Australian Government
Department of Industry and Science
IP Australia

IP Toolkit – Tool 1
Considerations Checklist

To be used for higher value (e.g. over $100,000) and more complex collaborations. A Mini Considerations Checklist is also available.

	Question	Contract position
	Project purpose and scope	
☐ 1.	**What is the overall purpose of the project and output?** Is the collaborative project mainly to: a) solve an industry constraint or problem b) commercialise or improve existing material c) develop knowledge in an area, or d) develop new material for commercialisation?	The collaboration project contract should: a) reflect the main reason for the collaboration, and b) cater for use of the output of collaboration from the start.
☐ 1.1	Who takes the lead? a) which party is driving the project b) who should be the project parties, and c) who should control the project?	The collaboration project contract should specify regular times and appropriate mechanisms so: a) project activity can be assessed by parties and acted upon b) project activity is managed by the party best placed to do it, and c) the lead party can influence the direction of the project to achieve its overall purpose.
☐ 2.	**Does the design of the project fit the overall purpose of the project and output? (see 8 below)** a) what are the project aims, scope and timing, and b) what is the budget of the collaboration?	The collaboration project contract should have elements that when taken as a whole reflect and fulfil the overall purpose.
☐ 2.1	What needs to be taken into account in design of the collaboration? What are the: a) key project deliverables (distinguished from other investigator research) b) outcomes c) key dates d) publications e) key risks, and f) approach?	The collaboration project contract should: a) deal with likely events, and b) specify what deliverables are required to be delivered by whom. The collaboration project contract could: a) require parties to take a 'good faith' approach (while interpretations vary, it can require parties to consider others' interests), and b) reflect what, if any, promises should be made and liability taken on by the parties in the liability provisions.
☐ 3.	**How and when should project payments be made?** a) how should project deliverables be reflected in milestones, and b) what proportion of payments should be linked to each milestone?	Payments should be made for key deliverables and be cognisant of inputs (including work undertaken at relevant stage) by the parties.
☐ 3.1	How is a milestone demonstrated to be met to the satisfaction of all parties?	Milestones in contracts should be able to be as objectively measured as possible (e.g. prototype complete and functioning as specified).
☐ 3.2	What should be the consequence of a milestone being met or not being met and what is a minor variation for all or specific milestones?	Where a milestone has a significant impact on a party, this should be reflected in the contract.
	Project inputs	
☐ 4.	**Who are key project personnel?** a) who is the Principal Investigator and Project Manager, and b) who are other key personnel?	How are people, including those integral to the project, incorporated in the contract? How should changes in personnel affect the contract?

	Question	Contract position
	Project inputs (continued)	
5.	**Which party contributes what?** (e.g. money, staff, equipment and/or facilities.)	Does the contract make clear what level and types of resources are contributed by each party and by when?
5.1	What background information and IP is needed for the collaborative project from each party?	The contract should specify in detail the resources provided by each party (including Background IP) and how they should be treated.
5.2	Do the parties own the IP inputs needed for collaboration (e.g. researchers may own some IP, and employment and third party agreements may be relevant, and are there any preconditions (such as approvals) for collaboration)?	Reflect in the contract how IP constraints are to be dealt with.
5.3	What is specified as confidential information from each party and what should other collaborating parties do in relation to this information?	Ensure the contract has provisions to specify confidential information and how other parties are to handle it in foreseeable situations.
	Project activity	
6.	**How is the project to be managed?** (e.g. through a project plan and weekly project meetings, measures to ensure the quality and identification of project IP and other research results, conflict of interest and privacy requirements.)	Specify project management expectations (e.g. regular team meetings, timing and content of updates on the project plan sent to parties fortnightly) and processes (e.g. methods to be used and responsibilities).
6.1	Who should be able to participate in the project or have access to project material and facilities (e.g. students, volunteers and IT access arrangements)?	Specify in contract whether student involvement is permissible and any conditions required.
6.2	Does one or more parties conduct searches and decide to register, maintain, monitor and defend IP, on what basis, and which party or parties pays for these activities?	Reflect this in the IP provisions in the contract.
6.3	How do parties notify, resolve and deal with changes and disputes quickly?	Reflect in the dispute resolution provisions in the contract.
6.4	How can a collaboration be terminated?	Reflect this in the termination provision in the contract.
7.	**How are parties able to monitor the project and how often should this occur?** (e.g. attend weekly project team meetings and update project plans/reports.)	Reflect this in the contract.
7.1	How is project IP identified and recorded, and by whom and how often?	Reflect requirements in the contract (e.g. IP register).
	Project outputs	
8.	**What does each party want to reasonably do with outputs in domestic and international markets?**	Reflect this in the contract, particularly in the IP, commercialisation and deliverables provisions.
8.1	What should each party be able to do other than to use project inputs and outputs solely to fulfil the project (e.g. publications and naming authors, further research, improvements and teaching)?	Reflect this in the IP, commercialisation, and deliverables parts of the contract.
8.2	Consider contract arrangements that create one or more licences to do these (e.g. license for Australia only).	Reflect this in licensing part of the contract.
9.	**Who should own specific outputs (including IP and other research results) or is another option such as a licence suitable?**	Reflect this in the IP, commercialisation, and deliverables parts of the contract.
9.1	How will these outputs/outcomes be managed?	Reflect this in the project details schedule of the contract.
10.	**What will each party need after project completion?** (e.g. confidentiality obligations, reasonable requests for data, further research and teaching permissions and/or ability to provide improvements.)	Reflect this in the contract and specify if particular timeframes are relevant. Reset form Print form