



# Intellectual property guidelines

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2010-2011 Research program

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*Sustainable Development First!*

## 1. BACKGROUND

This Guide spells out the norms that all the Partners (defined hereinafter) are required to consider, and as far as possible to apply in terms of protecting the Intellectual property rights that emerge from the research and development projects sponsored by the **CRIBIQ - Québec Industrial Bioprocesses Research and Innovation Consortium** (hereinafter called the “**Consortium**”).

All the Partners (defined hereinafter) who wish to participate in a Project (defined hereinafter) shall, as part of a presentation to the Consortium, prepare and submit a plan to protect and commercialize the results that emerge from the Research Project, the whole in accordance with the provisions in this Guide, notably those set out in Article 4.

## 2. DEFINITIONS

**2.1 “Intellectual property rights”** means, but is not limited to, the intellectual property rights, whether registered or not, including any rights in patents and patent applications, copyrights, industrial drawings, integrated circuit topography, plant breeders, inventions (whether patentable or not), discoveries, trade secrets, know-how, domain names, trademarks, trade names and other rights recognized by statutory law or common law in connection with the foregoing, including any applications for protection.

**2.2 “Previous information”** designates the information, technical know-how and Intellectual Property Rights held or controlled by a Partner before the Project begins.

**2.3 “Member”** designates the persons, whether natural or legal, who are Members of the Consortium.

**2.4 “Partners”** designates the Industrial Members – Major Companies, Industrial Members – SME, University/Research Centre Members, Technology Transfer Members, Associate Members, as well as any legal or natural person who participates in a Project, with the exception of those persons who have issued a renunciation in accordance with paragraph 8.3 herein.

**2.5 “Products”** designates a product or process that emerges from the Results that is designed to be manufactured or used.

**2.6 “Project”** designates any research and development Project whose setting up and carrying out are being contemplated by the Partners and that has been the subject of an analysis and approval by the Consortium’s decision-making bodies.

**2.7 “Results”** includes all the knowledge, technical and scientific data developed in the course of a Project, including notably the Intellectual Property Rights created, produced or brought to fruition in the course of the Project, regardless of their form and of whether they are patentable or not.

## 3. SCOPE

**3.1** A copy of this Guide shall be transmitted to each Member. All Members are required, as far as possible, to be guided by it in the preparation of any Project they submit to the Consortium.

#### **4. RIGHTS AND OBLIGATIONS OF THE PARTNERS**

**4.1** Before any Project begins, the Partners must jointly prepare an agreement and submit it to the Consortium. This agreement must notably address the plan to protect and commercialize the Results and issues related to the Intellectual Property Rights that are likely to be created, how the Results are to be protected, the Previous information, the improvements to the Results, the breakdown of the Results, as well as how they are going to be used. The agreement may be modified and/or completed jointly by the Partners when the Project is being carried out, if necessary. A copy of the initial agreement and the modified or completed agreement, where applicable, must be transmitted to the Consortium.

**4.2** The Partners will transmit to the Consortium, who will then distribute it to the Members of the Consortium twice a year, a progress report that will describe the evolution of the Project and the Results achieved during the previous year.

**4.3** The Partners shall inform one another and the Consortium of all the Results that are susceptible to being protected and shall take all action, with the agreement of all the Partners involved in the Project, that are appropriate with a view towards acquiring such protection.

#### **5. PROTECTION AND UTILIZATION OF PREVIOUS INFORMATION**

**5.1** The Partners shall not acquire, under any circumstances, any kind of title to any Previous information coming from one of the Partners.

**5.2** The communication of any Previous information to other Partners cannot be interpreted as a transfer of title.

**5.3** Each Partner shall freely ensure the protection of their Previous information. Notably, they shall decide whether to protect or not their Previous information and, where applicable, decide alone what kind of protection is adequate.

**5.4** The Intellectual Property Rights developed thanks to such Previous information shall belong to the Partner who developed said Previous information.

#### **6. PROTECTION OF RESULTS**

**6.1** The Results that emerge from a Project must benefit the Partners who have participated in said Project.

**6.2** In any application for the protection of Results, the names of the people who have played a direct intellectual role in the Project shall be referred to as inventors by the Partners.

**6.3** The Partners undertake to sign an agreement regarding the use of the Results before each Project, in accordance with Article 4 herein.

**6.4** The application for the protection of Results must be made on behalf of the Partners in accordance with the agreement submitted under Article 4, after CRIBIQ has been duly informed of same.

**6.5** In the month following the submission of the application for the protection of Results, the Partners shall exchange amongst themselves and transmit to CRIBIQ copies of the application and of all the documents enclosed with it. They shall inform one another and CRIBIQ of the details of this application and of its acceptance and of the safeguarding of their rights, as soon as they become aware of same.

**6.6** In the event that the Partners should decide to not submit an application for protection, they shall explain their reasons for not doing so to CRIBIQ.

## **7. USE OF THE RESULTS FOR RESEARCH AND COMMERCIAL PURPOSES**

**7.1** The Partners recognize that the University/Research Centre Members and Technology Transfer Members of the Consortium should be able to use the Results, unless there are provisions to the contrary under the agreement submitted pursuant to Article 4, for teaching and research purposes, but not for commercial purposes.

**7.2** Subject to the rights granted to the other Partners in an agreement to that effect, the Partners agree that each of the Partners who has participated in the Project shall enjoy a non-exclusive, irrevocable, non-transferable, geographically unlimited and royalty-free licence that will enable them to make use of the Results for their own in-house research, evaluation, or characterization purposes, or for any other kind of bioprocess-related use.

**7.3** Subject to the rights granted to the other Partners in an agreement to that effect, the Partners, inasmuch as they all agree, hereby grant to each of the other Partners who have not participated in the Project an option to purchase a licence, against certain royalties, that would enable them to make use of the Results for commercial or in-house purposes.

**7.4** Each of the Partners shall be free to make use of the services of researchers, employees, professors, students and subcontractors (“**Third-party**”) to make use of the licences that might be granted to them. However, no rights to conduct business shall be granted vis-à-vis a Partner’s Intellectual Property Rights or vis-à-vis the Results to any Third parties.

The Partners shall ensure that any Third party involved in carrying out the Project:

- a) assigns to the respective Partners all its Intellectual property rights that emerge from the Project, with the exception however of any copyrights related to dissertations and theses;
- b) renounces in writing all moral rights regarding any works that emerge from the Project, with the exception however of any copyrights related to dissertations and theses;
- c) signs a confidentiality undertaking, which notably includes an undertaking to use the Intellectual Property solely for the purposes of the mandate granted to the Third party by the Partner.

## **8. APPLICATION FOR THE PROTECTION OF INTELLECTUAL PROPERTY**

**8.1** The Partners shall immediately take all necessary action to protect the Intellectual Property Rights and the Results. They shall jointly determine how to commercialize the Results in the countries concerned as part of the agreement set out in Article 4 herein.

**8.2** Subject to what is stipulated in paragraph 8.3, the Partner proprietors or licensees shall jointly embark upon the appropriate course of action to protect the Results that emerge from the Projects and

as determined within the framework of the agreement set out in Article 4 herein.

**8.3** If one of the Partners renounces their right to secure the protection of their Intellectual Property rights or to ensure that they are safeguarded, or should they refuse to participate in defraying the costs pertaining to the foregoing, the Partner shall immediately inform the Consortium and the other Partners who have participated in the Project. The other Partners, after consultations between one another and the Consortium, may take action designed to acquiring this protection in their own name and/or to ensure the safeguarding of their rights. The Partner who has renounced their rights shall then collaborate with the other Partners for the performance of the aforementioned formalities.

The Partner renouncing such rights undertakes to assign their rights to the Intellectual Property Rights to the other Partners and to do whatever is necessary or appropriate, including signing and/or transmitting any documents, to give full effect to said assignment in favour of said Partners designated by the present paragraph.

**8.4** With the exception of the Partners designated in paragraph 8.3, the Partners shall consult one another and work together to prepare the documents necessary to ensure the protection of Results.

**8.5** With the exception of the Partners designated in paragraph 8.3, the Partners shall undertake, at their own expense, the steps necessary to protect their Intellectual Property Rights.

**8.6** In any such application, the names of the people who have played a direct intellectual role shall be referred to as inventors by the Partners.

**8.7** In the month following the submission of the application, the Partners shall exchange amongst themselves and transmit to the Consortium copies of the application and of all the documents enclosed with it. They shall inform one another and the Consortium of the details of this application and of its acceptance and of the safeguarding of their rights, as soon as they become aware of same.

## **9. PUBLICATION AND DISCLOSURE OF RESULTS**

**9.1** Subject to the confidentiality provisions that shall be stipulated in any contract related to carrying out a Project, as well as the rules stipulated in this Article, each Partner has the right to publish the Results achieved within the framework of the Project and will be able to use the Results within the normal framework of disseminating knowledge, including the publication of scientific articles, seminars, oral or written presentations, Masters dissertations or Doctoral theses.

**9.2** The Partners shall, before disclosing the Results in any way whatsoever, including the publication of scientific articles, seminars, oral or written presentations, Masters dissertations or Doctoral theses regarding the Results achieved, transmit a copy to the other Partners and to the Consortium, in order that they may, within a period of sixty (60) days as of the receipt of such a draft:

- a) ensure that the dissemination of this technical information complies with the conditions pertaining to confidentiality;
- b) take whatever action is necessary to protect the technical information that, if it were to be disclosed, could diminish the commercial value of the Intellectual Property;
- c) inform, in writing, any other person or institution with an interest in the Intellectual Property Rights in order that they may take whatever action is necessary to protect the Intellectual

Property involved in the disclosure.

**9.3** The Partners shall have sixty (60) days after the date of receipt of this article to submit their comments in writing to the other Partners and to the Consortium. If the Partners do not manage to agree on a version that is acceptable to everyone, or if the Consortium rejects such a version within fifteen (15) days of the date of receipt of the comments, the Partner who wishes to publish the Results shall draft the final version of the publication with the information deemed confidential by one or the other of the Partners removed from it.

**9.4** Should no comments be received from the other Partners and the Consortium within the sixty (60) day period stipulated in the previous paragraph, the Partners concerned shall consider that the other Partners and the Consortium agree with the draft of the publication as submitted.

**9.5** The Partners may also take advantage of an additional delay, which shall not exceed six (6) months following the date of receipt of the draft of the publication by the Partners, in the event that one or more of the Partners believes that necessary actions to protect the Intellectual Property regarding the Results covered by the disclosure should be taken.

**9.6** The publications arising from the Project shall include the name of the authors, unless one of the authors refuses to be mentioned.

## **10. LIABILITY AND COMPENSATION**

The Consortium shall be indemnified and held harmless against all legal proceedings, expenses or claims arising from carrying out the Project or the use, by any Member, by its customers or by any licence holders, of part or all of the Intellectual Property developed within the framework of a Project. In addition, the Members acknowledge that the Consortium is making no representations or providing any guarantees with regard to the Results that emerge from a Project.

## **11. AMENDMENTS**

The Partners recognize that this Guide can be modified, replaced or repealed, from time to time, by the Consortium's Board of Directors, without any prior notice.

## **12. DISCIPLINARY ACTIONS**

Any designated Partner who has knowledge of a possible breach of the Directives herein is required to report this fact by informing the Consortium's Board of Directors as soon as possible. In this regard, the Board has the power to weigh the seriousness of the breach that has been reported to them and to impose the appropriate disciplinary actions, where applicable.

Any breach of the provisions of these Directives or any divergence from the principles and values that it is designed to promote shall constitute a violation that is subject to disciplinary actions that could go as far as a discharge, removal or dismissal of the Partner, regardless of their position, and this, without any warning.