

About IP Co-Ownership

Intellectual Property ownership is defined in the national IP laws of each country. There may be relevant provisions in patent/copyright laws, employment laws, laws on employees' inventions, which contain chapters relating to inventions made by a university or other publicly funded research institutions dealing with university-created IP, and technology transfer; or even *sui generis* laws that govern such rights.

While there are important differences among national laws and also among the IP policies of different universities or other publicly funded research institutions, the general guideline is that, where IP emanates from research funded by the government, the university or publicly funded research institution, owns the IP. Commercialization of such IP, should be a balance between private interests and the broader public interest. Research collaboration will generate new intellectual property (foreground IP), and as such it is important to consider ownership and management of such IP and to study the national legislation where research is carried out to ensure that the corporation either owns the IP, or obtains an exclusive right to its exploitation. These aspects should be appropriately addressed in the joint development agreement so as to secure appropriate rights for ownership and exploitation of IP.

In our session today we will consider the cases where an invention is made by multiple inventors from different countries and the subsequent patent application is co-owned by multi-national research institutions.

Our experienced panel will elaborate on the application and interpretation of the law. Is Exchange control approval of FinSurv necessary for the assignment of the South African inventor's share to the non-South African applicant? Is the South African co-inventor assigning a proportional share of its right to IP to the off-shore entity? Secondly, would NIPMO approval be required?



Madelein Kleyn- Moderator

**Co-Chair of LESI PTLC
CEO, Mad K IP Consulting (Pty) Ltd and Director
Technology Transfer, Innovus**

Madelein Kleyn has more than 27 years international experience as intellectual property practitioner, patent attorney and in-house legal corporate counsel in the petrochemical and agri industries. She is presently the Director, Technology Transfer at Innovus, the division of Stellenbosch University accountable for the commercialisation of IP emanating from the University. She also is the CEO and founder of Mad K IP consulting (Pty) Ltd a private company advising clients on IP matters.

She is a qualified chemical engineer, an admitted attorney of the High Court of South Africa and a registered South African patent attorney. She holds a LLM in tax law and PhD in intellectual property law. Her technical expertise is in the area of petrochemicals, chemistry, process engineering, explosives and agriculture.

Madelein's main areas of expertise include IP Portfolio management, IP policy and strategy development and implementation. She regularly advises on corporate governance and IP risk management and specialises in drafting and advising on IP-related business transactions, including technology transfer and licensing including off-shore transactions and Exchange Control matters.

Madelein has authored and presented various articles, papers and publications on IP matters internationally specifically on technology and IP licensing and commentaries on national IP related legislation. Since 2014 she is the co-editor of the journal "International Pharmaceutical Law" and is also a co-author of the South African Chapter of this publication.

She is a member of American Chemical Society, INTA, LESI, LES SA (Past President), RTTP and SAIPL (Editor of IP Briefs™).

Madelein has been included in the IAM Strategy 300 - The World's Leading IP Strategists since 2015 and featured in WTR300 World's leading trademark professionals since 2016.



Theo Doubell

Theo is a Director of Bouwers Inc. He has 5 years' experience in metallurgical research & development for the Anglo American group of companies and more than 25 years' experience in technology related legal matters, with extensive experience in IP management, procurement, protection, and commercialisation, including valuations.

He has acted for numerous local and multinational private and public entities as well as various national governments, including government departments and state owned enterprises, such as South Africa (the Departments of Science & Technology (DST), Trade and Industry (DTI), Treasury (Revenue Services (SARS)), Mozambique and the United Arab Emirates, universities and research counsels, with IP related strategies, policies, collaborative research & development and IP sensitive commercial transactions, including listings, group restructurings, mergers, public-private partnerships, industry clustering, taxation and valuations.

He was directly involved with the drafting of the Technology Innovation Agency Act and the Intellectual Property Rights from Publicly Financed Research and Development Act, as well as the proposed legislation regarding Biodiversity and Indigenous Knowledge.

He has valued numerous IA and IP portfolios for purposes of local and cross-border transactions as well as SA Reserve Bank approvals, tax write-offs and liquidations over a period of more than two decades. Theo has written and delivered various articles, papers, seminars and lectures, and participated in numerous panel discussions, workshops and conferences regarding IA & IP locally and internationally, including valuations, in cooperation with stakeholders such as the SA Government (DTI, DST, SARS and Treasury), the OECD, the Pan African Intellectual Property Organisation (PAIPO), WIPO, the International Partnership for Hydrogen & Fuel Cells in the Economy, LESI and LES SA.



Glen Sommerville

Glen, better known as Butch, is a man of few words and a wealth of experience. He is the Head of Exchange Control at Standard Bank.

Butch holds a BCom degree in Business Economics and an advanced diploma in Treasury Management from the institute of Bankers.

Butch has been involved in the Exchange Control environment, both at the South African Reserve Bank (SARB) for 12 years and thereafter at various Commercial Banks for 20 years advising on various exchange control matters.

Butch is also forever young! Notably from his profile picture.

He is a keen sportsman and played cricket and hockey until the Golf bug bit him.



Dr. Andrew Bailey

Andrew is the Senior Manager: Innovation in the Research Contracts & Innovation Department at the University of Cape Town. In this position, he is responsible for the protection of IP, implementation of the institutional IP policy, raising awareness of IP, as well as commercialisation of IP and technology transfer.

In the past he also worked for Science Councils: Mintek and the CSIR, as well as corporates AECI and the Dialogue Group. He received his PhD in Chemical Engineering from UCT and has completed courses in financial management through UNISA. He is a member of SARIMA (President-Elect), AUTM (International Strategy Committee: Africa Co-Chair) and LES.



Darren Margo

Darren is the Managing Director of Margo Attorneys Inc. He is a registered patent attorney, holding BSc degrees in Mathematics and Chemistry. He is also a registered tax practitioner, with a particular specialisation in the income tax and exchange control issues affecting intellectual property transactions. He commenced his professional career qualifying as a patent attorney at D M Kisch, Inc, drafting & prosecuting patent applications, and conducting patent searches, and drafting commercial agreements having IP as basis. Darren continued to immerse himself and practise in these areas when he joined Adams & Adams patent attorneys.

Darren was then invited to join Deloitte and Touche, where he was involved in the investigation and assessment of taxpayers' technologies and activities, with an eye to maximising R&D income tax deductions, and opinion work related to the same. Since then, he also enjoyed acting as advisor both to the National Treasury – on issues of legislative drafting in the Income Tax Act – and to the SA Revenue Services and the Department of Science & Technology – on issues of interpretation of income tax legislation, and its practice.

This led Darren to form the specialist IP firm and tax consultancy, Margo® Attorneys, Inc. in 2009, where he and his team continue to practise in these specialised disciplines. He also attends to the registration and maintenance of trade mark, patent, and design cases in South Africa and internationally.



Dirk Hanekom

Dirk is a Partner at Spoor and Fisher attorneys and a Patent Attorney. He holds an MSc (Chem) and LLB cum laude degrees. He is an Attorney of the High Court of South Africa. He has over a decade of experience in domestic and international patent matters.

He specialises in the preparation and prosecution of applications relating to pharmaceutical inventions, including novel compounds, formulations, and manufacturing techniques; and other general chemical technologies including petrochemicals, catalysts, polymer chemistry, pesticides, rubber, and general consumer goods. Dirk also advises clients on regulatory issues relating to these technology areas and has extensive experience in conducting freedom to operate investigations.

He is a Fellow – South African Institute of Intellectual Property Law (SAIIPL), an associate Member – Corporate Counsel Association of South Africa (CCASA), a Member – Southern African Research and Innovation Management Association (SARIMA), a member – International Association for the Protection of Intellectual Property (AIPPI) and a member – Legal Practice Council (LPC)



Ralph van Niekerk

Ralph is an Attorney of the High Court, South Africa, and a patent attorney. He is a partner at Von Seidels. His expertise includes patent prosecution, litigation, and technology licensing for a broad range of clients. His particular focus is on the ICT, software, and electronics industries where he has extensive experience in developing and managing large patent portfolios. His clients range from start-ups and universities to global technology companies.

Ralph's practice includes IP transactional matters, including negotiating and preparing license agreements, advising clients on cross border transactions involving IP, and assisting clients in applying for exchange control approval that may be required for such transactions.

Ralph holds undergraduate degrees in electronic engineering, computer science and law, and holds a Master of Laws from Stanford Law School. As one of the few practicing South African patent attorneys with a United States IP law qualification, Ralph offers clients valuable insight into IP matters in the US.

He is a Fellow of the South African Institute of Intellectual Property Law (SAIIPL), and its foreign Affiliate, American Intellectual Property Law Association (AIPLA), a member of Licensing Executives Society SA and a member of International Federation of Intellectual Property Attorneys (FICPI). He is the recipient of Fulbright Scholarship and featured in IP Star, Managing Intellectual Property, Patents (2016-2020).