



African Regional Intellectual Property
Organization



FACILITATING THE USE OF IP FOR DEVELOPMENT - THE IMPORTANCE OF INSTITUTIONAL IP POLICIES AND STRATEGIES FOR UNIVERSITIES IN AFRICA

WIPO-ARIPO PROJECT FOR ELABORATION OF GUIDELINES FOR DEVELOPMENT OF INSTITUTIONAL IP POLICIES AND STRATEGIES

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**Presentation at WIPO Forum on Strengthening IP Management in African
Universities**

20th October 2018

ACKNOWLEDGEMENTS

- The WIPO-ARIPO Project on “[Elaboration of Guidelines for IP Policy and Strategy Development by Universities and Research Institutions in Africa](#)” is supported by the Japan Patent Office (JPO) under the arrangements of the Funds-in Trust (FIT) for Africa and Least Developed Countries.
- Development of the Guidelines was undertaken by Consultants engaged by WIPO, namely:
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PRESENTATION OUTLINE

- Introduction
- Rationale for institutional IP policies and strategies.
- Scope of IP covered
- Definitions
- Formulation & implementation of institutional IP policies
- Ownership, Disclosure & Commercialization of IP
- IP benefit sharing
- TK, TCEs and Biological Resources
- Creation of IP awareness
- IP dispute resolution
- Guidelines on IP stakeholder obligations
- Critical factors informing institutional IP policy development process
- Institutional IP policy development steps

INTRODUCTION

- The Guidelines for IP Policy and Strategy Development by Universities and Research Institutions in Africa were completed and validated in 2017.
- Formulation of the Guidelines was aimed at fostering more effective use of the existing IP System.
- The initiative has been undertaken in recognition of the stark reality that most African Universities and R&D Institutions are predominantly engaged in teaching and basic research and missing out on the opportunity to become the birthplaces of pioneering discoveries, innovations and inventions that can enhance the quality of lives of millions of Africans.
- The use of institutional IP policies for proper identification, generation, protection and exploitation of IP assets is now indispensable.

INTRODUCTION...

- The goal of the project is to avail Universities and R&D Institutions with guidelines that can assist them establish appropriate institutional IP policies and strategies that can encourage and enable them to more effectively and equitably generate and exploit IP assets, in a manor that is aligned with their core mission priorities, while at the same time cognizant of prevailing national, regional and international legal frameworks that govern issues of;
 - IP Ownership (e.g. among students, researchers and third parties)
 - IP Exploitation (e.g. disclosure, commercialization and exploitation through spin-out companies)
 - Benefit Sharing (e.g. income sharing and recognition of IP as a criterion for academic promotion)

INTRODUCTION...

- For example, if the mission priority is **education and dissemination of knowledge**, then the institutional IP policy should favor faculty ownership or release of IP into the public domain, with less emphasis on IP protection.
- Conversely, if **R&D** is the mission priority, then the institutional IP policy should favor control and exploitation of IP (e.g. through flexible licensing of rights).
- Similarly, if the mission priority is **technology transfer and commercialization**, then the institutional IP policy should favor greater control and exploitation of IP (e.g. through exclusive licensing of rights in order to induce commercialization through private investment), more-flexible royalty sharing with inventors to induce disclosures and selection of the best commercial partners for any given invention or innovation.

INTRODUCTION...

- Finally, if the mission priority is **socioeconomic development**, then the institutional IP policy should favor balanced ownership and exploitation of IP. An effective avenue in this case is licensing IP to national companies for **creation of local innovation-based spin-out companies** through initiatives such as incubation.
- The fundamental aim of the Guidelines is to **promote critical thinking and deepen understanding on how best to address IP issues within the context of African Universities and R&D Institutions**.

RATIONALE FOR DEVELOPMENT OF INSTITUTIONAL IP POLICIES & STRATEGIES

- Encouraging identification, generation, protection and commercialization of IP created by staff, researchers, students, collaborators, visitors and partners.
- Ensuring research findings, inventions, innovations and creative works are used for the benefit of the public/society.
- Promoting progress in R&D, technology transfer and innovation.
- Outlining modalities and mechanisms through which staff, researchers, students, collaborators, visitors, partners and other stakeholders can **equitably/fairly protect the IP they create**, for both their benefit and socioeconomic transformation.
- Alignment with National, Regional and International IP Policies and Strategies, for better linkage with support that can accrue.

SCOPE OF IP COVERED

- The Guidelines pertain to all forms of IP rights that currently exist and include;
 - **Copyright works** as defined by the Copyright Act or Law of the University/Research Institute home country.
 - **Inventions** including both products and processes which may be patentable under the Patents Act or Law of the University/Research Institute home country.
 - **Patents**, whether standard, provisional, application as defined in the Patents Act or Law of the University/Research Institute home country.
 - **Utility Models**
 - **Industrial Designs**

SCOPE OF IP COVERED...

- **Plant varieties** qualifying for rights under the Plant Breeders' Rights Act or IP law of the University/Research Institute home country.
- **Trademarks** whether registered or not as defined by the Trade Marks Act or IP Law of the University/Research Institute home country.
- **Eligible layouts** as defined by the Circuits Layouts Act or IP Law of the University/Research Institute home country.
- **Designs** as defined by the Designs Act or IP Law of the University/Research Institute home country.
- **Confidential information** as pertains to any information protected by law either contractual or equitable.

SCOPE OF IP COVERED...

- All IP owned or managed by the University/Research Institute.
- Any other relevant forms of IP not expressly dealt with in the Guidelines.
- The Guidelines seek to attend to measures for effective management and use of IP owned by, and/or created within the University/Research Institute, be it in research, teaching, commercialization or other activities. They also pertain to the use of Third Party IP, to ensure freedom of use for the University's/Research Institute's activities.

DEFINITIONS

- The Guidelines provide indicative* definitions for various IP-related words, terms and expressions for purposes of easing understanding of content and aiding the use of appropriate terminologies during formulation of University/Research Institute policies.

*It is therefore, recommended that in using these Guidelines each University/Research Institute contextualizes the definition applied according to its own/unique mission and environment.

GUIDELINES ON FORMULATION & IMPLEMENTATION OF INSTITUTIONAL IP POLICIES & STRATEGIES

- An IP Advisory Committee should be established prior to commencement of the IP Policy/Strategy development process.
- The IP Advisory Committee should be structured according to the principles and objectives of the Policy/Strategy and the management system of the University/Research Institute and should include representatives of all key stakeholders.
- The IP Advisory Committee should have the following functions:
 - Reviewing issues related to existing & proposed IP management matters and policies/strategies.
 - Making recommendations on amendments to IP policies/strategies.
 - Managing disputes arising directly from implementation of the IP policy/strategy.

GUIDELINES ON FORMULATION & IMPLEMENTATION OF INSTITUTIONAL IP POLICIES & STRATEGIES...

- Providing guidance and advice to the institution on matters involving institution-owned IP.
 - Handling disputes involving institution-owned IP and making recommendations towards their resolution.
 - Resolving issues related to ownership of IP generated at the institution.
 - Assisting the management of the institution in increasing IP awareness within its community.
 - Performing such other responsibilities as required to comply with National laws in regard to the institution's IP policy/strategy and assets.
- The IP Advisory Committee should meet regularly (e.g. Quarterly).

GUIDELINES ON FORMULATION & IMPLEMENTATION OF INSTITUTIONAL IP POLICIES & STRATEGIES...

- An IP Management Office (IPMO)/Technology Transfer Office (TTO) should be established.
- The **duties and responsibilities** of the IPMO/TTO should be related to managing processes related to; disclosure, protection, commercialization, monitoring and awareness of IP.
- The IPMO/TTO should have the following functions:
 - Fostering sustained public support for research by demonstrating public/social benefits (e.g. new products and services).
 - Stimulating industrial and private sector support for research.
 - Fostering community engagement by supporting job and enterprise creation.
 - Assisting researchers and students attain entrepreneurial skills and mind-set.

GUIDELINES ON FORMULATION & IMPLEMENTATION OF INSTITUTIONAL IP POLICIES & STRATEGIES...

- Advising the institution on IP-related matters.
- Making recommendations on amendments to the institutional IP Policy.
- Providing guidance and assistance on matters involving University/Research Institute-owned IP.
- Keeping a register of protected IP, together with records of income generated.
- Establishing a system for providing guidance to staff about IP management at the earliest possible stage in the invention/innovation process, in order to maximize the potential for development of appropriate IP opportunities which may include commercial exploitation.
- Ensuring compliance with the IP provisions of the institution and sponsored research grants and contracts.

GUIDELINES ON FORMULATION & IMPLEMENTATION OF INSTITUTIONAL IP POLICIES & STRATEGIES...

- Assisting all those affected by the IP policy with information on procedures for recording IP activity in a manner that meets internal institutional requirements, while at the same time satisfying the requirements of external organizations.
- Guiding all institutional IP policy stakeholders to appropriate IP management tools (e.g. advisory leaflets; IP registration, evaluation, confidentiality forms), in order to ensure effective IP management.
- Encouraging all institutional IP policy stakeholders to issue notices of IP rights related to ideas or other forms of IP that they may have developed at the earliest opportunity and before disclosure to any Third Party outside the institution either orally or in writing.
- Scrutinizing and reviewing all funding and service level agreements for appropriate references to IP rights and where appropriate, negotiate IP agreements and ownership, prior to signing.

GUIDELINES ON FORMULATION & IMPLEMENTATION OF INSTITUTIONAL IP POLICIES & STRATEGIES...

- Working with external organizations to ensure the effective management and exploitation of the institution's IP for the purposes of income generation, technology transfer and stimulation of local and regional economic growth.
- Creating systems and implementing procedures for reporting IPs in which the institution has a proprietary interest.
- Performing initial assessments of disclosures submitted to the institution for purposes of determining subsequent rights thereto.
- Providing procedures for disclosures based on an incentive scheme that specifies an adequate share of benefits for researchers in the IP commercialization transaction terms of the IP policy.
- Promoting IP awareness and training among the institution's community.

GUIDELINES ON FORMULATION & IMPLEMENTATION OF INSTITUTIONAL IP POLICIES & STRATEGIES...

- Providing services that facilitate the management, evaluation, protection, marketing and commercialization of the institution's IP, through internal and/or external resources, including but not limited to patent management agents, consultants and lawyers.
- Ensuring that required agreements related to the administration of IP are concluded for all activities where the institution has a proprietary interest, and consequent rights of all parties concerned are properly executed.
- Performing other responsibilities as required to comply with National laws with regard to the institution's IP policy and assets.
- Preparing annual IP reports for the institution.

GUIDELINES ON OWNERSHIP OF IP

■ Principles

- The institution should recognize that the its Employees', Researchers', Visitors', Partners' and Students' activities may result in innovative and creative outputs.
 - National laws provide that the **creator of the work is the first owner of the IP rights.**
 - Accordingly, **ownership of IP created in a University /Research Institute belongs to that University/Research Institute.** However, the inventors/creators should retain the right to be **named & share the benefits derived from exploitation of the IP.**
- The institution should be cognizant of the various modes of IP ownership and exercise them as appropriate, on a case by case basis that **accommodates the specific circumstances surrounding how the IP is generated.**

GUIDELINES ON OWNERSHIP OF IP...

■ Modes of IP Ownership

- **Creator-Owned IP** - creators may retain full ownership of IP rights provided the following conditions are met:
 - ❖ IP is not subject to a sponsored research or other agreement requiring ownership to belong to another party, including a University/Research Institute.
 - ❖ IP was not conceived, created, developed, or first reduced to practice with significant use of University/Research Institute support.
 - ❖ IP was not conceived, created, developed or first reduced to practice as a direct result of formal duties at the University/Research Institute.

GUIDELINES ON OWNERSHIP OF IP...

■ Modes of IP Ownership

- **Ownership of IP Created by Students/Interns/Apprentices** - all works created by students/interns/apprentices during the course of their study at the University/Research Institute should **belong to the University/Research Institute provided** that the students/interns/apprentices:
 - ❖ Use substantial University/Research Institute resources.
 - ❖ Use University/Research Institute-owned IP.
 - ❖ Receive project-specific funding from the University/Research Institute or a third party engaged by the University/Research Institute.
 - ❖ Use IP owned by another employee of the University/Research Institute.
 - ❖ Participate in a University/Research Institute Project.

GUIDELINES ON OWNERSHIP OF IP...

■ Modes of IP Ownership

- **University/Research Institute-Owned IP** - the University/Research Institute retains full ownership of rights to:
 - ❖ IP subject to the terms of a sponsored research or other agreement that grants the University/Research Institute rights of ownership.
 - ❖ IP whose conception, creation, development or first reduction to practice involved significant use of University/Research Institute support.
 - ❖ IP that was conceived, created, developed or first reduced to practice as a direct result of University/Research Institute duties.
 - ❖ Any physical object embodying University/Research Institute IP.
 - ❖ Copyrighted material created as a “work made for hire” by operation of Copyright Law or pursuant to a written agreement transferring copyright to the University/Research Institute.

GUIDELINES ON OWNERSHIP OF IP...

■ Modes of IP Ownership

➤ University/Research Institute-Owned IP...

- ❖ IP derived from R&D conducted by researchers (e.g. adjunct professors, emeritus professors, post-doctoral associates, casual staff and other visitors) directly appointment or assigned responsibility by the University/Research Institute, including through participation in research projects, collaboration with other staff, supervision of students of the Research Institute/University, or while they utilize Research Institute/University resources or facilities.
- ❖ All IP created in the course of postgraduate (masters and doctoral) students' research activities.
- ❖ IP created by University/Research Institute employees, if said IP was created within the scope of their employment or by written agreement with the University/Research Institute.
- ❖ All courses developed for teaching at the University/Research Institute.

GUIDELINES ON OWNERSHIP OF IP...

- Guidelines on ownership of IP further elaborate modalities for the sharing of benefits of IP arising from:
 - Sponsored Projects/Collaborative and Contract Research.
 - Research Conducted Outside the University/Research Institute.
 - Consulting Agreements and Other Business Activities.
- Guidelines on ownership of IP also offer direction on the use of other Specific Types of IP such as those related to:
 - ❖ Teaching and Learning Materials
 - ❖ Software
 - ❖ Databases
 - ❖ Research materials
 - ❖ Theses and Dissertations
 - ❖ Surrender/Assignment of Rights to Inventors/Creators
 - ❖ IP belonging to Third Parties

GUIDELINES ON DISCLOSURE OF IP

- The University/Research Institute office or structure responsible for IP should identify and encourage the disclosure of information acquired by researchers in the course of carrying out research which could potentially lead to IP assets.
- To this end, the University/Research Institute should:
 - Ensure that a system is put in place to assist persons covered under the institution's IP policy to disclose any information acquired, developed or accessed while dealing with or using University/Research Institute resources.
 - Ensure that IP Disclosure Forms are designed and available for inventors and researchers.
 - Ensure that information disclosed is kept confidential.
 - Ensure that those who access or deal with the disclosed information sign separate undertakings that bind them not to disclose the said information to third parties unless authorized in writing by the University/Research Institute IP office, in consultation with the researcher.

GUIDELINES ON COMMERCIALIZATION OF IP

- The University/Research Institute should take necessary and appropriate measures to commercialize its protected IP assets.
- **Commercialization of IP assets** should be pursued through the following non-exhaustive routes details of which are provided in the Guidelines:
 - **Licensing** - of rights to IP against payment of royalties.
 - **Assignment** - of rights to a third party against a one-off payment.
 - **Self-exploitation** - of IP rights through establishment of a spin-off company.
 - **Joint venture** - seeking of private partners to jointly commercialize IP assets.

GUIDELINES ON IP BENEFIT SHARING

- The University/Research Institute should provide incentives to Inventors/Creators by equitably distributing revenue generated from the commercialization of IP.
- The University/Research Institute should recognize IP as a criterion for the promotion of the researchers (alongside publications) and should review and implement promotion guidelines that take IP Applications, Grants and Commercialization into account.
- Guidelines on IP benefit sharing elaborate modalities for equitable distribution of revenue generated from the commercialization of IP.

GUIDELINES ON TRADITIONAL KNOWLEDGE AND TRADITIONAL CULTURAL EXPRESSIONS

- The University/Research Institute should:
 - Recognize the role of Traditional Knowledge (TK), Traditional Cultural Expressions (TCEs) and Genetic Resources in the development of inventions, innovations, new plant varieties and creative works.
 - Endeavour to facilitate the identification, documentation and protection of TK and TCEs of local and indigenous communities.
 - Be guided by national, regional and international policies, laws and regulations with regard to the use of TK and TCEs, access to genetic resources, and sharing of associated benefits with holders of such knowledge.
 - Obtain **necessary permits** and **prior informed consent** and **disclose the origin and/or source** of any TK, TCEs and genetic resources in its IP applications.

GUIDELINES ON CREATION OF IP AWARENESS

- The University/Research Institute should:
 - Promote IP awareness through seminars, conferences, symposia, colloquia, workshops and any other appropriate means, as circumstances allow.
 - Encourage each faculty/college/division/unit to incorporate IP as one of the compulsory/elective courses in its curriculum.
 - Encourage the development of IP awareness promotion materials.
 - Enter into strategic partnerships with appropriate institutions for the promotion of IP.

GUIDELINES ON IP DISPUTE RESOLUTION

- The University/Research Institute should **establish dispute resolution mechanisms** to resolve any disputes that may arise in the course of implementation of its IP policy.
- These mechanisms may include the following:
 - Referring internal disputes or questions of interpretation arising from institutional IP policy implementation to the University/Research Institute **IP Advisory Committee** for resolution, at the request of any interested party.
 - Encouraging affected parties to **use Mediation and Arbitration means to resolve disputes** without going to court.

GUIDELINES ON IP STAKEHOLDER OBLIGATIONS

- The University/Research Institute should:
 - Acknowledge the importance of transferring its IP in an appropriate and cost-effective manner and establish efficient mechanisms for technology transfer, in order to maximize the value of technologies it develops.
 - Provide oversight of IP management and technology transfer processes, in order to ensure adherence to its established policies.
 - Assist its stakeholders in establishing and maintaining effective technology transfer mechanisms.
 - Ensure divisional policies and procedures are consistent with its IP policy.
 - Provide legal services and cooperate with its stakeholders in promoting and licensing IP.
 - Take appropriate actions to protect its IP.
 - Establish mechanisms and procedures to minimize disputes conflicts of interests.

GUIDELINES ON IP STAKEHOLDER OBLIGATIONS

- Inventors and Creators should:
 - Disclose IP created to appropriate University/Research Institute/University authorities and offices.
 - Conduct technology transfer activities in a manner consistent with established University/Research Institute policies and procedures, including those governing conflicts of commitment and interest.
 - Cooperate with the University/Research Institute in defending and prosecuting IP and in legal actions taken in response to infringement.

GUIDELINES ON OTHER IP CONSIDERATIONS

- Guidelines on other key IP considerations are provided including:
 - Regular monitoring and periodic review institutional IP policy implementation, in order to take into account emerging changes and issues at institutional, national, regional and international levels.
 - Develop appropriate and effective mechanisms to manage conflicts of interest and commitment that may arise during implementation of the IP policy.

CRITICAL FACTORS INFORMING INSTITUTIONAL IP POLICY DEVELOPMENT PROCESS

- The Guidelines outline critical factors that should inform the institutional IP policy development process. These include but are not limited to:
 - Motivation for developing the policy.
 - Timeframe for policy development and implementation.
 - Level of commitment to develop and utilize the policy.
 - Capacity to persuade management and staff on policy value.
 - Identification and selection of key personnel to participate.
 - Comprehensive stakeholder engagement.
 - Careful choice of approach applied for development of the policy.
 - Proper understanding of the institution's needs.
 - Analysis of internal and external activities in respect to how they are affected by the policy.
 - Continuous and iterative discussion and analysis of policy provisions as relates to the institution's overall mission.

INSTITUTIONAL IP POLICY DEVELOPMENT STEPS

- The Guidelines articulate the discrete steps that should be taken towards development of an appropriate institutional IP policy.
- These are:
 - Information gathering.
 - Iterative analysis and discussion of acquired information.
 - Policy formulation/drafting.
 - Policy validation
 - Policy adoption.
 - Policy implementation - includes public announcement and dissemination!
 - Policy monitoring and evaluation – critical evaluation and review.
- Annexes to the Guidelines provide **indicative template forms** for:
 - IP Assignment/Agreement

ANNEXES TO GUIDELINES FOR IP POLICY FORMULATION

- Annexes to the Guidelines provide **indicative template forms** for use as a starting point for institutions. Templates provided include:
 - IP Assignment/Agreement
 - Non-Disclosure Agreement
 - IP Disclosure
- Also annexed are **Guidelines on the interface between IP and Consultancy Services**



WHY IS ALL THIS IMPORTANT?!

THANK YOU FOR YOUR KIND ATTENTION

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