

THE UNIVERSITY OF WARWICK

Minutes of the meeting of the Intellectual Property Committee
held on 4 July 2013

Present: Professor T Jones (Chair), Mr Q Compton-Bishop, Professor R Dashwood, Dr P Hedges, Dr A Reed, Mr T Skelhon and Professor H Spencer-Oatey.

In Attendance: Mr S Gilling (University Legal Advisor), Dr S Mak (Secretary) and Mrs J Prewett (Research Support Services Advisor).

Ms A Chambers (Strategy and Change Team, Deputy Registrar's Office) in attendance for item 21/12-13.

Apologies: Professor C Dowson, Dr S Gallagher (Warwick Ventures Advisor) and Professor Sir John Temple.

18/12-13 Conflicts of Interest

REPORTED: (by the Chair)

That, if any members or attendees of the Intellectual Property (IP) Committee had any conflicts of interest relating to agenda items for the meeting, they were required to be declared in accordance with the CUC Guide for Members of Higher Education Governing Bodies in the UK.

NOTE: No declarations were made.

19/12-13 Minutes of the Previous Meeting

RESOLVED:

That the minutes of the meeting of the IP Committee held on 8 May 2013 be approved, subject to amendment to minute 16/12-13 (d) as follows (amendment underlined, deletion ~~struck through~~):

REPORTED:

(...)

That it would be important to ensure that ~~a warranty~~ no warranty was provided on the application of WAMS [now known as Warwick Scientific Services or 'WSS'] results ~~was applied~~ to any consultancy services provided, to ensure that the University was not liable for others use of those outputs.

(...)

20/12-13 Matters Arising on the Minutes (minute 13/12-13 refers)

RECEIVED:

An oral report from the University Legal Adviser on developments around Regulation 28 (Covering Intellectual Property Rights).

REPORTED: (by the University Legal Adviser)

- (a) That the Committee at its last meeting had recommended to the Senate and to the Council minor amendments to Regulation 28, covering the University's position on ownership of e-learning materials.
- (b) That subsequently a further practical point had arisen on Teaching Materials and Course Materials that would require further minor amendments to the existing wording of the Regulation.
- (c) That the proposed amendments to Regulation 28 had therefore been withdrawn from the agendas of next meetings of the Senate and the Council, and that the proposed amendments would be presented in the autumn.

RESOLVED:

That the Committee be updated on progress on the proposed amendments to Regulation 28 at its next meeting. **Action: University Legal Adviser**

21/12-13 Update on IP Agreements within University Partnerships

CONSIDERED:

An oral report from Ms Ailsa Chambers (Strategy and Change Team, Deputy Registrar's Office) on the current status of IP arrangements within University partnership agreements.

REPORTED: (by Ms A Chambers)

- (a) That a summary had been completed surveying current status on progress towards IP agreements within the University's strategic partnerships.
- (b) That the summary covered the following partnerships, which were at different stages of progress:
 - (i) Monash-Warwick Alliance
 - (ii) Centre for Urban Science and Progress (CUSP)
 - (iii) Liverpool School of Tropical Medicine (LSTM)
 - (iv) Nanyang Technical University (NTU), Singapore
 - (v) Queen Mary, University of London (QMUL)
- (c) That there were currently two broad approaches to IP ownership arrangements for joint appointments within strategic partnerships:
 - (i) A joint ownership model where IP rights would be equally owned by both parties (as with NTU), with revenue share to generally also be equally distributed.
 - (ii) A majority ownership model where IP would be owned and managed by the dominant employer under local rules, with revenue share to reflect relative contribution to IP creation (as with Monash).
- (d) That for joint PhD programmes the current position across partnerships was for IP ownership to be established on a joint basis between the parties, or alternatively to be owned by an appropriate entity set up by the parties (as with the Monash Alliance entity).

- (e) That views would be welcomed from members on a possible preferred standard position or approach towards any future strategic partnerships.

(by Mr Q Compton-Bishop)
- (f) That it was suggested that it might be useful to consider standard wording for the university's preferred terms within future IP operating agreements.
- (g) That it was important that wording of a possible model operating agreement be clear and unambiguous regarding terms on ownership of any created IP and subsequent revenue share between the partners.
- (h) That complicated or unclear wording might potentially hinder successful commercialisation of any valuable IP that might be created under a partnership.

(by Dr P Hedges)
- (i) That it was suggested a preferred operating model agreement should be the majority owner type, similar to the current approach that had been taken on joint appointments within Monash Alliance.
- (j) That a joint ownership model was not preferred, due to potential for deadlock should equal partners be unable to agree on issues that might arise which had not previously been provided for under an agreement.
- (k) That a joint ownership model might also potentially result in lower returns on investment, as one party might potentially retain only half of the value or revenues from a valuable IP despite it having invested the majority of resources to create it.

(by Dr A Reed)
- (l) That the Lambert model of collaborative research agreements might be of use to consider using should preferred IP operating agreement terms be developed.
- (m) That the Monash, LSTM and CUSP partnerships appeared to align well with the majority ownership model presented to members.

(by the Research Support Services Adviser)
- (n) That it would be helpful to consider the extent to which the University might wish to share, retain, or exploit existing or future IP within potential partnerships in advance of entering into any partnership discussions.
- (o) That it would be important to obtain assignment of IP rights from joint PhD students at the start of any joint PhD courses established under a partnership.

(by the Chair)
- (p) That the priority was to establish agreed terms and conditions on IP ownership arrangements for joint appointments and PhDs, particularly regarding Monash.

- (q) That it would be important to ensure that research students understood the terms and conditions on IP ownership that they would be signing up to under each partnership's operating agreement.
- (r) That it was suggested that Departments could provide further support for students to ensure awareness of IP policies that might cover postgraduates.

RESOLVED:

- (a) That a majority ownership model be agreed as the preferred approach for negotiating future IP operating agreements with potential strategic partners.
- (b) That agreements be formalised to obtain assignment of IP rights from joint PhD students at the start of any joint courses as a matter of urgency.
Action: University Legal Adviser
- (c) That details of the preferred model for IP operating agreements be provided to the LSTM implementation group. **Action: Ms A Chambers**
- (d) That draft versions of the IP operating agreements with strategic partners be provided to members ahead of the next meeting of the Committee.
Action: Ms A Chambers

22/12-13 'M5' Consortium – Equipment Sharing

CONSIDERED:

An oral report from Dr P Hedges on developments with equipment sharing and the Consortium.

REPORTED: (by Dr P Hedges)

- (a) That the Consortium was a group of five Midlands universities exploring ways to boost research collaboration and sharing of equipment.
- (b) That a draft agreement to facilitate the sharing of equipment between the M5 members had been proposed, though a single agreement had so far proved challenging to achieve.
- (c) That a potential IP risk might exist where a member who had lent equipment to another member for research that led to a new valuable IP, might not be able to then claim a share of ownership rights.
- (d) That it was suggested that such risks were acceptable in that this could be viewed on a *quid pro quo* basis, where Warwick might be also able to generate valuable IP from use of another M5 member's equipment.

(by the Research Support Services Adviser)

- (e) That under Science City project terms and conditions, the University retained ownership of any Foreground IP, with clients receiving rights to results and reports stemming from the IP regarding their contracted work.

- (f) That it was suggested that terms similar to those used for Science City agreements be included within a proposed M5 agreement, as a possible means of mitigating potential IP ownership risks.

RESOLVED:

That a single agreement on equipment sharing in the Consortium be proposed, which includes terms on IP ownership similar to those used in Science City agreements. **Action: Dr P Hedges**

23/12-13 Co-ordination of IP and Research Contracting Activities

CONSIDERED:

An oral report from the Chair on possible ways to promote enhanced collaboration between University directorates involved in protecting and exploiting intellectual property stemming from research activities and partnerships.

REPORTED: (by Professor R Dashwood)

- (a) That the current process for agreeing terms of research contracts and IP rights (including non-disclosure agreements (NDAs)) was sometimes felt by academics to be drawn out, and might be better expedited.
- (b) That perception from within Warwick Manufacturing Group (WMG) was that there was no consistent position on when IP rights should be retained by the University or might be reassigned to a third party, when negotiating research agreement terms.
- (c) That the ownership terms for any new IP generated in a research project were often based around the proportional funding or resourcing of a research project by a given party.

(by Professor H Spencer-Oatey)

- (d) That further work was required to raise awareness amongst academics and researchers on what the University's policies and preferred approach on IP ownership and exploitation were.
- (e) That it could sometimes be challenging to persuade academics and researchers of the importance of agreeing satisfactory terms when negotiating IP ownership rights or revenue shares within an agreement.
- (f) That it could sometimes be unclear about whom to best contact, or where to seek advice from, within the University on IP or research contractual issues.

(by Dr A Reed)

- (g) That to achieve satisfactory and expeditious contractual terms around research outputs and IP ownership it would be important to be clear at the start of any negotiations what final outcomes or objectives staff or researchers were seeking to achieve.
- (h) That it was suggested that some form of standard research agreement terms might be helpful to consider for use in future research agreements.

- (i) That a process map (or similar visual format) might be of use in explaining to academics and researchers who was responsible for what tasks across the research contracting and IP management processes.

(by Mr Q Compton-Bishop)

- (j) That it was suggested that it might be beneficial to make third parties aware in advance of what terms the University would be likely to consider acceptable ahead of negotiating contractual terms relating to IP rights and revenue shares.
- (k) That development and publication of a standard research agreement might be one method of informing potential third parties in advance of agreements, of the University's preferred position on contractual terms.

(by Dr P Hedges)

- (l) That it was recognised that reaching of agreements on IP ownership arrangements and revenue shares might delay final agreement of research contracts in certain circumstances, though potential liabilities were perhaps the most significant issue when negotiating satisfactory contractual terms.
- (m) That an NDA was useful only in facilitating negotiations on agreements and should not take long to process, and that delays in signing of NDAs might possibly be symptomatic of wider issues with progress on an agreement.
- (n) That RSS staff were being increasingly embedded into wider Departments to improve accessibility to RSS advice.
- (o) That the University had been participating in a benchmarking exercise within the Brunswick group on its relative success in its research applications and awards.
- (p) That the University's indicative benchmarking results had been as expected and that final results should help to inform RSS activities going forward.

(by the University Legal Adviser)

- (q) That it would be inadvisable to contract off of the University's insurance policy regarding potential liabilities in research contracts.
- (r) That services provided by SGH Martineau might be able to be used in reviewing of University standards around contractual agreements other IP related issues, and to up-skill staff on relevant issues and best practice.

(by the Chair)

- (s) That the discussion on improved co-ordination was intended to explore issues that might currently exist, rather than to seek immediate next steps, and that views from members on the issue were welcome.
- (t) That other universities were facing similar challenges as Warwick was regarding co-ordination of research activities, engagement with external partners and successful protection and exploitation of created IP.
- (u) That it was suggested the issue be discussed further at a future meeting of the Committee.

RESOLVED:

That the topic of achieving improved co-ordination between the research contracting process and IP management process be considered at the next meeting of the Committee. **Action: Dr S Mak**

24/12-13 Update on Research Data Management (RDM) activity

RECEIVED:

A paper (IPC.09/12-13) for information only updating on RDM developments since the last meeting.

25/12-13 Any Other Business

REPORTED: (by the Chair)

- (a) That the term of office for Mr T Skelhon as a member would be coming to an end and that the Committee wished to express its thanks for his contributions to the Committee and to the wider University.
- (b) That following the May meeting of the Committee, Ms M Wenham had stood down as nominee member for the Director of Human Resources, and that the Committee also wished to express its thanks for her contributions.