

# Learnings in Industry-University Research Agreements

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# Potentially critical issues

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- Confidentiality
- Ownership of IP
- Foreground vs background IP
- Publication rights
- Place of jurisdiction
- License terms
- Royalties
- Cost sharing models (patent filing)
- Third party obligations
- Different pace of management body

# The early drug development pipeline



The impact of owning IP

# Ownership of IP from sponsored research

## Key interests

### Industry

### University

To ensure that IP to compounds are not lost or minimized	To ensure results can be published in peer-reviewed journals
May seek tech transfer	Tech Transfer might conflict with publicly funded activities
Broad IP country coverage for multinational organizations	Potential for limited country coverage
Advancement of applied science	Advancement of basic science (applied science in certain cases)
Management of IP for commercial research	Management of IP in public interest
Industry may seek non-exclusive arrangements (excluded: compounds)	Academia seeks exclusive arrangements

# License terms, Funding models (1)

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## Industry

- Dedicated employees funding preferred
- Funding should be split into packages related to deliverables
- Milestones are acceptable but should reflect the maturity of the project
- Royalties should reflect the value and the maturity of the project
- Exclusivity only in late stage collaborations or when sponsor's compounds are used

# License terms, Funding models (2)

	Industry	University
Fee for service	Newly generated IP is owned by sponsor	Payment for service rendered but no right to publish
Collaboration with separable background and foreground IP	Industry receives commercial rights to use the results of the collaboration	University receives the rights to publish and for use in non-commercial research
Collaboration with joint IP	Industry and University co-own rights to results, prosecution negotiable	
Collaboration combined with Tech Transfer	First right to license after completion of collaboration	Spin-offs for commercial tech transfer
MTA	Needs clear definitions of expected results and use by both parties	

# Successful collaborations need.....

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- Specify list of needed IP
- Define background IP
- Bring all negotiating parties to the table early
- Limit university background IP to such needed for the collaboration
- Determine ownership and rights to use and/or to market
- Obtain Freedom to operate to use and/or to market
- Define needs of potential sublicensees (in case of affiliates)
- List all terms upfront (if possible)
- Address IP filing rights and costs upfront