

## **UofG MVLS Non-Disclosure Agreements Transcript**

### **Introduction**

The MVLS Translational Research Initiative supports academic staff, early career researchers and PhD students, giving guidance and advice on research translation, funding, industry engagement and commercial aspects of research undertaken at the College. Our colleagues in the Contracts Team, help advise and process a wide variety of legal agreements including non-disclosure agreements (NDAs) between people, institutes and industry.

These documents are also commonly known as Confidential Disclosure Agreements (CDAs) or Confidentiality Agreements (CAs) and exist between two or more parties wishing to disclose confidential information.

But why are these needed and when are they necessary?

By its very nature, research requires academics to discuss their work frequently. Researchers present their work in various formats and discuss new ideas with colleagues and collaborators. However, discussing work with collaborators without an NDA in place can have negative consequences for intellectual property protection, as information may be misused or passed on without the consent of the researcher. This in turn can reduce the impact of the research and prevent the full value of the innovation being realised.

CDAs are not meant to discourage collaboration, in fact, when used correctly, they help achieve research goals. They are extremely useful in the situations where you have a great idea or novel data that you know is potentially impactful or commercially valuable. Therefore, you should think twice before sharing without the necessary confidentiality protections in place.

### **Where and when is an NDA necessary?**

Patent applications can only protect inventions which are novel, i.e., unpublished or undisclosed. So, if you have published or spoken about your invention to someone who is not an employee of the University of Glasgow, for example a student or an external collaborator, without an NDA in place, there is little chance you can patent it.

Or you may wish to discuss your research with a company or other institution, with a view to developing a collaboration. Without an NDA in place, the other party is free to use any of the valuable information or data that you may have disclosed.

For example, Professor Plover has a PhD student working on a new DNA vaccine, with an interesting new mechanism of action for an important parasitological disease. The student presents their research at the British Society of Parasitology, with the sequence in a figure. Afterwards, they have very positive discussions with an enthusiastic layperson, who is a trustee of a major healthcare charity. In trying to explain the work, the student describes the new mechanism and adds that all of this has been accepted for publication.

What are the unintended consequences of this?

- a) Firstly, a novel idea has been disclosed and is now in the public domain. Any possibility of the University, supervisor or the PhD student being able to file a patent application on this new vaccine is gone, or at the very least, severely limited.
- b) Anyone attending the presentation could use this sequence or start working on the same idea and potentially beat the inventors to the market.

What could have prevented this?

- 1) Firstly, not putting the sequence on the poster or disclosing this in conversation.
- 2) Secondly, simply saying to the trustee “we would be delighted to talk with your charity but under NDA.”

This example is an exaggeration and would never happen, right? Wrong!

Similar issues arise frequently at the University. If and when the work gets promising and exploratory discussions about patenting start, then disclosures like this can come back to haunt both the researcher and the PI. However, if the cat has been let out of the bag, all is not lost. So long as both parties agree – a retrospective NDA can be put in place, although this is obviously not practical if the disclosure was made to a large group (for example, at a conference).

### **What is considered public information?**

Obviously, an NDA is not required for every interaction with someone outside of the University. Some relevant questions to consider are:

- Is there valuable University intellectual property (IP) or know-how that should be protected?
- Is there potential for the confidential information to be utilised by either party for commercial or academic gain?
- Is the University able to adhere to the confidentiality obligations imposed by an NDA?

If you are informed by an outside party that an NDA is required, enquire as to whether there are any other agreements in place.

Often an NDA is not what is required as a funding application has been submitted and an award has been made. In this case a collaboration agreement with appropriate confidentiality provisions would be more suitable.

You should also enquire with, and take a steer from, the relevant Principal Investigator.

### **General Rules of thumb**

- 1) If it's not published – think twice “do I really want this work in the public domain at this particular time?”
- 2) If the person you are talking to is external to the university, even if they may not fully understand what you are describing, do not disclose confidential information.

Published, or 'public' is the key difference here – it does not matter where it was disclosed or in what format. Once intellectual property rights (such as a patent) has been filed and published, researchers are free to talk about the research (to the extent that the conversation doesn't go beyond what was in the patent).

### **Different types of NDA**

There are four styles of NDA that the contracts team typically uses:

- A One-way student work placement NDA: where the student may be on a work placement at a company.
- A One-way NDA: where either the University or the company individually owns all IP.
- A Two-way or 'mutual' NDA: where both parties can disclose information to the other.

A Three-way (or multilateral) NDA: involving more than two parties in agreement.

### **Who can sign and approve NDAs?**

NDAs can only be signed on behalf of the University by certain individuals in the University of Glasgow Contracts Team. The members of this team have delegated authority to sign legal documents on behalf of the Secretary of Court.

Note that some NDAs can take the form of a letter and must have the University as the recipient of the confidential information. Please also take into consideration, the choice of law – Scots law is preferred.

Even if you have put an NDA in place, it is good practice to limit the extent of the disclosure to what is required for you to achieve the goals set out in your collaboration. Also, it is best that you limit the number of people to whom you disclose this information. Make sure that you clearly mark any confidential materials so that the recipient is aware that the obligation of confidence applies in respect to those materials.

### **Summary**

- NDA's protect the potential future of your research and allow you to achieve a wider range of impact on your terms;
- If you are compelled to use a non-University of Glasgow NDA, the contracts team can review the other party's template.

Finally, remember that the Contracts Team are on hand to help you with any questions that you may have.