

**KENYA FORESTRY RESEARCH INSTITUTE
(KEFRI)**

**INTELLECTUAL PROPERTY
RIGHTS POLICY**



FEBRUARY 2007



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INTELLECTUAL PROPERTY RIGHTS POLICY

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1.0 Introduction

1.1 Vision, Mission and Mandate of KEFRI

KEFRI is a national institute created through the Science and Technology Act (CAP 250) of 1980. It also operates under the State Corporations Act (CAP 446) of 1986. The following are the KEFRI vision, mission, mandate and core values.

Vision

To be a centre of excellence in forestry research, technology and dissemination of information for development.

Mission

To conduct research and provide information and technologies for sustainable development of forest and allied natural resources.

Mandate

The mandate of KEFRI is to:

- (i) Conduct research in forestry;
- (ii) Disseminate research findings;
- (iii) Co-operate with the research bodies within and outside Kenya carrying out similar research; and
- (iv) Establish partnership with other organizations and institutions of higher learning in training and on matters of forestry research.

Core Values and Principles

KEFRI embraces the following core values and principles in carrying out its mandate:

(i) Team Work

Promotes collective participation of its staff in implementation of its

mandate to achieve its goals.

(ii) Integrity

Upholds firmness, openness, transparency and accountability within the Institute and in provision of services to clients.

(iii) Collaboration

Builds strong linkages with stakeholders and partners.

(iv) Financial Justification and Impacts

Remains sensitive to costs and benefits of all activities by the Institute.

(v) Monitoring and Evaluation

Mainstream monitoring and evaluation in implementation of all KEFRI activities.

(vi) Maintaining Clean Environment

Upholds maintenance of clean environment in KEFRI premises and resources, and to promote the same with partners and clients.

1.2 Rationale for KEFRI Intellectual Property Rights Policy

Technology development and utilization of innovations are considered as important vehicles for sustainable conservation of biodiversity, poverty alleviation and wealth creation. Technologies and innovations must therefore not only be developed but also managed. The World Intellectual Property Organization (WIPO) encourages establishment of technology and innovation management offices in developing countries and such initiative is being undertaken in Kenya through the Kenya Industrial Property Institute (KIPI). The rationale for management of technologies and innovations is justified by the facts that:

- (a) Technology gap between north and south is widening;
- (b) There is inadequate capacity in developing countries to understand the status of national Intellectual Property Rights (IPRs), and manage technologies and innovations; and
- (c) Limited free access and exploitation of generated knowledge through research.

The challenges for KEFRI IPR Policy would be:

- (i) To avail competent technology management so that useful inventions are protected and exploited through well-established mechanisms;
- (ii) To ensure maximum benefit from research and development (R&D) initiatives, indigenous technologies and have access to latest foreign technologies; and
- (iii) To ensure optimum sharing of benefits arising from innovations and inventions between developers and users of the technologies.

1.3 Objectives of the Policy

The objectives of the KEFRI IPR policy are:

- (a) Promoting the progress of science and technology through focused R & D process
- (b) Ensuring that discoveries, inventions and creations generated by KEFRI and its collaborators are owned and availed to the public for advancement of development;
- (c) Facilitating use of KEFRI products through protection and marketing, for greater national and international impact and institutional benefit;
- (d) Encouraging innovations and motivating inventors; and
- (e) Generating funds to promote further research and innovations.

2. Definitions of Terms

Access - Acquisition of biological material derivatives through laid down regulations under the Convention on Biological Diversity (CBD) and guidelines from Food and Agricultural Organisation (FAO), World Trade Organisation (WTO), Bonn and African Union (AU).

A patent – Is an exclusive right granted for an invention, which is a product or a process that provides a new way of doing something, or

offers a new innovative and useful technical solution to a problem in industry.

Associate – shall mean any postgraduate students, postdoctoral fellows, visiting scientists and any other individuals participating in research sponsored or hosted by KEFRI, or making significant use of KEFRI's facilities, funds or other resources.

Benefit sharing - Distribution of benefits derived from biological resources as per Bonn CBD, FAO guidelines, etc.

Collaborator - A person or organization working with KEFRI to create or produce an innovation or invention.

Copyright – Is a legal term describing rights given to creators for their literary and artistic works. This include literary novels, poems, plays, reference works, computer programs, databases, films, musical compositions and choreography, artistic works such as paintings, drawings, photographs, sculptures; architecture; maps, multimedia creations and technical drawings.

Farmers' rights – Rights that the farmer deserves to be accorded within the framework of the IPRs.

Indigenous knowledge - Refer to community intellectual rights and community knowledge as defined by AU model law on access and benefit sharing.

Industrial Design – Is the ornamental or aesthetic aspect of an article. It may be the shape, the patterns, lines or colour of an article. Industrial designs are what make an article attractive and appealing, hence they add to the commercial value of a product and increase its marketability.

Innovation - The introduction of new things, ideas or ways of doing something

Intellectual Assets (IA) - Refer to products that contain input of human creativity. IA shall include all intellectual products created by

people working in KEFRI. These may include among others, employment agreements, visiting scientists/students agreements, collaborative agreements, funding donor/agreements, licenses and material transfer agreements, permission/license to published materials, photographs, art work, etc; other KEFRI products such as laboratory/field note books, software, publications, "know how", innovations and materials.

Intellectual Property (IP) - Intellectual properties are assets that have been protected under laws that give the originator(s) certain rights over their creation. IP includes patents, trade secrets, trade marks, sui generis, plant variety, mask works, geographical indications, utility patents, all forms protectable by law and limit unauthorized use by others than the right holder(s).

Invention - A thing or an idea that has been designed or produced for the first time

Inventor – Means an Inventor(s), Creator(s), Breeder(s) and is understood to mean the person(s) who actually devises an invention or creates a work or breeds a plant as defined by the Seeds and Plants Varieties Act Cap 326.

IP policy - Is a document that guide in management of institutional intellectual assets and intellectual property as per the organization mission and mandate.

Modification - The act or process of changing something in order to improve it or make it more acceptable

Organism - A living thing.

Patent Protection – Means that the invention cannot be commercially made, used, distributed or sold without the patent owner's consent. These patent rights are usually enforced in court, which holds the authority to stop patent infringement.

Proprietary Information - Means trade, either secrets or commercial or financial or other information that is privileged or confidential.

Trademark – Is a distinctive sign, which identifies certain goods or services as those produced or provided by a specific person or enterprise. The system helps consumers identify and purchase a product or service because its nature and quality, indicated by its unique trademark, meets their needs.

Utility Model – Is an invention, which does not meet all the requirements of patentability but has an industrial use. In Kenya, utility models are protected by Industrial Property Act of 2001.

3.0 Application and Management of KEFRI Intellectual Property

3.1 Intellectual Property Rights Covered

KEFRI IP policy covers the following IPRs and related issues:

1. Industrial designs
2. Patents
3. Utility models
4. Copyright in literary work
5. New plant or tree varieties
6. Contract research
7. Research collaboration
8. Trade and service marks
9. Process and mechanism

3.2 Application of the Policy

The IP policy is governed by Kenyan law and is applicable to: All KEFRI employees, Students on attachment, research associates, collaborators and partners.

3.3 Management

- (a) KEFRI is a Kenya government institution, established under the act of parliament, adhering to all government regulations in regard to

its establishment. In this respect the Kenyan government is a signatory to CBD, FAO agreement on genetic resources, the international treaty on plant genetic resources for food agriculture, WIPO, WTO, among others. Thus KEFRI will adhere to all principles and guidelines stated there in.

- (b) All rights to data, whether in raw form of laboratory/field note books, research results and products belong to KEFRI as indicated in contractual agreements as per employment. Non-KEFRI staff will sign appropriate intellectual forms as attached.
- (c) KEFRI will manage all issues associated with intellectual property rights with integrity, equity, responsibility and accountability.
- (d) KEFRI will develop a mechanism of protection of information through copyright or trademarks to acknowledge its contribution.
- (e) KEFRI will seek IPR protection where advanced technology input, in partnership with a private sector(s) has been involved, for purposes of commercialization.
- (f) Information, data, knowledge and invention generated by KEFRI and partners will be utilized accordingly as per the established agreements, through memorandum of understanding, among others. Thus, KEFRI will not allow the use of generated products through partnership without its consent as per the agreement. Approval may be withheld if contrary to mission of KEFRI.
- (g) KEFRI will comply with national laws and regulations relevant for the use of protected intellectual assets, for example, laws and regulations being enforced by Kenya Industrial Property Institute (KIPI), National Environment Management Authority (NEMA), Kenya Wildlife Service (KWS), National Museums of Kenya (NMK) and Kenya Plant Health Inspectorate Service (KEPHIS).
- (h) KEFRI will register its name and logo as trademarks.

- (i) All researchers in KEFRI shall be obliged to disclose all potentially protectable creations and inventions made in the course of their responsibilities.

4.0 Ownership

4.1 Important Agreements

- (i) KEFRI will formulate appropriately, as the need arises, agreements and other related contractual documents, for the management of Intellectual Property Rights, such as:
 - a. Participation Agreement;
 - b. Material Transfer Agreement (MTA); and
 - c. Confidentiality Agreement.
- (ii) As a way of enforcing KEFRI Intellectual Property Rights Policy, there shall be a Participation Agreement that confirms acceptance of the policy by employees, students and all other category of researchers. Each Head of Programme/Division/Centre must confirm that a valid Participation Agreement is on file before any resources are made available to any researcher.
 - a. New employees shall be required to sign the Participation Agreement upon taking up appointment.
 - b. Others shall be required to sign the document upon the initiation of the research project/programme.
- (iii) There shall be Material Transfer Agreement, which will govern the transfer of proprietary tangible property, often biological materials to or from KEFRI during collaboration with other institutions and industries.
- (iv) Each Head of Programme/Centre shall ensure that

appropriate Material Transfer Agreement is developed with the collaborating institution and signed by the authorized officer of KEFRI and authorized officer from participating institution.

- (v) There shall also be Confidentiality Agreements to govern research, ideas and information between KEFRI and other institutions.

4.2 Ownership of IP rights

- (i) KEFRI shall own any Intellectual Property that is made, conceptualized, discovered or created by a member of staff, students in attachment, visiting researchers, and collaborators in the course of their employment and responsibilities or any person who makes significant use of the institute's resources in connection with the development of such Intellectual Property.
- (ii) 'Resources' shall be considered as tangible resources provided by KEFRI to investors including:
 - a. Office, lab, studio space and equipment;
 - b. Computer hardware, software and support;
 - c. Secretarial services;
 - d. Research, supervision and lab assistance;
 - e. Supplies and utilities;
 - f. Funding for research,
 - g. KEFRI transport;
 - h. KEFRI demonstration plots and plantations; and
 - i. KEFRI time.
- (iii) The use of other facilities available to the general public shall not be considered as significant use of KEFRI facilities and equipment.
- (iv) KEFRI shall own any Intellectual Property that is made,

discovered or created by anybody who is specifically hired or commissioned by KEFRI for that purpose, unless otherwise provided by written agreement between such individual and KEFRI.

5.0 Administration

The KEFRI Intellectual Property Rights Policy will be coordinated by the Manager, Corporate and Public Relations, in the Directors Office. An Intellectual Property Management Committee shall be established to guide the IP Coordinator.

(a) Functions of Director

- (i) Developing and updating KEFRI IPR Policy
- (ii) Managing KEFRI IPR Policy
- (iii) Chairing Intellectual Property Management Committee Meetings.

(b) Functions of Manager, Corporate and Public Relations

- (i) Developing annual work plan and budget for IPR
- (ii) Coordinating activities of IPR
- (iii) Monitoring and evaluating IPR activities
- (iv) Secretary to the Intellectual Property Management Committee
- (v) Liaise with KIPI and any other relevant bodies.

(c) Functions of Intellectual Property Management Committee

- (i) Providing general guidance on KEFRI IPR
- (ii) Holding quarterly IPR meetings
- (iii) Approving IPR work plan and budget
- (iv) Approving distribution of IPR benefits
- (v) Monitoring and evaluating IPR activities.

6.0 Revenue Distribution From Commercialized Intellectual Property

- a. Gross income shall be understood as funds obtained from commercialization of intellectual property
- b. Net income shall be understood as gross income less expenses incurred by KEFRI for Intellectual Property Rights processing, protection, maintenance and licensing.
- c. Where an invention made by an employee of KEFRI is commercialized, the net income shall be distributed as follows:
 - i. Inventor(s) - 40%
 - ii. IP fund of KEFRI – 40%
 - iii. Inventor's research – 20%
- d. These percentages shall be reviewed regularly.
- e. In the absence of a written agreement to the contrary, multiple Inventors shall receive equal portions of the inventor's share of net revenue. When multiple inventors are located on different centres/labs, the same shall also apply to the units.
- f. It should be understood that the Inventor shall continue to receive his/her share even after leaving employment of KEFRI. In the event of death of the Inventor, the legal next of kin shall continue to receive the benefits.
- g. Collaborating institutions shall be free to use their own policies and practices as regards distribution of their respective shares of royalties, but such policies and practices shall not contravene or be contrary to this policy.

- h. Benefit sharing mechanism with private sector investor shall be agreed upon prior to starting the project.
- i. Where applicable, benefit sharing with local communities that have participated in research, that has generated revenue, shall be discussed and agreed upon.

7.0 Exceptions and Variations

- (i) The Director KEFRI may, with the advice of the Intellectual Property Management Committee, agree to variations of this Policy by express written consent on a case-by-case basis.
- (ii) Variations made under this Policy shall only be agreed to on the premise that they do not in any way prejudice the overall aims and objectives of KEFRI.

8.0 Disputes

Any dispute arising from the terms of implementation of this Policy shall be submitted to the Intellectual Property Management Committee for resolution. Where such practices are not successful, the dispute shall be referred to the Board of Management of KEFRI.

ANNEXES

ANNEX I: THE KEFRI INTELLECTUAL PROPERTY AGREEMENT

I understand that the Kenya Forest Research Institute (KEFRI) is governed, in the handling of intellectual property by its official policy titled 'The KEFRI Intellectual Property Rights Policy 2006', which I have read and understood, and I agree to abide by the terms of that Policy.

Pursuant to that Policy, and in consideration of my employment by KEFRI, the receipt of remuneration from KEFRI, participation in projects administered by KEFRI, access to or use of facilities provided by KEFRI, access to information provided by KEFRI, and/or other valuable consideration, I hereby agree as follows:

1. That, subject to any agreement expressly stating otherwise, the Institute shall have ownership of all rights and obligations relating to any patentable inventions and innovations eligible for protection by other forms of intellectual property such as utility models or petty patents, trade secrets and other rights in information relating to useful articles of commerce that are produced in the course of official duties, or making more than incidental use of KEFRI's time and resources.
2. That I shall execute and deliver all documents and records and do any and all things necessary and proper on my part to effect the terms of paragraph 1 of this agreement, provided that all such activities shall be undertaken at the expense of KEFRI.
3. That I shall immediately notify the Intellectual Property Management Committee, by the means set out in the KEFRI Intellectual Property Rights Policy, when it first becomes apparent that an invention, discovery or technical development has been made in the course of official duties, or making more than incidental use of KEFRI's time and resources.

4. That I shall maintain full confidentiality regarding all information that has been the subject of an Invention Disclosure. This requirement may be terminated by the express written consent of the Chairman of the Intellectual Property Management Committee or at such time that the information is clearly considered to be in the public domain, whichever may be the earlier.

5. That I shall make and maintain adequate and current records of all information relating to any research undertaken in the course of official duties, or making more than incidental use of KEFRI's time and resources, in such forms as written notes, tables, sketches, drawings, spectra, chromatograms, photographs, computer diskettes, computer software, databases and the like or reports relating thereto, which records shall be and remain the property of and available to the Institute at all times and which shall be surrendered to the Institute in the event of the cessation of our relationship.

6. That I shall undertake to preserve samples of all isolates, fractions, compounds

or modifications of these that may be undertaken, all of which shall also be and remain the property of and available to the Institute at all times and which shall be surrendered to the Institute in the event of the cessation of our relationship.

7. That I am presently under no obligation to any third person, organisation or corporation in respect to any patentable inventions and innovations eligible for protection by other forms of intellectual property such as utility models or petty patents, and other rights in information relating to useful articles of commerce, or intellectual property rights thereof which are, or could be reasonably construed to be, in conflict with this Agreement or the terms of the KEFRI Intellectual Property Rights Policy.

NB: Where associates of KEFRI have prior existing employment agreements that conflict with the terms of either this Agreement or

the KEFRI Intellectual Property Rights Policy, they should immediately contact the Manager, Corporate and Public Relations, as an alternative agreement may be necessary.

8. That I will not enter into any agreement that might create rights to any patentable inventions and innovations eligible for protection by other forms of intellectual property such as utility models or petty patents, trade secrets and other rights in information relating to useful articles of commerce, or intellectual property rights thereof which conflict with this Agreement or the terms of the KEFRI Intellectual Property Rights Policy.

That in the event of the cessation of my relationship with the Institute, I, and my estate, heirs and assigns, shall continue to be bound by the terms of this Agreement and the terms of the KEFRI Intellectual Property Rights Policy.

Name of Employee/Associate: _____

Date: _____

Signature: _____

Address: _____

Name of Witness: _____

Date: _____

Signature: _____

Address: _____

ANNEX II: KEFRI-STANDARD MATERIAL TRANSFER AGREEMENTS

Parties:

KEFRI

Director: _____

Principal Scientist: _____

Address: _____

Recipient

Scientist: _____

Institution/Company name: _____

Address: _____

PURPOSE

The material is released to recipient under the following requirements and conditions:

1. Information is provided on type of material and quantity under transfer.
2. The intended use of the material is clearly stated.
3. That material shall not to be transferred to third party without KEFRI consent, or under different arrangement.
4. That the material is not for commercial use or making profit without approval by KEFRI.
5. That KEFRI shall be updated of progress and results, and any arising publication, thereof should acknowledge KEFRI contribution.
6. That it is the responsibility of the recipient to comply with all laws, regulations governing the materials, accessibility, including permits

before its release.

7. That KEFRI gives no warrants on use or applicability of the said material.
8. Upon completion, the material will either be returned or destroyed based on the attached instructions.
9. In the event of desire for joint ownership of KEFRI material, for whatever reason, a meeting will be arranged between parties to explore partnership possibilities.
10. That confidential or proprietary material shall not be disclosed to third party, unless the material or information is within public domain.
11. If parties agree to enter into another project, a new agreement shall be negotiated.
12. Technology transfer, benefit-sharing mechanisms shall be agreed upon with both parties.
13. This material transfer agreement shall be governed through the relevant government law.
14. The duration and effective date of the agreement shall be on the date of last signature.

FOR KEFRI

Name: _____ Date: _____

Signature: _____

Address: _____

Name of Witness: _____

Date: _____

Signature: _____

Address: _____

FOR RECEIPT

Signature: _____ Date _____

Address: _____

Name of Witness: _____

Date: _____

Signature: _____

Address: _____
