

THE LAMBERT TOOLKIT

Easing the Path to University and Industry Collaboration

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Lambert Toolkit

- The Lambert Report 2003
 - Barriers to university/industry research collaboration – time, effort, cost of putting agreements in place
 - Recommendation - series of model agreements
 - Methodology - negotiation by small group of industry and academic practitioners - real experience of negotiating contracts, not theory (legal or otherwise)
- Lambert Toolkit
 - www.innovation.gov.uk/lambertagreements

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- One size does not fit all – 57 varieties
- Different approaches/spectrum of solutions
- Starting point/negotiation
- Ease/speed the process - not solve every issue
- Not cover every scenario
- Workable and reasonable compromise
- Pick and mix - more experienced

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- 5 Model One to One Research Collaboration Agreements
- 3 Model Consortium Agreements
 - Emphasis on maximising innovation
 - Consortium 2 and 3 fit with DTI Technology Programme funding terms
 - Useful without public funding
- Guidance Notes
- Heads of Terms/Outline
- Decision Guide
- Useful resources
 - Other agreements
 - Links to other websites

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- Model 1 – One to One
- **University owns IP in Results**
 - University grants non-exclusive licence to Sponsor to use for any purpose in the field/territory

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- Model 2 - One to One
- University owns IP in Results
 - University grants non-exclusive licence to Sponsor to use for any purpose in the field/territory
 - Sponsor has opportunity to negotiate exclusive licence

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- Model 3 – One to One
- University owns IP in Results
 - University grants non-exclusive licence to Sponsor to use for any purpose in the field/territory
 - Sponsor has opportunity to negotiate assignment

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- Model 4 – One to One
- Sponsor owns IP in Results
 - Assignment of IP
 - University may use for academic purposes (teaching and research)
 - Academic Publication

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- Model 5 – One to One
- Sponsor Owns IP in Results (Contract Research)
 - Assignment of IP
 - University may NOT use for academic teaching and academic research
 - University has NO right to publish

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- Common issues/clauses
 - Project Description/Management
 - Retrospective Effect
 - Sponsor's Financial Contribution
 - External Funding
 - Use of Background
 - Confidentiality -vs- Academic Publication/Freedom of Information
 - Warranties/Liability
 - Boiler Plate/General

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- Consortium 1
 - Each member owns IP in Results it creates
 - Grants each of the others a non-exclusive royalty free licence to use its Results for the Project
 - Grants each of the others a non-exclusive royalty free licence to use its Results for any other purpose
 - Any member of the Consortium may exploit any of the Results
 - Suitable for collaborations funded by RDAs

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- Consortium 2
 - Lead Exploitation Party best suited to exploit Results
 - Other parties assign IP in Results to LEP
 - Alternatively, other parties grant a worldwide exclusive licence (more suitable where the LEP is SME)
 - LEP undertakes to exploit
 - LEP pays other members revenue share/success payment
 - Non-exclusive licence back (and non-exclusive licence of LEP's Results) to other parties for the purposes of the Project and internal (including group companies) use

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- Consortium 3
 - Different parties best placed to exploit different Results
 - Different core businesses/interested in different Results
 - Each takes assignment of Results germane to its core business
 - Undertaking to exploit Results to comply with Funding Terms
 - Grant a non-exclusive licence to use Results for the Project and for internal (including group companies) use

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- Consortium Agreements additional issues
 - Joint ownership of IP (Only Consortium Agreement 1)
 - Project Management
 - External Funding
 - Lead Party (banker)
 - Lead Exploitation Party
 - Expulsion/termination

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- Keys to having the right agreement:
 - Understanding the issues (Guidance notes/Education)
 - Communication - internal and external (Outline)
 - Reaching real agreement on the principles (Outline)
 - Choosing the right Model Agreement (Decision Guide)
 - Amending where necessary
 - Using a different agreement!

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- Guidance Notes explain:
 - Models and approaches
 - Rationale for some provisions
 - Confidentiality of Background/Academic Use/Publication
 - Importance of some provisions
 - Schedule 2 (Project Description)
 - Legal issues
 - Warranties/Liability
 - Freedom of Information/Charitable Status
 - Intellectual Property
 - State Aids
 - VAT/R&D Tax Credits

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- Outline (Heads of Terms)
 - The Project
 - Sponsor's Financial Contribution
 - Background
 - Ownership and exploitation of Results
 - Confidentiality
 - Academic use and publication
 - Warranties and Liability
 - Termination

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- Decision Guide
- Series of Questions to identify which Model Agreement provides most appropriate starting point
- Key Elements/Criteria
 - Ownership and rights to use Results
 - Sponsor's financial and other contributions
 - University's use of Results for academic purposes

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- Decision Guide
 - Not set in tablets of stone
 - Over simplification?
 - May not produce definitive answer
 - Help develop a “feel”
 - Inspired CREST – www.ec.europa.eu/invest-in-research/policy/crest_cross_en.htm
 - University perspective?
 - Industry and other universities - different considerations/questions?
 - Danish experience

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- Decision Guide - Whose project is it?
 - Did Sponsor commission Project?
 - Is it critical to Sponsor's technology strategy?
 - Does Project rely on Sponsor's Background?
 - Would Project be difficult/impossible without access to Sponsor's Background?
 - Is focus research based on Sponsor's Background?
 - Did Sponsor take lead in designing work plan?
 - Is Sponsor setting deliverables?
 - Can Project be ring-fenced from University's other research activities?

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- Useful Resources
- Agreements/Documents
 - Not “endorsed”, but considered
 - Give an ideas/starting point
 - Terms “reflect” Model Agreements
 - Patent and Know how Licence
 - Patent Assignment
 - Non Disclosure Agreement
 - Materials Transfer Agreement
 - Equipment Loan Agreement
 - Consultancy Agreement

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- Very early feedback (year 1)
- Association for University Research & Industry Links (AURIL) Survey
 - 72% - Agreements simplify process
 - 61% - Agreements save time
 - 55% - Financial savings/savings in resources
 - 58% - Used elements in own contracts
 - 60% - Positive feedback from industry
 - Agreement 4 most commonly used
 - Over 50% used Agreement 3
 - Closely followed by Agreement 1

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- Feedback
- Guidance notes particularly useful to SMEs/inexperienced universities
- GSK – over 60 and counting (some overseas - China)
 - Mostly Model 1 or 4
 - 1 negotiated from start to finish in 2 days
- US investment attracted by principle of non-exclusive licence
- 70% of SEEDA/FSE Pocket Fund collaborations
- WIPO think they are the best of their kind
- EU Presidency list them as one of 5 important KT documents

Thank You

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