

Intellectual Property Rights: Concerns in Collaborative Research and Technology Transfer

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About Anand and Anand

Our Transition : 90 to 100

- Heritage of 90+ Years
- Deal with IP in 90% of the world's countries
- Team of over **100** attorneys / engineers
- Strong leadership-26 Partners + 4 Directors and professional management

Our Strength – Our People



- Diverse team of over 300 people - Lawyers, PhDs, IITians, MBAs, CAs
- International secondments / trainees

Our Clients

- Few thousand clients including 8 out of the global **Top 10** brands by Interbrand
- Represent interests of innovators / right owners
- Act for industry leaders of almost all intangible dominated industries

Our Presence

- Offices in Delhi, Noida, Chennai and Mumbai
- Mumbai Office practice merged with Khimani & Associates to create new entity "Anand and Anand & Khimani"
- Handling portfolios globally with specialized team for SAARC countries

Practice Areas – IP 365°



COPYRIGHT



DESIGN



LITIGATION



PATENTS



TRADEMARK

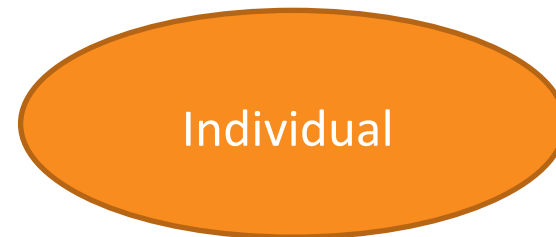
- ADVERTISING AND PRODUCT LIABILITY
- ALTERNATE DISPUTE RESOLUTION
- ART LAW
- BIODIVERSITY
- BRAND STRATEGY
- COMPETITION LAW
- CONTRACTUAL & COMMERCIAL IP
- CUSTOMS

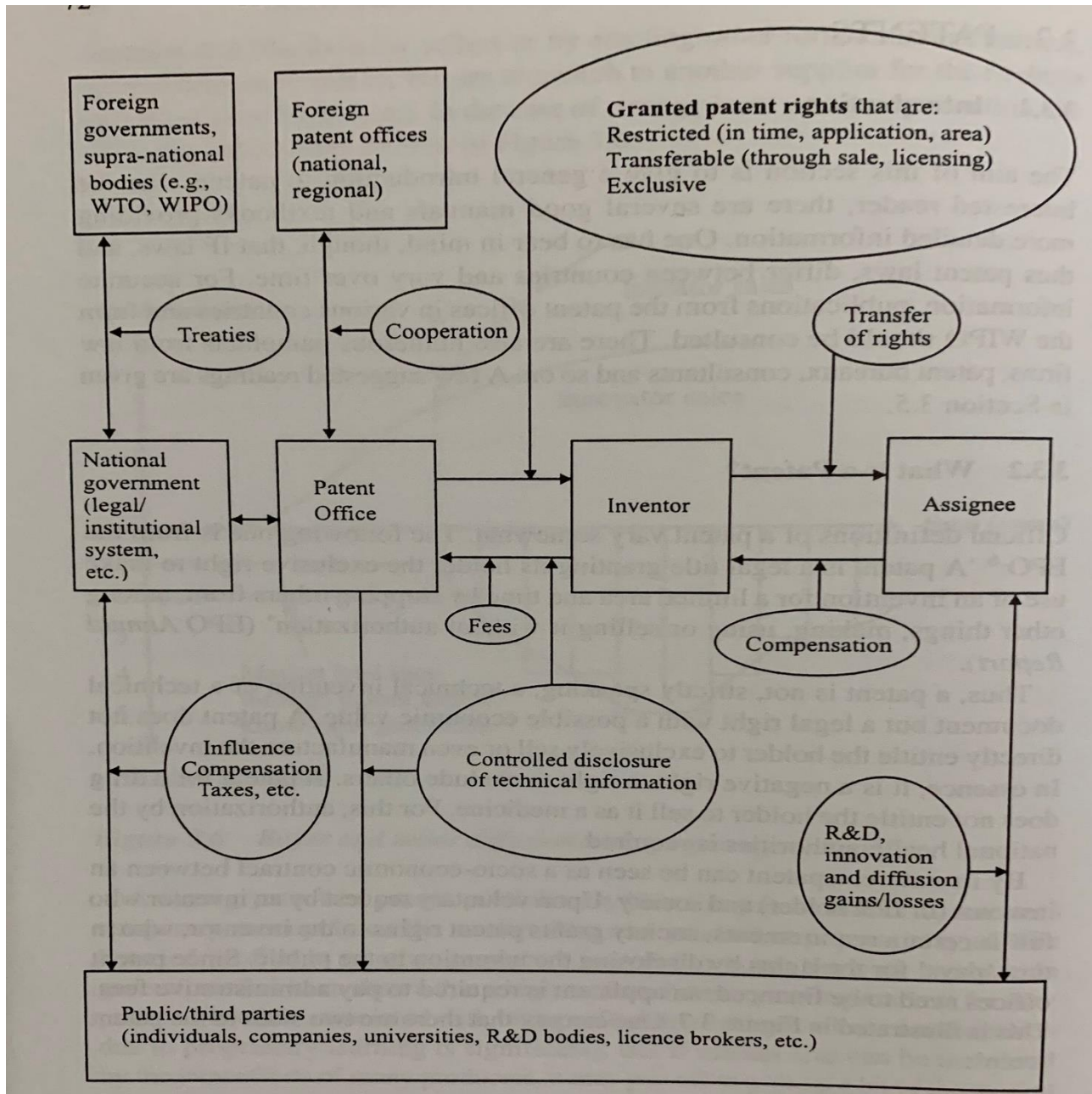
- ENFORCEMENT
- ESSENTIALITY EVALUATION
- FASHION LAW
- FRANCHISING
- GEOGRAPHICAL INDICATIONS
- IT & E-COMMERCE LAWS
- LICENSING
- MEDIA AND ENTERTAINMENT LAWS

- PACKAGING AND LABELLING
- PLANT VARIETY
- REGULATORY
- SPORTS LAW
- START-UP LAW
- TRADE SECRETS
- WHITE COLLAR AND IP CRIME

Partnerships

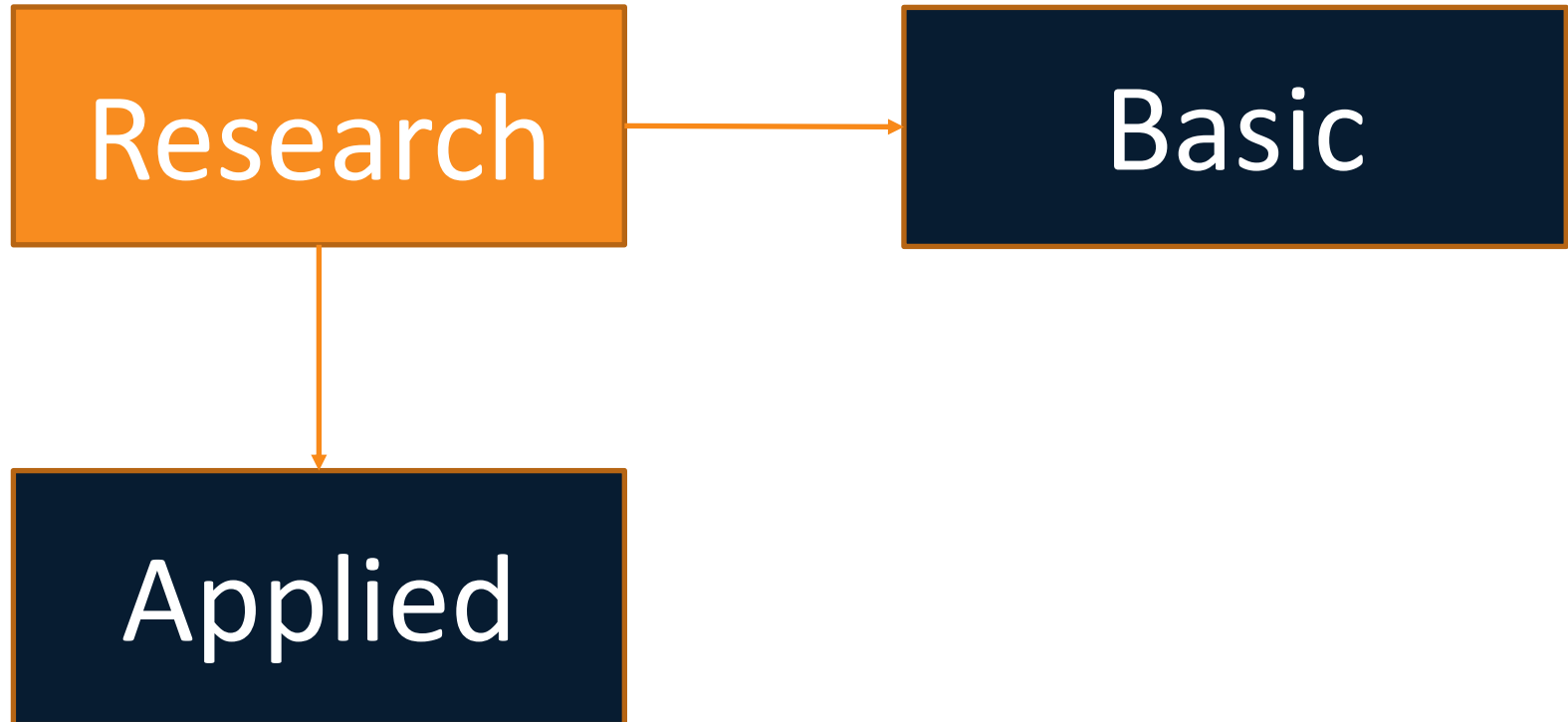
- Private-Private
- Public-Public
- Public-Private



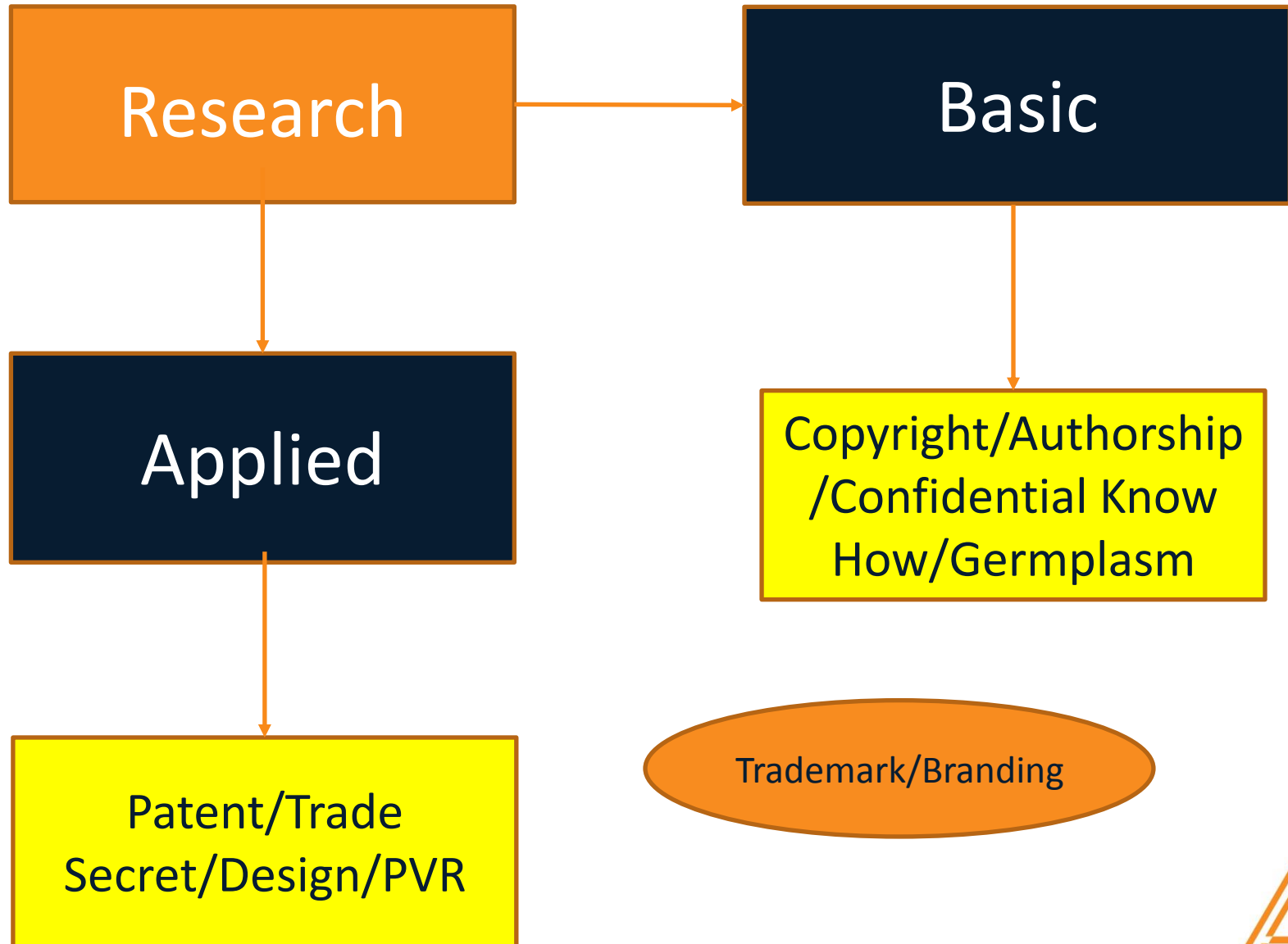


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Research Collaboration



Research Collaboration



Type	IP-related characteristics ²	Examples
Technological/technical ³ innovation	Patentable Also protectable by trade secrets, copyrights, designs and trademarks	Wheel Telephone Incandescent lamp Transistor
Service innovation (e.g. in information services, financial services, telecommunications services, medical services, transportation services, educational services, etc.)	Non-patentable in general Supporting technologies may be patentable Protectable by trade secrets, trademarks and copyrights	Newspapers Messaging systems Heart transplantation New school courses
Financial innovation	Non-patentable Easy to imitate but diffusion may still be slow	Insurance Convertible debentures Certificates of deposit Put and call options
Managerial/organizational innovation	Non-patentable Often slow diffusion May be protected as trade secrets	Divisionalized organization (corporate organization form (M-form)) Programme evaluation and review technique (PERT) for project planning <i>Kanban</i> , just in time (JIT), total quality management (TQM), etc. ⁴
Marketing/distribution innovation	Non-patentable Supporting technologies may be patentable	Supermarket Mail order Teleshopping
Institutional innovation	Non-patentable Slow diffusion	Patent system Limited liability joint stock company
Other types (social, legal, political, cultural, etc.)	Cultural innovations are protectable by IPR	European Community Opera

Confidentiality

Confidentiality Concerns

Novelty

Competitive advantage

Knowledge Dissemination

Confidentiality

- Publication
 - Authorship
 - Acknowledgement
- Laboratory notes
- Transfer of Research Results
- Staff Personnel
 - Students
 - Research scholars

Confidentiality

- Publication
 - Authorship
 - Acknowledgement
- Laboratory notes
- Transfer of Research Results
- Laboratory Staff
- Updates
 - Internal
 - External
 - Conferences
 - Public Funding
- International
 - Party
 - Expert
- Biological Resource

Confidentiality

- Clear Policy of both Parties
- Agreement on issues prior to collaboration

- Confidential Information
 - Pre-existing
 - Created
 - Generated Confidential
 - Generated Non-Confidential
 - Confidential with Pre-existing
- NDA
- Collaboration Agreement
- Regular Review
 - Use
 - Term

Ownership

OWNERSHIP

Basis

- Contribution
- Financial inputs
 - Direct
 - Indirect
- Research infrastructure
- Intellectual Capital Value
- Expert Skills

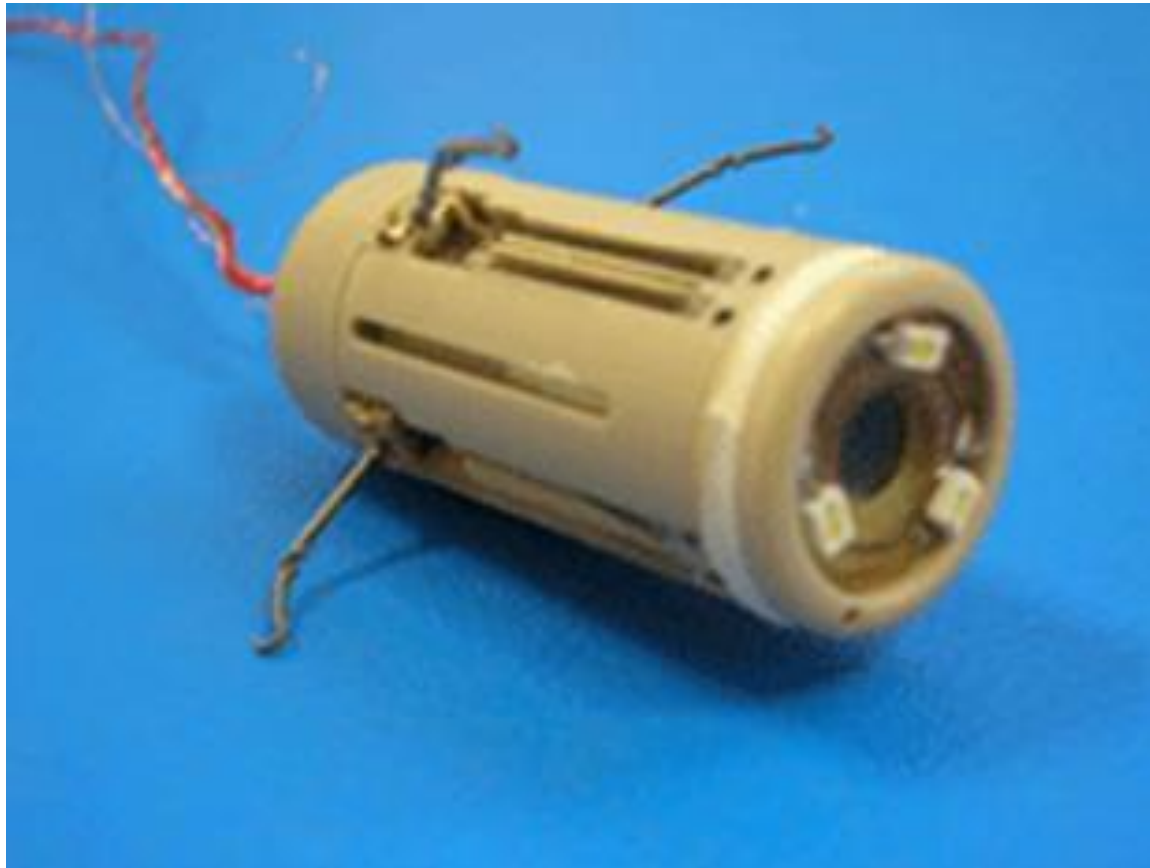
Concerns

- Which parties?
- What Rights?
- Pro-rata rights?
- Joint Ownership?
- When
 - Outcome unknown

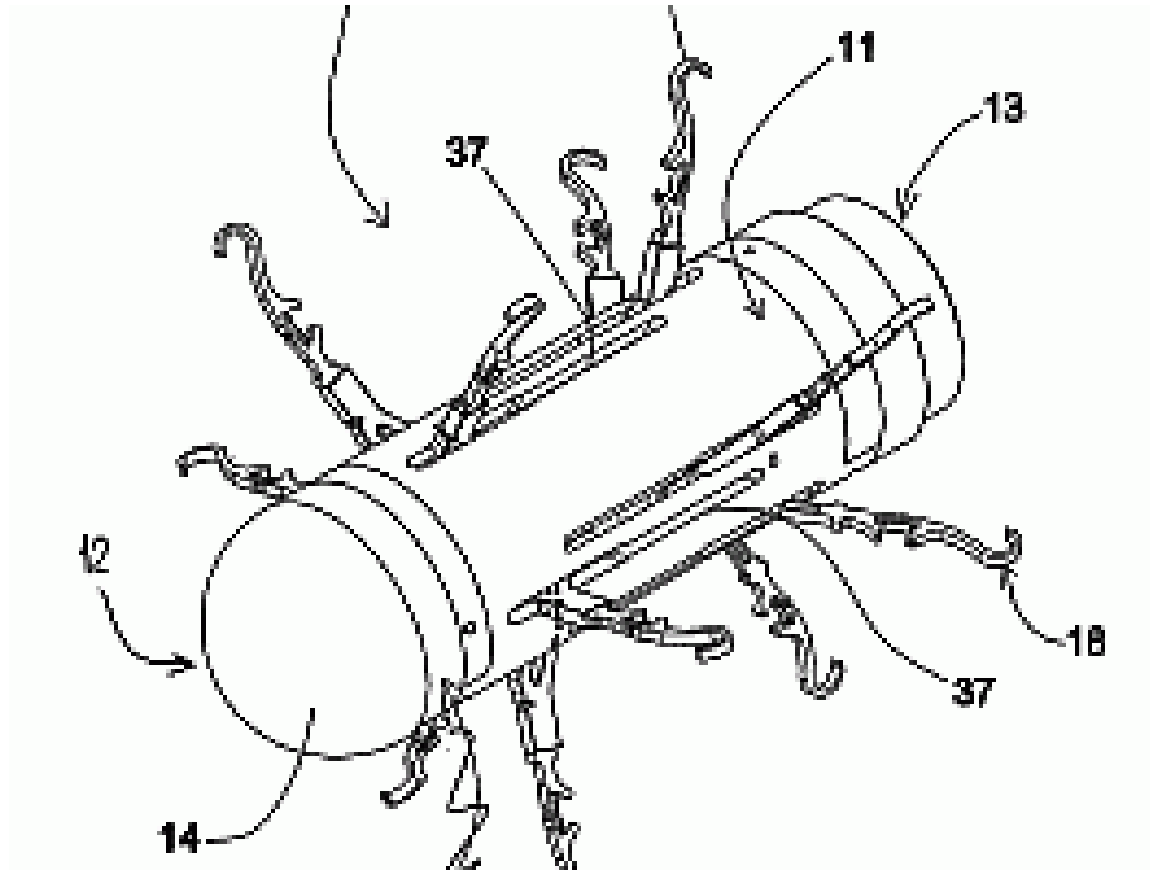
Ownership

Licensing options with respect to the IP – case to case basis

- License
 - Exclusive
 - First Right
 - Use dependent
 - Duration
 - Royalties
 - Territories
 - Industry
- Collaboration Agreement
- Post Research Phase



The Capsule Crawler Case Study



PCT/IT2007/000259

PCT Biblio. Data

Description

Claims

Drawings

National Phase

Notices

Doc

Latest bibliographic data on file with the International Bureau

Pub. No.: WO/2008/122997 **International Application No.:** [PCT/IT2007/000259](#)
Publication Date: 16.10.2008 **International Filing Date:** 04.04.2007
IPC: **A61B 1/05** (2006.01) (?)
Applicants: **SCUOLA SUPERIORE DI STUDI UNIVERSITARI E DI PERFEZIONAMENTO**
56127 Pisa, IT (AllExceptUS)
KOREA INSTITUTE OF SCIENCE AND TECHNOLOGY [KR/KR]; 39-1, Hawol
(AllExceptUS)
QUIRINI, Marco [IT/IT]; IT (UsOnly)
WEBSTER, Robert, J., III [US/US]; US (UsOnly)
MENCIASSI, Arianna [IT/IT]; IT (UsOnly)
DARIO, Paolo [IT/IT]; IT (UsOnly)
Inventors: **QUIRINI, Marco**; IT
WEBSTER, Robert, J., III; US
MENCIASSI, Arianna; IT
DARIO, Paolo; IT
Agent: **BARDINI, Marco Luigi** ; Società Italiana Brevetti S.p.A. Corso dei Tintori, 25 I-5
Priority Data:
Title **(EN)** TELEOPERATED ENDOSCOPIC CAPSULE
(FR) CAPSULE ENDOSCOPIQUE TÉLÉCOMMANDÉE
Abstract: **(EN)** Teleoperated endoscopic capsule for diagnostic and/or
therapeutic purposes inside a cavity in a human body, comprising a
body (11) having a front part (12) and a rear part (13), locomotion legs
(18) able to project from the body (11) and, moving means (19) for said
legs (18) housed in the same body (11), a source of energy (16),
means for image acquisition (15), means for reception/transmission of
signals (17) from and to an operator, for permitting capsule the control
and transfer of acquired images. The legs (18) are hinged to the body
(11) and are subdivided into two separate groups (20, 21). The moving
means (19) comprise two driving devices (22) each one comprising a
motor (23) connected to a corresponding worm screw (24) on which a
translatable nut screw cursor (25) is engaged. The nut screw cursor
(25) is kinematically connected to the legs (18) of a respective rou (20,

Milestones or Performance

Milestones

- Define Research in terms of work performance rather than outcome
- Progress Reports

- Stages of Research
 - Time
 - Work
 - Outcome
- Guarantee
- Indemnity
- Breach
- Termination
 - IP ownership
 - Confidentiality

Use of IP/ Commercialization

CSIR – Well Ahead
Quality Control

Enforcement

STC.UNM v. Intel Corp. 2013

- STC.UNM attempted to sue Intel for infringement of a patent.
- Patent was a continuation-in-part of an earlier patent application that was jointly owned by the University of New Mexico (UNM) and Sandia Corp.
- Terminal disclaimer, UNM and Sandia also co-owners
- Sandia refused to join the lawsuit
- There was no agreement between UNM and Sandia that required Sandia to do so.
- District court dismissed the case for a lack of standing
- Federal Circuit affirmed
- “as a matter of substantive patent law, all co-owners must ordinarily consent to join as plaintiffs in an infringement suit”

STC.UNM v. Intel Corp. 2013

- Reasoning - if only one co-owner sues, it effectively deprives the other co-owner of the right to sue and collect damages for infringement
- Courts refused to involuntarily join Sandia to the case as a necessary party
- Risks can occur if joint owners of a patent don't carefully specify
 - enforcement rights
 - obligations of both parties
- The requirement of non-enforcing co-owners to participate in the enforcement action when and if needed therefore need to be clear in collaborative agreements.

Other Concerns

- Data Access – Control of IP
- Freedom to Operate
 - Foreground IP
 - Background IP
- Maintenance of IP
- Legal Expenses
- Spin-offs
- Expert Poaching
- Disputes
 - Resolution via litigation
 - ADR

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THANK YOU

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