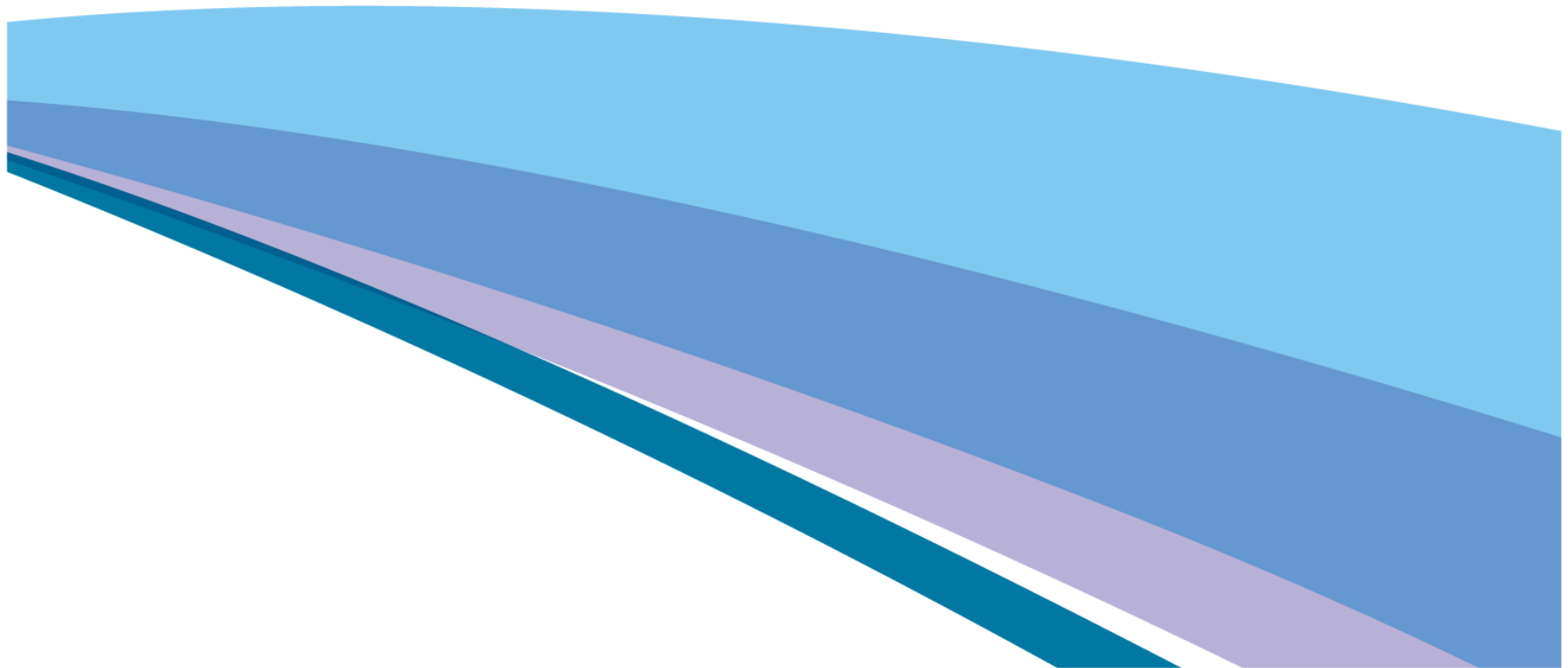




Intellectual
Property
Office

Ministerial launch of the updated Lambert toolkit



Panel

Chair:

Guy Robinson

Deputy Director of Innovation at the IPO

Panel:

Baroness Neville-Rolfe DBE CMG

Minister of State for Energy and Intellectual Property

Christine Reid Northwood

Reid Lawyers, Developer of the Lambert toolkit

Malcolm Skingle

Academic Liaison at GSK, Lambert working group chair

Baroness Neville-Rolfe DBE CMG

**Minister of State for Energy and
Intellectual Property**



THE REVISED LAMBERT TOOLKIT

An Overview



Christine Reid

AURIL 6 October 2016

Lambert Toolkit - History

- Lambert Report - University and Business Collaborations – December 2003
- Barriers to collaboration
 - High **legal costs**
 - Long **time** to conclude agreements
 - Limited **resources** (especially SMEs)
- Recommendation – series of model research collaboration agreements
- Toolkit – initially 5 one to one agreements, but more than model agreements

Lambert Toolkit - IP Pragmatics Report

- **Report on the Toolkit 8 years on commissioned by the IPO, in collaboration with AURIL, the CBI, PraxisUnico & Innovate**
- **IPO invited practitioners to sit on reformed working group to**
 - **identify what should be done to update the Toolkit – new agreements, new provisions, updated provisions, new guidance**
 - **critique new materials and amendments**

Lambert Toolkit - Updating the Toolkit

- Working Group decided to
 - add a model agreement splitting the ownership of the results
 - prepare a model agreement for Knowledge Transfer Partnerships
 - produce guidance on universities' duties as charities and state aid
 - add a form of variation agreement

Lambert Toolkit - Updating the Toolkit

- **Working Group decided to**
 - **add provisions on data protection and anti-bribery and corruption**
 - **convert the existing Outline into Heads of Terms – and make more prominent**
 - **add a counterparts clause**
 - **review the provisions on publication and confidentiality**
 - **review the provisions on liability**

Lambert Toolkit - Updating the Toolkit

- Working Group considered, but decided not to
 - add provisions relating to stem cells/the use of human tissue
 - prepare a template for a sub-contract
 - adapt the model agreements to meet the requirements of various sectors: - ICT, life sciences, aerospace, defence, nuclear, transport, oil and gas, engineering, creative industries
 - prepare model agreements solely for government-funded research
 - prepare model agreements specifically for overseas collaborations

Lambert Toolkit - Difficulties

- Causes of protracted negotiations/high costs
 - No meeting of minds – **polarisation** of position
 - Failure to **communicate**
 - Failure to **identify** issues
 - Failure to **resolve** issues
 - Avoidance of the ‘**difficult bits**’
 - Agreements to agree (**fudging** the issues)
 - Precedents/models **not fitting circumstances**
 - **Mismatch** between reality and agreement
 - **Badly drafted agreements**
 - **Ownership of IP major issue (but not the only one)**

Lambert Toolkit - Principles

- **Rights to use IP** are key – minimum for industry is a non-exclusive licence
- **One size does not fit all. Nor can the model agreements fit everyone's way of working**
- Different approaches/spectrum of solutions
- Starting point/negotiation – can't run on automatic pilot
- **Ease/speed the process** - not solve every issue
- Not cover every scenario - but cover **common scenarios**
- Workable and reasonable **compromise**

Lambert Toolkit - Contents

- 7 Model **Collaboration Agreements** (One to One)
- 4 Model **Consortium Agreements** (Multi-Party)
- 2 Model Heads of Terms
- 2 Model Variation Agreements
- **Guidance**
 - state aid
 - charitable status of universities
 - data protection
 - anti-bribery
 - notes on issues - liability, confidentiality, co-ownership etc., etc.

Collaboration Agreements Scenarios

1. Institution owns the results and grants Collaborator a **non-exclusive licence** to use results for any purpose
2. Institution owns the results and grants Collaborator a non-exclusive licence to use results for any purpose. **Collaborator has the right to call on the Institution to negotiate an exclusive licence**
3. Institution owns the results and grants the Collaborator a non-exclusive licence to use results for any purpose. **Collaborator has the right to call on the Institution to negotiate an assignment.**
4. Collaborator owns the results. Institution has right to use the results for Academic and Research Purposes. Institution's students and staff have Academic Publication Rights.

Collaboration Agreements Scenarios

4A. Split Ownership

Each party has the right to exploit certain results and takes an assignment of those results

Institution has the right to use Collaborator's results for Academic and Research Purposes. Its students and staff have Academic Publication Rights

Collaborator has the right to use Institution's results for Research Purposes

any purpose except commercialisation, i.e. licensing for value or sale for value OR

acts done for experimental purposes[or to obtain regulatory approval for any generic or innovative medicinal product (including any clinical trial)]

Collaboration Agreements Scenarios

- 5. Collaborator owns the results and Institution does NOT have right to use for Academic and Research Purposes. Academic Publication is NOT permitted. This form of Agreement is more suited to Contract Research**
- 6. Designed for a Knowledge Transfer Partnership (KTP) where a graduate or postgraduate student carries out the Project. Company owns the results. Institution has the right to use the results for Academic and Research Purposes and its students and staff have Academic Publication Rights. Terms are very similar to those of Collaboration Agreement 4 with additional terms in the light of the KTP programme**

Consortium Agreement A Scenario

- Each party owns the results which it creates
- Each party grants each of the other parties a non-exclusive licence to use those results for any purpose
- Any party may exploit any of the results – level playing field
- No exploitation strategy

Consortium Agreement B Scenario

- **Lead Exploitation Party** is best suited to exploit results. Other parties assign IP in the results to LEP or grant LEP an exclusive licence
- LEP undertakes to exploit and pay other parties a share of the revenues generated from that exploitation or a success payment
- Academic Parties have the right to use the results for Academic and Research Purposes and their students and staff have Academic Publication Rights
- Commercial Parties have the right to use the results for Research Purposes

Consortium Agreement C Scenario

- **Two of the four parties are best placed to exploit different results**
- **Each of the two takes assignment of certain results and undertakes to exploit those results and to pay other parties a share of the revenues generated from that exploitation or a success payment**
- **Academic Parties have the right to use the results for Academic and Research Purposes and their students and staff have Academic Publication Rights**
- **Commercial Parties have the right to use the results for Research Purposes**

Consortium Agreement D Scenario

- **Each party owns IP in results which it creates**
- **Each party grants the other parties a non-exclusive licence to use those results for **the purposes of the project****
- **If a party wishes to exploit another party's results or background, it must negotiate a licence or an assignment**
- **Academic Parties have the right to use the results for Academic and Research Purposes and their students and staff have Academic Publication Rights**
- **Commercial Parties have the right to use the results for Research Purposes**

Lambert Toolkit

- **More than just agreements – models are NOT enough**
- **Guidance Notes – critical to understanding issues**
- **Heads of Terms – critical to meeting of minds - prompt consideration of**
 - Respective roles and tasks
 - Financial contribution
 - Background
 - Ownership and exploitation of results
 - Confidentiality
 - Academic and Research Use and Academic Publication
 - Warranties and liability
 - Termination
 - Expulsion of member of consortium
 - Consequences of termination/expulsion

Lambert Toolkit

- Keys to having the right agreement:
 - **Understanding the issues** (Guidance Notes)
 - **Understanding the Model Agreements** (Guidance Notes)
 - **Communication** - internal and external (HoT)
 - Reaching real agreement on the **principles first** (HoTs)
 - Choosing the right Model Agreement (Decision Guide)
 - **Amending** where necessary
 - Using a different agreement!

Thank You

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Academic Liaison at GSK, Lambert working group chair

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