

Regional Scholarship and Innovation Fund for Applied Sciences, Engineering and Technology (RSIF)

Intellectual Property Management Manual

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The **PASET** Regional Scholarship and Innovation Fund



PASET
Partnership for Skills
in Applied Sciences,
Engineering & Technology

An Africa-led initiative to bridge the skills gap in Applied Sciences, Engineering, & Technology

Regional Coordination Unit



icipe

Preface

As countries seek new ways to diversify their economies, the need for collaboration in scientific research and innovation development nationally and globally become absolutely necessary. Intellectual property (IP) management underpins the success of any of these collaborations.

African governments together with development partners, have committed to support collaboration in scientific research and innovation development through the Regional Scholarship and Innovation Fund (RSIF) program of the Partnership for skills in Applied Sciences, Engineering and Technology (PASET). This is achieved through doctoral training of African scientists, and collaborative research and innovation projects involving academia and industry. It is, therefore, imperative to have an IP framework to safeguard the interests of parties as they engage in collaborative research and innovation activities.

This Manual provides guidance on IP Rights (IPR) provisions applicable in the RSIF program. Proper management of IP facilitates the use and dissemination of results emanating from RSIF interventions in sub-Saharan Africa (SSA), which is a key objective of PASET. Scientists and all partners in a scientific research or innovation collaboration project should consider protection of IP and related issues early on when developing joint activities.

The Manual has been prepared through intensive consultations with partners involved in RSIF research and innovation activities, including faculty at African Host Universities (AHUs) and International Partner Institutions (IPIs) as well as RSIF Scholars and other relevant third parties. It provides guidance on key issues including ownership of background and foreground IP, protection, dissemination and use of foreground IP, patent applications, publications, access rights and commercialization of IP generated from collaborative research and innovation activities. The Manual should be used as reference in conjunction with relevant institutional policies of the collaborating partners as well as related project or partnership agreements.

This Manual is a living document. It will be revised from time to time as need arises.


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Abbreviations

AHU	African Host University
ASET	Applied Sciences, Engineering, and Technology
<i>icip</i>	International Centre of Insect Physiology and Ecology
IP	Intellectual Property
IPI	International Partner Institution
IPR	Intellectual Property Rights
MTA	Material Transfer Agreement
PASET	Partnership for skills in Applied Sciences, Engineering and Technology
RCU	Regional Coordination Unit
RSIF	Regional Scholarship and Innovation Fund
SSA	Sub-Saharan Africa
TTO	Technology Transfer Office

1. Introduction

PASET is an African-led initiative whose objective is to strengthen skills in applied sciences, engineering and technology to further socio-economic transformation in sub-Saharan Africa (SSA). RSIF is the flagship program of PASET. RSIF activities are implemented mostly through African Host Universities (AHUs), which are competitively selected to participate. The current list of participating AHUs can be obtained at <https://www.rsif-paset.org>. RSIF is currently funded by contributions from African governments, the World Bank and the Government of Korea. It is managed by the International Centre of Insect Physiology and Ecology (*icipe*), Nairobi, Kenya, as the RSIF Regional Coordination Unit (RCU). The PASET Executive Board provides oversight and strategic direction for the RSIF.

The primary objective of RSIF is to train high-quality PhD students and post-doctoral fellows to address the human resource gap of highly qualified specialists in the fields of applied sciences, engineering, and technology (ASET) and to contribute to improving research and innovation capacities in those fields in SSA. RSIF supports PhD students, post-doctoral scientists and universities in SSA to establish high-quality PhD training and research programs, and to strengthen their institutional capacity for innovation development.

A key expected outcome of RSIF is the delivery of knowledge and technological innovations that contribute to science-based economic growth in SSA. RSIF implementation is arranged into three windows: Window 1 supports PhD training and capacity strengthening at African Host Universities; Windows 2 and 3 provide competitive grants for strengthening research, scientific excellence and innovation.

RSIF's implementation model includes strategic partnerships with International Partner Institutions (IPIs)¹ for collaborative research and doctoral training through a "sandwich placement". These collaborations are expected to not only contribute to an increase in the number of quality PhD graduates but also lead to an increase in quality research leading to publications in ASET fields and increase in number of IP resulting from the research outputs and innovation projects. There is, therefore, a need to develop detailed guidelines to govern IP protection for collaborative research activities by scholars hosted in partnering institutions as well as faculty implementing research and innovation projects.

The Manual provides guidance on the rights and obligations of African Host Universities and their researchers participating in RSIF projects as IP creators in the disclosure, ownership, transfer, commercialization, and revenue sharing of protected and commercialized IP. The Manual is a reference, which only complements but does not supersede the IP policies at the AHUs and IPIs as legal entities. It is a guide to the various issues and potential pitfalls regarding IPR that participants may encounter

¹IPIs are advanced universities, research institutes/centres or companies (public or private) that are willing to offer sandwich research placements for RSIF PhD Scholars from Africa, help improve the quality of PhD programs at AHUs, and collaborate with AHUs on research and innovation projects. Advanced/international research centres in sub-Saharan Africa and universities in South Africa may qualify as IPIs.

when preparing and participating in an RSIF supported activity.

Overall, partners are strongly encouraged to consider and resolve IPR issues during the preparation of their research projects and to negotiate any relevant questions before starting the project. Indeed, IPR issues can affect both the way a project is conducted and the exploitation of results after the end of a project.

This Manual should be considered in conjunction with other applicable RSIF RCU, AHU and IPI policies and agreements including the Tripartite Agreements signed between an AHU, IPI and *RSIF RCU* for sandwich placements of students at IPIs, and Grant Agreements signed between partners in RSIF funded research and innovation projects.

2. Partners and Third Parties

“African local partner” means a legal entity (from other African research institution or private sector entity) taking part in an RSIF funded project and having the rights and obligations defined by an Agreement with the AHU.

“Background IP” means the IP (i) owned or controlled by any of the Parties prior to the commencement date of the RSIF funded project; or (ii) conceived, developed, or created independently by a Party (including its agents, servants, employees, faculty, students or assigns), at any time without use of or reference to the other Party’s Confidential Information;

“Consortium” means all of the partners in the same research and innovation project who have rights and obligations defined by the Consortium Agreement.

“Foreground IP” means IP generated by a party during the execution of the RSIF funded project.

“Intellectual property” means any IP of any description including but not limited to all inventions, works of authorship, concepts, designs, developments, documentation, drawings, hardware, improvements, information, specifications, formulae, discoveries, know-how, data, processes, methods, research, software, techniques, technology, tools, and the like, and the intellectual property rights therein, including but not limited to, patents and patent applications copyrights, database rights, design rights (registered and unregistered), trademarks, trade names, and service marks, applications for any of the above.

“International partner” is a legal entity (an advanced university, research organization or company (public or private) taking part in an RSIF funded project and having the rights and obligations defined by an Agreement with the AHU.

“Joint ownership” refers to ownership of IP jointly generated by two or more partners when it is impossible to segregate each partner’s intellectual contribution to the creation of such IP.

“Mentor” refers to a supervisor who may be a member of a university faculty or IPI whose role is to guide RSIF PhD students and monitor their progress through the PhD program.

“RSIF funded project” means research and innovation activities, including PhD training, performed with funding, whether partial or full, from the RSIF.

“RSIF scholar” means a PhD student registered in an RSIF AHU and funded by RSIF, and who may be participating in a “sandwich placement” at an IPI. The RSIF scholar would be performing research for his/her PhD thesis and will work with mentors at the AHU and IPI.

“Partner” includes members of a Consortium involved in research and innovation project funded by RSIF or members in a research project performed by the RSIF scholar, the mentor from the AHU and another mentor from the IPI in a “sandwich placement” or third party.

“Project coordinator” has a very specific role amongst the partners in a given project. Project coordinator manages the project by providing guidance and monitors compliance by all partners (grant beneficiaries) with their obligations under RSIF grant agreement including IPR protection and dissemination.

“Third party” means a legal entity that does not participate in the same project.

3. Ownership of Background Intellectual Property

“Background” is information and knowledge (including inventions, databases, etc.) held by the partners prior to their accession to the **Partnership Agreement, the Joint Project Consortium Agreement, or the RSIF Scholar Agreement (as applicable)**, as well as any pre-existing IPRs, which are needed for carrying out the project. Ownership of background is not affected by participation in an RSIF project or activity.

Background should relate only to information relevant to the project (i.e. needed to implement the project). This further limits the scope of information and rights that could potentially be considered to constitute background, and to which other partners could request access. In addition, it should be noted that the background of a given partner is not limited to the information it owns, but also extends to any information or IPR which it holds – for instance through licensing agreements or material transfer agreements (MTAs).

Background IP is generated by each partner prior to entering into the RSIF funded project. All background IP belonging to each party in RSIF project is and shall remain the exclusive property of the party owning it. The background IP shall be made freely available to all parties solely for the purpose and for the duration of the research and development as well as innovation activities of the joint RSIF funded project. No rights, title or interest to any party’s Background IP is granted. Each party shall retain ownership of its Background IP and no license or other use or rights in such Background IP is created between the parties.

4. Ownership of Foreground Intellectual Property

4.1. General principles

Foreground IP is governed by the official policies of the AHU, IPI and *RSIF RCU*, as well as by policies of other members of a consortium participating in a RSIF funded research and innovation project, including contracts signed between the parties. For purposes of this Manual, and where a conflict arises in the interpretation of the policies or the terms of this Manual, IP provisions in the agreement between *RSIF RCU* and AHU or IPI take precedence. Consortium members should agree to make and maintain adequate and current records of all information relating to research undertaken during RSIF project implementation, in such forms as written laboratory notebooks, written notes, tables, sketches, drawings, spectra, chromatograms, photographs, electronic files, computer software, databases and the like or reports relating thereto.

For RSIF Scholars, IP is governed by the official policy of the AHU and by any agreement between *RSIF RCU*, the AHU, and the IPI regarding sandwich placements. The Scholar shall read and agree by signing to abide by the terms and conditions of the IP policy of the AHU. Before any sandwich placement at an IPI, the Scholar shall be informed in writing of the IP conditions in any agreement between the *RSIF RCU*, the AHU and the IPI. The Scholar shall read and agree to abide by the terms of the IP conditions of the said Partnership Agreement. The Scholar, together with his/her supervisor(s), will ensure that any movement of 'materials' or related IP for the PhD study will be covered by a material transfer agreement (MTA). AHUs and IPIs are encouraged to have MTA templates, which scholars and their supervisors can use.

In the event of cessation of the Partnership Agreement between *RSIF RCU*, AHU and IPI, the RSIF Scholar shall be bound by the IP Policy of the AHU and by any IP conditions in the Partnership Agreement regarding RSIF Scholar sandwich placements between *RSIF RCU*, the AHU and the IPI as stipulated by relevant clauses in those agreements.

Foreground IP resulting from the RSIF funded research and innovation project belongs to the partner who generated it, unless the Foreground IP is generated jointly by partner(s) and it is impossible to segregate each partner's intellectual contribution to the creation of such Foreground IP in which case the Foreground IP will be jointly owned by the partners in equal shares unless otherwise agreed in writing. To be able to prove ownership as well as the date of generation of Foreground IP, it is strongly recommended that all partners should maintain documents showing the development and generation of knowledge or results, e.g. laboratory notebooks, in accordance with proper standards. This may help avoid or resolve disputes between partners about the origin of certain results and any associated IPR.

Furthermore, partners must ensure that, where necessary, they reach an agreement with their employees and other personnel, including third parties such as subcontractors, students, etc., if the latter are entitled to claim rights to Foreground IP in order for the partner to be able to meet their contractual obligations. Such agreements may, for instance, involve a formal transfer of ownership, or at least the granting of appropriate access rights preferably with a right to sub-license.

4.2. Joint ownership

Joint owners must agree among themselves on the allocation and the terms of exercising the ownership of the Foreground IP. This should be defined in detail in a Consortium Agreement in the case of research and innovation projects or in the Partnership Agreement signed between RSIF RCU, the AHU and the IPI, in the case of the sandwich program.

Joint ownership arises in two specific cases: (i) in collaborative projects in respect of Foreground IP generated jointly by two or more partners and it is impossible to segregate each partner's intellectual contribution to the creation of such Foreground IP; and (ii) in the case of RSIF scholar on a sandwich placement who will conduct joint research project between the laboratory of his/her PhD thesis mentor at the AHU and co-mentor at the IPI.

Partners in research and innovation projects are free to agree amongst themselves on alternative practice, such as the joint ownership of the Foreground IP resulting from the project. Joint owners have to agree among themselves on the allocation and the terms of exercising the ownership of the Foreground IP, typically by incorporating appropriate provisions in their Consortium Agreement regarding joint ownership or entering into a joint ownership agreement. The same principle of joint ownership applies for the RSIF Scholar and mentors in AHU and IPI.

The joint owners may agree that patent applications will be filed and maintained by only one partner on behalf of the others, in which case there will be a partial transfer of ownership. They should also define the respective shares of ownership if they are not divided equally.

With respect to the terms of exercising the ownership, it is highly advisable that joint ownership arrangements clarify management issues such as the sharing of the costs arising from legal protection procedures (e.g. patent filing and examination fees, renewal fees, prior state of the art searches, infringement actions, etc.) and the exploitation of the jointly owned Foreground IP (e.g. sharing of any revenues or profits). All of this should be defined in the Consortium Agreement for research and innovation projects or in RSIF scholar sandwich program. Such joint ownership arrangements should also consider the different national joint ownership regimes to avoid potential pitfalls.

The joint owners may, of course, agree not to continue with joint ownership but decide on an alternative regime, for example, a single owner with more favorable access rights for the other partners that transferred their ownership share or any other fair counterpart. To avoid problems regarding the joint ownership provisions of national IPR laws, in particular regarding the right to grant licenses by joint owners, a default regime for joint ownership should be introduced, which is applicable only in the

absence of a specific agreement between the partners concerned or pending its conclusion. The partners could foresee a specific procedure in their Consortium Agreement to deal with such issues relating to possible joint ownership agreements.

Whether or not a patent relating to Foreground IP is jointly owned depends on the exact scope of work done by each of the joint owners and the claims of the patent application(s) as well as, where different in scope, that of the patent(s) granted.

Foreground IP rights arising from the RSIF research and innovation projects and from research activities of PhD scholars in “sandwich placement” in accordance with the relevant RSIF Agreements in this regard shall be owned as follows:

- (i) To the extent that the Foreground IP is generated or developed by the activities and/or intellectual contributions of the AHU partners alone, then it shall vest in and be exclusively owned by the AHU partners, unless otherwise stipulated by the IPR transfer agreement concluded between the parties.
- (ii) PhD Scholars participating in “sandwich placement” will also be entitled to Foreground IP when they directly contribute towards development of the IP.
- (iii) To the extent that the Foreground IP is generated or developed by the activities and/or intellectual contributions of the IPI partners alone, then it shall vest in and be owned by the IPI partners.
- (iv) To the extent that the Foreground IP is generated or developed by the activities and/or intellectual contributions jointly by the AHU and IPI partners, then it shall vest in and be owned jointly and proportionally to their intellectual contributions.

During the RSIF project’s term, partners may on request, grant use of such Foreground IP to the partner on fair and reasonable terms. The financial terms of exploiting rights of any jointly owned Foreground IP will be fair and reasonable in the circumstances and will be negotiated considering the financial and intellectual contributions of the partners towards the IP.

The partners shall not disclose to any third party any part of Foreground IP financed in whole or in part by RSIF without previously obtaining written permission from the other party. The RSIF RCU should be informed in writing about Consortium decisions and PhD scholar IP related activities.

Each partner may grant the other partner a non-exclusive license on fair and reasonable terms to use any Background IP or Foreground IP that is required for the exploitation of the Foreground IP.

4.3. Transfer of ownership

When ownership is transferred, the assignor must conclude appropriate arrangements to ensure that its contractual obligations with respect to dissemination, use, and the granting of access rights are passed on to the new owner (the "assignee"), as well as by the latter to any subsequent assignee. Moreover, prior notice must be given to the other partners in the RSIF funded research and innovation project or in the case of RSIF Scholar on a “sandwich placement” to AHU, the RSIF Scholar and the host IPI.

There is a requirement to give prior notice on transfer of ownership to the other partners in the same project as long as the partner concerned is required to grant

access rights, with a minimum notice of 30 days or a different notice period agreed-upon by Consortium members or RSIF Scholar, AHU and IPI in advance.

In the case when the IP rights will be transferred to a specific third party, the transfer is subject to prior agreement by all parties in a project. This should be defined in the Consortium Agreement. One of the Consortium members can be authorized to transfer the ownership of any Foreground IP it generates to a specifically identified third party. Before agreeing to such an exemption, the other parties should carefully consider the situation and, in particular, the identity of the third party concerned to determine if their access rights could be properly exercised in case a transfer takes place.

In the case when the member(s) of Consortium come from the private sector transfer of ownership of Foreground IP can take place explicitly but may also arise in the context of a take-over, the merger of two companies or similar cases. Where appropriate, a special statement may be included in the relevant Agreement, requiring the participants to notify the RSIF RCU of any intended transfer of ownership of Foreground IP to a third party established in a non-associated third country.

5. Protection of Foreground IP

Where Foreground IP is suitable for industrial or commercial application (even if it requires further research and development, and/or additional private investment), it should be protected in an adequate and effective manner in conformity with the relevant legal provisions, having due regard to the legitimate interests of all partners, particularly the commercial interests. Partners should, individually and preferably collectively, reflect on the best strategy to protect in view of the use of the Foreground IP both in further research and in the development of commercial products, processes or services.

The reference to industrial or commercial applicability and to the legitimate interest of the partners means that IP protection is not mandatory in all cases. Apart from a lack of industrial or commercial applicability (e.g. certain fundamental research results), there are also situations where journal publication or other means of putting Foreground IP in the public domain constitute appropriate alternatives, considering the specificity of the project, the nature of the results concerned and the legitimate interests of the partners. For example, the free and open source software approach is perfectly valid in some cases, but evidently it is preferable that all partners in the project are informed of this strategy before the project starts in order to avoid possible future conflicts.

In certain cases, it is advisable to keep the invention confidential and to postpone the filing of a patent (or other IPR) application (and consequently any dissemination), for instance, to allow further development of the invention while avoiding the negative consequences associated with premature filing (earlier priority and filing dates, early publication, possible rejection due to lack of support / industrial applicability, etc.).

Partners are encouraged to consult with and inform each other before deciding to protect or not to protect a specific piece of Foreground IP they individually own (i.e.

where the Foreground IP is not jointly owned) to give the other partner a chance to express (and substantiate) possible legitimate interests. Partners should inform each other even after protective measures have been taken. These issues should be covered in details within the Consortium Agreement in the case of RSIF funded research and innovation projects or in the case of scholar on sandwich placement through specific agreements.

For purposes of this RSIF Manual, in the case when a partner does not intend to protect its Foreground IP, it may first offer to transfer it to another partner or even to certain third parties, which may consider it worthwhile protecting this piece of Foreground IP, rather than leaving it unprotected and available for use by competitors.

6. Specific Issues Relating to Patent Applications for Foreground IP

If either partner has not protected valuable Foreground IP, they must inform the RSIF RCU at the latest 45 days prior to any dissemination activity. The RSIF RCU shall, within 30 days, advise on the appropriate mechanisms to ensure protection of the IP. More specifically, in such a case, protection measures could be taken by the RSIF RCU.

The obligation to inform the RSIF RCU may be applied also by partner (1) when some Foreground IP was protected by a partner but the owner considers abandoning the protection (e.g. by not paying the official prosecution or renewal fees for a patent application), and (2) when protection was applied for in a first country ("priority application"), but the owner does not consider extending the protection to foreign countries before the end of the priority period.

In these cases (intention not to protect, or to abandon protection of, Foreground IP), the RSIF RCU should be informed well in advance of any applicable official deadline (such as those associated to the payment of renewal fees or with the end of the priority period); preferably with at least 2 months prior notice, so as to be able to take appropriate measures.

When a patent application is filed, it is important that the true inventor(s) be identified, not only for fairness reasons, but also for legal reasons. Patent applications concerning Foreground IP also need to contain the following specific sentence (or a translation thereof) in the description referring to RSIF funding as follows: "*The work leading to this invention has received funding from the PASET RSIF Program under grant agreement n° xxxxxx.*"

7. Use of Foreground IP

The partners should use the Foreground IP that they own, or ensure that others will use it. Use of Foreground IP means the direct or indirect utilization of Foreground IP in further research activities other than those covered by the RSIF funded project, or

for developing, creating and mass marketing a new product or novel process, or for creating and providing a new service. Direct utilization is done by the partner owning the Foreground IP (e.g. through further research or commercial or industrial exploitation in its own activities) while indirect utilization is done by other parties through licensing of research results or technology developed in research and innovation project or as the part of RSIF Scholar's thesis research activities.

8. Dissemination of Foreground IP

Where dissemination of Foreground IP does not adversely affect its protection and use, there is an obligation to disseminate it swiftly. Should the partners fail to do so without any justification, the RSIF RCU may disseminate the Foreground IP without seeking permission. Since RSIF RCU is playing mostly a supportive role in this regard, researchers/scholars should indicate whether or not the information they share with RSIF RCU is bound by some confidentiality requirements or not. If this is not stated, RSIF RCU will assume that the information is free to be shared publicly.

However, no dissemination of Foreground IP may take place before a decision is made regarding its possible protection. The Consortium members and mentors/supervisors of RSIF scholars should develop the IP protection plan in advance, ensuring that the entire process of protecting Foreground IP is done efficiently without significant delays. Consortium members and scholars should take necessary measures to protect the Foreground IP prior to openly discussing data at conferences, research seminars or revealing research results through publishing abstracts or research papers. RSIF Scholars are under obvious pressure to finalize their PhD degree within the agreed timelines and mentors (both at AHU and IPI) should ensure that the protection of Foreground IP does not delay this process significantly.

Indeed, any disclosure, even to a single person who is not bound by secrecy or confidentiality obligations (typically someone from a different organization outside the consortium or in the case of RSIF scholar outside of mentor's/supervisor's team at the AHU and IPI), prior to filing for protection, may invalidate any subsequent patent application, be it written (including by e-mail) or oral (e.g. at conferences, or even to a single person). Evidently, no dissemination at all may take place if it is intended to protect the Foreground IP as a trade secret (i.e. confidential know-how).

It is recommended that confidentiality obligations be detailed in the Consortium Agreement in the case of research and innovation projects or a specific confidentiality agreement. Any data that is to remain secret should be clearly labeled as confidential and appropriate measures should be taken by the other partners and the RSIF RCU to maintain confidentiality, even after the end of the project. The other partners must be given at least 30 days prior notice in writing of any planned dissemination activity, together with sufficient information about the intended dissemination. This is necessary to allow them to assess whether their legitimate interests could in any way suffer in relation to their foreground or background. In such cases, the dissemination activity may not take place unless appropriate steps are taken to safeguard these legitimate interests of other partners.

The partners may agree in writing (e.g. in the Consortium Agreement) on different time-limits to those set out above, which may include a deadline for determining the appropriate steps to be taken to ensure that for example publications relating to a specific piece of Foreground IP are not postponed or delayed unreasonably.

Under RSIF, the RSIF RCU only needs to be notified *ex-ante* of dissemination intentions when the Foreground IP to be disseminated is capable of industrial and commercial application and has not been formally protected. Where this is the case, no dissemination activities can take place before the RSIF RCU has been informed and has advised on the mechanism to protect that Foreground IP.

Given the importance of dissemination, Consortium members are encouraged to develop an appropriate plan for the use and dissemination of Foreground IP. The plan should describe appropriate activities to ensure the optimal dissemination and use / exploitation of the project results, including the management of IPR. The plan for dissemination and use of Foreground IP should be submitted to the RSIF RCU for the record, and eventual monitoring of its implementation.

All of the above applies equally for both RSIF funded research and innovation projects and projects involving RSIF scholars.

9. Financial Support and Reporting

In order to facilitate their identification by the public and RSIF RCU, dissemination materials (e.g. publications, websites, etc.) concerning results from RSIF projects need to contain the following specific sentence, included in the Grant Agreement:

The research leading to these results has received funding from the PASET's RSIF Program under grant agreement n° xxxxxx.

Any dissemination activity shall be reported in the plan for the use and dissemination of Foreground IP, including sufficient details/references to enable the RSIF RCU to trace the activity if needed. With regard to scientific publications relating to Foreground IP published before or after the final report, such details/references and an abstract of the publication must be provided to the RSIF RCU at the latest within three months following publication. As part of the final project report, the Project Coordinator (in the case of research and innovation project) will be required to submit a full list of publications relating to Foreground IP of the project. The RSIF Scholar in the “sandwich placement” should be required to submit the same. Co-supervisors/mentors from the AHU and the IPI should jointly sign the RSIF Scholar’s Report that RSIF RCU receives.

10. Publications in Scientific Journals

Many publishers require authors to sign an agreement by which authors transfer their copyrights to publishers and thereby exclude publication elsewhere. This type of agreement may also limit authors' rights to deposit articles into openly accessible repositories upon publication.

Several important facts should be considered:

- i. First of all, the provisions of a publication agreement could apply only to a piece of publication text. They do not apply to any inventions or other knowledge described in that text. The use, ownership, etc. of such inventions or knowledge are not affected by the publication agreement. Some publication agreements should explicitly mention that the participant or author(s) retain such rights. The main provision of such a publication agreement usually relates to the transfer of the copyright attached to the concerned text. However, it should not be considered that a publication (copyright transfer) agreement prohibits the publication of any further paper by the project participants regarding their project in so far as no parts of first text are used, i.e. the underlying ideas may of course be used again but must be expressed differently.

The partners should ensure that they have internal procedures in place to deal with this as they remain liable for the fulfillment of their obligations regarding the Foreground IP as described in this Manual and any other related agreements between RSIF RCU, the AHU, and the IPI. However, partners should also ensure that prompt publishing in high quality scientific journals is desirable so the protection of Foreground IP is accomplished promptly and efficiently without significant delays.

- ii. Each partner who would like to publish in high-quality scientific journals shall discuss this intention with the other partners and, if some (or all) of the Foreground IP and/or Background IP to be published belong to (an) other partner(s), seek its/their prior approval (i.e. no Background IP or Foreground IP may be disseminated without the approval of its owner). Prior to any submission for publication, the partners shall confer with sufficient time to request redaction or removal of any Confidential Information (as defined herein) that either partner requests be stricken from such research or to delay publication for a period not to exceed ninety (90) days if the publication contains disclosure of an invention(s) on which either partner desires to file a patent. It should be noted that although each partner must disseminate the Foreground IP it owns, several partners may agree to disseminate jointly, as for example often occurs through co-authoring of scientific publications. Furthermore, partners should ensure that publications adhere to their organization's publication policies, including correct authorship, proper acknowledgements and an agreement on standards of expected ethical behavior for all parties involved in the writing and publishing of science. To avoid conflict, all partners must be involved in the prior review of all publications emanating from RSIF projects.
- iii. Carefully check the compatibility of the relevant agreements, e.g. RSIF Grant

Agreement, Consortium Agreement, and Partnership Agreement, with any publication agreement they are considering to sign, and inform the publisher of the obligations resulting from such agreement, e.g. a contractual provision could be inserted in the publication agreement to take this into account, for example: *"The publisher agrees that the author retains the right to provide the RSIF RCU for publication purposes with an electronic copy of the published version or the final manuscript accepted for publication."* Reputable publishers will usually also allow a statement of financial support in the acknowledgements section.

11. Access Rights

A partner in the Consortium (in the case of RSIF funded research and innovation project) may request access rights for use purposes only if it needs them for using its own foreground resulting from the project. In all other situations, appropriate access rights may be freely negotiated, but there is no requirement to grant them by other Consortium members (this should be defined in advance and reflected in the Consortium Agreement).

Access rights for use purposes, both to Background IP and to Foreground IP, may be granted either royalty-free, or on fair and reasonable conditions to be agreed. Partners may, of course, consider a combination of the two, for example, royalty-free for further research purposes and, as is often the case, on fair and reasonable conditions for other use purposes. These considerations are relevant also for RSIF Scholars participating in RSIF Sandwich placement.

12. Cost of IPR Protection, Dissemination and Management

The cost for IP protection should be included in the RSIF funded research and innovation project budget and it should be planned in advance during submission of a project's budget. This should be developed in line with financial guidelines of the RSIF project. Similarly, the cost of the IP protection should be incorporated into the Agreement between AHU and IPI and RSIF scholar participating in the sandwich placement, and should consider cost-sharing arrangements in the case of joint ownership of IP. Costs associated with patents (or other IPRs) relating to results obtained outside of the project are not eligible for funding by RSIF.

Licensing royalties should be discussed with the RSIF RCU on a case-by-case basis. These are principles to be considered: (1) Royalties to be paid to a third party (who is not RSIF project partner); (2) Royalties to be paid for access rights granted by the other partner. In the first case such royalty fees can be considered as being eligible for RSIF financial support if the other applicable conditions required for the implementation of the project have been met. On this basis, eligibility might be limited in specific cases, for instance regarding royalty fees with respect to an exclusive license, unless it is demonstrated that the exclusivity is absolutely necessary for the

implementation of the project.

In the second case the access rights to Foreground IP and Background IP needed for implementation of the project must be granted royalty-free. However, if all participants agree before accession to the Grant Agreement, access rights to background needed for implementing the project can involve the payment of a royalty-fee. This will apply in the case if one of the partners has unique and valuable background necessary for implementing the project and others do not bring the same level of background or expertise into the RSIF funded project.

13. Consortium Agreement and RSIF Scholar Agreement

A Consortium Agreement sets out the internal management guidelines for the Consortium and can, for example, provide arrangements regarding the granting of specific access rights in addition to those provided for in the standard IPR provisions of this Manual. A model consortium agreement can be found at <https://www.rsif-paset.org>.

Consortium agreements need to be developed in line with the provisions of the Grant Agreement, which always prevails. They should be concluded early on at the beginning of the project. Partners might prepare several consortium (sub-)agreements governing different aspects of the project (some before the signature of the Grant Agreement and some possibly after), or from amending their initial consortium agreement according to their needs and the evolution of the project. They may also consider preparing bilateral or other arrangements involving smaller groups of partners. Certain specific issues that are not essential at the start of the project can be negotiated later, with the advantage that the corresponding (negotiation) costs may then be considered as being eligible.

RSIF Scholar Agreement sets out the guidelines for AHU, RSIF RCU and the IPI for the RSIF scholar “sandwich” placement at the IPI.

14. Commercialization of Intellectual Property

Where appropriate, the partners in RSIF funded research and innovation project and RSIF Scholars and their mentors may consider specific strategies for managing and exploiting their Foreground and Background IP, for instance by setting up:

- (i) one or more "patent pools" (groups of patents or other IPRs relating to a given technology) which could be freely used or cross-licensed among themselves and/or jointly licensed to third parties; or
- (ii) establishing a new legal entity (spin-off company). This new legal entity would own the IP concerned and exploit it jointly. This will be subject to the granting of access rights and fulfillment of other commitments under the RSIF Grant Agreement).

- (iii) The third option to consider is technology transfer and commercialization of research results. Details on these aspects must be proposed and provided in the Plan for the use and dissemination of foreground. It is advisable to consult appropriate university knowledge transfer offices of participating universities. This will ensure adequate level of professional advice when considering strategies that may also prove helpful in ensuring continuity after the end of the RSIF project. In cases where the AHU does not have a technology transfer office (TTO), the RSIF RCU may provide support with technology transfer and potential commercialization of results.

15. Resolution of Potential Conflicts

Dealing with potential IPR conflicts among partners and with third parties is essential when conceiving the IP strategy in any research projects. Avoiding IPR conflicts within a RSIF funded project is crucial to smooth project implementation and to the marketability of the results. Appropriate IP management is essential to lead to a successful research project.

When conflicts arise pursuant to an IPR, research consortia members, including RSIF scholars, should try as much as possible to reach amicable resolution. Where amicable resolution is not possible, the affected persons may seek further support to resolve conflicts from offices at the AHUs or IPIs, which are responsible for regulation of IP or related legal matters. These offices could be technology transfer offices (TTO) or innovation offices or university legal offices dealing, among other issues, with the IP protection. It could also be an IP Management Committee or person designated by the AHU to handle IPR matters.

16. IPR Help Desk

The RSIF RCU shall maintain an IPR help desk. The help desk shall provide advice to all Consortia members and RSIF scholars on IPR issues and will be in the position to help in providing solutions to prevent or to resolve conflicts related to IPR.

Annexes

Annex 1: IP provisions in the *icipe*-RSIF Scholar Contract/ Agreement

- a) Intellectual property (IP) is governed by the official policy of the University and by any agreement between ICYPE, the University, and the IPI regarding sandwich placements for RSIF PhD Scholars. The Scholar agrees to read and abide by the terms and conditions of the IP policy of the University. Before any sandwich placement at an IPI, the Scholar shall be informed of the IP conditions in any agreement between ICYPE, the University and the IPI. The Scholar will ensure that any movement of 'material' or related IP for the purposes of the PhD study will be covered by a material transfer agreement. The Scholar agrees to read and understand and abide by the terms of the IP conditions of the said agreement.
- b) The Scholar agrees to make and maintain adequate and current records of all information relating to research undertaken during the scholarship, in such forms as written notes, tables, sketches, drawings, spectra, chromatograms, photographs, electronic files, computer software, databases and the like or reports relating thereto.
- c) In the event of the cessation of this agreement, the Scholar shall be bound by the IP Policy of the University and by any IP conditions in an agreement regarding RSIF Scholar sandwich placements between *ICYPE*, the University and the IPI.

Annex 2: IP provisions in the *icipe*-AHU Agreement

- a) All background IP shall remain the exclusive property of the Party bringing it for the implementation of the Agreement
- b) Foreground IP generated solely by one party shall be owned wholly by that party
- c) Where Foreground IP is generated jointly by the parties and it is impossible to segregate each party's intellectual contribution to the creation of such foreground IP, the results will be jointly owned by the parties in equal shared, unless otherwise agreed in writing
- d) Parties may grant to the other a non-exclusive, royalty-free license for the duration of the Agreement to use its Background Intellectual Property or Foreground Intellectual Property for the purpose of implementing the Agreement and for their own internal teaching, research and development purposes.
- e) No Party makes any representation or warranty that advice or information given by a Party or any of the Parties' respective employees, students, agents or appointees, on the content or use of any materials, works or information provided herein (including but not limited to Background Intellectual Property), will not constitute or result in infringement of third-party rights.
- f) No Party accepts responsibility for any use which may be made of any work carried out under or pursuant to this Agreement, or of the Results, nor for any reliance which may be placed on such work or Results, nor for advice or Information given in connection with them.
- g) Parties shall have the joint right to determine the commercial exploitation and disposition of jointly owned Foreground Intellectual Property, and parties shall enter in good faith discussions in order to make joint applications for the registration of the same. Before any registration or commercialization of any

jointly owned Foreground Intellectual Property takes place, the Parties agree to reach a separate agreement covering issues such as exploitation rights and revenue sharing.

Annex 3: IP provisions in the RSIF Project Grant Agreement

- a) Wherever possible, the results of the Project shall be made available as public goods. However, where it is necessary to promote commercialization of the technology, the Recipient shall pursue adequate measures to protect IP Rights in accordance with its institutional IP policies.
- b) The Recipient shall require all its scientists, employees or students conducting research under the Project to assign their rights in any IP conceived during the Project to the Recipient. Nothing in this Article shall be interpreted to require MSc and or PhD students to assign copyright in their thesis.
- c) Project partners shall jointly agree and describe the ownership of Background and Foreground IP in the Project Partners' Collaborative Agreement.
- d) *icipe* and all the respective donors to RSIF shall have the right to copy and distribute in a suitable form any reports and studies directly arising from the Project. The IP regulations will be considered during distribution of the information.
- e) The Recipient warrants that it will take all reasonable steps to ensure that its implementation of the Project under this Grant Agreement will not infringe any third-Party IP Rights.
- f) The Recipient agrees to indemnify and hold *icipe* harmless against all liability, loss, damage, costs and expenses (including legal costs) which *icipe* may incur or suffer as a result of any claim of alleged or actual infringement of a third party's IP Rights arising out of the Recipient's negligent implementation of the Project.

Annex 4: IP provisions in the RSIF tripartite agreement

- a) All Background Intellectual Property shall remain the exclusive property of the Party bringing it for the implementation of this Agreement. No rights, title or interest to any Party's Background Intellectual Property are granted under the terms of this Agreement. Each Party shall retain ownership of its Background Intellectual Property during the term of this Agreement and no license or other use or right in such Background Intellectual Property is created between the Parties under this Agreement.
- b) Foreground Intellectual Property generated solely by one Party shall be owned wholly by that Party.
- c) Where Foreground Intellectual Property is generated jointly by the Parties and it is impossible to segregate each Party's intellectual contribution to the creation of such Foreground Intellectual Property, the results will be jointly owned by the Parties in equal shares, unless otherwise agreed in writing.
- d) Parties may grant to the other a non-exclusive, royalty-free licence for the duration of the Agreement to use its Background Intellectual Property or Foreground Intellectual Property for the purpose of implementing the Agreement and for their own internal teaching, research and development purposes.

- e) No Party makes any representation or warranty that advice or information given by a Party or any of the Parties' respective employees, students, agents or appointees, on the content or use of any materials, works or information provided herein (including but not limited to Background Intellectual Property), will not constitute or result in infringement of third-party rights.
- f) No Party accepts responsibility for any use which may be made of any work carried out under or pursuant to this Agreement, or of the results, nor for any reliance which may be placed on such work or results, nor for advice or information given in connection with them.
- g) Parties shall have the joint right to determine the commercial exploitation and disposition of jointly owned Foreground Intellectual Property, and parties shall enter in good faith discussions in order to make joint applications for the registration of the same. Before any registration or commercialization of any jointly owned Foreground Intellectual Property takes place, the Parties agree to reach a separate agreement covering issues such as exploitation rights and revenue sharing.



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