

The SKA project: General conditions for protection of IPR

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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 the principles of cooperation between participating parties in the development of technologies. In particular, unless restrained by contract or agreement with third parties, it is the intention that all documents depicting concepts, technology solutions, and results should be made freely available to participating parties.

Nonetheless, there will be instances when, for commercial reasons for example, that a party or collaborating parties may wish to protect the Intellectual Property Rights (IPR) of technology or know-how developed as a separate activity, but which may be applicable to the SKA. Another scenario is where one or more parties signatory to the MoU-2000, which individually contribute their own IP (Background IP) and in addition wish to collectively develop 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 also wish to exploit the Project IP for other purposes in addition to the SKA.

Definitions of terms are given in the section 2. In sections 3, 4, and 5 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. Sections 6, 7 and 8 deal with the ownership of Intellectual Property, and sections 9 and 10 describe the concepts of Confidentiality, and Access to Intellectual Property. Resolution of disputes is covered in section 11.

2. Definitions

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

"Background IP" means 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" means 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) means 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 means 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 (because it is in the public domain).

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

"Party" means a signatory to the MoU-2000.

“*Affiliate*” of a Party means:

- (a) any legal entity directly or indirectly controlling, controlled by, or under common control with a *Party*, for so long as such control lasts.

Control of an entity shall exist through the direct or indirect:

- control of 50% or more of the nominal value of the issued equity share capital of the entity or of 50% or more of the equity's shares entitling the holders to vote for the election of directors or persons performing similar functions, or
- right by any other means to elect or appoint directors of the entity (or persons performing similar functions) who have a majority vote,

- (b) any other organisation specified to be an *Affiliate* of the *Party*.

Common control through government does not, in itself, create affiliated status unless otherwise specified in accordance with paragraph (b) above.

“*Legitimate Interests*” TBD

“*Access Rights to IP*” means rights to make use of Project and Background IP owned by another Party.

“*Staff member or member of staff*” means a person appointed as a member of the *Party's* academic or non-academic staff including part-time and casual staff at the time he or she creates or develops *Intellectual Property*.

“*Student*” means a person enrolled as a student of a university or seat of higher learning, or in a course or program of study conducted by or on behalf of a university or seat of higher learning, at the time he or she creates or develops *Intellectual Property* as part of the SKA Project.

“*Visitor*” means any person other than a student or staff member who takes part in any research project or scholarly activity that is conducted by any staff member of the *Party* or student, or who visits any part of the *Party's* premises in which research or scholarship, or any related activity, is conducted.

“*Software*” means

- (a) software programs being sequences of instructions to carry out a process in, or convertible into, a form executable by a computer and fixed in any tangible medium of expression and in any code form (including source code form);
- (b) software information being technical information used or, useful in, or relating to the design, development, use or maintenance of any version of a software program; and/or
- (c) software documentation being software information in documentary form.

3. No restrictions on use of IPR

Where there are no restrictions on a participating Party to divulge essential aspects of technology, including experimental results, for continuing developments of the SKA, each Party to the MoU-2000 shall be entitled to use such IPR for its own purposes. Unless restricted from doing so during a patenting process, 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.

Also, suitable arrangements for protection and exploitation (as applicable) of the Project IP developed by the parties should be negotiated as early as possible.

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), the party may exploit the technology for other purposes besides the SKA, but only if no other party has contributed know-how to the Project IP. Where another party has contributed, the parties will enter into an appropriate agreement.

4.2 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 by the project (see Annex 1).

(In more formal language...)

4.3. If, in the course of carrying out work on the *Project*, a joint invention, design or work is made (and one or more *Parties* are contributors to it), 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 concerned.

The *Parties* concerned shall seek to agree between them and the other parties concerned arrangements for applying for, obtaining and/or maintaining such right on a case-by-case basis. Where the parties concerned are solely *Parties*, so long as any such right is in force, the *Parties* concerned shall be entitled to use and to license such right without any financial compensation to or the consent of the other parties concerned.

For the avoidance of doubt, joint ownership of an invention, design or work shall not affect the obligations arising under the MoU-2000.

4.4 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 license on a case-by-case basis.

5. 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 TBD procedure.

6. Ownership of IPR

Ownership of all IPR generated by Members of Staff of a Party specifically employed to carry out research in the SKA Project will be asserted by the Party.

7. Student IPR

Students own any Intellectual Property they create pursuant to their participation in the SKA Project, unless they sign a Deed of Assignment relinquishing ownership to the Party funding the research. Intellectual Property created jointly by a Student and a Member of Staff of a Party is jointly owned by the Student and the Party and, in practice, is unlikely to be commercialised unless the Student signs a Deed of Assignment.

Assignment of a Student's IPR must be freely given in full knowledge of what he or she is doing. Assignment of a Student's IPR cannot be a condition of enrolment in a university or course given by the university. It is the responsibility of the Party to advise the Student as follows before the Student is allowed to participate in the SKA Project:

- a) the Student is required to assign his or her IPR to the *Party*; and
- b) the Student should seek independent legal advice about his or her rights.

8. Visitors IPR

Before a Visitor participates in work on the SKA Project during a visit to a Party, he or she will be required to sign, as a condition of that participation, an agreement to keep Intellectual Property, and information that relates to it, confidential and to transfer IPR created or developed by him or her independently or in collaboration with a Member of Staff of a Party or a Student whose research is funded by a Party, to the Party.

9. Confidentiality

9.1 With respect to all information of whatever nature or form as is disclosed to a *Party* in connection with the *Project*, but which

- (i) is clearly marked "confidential" in physical form;
- (ii) if disclosed orally, was at the time of disclosure indicated to be "confidential" and within thirty days reduced to physical form and marked "confidential" by the discloser.

each *Party* agrees such information is communicated on a confidential basis and its disclosure may be prejudicial to the owner of the information, and undertakes that:

- (A) it will not during a period of TBD years from the date of disclosure to the *Party* use any such information for any purpose other than in accordance with the terms of the *MoU-2000*; and
- (B) it will during the period of TBD years treat the same as (and use reasonable endeavours to procure that the same be kept) confidential and not disclose the same to any other third party without the prior written consent of such owner in each case;

provided always that:

- (i) such agreement and undertaking shall not extend to any information which the receiving *Party* can show:
 - (A) was at the time of disclosure to the *Party* published or otherwise generally available to the public, or
 - (B) has after disclosure to the *Party* been published or become generally available to the public otherwise than through any act or omission on the part of the receiving *Party*, or
 - (C) was already in the possession of the receiving *Party*, without any restrictions on disclosure, at the time of disclosure to the *Party*, or
 - (D) was rightfully acquired from others without any undertaking of confidentiality, or
 - (E) was developed independently of the work under the *Contract* by the receiving *Party*;
 - (ii) nothing in section 9.1 shall prevent the communication of information
 - (A) as is needed to be communicated to comply with applicable laws or regulations or with a court of administrative order provided that insofar as reasonably possible the complying *Party* shall have informed the owner of the information of such need and shall have complied with such owner's reasonable instructions designed to protect the confidentiality of such information;
 - (B) subject to Section 9.2, to any *Affiliate* or to any other third party insofar as needed for the proper carrying out of the MoU-2000;
 - (C) subject to Section 9.2, to any third party (including to the public) as strictly needed for technical reasons and insofar as needed for proper use of Intellectual Property from the *Project*.
- 9.2 Concerning any permitted communication of any of the information referred to in Section 9.1 by the recipient *Party* to a third party (including but not limited to its *Affiliates*) such *Party* will use reasonable endeavours to procure due observance and performance by such third party of the undertakings referred to in Section 9.1 (A) and (B) and all relevant undertakings in the MoU-2000.

10. Access to Intellectual Property

10.1 General principles relating to Access Rights to Intellectual Property

- 10.1.1 All *Access Rights* to *IP* for carrying out of the *Project* and for use of *IP* by Parties acting on their own behalf or on behalf of third parties are granted on a non-exclusive and non-transferable basis.
- 10.1.2 Save in exceptional circumstances, no transfer costs shall be charged for the granting of *Access Rights* for carrying out the *Project*. Save in exceptional circumstances, transfer costs for granting *Access Rights* for Use shall borne by the beneficiary of those *Access Rights*.

10.1.3 *Change of Control*

- (a) Upon cessation of the control of an *Affiliate* any *Access Rights* granted to such *Affiliate* in respect of *Project* or *Background IP* shall lapse, provided however that information which is *Project IP* which has been incorporated into the products, processes, software or services of such *Affiliate* or which has been amalgamated with such *Affiliate's* own information may continue to be used (in the manner it was then being used) by such *Affiliate* provided it is not practical to do otherwise. In such event, at the request of such *Affiliate*, each requested *Party* shall grant to such *Affiliate* non-exclusive and non-transferable licences under that *Party's* intellectual property rights relating to *Intellectual Property* against terms and conditions to be agreed, provided that no *Legitimate Interests* of such *Party* oppose the grant of such licences. Upon such cessation of control, *Access Rights* granted by such *Affiliate* shall continue in full force and effect.
- (b) In case the identity of an *Affiliate* (for instance the parent company) of a *Party* changes, such *Party* shall give notice hereof to all other *Parties*, and no *Access Rights* in respect of *Project* or *Background IP* shall be granted to such new *Affiliate* until approval therefore has been received from all other *Parties*.

10.2 **Access Rights to IP for carrying out the Project - software**

- 10.2.1 *Software* will be available only insofar as, and in the form which it is, needed for carrying out the *Project*. Notwithstanding the foregoing, the supplying *Party* shall have no obligation to port the *Software* to any particular equipment or to change it from the form in which the supplying *Party* has it.

10.3 **Access Rights to IP for Use**

- 10.3.1 Notwithstanding the provisions of Section 9.1, each *Party* may enter into a technical cooperation or licensing arrangement with a third party in respect of its own information even if unavoidably incorporated into or amalgamated with such information, there are minor amounts of information which is *Project IP* of another *Party* (and there are minor amounts of information which is *Background IP* or other *IP* of the other *Party*, but which is associated with that information which is *Project IP* of the other *Party*). In such circumstances and upon request of the *Party* entering the cooperation or arrangement, the other *Party* shall grant non-exclusive rights to permit such cooperation or arrangement against terms and conditions to be agreed, provided that no *Legitimate Interests* of the other *Party* opposes the grant of such rights.
- 10.3.2 Recognising the *Parties'* obligations to act in good faith and in accordance with Section 9.1(ii)(C) the *Parties* agree the *Access Rights* for using *Project IP* in subsequent research activities are to be as follows:

Parties are deemed to be granted a right to use free of charge *Project IP* for

- (A) internal research;
- (B) third party research, provided the third party does not have direct access to confidential *Project IP* generated by other *Parties* (as examples - producing research results which are available to the third party but which contain hermetically-sealed *Project IP*; using *Project IP* for in-house testing or diagnosis purposes in doing research.)

In the case of research in collaboration with and/or for a third party where the third party needs *Access Rights* to confidential *Project IP* of another *Party*, the researching *Party* shall in

a traceable form (before starting or committing to start the research) inform the third party of such need, and shall use reasonable endeavours to inform the owner of that *IP* of such need in a traceable form. If the owner has been so informed, he shall (i) not unreasonably delay his decision on whether or not to refuse to grant the needed third party *Access Rights* and (ii) not unreasonably refuse to grant such rights on fair and reasonable terms but may, in good faith, so refuse on the grounds of business interest.

However, if despite such reasonable efforts on behalf of the researching *Party*, the owner has not been so informed, the researching *Party* may carry out the research without prejudice to the owner's rights to enforce its rights in any way it deems fit against such third party.

10.3.3 Recognising the *Parties'* obligations to act in good faith and in accordance with Section 9.1(ii)(C) the *Parties* agree the procedures for using another *Party's Background* in subsequent research activities are to be as follows:

- i) A *Party* seeking *Access Rights* to a second *Party's Background IP* will promptly notify the second *Party* of the *Background IP* required, and in particular, where possible it shall do so before entering into any Contract with a third party. Failure to so notify the second *Party* shall not be a breach of the MoU-2000 unless such failure is due to an action in bad faith.
- ii) When a *Party* is unable to grant *Access Rights* which it reasonably believes that another *Party* will require, it will promptly notify such other *Party*

11. Resolution of Disputes

TBD

Annex 1

(based on FARADAY example by Andrew Parfitt - CSIRO TIP, Australia)

**The International Square Kilometre Array Steering Committee
(ISSC)**

Intellectual Property Register (Part 1)

STEP 1 - Inventor(s)/Creator(s) to Complete

Date IP Contributed/Created:

Background or SKA IP:

Name(s) of Inventor/Creator:

Other Interests/Partners:

Location:

Description:

Location of Original IP Documentation (i.e. Log Book):

Forward to Institution Director (or Delegate) for Approval

STEP 2 – Institution Director (or Delegate) to Complete

I certify that the details outlined in the description are correct and should be registered as SKA Intellectual Property.

Signed by: _____

First Name

Surname

Date: ____/____/____

Forward to ISSC Project Leader for Approval

STEP 3 – ISSC Project Leader to Complete

I certify that the details outlined in the description are correct and should be registered as SKA-ISSC Intellectual Property.

Signed by: _____

First Name

Surname

Date: ____/____/____

Forward to Commercial Manager for registration and subsequent action (Part 2)

**The International Square Kilometre Array Steering Committee
(ISSC)**

Intellectual Property Register (Part 2)

STEP 4 – Commercial Manager to Complete

Date Registered:

SKA Registered Number:

SKA File Ref:

Owner:

Restrictions on Use:

I agree with the registration of the Intellectual Property contained herein.

Recommendation to Proceed with Patent Protection: Yes/No

Proceed with any other action:

Commercial Significance:

Value/Expected Return on Investment:

Commercial Partner:

Resources Available:

Funding Source:

Signed by Commercial Manager: _____

First Name

Surname

Date: ____/____/____

Endorsed by SKA Project Leader: __

First Name

Surname

Date: ____/____/____