

A Better Start, NSC

Intellectual Property Management Plan

A BETTER
START

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Schedule 4 - Intellectual Property Management Plan

- 1.1 Project IP is the Intellectual Property Rights created by a Challenge Member (or Challenge Members) during the course of carrying out a research project, as part of the Challenge.
- 1.2 Project IP will be owned by the Challenge Member that creates it (and according to any internal policies for its assignment), who will be responsible for decisions concerning protection, management and commercialisation of the Intellectual Property Rights that arise.
- 1.3 Where Project IP is created by more than one Challenge Member, the Challenge Members who created it shall agree which of them shall be the "Managing Party". The Managing Party will be responsible for decisions concerning protection, management and commercialisation of the Project IP. Generally, for the purposes of guidance, the Managing Party will be the Challenge Member which is best placed to create value from the Project IP and/or with any other parties involved in the project consistent with the mission and objectives. Benefits will be shared between the creating Challenge Members (after costs of commercialisation have been deducted) in shares reflecting the relative input to the Project IP, including Intellectual Property Rights that are acquired or developed by a party independently for use in the course of carrying out a research project as part of the Challenge ("Background IP") and know how provided, inventorship and costs of commercialisation and after recognising the relative risks of the different Challenge Members (this may include the additional financial risks of the Managing Party).
- 1.4 Challenge Members will report all Project IP to the Director, who will keep a register of reported Intellectual Property Rights to support reporting to the Ministry.
- 1.5 It is acknowledged that where Project IP is developed in collaboration with co-funders / industry partners the regime set out in clauses 1.1 and 1.2 may not apply and it is expected that the Challenge Members involved will enter into appropriate agreements with the co--funders/ industry partners to:
 - (a) ensure Project IP is developed in a manner that will advance the purposes of the Challenge; and

- (b) agree commercialisation and revenue sharing arrangements.
- 1.6 Subject to any confidentiality provisions defined in the heads of agreement between the Challenge Members, Project IP will be licensed non-exclusively and royalty free to all Challenge Members for the purposes of research and/or related activities as well as educational activities.
- 1.7 The underlying purpose of the Challenge is to create benefit for New Zealand. Each Challenge Member will give consideration to the Intellectual Property Policies and Principles set out below when making decisions about the management of any Project IP.
- 1.8 Progress on commercialisation or translation or implementation plans shall be reported annually to the Director, science leadership team and the Establishment Oversight Group for the purposes of reporting outcomes to the Ministry. Such reporting shall be subject to ensuring protection of commercially sensitive or confidential information.
- 1.9 Post contract reporting to the Ministry by the Challenge Contractor may be required to allow the Ministry to review or evaluate the delivery of the outcomes of the Challenge. The Challenge Members shall maintain, and provide to the Challenge Contractor on reasonable notice, sufficient information and reports to allow the Ministry to review the delivery of outcomes by the Challenge for a period of at least 7 years after the end of the Challenge, or such other period specified in any subcontracts or the Contract.
- 1.10 Nothing in this plan shall change the ownership of any Background IP. Challenge Members will grant a non-exclusive, royalty-free, non-transferable license of relevant Background IP to each other, to the extent that they are able, unless there are reasonable grounds not to grant such a licence. Such licence shall be solely for the purposes of the research and/or related activities. Any commercial use of Background IP shall require the grant of a separate licence which shall be negotiated between the relevant Challenge Members.

Intellectual Property Policy and Principles

The Challenge Contractor will ensure that the Challenge Members will observe the following principles (which must not be inconsistent with the Intellectual Property Policies and Principles contained in Appendix 2 to the Contract and, to the extent that they are, the provisions of the Contract will prevail) in dealing with Intellectual Property Rights created from Challenge funding.

The underlying purpose of the Challenge is to create benefit for New Zealand. It is expected that Project IP will, to the extent reasonable, be commercialised by the owning/Managing Party in a manner consistent with this purpose. Such commercialisation may involve making the Project IP available to a suitable New Zealand company, or publicly disseminating the Project IP.

For the avoidance of doubt

- organisations (including Challenge Members) participating in the Challenge retain ownership of both Background IP and new Project IP created.
- Where multiple parties create Intellectual Property Rights then it is up to them to agree

Intellectual Property Rights' arrangements but the Challenge will have visibility of the outcomes of these discussions.

- Research organisations do their own technology transfer or commercialisation.

Furthermore

- The Challenge Members will use all reasonable endeavours to maximise the benefits to New Zealand of each investment through their management of any Intellectual Property Rights created.
- The Challenge Members will ensure that the ownership and/or assignment, if any, of Project IP is clear and will require employees to acknowledge the relevant ownership and rights associated with any Project IP (this may be via their employment agreement or a general institutional policy); ensure that researchers are advised of the potential value of Project IP and of the options available to them to add value to those rights; ensure that researchers are advised of any actual or potential confidentiality issues relating to Project IP and any mutual obligations of the staff and the Parties in relation to Project IP management and protection.
- The Challenge Members will ensure internal processes are in place to identify protectable and potentially valuable Project IP and associated commercial activities and to prevent the infringement of existing protected Project IP and associated commercial activities; and which provide guidance on the prompt disclosure and resolution of potential conflicts of interest concerning the generation, ownership, management and use of Project IP; and cover good scientific conduct, including sound record keeping and human and animal experimentation ethics.
- The Intellectual Property Policies and Principles should ensure that cultural, Treaty of Waitangi, and Maori issues are properly taken into consideration.
- The Challenge Members should give preferential access to competent New Zealand-based firms to develop the Project IP. Where a Challenge Member believes that it is best to commercialise the Project IP outside of New Zealand, the Challenge Member should seek to retain ongoing research, science, and technology in New Zealand and reinvest any net income derived from the commercialisation of the Project IP in research, science, and technology in New Zealand.
- The Challenge Members should, wherever possible: provide assistance to researchers in fulfilling Project IP obligations and responsibilities; encourage participation by researchers in any subsequent commercialisation process of any Project IP; and develop policies that incentivise staff and other stakeholders to generate benefits to New Zealand from the work.