Draft IP toolkit: comments from the Group of Eight

The Group of Eight appreciates this opportunity to provide comment on the consultation draft of the IP toolkit. The member universities of the Group may also make their own submissions, providing their own perspectives on the draft.

Two of the most important ways a government can maximise the returns it receives from its investments in public sector research are to help develop strong and effective linkages between the business community and public sector researchers; and to remove any impediments to these linkages. The Group of Eight supports any such actions and strongly supports the intention behind the development of the toolkit.

There is no doubt that negotiations focussed on the development, ownership, protection and management of intellectual property can be complex and hinder the development of robust collaboration agreements between universities, public sector research agencies and business. Sometimes this can draw attention away from the main purposes of the collaboration and the genuine outcomes the parties to the collaboration are seeking to achieve; and frequently the complexity of these discussions builds on quite unrealistic notions of the potential value of any IP that the collaboration is likely to create. Any means of facilitating and expediting IP considerations in these negotiations will be helpful.

IP provides a useful tool but is only one of the factors that will play a role in the success of a collaboration, so that it is important not to over emphasise its importance. It is also important that the toolkit not intimidate potential users or appear to make IP issues more complex than they need be. The Group also believes that it is important to target the toolkit, and its presentation style, to those who will obtain most value from its use.

The matters presented in the toolkit are all familiar to the commercialisation groups within universities, which have their own templates for term sheets and different kinds of contract. Such groups also have experience in working with different sized businesses and are able to assess the potential importance of IP issues in any collaboration. Similarly, large and medium businesses with experience in collaboration or with in-house sources of advice on IP and other legal matters are unlikely to find the toolkit of direct use. This is consistent with the evaluation of the Lambert toolkit which identified very little direct use of the kit or of the agreements it provided.

There are therefore two target audiences. One would appear to be small businesses considering a collaboration which they believe might involve IP. The other, perhaps even more important, consists of researchers, students and other groups with an interest in learning about collaboration and the role that IP can or should play in research-business interactions. The Group believes that this second audience is large and important.

For these reasons, the Group believes that the toolkit as it stands appears too technical and could appear intimidating to those who have most to gain from using it. (An upfront ‘decision assistance checklist’ of 34 questions is likely to be confronting and present too much detail to someone starting to explore the subject.)
Parts of the draft toolkit (the checklists, sample term sheet and contracts, for example) would provide a useful appendix to a more user-friendly discussion of the general principles that underlie the use of IP in collaboration and collaboration agreements. This discussion would benefit from an introduction that outlines and promotes the value of collaboration and presents IP within this context. An introduction could also note how businesses use IP (and their general preference for trade secrets and confidentiality) and emphasise the benefits of a business strategy that integrates different kinds of IP right to take advantage of their complementary characteristics. In doing this it would also be important to consider the costs of seeking IP protection and the difficulties (and often even higher costs) of enforcing rights once obtained, as these are also pertinent to any decisions made in developing an agreement covering IP ownership and use issues. This discussion could also highlight why there can be conflicting views on some matters (such as publication) and, for example, the particular issues that can arise when the collaboration involves students. Explanation can lead to understanding which can then facilitate the negotiation process.

Providing a general discussion as proposed, with some of the current elements of the toolkit as attachments demonstrating how these general principles translate into practice, would increase significantly the potential use of the toolkit and provide an educational resource that would find many users. The case studies would then provide an essential and coherent extension of the text and should examine the issues involved from the perspective of the researchers and students, as well as presenting a business view. Interviews with people who have taken part in collaborative activities involving IP (and that encompass discussions of the problems they experienced and what actions they took to overcome them) would also add to the learning experience – and could be in video format as well as text, increasing the attractiveness of the toolkit.

As a specific comment on the current draft, sections A1 – the decision assistance checklist, and A2 – the chart of considerations in research collaboration projects – contain much in common but also have some differences. It is not clear how they relate to each other or why the differences exist. More explanation of the purpose of each might help.

Part B and Appendix one might form part of the general principles introduction we are suggesting – in any case it might be best to present them before the detail presented in Part A.

The current draft also has some repetition, with similar material covered in different parts.

On a more trivial point, footnotes 7 and 8 on page 6 need to make it clear the paragraphs they reference are in Section B2.

Overall we believe that the current draft lacks a clear target audience or purpose. Reformattting it to serve a wider group by presenting general principles and explanations would be a more effective and worthwhile approach than developing detailed pro-forma contracts. Experience (and the review of the Lambert toolkit) suggests these will not be used and are unlikely to be necessary, except as examples of the matters that such collaborations need to consider.