



NATIONAL CODE OF PRACTICE FOR MANAGING AND COMMERCIALISING
INTELLECTUAL PROPERTY FROM PUBLIC-PRIVATE COLLABORATIVE RESEARCH

November 2005



The National Policy and Advisory Board for Enterprise,
Trade, Science, Technology and Innovation



Advisory Council for Science
Technology and Innovation
An Comhairle Eolaíochta

ADVISORY COUNCIL FOR SCIENCE, TECHNOLOGY AND INNOVATION

The Advisory Council for Science, Technology and Innovation is the Government's high-level advisory body on STI policy issues. It serves as the primary interface between stakeholders and policy policymakers in the STI arena. The Council was established by Government in April 2005 under Forfás legislation, as a successor body to the Irish Council for Science Technology and Innovation.

The Council's remit is to contribute to the development and delivery of a coherent and effective national strategy for STI and to provide advice to Government on medium and long-term policy for STI and related matters.

The Council operates within the context of the arrangements put in place by Government in June 2004 for the Co-ordination and Governance of STI matters, which include the Cabinet Committee and the Inter-Departmental Committee for STI and the Office of the Chief Science Adviser.



Minister Micheál Martin, T.D.

Minister for Enterprise, Trade and Employment

FOREWORD

The publication of this national Code of Practice is both relevant and timely. In essence it is about making knowledge work for Ireland.

This Government has increased its investment in research five-fold under the current National Development Plan, 2000-2006 to €2.5 billion and is committed to developing Ireland as an innovation and knowledge driven economy recognised for the excellence of its people and research. We need to make this investment in knowledge creation work to increase the competitiveness of firms, to grow our economy and to guarantee the continued prosperity of our people. These goals can only be achieved if we focus on ways to turn knowledge into value. Ensuring that the knowledge created drives Ireland's economic growth will depend hugely on the creativity of our people and our policies as well as creating an environment, practices and culture conducive to exploiting the outputs of research investment.

We need to create strong collaborative research links between enterprise and the public research sector. We want to become the location of choice for collaborative research among international public research organisations and industry. To achieve this, we want to develop excellence in the public research base and a strong pro-commercialisation culture so that we can promote collaboration with enterprise and maximise the commercial exploitation of research outcomes.

Ireland offers great potential to enterprise for innovation and wealth creation. The recent significant public investment in basic research and in building excellence in the public research system means companies large and small can use the knowledge, expertise and facilities of public research organisations to help build their technological capability and create the technologies that will underpin future products and services.

In today's world of 'open innovation', competitive advantage comes to those firms that can exploit the skills of research teams far beyond their own organisational boundaries. Collaborative research is fast becoming a critical tool in industry's search for new technology.

In turn, effective industrial collaboration also builds and strengthens the public research base. Through market knowledge and an understanding of the scientific barriers to developing next generation technologies, industry can assist in providing direction and focus for academic research. Important intangible benefits also arise from collaborative relationships through exchange of information, know-how, commercial awareness and a culture of commercial exploitation.

In order to promote strong collaborative links with industry and to maximise the exploitation of new knowledge, greater clarity and coherence in our national approach are required in terms of the management and access to intellectual property (IP) arising from collaborative research. This Code of Practice for Managing and Commercialising Intellectual Property in Public-Private Collaborative Research, taken together with the ICSTI national Code of Practice for Managing Intellectual Property from Publicly Funded Research published in 2004, now provides a comprehensive set of guidelines for IP management and commercialisation and a clear framework for IP negotiations to facilitate the development of enterprise academic relationships.

I welcome and fully endorse this Code of Practice for Managing and Commercialising Intellectual Property from Public-Private Collaborative research. I am indebted to the wide range of stakeholders, research funding agencies and public research organisations, enterprise and representative bodies, who contributed to its development. I am confident that this Code will contribute to strengthening the public research system in Ireland and Ireland's international reputation as a location of choice for collaborative research.



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The Code should not be interpreted as constituting a comprehensive account of the legal rights or obligations of industrial companies, public research organisations (PROs), academic researchers or other interested parties. The Code is intended only to provide a general overview of certain of these matters and does not constitute legal or professional advice. The various stakeholders should ensure that all agreements entered into comply with applicable provisions of both Irish and EU Law (including laws regulating diverse areas such as intellectual property (IP), competition, public procurement, freedom of information, data protection and ethics). Partners should also be aware of the restrictions that may apply to them under State Aid Rules. It is the responsibility of those referring to the Code to obtain the appropriate professional advice in relation to the foregoing and also in relation to IP matters generally.

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NATIONAL CODE OF PRACTICE FOR MANAGING AND COMMERCIALISING INTELLECTUAL PROPERTY FROM PUBLIC-PRIVATE COLLABORATIVE RESEARCH

INTRODUCTION

This Code of practice provides guidelines for the management and commercialisation of intellectual property from collaborative research between industrial and academic partners. It provides a set of principles and a consistent starting point for negotiation that the partners should adopt in establishing collaborative research agreements, including a flexible approach to the issues of ownership and rights of exploitation of research outcomes. The flexible approach recognises that every collaborative research arrangement is different and recommends that the partners should choose IP management arrangements that reflect their circumstances and are tailored to their needs.

An important purpose of the Code is to enable all prospective partners to approach new collaborations with a common understanding of the IP issues involved. Using this as a starting point for negotiation will help speed up negotiation times allowing the partners to reach agreement on the terms of their collaboration quickly, so that they can start working and creating useful results as soon as possible. In addition, speeding up negotiations will increase the number of research collaborations as more deals will be agreed in a timely fashion.

The Objectives of this Code of Practice

The Code aims to:

- ▶ build and sustain capability and capacity for collaborative research in PROs and industry and drive commercialisation of research output through all available avenues;
- ▶ enable indigenous Irish companies to grow through knowledge development and management in partnership with Irish researchers;
- ▶ maximise Ireland's attractiveness for foreign direct investment (FDI) in R&D;
- ▶ encourage and provide incentives for smart and timely industry-PRO research collaboration with a focus on commercialisation;
- ▶ drive Ireland's strategy to become the location of choice for industry-PRO collaboration; and
- ▶ achieve coherence in the national approach to managing and commercialising IP arising from collaborative research.

For industry, this Code aims to:

- ▶ Facilitate access to institutes, faculty and students that are aware of industrial needs and the processes through which knowledge acquires value;
- ▶ Provide an approach to obtaining access to IP that supports strategic business investment and the inclusion of IP in product development;
- ▶ Provide a starting point and clear principles and guidelines to manage the IP aspects of collaborative research agreements;
- ▶ Help to ensure speed, simplicity and consistency in negotiating collaborative research agreements with PROs.

For the research community, this Code offers:

- ▶ Endorsement of the need to grow and sustain research and teaching capabilities that are internationally competitive;
- ▶ Greater recognition of the strengths and results provided by the community;
- ▶ A starting point and clear principles and guidelines to manage the IP aspects of collaborative research agreements;
- ▶ Speed, simplicity and consistency in negotiating collaborative research agreements with industrial partners;
- ▶ An approach to securing the access to research results necessary for teaching, research, publication and building and sustaining research capabilities;
- ▶ The opportunity to optimise benefits from commercial exploitation of research results and to attract further support from industry.

The Code complements the objectives of the public sector research funding agencies to:

- ▶ promote common IP management practice across funding agencies and all public grant recipients;
 - ▶ strengthen connections between academic and industrial research; and
 - ▶ raise the global profile of Irish research through notable advancement of knowledge, widely known international collaborations, and broad use of IP generated in Ireland.
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The scope of this Code of Practice

This Code of Practice provides guidelines on the management and exploitation of the IP arising from *collaborative* research. Collaborative research, in this context, is research involving one or more PROs, and one or more private sector organisations. The research may be performed wholly by the PRO(s) or jointly by the PRO(s) and by the private sector. The public and private sectors both support the research, through funding and/or intellectual or other contributions in kind.

Part I of this Code sets out the principles that partners should follow in managing IP arising from their collaborative research; Part II expands on these principles by providing more detailed guidelines. Both Part I and Part II include guidance on each of the three distinct issues of invention, ownership and exploitation. The emphasis is on encouraging exploitation as the key priority.

The Code does not provide a set of strict rules for the management of IP; rather, it provides guidelines and a framework for opening negotiations between parties, based on best practice and aimed at making Ireland an attractive place to do collaborative research. Similarly, the Code is a living document that responds with flexibility to the wide variety of circumstances that occur in relation to IP management. In this context, supplementary material which deals with practical aspects of implementation, will be hosted on www.sciencecouncil.ie where it will be regularly revised and updated.

The principles and provisions of this Code respect two important underlying themes.

First, the public sector supports collaborative research both by direct funding and by making available the accumulated knowledge and facilities already built up within the PRO. It is important to maximise the benefits of this public investment by ensuring commercial exploitation, where possible, of the results. Partners in collaborative research should recognise this and help to achieve it.

Second, successful collaborative research draws on many types of knowledge and skills and depends on the contributions of all the partners. Partners should recognise that they all must share equitably in the rights to the research results and in the benefits derived from exploiting those results.

This Code follows-on from the *National Code of Practice for Managing Intellectual Property from Publicly Funded Research*¹ and complements it. Together, these Codes form an integral part of the commercialisation infrastructure in Ireland, and the Council recognises that their successful implementation is dependent on the appropriate resourcing and infrastructure being available to support the commercialisation of research.

¹ National Code of Practice for Managing Intellectual Property from Publicly-Funded Research; ICSTI, April 2004.

This Code has been prepared following extensive consultation amongst industrial and public sector organisations and with specialists in IP management. International consultants Arthur D. Little, who have specialist expertise and experience in matters related to IP, provided ongoing support during the process. The Code draws on, and has sought input from, international best practice, especially that emerging in the European Union^{2,3}, though its first priority is to support Ireland's needs and objectives.

While the Council recognizes that some PROs have taken the time and significant effort to establish IP policies at institutional level, including well staffed technology transfer/industrial liaison offices and appropriate procedures for IP management/commercialisation, all PROs are invited to adopt this Code of Practice. The Council believes that the national cohesion achieved on the subject by broad adoption of the Code will offer significant benefits for stakeholders and encourage greater industrial investment.

2 Guidelines for Management of Intellectual Property in Publicly Funded Research Organisations: Conclusions of the Expert Group on IPR Issues in Publicly Funded Research constituted by the Research Directorate General of the European Commission, 2003.

3 Responsible Partnering: Capitalising Upon Our Strengths in a World of Open Innovation, Report by EUA, ProTon Europe, EARTO and EIRMA, December 2004.

DEFINITIONS

Intellectual Property

Term used to describe the bundle of legal rights that in whole or in part will be in the results of academic research including the following:

1. Patents;
2. Know-how;
3. Copyright;
4. Database rights;
5. Registered designs and design rights (which protect aesthetic features of a product), and also lay-out designs (semi-conductor topography rights) of integrated circuits;
6. Registered and unregistered trade marks, which protect words and symbols used in the course of trade.

Intellectual Property Rights

The legal and beneficial title and interest in Intellectual Property.

Confidential Information

Term used to describe information in whatever form that has the necessary quality of confidence about it, having regard to the circumstances in which it is created, disclosed or used, so as to attract protection under law.

Technology Transfer

A formal transferring of new inventions, creations, discoveries, innovations, processes and the like which result from scientific research conducted at public research organisations to a commercial environment.

Public Research Organisations

Research laboratories and agencies operated and funded entirely by government and other research organisations including Universities and Institutes of Technology that receive a significant share of their total funding from public sources.

In Kind

In kind contributions could include access to research infrastructure, expensive equipment or specialist expertise provided by either party.

State Aid⁴

A European Commission term which refers to forms of assistance from a public body, or publicly-funded body, given to undertakings on a discretionary basis, with the potential to distort competition and affect trade between member states of the European Union.

Companies and PROs should consult the relevant development agencies and receive appropriate legal advice for any questions relating to the possible impact of State aid rules on collaborative research activities.

ABBREVIATIONS

ACSTI	Advisory Council for Science, Technology and Innovation
PRO	Public Research Organisation
AURIL	Association for University Research and Industry Links, UK & Ireland
AUTM	American Association of University Technology Managers
Code	National Code of Practice for Managing and Commercialising Intellectual Property from Public-Private Collaborative Research
ICSTI	Irish Council for Science, Technology and Innovation
IP	Intellectual Property
IPR	Intellectual Property Rights

⁴ For supplementary information on State Aid, please refer to www.sciencecouncil.ie

PART I

**Principles for the Management and
Commercialisation of Intellectual Property
from Public-Private Collaborative Research**

PART I CODE OF PRACTICE: PRINCIPLES

SECTION A – IP STRATEGY AND ROLES OF PARTNERS

A.1 EXPLOITATION IS A KEY PRIORITY

One of the most important objectives of collaborative research projects is to enable the creation of commercial opportunities that maximise the exploitation of the research output.

A.2 ROLES AND RESPONSIBILITIES OF THE PARTNERS

Partners should have clear roles and responsibilities. Partners in a collaborative research project may obtain rights to exploit IP; with these rights, they also assume the responsibility to pursue exploitation.

A.3 DIFFERENT INDUSTRIES HAVE DIFFERENT NEEDS FOR IP MANAGEMENT

Different industries have different requirements for exploiting the results of collaborative research. Indeed different types of companies within the same sector have different requirements for exploiting the results of collaborative research.

Agreements between the partners in a collaborative research project should reflect the needs and priorities of the industry partner(s) concerned.

A.4 SINGLE CONTACT POINT FOR IP MANAGEMENT FROM EACH PARTY

Clarity of purpose is achieved when there is clear communication between partners. Collaborating partners should each provide a single point of contact with the authority to communicate and make decisions on matters of IPR on behalf of that partner and to manage internal communications regarding IPR within their organisation.

SECTION B – IP MANAGEMENT

B.1 FORMAL AGREEMENT BEFORE WORK STARTS

Putting in place agreements between collaborating partners before work starts, and maintaining these throughout the work, reduces uncertainties, promotes trust and protects the rights of partners. Collaborative research projects should be covered from the start by a formal agreement that describes the project, including the future ownership and access arrangements, management and exploitation (in as far as possible given the stage of the research) of IP. The time it takes to negotiate an agreement is a key determinant of the attractiveness of a collaborative research project, particularly to the industrial partner. The partners should complete the negotiation of the agreement as quickly as possible. The conclusion of the agreement may represent the first step in an evolving relationship entailing a series of agreements and/or amendments lasting a number of years. The partners should also agree a process for making alterations to this agreement in order to maximise exploitation.

B.2 CONFIDENTIALITY

Confidentiality is a requirement in order to obtain certain types of IP protection. Until IP protection has been established, project results must be kept confidential and should not be communicated outside the project team and key decision makers within partner organisations without review and agreement by the partners and subject to an appropriate confidentiality agreement. A partner who wishes to publish results must first obtain permission from the other partner(s). Any objection should be notified within 14 days of the request for publication (unless a different fixed time period is agreed at the outset of the project) and should include a suggestion for an acceptable amendment. The other partners should not unreasonably withhold permission to publish and, in any case, should be deemed to have given permission if they fail to respond to a written request to publish within 30 days.

B.3 RECORD KEEPING

Demonstrating the basis of an invention, the identity of the inventor or inventors and the date of discovery are requirements in order to obtain certain types of IP protection. Research team members should maintain adequate records, either electronically (in an acceptable form for demonstrating discovery dates) or recorded in laboratory books, for the purpose of establishing inventors and date of invention. Project records should remain secure and confidential.⁵

⁵ For more information on record keeping, please see Section 3 of this Code or www.sciencecouncil.ie

B.4 VERIFICATION OF OWNERSHIP

As a general principle of law in Ireland, ownership of inventions and other IP created by employees during the course of employment resides with their employers. However, each collaborating partner must ensure that it has entered into appropriate written agreements with its employees that grant it ownership of inventions and other IP arising from their work, while providing for appropriate recognition, incentives and reward for the team involved. It is also extremely important that appropriate written agreements are in place with any consultants, contractors, students and other non-employees working for any collaborating partner, in which those parties assign any IP created by them in the course of the project, to the collaborating partner for whom they are doing the work. This is very important because IP created by non-employees (e.g. consultants, contractors, students) does not automatically vest in the organisation for which they are doing the work unless a written agreement to this effect is put in place. Any agreements with employees, students and third party consultants/contractors should also contain appropriate provisions to enable the collaborating partner to deal with any formal registration requirements for any IP developed.

B.5 DISCLOSURE

Early identification of new ideas and discoveries is important for IP protection and increases value to all partners. There should be a formal procedure for early and confidential disclosure of new ideas or discoveries by researchers to all partners.

B.6 EVALUATION

All disclosures of new ideas or discoveries should be promptly and formally evaluated to assess commercial potential. The process should take account of the time pressures on all parties, including the pressure to achieve early publication and the pressure to commercialise. The process should be clearly understood and communicated amongst the partners. The process should recognise that each evaluation will be different. Evaluations should involve all project partners, as prescribed in the initial agreement. Evaluations must involve the originating researchers/inventors and project partners.

B.7 IP PROTECTION

Securing IP protection is frequently vital to promote commercial exploitation. Where possible, the appropriate protection should be agreed up front. If a decision is taken to obtain patent protection, or to secure protection by other means (e.g. trade secret) the process should be led by a suitable project partner with professional assistance used as appropriate. Partners should have a formal agreement on ownership, access rights, royalties, and responsibility to exploit before they begin the research project. Trade marks, know-how and confidential market information are important commercial assets.

SECTION C – OWNERSHIP

C.1 EARLY AND FLEXIBLE AGREEMENT

Agreement on allocation of ownership and access to potential IP between collaborating partners, which is established before work starts, reduces uncertainties, promotes trust and protects the rights of partners. Partners should agree who will own the IP and associated IPR as part of their up-front collaboration agreement. Partners should choose ownership arrangements that provide the best environment for subsequent commercial exploitation.

C.2 OWNERSHIP OF PRIOR IP CONTRIBUTED TO COLLABORATIVE RESEARCH

Collaborative research draws on the expertise and resources of the partners. Partners should respect the specific expertise and associated IP of their partners. Each partner should retain ownership of the IP they bring to the project (the 'background IP'), and should grant appropriate access to this background IP to the other partners for the purposes of research and teaching, and for the commercial exploitation of the IP arising from the project. Where a partner has already granted/agreed to grant, access to that IP to other parties, it should make the other partners aware of any resulting limitations on the access rights to its background IP.

C.3 OWNERSHIP OF IP ARISING FROM COLLABORATIVE RESEARCH

Successful commercialisation should be the primary consideration in all research collaborations and agreements. Optimum IP ownership and access arrangements will play a key role in protecting investment in research, and ensuring successful exploitation leading to new products and services.

As all research collaborations are different, **ownership and access to IP should be negotiated on a project by project basis**. In conducting such negotiations, decisions on allocating ownership and access should principally be based on a combination of the funding contributions by the parties, their intellectual contribution to the research project, the optimum exploitation route for a particular technology and the partner(s) best positioned to protect and exploit the IP. Further considerations are outlined in the guidelines below. The agreement reached should ensure fair and reasonable incentives for all parties, and should also ensure that PROs are free to pursue similar lines of research with other industrial partners, while respecting existing IP ownership and confidentiality agreements. Special attention will be required in the case of IP arising from technologies with applications in multiple products and across several technology sectors.

Discussion between parties to arrive at an agreed arrangement on ownership and access to IP should include consideration of three key factors (1) financial input, (2) intellectual input and (3) capacity to exploit. Issues to be addressed should include:

Financial input:

- ▶ Relative financial contribution from the parties;
- ▶ Requirement to strike a fair and reasonable incentivisation between all parties involved in the project;
- ▶ Other input to the project, including researchers, equipment and provision of materials, and a clear understanding and financial outline of in-kind contributions;
- ▶ Impact on future research – is it compromised? All parties should understand the relationship of the current research to future academic research.

Intellectual input:

- ▶ Nature and scope of the proposed collaboration;
 - ▶ Level of intellectual input from both sides, is there a genuine collaborative effort?
 - ▶ Relative abilities of the partners to obtain, maintain and, where necessary, defend IPR.
-

Capacity to exploit:

- ▶ Likely commercial applications of the IP, the optimum exploitation route and the partner(s) best positioned to execute it;
- ▶ Degree of alignment of the research with the industrial partner's technology development and acquisition strategy;
- ▶ Likely costs and resources required to develop the results of the collaboration into commercial products or services;
- ▶ Stage of the research: early or closer to market?
- ▶ Scale and timeframe required for pre-commercial development;
- ▶ Risk associated with taking a product to market.

SECTION D – COMMERCIALISATION

D.1 MAXIMUM EXPLOITATION OF IP

The primary aim of any relationship and associated agreement between the partners concerning IP should be to ensure that the IP arising from the research can and will be fully exploited for commercial gain.

The preferred arrangements for exploiting the results and IP arising from the research are that the partner best positioned and most able to pursue commercial exploitation will have sufficient access to the IP to enable full and successful exploitation.

All available avenues for exploitation should be considered, including the option of spin-out formation.

D.2 EXPLOITATION PLAN

Establishing an explicit exploitation plan as part of the collaboration agreement encourages partners to agree how to manage the IP and to exploit it in a purposeful way. Before the project starts, in as far as possible given the stage of the research, partners should discuss (in confidence) the implications of different exploitation routes and the associated

issues of IP ownership, exploitation rights, risk and appropriate rewards. They should agree arrangements for IP access by each partner that are appropriate to the specific collaboration and that will allow full exploitation. Partners should review and, if necessary, refine this exploitation plan before seeking any form of IP protection.

D.3 ACCESS TO AND USE OF IP BY PARTNERS FOR EDUCATION AND RESEARCH

Partner(s) should retain rights to use and access knowledge and data arising from the project for the purposes of research, while respecting confidentiality agreements. Access to background IP should be considered as part of the ongoing discussion on background IP over the course of the project. Partners should recognise the possible limits on access required by the other party. In the case of the PRO, for example, access to enterprise background IP may be limited by confidentiality requirements concerning potentially patentable matter or third party rights to the background IP; in the case of industry, access to PRO background IP may be limited by the PRO having specific applications tied up with third parties or having reserved certain elements of background IP for its own commercialisation activities.

D.4 TRANSFER OF OWNERSHIP AND LICENSING TO PARTIES OTHER THAN THE PARTNERS

The value of IP is maximised when it is exploited in as many ways as possible. The partners should be able to grant licences to enable parties other than the original partners to exploit the IP in non-competing fields of use, or, alternatively, to transfer ownership to third parties.

D.5 EXPLOITATION IN IRELAND

Exploitation options should be considered based on the commercial evaluation of the technology and the technology transfer policy of the PRO, giving consideration to exploitation firstly within Ireland and thereafter the European Economic Area (EEA) and globally, and ensuring always that the option chosen is regarded as the best form of exploitation for the maximum benefit to the Irish economy.

D.6 GOVERNING LAW

Irish law should govern collaborative research agreements.

SECTION E – INCENTIVES AND BENEFITS

E.1 INCENTIVES FOR PRO PARTNERS

PROs have a mission to educate and carry out research. Employees in PROs should be able to share in the benefits of IP exploitation subject to the nature of the collaborative arrangements, and taking account of financial input, intellectual input and capacity to exploit.

PROs should publish a policy that clearly explains how they will share income such as royalties and equity, arising from the exploitation of IP created during collaborative research projects, between the PRO, departments within the PRO and individual inventors. Reward structures need not be restricted to financial benefits, and PROs should also consider other types of benefits including career advancement and tenure.

E.2 INCENTIVES FOR INDUSTRIAL PARTNERS

Industrial partners should have a right to exploit IP arising from collaborative research and to obtain royalties from licenses granted to third parties.

It is the responsibility of the industrial partner(s) to reward their employees, who contribute to collaborative research resulting in IP, in a fashion consistent with their employment contracts.

SECTION F – CONFLICTS OF INTEREST

F.1 MANAGEMENT OF CONFLICTS OF INTEREST

It is in the interest of all partners to minimise conflicts of interest. Partners should develop and implement policy and procedures to avoid and, if necessary, address conflicts of interest.

SECTION G - RELATIONSHIP MANAGEMENT AND CONFLICT RESOLUTION

G.1 RELATIONSHIP MANAGEMENT AND DEALING WITH DISAGREEMENTS

Established relationships create trust and facilitate the process of managing collaborative research. Partners should take care to maintain good relationships with their collaborators.

Having established mechanisms for dealing with disagreements simplifies and speeds up resolution. Partners should develop an agreed mechanism and timescale for dealing with disagreements.

SECTION H – MONITORING AND EVALUATION

H.1 MONITORING AND EVALUATION

Monitoring and evaluation can strengthen the effectiveness of IP management and exploitation mechanisms. Partners should develop and implement clear systems for monitoring and evaluating their performance of collaborative research.



PART II

**Code of Practice for the Management and
Commercialisation of Intellectual Property
from Public-Private Collaborative Research**

PART II CODE OF PRACTICE

SECTION A – IP STRATEGY AND ROLES OF PARTNERS

A.1 EXPLOITATION IS A KEY PRIORITY

One of the most important objectives of collaborative research projects is to enable the creation of commercial opportunities that maximise the exploitation of the research output.

Guidelines:

- ▶ Partners in a collaborative research project should have a clear strategy to maximise the exploitation of IP arising from the project.
- ▶ Partners wishing to make use of IP arising from the project should be able to demonstrate clearly how the IP will be exploited to its full potential.
- ▶ Partners responsible for exploitation should ensure that they can access (internally or externally) sources of commercial, technical and legal advice for the purposes of exploiting IP arising from the project.

A.2 ROLES AND RESPONSIBILITIES OF THE PARTNERS

Partners should have clear roles and responsibilities. Partners in a collaborative research project may obtain rights to exploit IP; with these rights, they also assume the responsibility to pursue exploitation.

Guidelines:

- ▶ Partners should agree who has what rights of exploitation, and the associated responsibilities to pursue exploitation, as part of the up-front collaboration agreement (see Section B.1 Formal agreement before work starts).
 - ▶ Participants should be clear about their partners' expectations regarding working arrangements.
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A.3 DIFFERENT INDUSTRIES HAVE DIFFERENT NEEDS FOR IP MANAGEMENT

Different industries have different requirements for exploiting the results of collaborative research. Indeed different types of companies within the same sector have different requirements for exploiting the results of collaborative research.

Agreements between the partners in a collaborative research project should reflect the needs and priorities of the industry partner(s) concerned.

Guidelines:

- ▶ Partners should secure appropriate IP protection to maximise exploitation potential.
- ▶ Where IP can be licensed to third parties, partners should consider the requirements of different industries in structuring access to IP arising from the project.
- ▶ Consideration should be given to appropriate protection for platform type IP that may have applications across different sectors.

A.4 SINGLE CONTACT POINT FOR IP MANAGEMENT FROM EACH PARTY

Clarity of purpose is achieved when there is clear communication between partners. Collaborating partners should each provide a single point of contact with the authority to communicate and make decisions on matters of IPR on behalf of that partner and to manage internal communications regarding IPR within their organisation.

Guidelines:

- ▶ Partners should operate clear and agreed processes for exchanging (in a confidential manner) information regarding actual or potential IP.
 - ▶ The IP contact person should deal with all enquiries promptly and efficiently in order to allow the research to progress in a timely fashion.
 - ▶ The IP contact person should support and encourage open and direct communications amongst the members of the research team.
 - ▶ The designated IP contact person from the PRO(s) should ensure the necessary communication with the State Funding Agencies is dealt with to avoid any delays in the process.
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SECTION B – IP MANAGEMENT

B.1 FORMAL AGREEMENT BEFORE WORK STARTS

Putting in place agreements between collaborating partners before work starts, and maintaining these throughout the work, reduces uncertainties, promotes trust and protects the rights of partners. Collaborative research projects should be covered from the start by a formal agreement that describes the project, including the future ownership and access arrangements, management and exploitation (in as far as possible given the stage of the research) of IP. The time it takes to negotiate an agreement is a key determinant of the attractiveness of a collaborative research project, particularly to the industrial partner. The partners should complete the negotiation of the agreement as quickly as possible. The conclusion of the agreement may represent the first step in an evolving relationship entailing a series of agreements and/ or amendments lasting a number of years. The partners should also agree a process for making alterations to this agreement in order to maximise exploitation.

Guidelines:

Parties should endeavour to reach agreement in as short a period as possible, and in any event within a maximum of **90 days**.

The formal agreement should explicitly state:

- ▶ The purpose of the project.
 - ▶ The identity and roles of each partner, the activities that each will carry out, and the management structure including:
 - ▶▶ The lead contact point for each partner;
 - ▶▶ The project manager;
 - ▶▶ The members of the project technical team. This should consist of work package leaders from each partner, lead contact points and any external experts;
 - ▶▶ The members of the project management team. This should consist of one member from each partner, who has authority to represent that partner in financial matters and to negotiate on behalf of that partner.
 - ▶ The provision of funding and in-kind contributions by partners and the total allocated costs of the project.
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- ▶ The project objectives, goals, work schedule, timelines and associated project milestones.
 - ▶ The process for identifying, evaluating and protecting (including prosecution, maintenance and enforcement), IP arising from the project, including timeframes.
 - ▶ The partner responsible for the timely prosecution (typically within 90 days) and maintenance of all arising IP; the partner that is nominated should be entitled to charge the other partners with a fair share of the associated costs in proportion to their access/ownership rights.
 - ▶ The definition of what will constitute improvements to IP arising from the project, and what rights each partner will have to those improvements.
 - ▶ The process and timeframes for identifying, evaluating and protecting improvements to the IP arising from the project.
 - ▶ Ownership and access rights to IP arising from the project.
 - ▶ An exploitation plan; the proposed route to commercial exploitation and associated arrangements for access to IP. All parties are encouraged to consider all possible exploitation routes including, where appropriate, PRO spin-outs and third-party licensing.
 - ▶ The responsibilities of partners owning or holding licences to IP to exploit that IP with associated actions and agreed timelines and consequences should obligations not be met.
 - ▶ The terms and conditions associated with IP access and usage, and the principles to be used in determining financial and non financial incentives:
 - ▶▶ Parties are encouraged to fully explore the range of possible benefit sharing options available to include e.g. profit sharing, equity participation in a spin-out, royalty payments and goods in kind, taking into account that different sectors may opt for different combinations of financial and non-financial incentives;
 - ▶▶ The specific financial and non-financial incentives to be provided should be finalised, where possible, immediately prior to obtaining IP protection, and should normally be based on likely revenues, costs and other contributing IP.
 - ▶ The mechanism for external dispute resolution if partners are unable to resolve differences amongst themselves.
 - ▶ The circumstances in which the Formal Agreement would need to be modified.
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- ▶ The extent to which the partners should indemnify each other with respect to, liabilities arising from commercialisation of the resulting IP, and of other activities of the project they are not involved in and over which they have little or no control.
- ▶ So far as possible, identification of the IP which each partner brings to the project (i.e. background IP), and the extent to which, and terms on which, the other partners are granted access to same.
- ▶ Provisions dealing with governing law and jurisdiction.

B.2 CONFIDENTIALITY

Confidentiality is a requirement in order to obtain certain types of IP protection. Until IP protection has been established, project results must be kept confidential and should not be communicated outside the project team and key decision makers within partner organisations without review and agreement by the partners and subject to an appropriate confidentiality agreement. A partner who wishes to publish results must first obtain permission from the other partner(s). Any objection should be notified within 14 days of the request for publication (unless a different fixed time period is agreed at the outset of the project) and should include a suggestion for an acceptable amendment. The other partners should not unreasonably withhold permission to publish and, in any case, should be deemed to have given permission if they fail to respond to a written request to publish within 30 days.

Guidelines:

- ▶ Employees, students, consultants and all other individuals associated with the project should be bound by confidentiality agreements.
 - ▶ Confidential disclosure to individuals is possible, but should be accompanied by a clear written statement that disclosure is on a privileged and confidential basis; confidentiality should be agreed in advance otherwise it cannot be enforced.
 - ▶ Partners should have an agreed standard confidentiality agreement to cover confidential disclosures to third parties.
 - ▶ Partners may wish to protect IP through trade secrecy and to maintain all project results as strictly confidential. Normally this should be agreed at the outset and, in such cases, only in exceptional circumstances would a contribution from public funds be appropriate. IP which industrial partners wish to keep secret may however, only become apparent during the course of a project. In this event the public funding agency should have
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discretion to require the industrial partner to cover the full costs (including overheads) of the relevant part of the research project, together with a suitable incentive to reward the PRO partner. Employees at the PRO should share in this incentive in order to recompense them for loss of publication opportunities.

- ▶ The partners should have mechanisms in place to review the current status of the research results arising from the project and to remove confidentiality restrictions on any results for which a decision has been taken not to seek IP protection.
- ▶ Authorisation to publish should not be unreasonably withheld once an application for IP protection has been filed. Once a patent application has been filed then it may be possible to develop an academic publication. However, a commercial judgement should be made to establish exactly when to publish, so that the partners can, if required, retain the flexibility to amend or re-file the patent within the priority year.
- ▶ IP awareness, education and training at appropriate levels within the partner organisations should focus on practicalities such as:
 - ▶▶ The process of identifying and protecting IP;
 - ▶▶ The importance of confidentiality and what constitutes a non-prejudicial disclosure;
 - ▶▶ The importance of ensuring that a clear chain of ownership to the IP exists;
 - ▶▶ Understanding patentability and the patenting process;
 - ▶▶ The organisation's policy on IP disclosure, ownership, protection and exploitation, and who to contact.
- ▶ The term "publish" means making information freely available to third parties by visual, oral or written communication, for example:
 - ▶▶ Seminars, abstracts, posters, scientific or trade publications;
 - ▶▶ Interviews with journalists ("off the record" comments should be avoided);
 - ▶▶ Exchange or deposit of materials or compounds;
 - ▶▶ Informal discussions by word, e-mail or otherwise with colleagues outside the organisation;
 - ▶▶ Placing any document or drawing or information on a website or bulletin board;
 - ▶▶ Submission of a thesis (without requesting a library restriction).

Other mechanisms may also constitute publication.

B.3 RECORD KEEPING

Demonstrating the basis of an invention, the identity of the inventor or inventors and the date of discovery are requirements in order to obtain certain types of IP protection. Research team members should maintain adequate records, either electronically (in an acceptable form for demonstrating discovery dates) or recorded in laboratory books, for the purpose of establishing inventors and date of invention. Project records should remain secure and confidential.⁶

Guidelines:

- ▶ As part of the discipline for identifying and exploiting intellectual property, researchers should maintain dated laboratory notes or electronic records. Laboratory notes should be written in ink, on numbered pages in a bound notebook, and witnessed and signed by a colleague not involved in the discovery. Legally approved electronic laboratory records should be in an acceptable form for demonstrating discovery dates.
- ▶ Partners should provide specific training on record keeping as part of the IP awareness, education and training programmes within their organisations.
- ▶ Partners should provide good practice guidelines to assist in relation to record keeping and laboratory notebooks.
- ▶ Partners should operate appropriate security systems such as encryption of electronic files, maintaining adequate back-up copies and safe storage of physical records.

B.4 VERIFICATION OF OWNERSHIP

As a general principle of law in Ireland, ownership of inventions and other IP created by employees during the course of employment resides with their employers. However, each collaborating partner must ensure that it has entered into appropriate written agreements with its employees that grant it ownership of inventions and other IP arising from their work, while providing for appropriate recognition, incentives and reward for the team involved. It is also extremely important that appropriate written agreements are in place with any consultants, contractors, students and other non-employees working for any collaborating partner, in which those parties assign any IP created by them in the course of the project, to the collaborating partner for whom they are doing the work. This is very important because IP created by non-employees (e.g. consultants, contractors, students) does not automatically vest in the organisation for which they are doing the work unless a written agreement to this effect is put in place. Any agreements with employees, students and third party consultants / contractors should also contain appropriate provisions to enable the collaborating partner to deal with any formal registration requirements for any IP developed.

⁶ For more information on record keeping, please see www.sciencecouncil.ie

Guidelines:

- ▶ Effective written contracts should be put in place between each of the partners and all individuals (both employees and non-employees) potentially contributing to new IP that, in particular, address ownership issues. These contracts should also include confidentiality obligations.
- ▶ In the event that a person who is or has been engaged in the creation of IP leaves the project or joins another organisation, the project partners should ensure that a written agreement is in place, having regard to the nature of the IP created by that person, setting out the position regarding ownership and confidentiality of the IP, and arrangements regarding (a) the delivery over, in whatever form, of that IP and (b) the signing of any documents necessary to secure IP ownership and recordal rights.
- ▶ Confirmatory assignment by inventors is considered important for all parties.⁷

B.5 DISCLOSURE

Early identification of new ideas and discoveries is important for IP protection and increases value to all partners. There should be a formal procedure for early and confidential disclosure of new ideas or discoveries by researchers to all partners.

Guidelines:

- ▶ Inventors should normally complete disclosure procedures within 30 days of making the invention.
- ▶ Procedures that provide for disclosure of new ideas and discoveries with potential commercial applicability should be swift and straightforward (through, for example, the use of standard forms and a clear system of information exchange) so that research activity is not disrupted.
- ▶ An Invention Disclosure Form or other appropriate method for collection and documentation of basic information from the inventor/author to allow an assessment of patentability should be used for assistance, as required. Other information required by the various parties involved in commercialising inventions is also included. The headings in the form can be used as a checklist of information that is required.⁸
- ▶ A typical Invention Disclosure Form allows for collection of information on multiple sources of research funding. This information should be obtained at an early stage in order to clarify IP obligations that may exist in relation to different individual research funders and to ensure that appropriate information is provided to funders if necessary.

⁷ For sample confirmatory assignment form, please see www.sciencecouncil.ie

⁸ For sample invention disclosure form, please see www.sciencecouncil.ie

B.6 EVALUATION

All disclosures of new ideas or discoveries should be promptly and formally evaluated to assess commercial potential. The process should take account of the time pressures on all parties, including the pressure to achieve early publication and the pressure to commercialise. The process should be clearly understood and communicated amongst the partners. The process should recognise that each evaluation will be different. Evaluations should involve all project partners, as prescribed in the initial agreement. Evaluations must involve the originating researchers/inventors and project partners.

Guidelines:

- ▶ Partners should recognise the need to facilitate timely publication and should complete the evaluation process within 60 days of disclosure.
 - ▶ Partners should be aware that during the evaluation process it may be concluded that further investigation and results are needed to make a responsible decision on the possibility and practicality of filing for IP protection of the discovery. Partners should seek to ensure that this additional investigation is kept to a minimum and does not significantly delay publication.
 - ▶ Details provided in an Invention Disclosure Form may help in the timely evaluation of a new invention or discovery.
 - ▶ In the course of the evaluation process, all information provided in the Invention Disclosure Form should be reviewed to assess the ownership position, confidentiality restrictions and exploitation rights of other interested parties.
 - ▶ In many instances, evaluation will be brief and lead to a decision not to pursue IP protection. Partners should take care to ensure that this does not significantly delay publication.
 - ▶ Should the partners decide not to pursue exploitation of a discovery, they may decide to offer the opportunity to the inventor(s) to pursue exploitation on their own account, subject to appropriate agreements concerning transfer of exploitation rights to the inventor, and concerning any payments by the inventor to the partners, in accordance with the policies of the parties.
 - ▶ The evaluation process should be revisited for existing patent applications, patents and other forms of IPR in the partners' IP portfolio at appropriate intervals to inform decisions on continuing or abandoning IPR prosecution.
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B.7 IP PROTECTION

Securing IP protection is frequently vital to promote commercial exploitation. Where possible, the appropriate protection should be agreed up front. If a decision is taken to obtain patent protection, or to secure protection by other means (e.g. trade secret) the process should be led by a suitable project partner with professional assistance used as appropriate. Partners should have a formal agreement on ownership, access rights, royalties, and responsibility to exploit before they begin the research project. Trade marks, know-how and confidential market information are important commercial assets.

Guidelines:

- ▶ Background IP brought to the research project by each partner should only be disclosed to the other partner(s) once appropriate confidentiality agreements have been signed. The nature and extent of background IP required may be difficult to define in advance of the research programme. Consequently, all parties are encouraged to discuss and review background IP as part of routine project management and governance by technical and management teams.
 - ▶ A partner that owns certain arising IP is normally responsible for obtaining, maintaining and defending appropriate protection (such as patents) for that IP. Should it decline to do so, it should provide other partners with sufficient notice of its intentions to enable them to take over that responsibility. Where there are multiple exploitation partners costs should be shared in accordance with access rights.
 - ▶ Partners should consult with each other before seeking IP protection and should develop a formal agreement regarding the transfer of, and access to, that IP (through assignment or licences) as outlined in the collaboration agreement, once protection has been secured. Partners should also review the conditions attached to planned future assignments or licences including the proposed benefit-sharing provisions thereof.
 - ▶ The process of obtaining IP protection should where appropriate involve the relevant inventors.
 - ▶ Guidance information on the main types of IP protection, on patent applications in general and on patent costs should be made available to inventors and other individuals involved in the project.
 - ▶ General guidelines and considerations intended for assistance in liaising with an appropriately qualified patent agent and filing a patent application should be made available to appropriate individuals involved in the project.
 - ▶ Inventors should be made aware that their support and assistance at the various stages of the patenting process, including the provision of all necessary information, are essential to ensure that patent protection can be obtained.
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SECTION C – OWNERSHIP

C.1 EARLY AND FLEXIBLE AGREEMENT

Agreement on allocation of ownership and access to potential IP between collaborating partners, which is established before work starts, reduces uncertainties, promotes trust and protects the rights of partners. Partners should agree who will own the IP and associated IPR as part of their up-front collaboration agreement. Partners should choose ownership arrangements that provide the best environment for subsequent commercial exploitation.

Guidelines:

- ▶ Agreement on ownership and access to research outcomes should be established as part of the formal collaboration agreement, before work starts.
- ▶ Agreement on ownership and access to IP should deal with ownership of IPR which are automatic (such as know-how and copyright) and with ownership of rights that are granted (such as patents).
- ▶ Agreement on ownership and access to IP should include a process for defining and accessing background IP, where relevant.
- ▶ Partners should review these arrangements from time to time and in good faith consider amending them if doing so will improve the environment for exploitation. This review mechanism should be included in the management agreement and governance procedure.

C.2 OWNERSHIP OF PRIOR IP CONTRIBUTED TO COLLABORATIVE RESEARCH

Collaborative research draws on the expertise and resources of the partners. Partners should respect the specific expertise and associated IP of their partners. Each partner should retain ownership of the IP they bring to the project (the 'background IP'), and should grant appropriate access to this background IP to the other partners for the purposes of research and teaching, and for the commercial exploitation of the IP arising from the project. Where a partner has already granted/agreed to grant, access to that IP to other parties, it should make the other partners aware of any resulting limitations on the access rights to its background IP.

Guidelines:

- ▶ Partners should, where practical, define in advance, and ensure that they have and retain, the ownership of all the background IP that they bring to the project.
- ▶ For the purposes of commercial exploitation of the IP arising from the project, the exploiting partner(s) should receive access to the required background IP and specialist know-how of the other partner(s), on terms to be agreed. Partners are reminded to disclose the existence of any restrictions concerning access to required background IP.
- ▶ PRO partners should receive non-exclusive, royalty-free access to the background IP of the other partners for the purposes of research and teaching, subject to any agreement on confidentiality. Partners are reminded to disclose the existence of any restrictions concerning access to required background IP.
- ▶ In sharing background IP, each partner should recognise the need to protect confidential information provided to it by the other partner(s). In particular, PROs must respect the requirement to protect confidential information provided by the industrial partner(s), while industrial partners must clearly define to their PRO partners what information it is necessary to treat as confidential.

C.3 OWNERSHIP OF IP ARISING FROM COLLABORATIVE RESEARCH

Successful commercialisation should be the primary consideration in all research collaborations and agreements. Optimum IP ownership and access arrangements will play a key role in protecting investment in research, and ensuring successful exploitation leading to new products and services.

As all research collaborations are different, **ownership and access to IP should be negotiated on a project by project basis**. In conducting such negotiations, decisions on allocating ownership and access should principally be based on a combination of funding contributions by the parties, their intellectual contribution to the research project, the optimum exploitation route for a particular technology and partner(s) best positioned to protect and exploit the IP. Further considerations are outlined in the guidelines below. The agreement reached should ensure fair and reasonable incentives for all parties, and should also ensure that PROs are free to pursue similar lines of research with other industrial partners, while respecting existing IP ownership and confidentiality agreements. Special attention will be required in the case of IP arising from technologies with applications in multiple products and across several technology sectors.

Discussion between parties to arrive at an agreed arrangement on ownership and access to IP should include consideration of three key factors; (1) financial input, (2) intellectual input and, (3) capacity to exploit. Issues to be addressed should include:

Financial input:

- ▶ Relative financial contribution from the parties;
- ▶ Requirement to strike a fair and reasonable incentivisation between all parties involved in the project;
- ▶ Other input to the project, including researchers, equipment and provision of materials, and a clear understanding and financial outline of in-kind contributions;
- ▶ Impact on future research – is it compromised? All parties should understand the relationship of the current research to future academic research.

Intellectual input:

- ▶ Nature and scope of the proposed collaboration;
- ▶ Level of intellectual input from both sides, is there a genuine collaborative effort?
- ▶ Relative abilities of the partners to obtain, maintain and, where necessary, defend IPR.

Capacity to exploit:

- ▶ Likely commercial applications of the IP, the optimum exploitation route and the partner(s) best positioned to execute it;
 - ▶ Degree of alignment of the research with the industrial partner's technology development and acquisition strategy;
 - ▶ Likely costs and resources required to develop the results of the collaboration into commercial products or services;
 - ▶ Stage of the research: early or closer to market?
 - ▶ Scale and timeframe required for pre-commercial development;
 - ▶ Risk associated with taking a product to market.
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Guidelines:

These guidelines are intended to provide a framework and starting positions to guide negotiations between project partners.

Recommended opening positions for negotiation:

I 100% Industry Funded Research

- A. Where industry pays in full for the research, including both direct and indirect costs, participates in the project and is considered the key exploitation partner, it will own the IP.
- B. Where a project is PRO-led and industry does not provide intellectual input to the project, title to IP should be negotiated based on best route for exploitation and the partner best positioned to execute the exploitation strategy⁹.

II Collaborative Research

Always conscious of State Aid rules¹⁰:

- A. Where industry provides a significant part of the funding, provides intellectual input to the project and is deemed best positioned to exploit the IP, the industrial partner(s) can own the IP. Fair and reasonable financial and non financial incentives should be provided to the PRO.
- B. Where the State is the primary financial contributor to the project, the PRO will own the IP. All industrial partners will have rights of access unless it has been agreed upfront that one party will have an exclusive licence, for which it will pay market rates¹¹. The PRO is obliged to maximise the exploitation of IP through licensing to industrial partner(s) where the industrial partner(s) is best positioned to exploit the IP. Exclusivity may refer to all or part of the project(s).

III 100% State Funded Research

IP arising from research fully funded by the State is owned by the PRO as outlined in the National Code of Practice for Management of IP from Publicly Funded Research.¹²

⁹ Note that this situation typically only arises in the case of research funded from philanthropic sources.

¹⁰ For basic definition of State Aid, refer to "Definitions" above, and to www.sciencecouncil.ie; guidance on State Aid rules should be sought from relevant development agencies.

¹¹ The appropriate market rate payable should be discounted based on the initial contribution made by the industrial partner to the project.

¹² National Code of Practice for Managing Intellectual Property from Publicly Funded Research, ICSTI 2004.

Where employees from two or more parties contribute to an invention, joint ownership may be negotiated by the parties. While the negotiation and management of joint ownership agreements can be complex, should this be an agreed option by the parties, the possibility should be included in the upfront agreement. A joint ownership management agreement, outlining exploitation rights and terms, should be negotiated. This agreement should stipulate possible exploitation routes, and should consider third party licensing arrangements by all partners, with provision for further discussion on compensation via royalty payments, as appropriate.

INCENTIVES FOR COLLABORATIVE RESEARCH:

In negotiating ownership and access to the IP, all partners should ensure that adequate incentives are provided for the collaborating parties, taking account of funding arrangements and relative intellectual input. Members of the project team should share in the benefits of successful collaboration and commercialisation. Incentives should be broadly-based and include both financial and non-financial rewards.

SECTION D – COMMERCIALISATION

D.1 MAXIMUM EXPLOITATION OF IP

The primary aim of any relationship and associated agreement between the partners concerning IP should be to ensure that the IP arising from the research can and will be fully exploited for commercial gain.

The preferred arrangements for exploiting the results and IP arising from the research are that the partner best positioned and most able to pursue commercial exploitation will have sufficient access to the IP to enable full and successful exploitation.

All available avenues for exploitation should be considered, including the option of spin-out formation.

Guidelines:

- ▶ The partner who expects to exploit the IP commercially has an obligation to do so in a timely manner, subject to the demands of the market. If they cannot or choose not to do so, they should make the necessary arrangements to enable other partner(s) or third parties to exploit the IP.
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- ▶ Parties should agree a suitable definition of action or milestones which would qualify as commercialisation actions and associated timeframe for their demonstration.
- ▶ If none of the partners has taken action to exploit particular IP within a period of two years, the owner(s) may request that the IP be released to another party for the purpose of exploitation. The request should be considered in light of the nature of the collaborative arrangements, taking account of intellectual input, potential to exploit and financial input. Financial input at this stage would include not only contributions to the initial project that gave rise to the IP, but also any investment made subsequently in product development.
- ▶ The partners may at any time mutually agree that the partner owning certain IP may transfer title to that IP to the other partner(s) or may grant a licence to the other partner(s).
- ▶ The partners should consider flexible benefit sharing schemes. Where royalties form part of the benefit sharing scheme, all parties are encouraged to avoid scenarios where the end products are subject to such prohibitive multiple royalty payments that the partner holding the exploitation rights has little or no incentive to further develop and commercialise.

D.2 EXPLOITATION PLAN

Establishing an explicit exploitation plan as part of the collaboration agreement encourages partners to agree how to manage the IP and to exploit it in a purposeful way. Before the project starts, in as far as possible given the stage of the research, partners should discuss (in confidence) the implications of different exploitation routes and the associated issues of IP ownership, exploitation rights, risk and appropriate rewards. They should agree arrangements for IP access by each partner that are appropriate to the specific collaboration and that will allow full exploitation. Partners should review and, if necessary, refine this exploitation plan before seeking any form of IP protection.

Guidelines:

- ▶ Partners should discuss the implications of different exploitation routes and the associated issues of IP ownership, exploitation rights and benefits.
 - ▶ Partners should review and refine their exploitation plan as part of the process of deciding how to protect and exploit specific IP as it arises, for example in order to deal with potential issues associated with royalty stacking.
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- ▶ Partners should have an agreed and documented process for identifying and evaluating potential exploitation routes.
- ▶ Partners are reminded to review background IP provisions on an ongoing basis.
- ▶ The valuation of early stage IP is very uncertain. Several factors should be considered in estimating value or potential value, for example:
 - ▶▶ Market valuations – in other words “what is the current market willing to pay?”
 - ▶▶ Third party assistance including, for example, input from industry and state agencies;
 - ▶▶ Study of comparable existing subject matter, licences and commercialisation practices;
 - ▶▶ Estimating projected sales based on market research;
 - ▶▶ Development stage of the subject matter;
 - ▶▶ Estimated cost of getting to market;
 - ▶▶ Barriers to entry into markets;
 - ▶▶ Estimated cost of patent process;
 - ▶▶ Risks associated with taking a product to market.

D.3 ACCESS AND USE BY PARTNERS FOR EDUCATION AND RESEARCH

Partner(s) should retain rights to use and access knowledge and data arising from the project for the purposes of research, while respecting confidentiality agreements. Access to background IP should be considered as part of the ongoing discussion on background IP over the course of the project. Partners should recognise the possible limits on access required by the other party. In the case of the PRO, for example, access to enterprise background IP may be limited by confidentiality requirements concerning potentially patentable matter or third party rights to the background IP; in the case of industry, access to PRO background IP may be limited by the PRO having specific applications tied up with third parties or having reserved certain elements of background IP for its own commercialisation activities.

Guidelines:

- ▶ IP used in or arising from the project must be clearly defined and separated from general, ongoing research or other collaborations.
- ▶ Unnecessary reach-through agreements should be avoided for all partners.
- ▶ Partners should, where appropriate, be notified of further research activities that draw on IP arising from collaborative research.
- ▶ Partners should ensure that employees, students and other third parties being educated or carrying out further research are aware of and abide by any confidentiality requirements.

D.4 TRANSFER OF OWNERSHIP AND LICENSING TO PARTIES OTHER THAN THE PARTNERS

The value of IP is maximised when it is exploited in as many ways as possible. The partners should be able to grant licences to enable parties other than the original partners to exploit the IP in non-competing fields of use, or, alternatively, to transfer ownership to third parties.

Guidelines:

- ▶ Providing that it does not reduce the opportunities for exploitation or for further research and training by the original partners, there should be a provision in the collaboration agreement between the partners allowing for such licensing or transfers of ownership on the consent of all partners.
 - ▶ Existing partners should have rights of first refusal on all such licences or transfers.
 - ▶ Where appropriate, all partners should share in royalties from licences issued to third parties and from payments for all transfers to third parties.
 - ▶ The right of first refusal should continue to apply while a partner is in the process of liquidation (subject to insolvency laws).
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D.5 EXPLOITATION IN IRELAND

Exploitation options should be considered based on the commercial evaluation of the technology and the technology transfer policy of the PRO, giving consideration to exploitation firstly within Ireland and thereafter the European Economic Area (EEA) and globally, and ensuring always that the option chosen is regarded as the best form of exploitation for the maximum benefit to the Irish economy.

Guidelines:

- ▶ Where exploitation is not to be entirely carried out in Ireland, the exploiting partner should consider what parts of the exploitation process can be located in Ireland.

D.6 GOVERNING LAW

Irish law should govern collaborative research agreements.

Guidelines:

- ▶ Where Irish law does not govern the collaborative research agreement, the partner requesting the exception should (where applicable and/or appropriate) provide contingency funding for access to appropriate legal advice where it is required by its partners.

SECTION E – INCENTIVES AND BENEFITS

E.1 INCENTIVES FOR PRO PARTNERS

PROs have a mission to educate and carry out research. Employees in PROs should be able to share in the benefits of IP exploitation subject to the nature of the collaborative arrangements, and taking account of financial input, intellectual input and capacity to exploit.

PROs should publish a policy that clearly explains how they will share income such as royalties and equity, arising from the exploitation of IP created during collaborative research projects, between the PRO, departments within the PRO and individual inventors. Reward structures need not be restricted to financial benefits, and PROs should also consider other types of benefits including career advancement and tenure.

Guidelines:

- ▶ All those primarily responsible for the creation of IP (i.e., the inventors) should benefit from its exploitation. It is important that inventors are clearly defined and identified through the disclosure process as outlined in Section C.
 - ▶ Procedures and policies relating to sharing commercialisation income should recognise specific terms and conditions in relevant funding contracts.
 - ▶ PROs should, as far as possible, set out the parameters for sharing royalties and other income relating to exploitation of IP, by way of a standardised approach.
 - ▶ Inventors should be made aware that they may be obliged to continue to sign documents related to their inventions made as part of their work at a PRO, irrespective of whether they are still with that PRO or have moved on, and appropriate procedures should be put in place to ensure this.
 - ▶ Allocating a share of returns to the department/faculty compensates other employees for the indirect contributions they make to generating IP.
 - ▶ Financial incentives need to meet a number of minimum requirements. They should:
 - ▶▶ Include the correct groups i.e. the inventors, the department and the PRO;
 - ▶▶ Be clear and publicised;
 - ▶▶ Be fair and treat all contributors in a similar way;
 - ▶▶ Reflect the returns that are generated;
 - ▶▶ Be sufficiently large and timely in order to have an effect on behaviour;
 - ▶▶ Legislate for inter-PRO IP collaboration.
 - ▶ Other, non-financial types of benefits should also be considered, including:
 - ▶▶ Support for academic employees engaged in IP commercialisation e.g. providing additional time to engage in IP-related activities where there may be scope to relieve employees of particular duties for a specified period of time;
 - ▶▶ Inclusion of IP-related activities as a criterion for career advancement.
 - ▶ In instances where more than one PRO partner has an interest in the IP, the leading PRO partner should take responsibility for sharing any net income generated amongst all the PRO partners.
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E.2 INCENTIVES FOR INDUSTRIAL PARTNERS

Industrial partners should have a right to exploit IP arising from collaborative research and to obtain royalties from licenses granted to third parties.

It is the responsibility of the industrial partner(s) to reward their employees, who contribute to collaborative research resulting in IP, in a fashion consistent with their employment contracts.

Guidelines:

- ▶ Industrial partners may consider providing similar benefits to those listed in Section E.1

SECTION F – CONFLICTS OF INTEREST

F.1 MANAGEMENT OF CONFLICTS OF INTEREST

It is in the interest of all partners to minimise conflicts of interest. Partners should develop and implement policy and procedures to avoid and, if necessary, address conflicts of interest.

Guidelines:

- ▶ Partners should have procedures that help research employees to recognise areas where conflicts of interest may occur.
 - ▶ Partners should have a policy for the management of conflicts of interests.
 - ▶ Partners should encourage full disclosure of potential areas of conflict and open discussion amongst the partners at an early stage.
 - ▶ Partners should manage and resolve conflicts as they occur.
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SECTION G - RELATIONSHIP MANAGEMENT AND CONFLICT RESOLUTION

G.1 RELATIONSHIP MANAGEMENT AND DEALING WITH DISAGREEMENTS

Established relationships create trust and facilitate the process of managing collaborative research. Partners should take care to maintain good relationships with their collaborators.

Having established mechanisms for dealing with disagreements simplifies and speeds up resolution. Partners should develop an agreed mechanism and timescale for dealing with disagreements.

Guidelines:

- ▶ In the event of any dispute or difference between project partners, this should be referred to the project manager who should communicate a decision to all project partners. The project manager's decision should be deemed to have been approved unless one of the partners notifies the other partners of their dissatisfaction within 14 days.
- ▶ If a partner is dissatisfied with the project manager's decision, the decision should be referred to the management team which should attempt to resolve the matter amicably within 30 days.
- ▶ If the management team is unable to resolve the matter amicably within 30 days, the partners may pursue the dispute resolution procedure, as provided for in the collaboration agreement.

SECTION H – MONITORING AND EVALUATION

H.1 MONITORING AND EVALUATION

Monitoring and evaluation can strengthen the effectiveness of IP management and exploitation mechanisms. Partners should develop and implement clear systems for monitoring and evaluating their performance of collaborative research.

Guidelines:

For the PRO, routine records of IP management measurement indicators can:

- ▶ Illustrate to external organisations that the partners are managing IP effectively, including regular review of background IP;
- ▶ Identify problems and opportunities relating to IP management, enabling organisations to change budgets and strategies in response;
- ▶ Provide information useful for retention and recruitment of employees.

In recognition of these considerations, PROs, in conjunction with the funding agencies, should collect and publish data annually on appropriate indicators. Industrial partners should assist their PRO partners in the collection of appropriate data.

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