European IPR Helpdesk

IP in FP7 – Challenges within collaborative research projects

Video-conference
Academy of Sciences of Moldova,
4 September 2013

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Roadmap

- General frame
- Rules and agreements
- Specific vocabulary in FP 7
- IP in the FP7 – Project life cycle

STOP

General frame
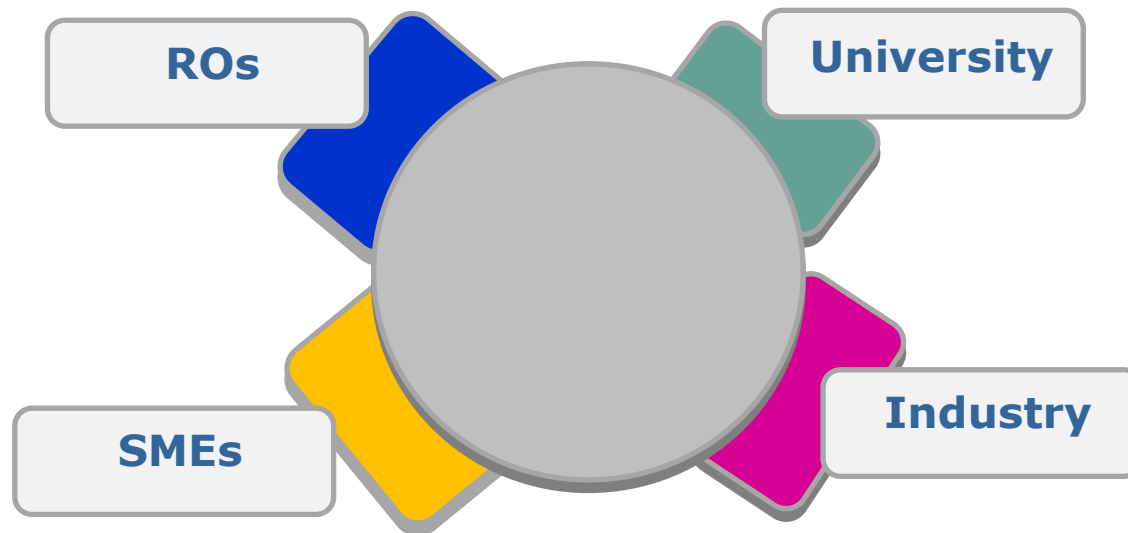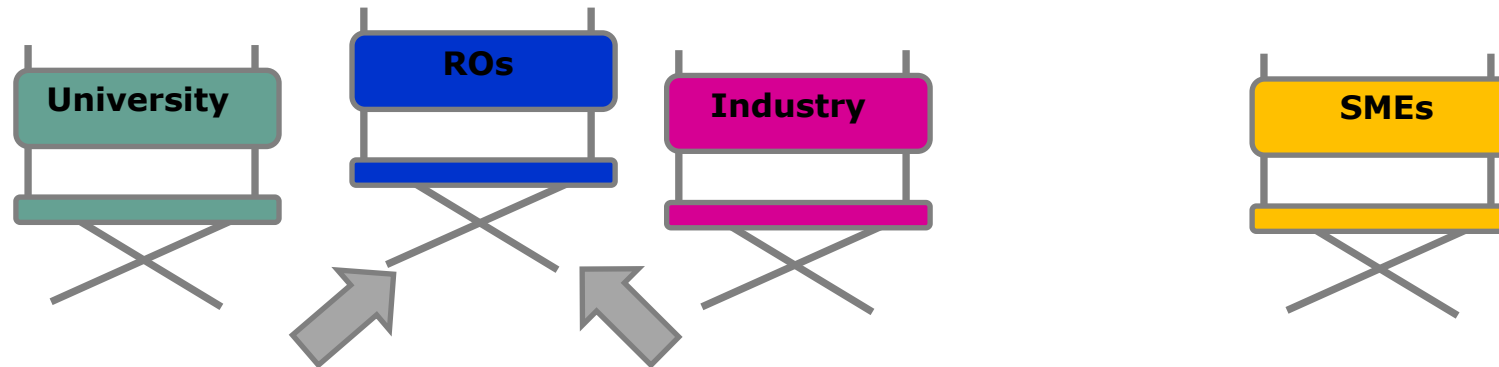
What are the characteristics of an EU funded project?

Collaborative projects

It is in the nature of collaborative projects that different partners with varying mindsets and interests come to sit at one table.

ROs

University

SMEs

Industry

Characteristics

University
ROs
Industry
SMEs

- Goal: publication
- Using results for future research and teaching activities
- Insufficient exploitation strategy
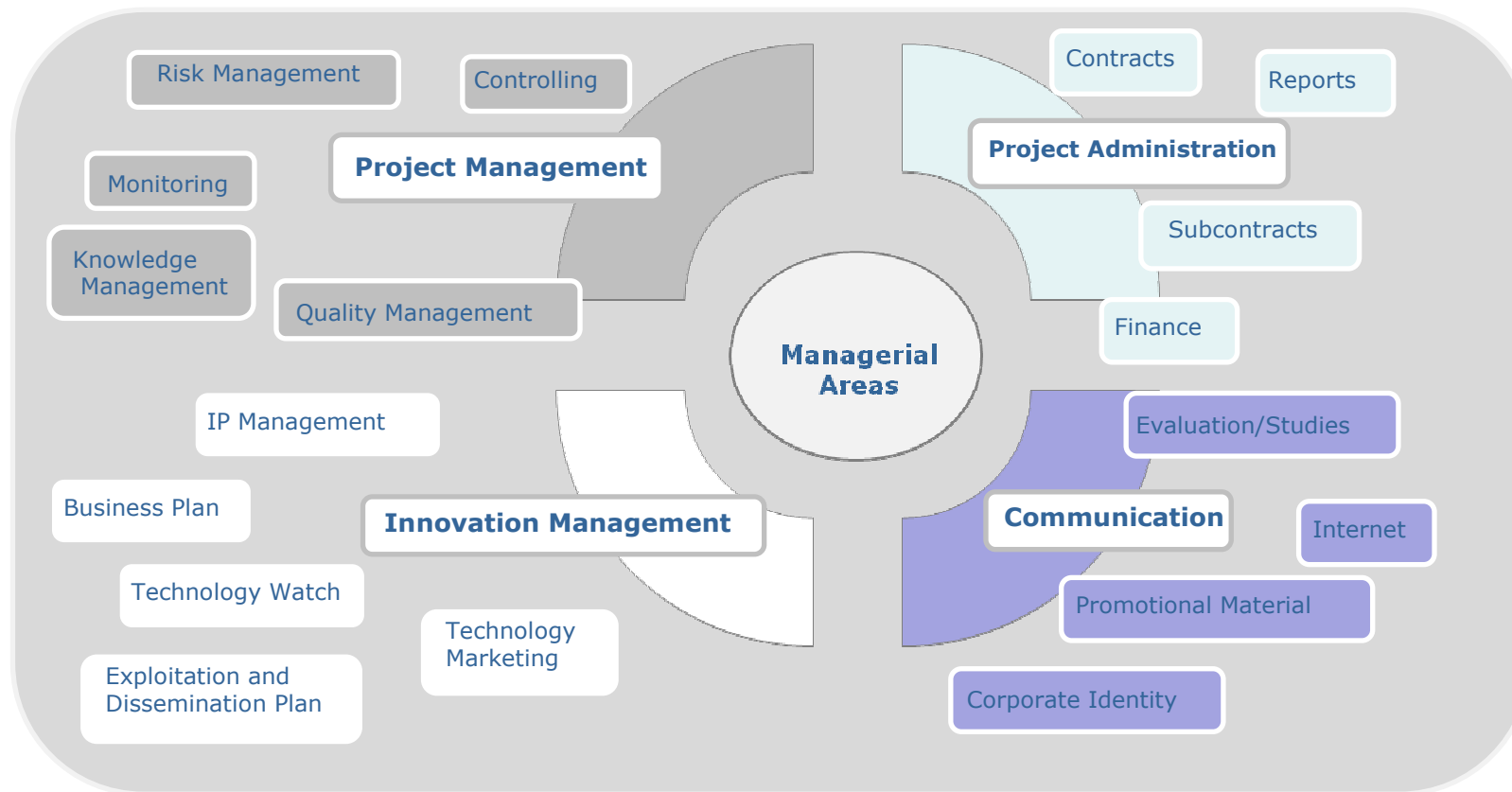- Lacking legal/ IPR expertise

- Goal: commercialisation of results
- Application-oriented approach
- Strong in-house legal/IPR expertise

- Goal: keeping control over own research results
- Protection of existing know-how, that is brought into the project
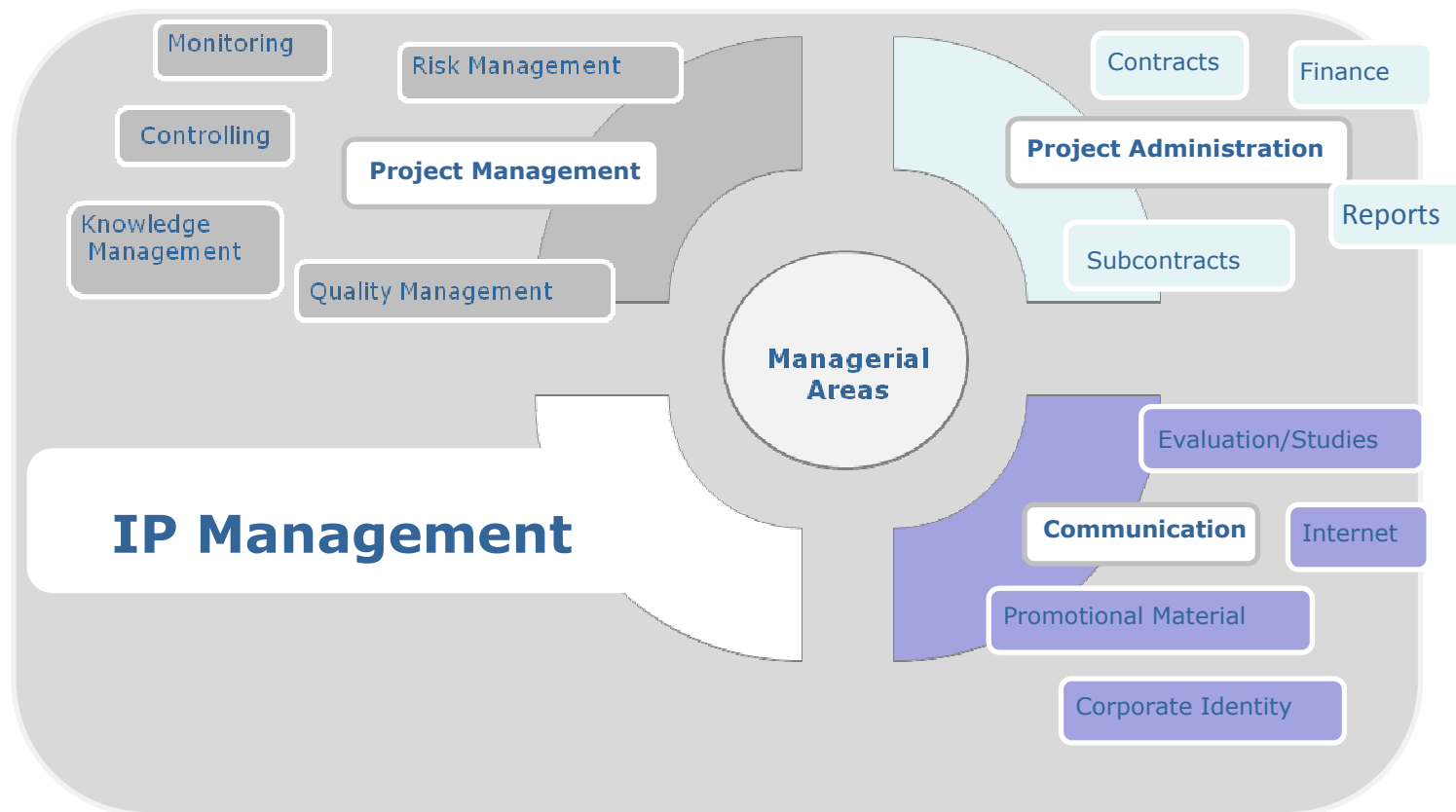- Lacking legal/IPR expertise

How should the overall management of a collaborative FP7 project look like?
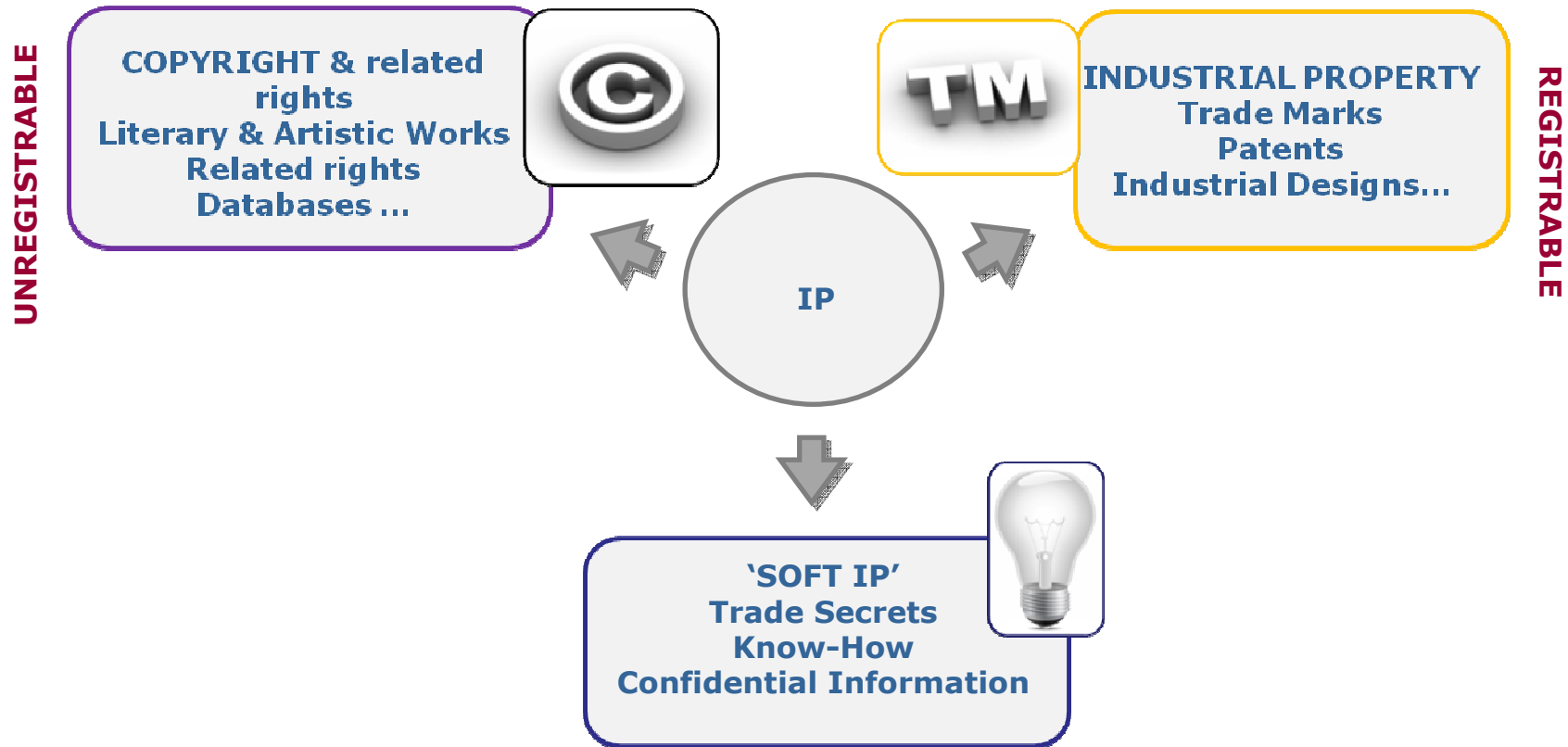
FP7 Management

Managerial Areas

Project Management
- Risk Management
- Controlling
- Monitoring
- Knowledge Management
- Quality Management

Project Administration
- Contracts
- Reports
- Subcontracts
- Finance

Innovation Management
- IP Management
- Business Plan
- Technology Watch
- Technology Marketing
- Exploitation and Dissemination Plan

Communication
- Evaluation/Studies
- Internet
- Promotional Material
- Corporate Identity

FP7 Management

Managerial Areas

- Project Management
  - Monitoring
  - Risk Management
  - Controlling
  - Knowledge Management
  - Quality Management

- Project Administration
  - Contracts
  - Finance
  - Reports
  - Subcontracts

- IP Management

- Communication
  - Evaluation/Studies
  - Internet
  - Promotional Material
  - Corporate Identity

What does intellectual property mean and comprise? Why is intellectual property relevant?

Intellectual Property

UNREGISTRABLE

COPYRIGHT & related rights
Literary & Artistic Works
Related rights
Databases ...

INDUSTRIAL PROPERTY
Trade Marks
Patents
Industrial Designs...

REGISTRABLE

IP

'SOFT IP'
Trade Secrets
Know-How
Confidential Information

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IP value

Regardless of what product your organisation makes or what service it provides:

YOU **CREATE IP**!

Therefore it is vital that your **IP asset** be:
- ✓ *Protected*
- ✓ *Managed*
- ✓ *Enforced*
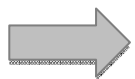
➡ **Thus, reaping the full commercial benefit from its ownership.**

IP value

IP may ...

... generate an income for your organisation through the licensing, sale, or commercialisation of the IP protected products or services

... contribute to making your organisation's products and services more attractive to consumers

... enhance the value or worth of your organisation in the eyes of investors and financing institutions

... may significantly raise the value of your organisation in the event of sale, merger, or acquisition

STOP

Rules and agreements

Where do I find rules regarding IP in FP7 projects?

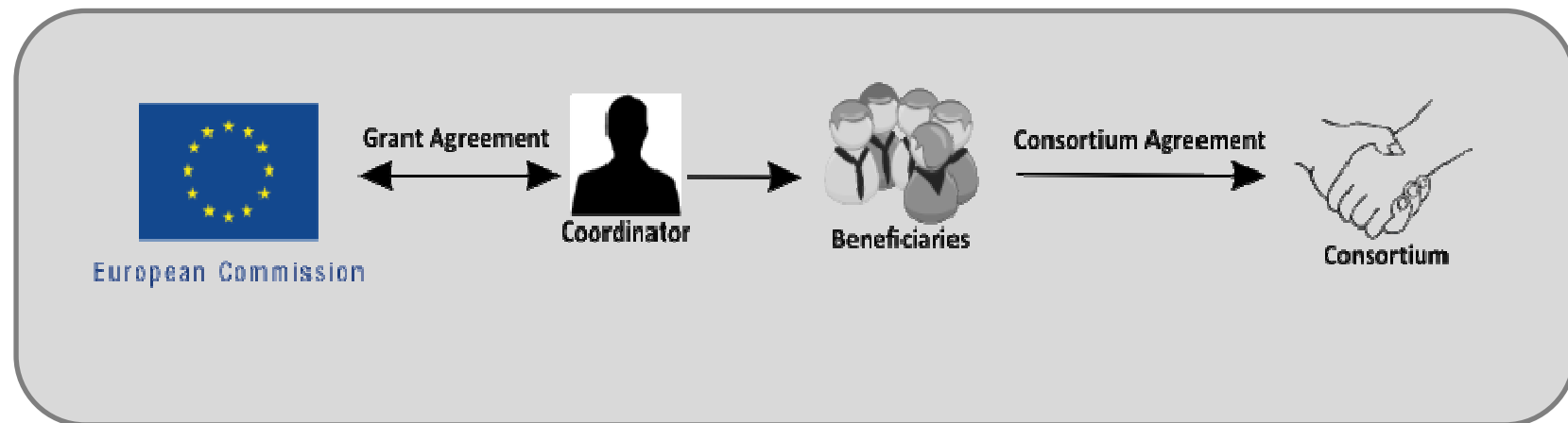# IP rules in FP7

Protection of IP in FP7 projects is dealt with in …

… Grant Agreement

… Consortium Agreement

… *Guide to Intellectual Property Rules for FP7 projects* (= not legally binding)

Overview: FP7 agreements

STOP

Specific vocabulary in FP7

Vocabulary in FP7

Key terms in the context of FP7 are:

- Background
- Foreground
- Access rights
- Use
- Dissemination

Definitions (I)

Background
Information which is held by the project partners prior to their accession to the agreement. Includes IP as copyright, patents/ patent applications (filed prior to access to agreement).

Foreground
All results which are generated under the project
– whether or not protectable. Such results may include copyrights, design or patent rights, trademarks or others.

Definitions (II)

Access rights
User rights (incl. licenses) to foreground or background of project partners.

Use
Utilisation (direct/indirect) of foreground in research activities, which are **not** part of the project. As well as utilisation for further development, creation and marketing of a product or process.

Dissemination
Means trough which research results are presented to the public. Official publications (e.g. patent applications) are not considered as dissemination.
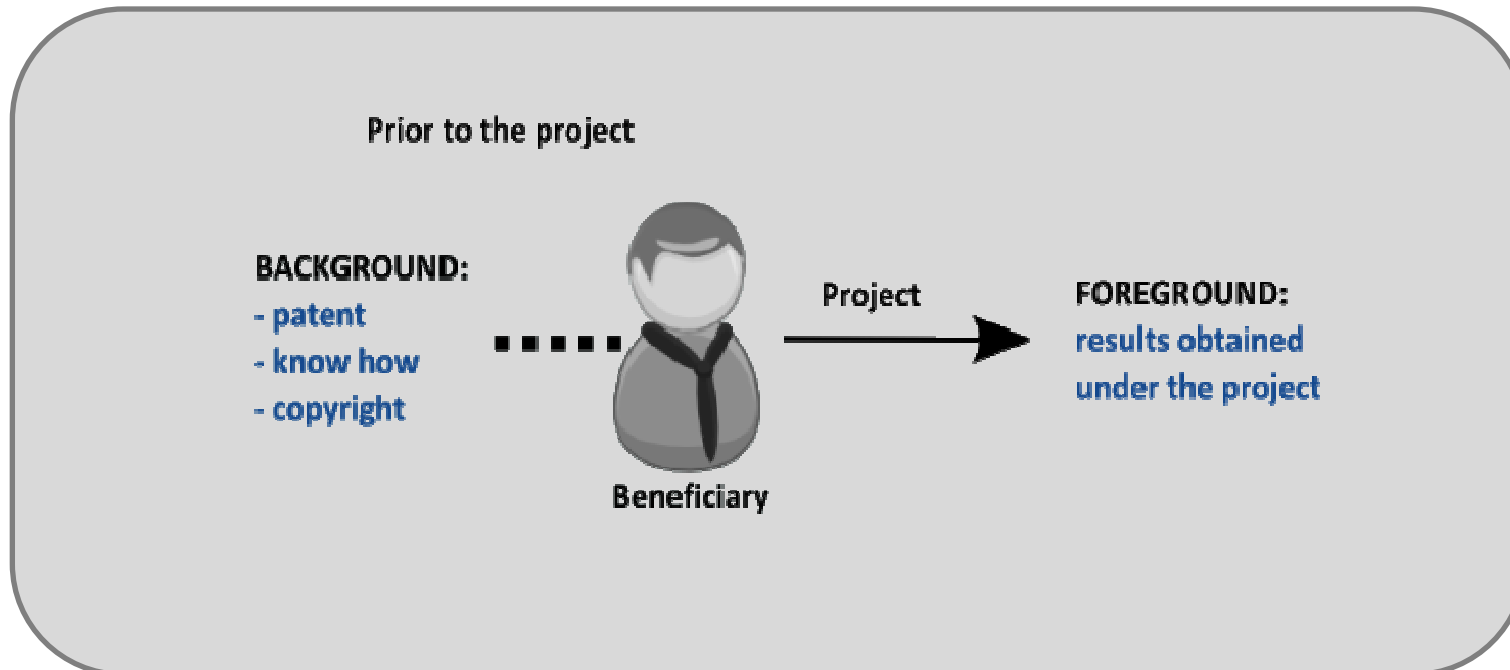
Definitions in detail

Let's take a closer look!

Background & Foreground

Prior to the project

BACKGROUND:
- patent
- know how
- copyright

Beneficiary

Project

FOREGROUND:
results obtained
under the project

Background

- Information which is needed for the project (includes IP rights).

- Remains the property of the project partner that brings it into the project.

- Project partners have the right to define the background that each of them is going to make available to the project and / or exclude from their obligation to grant access rights.

- This can be done as „positive" or „negative" list – in writing and attached to the Consortium agreement.

Foreground (I)

Ownership:
•Each beneficiary is the owner of the results it generates during the project.

•Personnel rights have to be taken into consideration.

Joint ownership:
•Appears for Foreground generated in common while respective parts of the partners cannot be determinded.

•Project partners must therefore conclude a **joint ownership agreement** to deal with allocation and exercise.

•In absence of such an agreement, a default joint ownership regime applies.

Foreground (II)

Transfer of Ownership:
- A beneficiary may transfer ownership of **its** foreground.

- The other project partners should be informed about the envisaged transfer – objection possible if their access rights are not preserved.

Licensing:
- A project partner may grant an exclusive license to foreground / background but the other participants shall waive their access rights in writing.

Access rights (I)

- Each project partner has the right to **request access rights** to the other project partner's background and foreground as long as it needs them in order to carry out its work under the project or to use its own foreground.

- Shall be made in writing.

- Are to be granted troughout the duration and up to 1 year after the end of the project for use needs.

- Access rights do **not** confer the right to grant sub-licences.

- **Affiliated entities** may get some access rights for use purposes. Therefore they need ownership of foreground (in whole or in part).

Access rights (II)

Granting of Access Rights

Project participants have to grant other partners access to their know-how, if those need the know-how in order to be able to implement the project or to use the results of the project

	Access to background	**Access to foreground**
Project implementation	Royalty-free	Royalty-free
Use of results	Royalty-free, or on fair and reasonable conditions	Royalty-free, or on fair and reasonable conditions

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Example Question

A research institution from Spain, in the process of drafting the Consortium Agreement for an FP7 project, asked the European IPR Helpdesk the following question.

Access Rights to Background : how should background be listed and dealt with in the Annexes?

Dissemination

Annex II of the Grant Agreement = the disclosure of foreground by any appropriate means other than that resulting from the formalities for protecting it, and including the publication of foreground in any medium.

Means of dissemination

Examples

- Press releases
- Meetings
- Newsletters
- Homepage/project website
- Scientific publications
- Workshops
- Exhibitions & conferences
- Audiovisual media
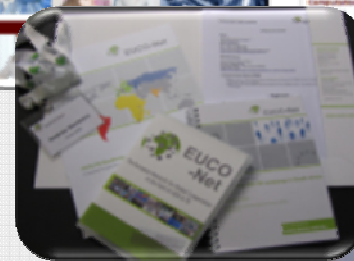
Obligation

Project partners are obliged to disseminate the results swiftly.

But:
No dissemination of foreground may take place before decision is made regarding its possible protection.

Example Question

An SME from Malta contacted the European IPR Helpdesk with the following question.

We are currently participating in an FP7 project. As we are still in very early stages we are not sure as to whether we will file for a patent to protect our results. A TV channel has invited us to be featured in a TV documentary. This would be a fantastic dissemination opportunity, but we are worried about the IP aspects of it. Can the disclosure of our technology be detrimental?

STOP

IP in FP7 – Project life cycle

At which stages of my project
does IP matter?

IP in FP7 project life cycle

Before Project Start

- **Proposal preparation, incl. plan for the use and dissemination of research results**

- **Defining project-related know-how**

- **Defining IP protected areas**

- **Negotiating a CA/NDA**

During Implementation

- Strategy for securing and managing research results

- Granting of access rights

After Project End

- Disseminating and securing generated IP

- Exploitation of the results

- Valorisation of intangible values
  → Commercialisation

IPR issues are relevant at all stages of the project

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Before project start

Every project starts with an idea

- Define the **state of the art**

- **Screen** already existing project landscape

- Search in **patent databases & documents**

- **Protect technical drawings** (e. g. by copyright or trade secrets)

- Protect all **information linked to the idea**

Before project start

No project without partners – no project without negotiations

•**Define** …

… intangible assets of the project, i. e. „**background**" & „**foreground**"

… **use & dissemination strategy**

… **access rights** regime

•Set up **confidentiality agreement**

•Sign **Consortium and Grant Agreement**

Before project start

Use and dissemination strategy

- **Strategic plan**

- Every contracting party has to **ensure**, that project **results are secured, disseminated and used** → all results have to be used

- Project **partners have to be informed** in advance (e.g. 45 days) about publication activities

Before project start

Confidentiality agreement

- Identifies **relevant information**

- **Defines use of information** as well as **restrictions**

- Already very **important at the proposal stage**, when valuable information is exchanged between potential project partners

- Includes **possible sanctions**

Before project start

Ways to protect intangible assets

Industrial Property

Trademarks
Patents
Industrial Designs

Literary & Artistic Works

Copyrights
Related rights
Databases

«Soft IP »
Secrets
Know-How
Contracts

IP in FP7 project life cycle

Before Project Start

- Proposal preparation, incl. plan for the use and dissemination of research results

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During Implementation

- **Strategy for securing and managing research results**

- **Granting of access rights**

After Project End

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IPR issues are relevant at all stages of the project

During implementation

Secure and manage research results

- Have a **clear strategy for securing and managing** newly generated know-how

- **Continuously update** the use and dissemination strategy plan

- Be clear about …
  … **publication regime**
  … **access right regime**

During implementation
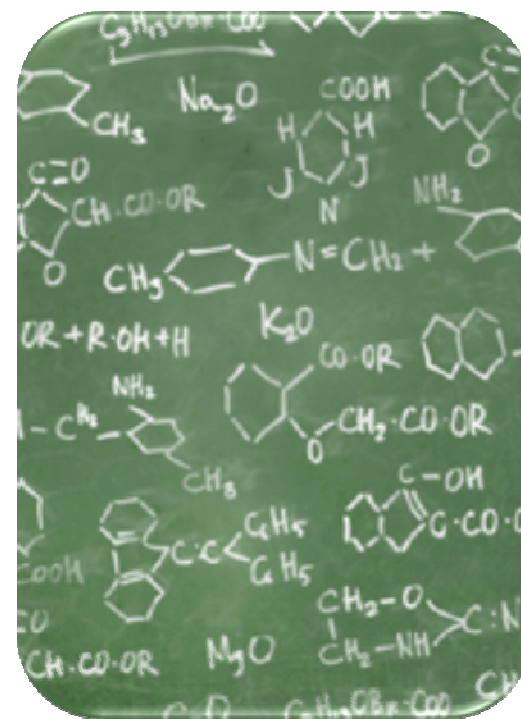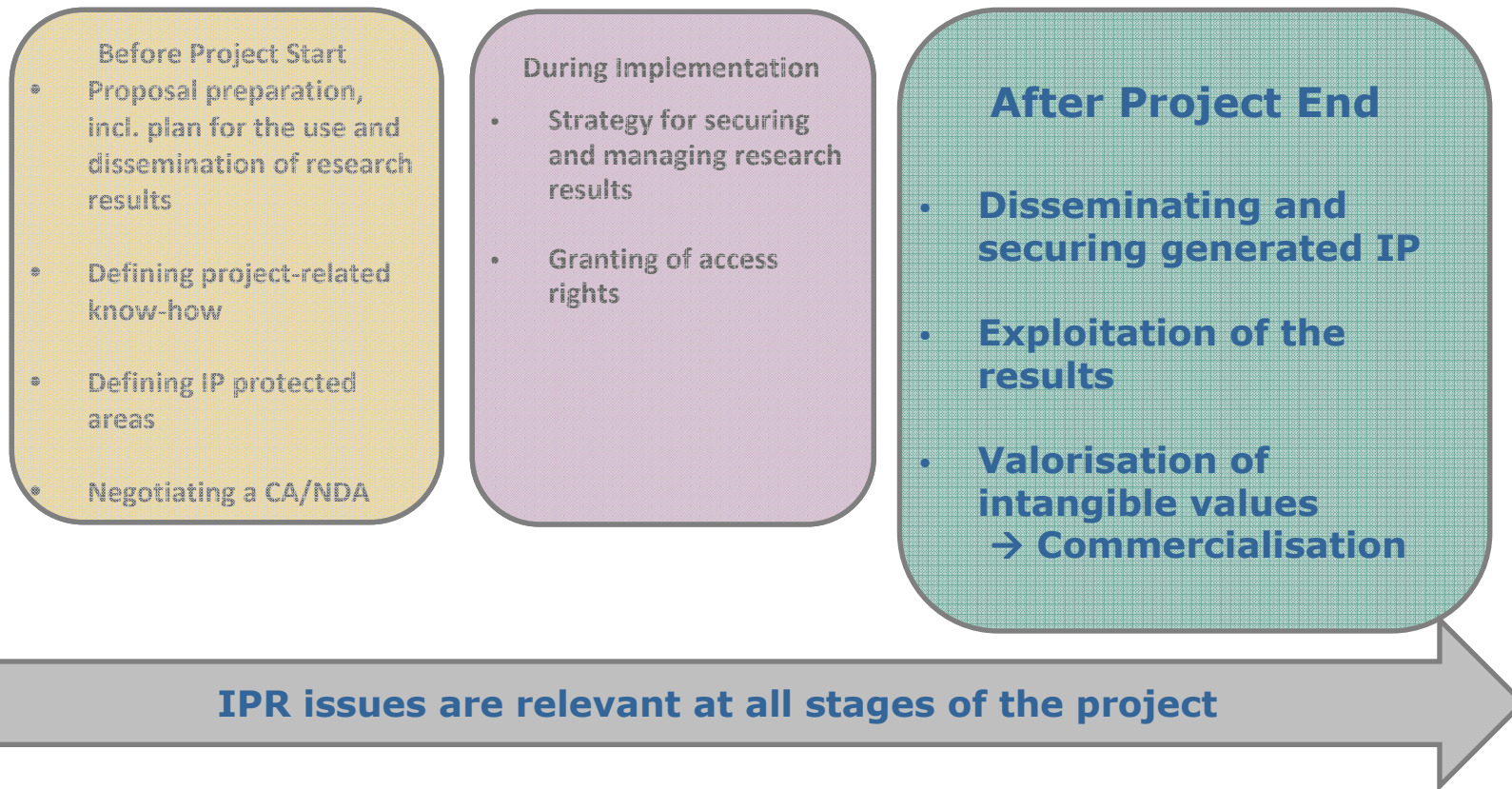
Ownership of results

- All know-how gained in the project belongs to the **project partner, who generated it**

- If project **partners generate knowledge jointly** without being able to identify the single contribution of each partner
  → **joint ownership**

- Handling of **ownership has to be clearly regulated** by the project partners
  (→ Consortium Agreement)

IP in FP7 project life cycle

Before Project Start
- Proposal preparation, incl. plan for the use and dissemination of research results
- Defining project-related know-how
- Defining IP protected areas
- Negotiating a CA/NDA

During Implementation
- Strategy for securing and managing research results
- Granting of access rights

After Project End
- Disseminating and securing generated IP
- Exploitation of the results
- Valorisation of intangible values → Commercialisation

IPR issues are relevant at all stages of the project

Towards project end

Use and dissemination of research results

•Be clear about **how to protect newly gained intangible assets**

•**Make use of research results** – either in **further research** or by **commercial use**

•**Communicate project work** (and results) via different dissemination channels

After project end

Exploitation and valorisation of generated IP

- Be clear about **different options of valorising** generated project results

- Implement **IP portfolio management**

Thank you.

We look forward to getting in touch with you!

For further questions and general IP advice, please contact our Helpline team:

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