Government Office for Technology Transfer

Intellectual Property Checklist

Context – Good Knowledge Asset management

[The Rose Book](#) provides guidance and support for public sector organisations to manage their Knowledge Assets and, in turn, fulfil their asset management responsibilities as set out in [Managing Public Money](#).

The Rose Book recommends that organisations develop a Knowledge Assets Management Strategy (KAMS) and as part of a KAMS there should be an intellectual property (IP) policy detailing management of IP, the protection process, costs and decision points. IP, including patents, trade marks, copyright, trade secrets, and know-how, is a sub-set of Knowledge Assets, which also include information and data.

Before reading this document, it is recommended that related Government Office for Technology Transfer (GOTT) guidance should be reviewed, specifically The Rose Book and [KAMS guidance](#). It is recommended that before drafting an IP policy an organisation should understand the principles of Knowledge Asset management in government and have begun work on developing its KAMS.

See Box 1 below for how relevant guidance and recommendations should be read and implemented.

Box 1 - GOTT Guidance hierarchy

1. The Rose Book

The Rose Book establishes the concept of managing knowledge assets in government and the public sector. It focuses on how to identify, protect and support their exploitation to help maximise the social, economic and financial value they generate.

The Rose Book recommends that organisations develop a KAMS.

2. KAMS

KAMS Guidance helps public sector organisations develop a KAMS and consider what is required to put this into practice to ensure effective Knowledge Asset (KA) management within an organisation.

The KAMS Guidance recommends that organisations develop an IP policy in parallel to their KAMS.

3. IP Policy Checklist

This IP Policy Checklist helps organisations to develop an IP policy as part of their KAMS.

Introduction to IP policy checklist

Good Knowledge Asset management requires the owner of any Knowledge Assets, e.g. a public sector body, to identify their assets, and control how the asset is exploited to realise maximum social, economic and financial value of a Knowledge Asset.

An IP policy provides organisational guidance specifically concerning how IP is identified, protected and exploited, how these decisions are made and by whom.

Completing the IP policy checklist will require a certain level of IP experience and legal expertise. It is therefore recommended that the IP policy is written by an employee of the organisation who has an appropriate level of expertise in IP management. If there is uncertainty regarding who this is in an organisation or whether this expertise exists GOTT is able to provide support with writing this policy – contact GOTT@dsit.gov.uk for support.

IP policy checklist

1. Purpose of Policy

The IP policy should detail why the document has been written.

- Why protection of IP is important for the organisation

    – This should link to the organisation's strategic objectives and state the benefits to the organisation from identifying, protecting and exploiting its Knowledge Assets, including IP (see Section 1 of the KAMS Checklist for more information)

- The objectives of the policy

- Any related organisational policy documents or other associated documents

    – For example, the organisation's KAMS, rewards to innovators policy, HR policies, employment term and conditions, finance policies etc.

2. Scope and Ownership

The IP policy should detail clear ownership of the policy as well as how and when the document will be reviewed.

It is recommended that there is periodic review of the IP policy by a governance structure that includes HR, finance, legal, KA SRO and commercial representatives, to ensure alignment with changes in law, policy and the organisational strategic objectives, and that risks are identified and managed.

- Scope

    – To whom does the policy apply?

    – What does the policy cover?

- Ownership of the Policy

    – Who has written or will write the policy? This might be your IP manager or Knowledge Asset officer[1]

    – Who is accountable for the policy and its ongoing implementation and maintenance?

    – Who will manage the day-to-day implementation of the policy?

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[1] Some organisations may appoint a dedicated IP manager to lead on IP, however in many organisations this may also be the KA manager. See Annex B of the SRO Checklist for more detail on the role of the Knowledge Assets Officer

    – What governance structures have approved the policy?

- Key contacts – who should people contact if they:

    – Have questions regarding the policy?

    – Think they have developed a protectable Knowledge Asset?

    – Are planning activity (e.g. contract some work) which could generate IP?

- Key dates, including implementation, planned reviews and revisions and any historical reviews and revisions
- Review process

    – Who lead reviews of the policy?

    – How often will the policy be reviewed? This will likely depend on the number and type of protectable Knowledge Assets in the organisation

    – What governance structures will approve any subsequent revisions?

3. Roles and responsibilities

The policy should describe the responsibilities of those involved in management of IP and in scope of the policy. Below are listed key roles and examples of the kinds of responsibilities to implement the policy effectively.

- All personnel including employees and contracted partners

    – Disclosure of new Knowledge Assets and IP

- Knowledge Asset management team e.g. IP managers

    – Review disclosures and add to Knowledge Asset or IP register where appropriate

    – Perform due diligence on any IP disclosures and make decisions on IP management e.g. when a patent should be filed or when an opportunity to exploit copyright should be escalated

- Knowledge Asset Senior Responsible Owner (SRO)

    – Oversee high level strategic decisions relating to IP management, sign off changes to IP policy and provide an escalation route for any significant risks or issues. For more detail see the [SRO Checklist](#).

4. Ownership of Assets

The policy should explain ownership of IP and who is covered.

- Those in scope may include:

    – Employees of the organisation

        - It is likely that IP created by civil servants in the ordinary course of their duties will be owned by the Crown. For other public sector staff it is likely that their organisation owns any IP they create, but to note this may be dependent on arrangements with parent bodies

    – Visiting staff e.g. researchers or secondees

- – Staff based temporarily outside of the organisation
- – Dual appointments (where relevant)
- – Students (where relevant)

- Explanation of ownership should include

    - – How inventors/creators are identified and determined
    - – How the relative contributions made by the inventors/creators to the new innovation are identified and determined
    - – How inventors/creators may be rewarded
    - – IP generated through procurement activities

        - It is important to consider ownership and rights of existing and potential Foreground and Background IP that might be used or generated in procurement contracts. Annex D of the Rose Book provides guidance on identifying and managing IP in procurement activities

5. Intellectual property rights

The policy document should cover the approach to protection for IP, which may include a variety of IP rights (IPRs), including:

- What forms of protection are likely apply to the most common types of IP in the Organisation (and staff should be most aware of)
- IPRs include:

    - – Registered Rights

        - Patents
        - Trade Marks
        - Registered Design Rights
        - Database
        - Plant Breeders Rights

    - – Unregistered Rights

        - Copyright (including software, code and algorithms
        - Trade marks
        - Designs
        - Know-how and trade secrets

- How the appropriate protection route(s) is decided and how the budget will be determined for long term maintenance of any registered rights.
- How will the IPRs be recorded and records kept up to date?
- How will the organisation approach infringement of IPRs by a third party?
- How will the organisation ensure they are not infringing on third party IPRs?
- What is the organisation's approach to protection of IP in other territories?

6. Approach to exploitation

The policy document should explain the organisation's approach to the major exploitation routes and should include:

- How IP will be evaluated for an exploitation route
- What criteria IP should meet to justify the exploitation route
- The decision making process to agree an exploitation strategy
- Exploitation routes include:

    – Licensing

        - The IP policy should set out when an open licence is appropriate and how the decision is made whether to use this route
        - This should make note of any other UK legislation and regulations which should be compatible with proposed licensing actions

    – Sharing across the public sector
    – Spin-out company creation
    – Joint venture creation
    – Consultancy services
    – Transfer of IP (assignment)

- The policy should identify the situations where there is potential for conflict of interest in respect of IP commercialisation and should cross-reference the organisations Conflict of Interest policy
- What should be considered if seeking to exploit IP in other territories

7. Governance and Decision making

The policy should explain how decisions involving IP will be made and activities undertaken, including:

- The structure and composition of relevant decision-making governance structures (e.g. committees) and how they interact with other structures such as the Executive Committee
- What decisions will be undertaken by the relevant committee and which decisions are delegated to individuals or business units, such as the IP manager.
- Some recommendations of the types of decision (and ownership) that should be documented are listed below:

    – Scoping decisions made on disclosures, including due diligence on the information and proposed inventors/creators and freedom to operate searches
    – Decisions on exploitation and/or commercialisation strategy following evaluation of new innovations

- Decisions on IP protection and prosecution, including filing and management of patent applications, registrations and related IP protection
- What team is responsible for negotiating commercial terms of an IP-based deal e.g. a licence, assignment, spin-out creation etc.
- Where approval sits for the commercial terms of IP-based deals and any processes involved
- Decision to terminate exploitation and to abandon a patent application or other protection
- Decisions on rewards in respect of IP exploitation

• A link to where detail on authorised signatories can be found

• Approaches that may generate revenue should be within the organisation's parliamentary ambit set out in HM Treasury's Main Supply Estimates, where applicable