

Square Kilometre Array

Statement of common intent on IPR amongst Parties to MoU-2000

1. *Background*

The development of knowledge and technologies for the SKA requires the collaboration of organizations and companies from countries/regions signatory to the Memorandum of Understanding to Establish an International Square Kilometre Array Steering Committee (MoU-2000). The Memorandum of an Agreement to Cooperate in a Technology Study Program Leading to a Future Very Large Radio Telescope (MoA-1996) establishes principles of cooperation between participating Parties in the development of technologies. In particular, it is the intention that all documents depicting concepts, technology solutions, and results should be made freely available to participating Parties, unless restrained by contract or agreement with third Parties.

Nonetheless, there will be instances when, for commercial reasons for example, that a Party or collaborating Parties may wish to contribute their own Intellectual Property Rights (IPR) to the SKA while maintaining adequate protection of technology or know-how developed independently. Another scenario is where one or more Parties signatory to the MoU-2000, wishes to individually contribute their own IP (Background IP) while collectively developing new IP (Project IP) specifically for the SKA. In this case, one or more of the Parties may wish to protect its Background IP, and collectively, the Parties may wish to exploit the newly developed Project IP for other purposes in addition to the SKA.

This Statement of Intent seeks to establish ground rules for collaboration and protection of IPR among Parties. In cases where a Party does not hold the legal rights to the IP, for example if it is not a legal entity in its own right, it will use its best efforts to secure permission from its controlling legal entity (e.g. Research Council, NSF, etc) to make the IP available to other Parties. Definitions of terms are given in the section 2. In sections 3, 4, 5 and 6 simple guidelines for the protection and patenting of IPR, where this is considered necessary, are given.

It is expected that agreements between Parties will be negotiated in the spirit of scientific collaboration ensuring that the challenging technical requirements to be met by the SKA will be achieved. At this stage of the project, a Statement of Intent is deemed sufficient. When the SKA project is funded and when each participant is formally represented by a legal entity, it will be appropriate to revise and expand this document.

2. *Definitions*

"Party": a signatory to the Memorandum of Understanding to Establish an International Square Kilometre Array Steering Committee (MoU-2000). In the case of a consortium as signatory, the term "Party" includes the participating organisations in the consortium.

"Intellectual Property" (IP): knowledge with potential commercial value generated in the course of intellectual endeavours by individuals and organisations.

"Background IP": any Intellectual Property created independently of the SKA Project which is made available to perform the research and/or development for the SKA Project.

"Project IP": the Intellectual Property developed during and as a result of carrying out the research and/or development for the SKA Project.

"Intellectual Property Rights" (IPR): all intellectual property rights including patents, copyright, rights in circuit layouts, registered designs, software, trademarks, and right to have confidential information kept confidential.

"Confidential Information" of a Party: any information that a Party claims is confidential to itself and marks as confidential at the time of disclosure. It does not include information to the extent that information is independently developed or known by the other Party (or information that is in the public domain).

"Publication" (in reference to patent applications): any form of non-confidential disclosure and includes media releases, books, scientific papers, seminars and oral disclosures.

3. No restrictions on use of IPR

Where there are no restrictions on a participating Party to divulge essential aspects of technology, including but not limited to experimental results, each Party to the MoU-2000 shall be allowed to use such IPR for its own purposes for continuing developments of the SKA. Unless restricted from doing so during a patenting or commercialisation process, or because of conflict with the terms of other agreements, IPR, including experimental data summarising the performance of a technology or system, are to be made accessible to all Parties to the MoU-2000.

4. Procedures where protection of IPR is deemed essential

4.1 Where one or more Parties to the MoU-2000 have developed IP independently of the SKA project (Background IP) and wish to contribute this Background IP to the SKA project, but at the same time wish to restrict general access to the Background IP, then the Parties which are involved in further development of related technologies for the SKA and wish to use the Background IP of one or more of the Parties, should, as early as possible, enter into an agreement which provides adequate protection of Background IPR. All Parties should have equal opportunity to conclude such agreements on Background IP.

4.1.1 Suitable arrangements for protection and exploitation (as applicable) of the Project IP developed by the Parties should be negotiated as early as possible.

4.1.2 Where only one Party to a technology development wishes to protect its own Background IP and any subsequent IP developed at its own expense for SKA (Project IP), that Party may exploit the technology for purposes other than the SKA, but only if no other Party has contributed know-how to the Project IP. Where another Party has contributed, and if the features of such joint invention, design or work are such that it is not possible to separate them for the purpose of applying for, obtaining and/or maintaining the relevant patent protection or any other IPR, the Parties concerned agree that they may jointly apply to obtain and/or maintain the relevant right together with any other Parties in the SKA project.

4.1.3 Joint ownership of an invention, design or work shall not affect the obligations arising under the MoU-2000.

4.2 Any other Party involved but not applying for such jointly owned intellectual property right shall discuss with the joint owners the possibility of obtaining a non-exclusive, non-transferable, irrevocable, paid-up license on a case-by-case basis. Whatever license rights are obtained should be available to all Parties in the SKA project on the same terms.

4.3 To facilitate the protection of both Background and Project IPR, an IP register will be maintained that documents the information on IP brought into the project, and generated in the course of the project (see Annex 1).

5. **Confidentiality**

Background and Project IP related to the SKA project will be treated as Confidential Information by all Parties if so indicated by the originating Party at the time of disclosure.

6. **Patentable IPR**

Material which is patentable arising from the SKA project should be considered as a separate issue given the need to restrict publication prior to issue of a patent. It may be necessary during this period, for Parties participating in the development of the relevant technology, or Parties requiring access to the technology for the development of SKA, to be signatories to a Mutual Confidentiality Agreement.

The costs of patent applications will be shared following a procedure to be determined.

Signed

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