

National University of Singapore



Singapore's
Global
University

Cross Border Agreements in R&D and Technology Transfer
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Collaborations and Negotiations: Perspectives from NUS Technology Transfer Office

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Outline

- **Mission of University TTO**
- **Collaboration Perspectives**
- **The “Great Divide”**
- **Bridging the “Gap” – Mechanisms**
- **Commonly used agreements/
negotiated terms**
- **University’s Position**
- **Summary**

Mission of University TTO

- **To promote innovation, enhance research, and facilitate economic development through protecting and commercializing intellectual property in an efficient and effective manner that benefits the University, the region, and the society as a whole**

Henry Chesbrough

Open Innovation - A Paradigm shift

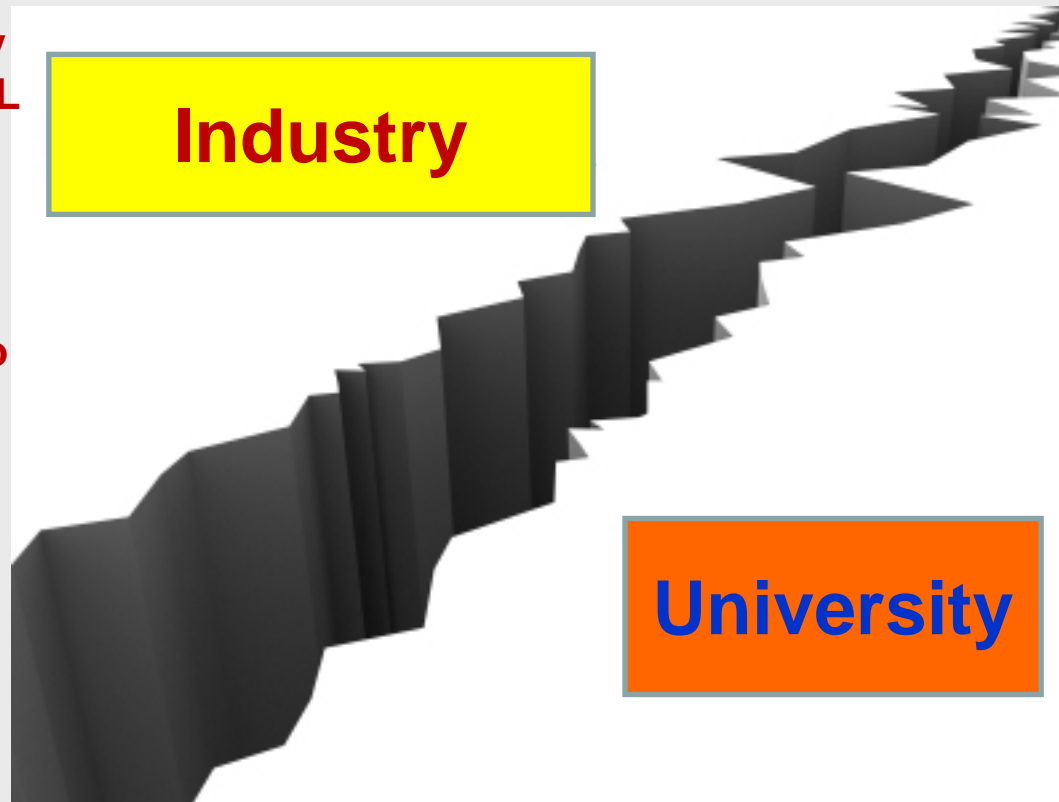
- **Companies become aware of the increasingly importance of open innovation. Not all good ideas are developed within the own company, and not all ideas should necessarily be further developed within the firm's own boundaries**
- **look for other ways to increase the efficiency and effectiveness of their innovation processes.**

University Perspective

- **Industry Partners/Collaborators**
 - Good avenues for students to acquire working experience and exposure
 - Stay relevant in research
 - Leveraging on research expertise, facilities and knowledge
 - Commercialization of technologies
 - Support in research funding (vice versa)

Understanding the “Great Divide”

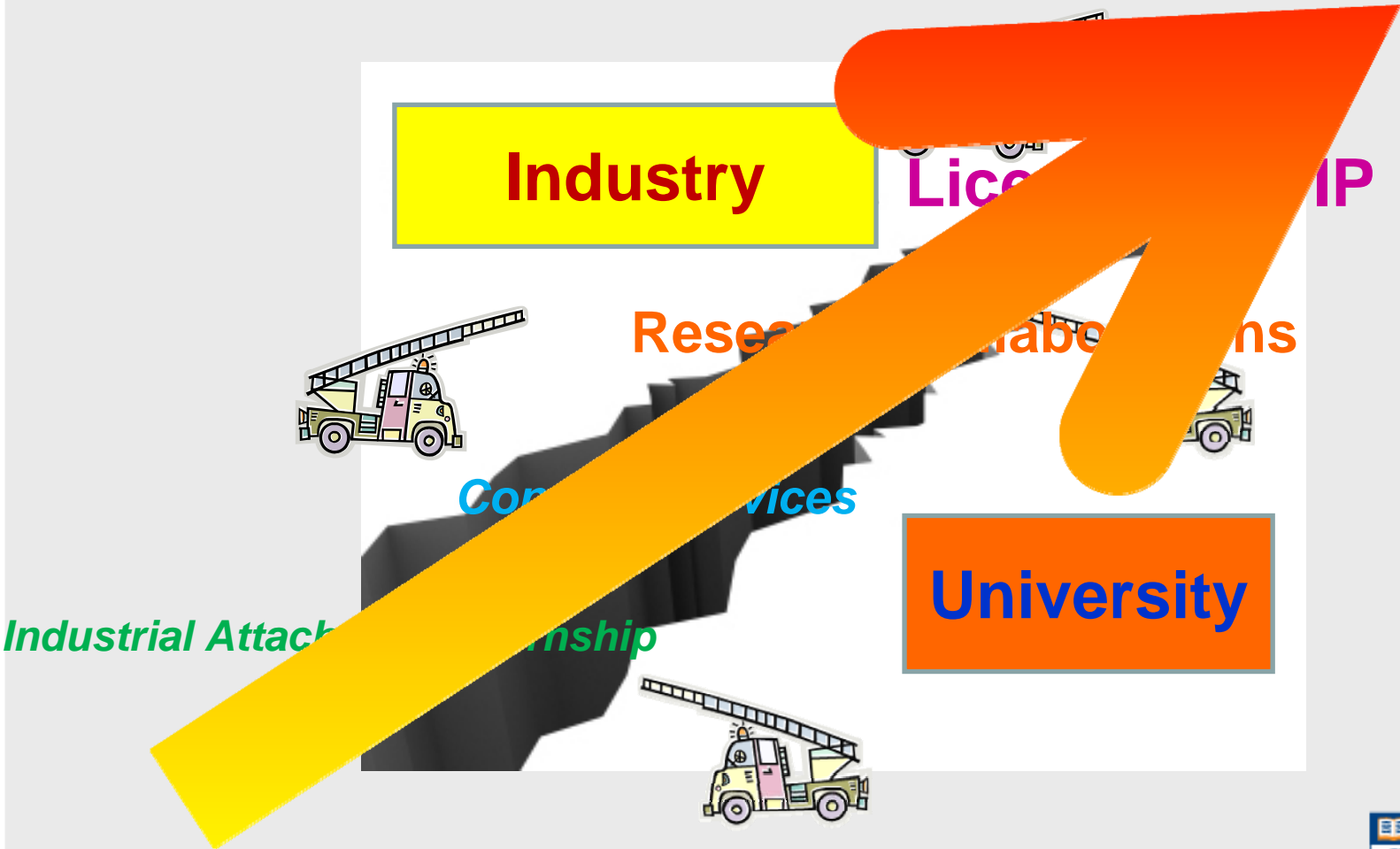
- Commercial Entity
- Profit Driven – P&L
- Defined Products or Services
- Core Business Focused
- Research: short to Mid term
- Focus on Applied Research



- Non Commercial Entity
- Not Profit Driven
- Knowledge creation and dissemination
- No Defined Products or Services
- No Core Business Focused
- Research: Mid to Long term
- Focus on Basic Research

Bridging the "Gap" - Mechanism

Relationship & Trust



Common Agreements are . . .

- **Non Disclosure Agreement (NDA)**
- **Material Transfer Agreement (MTA)**
- **IP Agreement**
- **Research Collaboration Agreement (RCA)**
- **Contracted Research (CRA) /Service Agreement**
- **Licensing Agreement (LA)**

Some Commonly Negotiated Terms in . . .

- **NDA**
 - Definition of Confidential info, Purpose of Disclosure
 - Duration of the confidentiality (extreme case – perpetual)
 - Governing Law
- **MTA**
 - Ownership of improvements
 - Rights to publish
- **IP Agreement**
 - Ownership of IP
 - Management of IP
 - Rights of use

Some Commonly Negotiated Terms in Licensing

- **Scope of Rights:**
 - Exclusive/Non Exclusive
 - Revocable/Non Revocable
 - Transferability
 - Territory
 - Field of Use
 - Sublicensing rights
 - Improvements
- **Financial Considerations**
- **Term of license**
- **Warranties and liabilities**
- **Indemnification**

Commonly Negotiated Terms in RCA / CRA

- **Publication Rights**
- **Use of Background IP**
- **Ownership of Foreground IP**
- **Commercialisation Rights**
- **Warranties and liabilities**
- **Indemnification**
- **Governing Law, Jurisdiction**
- **Overhead charges**
- ***US Parties – Export Control**

University's Position

- **Use of Background IP**
 - *Free use during project*
 - *License for commercial use*
- **Ownership of Foreground IP**
 - *Solely invented, solely owned*
 - *Jointly invented, jointly owned*
 - *Solely or Jointly invented, jointly owned*
- **Use of Jointly owned Foreground IP**
 - *Rights to use for internal academic / research*
 - *License for commercial use*
- **Rights to Publish**
 - *University must be able to publish, subject to removal of confidential information or reasonable delay to seek protection*

..... continue

- **Warranties**

- *Do not provide warranties. All project results are provided “as is”*

- **Indemnities**

- *Do not provide indemnity*
- *Require industry to indemnify university for use of IP*

- **Infringement**

- *Licensee to front but University provide support*

- **Indirect Cost/Overheads**

- *RCA (NUS – 20%); CRA (NUS – 60%)*

- **GST**

- *Prevailing rate*
- *Applicable if benefits are conferred on the collaborator*

Summary

- **Clear understanding of each other's perspectives and goals in the collaboration**
- **Upfront about communicating expectations**
- **Work towards fostering long term partnerships**
- **Adopt a “Win-Win” Model**
- **Some times, it is a question of “Who needs Whom more?”**



Thank-You