP was not conceived, created, developed or first reduced to practice as a direct result of formal duties at the research institute/university.

6.3 Ownership of IP Created by Students/Interns/Apprentices

All works created by students/interns/apprentices during the course of their study at the research institute/university shall belong to the research institute/university provided that the students/interns/apprentices:

- Use substantial research institute/university resources;
- Use research institute/university-owned IP;
- Receive project-specific funding from the research institute/university or a third party engaged by the research institute/university;
- Use IP owned by another employee of the research institute/university or;
- Participate in a research institute/university project.

6.4 Research Institute/University-Owned IP

The research institute/university retains full ownership of rights to:

- a) IP subject to the terms of a sponsored research or other agreement that grants the research institute/university rights of ownership;
- b) IP whose conception, creation, development or first reduction to practice involved Significant Use of research institute/university support;
- c) IP that was conceived, created, developed or first reduced to practice as a direct result of duties at the research institute/university;
- d) R&D IP created by researchers (adjunct professors, emeritus professors, casual staff and other visitors) engaged in research or activities where the R&D IP is created directly through their appointment or responsibilities at the research institute/university, including through participation in research projects, collaboration with other staff, supervision of students of the research institute/university or while they utilize the research institute/university's facilities;
- e) Any physical object embodying the research institute/university's IP;

¹⁸ See WIPO database for Institutional IP policies

- f) Copyrighted material created as a 'work made for hire' by operation of copyright law or pursuant to a written agreement with transferring copyright to the research institute/university;
- g) All IP created in the course of postgraduate (master's and doctorate) students' research activities;
- h) IP created by employees of the research institute/university if the said IP was created within the scope of their employment or by written agreement with the research institute/university and;
- i) All courses developed for teaching at the research institute/university.

6.5 Ownership of IP Arising from Sponsored Projects/Collaborative and Contract Research

The following shall accrue to ownership of IP arising from sponsored projects/collaborative and contract research:

- a) The IP arising from sponsored or collaborative projects shall be owned by the research institute/university unless otherwise stated in the Contract Agreement;
- b) The ownership of IP arising from privately funded research will be negotiated as expressed in the Research contract and;
- c) The ownership of IP arising from work commissioned by the research institute/university will be owned by the research institute/university.

6.6 Ownership of IP for Research Conducted Outside the Research Institute/University

Ownership of IP for research conducted outside the research institute/university shall be governed by the following principles:

- a) Where a staff of a research institute/university visits other research/educational institutions or other organizations with a view of discussing research ideas or conducts research elsewhere during research or sabbatical leave, they must ensure that appropriate agreements regarding IP rights are concluded prior to the visit and;
- b) Unless otherwise agreed, such research shall be deemed to fall within the normal course of the staff member's employment and any resulting IP would be vested in the research institute/university.

6.7 Ownership of IP Arising from Consulting Agreements and Other Business Activities

- a) IP created under consulting agreements with any third party or other business activities is owned as provided in the consulting agreement or other applicable agreement or law, except in cases where consulting or other work involves Substantial Use of Research Institute/University Facilities that is not the subject of a written agreement with the research institute/university;
- b) The research institute/university shall make no claim to IP rights arising from wholly private consultancy work, provided no use is made of its resources or facilities.

These provisions include, but are not limited to, computer software written by staff employed by the research institute/university.

6.8 Ownership and Use of Specific Types of IP

6.8.1 Teaching and Learning Materials

The research institute/university shall own all teaching and learning materials that are:

- a) Developed by staff in the course of their duties while employed by the research institute/university;
- b) Otherwise created in the course of staff's employment, which shall be deemed to include in addition to any teaching and learning materials which: use significant resources of the research institute/university in their development such as multi-media materials, visuals or slide shows; video and audio material and presentations streamed or made downloadable over the intranet or Internet and;
- c) Specifically commissioned by the research institute/university from a member of staff (requested by a line manager – normally in writing), whether in return for a special payment or not or are produced in connection with a research institute/university's module/course/ programme including teaching and learning materials produced for issue to students for example, handouts, summaries, case studies, seminar papers, or any materials made available on the Virtual Learning Environment (VLE).

Exceptions to these provisions are:

- a) Teaching and learning materials produced by members of staff for their personal use and reference in teaching, for example personal notes and annotations to support teaching materials.
- b) Author(s) of such teaching and learning materials grant(s) the research institute/university a free, unconditional, irrevocable and perpetual, transferable, non-exclusive license to make available, use and copy such material for academic and administrative purposes.
- c) Members of staff are granted personal, non-exclusive, worldwide, royalty-free license to the material which they personally authored to adapt such materials, and to use these adapted materials solely for their own teaching purposes within the research institute/university or for a future employer.

For works commissioned by the research institute/university from a member of staff, which is to be produced outside the normal course of their duties (i.e. outside the course of their employment), or from someone who is not a member of staff, the research institute/university will use a form of contract which makes it clear that all IP and IPRs in the work belong to the research institute/university.

For avoidance of doubt, the research institute/university does not claim rights to pre-existing materials created by members of staff prior to their employment by the research institute/university, although adaptations and modifications made as a member of staff will be owned by the research institute/university.

6.8.2 Software

- a) The research institute/university owns all software and associated items that are developed by staff in the normal course of their duties or otherwise in the course of their employment.
- b) The research institute/university also retains ownership of all software and associated items that are the subject of any contract whereby ownership is with the

research institute/university or that are developed by a student in the specified circumstances.

6.8.3 Databases¹⁹

- a) The research institute/university owns all the IP rights relating to databases that are developed by staff in the normal course of their duties or otherwise in the course of their employment.
- b) The research institute/university also owns all databases that are the subject of any contract whereby ownership is with the research institute/university, or that are developed by a student in the specified circumstances.

6.8.4 Research Materials

- a) The use of proprietary tangible property for research purposes, often biological material, either owned by a third party and transferred to the research institute/university, or owned by the research institute/university and transferred to a third party, should be the subject of a Material Transfer Agreement or Collaboration Agreement, which should include agreed terms on publication rights, ownership, management and commercialization of new inventions/innovations arising from use of the materials.

6.8.5 Theses and Dissertations

- a) The copyright for theses or dissertations shall belong to the student.
- b) The texts of all student theses and dissertations, and works derived from such works, are considered Exempted Scholarly Works. Therefore, the students will own copyright in the scholarly work subject to a royalty-free license to the institution to reproduce and publish. Students are normally allowed to publish their theses and dissertations unless they have agreed in writing to restrictions that preclude or delay publication.
- c) The authors grant the research institute/university free, unconditional, irrevocable and perpetual, transferable non-exclusive license to make available, use and copy the theses or dissertations for academic and administrative purposes.
- d) The license will remain in effect in the event that the author leaves the research institute/university.
- e) The research institute/university requires copies of the theses or dissertations to be deposited in its library.
- f) Where a patent application is being contemplated on an invention disclosed in a thesis or dissertation, regardless of ownership, external examiners or external subject reviewers must sign a confidentiality undertaking before being sent the thesis/dissertation.
- g) It may also be necessary for the thesis to be held in the research institute/university library on a restricted access basis with readers being denied access or being asked to sign confidentiality undertakings until a patent application has been filed.
- h) For the avoidance of doubt, restricted access to a thesis or dissertation may also be necessary under the Terms of Contract between the research institute/university and a third party funder to protect third-party confidential information.

¹⁹ Databases comprise all the registered and archived information

6.8.6 Surrender/Assignment of Rights to the Inventor

- a) If the research institute/university elects not to file a patent application for an invention in which it has a proprietary interest, rights to the invention may be released to the inventor, who may file for an IP subject only to restrictions which may be imposed by prior agreement.
- b) If the research institute/university decides that it does not wish to pursue the commercialization of any IP, or that it does not wish to maintain an interest in that IP, it can, at its discretion, offer to assign its ownership to the creators of the IP, or to enter into an agreement to enable the IP to be used by the creators on mutually agreed terms.

6.8.7 Using IP Belonging to a Third Party²⁰

- a) The research institute/university should endeavor to respect the IP Rights of third parties. This may include background IP used in a research project, IP generated at the research institute/university but owned by a third party, or IP owned by the research institute/university but licensed to a third party under terms which might restrict further use.

7. DISCLOSURE²¹

7.1 Disclosure of Potential IP Asset(s)²²

1. The research institute/university's Office/Structure in charge of IP shall identify and encourage the disclosure of any information available to researchers in the course of carrying out research which could potentially lead to IP asset(s).
2. The research institute/university shall:
 - a) Ensure that a system is put into place that will assist persons covered under this policy to disclose any information with IP potential which is acquired, developed or accessed while dealing or using the research institute/university resources;
 - b) Ensure that IP Disclosure Forms are designed and are available for inventors and researchers;
 - c) Ensure that the information disclosed is kept confidential and;
 - d) Ensure that those who access or deal with the information disclosed sign a separate undertaking which binds them not to disclose the said information to third parties unless authorized in writing by the research institute/university's IP office in consultation with the researcher.

²⁰ Staff, students and researchers intending to use any material provided by or owned by third parties must ensure that they and the research institute/university are duly authorized to do so. Particular care should be taken when downloading material from websites, since using such material may amount to copyright infringement. If software code or applications are downloaded, the terms of the licence agreement must be adhered to; for example, software on an educational-only license must not be used for commercial purposes. Care must also be taken to ensure its use does not compromise the use or commercialisation of research results which incorporate the code or are based on it.

²¹ See annexes at the end of this document.

²² Before submission/disclosure of results for publication, the patentability criteria of the research work shall be determined by participating in meetings between the inventor/creator and IP office.

8. Protection of IP Rights

- a) The research institute/university shall assess the commercial potential of the research output and protect them through the most appropriate IP regimes specified at national, regional and international levels.
- b) The research institute/university shall ensure that a copyright notice is affixed to any original works of authorship in which the research institute/university has a proprietary interest.

9. COMMERCIALIZATION

9.1 Rationale for Commercialization

1. The research institute/university shall take necessary measures to commercialize its protected IP assets.
2. Commercialization shall be pursued through the following non-exhaustive routes:
 - a) **Licensing**
This is where the research institute/university permits another entity to exploit the IP rights against payment of royalties. Ownership of the IP rights remain with the research institute/university. The parties to whom an IP right is licensed may choose to establish a start-up company to exploit the IP asset.
 - b) **Assignment**
This is where the research institute/university transfers (sells) the IP rights to a third party against a one-off payment. In this case, the research institute/university loses the ownership of the IP rights.
 - c) **Self-exploitation of IP rights/Spin-off**
This is where the research institute/university self-exploits the IP rights through establishment of a spin-off company.
A spin-off is a company created where the institution invests its own resources to self-exploit its IP rights. This is likely to include the transfer of existing research institute/university staff either on a permanent or secondment basis.
 - d) **Joint ventures**
The research institute/university shall seek private partners to establish joint ventures to commercialize its IP assets. The private partners will bring the necessary financial resources and business skills to manage the joint venture. A valuation of the IP asset will be required to determine the equity/shareholding of the research institute/university.

10. Benefits from IP

The research institute/university shall provide an incentive to the inventor(s)/creator(s) by equitably distributing revenue generated from commercialization of the IP and recognition of the IP as a criterion for the promotion of researchers.

10.1 Revenue Sharing

- a) The research institute/university shall provide an incentive to inventor(s)/creator(s) by equitably distributing revenue²³ generated from commercialization of IP.
- b) The research institute/university shall define the stakeholders with whom the institution's income may be shared. These may include an inventor's research group, faculty, campus, a patent fund, an operation of technology transfer, Intellectual Property Management Office, research fund, a scholarship fund and graduate education; or a research institute/university.
- c) The stakeholders shall share the net income.
- d) The institutional IP Policy shall establish the revenue distribution among stakeholders²⁴.

10.2. Promotion/Career progression²⁵

The research institute/university shall recognize IP as a criterion for the promotion of the researchers and shall review and implement promotion guidelines that take into consideration IP applications, grants and commercialization.

11. TRADITIONAL KNOWLEDGE AND TRADITIONAL CULTURAL EXPRESSIONS²⁶

- a) The research institute/university shall recognize the role of Traditional Knowledge (TK), genetic resources and Traditional Cultural Expressions (TCEs) in the development of inventions, innovations, new plant varieties and creative works.
- b) The research institute/university shall facilitate the identification, documentation and protection of the TK and TCEs of local and indigenous communities.
- c) The research institute/university shall be guided by national, regional and international policies, laws and regulations with regard to access to genetic resources, use of TK and TCEs and sharing of benefits with holders of such knowledge.

²³ In distribution of such revenue, the individual contribution made by an inventor/creator shall be considered after verification of terms of agreement among inventors/creators or subject to research institute/university Agreement with any third party if any, or the log book entries/lab records/any other documentary proof.
It is recommended that royalties received may be used for educational and research purposes.

²⁴ An example of Schedule for Net Revenue Distribution is given as follows : Inventors' personal share (35%), Inventors' research team or group share (15%), Inventors' department share (15%), School/Faculty's share (30%), and research institute's/university's share (5%) depending on the size of the annual net revenue.
The inventors' personal share shall survive termination of affiliation with the research institute/university and, in the event of death of the inventor, shall inure to his/her estate.
Upon termination of the inventor's affiliation with the research institute/university, the inventors' team/group share, both the unspent portion and future allocations, will be reallocated to the inventors' Department, School and research institute/university portions according to the applicable royalty distribution policy.

²⁵ CAMES (Conseil Africain et Malgache pour l'Enseignement Supérieur encompasses all the OAPI members plus Madagascar, Rwanda, and DRC) recognizes patents registered by OAPI and WIPO at the same value as scientific publications for the promotion of lecturers and researchers in its regional evaluation and promotion system. For details, see: <http://www.lecames.org/index.php/formulaire-cci>

²⁶ TK protection involves important policy issues beyond the domain of IP. Stakeholders should be aware of the two approaches of protection including positive protection, giving TK holders the right to take action or seek remedies against certain forms of misuse of TK, and defensive protection, safeguarding against illegitimate IP rights taken out by others over TK subject matter. The two protection approaches should be undertaken in a complementary way. A comprehensive approach to protection in the interests of TK holders is unlikely to rely totally on one form or the other.

- d) The research institute/university shall obtain the necessary permits and prior informed consent and disclose the origin and/or source of any TK, TCEs and genetic resources in any IP application.

12. IP AWARENESS CREATION

The research institute/university shall:

- a) Promote IP awareness through seminars, conferences, symposia, colloquia, workshops and any other appropriate means as circumstances dictate;
- b) Encourage each faculty/college/division/unit of the research institute/university to incorporate IP as one of the compulsory/elective courses in its curriculum;
- c) Encourage the development of IP awareness promotion materials;
- d) Enter into strategic partnerships with appropriate institutions for the promotion of IP.

13. RESOLUTION OF DISPUTES

The research institute/university shall establish dispute resolution mechanisms to resolve any disputes that may arise in the course of implementation of the IP Policy. These mechanisms shall include the following:

- a) Any internal disputes or questions of interpretation arising from the IP Policy must in the first instance be referred to the research institute/university's IP Advisory Committee for resolution.
- b) Parties are encouraged to use mediation and arbitration as ways of resolving disputes without going to court.

14 MISCELLANEOUS

14.1 Revision of the Policy

The research institute/university shall regularly monitor and periodically review its institutional IP Policy to take into account institutional changes and emerging issues at national, regional and international levels.

14.2 CONFLICTS OF INTEREST AND COMMITMENT²⁷

The research institute/university shall develop an appropriate and effective mechanism to manage conflicts of interest and commitment that may arise during implementation of the policy.

14.3 STAKEHOLDER OBLIGATIONS

The research institute/university shall:

- a) Acknowledge the importance of transferring its IP in an appropriate and cost-effective manner. To this end, the research institute/university shall establish efficient mechanisms for technology transfer to maximize the value of the technology;

²⁷ The inventor(s)/creator(s) are required to disclose any conflict of interest or potential conflict of interest. If the inventor(s)/creator(s) and/or their immediate family members have a stake in a license or potential licensee company, they are required to disclose the stake they and/or their immediate family have in the company in the prescribed form.

- b) Provide oversight of IP management and technology transfer to ensure adherence to research institute/university's policies;
- c) Assist all stakeholders in establishing and maintaining effective technology transfer mechanisms and divisional policies and procedures consistent with the research institute/university's policies;
- d) Provide legal services and cooperate with all stakeholders in promoting and licensing IP;
- e) Take appropriate actions to protect research institute/university IP and;
- f) Establish policies and procedures for technology transfer and the avoidance of conflicts of interests, consistent with the research institute/university's policies.

Inventors/creators of IP shall:

- g) Disclose to appropriate research institute/university offices the creation of IP;
- h) Conduct technology transfer activities in a manner consistent with the research institute/university's policies and procedures, including those governing conflicts of commitment and conflicts of interest and;
- i) Cooperate with the research institute/university in defending and prosecuting IP legal cases taken in response to infringement.

PART 2

15. DEVELOPMENT OF THE INSTITUTIONAL IP POLICY AND STRATEGY

This procedure suggests a way of creating an IP policy in sequential 'steps' by providing the 'who', 'when', and 'how' details that policies do not address.

Developing an IP policy is both an art and a craft. The art lies in the vision: how the institution perceives IP as furthering its institutional mission and goals. The craft lies in identifying, culling, and keying in on the issues that will help the institution attain the vision. The sections that follow outline general principles for developing a research institute/university IP policy and provide a framework to help draft the policy. However, it is noteworthy that there is no 'one way/one size fits all formula' to accomplish this goal. The art and craft are of the institutions' choosing.

The suggested procedure for creating a research institute/university IP Policy and Strategy shall include the following steps:

15.1 Motivating Factors

When developing an IP policy, it is important to consider what the motivating force behind it may be as this can inadvertently slant or skew the outcome. If external issues such as legal challenges or misappropriation of assets spawned in the process, special efforts are needed to prevent the policy from being a mere knee-jerk response or reaction to those issues.

15.2 Establishing Timeframe and Commitment

- a) Policy development is not a trivial short-term task and the process may take from one to three years from consultation, drafting, validation, approval to implementation.
- b) The policy development steps vary considerably depending upon whether policy creation is vested in one person (as it often is), or in institutional or departmental committees. Institutional size and complexity also adds time, since more people have to contribute to the policy to make it truly representative.

15.3 Raising Awareness and Persuading Management and Staff²⁸

- a) The research institute/university shall convince overworked staff or an unconvinced administration that the effort of creating an IP policy is necessary and worthwhile. Without administration and staff support or 'buy-in', the process will be difficult to undertake and sustain, and may be doomed from the outset.
- b) The research institute/university shall enlist 'buy-in' through gathering evidence to support the policy. There are a number of ways to collect this evidence within each institution. Informally polling managers about their views on IP use and ownership is likely to reveal different and conflicting perspectives that need to be reconciled. Querying staff about the daily IP issues they face can yield anecdotes that illustrate IP 'run-ins' involving rights holders and users.
- c) Once it has collected and documented information from the sources, the research institute/university, shall compile it into a clear and brief document (i.e., a list of 'reasons why we need to do this') and distribute it using the most appropriate channels within the institution.

15.4. Identify and Select Who Should Participate/Stakeholder Engagement

- a) The research institute/university shall make a commitment to develop an IP policy.
- b) The research institute/university shall designate someone who will oversee/champion and lead this selection process, as well as guide the group once it has been selected. The research institute/university should choose a staff member whose interest and experience with IP issues make him/her a natural choice for this role.
- c) The research institute/university shall gather the appropriate group of professionals²⁹ to help craft the policy. Group sizes vary, depending upon staffing and organizational structures of different institutions, as well as group dynamics. Working groups need to have enough people to share the workload and to provide representative perspectives. The number of participants is less important than the number of

²⁸ The IP policy will have to be 'sold', both inside and outside the research institute/university. Educating stakeholder communities as to what the policy is and why it is will promote acceptance.

²⁹ Policy developers may want to make available, for comparison purposes, other universities' policies to show that any suggested changes are not out of the mainstream. Providing such material and opportunities for informed discussion and debate as to the pros and cons of suggested changes to the IP policy will ease anxieties and highlight the benefits the changes will provide.

perspectives represented (IP interests in the research institute/university are addressed).³⁰

15.5 Crafting the Policy: The Development Process

15.5.1 Multiple Approaches

The research institute/university shall identify and compare the methodologies used to develop the IP policy.

- a) A Committee³¹ approach can be used to develop the IP policy. The process is started by putting together a group³² to take stock of the IP issues in the research institute/university. As a rough draft of an IP policy emerges, the Chairperson of the Committee refines the draft and submits it to the IP Management Advisory Committee, where it is discussed and further revisions are made. The Advisory Committee ultimately approves the IP policy.
- b) In some cases, the impetus for the IP policy development stems from the research institute/university Governing Council/Board of Directors/Board of Trustees' desire to implement a new governance model that mandates executive authority for policy development and monitoring. In this scenario, the IP policy may be drafted by an external consultant and contract policy analyst in consultation with an institutional working group. A formal review process allows for input from all key stakeholders and governing council/board committees before final governing council/board approval.
- c) The research institute/university hires an IP attorney to lead its IP Policy development and implementation process. This individual conducts an audit of the institution's IP assets, reviewing carefully those materials that would be used, draws up policies and procedures to guide institutional staff and works on implementing and monitoring the policy. In this case, the research institute/university grants this individual the authority at the outset to research, draft, and implement the policy throughout the organization.

Regardless of which of these approaches is used, there is need for resource discovery and background research, approval from administration both at the beginning of the process and at the end, evaluation and discussion, and drafting of the IP Policy.

15.5.2 Step 1: Information Gathering

Policy emerges from an understanding of the research institute/university's needs. For this reason, one of the first steps in the creation of the IP policy is to undertake background

³⁰ The key is to find the right balance to adequately represent all viewpoints and carry out work without overburdening the process. You may have to depart from this ideal in certain situations. For example, it may be politically expedient to include someone in the working group who normally would not have been considered. Conversely, you may have to exclude a qualified person because the individual cannot commit his/her time and resources to the process.

³¹ When pursuing these efforts, it would be wise to gain the support of the highest levels of administration and to determine a path of least resistance for the process, perhaps via the faculty senate or the administrative Committee Managing Council.

³² The individuals who eventually are selected should formally constitute a 'working group' (some organizations prefer to call them Committees or Task Forces). Official authorization is key; it gives the group credibility throughout the research institute/university, acknowledges the members' work as a legitimate component of their jobs and places a responsibility on the group to complete their assignment as professionally as possible. Even if only one or two people are selected to develop the policy, it is critical they be formally 'appointed' by upper administration for the same reasons outlined above.

research (often called ‘resource discovery’), to uncover all the information you need to know to make informed decisions. Adequate resource discovery will involve activities that are internal and external to the institution.

15.5.2.1 Internal Activities

Internal activities will include engaging in the processes below.

15.5.2.1.1 Identifying and Examining Existing Policies and Procedures

- a) The research institute/university shall carry out a review³³ of all internal rules, regulations inter alia, research policy, research contracts, publisher agreements, software/web development agreements, sponsorship agreements, academic procedures, recruitment and promotion policies and procedures. This will enable acquisition of information on IP needs, usage, and concerns identified by particular sectors of the research institute/university.

15.5.2.1.2 Identifying the Institutional IP (The IP Audit)³⁴

- a) The research institute/university shall carry out an examination of the actual IP assets, or more appropriately, the information that documents the rights status of those assets. This review is known as an IP audit. It is a methodical examination and review of all the IP assets owned by a research institute/university, where they reside, how they are used, and what documentation exists about their IP ownership.

15.5.2.1.3 Assessing the Institution's Level of Risk Aversion³⁵

- a) The Institution shall identify its level of comfort with respect to risk-taking activities, and the degree of sophistication of its risk management strategies.

15.5.2.2 External Activities

External activities will include engaging in the processes below.

15.5.2.2.1 Reviewing IP Policies from Other Institutions and Organizations³⁶

The research institute/university shall examine IP policies from other research institutes/universities for purposes of benchmarking and gaining important insights into the

³³ When studying this information, it is essential to look for areas of consistency, discrepancy, and coverage. This information will give important insights about what areas of IP are important throughout the research institute/university.

³⁴ The IP audit is an institutional undertaking that is initiated and coordinated by one person and assisted by individual departments whose representatives meet periodically with the audit project leader to report on findings and evaluate results. Critical areas considered include, but are not limited to: What assets does the research institute/university have rights to? Does the research institute/university exploit these rights now? Will it wish to do so in the future? How? For those assets whose rights are owned by others, does the research institute/university wish to seek assignments? For what uses? Are there gaps in the documentation of any assets? How should this be addressed? The audit findings, and the research institute/university's assessment of them in light of its institutional needs and activities, will help determine what areas of IP Policy need to be developed.

³⁵ Institutions frequently face instances where they want to use materials, but cannot clearly identify a rights holder. Or they may use a work without seeking permission because they believe it falls within one of the exemptions in IP law (e.g. fair use, fair dealing, etc.). When such circumstances occur, how comfortable is the research institute/university with taking risks? Does it 'push the envelope', take a 'better safe than sorry' perspective, or fall somewhere in between?

³⁶ The audit also offers insights into wording, format and layout that you may wish to consider (or avoid) for the research institute/university's own policy. Examples of IP policies for research institute/university can be found at http://www.wipo.int/policy/en/university_ip_policies/

kind of issues other organizations consider important and/or face, which may or may not parallel the research institute/university's own issues.

15.5.3. Step 2 - Analysis and Discussion - An Iterative Process

15.5.3.1 Analyzing the Institution's Mission

- a) The research institute/university shall begin the analysis phase of policy development by taking stock of its mission.
- b) Reviewing the research institute/university's mission in the electronic environment helps to clarify how it wishes to position itself for the future. With this understanding and a clear knowledge of the IP assets it owns and uses, as determined from the resource discovery effort outlined above, the research institute/university can make the necessary policy choices that will help it achieve its goals.

15.5.2.3 Analyzing the Findings³⁷

After completing its resource discovery efforts, the research institute/university shall identify the key issues to be addressed in the IP policy. The review of all institutional IP policies and practices in addition to the IP audit should reveal the areas of IP important to the institution. This phase of policy development requires analysis and evaluation. One way to begin is to start broadly by legal regime. Which legal regimes protect the research institute/university's IP assets? Which legal regime is the institution concerned with?

Once the IP regimes are identified, the research institute/university shall consider the specific issues that each regime addresses. This is the point where the external aspects of the earlier resource discovery efforts will come to fruition. As the research institute/university goes through this process of identifying issues within and across legal regimes, it needs to identify the scope of each issue for itself; i.e., the particular aspects of the issue that the research institute/university should consider and perhaps address in the policy. In some instances, the scope will be quite limited.

The process of identifying issues and their scope must be documented. Recording and writing the information also helps to evaluate and analyze it in a more systematic fashion. When a reasonable first effort is made to identify and define the scope in addition to analyzing each issue of concern to the research institute/university, the information should be circulated to a broader audience than just those individuals that have been involved in the evaluation process thus far. Depending upon the research institute/university, these might be other extant committees, department heads, or the entire institutional staff. Comments should be solicited from these broader audiences and then reviewed by the evaluators.

³⁷ Analysis and evaluation are iterative processes, and possibly the most time-consuming in the entire policy development effort. The number of back-and-forth reviews undertaken depends upon the results of the initial analysis and each research institute/university's circumstances. If the initial analysis is exceedingly comprehensive, and a review by other audiences reveals no major issues, then one review instance may suffice. In larger research institutes/universities, there are likely to be more voices and thus more comments that require further refinements and reviews before consensus is reached. The primary goals in any review process are to seek broad input and to reach consensus so that the end product, the policy, will reflect an institution's real needs. An unstated but equally important goal is to solicit 'buy-in' for the policy, by virtue of its having been crafted by those it will govern and those who have experience and vested interests in the issues it addresses.

15.5.4. Step 3: Writing the Policy

The Institution shall consider the following questions before it writes the policy:

Who should write the policy? The analysis process is likely to yield a long, detailed document that must be condensed and culled into a statement of policy, which is traditionally a short, concise document. People have different strategies for achieving this step (think about how you cull research into a written paper), although nearly all methods require identifying priorities, merging and synthesizing, and invoking disciplined editing³⁸.

What style of writing and prose are appropriate? Policy writing guidelines stress the importance of using clear and simple language. Avoid legalese and jargon; in instances where they must be included, explain the meaning of legal terms/phrases in a 'definitions' section of the policy.

Who should review policy drafts? Legal counsel should be part of the group that reviews the policy in its various drafts, as should a pre-selected group of R&D staff who are astute and have been involved in the policy development process.

What format should be used? The policy's organization, structure, and components are largely up to the research institute/university's choice and preference.

15.5.5 Step 4: Adopting the Policy

- a) Adoption makes the policy official, providing an imprimatur that lends institutional credence to the policy, the work behind it, and its use in the research institute/university.
- b) Generally, policies are approved at the highest possible administrative or governance levels of an institution. Governing Councils, the Board of Directors or Executive Directors of institutions usually approve policies. However, the stakes involved in IP ownership and use are increasing greatly, warranting review and adoption by the highest governance authority in an institution.

15.5.6 Step 5: Implementing the Policy

Implementation is a long-term commitment that involves education and training, promotion, use, monitoring and enforcement.

It also requires monetary and human resources, which a research institute/university's administration must be prepared to, provide or else the policy will remain unused and fail to serve its ultimate purpose.

Among the various statements included in any policy is the appointment of a person or committee responsible for policy oversight. Included in any implementation effort are the tasks captured in the following sections.

³⁸ The consensus of policy developers is that lawyers should **not** write your IP policy. Legal counsel cannot be expected to understand R&D's needs as well as the R&D staff does. They are not trained in the various areas of R&D administration and management, nor are they aware of the day-to-day IP issues that confront R&D staff.

15.5.6.1 Announcing the Policy

The institutional IP Policy must be promoted and the standard way to start this process is by announcing the policy's adoption to research institute/university staff, and more broadly to the research institute/university's Governing Council or Board of Directors (if they were not involved in the process). The policy should also be introduced to the Non-Government Organizations, and other research institute/university professionals. An official announcement shall serve several purposes including:

1. Emphasizing the importance of the policy and;
2. Presenting a public relations opportunity to showcase the institution's latest efforts in developing and setting high professional standards for itself.

15.5.6.2 Disseminating the Policy³⁹

- a) The institution shall make sure copies of the policy are disseminated to all staff, as well as made available in easily accessible locations such as the research institute/university's intranet, employees' handbook, students' handbook, staff bulletin board, etc.
- b) The research institute/university shall also consider posting the policy on websites.

15.5.6.3 Informing and Educating Staff⁴⁰

Disseminating the policy to employees is important, but dissemination alone is not sufficient.

Therefore, after the policy is announced, the research institute/university shall make a concerted effort to educate staff in application of the policy. All employees need to be informed about their responsibilities and liabilities under the policy. They also need to be informed on procedures for resolving disputes, seeking further clarification and reporting problems or violations.

The most effective way to minimize or eliminate challenges of this type during the implementation stage⁴¹ is to take steps before implementation.

15.5.6.4 Policy Evaluation and Revision

Policies need to be reviewed at regular intervals to ensure they remain relevant over time. The IP arena is particularly vulnerable to changes brought about by new information technologies and these changes may have policy implications.

³⁹ The easier it is for staff to locate the policy, the more likely it will be referenced and used.

⁴⁰ Possible educational forums include all-staff orientations, department meetings, workshops or seminars. Training should be more extensive for staff who confront IP issues routinely in the course of their daily activities. Tailoring policy education sessions to the context of particular institutional tasks or activities is a practical way to show how the policy plays a role in the daily activities of the staff. The IP policy should be reviewed periodically with staff; to ensure employee awareness and to announce and describe any changes or circumstances that affect the policy.

⁴¹ Implementation of any new policy frequently faces internal political and social challenges. A research institute/university may have a particular culture and history that makes it less receptive to a new policy in this area, or employees may resent what they perceive as interference in the activities they know best.

The review cycles cited in existing IP policies typically range from once a year to every five years.

A five-year policy review is probably unrealistic for research institute/university given the time constraints faced by most staff.

15.5.6.4.1 The Initial Review⁴²

An initial review is a first-time examination of a policy after it has been in operation for a designated period of time (usually one year).

The research institute/university shall decide which individual or group will conduct the policy review, although it makes sense to have some of the individuals who helped craft the policy serving on a review committee.

The individual or committee should, during this one-year period, carefully observe and monitor policy usage and actively solicit suggestions for policy changes from staff.

15.5.6.4.2 The Periodic Review

After the initial review has taken place, subsequent reviews should occur at routine intervals; two to five years are suggested. These periodic reviews may revisit some of the internal issues discussed in the initial review, but are likely to be more outward-looking, examining the policy in light of changes in IP law, current technology trends and user relationships.

15.5.6.4.3 Amendments and Changes

All policies are eventually amended, or if drastic changes are warranted, rewritten. Whenever amendments or changes are made to a policy, approval needs to be sought from the same authority that approved the initial policy.

Revised policies should be identified as such by affixing the word 'amended' and the date either at the beginning or end of the policy document.

Once changes have been approved, staff should be informed about the revisions and receive copies of the newly revised policy. If the changes are significant, the research institute/university may wish to hold an all-staff orientation or departmental meetings to update staff and make sure the newly revised policy is clearly understood.

⁴² When evaluating the policy, the following questions about clarity and use offer starting points for examination: a) Is staff adhering to the policy? If not, is more training needed? More promotion and awareness of the policy? More enforcement? b) Were there frequent questions, or requests for clarification, about the policy? c) Did these requests occur in the early part of the year (when the policy was still "new") and taper off as the year progressed? Such a pattern suggests that staff need more training and experience before they became comfortable and familiar with the policy; d) Did the requests occur at a consistent rate throughout the year? A constant rate of requests may indicate a need for greater clarity in the policy document; d) Do certain aspects of the policy get questioned or require more frequent clarification than others? These sections may need to be rethought and rewritten; e) Is the policy having an overall positive impact on the research institute/university? Is it fostering new ideas or promoting new initiatives? f) Do staff have a better understanding of the importance of IP to the institution, as evidenced by more communication, better 'follow-through' of process and procedures, and more thoughtful questions? g) Has the policy come into conflict with any other areas of the parent research institute/university? h) Does the policy respect and support innovation and creation, as evidenced in the level of fairness in which it treats artists, donors, source communities, users and visitors? i) How does the policy fit in with the research institute/university's mission?

ANNEX 1. STUDENT IP AGREEMENT

In order that the research institute/university may fulfil its mission as an educational institution and its legal and contractual obligations to sponsors of research, and in consideration of my participation in faculty-directed research projects at the research institute/university as a student, research assistant or intern, I ('student, research assistant or intern') agree that:

1. I do hereby assign to the research institute/university or its designee all my right, title and interest in and to all inventions, patents, copyrights, software, or other discoveries ('INTELLECTUAL PROPERTY') that arise from my participation in (insert description of specific research project) ('PROJECT') as directed and supervised by (insert faculty name, title and department) ('FACULTY MEMBER'). I will do all things necessary and appropriate on my part, at the research institute/university's expense, to execute and deliver all documents required to complete such assignment.

2. I will cooperate fully with the research institute/university or its designee, during and after my affiliation with the research institute/university, in the preparation and prosecution of patent applications or other protective measures on INTELLECTUAL PROPERTY and in the preparation and execution of all documents necessary to obtain, maintain, and enforce protection on INTELLECTUAL PROPERTY.

3. I acknowledge that during the course of my participation in the PROJECT, certain information, data, or results from the PROJECT may be provided to me or developed which may be considered confidential by the RESEARCH INSTITUTE/UNIVERSITY or the FACULTY MEMBER ('CONFIDENTIAL INFORMATION'). Any such CONFIDENTIAL INFORMATION will be clearly identified as such. I shall maintain confidentiality of such information unless I receive written permission to disclose it. CONFIDENTIAL INFORMATION shall not include information: i) that is or becomes generally available to the public through no fault of STUDENT; or ii) was already in the lawful possession of another entity at the time of its disclosure by STUDENT; or iii) is received by STUDENT in good faith from a third party who discloses such information on a non-confidential basis and is not bound by any obligation of secrecy or confidential relationship; or iv) is independently developed by the STUDENT outside of the scope of the PROJECT.

4. The research institute/university and its employees have the right, without restriction due to any involvement of STUDENT in this PROJECT, to publish in academic publications any information developed in the course of the PROJECT.

5. This Agreement embodies the entire understanding between the RESEARCH INSTITUTE/UNIVERSITY and STUDENT with respect to PROJECT INTELLECTUAL PROPERTY, and supersedes any previous oral or written agreements. It may be amended only in writing and is not assignable. This Agreement is binding upon all parties and governed by "Insert name of country or State " law.

6. This Agreement is made effective as of the first date of my affiliation with the PROJECT or upon signing of this Agreement, whichever occurs first.

Student, research assistant or intern Name (Type or Print)

Signature and Date

ANNEX 2. TEMPLATE OF NON-DISCLOSURE AGREEMENT

This agreement is made

Between

.....Of

(hereinafter referred to as First Party)

and

.....

Of

(hereinafter referred to as the Second Party)

(collectively, the 'Parties'),

PREAMBLE

WHEREAS, both parties want to ensure the protection and preservation of the confidential and/or proprietary nature of information disclosed or made available or to be disclosed or made available to each other;

WHEREAS, for the purposes of this agreement, each Party shall be deemed to include any subsidiaries, internal divisions, agents, and employees;

WHEREAS, any Signing Party shall refer to and bind the individual and the entity that he or she represents;

WHEREAS, the Parties desire to ensure the confidential status of the information that may be disclosed to each other;

NOW, THEREFORE, in reliance upon and in consideration of the following undertakings, the Parties agree as follows:

1. Definition and Operationalization

- 1.1. Subject to limitations set forth in paragraph 1.2., all information disclosed to the other party shall be deemed to be 'Proprietary Information'. In particular, Proprietary Information shall be deemed to include any information, marketing technique, publicity technique, public relations technique, process, technique, algorithm, program, design, drawing, mask work, formula, test data research project, work in progress, future development, engineering, manufacturing, marketing, servicing, financing or personal matter relating to the Disclosing Party,

its present or future products, sales, suppliers, clients, customers, employees, investors or business, whether in oral, written, graphic or electronic form.

1.2. The term 'Proprietary Information' shall not be deemed to include information that:

- i) is now, or hereafter becomes, through no act or failure to act on the part of the Receiving Party, generally known or available information;
- ii) is known by the Receiving Party at the time of receiving such information as evidenced by its records;
- iii) is hereafter furnished to the Receiving Party by a Third Party, as a matter of right and without restriction on disclosure,
- iv) is independently developed by the Receiving Party without reference to the information disclosed hereunder, or
- v) is the subject of a written permission to disclose provided by the disclosing party.

1.3. Notwithstanding any other provision of this Agreement, disclosure of Proprietary Information shall not be precluded if such disclosure:

- i) is in response to a valid order of a court or other governmental body in(*insert name of country*) or any political subdivision thereof,
- ii) is otherwise required by law, or,
- iii) is otherwise necessary to establish rights or enforce obligations under this agreement, but only to the extent that any such disclosure is necessary.

1.4. In the event that the Receiving Party is requested in any proceedings before a court or any other governmental body to disclose Proprietary Information, it shall give the Disclosing Party prompt notice of such request so that the Disclosing Party may seek an appropriate protective order.

1.5. If, in the absence of a protective order, the Receiving Party is nonetheless compelled to disclose Proprietary Information, the Receiving Party may disclose such information without liability hereunder, provided, however, that such party gives the Disclosing Party advance written notice of the information to be disclosed and, upon the request and at the expense of the Disclosing Party, uses its best efforts to obtain assurances that confidential treatment will be accorded to such information.

2. USE OF CONFIDENTIAL INFORMATION

2.1. Each Party shall maintain in trust and confidence and not disclose to any third Party or use for any unauthorized purpose any Proprietary Information received from the other Party;

- 2.2. Each Party may use such Proprietary Information in the extent required to accomplish the purpose of the discussions with respect to the subject;
- 2.3. Proprietary Information shall not be used for any purpose or in any manner that would constitute a violation of law regulations, including, but without limitation to, the export control laws of(*insert name of country*);
- 2.4. No other rights or licenses to trademarks, inventions, copyrights; patents or any other form of intellectual property are implied or granted under this Agreement;
- 2.5. Proprietary Information supplied shall not be reproduced in any form except as required to accomplish the intent of this Agreement;
- 2.6. The responsibilities of the Parties are limited to using their efforts to protect the Proprietary Information received with the same degree of care used to protect their own Proprietary Information from unauthorized use or disclosure;
- 2.7. Both Parties shall advise their employees or agents who might have access to such Proprietary Information of the confidential nature thereof and that by receiving such information they are agreeing to be bound by this Agreement;
- 2.8. No Proprietary Information shall be disclosed to any officer, employee, or agent of either Party who does not have a need for such information for the purpose of the discussions with respect to the subject; and
- 2.9. Each Party shall utilize the best efforts possible to protect and safeguard the confidential information from loss, theft destruction or the like.

3. RETURN OF CONFIDENTIAL INFORMATION

- 3.1. All Proprietary Information (including all copies thereof) shall remain the property of the Disclosing Party and shall be returned to the Disclosing Party after the Receiving Party's need for it has expired, or upon request of the Disclosing Party, and in any event, upon completion or termination of this Agreement.
- 3.2. The Receiving Party further agrees to destroy all notes and copies thereof made by its officers and employees containing or based on any Proprietary Information and to cause all agents and representatives to whom or to which Proprietary Information has been disclosed to destroy all notes and copies in their possession that contain Proprietary Information.

4. NON – CIRCUMVENTION

Neither Party shall not, directly or indirectly through any Third Party, or internally through its own representatives, officers, employees, agents or sub-contractors, in any manner: exploit the Confidential Information and Intellectual Property owned by, accruing, or under license of the Disclosing Party for the duration of this Agreement or solicit, or seek to exploit, any business, vendor or customer relationship disclosed by the Disclosing Party in terms of this Agreement, for its own account.

5. TREATMENT OF CONFIDENTIAL INFORMATION AFTER TERMINATION OF DISCUSSION

This Agreement shall survive any termination of the discussion with respect to the subject and shall continue in full force and effect until such time as Parties mutually agree to terminate it.

6. GOVERNING LAW

- 6.1. This Agreement shall be governed by the laws of..... (*insert name of country*) and as those laws that are applied to contracts entered into and to be performed; and
- 6.2. Should any revision of this Agreement be determined to be void, invalid or otherwise unenforceable by any court or tribunal of competent jurisdiction, such determination shall not affect the remaining provisions of this Agreement, which shall remain in full force and effect.

7. WHOLE AGREEMENT

This Agreement contains final, complete, and exclusive agreement of the Parties relative to the subject matter hereof and supersedes any prior agreement of the Parties, whether oral or written. This Agreement may not be changed, modified, amended or supplemented except by a written instrument signed by both Parties.

8. REMEDIES

Each Party hereby acknowledges and agrees that, in the event of any breach of this Agreement by the other Party, including but without limitations to, the actual or threatened disclosure of a Disclosing Party's Proprietary Information without the prior express written consent of the Disclosing Party, the Disclosing Party will suffer an irreparable injury such that no remedy at law will afford it adequate protection against or appropriate compensation for such injury. Accordingly, each Party hereby agrees that the other Party shall be entitled to specific performance of a receiving party's obligations under this Agreement as well as further injunctive relief as may be granted by a court of competent jurisdiction.

9. DURATION

The term of this agreement is for years, commencing on the 'Effective Date'.

10. NON-TRANSFERABILITY

This Agreement shall be binding upon each Party. The rights and duties of either Party under this Agreement may not be assigned or delegated, not in whole or in part, without the prior written consent of the other Party.

11. SUFFICIENCY AND JURISDICTION

This agreement contains all verbal and written agreements between each party in relation with confidential information and it therewith substitutes all precedents agreements and obligations in regard of this matter.

12. JURISDICTION

In the event that a dispute arises between the parties and cannot be resolved within fourteen (14) days from the time it arose, either Party shall have the right to refer the matter to the Magistrate's Court, within the jurisdiction which the dispute arose, of which the stated Court shall have jurisdiction over the matter despite the fact that the values or amounts involved exceed the jurisdiction of the Magistrate's Court.

13. TERMINATION OF CONTRACT

This Agreement is terminable on either Party giving SEVEN (7) days' written notice in advance. Each party shall notwithstanding receipt of any such notice, remain bound to fulfill its obligations under this agreement until the effective date of termination.

14. EFFECTIVE DATE

The effective date of this agreement shall be when both Parties append their signatures to this document.

THUS DONE AND SIGNED AT

ON THE DAY OF(YEAR).

AGREED TO:

Signature _____

Printed Name _____

Date: _____

AGREED TO:

Signature _____

Printed Name _____

Date: _____

ANNEX 3.TEMPLATE OF IP DISCLOSURE FORM

SECTION A: PERSONAL DETAILS OF INVENTOR

Please fill in your details in the space provided hereunder

Name of Inventor			
Position			
Email Address			
Phone Number			
Department:		Faculty	

SECTION B: INVENTION DISCLOSURE

a) Name of invention:

b) What is the field of technology of the invention?

c) What problems does the invention solve?

d) Provide full description of the invention (technical details).

e) Stage of Development of invention.

f) Has the invention been disclosed to any third party? If so, provide date of disclosure.

g) Has the invention been published in any academic literature or presented at a conference? If so, please provide date and manuscript.

h) What are the practical applications of the invention?

i) What is the targeted market for the invention?

j) What forms of intellectual property protection are necessary for the invention?

k) Is the invention a result of funded research? If so, provide details.

l) Are there any third parties who have a claim of ownership to the invention? If so, stipulate the nature of commitments and provide associated Agreement(s) detailing such ownership claims if any.

m) Are there any agreements that affect the invention (material transfer agreements, etc.)?

n) Did you use any research institute/university resources in the development of this invention? If yes, please stipulate nature of these contributions.

o) Please provide any other information which you feel might be necessary for disclosure assessment of this invention.

ANNEX 4.GUIDELINES ON THE PROCESS OF CONSULTANCY IP POLICIES

The following guidelines provide a general framework for proper and effective management of consultancy in research institute/university IP policies. In developing its IP policy, the research institute/university should endeavor to identify areas of overlapping obligations and responsibilities as well as conflicts that may arise as its staff and researchers undertake consultancy work. To this end, the research institute/university shall:

- a) Ensure the scope of consultancy work undertaken by staff and researchers is clearly defined and does not contravene institutional and national IP and research obligations, policies and regulations. The scope of consultancy work should be explicitly stated and should avoid overly broad and generic statements, such as “other services as may be requested from time to time” or “services in the area of” since these may lead to encroachment on the research institute/university’s areas of research and IP.
- b) Reserve the right to retain IP generated from staff and researcher consultancy activities and agreements, if the IP developed is in an area that overlaps with the faculty member’s field of research. To avoid difficulty, staff and researchers engaged in consultancy with third-party clients shall endeavor to avoid overlap by narrowing the scope of work undertaken to client-specific research and proprietary innovations.
- c) Ensure consultancy service agreements between staff/researchers and third-party clients do not convey any IP rights developed using research institute/university facilities and resources and/or developed through research institute/university grants or contracts. Consultants should inform such clients of their obligations to the research institute/university, particularly those related to IP ownership.
- d) Carry out due diligence and ensure staff and researchers proceed with utmost caution in cases where consultancy service agreements they enter into call for rights to improvements to existing works and future inventions. This will help to mitigate the prospect of putting related research institute/university research and IP at risk. Staff and researchers considering entering into such agreements should also be made aware this may lead to surrender of rights to use their own IP.
- e) Ensure staff and researchers engaged in consultancy with third parties keep proprietary client information they access confidential. This is best achieved through rules that explicitly stipulate the types and/or categories of client information that must be kept confidential. In cases with potential for overlap between consultancy services and research institute/university research and IP, ensure staff and researchers retain continued rights to publish.
- f) Make provisions that restrict staff and researchers from providing consultancy services to third parties in areas where the research institute/university wishes to retain complete exclusivity, as circumstances may dictate. The research institute/university should however be cognizant of the fact that such action may limit and/or negatively impact its ability to work with certain sponsors.
- g) Make provisions that limit the liability of staff and researchers engaged in consultancy services to third parties for any products created by such third parties, as a direct result of said services over which the consultants have no control. In some cases, it may be necessary to expressly disclaim liability for certain products and advice given

by staff and researchers to clients during the course of providing consultancy services.

- h) Ensure staff and researchers are indemnified for third party claims and/or actions related to consultancy services they provide, since such work may not be covered by the research institute/university's insurance policy.
- i) Ensure staff and researchers engaged in approved external consultancy service disclose outputs, innovations and inventions generated in the course of the work to the research institute/university.
- j) Approve waiving of IP rights by staff and researchers in cases where this is a prerequisite for performing consultancy work, and ensure the research institute/university does not possess any interest in such rights or that the consultancy agreement is suitably amended in regard to such rights. Permission to waive IP rights generated through state and other specified benefactors should not be granted.

[End of Annex 4 and of Document]

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