

# INTERNATIONAL PROJECT ON INNOVATIVE NUCLEAR REACTORS AND FUEL CYCLES (INPRO)

## ***Break-out Sessions on the Topic 2:***

# ***Intellectual property management within the context of collaboration on innovations***

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**IAEA**

International Atomic Energy Agency

# Key points, major observations and conclusions



## 1. Particular aspects of IP management within the context of collaboration on innovations in the nuclear field:

1. Profound differences in the IP laws in different countries in nuclear field;
2. Differences in IP Policies in different countries / organisations;
3. Cross-border as well as domestic licensing of IP in the nuclear field has certain restrictions due to special treatment of nuclear materials ( e.g. IAEA Safeguards, industry restrictions, EURATOM);
4. Issues related to development, protection and transfer of technology of dual-use items (e,g, nuclear vs non-nuclear components. Within nuclear – military and civil use).

# Key points, major observations and conclusions (cont'd)



## 2. How to handle IP – Background and Foreground:

### 1. Background IP:

1. Define Background IP (including IP that is necessary for exploitation of results);
2. Understand and agree on the terms to be applied to its use before commitment is made to the project;
3. Importance on declaration of background IP;

### 2. Foreground IP:

1. Early identification of protectable IP and decision to protect or not;
2. Clear definition on who pays, owns and right to use foreground IP;
3. Mechanism to file IP (e.g. territory, joint or individual, etc);
4. Mechanism to manage IP (e.g. licensing, exploitation of IP, arbitration mechanism etc);
5. Enforcement and defence measures (through exploitation / implementation committee)
6. Liability / indemnification policy related to licensing

# Key points, major observations and conclusions (cont'd)



## 3. Prerequisites for successful management of IP:

### 1. Legal and Organisational structure:

1. IP Policy endorsed and enforced by top management;
2. Creating and maintaining IP awareness including training staff;
3. Recognition of the importance of IP management in the organisation
4. Integrating IP process in goals of the organisation (maximising dissemination or income);
5. Effective implementation of IP policy through regulations, guidelines, templates, etc.

### 2. Adequate funding:

1. IP Management is a costly activity and hence sufficient and regular budget should be available to support its activities;
2. Commitment of top management to bear the cost of IP Management is a must.

# Key points, major observations and conclusions (cont'd)



## 3. Prerequisites for successful management of IP:

### 3. Human Capital:

1. Skilled (technical, commercial and legal) manpower necessary for IP management and exploitation;
2. Adequate training and re-training of manpower necessary.

### 4. Specialised IP tools:

1. IT enabled IP information and decision support system including electronic databases (connect IP to technology, valuation of IP etc)
2. Tools to process prior art and patent landscaping (search engines) should be available;
3. Outsourced IP service providers.

# Key points, major observations and conclusions (cont'd)



## 4. Harvesting and incentivization system:

1. Incentivization of individual is a must for innovation. It could be in terms of recognition or revenue depending upon the Institutes mission / company's policy;
2. Harvesting of IP should be based on Institutes mission / company's policy;
3. Incentivise the company by giving right to IP (ownership, exploitation etc) or rewards, as appropriate in the IP Policy.

## 5. Technology transfer contracts and licensing, and other ways of extracting value of IP:

1. IP as tradable commodity can be sold, asset for the companies,
2. Use in collaborative agreements as background IP;
3. Raises Company's prestige;
4. Using it for scientific research purpose



# Key points, major observations and conclusions (cont'd)



## 6. Collaboration Vs Competition and related IP issues:

1. In collaboration, sharing of IP for achieving end goal whereas in competition, IP's compete for their use in collaborative agreement;
2. Elements of IP protection facilitate collaboration - as partners can cooperate in security;
3. A competitive position drives the need for careful IP protection and its exploitation;
4. Collaboration offers the possibility of reducing the need for IP protection
5. Notwithstanding the above, Parties need to be able to protect their position in the event that the collaboration collapses or terminates.
6. In collaboration, IP acts as life insurance against unfaithful behaviour of your collaborator.

# Key points, major observations and conclusions (cont'd)



## 7. IP infringements: enforcement and prevention:

1. IP infringement enforcement is a costly affair and hence be realistic about the money you are prepared to pay;
2. For prevention of infringement and prevention of enforcement against you, build a strong strategic IP portfolio (strategic both with regard to technology coverage and territorial coverage);
3. Decision to enforce would depend upon the value of the product market, time required for enforcement, life cycle of the product, legal system etc.;
4. Build a reputation of rigorous enforcement.

## 8. Confidentiality Versus Transparency:

1. In collaboration transparency with IP protection is the best practice whereas outside the collaboration, confidentiality could be practiced.



# Thank you