

International Collaboration: Elements of IP Agreement

Arun Srivastava

Secretary, Atomic Energy Commission
International Collaboration and Planning Division
DAE, India
arun@dae.gov.in

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International Collaboration: Broad Outline of Umbrella Inter-Government R&D Agreement

- Preamble – Identifying Parties, recognizing their existing capabilities and need
- Objective
- Areas of Cooperation
- Forms of Cooperation – exchange, joint programme etc
- Coordinating Committee and Executive Secretaries
- Implementation
- Availability and Dissemination of Information – for R&D work and outcome of joint research works in accordance with IP clause.
- **Intellectual Property**
- Exchanges of Personnel
- Exchanges of Equipment, Samples, etc.
- General Provisions – domestic laws, territory, respect for domestic and international commitments, **dispute settlement** etc
- Duration, Amendment and Termination

Source: The European Atomic Energy Community (EURATOM) and the Government of the Republic of India Agreement for Cooperation in the field of Fusion Energy Research



IP Annex is an integral part of Collaborative R&D Agreement

■ Intellectual Property

- The protection and allocation of intellectual property created or furnished in the course of cooperative activities under this Agreement shall be governed by the provisions in IP Annex, which shall form an integral part of this Agreement and shall apply to all activities conducted under this Agreement.



General Elements of IP Annex

- Application
- Ownership, Allocation and Exercise of Rights
 - Selection of International Law / Agreement
 - Technology Management Plan (TMP)
 - Participants in the joint research
 - Implementation
- Copyright Works
- Scientific Literary Works
- Undisclosed Information
- Dispute Settlement, New Types and Unforeseen Intellectual Property



Elements of IP Annex: It is important to identify rules for Ownership, Allocation and Exercise of Rights

■ Application

- is applicable to all cooperative activities undertaken pursuant to this Agreement, except as otherwise specifically agreed

■ Ownership, Allocation and Exercise of Rights

- “Intellectual Property” shall have the meaning found in Article 2 of the Convention establishing the World Intellectual Property Organisation (WIPO), done at Stockholm, 14 July 1967.
 - literary, artistic and scientific works,
 - performances of performing artists, phonograms and broadcasts,
 - inventions in all fields of human endeavor,
 - scientific discoveries,
 - industrial designs,
 - trademarks, service marks and commercial names and designations,
 - protection against unfair competition (infringement),

and all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields.

- Clearly establishes allocation of rights, interests and royalties between the Parties while respecting the national laws and practices.
- The termination or expiry of this Agreement shall not affect the rights or obligations arising under this Annex.
- IP arising from joint research, i.e. research supported by both Parties – Generally establishes a Technology Management Plan (TMP) and lays down principles for ownership.



A clear joint Technology Management Plan helps in settling creation and management of IP

■ Technology Management Plan (TMP) – some principles:

- The Parties shall notify each other **within a reasonable time** of any intellectual property rights arising under this Agreement .
- Unless otherwise agreed, rights and interests in IP created during joint research shall be **exploitable by either Party without territorial restriction**.
- Each Party shall **seek protection for the IP in a timely fashion**.
- Each Party shall have a **non-exclusive, irrevocable, royalty-free license to use any IP arising under this Agreement for research purposes only**.
- **Visiting researchers** having participated in the creation of IP shall receive IP rights and royalty shares **earned by the host institutions** from licensing of such intellectual property rights under the policies of the host institutions. **Each Party shall accord to the visiting researchers no less favourable treatment than that it accords to its own nationals** with regard to the grant of the aforementioned intellectual property rights and royalty shares. In addition, **each visiting researcher named as an inventor shall be entitled to treatment as a national of the host Party with regard to awards, bonuses, benefits, or any other rewards**, in accordance with the policy of the host institution and the respective laws of the Parties applicable thereto.



It is important to indentify the rights of individual participants in joint research team

■ Participants in the joint research:

- To the extent required by its laws and regulations, each Party shall require all its participants to enter into specific agreements concerning the implementation of joint research activities and the respective rights and obligations of the participants.
- With respect to intellectual property, the agreements will normally address, among other things, ownership, protection, user rights for research purposes, exploitation and dissemination, including arrangements for joint publication, the rights and obligations of visiting researchers and dispute settlement procedures. The agreements may also address other issues such as access to foreground and background information, licensing and deliverables.

■ Implementation

- While maintaining the conditions of competition in areas affected by this Agreement, each Party shall endeavour to ensure that rights acquired pursuant to this Agreement and arrangements made under it are exercised in such a way as to encourage, in particular, (i) the use of information created under the Parties' domestic laws governing the treatment of sensitive or confidential information in the nuclear field, and (ii) the adoption and implementation of international standards.



Elements of IP Annex: Copyright and Scientific Literary Works

■ Copyright Works

- copyright belonging to the Parties shall be accorded treatment consistent with the **Agreement on Trade-Related Aspects of Intellectual Property Rights** administered by the World Trade Organization.

■ Scientific Literary Works (i.e. non-IP works)

- Each Party shall be entitled to a non-exclusive, irrevocable, royalty-free license in all countries to translate, reproduce and publicly distribute information contained in scientific and technical journals, articles, reports, books, or other media, directly arising from joint research pursuant to this Agreement by or on behalf of the Parties.
- All publicly distributed copies of a copyrighted work prepared under this provision shall indicate the names of the authors of the work unless an author explicitly declines to be named. They shall also bear a clearly visible acknowledgment of the cooperative support of the Parties.



Elements of IP Annex: Documentary and Non-Documentary Undisclosed Information

■ Undisclosed Information

■ Documentary Undisclosed Information

- Each Party shall identify at the earliest possible moment the information that they wish to remain undisclosed in relation to this Agreement, taking account, *inter alia*, of the following criteria:
 - the information is secret (Background IP)
 - the Parties may in certain cases agree that, unless otherwise indicated, parts or all of the information provided, exchanged or created in the course of joint research pursuant to this Agreement may not be disclosed.
- Each Party shall ensure that undisclosed information is readily recognisable as such by the other Party, for example, by means of an appropriate marking or restrictive legend.
- Undisclosed information communicated under this Agreement may be disseminated by the receiving Party on a-need-to-know basis.



Non-Documentary Undisclosed Information control is one of the most difficult aspect for Parties

■ Non-Documentary Undisclosed Information

- Non-documentary undisclosed or other confidential or privileged information provided in seminars and other meetings arranged under this Agreement, or information arising from the attachment of staff, use of facilities, or joint projects, shall be treated by the Parties or their designees according to the principles specified for documentary information in this Agreement, provided, however, that the recipient of such undisclosed or other confidential or privileged information has been made aware in writing of the confidential character of the information communicated not later than the time such a communication is made.

■ Control

- Each Party shall endeavour to ensure that undisclosed information received by it under this Agreement shall be controlled as provided herein.



Establishment of procedure for Dispute Settlement in advance is helpful in successful R&D collaboration

- Dispute Settlement, New Types and Unforeseen Intellectual Property
 - Disputes between the Parties concerning IP shall be resolved in accordance with Article ###(on Dispute Settlement) of the Agreement.
 - However, upon mutual agreement of the Parties, such a dispute may be submitted to an international arbitral tribunal for binding arbitration in accordance with the applicable rules of international law. Unless otherwise agreed, the arbitration rules of UNCITRAL (United Nations Commission on International Trade Law) shall govern.
 - In the event either Party concludes that a new type of intellectual property not covered in a TMP or agreement between designated entities may result from a cooperative activity undertaken pursuant to this Agreement, or if other unforeseen difficulties arise, the Parties shall enter into immediate discussions with the object of assuring that the protection, exploitation and dissemination of the intellectual property in question are adequately provided for in their respective territories.



Conclusion

- For any Collaborative work, especially in the international forum, IP Annex is becoming an important, inseparable part of Collaboration Agreement.
- It is important to identify and define major IP related issues and their treatment, well in advance, in order to have successful collaborative research work.
- Most delicate aspects relates to the handling of Undisclosed information (Background IP in particular) which each Party carry with it. Grounds for their sharing needs to be clearly defined either at the TMP level or in the Agreement itself.
- **In-spite of all the above, it is important that all R&D Institutions in the world should collaborate to give people of this world a better place to live. IP sharing should not become a barrier, rather it should be a facilitator in this endeavour.**



Thank You