INTELLECTUAL PROPERTY AND RESEARCH AND DEVELOPMENT (R&D) INSTITUTIONS

SAUDIN JACOB MWAKAJE
INTELLECTUAL PROPERTY PROPERTY MANAGER,
University of Dar es Salaam, TANZANIA
INTRODUCTION

- The world economy is changing- We are in the “information age”.
- Conception of what amount to property has significantly changed- we are no longer restricting the meaning of property to tangibles.
- In the knowledge based economy, the dictates of the day are the “ideas and concepts”.
In the knowledge-oriented economy, universities and research institutions play a key and dynamic role in the economy.

Universities and other research institutions are entangled in many types of researches with enormous potential of creating value and attend the problems in the society.
Research Management and Intellectual Property

- For decades, universities and R&D institutions in the developing economies have not been associating themselves with IP.
  - Neither promotion nor protection;
  - IP- Not in their teaching curriculum;
  - No national and/or institutional IP policies;
  - Researchers -interested with the immediate economic gains – at the expense of the long term value that can be captured from research outputs using the IP system.
The Changing Research Landscape

- From the mid-1980s - change of global policies - increasing western influence - liberalization of the economy – the key players are in the private sector

- Increasing collaboration with the western research institutions brought-in **new research values** - the need to have clear guidelines on ownership of research outputs;

- Inadequate and Diminishing Financial Support from the governments;

- Can the IP management system fill the gap and strike a balance?
Why IP Management?

1. As a way of tapping value from research;
2. As a way of creating additional incentive to researchers;
3. As a way towards developing beneficial linkages with other research institutions;
4. As a way of forming long-term beneficial partnerships with the private sector – SMEs, start-ups;
5. As a means of attracting research funding from private sector;
6. As a means of gauging the impact of research to the society;
7. As a way of repositioning R&D Institutions;
Integrating Research Management with IP…

A typical process of integration starts with Institutional IP Audit.

IP Audit serves the following functions:

- To identify existing IP potentials from research reports/results;
- To identify potential partners in developing the IP assets;
- To identify the risks;
- To identify market opportunities – for future commercialization;
- To identify the current research practices vs. best IP practices;
- To develop institutional IP portfolio.
The Next Step is to formulate the Institutional IP Strategy – the findings of the IP audit are extremely important in formulating the IP strategy.

The Institutional IP Strategy serves the following:

- It sets the institutional goals regarding IP;
- It sets the institutional priorities in harnessing IP;
- A self-assessment tool in gauging success or failure in harnessing IP;
- As a lobbying tool for research funding;
- To identify areas in the institution that requires short-term and long-term action;
- It identify the means of achieving the stated IP goals;
Integrating Research Management with IP...

- The IP strategy is followed by the setting of the institutional IP infrastructures:

Institutional IP Infrastructures entails:

- Institutional IP Policy;
- Institutional IP Guidelines;
- Intellectual Property Management Office;
- Integrating IP in curriculum in all disciplines;
Integrating Research Management with IP…

The IP Policy envisages, among other things:
1. Key policy issues as identified in the IP strategy;
2. The Scope of issues and persons covered;
3. Ownership of IP;
4. Processes – Operationalization;
5. Transfer/Commercialization of IP assets;
6. Benefit sharing scheme;
7. Enforcement;
8. Dispute Settlement.
Integrating Research Management with IP…

The Intellectual Property Management Office have the following traditional functions:

- It plays an advisory role on all issues relating to IP;
- It is responsible for implementation of the IP policy;
- Negotiating “Licensing-out” and “licensing-in” of the IP assets;
- Creating linkages between researchers and IPMO – a complex process;
- Taking all necessary timely actions to protect the IP interest of the institution;
- Filing of the Patent Applications – in most cases this may be sourced-out;
- Conducting institutional IP Audits;
- Reviewing of the Research Collaborative Arrangement – it may create tension with researchers;
- Carrying out IP awareness programs;
- Creating partnerships with potential users of various research results.
Integrating Research Management with IP...

**IP Best Practices in Research:**

1. Laboratory practices – the need to control access to information by the visitors;
2. The use of Lab Notebooks;
3. Signing of the Non-Disclosure Agreement;
4. Issues relating to material transfers;
5. Publish or Perish vs. Patent or Perish;
6. Freedom to Operate (FTO);
7. Intellectual Property Audit;
8. Intellectual Property Compliance;
9. Authorship/Inventorship
Integrating Research Management with IP…

The Research Cycle:

The Public/
The Government

Universities/
Research Outputs

Industry/Investors
Integrating Research Management with IP...

Commercial exploitation of IP

Research/IP Creation ➔ $ ➔ IP Protection ➔ IP commercialization
Integrating Research Management with IP...

Some of the Challenges:
1. The mindset change;
2. Budgetary Constraints;
3. Long Pay-back Period;
4. Conflict of interests (maintaining public interest vs. commercial interests);
5. Non-existence of the national IP policy frameworks;
Integrating Research Management with IP…

The way forward:
1. The need for R&D to take a proactive role in adopting the IP agenda;
2. Linking with WIPO and ARIPO for assistance;
3. Liaising with National IP office for expertise and advise;
4. Commit budget for IP Audit, Strategy, Policy, and Management Office;
5. Develop partnerships – i.e USHEPİA
The USHEPiA IP Initiative…

- Currently, USHEPiA have eight (8) partner universities:- UDSM, UCT, UoN, UB, JKUAT, University of Zimbabwe, University of Zambia, and Makerere University;

- The partner universities in 2004 recognized their lack of IP infrastructure in their respective institutions in terms of:
  - Policy Framework
  - Awareness
  - Absence of the IP or Technology Transfer Offices
USHEPiA Initiative Contd....

There were a unanimous feeling that all partner universities, except the UCT, need a support system in order to establish the IP policies and structures in their respective institutions;

The Need for Sharing of Expertise and Resources in IP Management in USHEPiA partners.
Given the limited available resources, it was decided that instead of spreading the resources to each partner university, the IP Coordination Office be set in one of the Partner University.

The UDSM was selected, after the bidding process, as the host for USHEPiA IP Coordination Office.

The office is currently set and is under the Directorate of Research.
The Role of the USHEPiA Intellectual Property Office

- To establish IP information and support infrastructure at the UDSM;
- Play an advisory role on all matter of IP to partner universities, in particular;
  - Collaborative Research agreements which have IP bearings.
  - Assist in IP awareness programs of partner universities;
  - Advise on suitable modes of university-industry linkage;
Liaise with partner universities to establish IP Offices and Policy mechanisms;

Enhancement of IP capacity at each partner university through awareness raising and introduction of IP teaching curriculum:

Currently, UDSM, UoN, UCT, Makerere, and UoZ have IP courses at the Faculty of Laws.

**The move is to make IP a cross-cutting course to cover other disciplines.**
Role of IP Office- Contd….  

- Establish a Link between the Universities and the Industry/Start-up companies and Investors in Technology and other forms of IP.
  - Through introduction of IP best practices and review of market strategies.
  - IP Audit
  - Licensing Agreements
  - Research Collaboration
The Goals-Expected Outputs

- IP policy formulation at each partner university
- Creation of defined IP infrastructures at each partner universities
- Raise of awareness on IP matters to the academic staff members of the partner universities.
- Establishment of the IP Best Practices at each partner university.
Goals - Contd....

- Increased research collaboration between USHEPiA partners and other R&D institutions
- Trickle-down effects of the benefits resulting from IP harnessing to the following parties:
  - Researchers
  - The Universities
  - Funding Agencies
  - The general public
  - The government
Conclusion

- R&D operate in a fast changing and complex business environment
- Property relations are being redefined – It is those with ideas that are set to rule the world;
- In order to develop a self-sustaining circle of research and innovation – IP is an indispensable agenda;
- The integration process requires investment in Time and Financial Resources
- The need for institutional collaboration on IP Management Capacity Building
THE END

THANK YOU

ASANTENI SANA
Saudin J. Mwakaje
saudinj@udsm.ac.tz