



GUIDE FOR DEVELOPING AN IP STRATEGY FOR PROJECT APPLICANTS AND FUNDING RECIPIENTS

The purpose of this document is to provide guidance for project applicants to put together a strong collaborative project intellectual property strategy (**Project IP Strategy**) that will adhere to NGen's **IP Strategy** and provide the basis for how intellectual property (**IP**) will be managed during the project.

The **Project IP Strategy** is a critical component of the project and often requires negotiations between project partners, therefore clear alignment up front will make the entire process much easier.

At the application phase only a summary level of detail is required, however it will be considered by the project assessors while evaluating the project application.

This guide is meant to help the applicants draft both the **Project IP Strategy** summary for the application as well as the final **Project IP Strategy**. The main difference between them is the level of detail and final decisions required; in the summary it is expected that there is a high-level understanding whereas in the final more specific details and decisions are expected. The final **Project IP Strategy** is a requirement of the Master Project Agreement (MPA), which will be put in place after the project has been approved for funding.

The **Project IP Strategy** will provide input into the *project application*, *commercialization plan*, and the *collaboration agreement* between the project partners. The collaboration agreement is a requirement of the MPA and needs to be approved by NGen, it will govern how the project partners manage the project, including the IP. The more complete and clear the **Project IP Strategy** is, the easier and faster it will be to satisfy the requirements of the MPA to get the project started after funding has been approved.

NGen's IP Manager is available to support applicants in preparing their **Project IP Strategy**. The IP Manager cannot make decisions but can help facilitate discussions between project members and provide advice, education, and guidance.

Below are the suggested steps the consortium members should take to develop their **Project IP Strategy**. Where applicable the links to the related application questions are included.

STEP 1 Ensure Project Alignment and Focus

- A. Research, document, and review the market opportunity and make sure that there is a clear, shared vision of what the project will be delivering; for example, who the customers are, who the competitors are, what is the geographic scope, etc. (relates to question 1 and 4 of your application)
- B. Outline the solution or approach to understand the functionality of both the entire solution and the different components of the manufacturing innovation. This is essential for the



consortium to have a meaningful discussion on where the innovations or critical technical or performance advances are going to occur.

- C. At this point if you have not already done so, it would be beneficial to do some searching to see what other products or IP exist in the space which may create some risks or concerns for the project. (relates to question 1,2, and 3 of your application)
- D. Ensure that there is a clear understanding of each consortium member's role in the project. (relates to question 1 and 8 of your application)
- E. Make certain that there is an understanding of the strategic business (also scientific and academic) intentions of the participants beyond the project and how they relate to the technical advances produced by the project. This includes clarity on how each participant intends to benefit from what they are investing in. (relates to question 7 of your application)

There should be a strong understanding of the strategic intent underlying both the project and the interests of each project participant before moving on to the next step.

STEP 2 Identify IP and Confirm Ownership and Licensing Terms

It should be possible to discuss with each consortium member, the foreground IP they expect to own and the licensing terms they would be granting to the other members of the consortium. At the same time, each consortium member should be able to articulate what background IP belonging to other consortium members, if any, they require access to.

- A. Ownership. Confirm a description of the expected foreground intellectual property, expected ownership and the type of IP and legal means by which it would be protected. (know-how, trade secret, patents- pending or granted, copyright, trademarks, or industrial designs).
- B. Licensing of foreground IP. Step 1 identified the expected innovations or critical technical and performance advances in the main elements of the solution, and this should act as a starting point for the discussion around licensing of the foreground IP. In order to comply with NGen's IP strategy and develop a collaboration agreement that will be approved by NGen each foreground IP owner should expect that each project member has a right to access, on fair, reasonable and non-discriminatory terms and subject to relevant competitive issues, all foreground IP arising from the project, at least for internal R&D purposes.
- C. Each project participant should identify the background IP they expect to bring to the project, and which other project participants will require access to it in order to produce their project deliverables or sustain their technology development and commercialization objectives, along with the applicable licensing terms.

At this stage there should be a matrix or table showing who owns the expected foreground IP, licensing terms and any applicable access rights to background IP that all project members have had input into and agree with. NGen provides a template WORD table for this portion of the strategy.



STEP 3 Supercluster Advanced Manufacturing Ecosystem Leverage for IP

Supercluster ecosystem leverage is about building market and technology development relationships outside the project consortium to build momentum around the advanced manufacturing innovation and strengthen the ecosystem. (relates to question 7 of your application)

- A. Market Development. Confirm target customer segments as well as potential applications of the foreground IP to different industries, markets, geographies, business models etc.
- B. Supplier Development. Confirm how potential suppliers, technology partners etc. could leverage the innovation and foreground IP to strengthen the leadership position of the advanced manufacturing innovation.
- C. Researcher Development. Confirm how researchers or research networks may access the innovation and foreground IP to build the competitive advantage through continued technical performance advances and innovations.
- D. The Supercluster IP Manager will help the consortium identify a list of members that could have a potential market and technology development interest in the advanced manufacturing innovation, including access to foreground IP, and confirm those that the project consortium would be willing to enter into negotiations, if requested.

At this point, there should be an outlined approach to market, supplier and research development where members with a technology or business development interest would be able to negotiate opportunities to use, advance or support the advanced manufacturing innovation.

STEP 4 Complete Project IP Strategy

Combine all the results from steps 1, 2, and 3 into a draft **Project IP Strategy**, this draft is not a final version but should summarize discussions, capture decisions on roles, comment on how each organization plans to protect/preserve it's IP (for example do they have the necessary agreements in place for IP assignment with employees, do they know how to manage trade secrets, are they working with academic institutions does that impact the ownership of IP, any other IP concerns or issues), comment on their awareness of the prior art or other competitive solutions, do they have any freedom to operate work done or does it still need to be done, foreground IP ownership and all related licensing requirements.

Consortium members review the draft, identify issues, resolve what they can and confirm a series of steps for those that need more work to finalize.

The **Project IP Strategy** summary is added to the project application as a project document.

If the project is approved by NGen for funding the consortium members will review and finalize their positions in a final **Project IP strategy**. The final **Project IP strategy** will be reviewed and approved by NGen and will form a basis for the IP portion of the collaboration agreement that the consortium members will agree to.