



**Collaborative Research  
Forging Successful Alliances  
11 December 2009  
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# Why Collaborate?

## 3 Options:

1. Develop In-House
2. License/Acquire/Outsource
3. Collaborate

# Need Internal Consensus

- Expectations
- Internal Assets Available
- External Assets Needed
- Markets
- Is Ownership Necessary?
- Acceptable Restrictions on RTU
- Project Time Lines

# Suite of Agreements

- Confidential Disclosure Agreement
- Letter of Intent
- Material Transfer Agreement
- Evaluation Agreement
- Collaborative Research Agreement

# Confidential Disclosure Agreement (CDA)

## Key Issues:

- What Constitutes “Confidential Information”?
- What is the Purpose of the Disclosure?
- Duration of Confidentiality Restrictions

# Key Provisions of a CDA

- Parties
- Purpose
- Definition of Confidential Information
- 1 way / 2 way
- Rights to Use
- Rights to Disclose
- Obligations during and after the Term
- No Grant of Rights
- Assignment
- Information Exchange Process
- Governing Law
- Dispute Resolution Procedures
- Entire Agreement Clause
- Duration of Confidentiality Restrictions

# Material Transfer Agreement

- To protect rights in the materials furnished and BIP
- To protect IP in the technology of the evaluating/receiving party
- To determine rights in the Foreground IP/Data (including materials generated)
- Prohibit patenting which would block the other party's technology - preserve the status quo

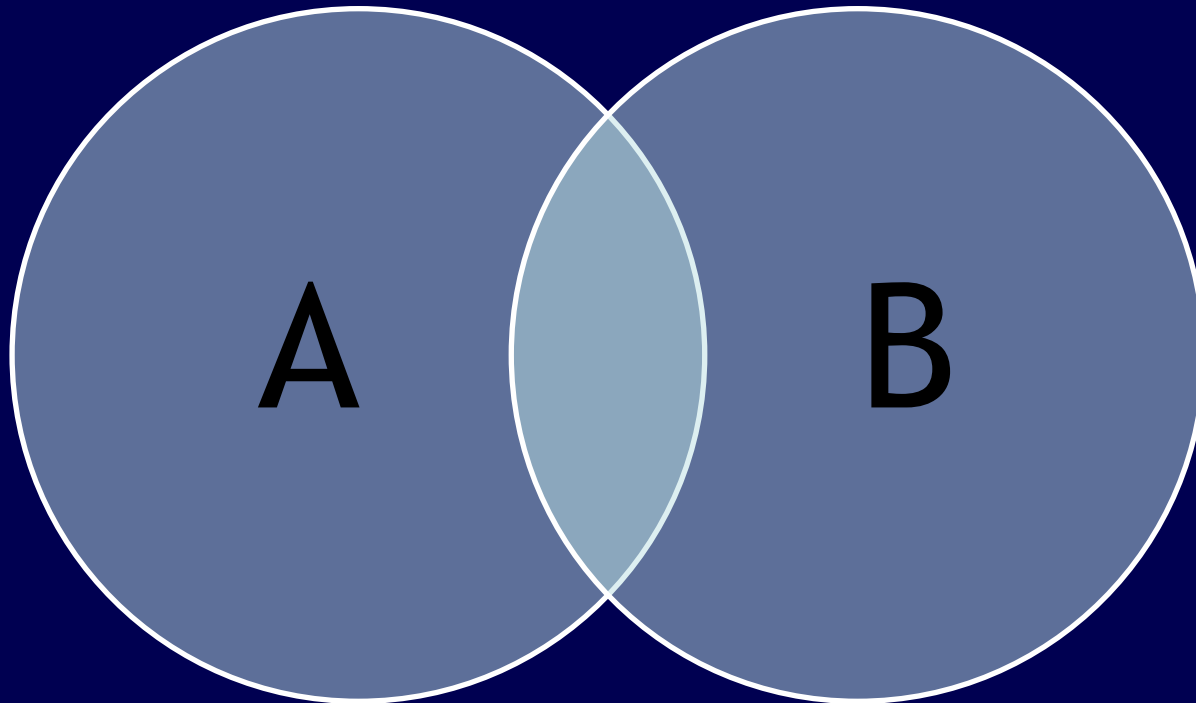
# Key Components of CRA

- Project Plan
- Funding/Costs
- Scope of the Alliance
- IPR
- Licence/Supply Terms
- Warranties, Indemnities, Caps on liability
- Governance Structure
- Dispute Resolution Procedure
- Confidentiality
- Publication Rights
- Term & Termination
- Governing Law
- Assignment

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# Defining the Scope of the Collaboration



# Key Components of CRA

- Project Plan
- Funding/Costs
- Scope of the Alliance
- **IPR**
- Licence/Supply Terms
- Warranties, Indemnities, Caps on liability
- Governance Structure
- Dispute Resolution Procedure
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# Ownership of FIP under CRA

- Joint Ownership
- Sole Ownership
- Ownership vs. Rights to Use
- Rights to Use
  - Fields of Use
  - Geographical Markets
  - Timeframes

# Dealing with IP Issues in CRA

- Identify, Evaluate and Protect FIP
- Responsibility for FIP
- Improvements
- Ownership of FIP
- Exploitation

## IP Issues in CRA (continued)

- RTU BIP
- Indemnification Obligations
- Patent Planning
- Publication

Thank You

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