



SOCIETY OF  
RESEARCH  
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# Aligning Missions: Strategies for Negotiating IP with Diverse Partners

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# **Mission Briefing: Understanding the Landscape**

# What is Intellectual Property (IP)?

Intellectual property (IP) refers to creations of the mind, such as inventions; literary and artistic works; designs; and symbols, names and images used in commerce.



Inventions  
(protected by Patents)

Works of Authorship  
(protected by Copyright)



Phrases, Symbols, Logos  
(protected by Trademarks)

Confidential Information  
(kept as Trade Secrets)



# Types of Partners & their Goals



## Industry

Innovation and  
Commercialization

Market  
Competitiveness

Revenue  
Generation



## Academic

Academic  
Advancement

Publication and  
Dissemination

Translational  
Research



## Government

Public  
Welfare/Safety

National Security

Economic  
Development



## Foundation

Public/Local  
Benefit

Publication/Open  
Access

Translational  
Research



# **Mission Planning: Know the Starting Point & Predict Challenges Ahead of Time**

# Evaluate the Research Plan



- **Scope of Work**
  - Responsibilities?
  - Material Exchange?
  - Data Exchange?
  - Deliverables?
  - Is existing IP being used?
  - Is new IP expected?
- **Budget**
  - Are we in agreement already?
  - Does this meet cost requirements of the project?

# Assemble the Team & Set Objectives



- Who will lead negotiations by each party?
- Who are the research experts?
- Do the parties agree on Research Plan?
- Discuss common sticking points early on, especially IP.

# Understanding what makes IP a common sticking point in a Research Contract

- A party is bringing pre-existing IP into the Research Plan
- A party is providing materials and/or Confidential Information to the Research Plan and the intent is for the receiving party to develop new IP through the Research
- Commercial IP rights without full cost recovery of the Research
- Misunderstanding of internal policies
- Industry-Academic partnerships (often related to substantially different goals)





# **Mission Execution: 5 Key IP Negotiation Strategies**



## Strategy 1:

Define any pre-existing or new IP in the research contract, and clarify who owns what

- Pre-existing or Background IP should include anything that is developed prior to or independent of the performance of the Research
- New IP should be limited to what is developed in the performance of the Research. In the Academic world, it is most common for ownership to follow inventorship, but this is negotiable in all research contracts
  - In Academic-Industry partnerships, ensure that research results are not considered the sponsor's Confidential Information (at least not in a way that might impede publication)



## Strategy 2:

Outline the notification process surrounding any new IP

- Clarify who the disclosure should come from and within what time frame they should disclose the IP to the other party. In many academic institutions, this can only be done by a Technology Transfer Office.
- Clarify if the disclosure needs to contain specific information (and whether that complies with internal policies).
- If the research is collaborative (i.e., both parties are performing research), notification should likely be mutual.



## Strategy 3:

Identify what each party's responsibility is once they receive a notice related to new IP

- Specify what type of documentation is needed to fulfill any patent application and/or commercialization opportunities (i.e., assignment, licensing, IIA).
  - For Academic-Industry research contracts, use internal policies to help Industry Partners understand Academic limitations  
(example: <https://www.utsystem.edu/board-of-regents/rules/90101-intellectual-property>)
- Clarify the timeline in which a receiving party must respond to an IP disclosure to complete the next steps associated with assignment, license, or IIA documentation.



## Strategy 4:

Include time limitations to all license negotiations and publication reviews and include alternative instruction if the actions are not completed within that timeframe.

- For license negotiations:
  - How long (from the time of disclosure) does the sponsor have to communicate that they are interested in pursuing a license?
  - How long do we have to negotiate the license?
  - If the parties cannot agree to terms within the timeframes above, what happens to the IP?
- For publication review:
  - How long does the other party have to review the publication, and what can they request?
  - What happens if they don't respond within that timeframe?



## Strategy 5:

As applicable, ensure that any retained rights are addressed in the research contract (especially in Academic-Industry partnerships)

- When research data, results, and/or IP are contractually obligated to one party, the other party may need retained rights.
- Retained rights may include but are not limited to:
  - Non-commercial research use
  - Educational purposes including teaching and scholarly uses
  - Patient-care purposes
  - Other academic purposes



# **Post-Mission Debrief: Tips and Tricks to Overcome IP Negotiation Obstacles**

# Open the Lines of Communication



- Provide justifications for critical redlines using the comments feature in Microsoft Word.
  - Explain to the counterparty WHY you are requesting a particular change
  - Provide policies or reference laws that might inhibit your ability to agree to the proposed language
- Calls can be helpful to work through sticking points.



# Be Firm, but Flexible



- Be firm on your position toward issues that are non-starters for your party.
- Find middle ground on issues that may not be ideal for either party - based on risk.
- Be flexible regarding the contract language used to address these problems.

# Use the Resources at your Organization



- Engage the experts at your organization early
  - Technology Transfer Office (TTO)
  - Legal Affairs
  - Public Affairs (for use of name/logo issues)
- TTOs and Legal teams can be very helpful with providing contractual clarity on IP issues and explaining WHY a certain issue should be addressed

# Summary



## Understanding the Landscape

Know your Partner

Know their Goals



## Create a Plan

Evaluate the Research Plan

Predict Sticking Points in Advance



## Key Strategies for Negotiating IP

Define IP

Notification Obligations

How Are Patents/  
Commercialization  
Efforts are Managed

Retained Rights



## Tips and Tricks for Overcoming Obstacles

Communicate Clearly

Remain Open-Minded to Creative Solutions

Use Resources



# Questions?