Intellectual Property Management - Consultant Personnel

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Anti-Counterfeit Agency – ACA

University of Nairobi - UoN

Kenya Association of Music Producers – KAMP

Kenya Revenue Authority – KRA

National Museums of Kenya – NMK

Kenya Medical Research Institute – KEMRI

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Intellectual Property Management - Consultant personnel

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**Foreword**

This Kenya Standard was prepared by the Intellectual property Services Technical Committee under the guidance of the Standards Projects Committee, and it is in accordance with the procedures of the Kenya Bureau of Standards.

## ****Introduction****

In the management and exploitation of Intellectual property, some organizations choose to rely on their own personnel but some use the services of external consultants, while some use both their own personnel and external consultants. The selection of a consultant by an organization is important for ensuring that IP management is efficient and effective.

This standard aims to provide guidance on the factors to be taken into consideration when selecting a IP consultant. It can be used by organizations in the selection of a IP consultant who is able to meet their specific needs, expectations and objectives in the realization of IP. It can additionally be used by

a) IP consultants as guidelines to IP consulting, and

b) Consulting organizations for the selection of IP management consultants

**1 Scope**

This standard provides guidance for the selection of Intellectual property management consultants and the use of their services.

It is intended to assist organizations when selecting an IP management consultant . It gives guidance on the process for evaluating the competence of IP management consultant and provides confidence that the organization's needs and expectations for the consultant's services will be met.

**2 References**

The following referenced documents are indispensable for the application of this document. For dated references, only the edition cited applies. For undated references, the latest edition of the referenced document (including any amendments) applies.

1. KS 2392, Intellectual property- Terms and definitions
2. KS 2480, Guidelines for the management of IP in research and development organizations

**3 Terms and definitions and abbreviations**

3.1 Intellectual property consultant

person who assists an organization on IP management, giving advice or information.

3.2 IP

Intellectual property

**4 Selection of an IP consultant**

**4.1 Input to the selection process**

**4.1.1 Organization's needs and expectations**

The organization should identify its needs and expectations of the IP consultant, based on its overall objectives for the realization of an effective IP management program. Top management should be involved in the process of evaluation and selection of the IP consultant.

**4.1.2 Role of the consultant**

The consultant's role may include but not limited to the following:

a) working with the IP manager

b) advising the organization in identifying the processes that may consume or generate IP assets;

c) assisting the organization in valuation of IP assets

d) assisting in identifying and evaluation of the training needs to enable the organization to appreciate IP management

e) Facilitate creation of awareness on IP management within the organization

f) assist the organization in developing IP management policy

**4.1.3 Evaluation of the competence of the consultant**

When evaluating the competence and suitability of a consultant, due consideration should be given to but not limited to the following:

a) personal attributes

b) relevant professional qualification

c) knowledge and skills necessary to meet the organization's overall objectives for the IP management

d) work experience

e) ethical behavior

**4.2 Competence of the consultant**

**4.2.1 General**

When selecting a IP consultant, the organization should evaluate whether the consultant maintains the competence required. The consultant should be able to demonstrate ability to apply knowledge and skills

**4.2.2 Personal attributes**

Personal attributes contribute to the successful performance of a IP management consultant. An IP management consultant should be:

a) ethical: fair, truthful, sincere, honest and discreet;

b) observant: constantly and actively aware of organizational culture and values, physical surroundings and activities;

c) perceptive: aware of and able to understand the business environment of the organization

d) versatile: able to adapt to different situations

e) tenacious: persistent, focused on achieving objectives; creative

f) decisive: capable of reaching timely conclusions based on logical reasoning and analysis;

g) self-reliant: able to act and function independently while interacting effectively with others;

h) communicative: able to listen to, and effectively interface with, all levels of an organization, confidently and with sensitivity to its culture;

i) practical: realistic and flexible with good time management;

j) accountable: able to take responsibility for his/her own actions;

k) facilitative: able to assist the organization's management and employees through the IP management plan

**4.2.3 Education, knowledge, professional qualification and experience**

IP management consultants should have appropriate education needed to acquire knowledge and skills useful for IP management. Knowledge and skills in this context means scholastic ability, such as linguistic ability and knowledge of basic science, economics and/or law.

The IP management consultant should have relevant work experience in aspects of IP management relevant to the organization. This can include policy formulation and/ experience in IP assets management responsibilities.

Verifiable references to past work experience and achievements are important and should be made available to the organization.

The consultant's relevant experience can include a combination of some or more of the following:

a) practical work experience;

b) experience in IP management;

c) experience in IP audits;

d) experience is policy development

e) experience in IP management standardization activities

The consultant shall demonstrate continuous professional development. The IP management consultant should maintain and improve competence through means such as additional work experience, continuing education, self-study, offering training, attending professional meetings, seminars, workshops and conferences or other relevant activities.

See annex A for further information

**4.2.4 Knowledge and skills specific to IP management**

An IP consultant is generally expected to be aware of technical regulations (including standards), legislations and policies governing the administration of IP.

**4.2.4.1 Relevant standards**

1. KS 2392, Intellectual property- Terms and definitions
2. KS 2480, Guidelines for the management of IP in research and development organizations
3. Identification and description standards for copyrighted contents

**4.2.4.2 Relevant legislations and regulations, conventions and treaties, protocols governing IP management**

IP management consultants should have general knowledge of:

1. Current legislations and regulations governing the administration and management of IP within the business environment(s) of the organization
2. International conventions, treaties and protocols governing the management of IP and the status of their ratification.

**4.2.4.3 General IP exploitation strategies**

Organizations develop and acquire IP assets for the purposes of exploitation and leveraging on business. An IP management consultant should be conversant with the various strategies of exploitation of IP assets, and be able to guide the organization on the best option depending on the business environment and long-term goals of the organization.

**4.2.5 Knowledge and skills specific to the organization**

The IP consultant should be able to understand the following:

1. IP assets consumed by the organization but not generated by the organization
2. IP assets that the organization may be able to produce

**4.3 Ethical considerations**

The organization should consider the following ethical issues when selecting an IP management consultant. The consultant should

a) avoid or declare any conflict of interest that affects the work to be carried out,

b) maintain the confidentiality of information provided by or acquired from the organization,

c) not offer services where the consultant does not have the necessary competence.

**5 Use of the IP consultant's services**

An organization may identify the need for a consultant's services. This may arise out of lack of qualified persons internally, or need to engage a person on temporary basis or need for an external assessment of the organization's performance on IP management.

**5.1 Consultant's services**

The organization may use consulting services to assist in one or more of the following:

a) developing an IP management strategy and policy

b) carrying out IP audit

c) carrying out training for staff

d) determining compliance with legislation and regulations

e) legal and technical advisory services

**5.2 Contract for consultant's services**

Organizations should ensure that they have a contract with the consultant. The contract should clearly defines the scope of work (including outputs), has realistic milestones and is cost-effective for the organization.

**5.3 Useful considerations for consultant's services**

In the process of using IP management consulting services, the organization should consider the following:

a) the consulting services should not result in unnecessary administrative expenses and documentation;

b) the success of a IP management depends mainly on the involvement and commitment of top management, cooperation and efficiency of regulatory authorities and not on the consultant alone;

c) the organization should assign a staff member to coordinate and monitor the consultant's activities;

d) employees are involved at all relevant levels, in order to cultivate the culture of "IP consciousness"

e) the consultant should be empowered to interact with the organization's processes at all levels in order to be able to appreciate the organization's processes;

**Annex A**

(informative)

**Evaluation of IP management consultants**

**Education and work experience for an IP management consultant**

The organization may use the education and work experience given in Table A.1 as a model when selecting IP management consultants. This table is only an example, it is not appropriate in all circumstances, and may depend on the scope of the IP management activities. In some cases, additional competencies may be required (see 4.2.4).

|  |  |  |  |
| --- | --- | --- | --- |
|  | **Education and work experience** | | |
| **Work experience**  **segments** | Complexity and diversity of the organization's business environment, business processes and products/services  - + | | |
| Total work experience | Fewer than two years may not be desirable | 4 years for people who have graduated from a  university (see Note 2), or 6 years for people  who have graduated from secondary  education (see Note 3) | More years is desirable |
| Work experience in IP  management | Fewer than two years may be not be desirable | At least 2 years | More than two years is desirable |
| Experience in the  IP management aspect (see 4.2.6) | At least one aspect of IP management | Have experience in more than one aspect | Have experience in at least three aspects, or equivalent personal development aspects |