

National IPR – United Kingdom

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The Intellectual Property Office IN United Kingdom is part of the Department for Business, Innovation & Skills External Link. It is the official government body responsible for Intellectual Property (IP) rights in the United Kingdom. These rights include:

- Patents
- Designs
- Trade marks
- Copyright

The Intellectual Property Office's core objectives are:

- grant patents and register trade marks and designs with a good presumption of validity, based on high standards of service, which are set in consultation with users and combine quality with good value for money;
- promote and support moves to simplify the law on IP and to harmonise international rules and procedures;
- increase awareness, recognition and use of IP as a tool for enhancing innovation amongst British industry and commerce, and small and medium enterprises in particular;
- increase awareness of the potential rewards for the exploitation of research in the academic community.

The various forms of Intellectual Property in UK are briefly:

- **Patents:**
A 20 year absolute monopoly in new and inventive technical innovations.
- **Supplementary Protection Certificate:**
Up to 5 years extension to the absolute monopoly given by a patent where the invention consists of a medicinal product for which approval by the relevant authority has yet to be given.
- **Trademarks:**
A 10 year (although renewable every 10 years ad infinitum) absolute monopoly in a sign such as a brand name which is indicative of the origin of goods.
- **Designs:**
A 25 year absolute monopoly in a new design applied to a manufactured article.
- **Unregistered Design Right:**
A right to prevent reproduction of an original design which arises automatically and which lasts for a maximum of 15 years.
- **Semiconductor Topography Rights:**
Unregistered Design Right in a semiconductor topography.
- **Copyright:**
A right to prevent reproduction of an original literary, artistic, musical or dramatic work for 70 years beyond the death of the author.
- **Confidentiality and Trade Secrets:**
A right to prevent misuse of confidential or secret information.

- **Plant variety rights:**
A registered monopoly right in a new horticultural genus or species.

The Lambert methodology

The Lambert toolkit is for universities and companies that wish to undertake collaborative research projects with each other.

- The toolkit consists of a set of five Model Research Collaboration (one to one) Agreements numbered 1-5 and four Consortium (multi-party) Agreements lettered A-D and documents that should help you to use and understand those agreements. The toolkit was prepared by the Lambert Working Group on Intellectual Property.

The aim of the model agreements is to maximise innovation. They have not been developed with the aim of maximising the commercial return to the universities; but to encourage university and industry collaboration and the sharing of knowledge. They do not represent an ideal position for any party; depending on the circumstances they are designed to represent a workable and reasonable compromise for both or all parties.

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- Website: <http://www.ipo.gov.uk/whyuse/research/lambert.htm>

1. Model Research Collaboration Agreements (one to one)

There are five model Research Collaboration agreements devised by the Lambert Working Group. Their use is optional, but they could help you save time and money when negotiating.

The model agreements are merely starting points and their use is not compulsory, but by using them you may be able to reduce the amount of time and money spent negotiating.

You should decide which of the five approaches best suits your purpose and negotiate with the other party to achieve consensus and a signed agreement before work on the project begins.

In reality, model Research Collaboration Agreements 2 and 3 may be combined so that the Sponsor has the right to negotiate an exclusive licence and/or an assignment. The outcome of negotiations could be, for instance, that the Sponsor takes an exclusive licence in one territory and an assignment of IP in a different territory.

None of the agreements deals with the joint ownership of IP because this occurs more rarely than people think and it is more difficult for both the Sponsor and the University to manage. The model Research Collaboration Agreements adopt the simpler approach that one or other of the parties will own the IP, but the result of negotiations may be that the University owns the IP in Result "A" and the Sponsor owns the IP in Result "B".

The model Research Collaboration Agreements do not represent an ideal position for either party; they represent a workable and reasonable compromise for both parties.

| Table 1. Lambert Research Collaboration Agreement | Terms | IPR |
|--|---|------------|
| <u>Agreement 1</u> | Sponsor has non-exclusive rights to use in specified field/territory; no sub-licences | University |
| <u>Agreement 2</u> | Sponsor may negotiate further licence to some or all University IP | University |
| <u>Agreement 3</u> | Sponsor may negotiate for an assignment of some University IP | University |
| <u>Agreement 4</u> | University has right to use for non-commercial purposes | Sponsor |
| <u>Agreement 5</u> | Contract research: no publication by University without Sponsor's permission | Sponsor |

2. Model Consortium Agreements (multi-party)

The four model Lambert Consortium Agreements use the same terminology and have the same structure as the five Research Collaboration Agreements, but contain additional provisions to cover some of the complications that arise as a result of having more than two parties.

There are too many possible variations and permutations to cover all of them and the model Consortium Agreements are merely starting points that may be useful in shaping the thinking about the structure of a collaboration, but by using them you may be able to reduce the amount of time and money spent negotiating.

You should negotiate with the other parties to achieve consensus and a signed agreement before work on the project begins.

Because there are more parties to the Consortium Agreements, they have provisions that do not appear in the Collaborative Research Agreements:

- Project Management (clause 3);
- Financial Management and External Funding (clause 4); and

- Expulsion and the addition of new parties (clause 10).

Consortium Agreements B and C have been drafted for use with the Technology Strategy Board’s Collaborative R&D Programme but, with a few changes, may be adapted for other circumstances.

Consortium Agreement A contains an example of a joint ownership provision in clause 5.4. The members of the Lambert Working Group recommend that you avoid joint ownership where possible. If it is important that more than one party owns some IP, a better way forward may be to consider whether some of the IP should be owned by one party, other IP by another party and so on, rather than having several or all of the organisations participating in the project having a joint interest in the ownership of the IP.

If you do decide to have joint ownership it is important that the Agreement sets out what rights each joint owner has to exploit the IP. For an example of this please see clause 5.7 in Consortium Agreement A.

The model Consortium Agreements do not represent an ideal position for any party; depending on the circumstances, they represent a workable and reasonable compromise for all parties.

| Table 2. Lambert Model Consortium Agreement | Terms |
|---|---|
| Agreement A | Each member of the Consortium owns the IP in the Results that it creates and grants each of the other parties a non-exclusive licence to use those Results for the purposes of the Project and for any other purpose. |
| Agreement B | The other parties assign their IP in the Results to the lead Exploitation Party who undertakes to exploit the Results. (Alternatively the Lead Exploitation Party is granted an exclusive licence). |
| Agreement C | Each party takes an assignment of IP in the Results that are germane to its core business and undertakes to exploit those Results. |
| Agreement D | Each member of the Consortium owns the IP in the Results that it creates and grants each of the other parties a non-exclusive licence to use those Results for the purposes of the Project only. If any member of the Consortium wishes to negotiate a licence to allow it to exploit the IP of another member or to take an assignment of that IP, the owner of that IP undertakes to negotiate a licence or assignment. |

The Lambert Agreements and supporting materials are subject to Crown copyright. It is free for universities and companies to use, adapt and re-use the agreements and the guidance notes for the purpose of undertaking collaborative research.

The Crown copyright material can therefore be re-used free of charge and without requiring specific permission. Where practicable, the Crown copyright status and the source of the Lambert Agreements and supporting materials should be cited.

Available websites:

<http://www.ipo.gov.uk/home.htm>

<http://www.ipo.gov.uk/whyuse/research/lambert.htm>