

Collaborative Working: Facts and FAQs

In any research it is often common to be working in collaboration with other individuals, research groups or companies. This may have many benefits including the sharing of specialist knowledge, additional finance, additional publications, the sharing of expensive equipment and access to resources you may not otherwise have (e.g. patient samples). All this may be of benefit to your work / research, but if a potentially useful technology is developed as a result of this collaboration, then any IPR (Intellectual Property Rights) that may subsist in it might not solely belong to you or your employer as it is likely that your collaborators (and / or funding body) will also have a claim on any IPR generated. Although most research in the NHS is not undertaken for commercial gain, the perceived value of such work may be very significant to others (particularly where a clear clinical outcome is evident) and it is important that any rights are protected. It is Medipex's policy that if there is any involvement of NHS staff or resources in a project where IPR has been generated, then some of the rights emanating from that project will belong to the NHS. If your collaborators are working within the same institution as you (e.g. hospital trust) then working out how each group should benefit from any commercial exploitation of IPR should not be too much of a problem, but if they are working for a different organisation then it is likely that the IPR will have to be shared. Working out IPR sharing can often be a complex and time consuming process, but it is one of the roles that Medipex undertakes on your behalf, so do not let this issue discourage you from forming collaborations that may benefit your research. If you do think that any IP will be generated from a research collaboration prior to setting it up, then it may be advisable to draw up a suitable agreement prior to any work being carried out. This fact sheet highlights some of the pitfalls to avoid when setting up collaborations and the simple agreements that need to be in place up front in order to enter into a successful collaboration, although you should contact your IP lead, R&D manager or Medipex for specific advice.

FAQS:

I am a consultant surgeon and have a joint appointment with the local hospital trust and the local university. How does this affect the ownership of any IPR (Intellectual Property Rights) coming out of my research?

It is likely that any IPR arising from your research will be shared between the hospital trust and the university, although this will depend on the terms of the joint appointment, whether the research was begun prior to your university appointment (and how much had already been done), whether there is a clinical aspect to the research and the employment status of any other persons involved in the research. Medipex has good working relationships with all of the university technology transfer offices in the region and so issues such as these will be evaluated by Medipex and the appropriate university technology transfer manager when deciding how IPR ownership should be shared.

I was recently approached at a conference by an individual working for a hospital in the USA who wants to collaborate with me because I have a novel diagnostic tool (patented) that he wants to use in his clinic. We had a brief discussion about the logistics of setting up the collaboration but did not agree or sign anything. How should I proceed?

It may be necessary first of all to get the individual concerned to sign a non-disclosure agreement (often referred to as a confidentiality agreement) so that any confidential information you disclose to him (such as details of how your tool works) or any confidential information that he discloses to you cannot be discussed with third parties. Once you have agreed the principles of how the collaboration will work you should get him to sign a materials transfer agreement so that your diagnostic tool cannot be exploited or used for purposes other than that intended by this collaboration. Full advice on all the steps involved and the necessary contracts can be provided by your IP lead or by Medipex.

I work for a research consortium who are funded by two different bodies and who are represented at four different academic institutions and one hospital. One of the collaborators in the consortium has recently made a breakthrough which is potentially patentable and we are currently trying to work out how any rewards from the IPR should be split. Everyone says that they have the largest claim to the IPR, so how would we go about sorting this out?

This is a problem that we frequently come across at Medipex and are quite used to dealing with. Discussions such as these need to take place between the technology transfer or research offices as they can act as impartial mediators and not between the individual researchers. As a general rule, agreements are reached based on the level of contribution that each party has made to the project and taking into account any IPR exploitation requirements imposed by the funding bodies and in any cases such as this Medipex or your IP lead should be informed as soon as possible so that they can talk to the appropriate people.

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A company recently approached me because they were interested in me carrying out some consultancy for them. In the proposed agreement they want me to sign, there is a clause assigning any IP that I own or produce to them in return for consultancy fees. They say that this is a standard clause in any such contract but I am hesitant to sign this agreement. Am I right in my concern?

You are quite right to be concerned about this agreement. You should avoid signing anything that assigns any IP that you own or will produce in the future to a third party, and any such agreements should be examined by your IP lead prior to signing.

For the past three years I have been working in collaboration with a research group based at a local university. Recently they made a breakthrough in the project that we have been working on, but their University say that they have a claim on all the IPR related to this breakthrough. What rights do I and the NHS trust that I work for have to this IPR?

In this case it will be necessary to see any agreements or contracts that were signed when this collaboration began as these should state how any IPR arising from the project is shared. If this is a project that you have contributed to then the NHS trust for which you work will have a claim on some of the IPR that has arisen from it. In cases such as these your IP lead and Medipex should be informed so they can talk to the appropriate university technology transfer manager to sort out how the rights should be shared.

Last year I had a visiting foreign postdoctoral researcher working in my research group for six months who has now returned home. Whilst she was working for us she developed a novel diagnostic process and last week we discovered that she had filed a patent on it in her name upon returning home. What can we do?

In the contract that the visiting researcher had with your host institution there should have been a clause about ownership of any IP that was generated whilst she was working for you. If she was registered as an employee of your institution then it is likely that they should have some claim on the ownership of the IP and the patent. However, if she was not registered as an employee of your institution then they may have no claim on the IP, especially if this was an invention she had been working on prior to working with your research group. If, however, this IP was generated with intellectual input from other members of your group then they may also be entitled to be named as inventors on the patent. In situations such as this, Medipex should be contacted for specific advice.

About four years ago I let a research group at another institution have some cell lines that I had made in-house for use in a project. Recently they published a paper describing how they had utilised these cell lines as a highly efficient source for protein production and I have subsequently discovered that they have set up a company using these cell lines to custom manufacture recombinant proteins. Have they breached any rights I might own in the cell lines and if so, what can I do about it?

A Materials Transfer Agreement (MTA) should have been in place before any materials were handed over for use in a collaborative research project. MTAs are legally binding agreements and state what materials you are providing and how they can and cannot be used for in a project, thereby protecting any intellectual property rights you may have vested in them. MTAs also state for how long materials can be used and specify how they should be destroyed at the end of the agreed term. They also ensure that the third party you are passing your materials on to cannot distribute them further without your permission. In this case you should contact Medipex for specific advice, but if no MTA was in place and you had not previously described how these cell lines could be used for protein production then it is unlikely that they have breached any rights that you may own to the cell lines.

One of our trust employees works half of her time in an old peoples' home. We have just found out that in conjunction with staff employed there she has developed an aid that assists with moving people with limited mobility from a bed to a chair and that they are in the process of selling the rights to this device to a company for manufacture. What rights does the trust have to this invention and what can be done about it at this stage?

In this case it is likely that the trust will own at least some of the rights to the device so it is essential that Medipex is contacted so they can assist with sorting out how any IPR should be shared and assist in ensuring that a fair commercial agreement is reached so that both the trust and inventors receive the maximum benefits from the sale of any rights.

Further Information or Advice:

Please contact Medipex on the contact details given below

This fact sheet has been produced in conjunction with Urquhart-Dykes and Lord, Patent Attorneys (Tel: 0113 245 2388; e-mail: email@udl.co.uk). It is provided for the purposes of information only and is not intended as a comprehensive guide to setting up and working in collaborations. In any cases where you have concerns or require advice regarding intellectual property matters, you should get in touch with your IP lead or Medipex.

