



Geistige Eigentumsrechte in Projekten des 7. FRP

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Die Helmholtz-Gemeinschaft



- Alfred-Wegener-Institut für Polar- und Meeresforschung
- Deutsches Elektronen-Synchrotron DESY
- Deutsches Krebsforschungszentrum
- Deutsches Zentrum für Neurodegenerative Erkrankungen
- Deutsches Zentrum für Luft- und Raumfahrt
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- Helmholtz-Zentrum Berlin für Materialien und Energie
- Helmholtz-Zentrum für Infektionsforschung
- Helmholtz-Zentrum für Umweltforschung – UFZ
- Helmholtz Zentrum München,
Deutsches Forschungszentrum für Gesundheit und Umwelt
- Helmholtz-Zentrum Potsdam,
Deutsches GeoForschungsZentrum - GFZ
- Karlsruhe Institut für Technologie
- Max-Delbrück-Centrum für Molekulare Medizin
- Max-Planck-Institut für Plasmaphysik (assoziiert)
- Ab 2011 Forschungszentrum Dresden-Rossendorf

Overview

What is intellectual property (IP) and why is IP-management important?

FP7 Legal Framework

IPR Provisions
Grant Agreement /
Consortium
Agreement

Research for the
benefit of SMEs

What is intellectual property (IP)?

“Intellectual **property** refers to **creations of the mind**: inventions, literary and artistic works, and symbols, names, and images **used in commerce.**”

„ Intellectual property rights are **like any other property rights** – they allow the creator, or owner, of a patent, trademark, or copyright to **benefit from his or her own work or investment.**“

(WIPO)

General characteristics of property

General principles of ownership

- Control of the **use** of the property
- Right to **benefit** from it
- Right to **transfer or sell** the property
- Right to **exclude others** from the property

Different forms of ownership

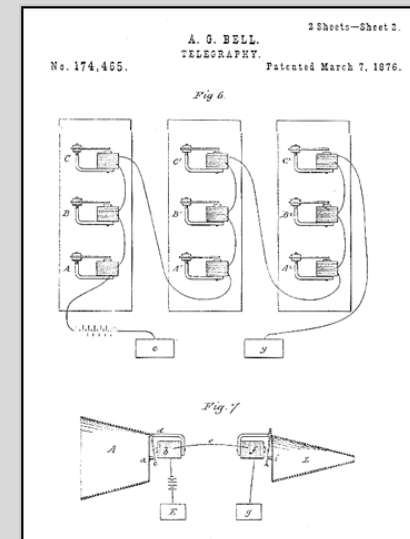
- sole ownership
- joint ownership

Bundle of rights conferred by law

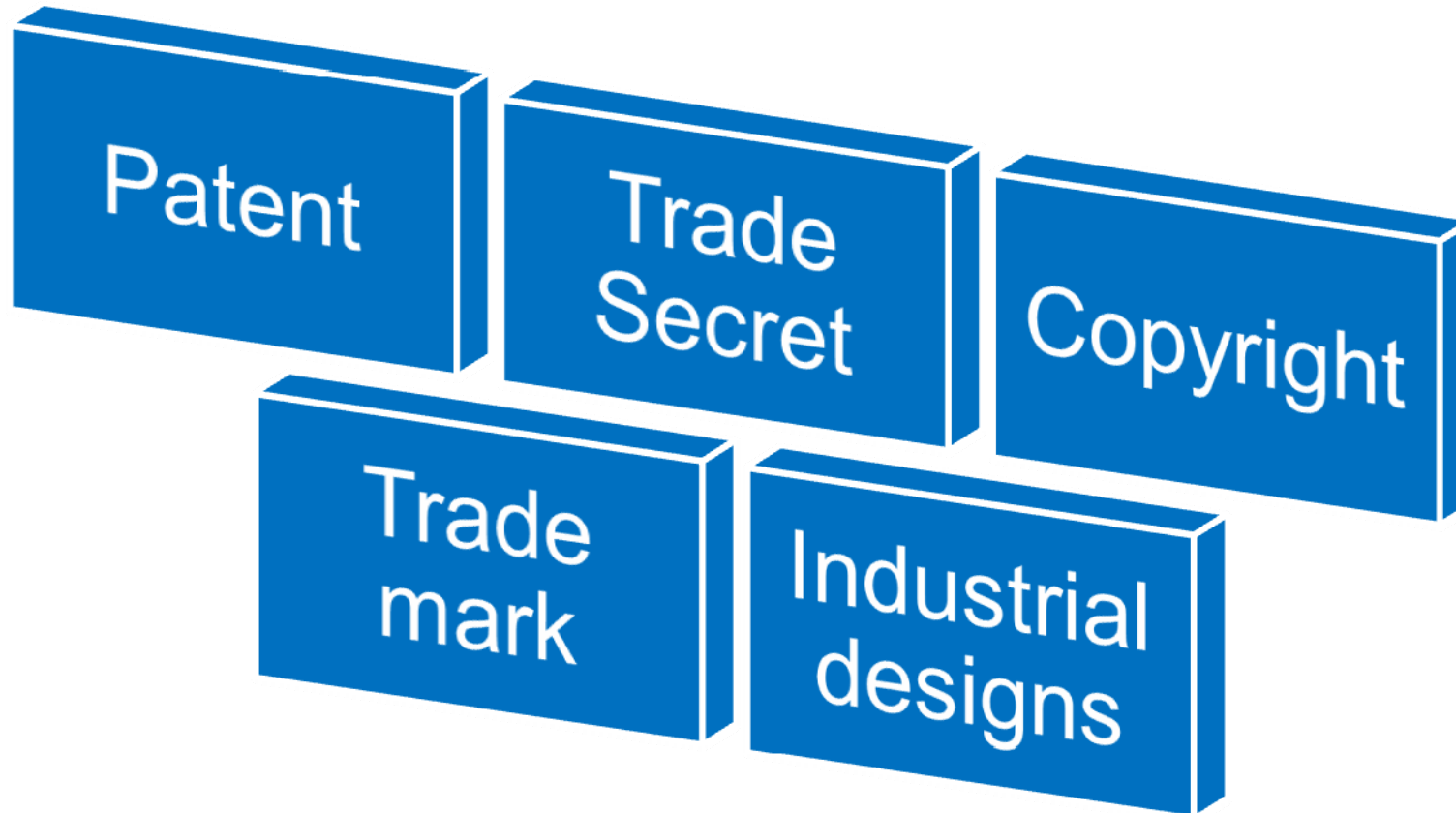
- Balance between the rights of the owner and the society
- Enforcement

Tangible and intangible property

- Economic value
- Authority to determine how it is used
- Possibility of theft and disputes concerning ownership



Main types of IP



Patents

Definition

- „A patent is an exclusive right granted for an invention, which is a product or a process that provides a new way of doing something, or offers a new solution to a problem.“ (WIPO)



What can be patented?

- “new“ (US- grace period)
- “involves an inventive step“
- “capable of industrial application“
- “not excluded“

What protection does it offer?



- The patented invention cannot be commercially made, used, distributed or sold without the patent owner's consent.
- Protection for a limited period (20-25 years).

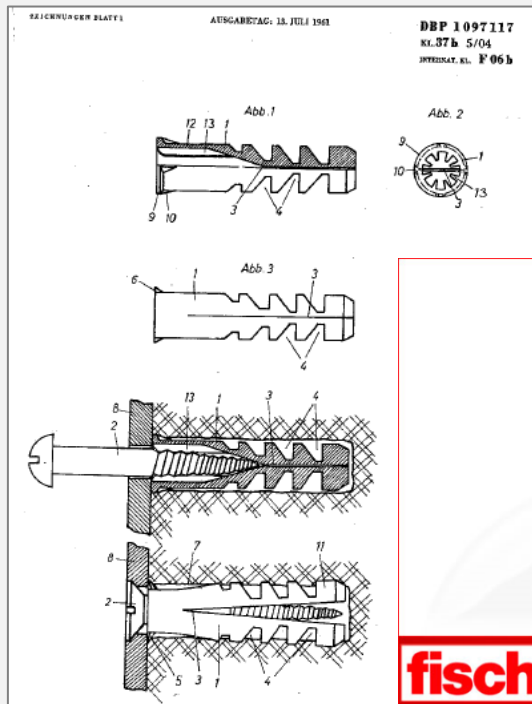


Special requirement

- Disclosure of invention

Examples of patents

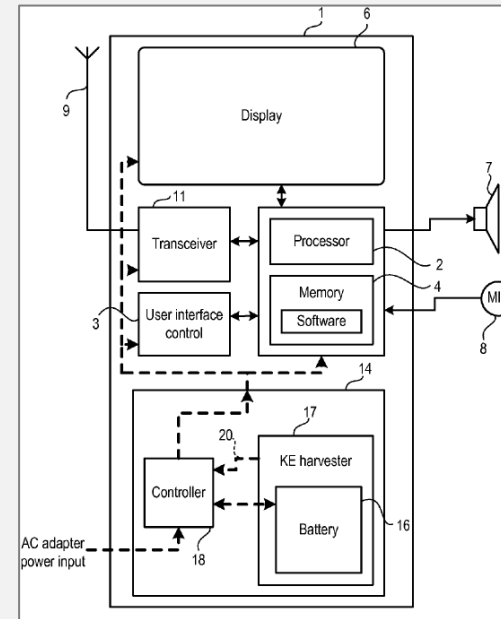
1961: DE-1097117



Cavity fixing



Feb. 2010: Piezoelectric Kinetic Energy Harvester
US 20100045241



Self charging mobile phone

NOKIA

Patent application



Patent offices

- The “big three”: (European Patent Office (EPO), United States Patent and Trademark Office (USPTO), Japan Patent Office (JPO))
- Emerging regions: State Intellectual Property Office of China (SIPO), Korean Intellectual Office (KIPO), Indian Patent Office

Harmonisation and cooperation

- WTO: Trade Agreement on IPR (TRIPS-Agreement),
- WIPO: Substantive Patent Law Treaty (SPLT)
- “European Patent” (still under discussion)

! First to file vs. first to invent

- First to file! (except USPTO)

Priority rights

- ! 12 month (triggered by first filling of an application for a patent)
- “new“ / another filing of a third party

Cost and duration

Trade secret / undisclosed information

Definition

- information which ...
 - has an economic value
 - is secret (not generally known or readily ascertainable)
 - is subject to reasonable efforts to maintain its secrecy

Non-disclosure agreement (NDA)

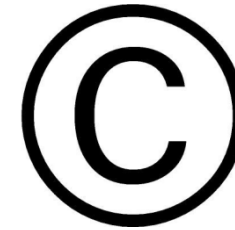
- points to consider when using a NDA

What protection does a trade secret offer?

- can be maintained for an indefinite period of time
- Misappropriation
- Reverse engineering



Copyrights ©



Definition

- „Copyright is the body of laws which grants authors, artists and other creators protection for their **literary and artistic creations.**“ (WIPO)

How are copyrights regulated?



- Copyright protection is obtained **automatically** without any need for registration or other formalities
- Optional registration and deposit of works



Basic rights under copyright law and duration

- The rightsholder(s) of a work can prohibit or authorize its reproduction, public performance, broadcasting, translation into other languages, etc.
- **Duration** of protection not less than 50 years after the creator's death

Examples

- Novels, plays, films, musical compositions, computer programs, databases, maps, technical documentation, instruction manuals, etc.

Trade mark, industrial design

Trademark ® ™	„a distinctive sign, which identifies certain goods or services as those produced or provided by a specific person or enterprise“	 The image shows two logos side-by-side. On the left is the Coca-Cola logo in its signature red script with a registered trademark symbol. On the right is the Microsoft logo, featuring the four-pane Windows logo above the word "Microsoft" in a bold, black, sans-serif font.
Industrial design	„the ornamental or aesthetic aspect of an article“	 The image shows two objects side-by-side. On the left is a black iPod with its characteristic scroll wheel and a small screen. On the right is a red Swiss Army knife with its blades partially open, featuring the white cross logo on the red handle.

Licensing intellectual property

What is an IP licence?

- A licence is a permission to do something that, without the licence, would be an infringement of IP
- IP can be „licenced-out“ or „licenced in“

Reasons to licence or to take a licence

- Sharing risk; revenue generation; reducing costs; saving time; obtaining competitive advantage; collaboration

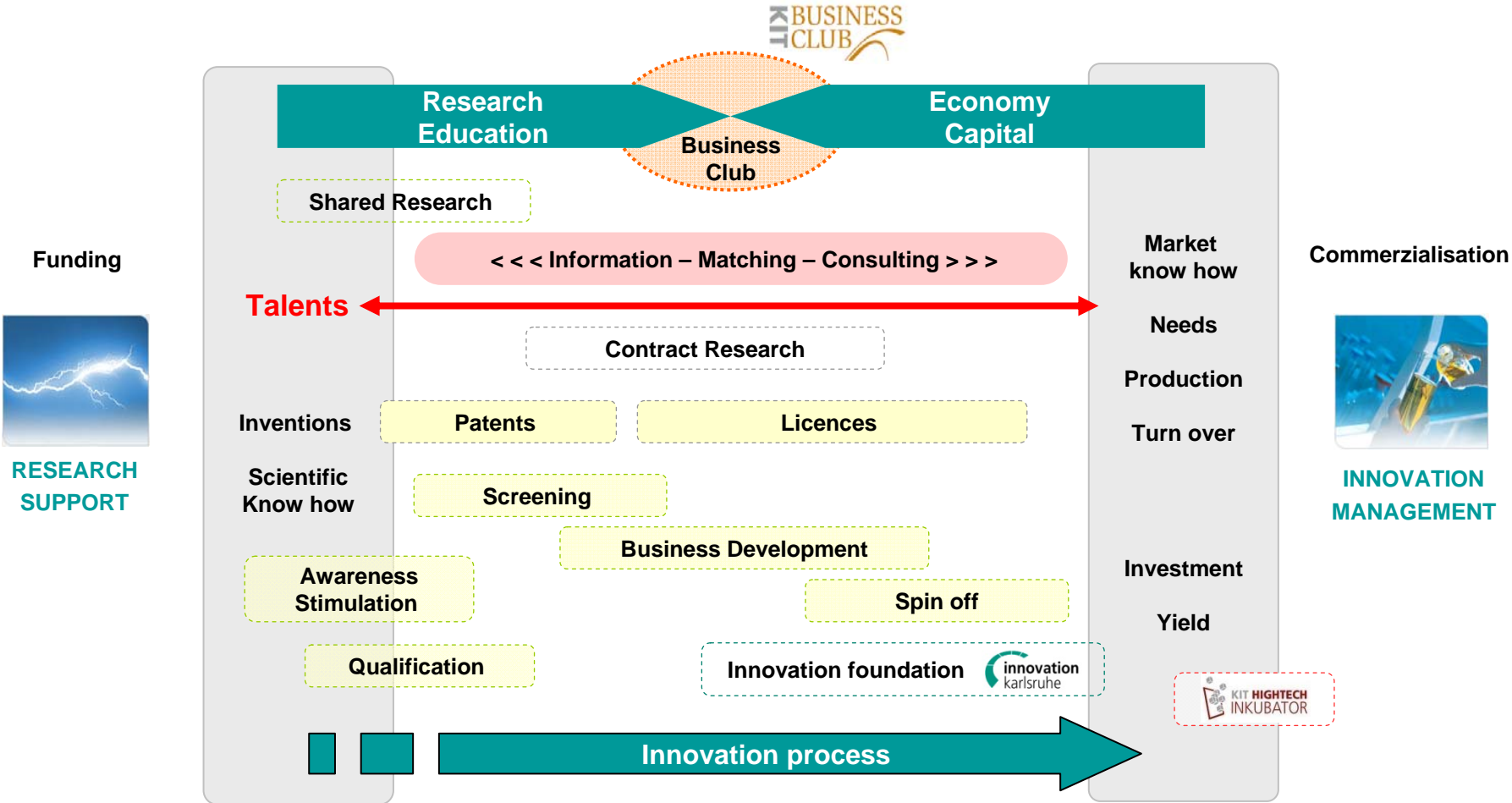
Reasons not to licence or to take a licence

- Ability to commercialise IP yourself; licence may diminish value of IP; royalties are too high; IP too weak; IP not valid or open to challenge

Main types of licence / specific issues

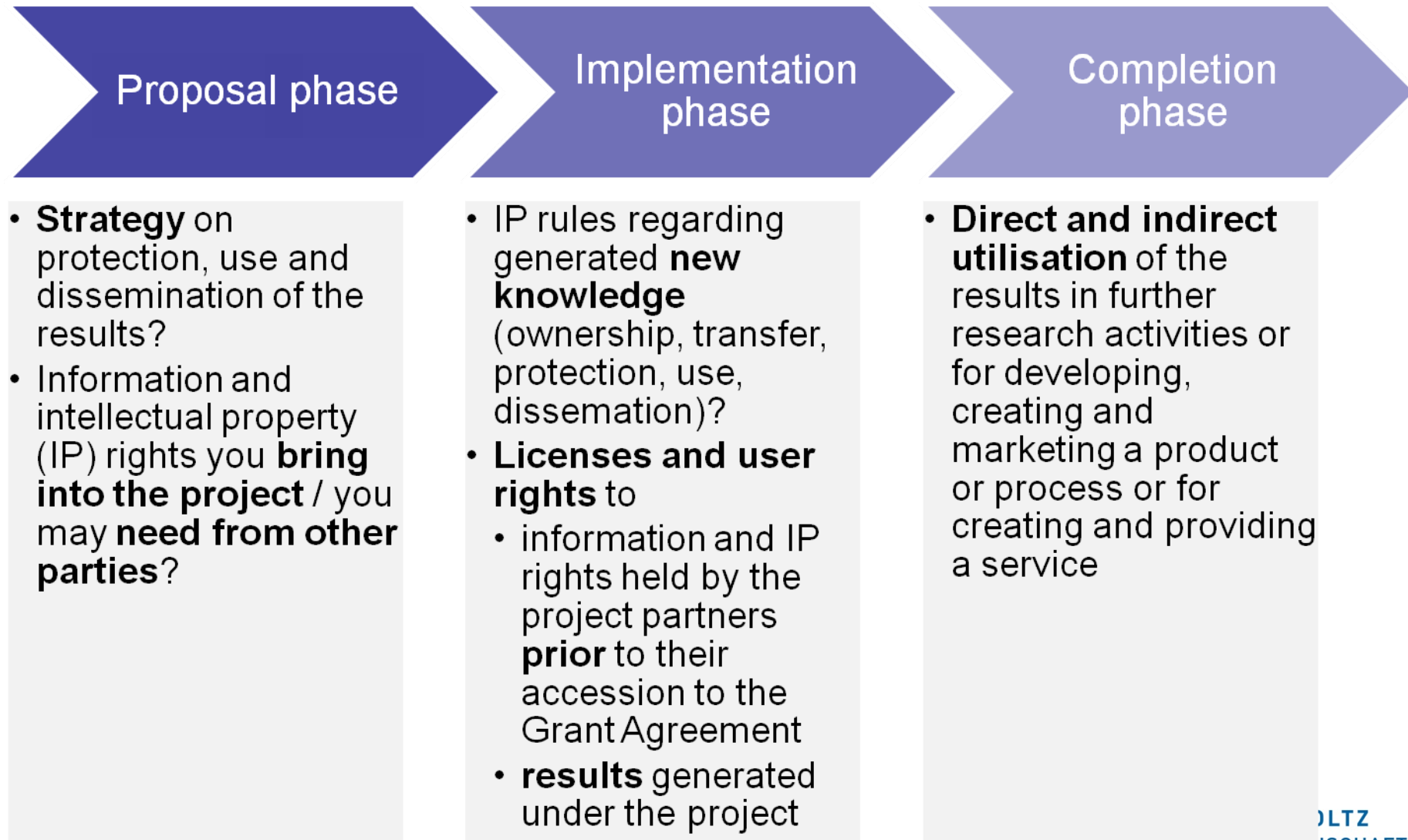
- Exclusive, sole and non-exclusive licences
- Right to sub-licence
- Restriction of the use (to specific fields of technology, one or more countries, for academic teaching/research, etc.)
- Transfer of the licence
- Duration and termination
- Charges and payments

Continuum Innovation @ KIT

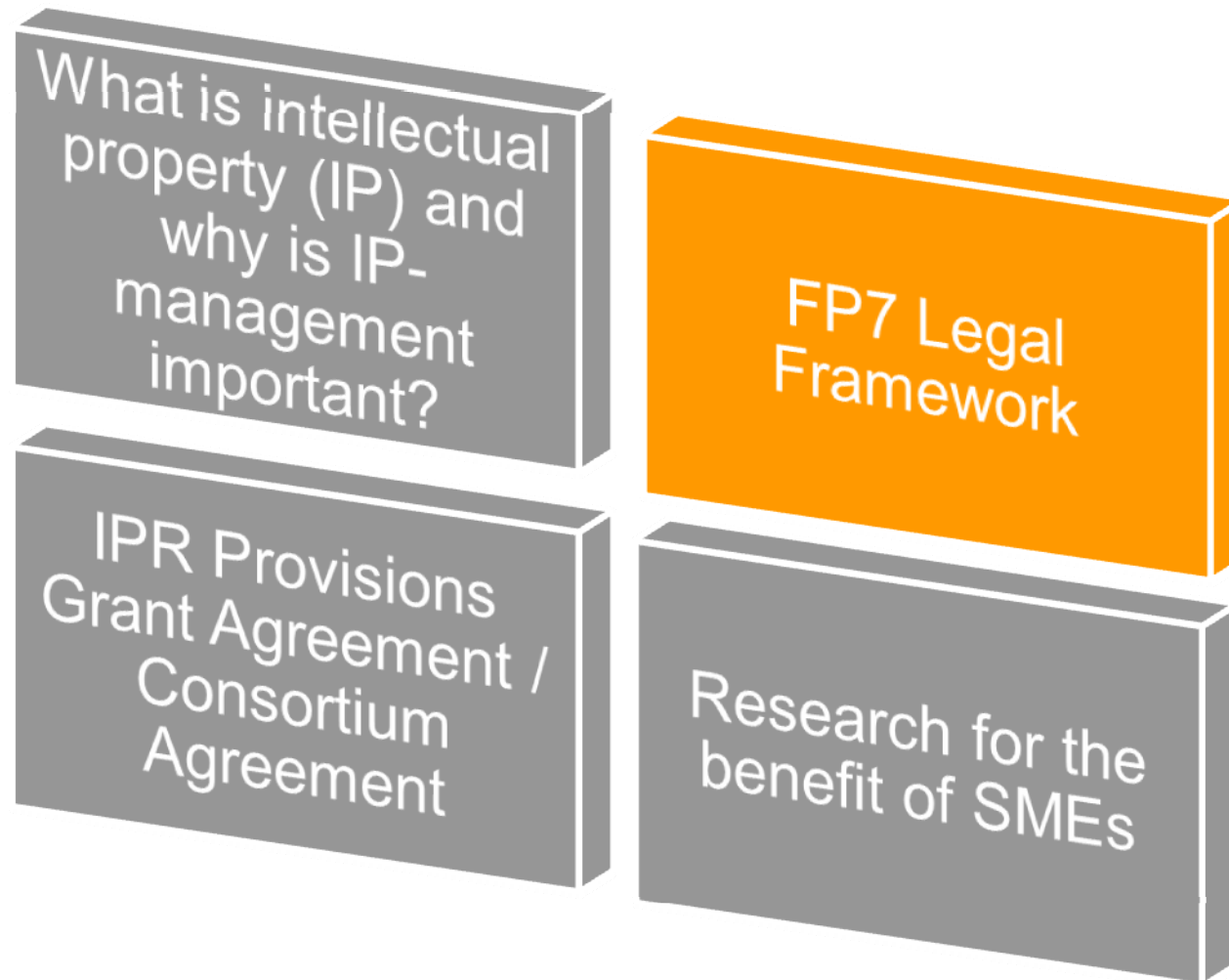


The source of all kinds of innovation originates in the scientific institutes of KIT

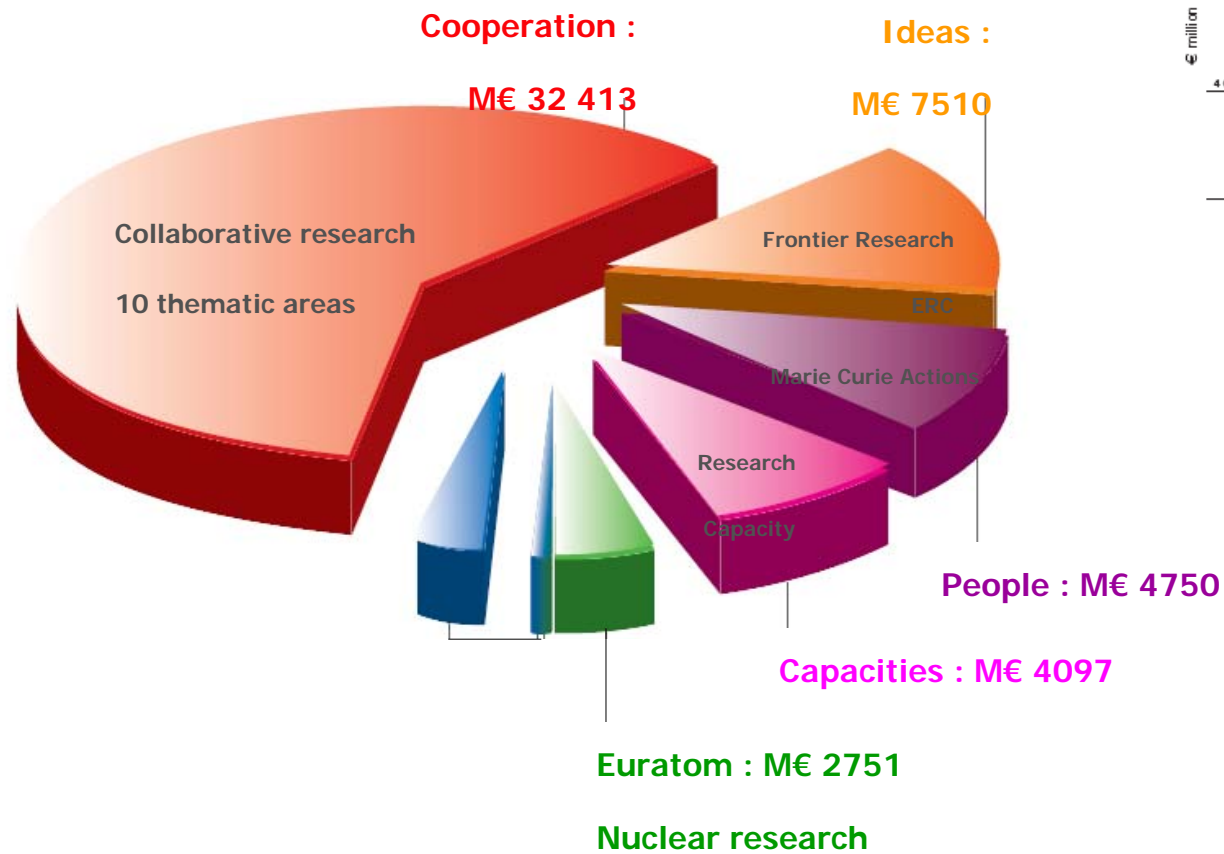
IP-issues to consider in FP7 Projects



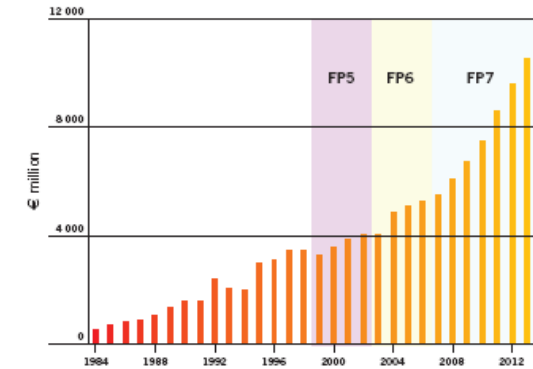
FP7 Legal Framework



FP7 Structure and Budget



Framework programme budget (1984-2013)

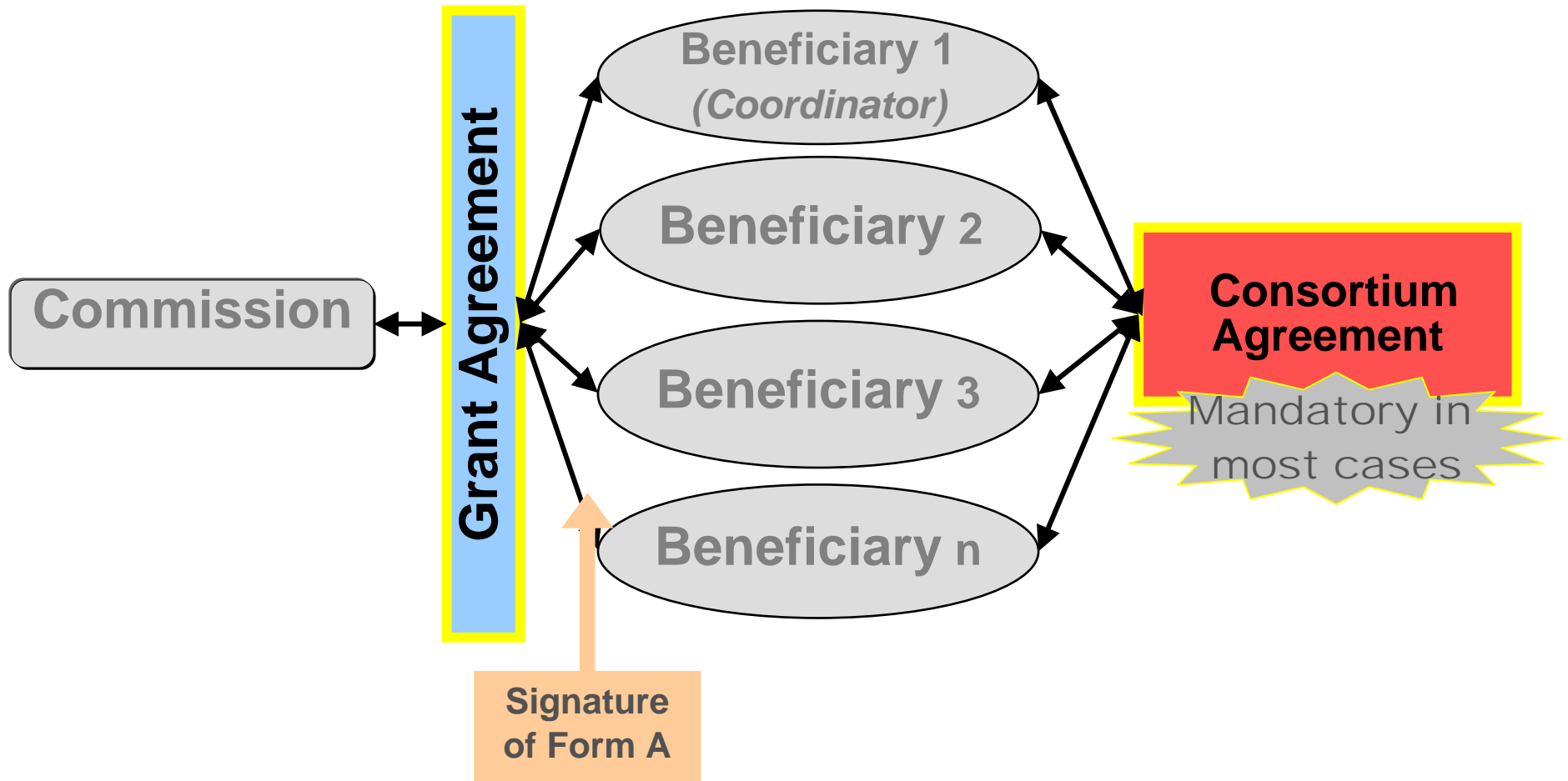


Evolution of annual budget

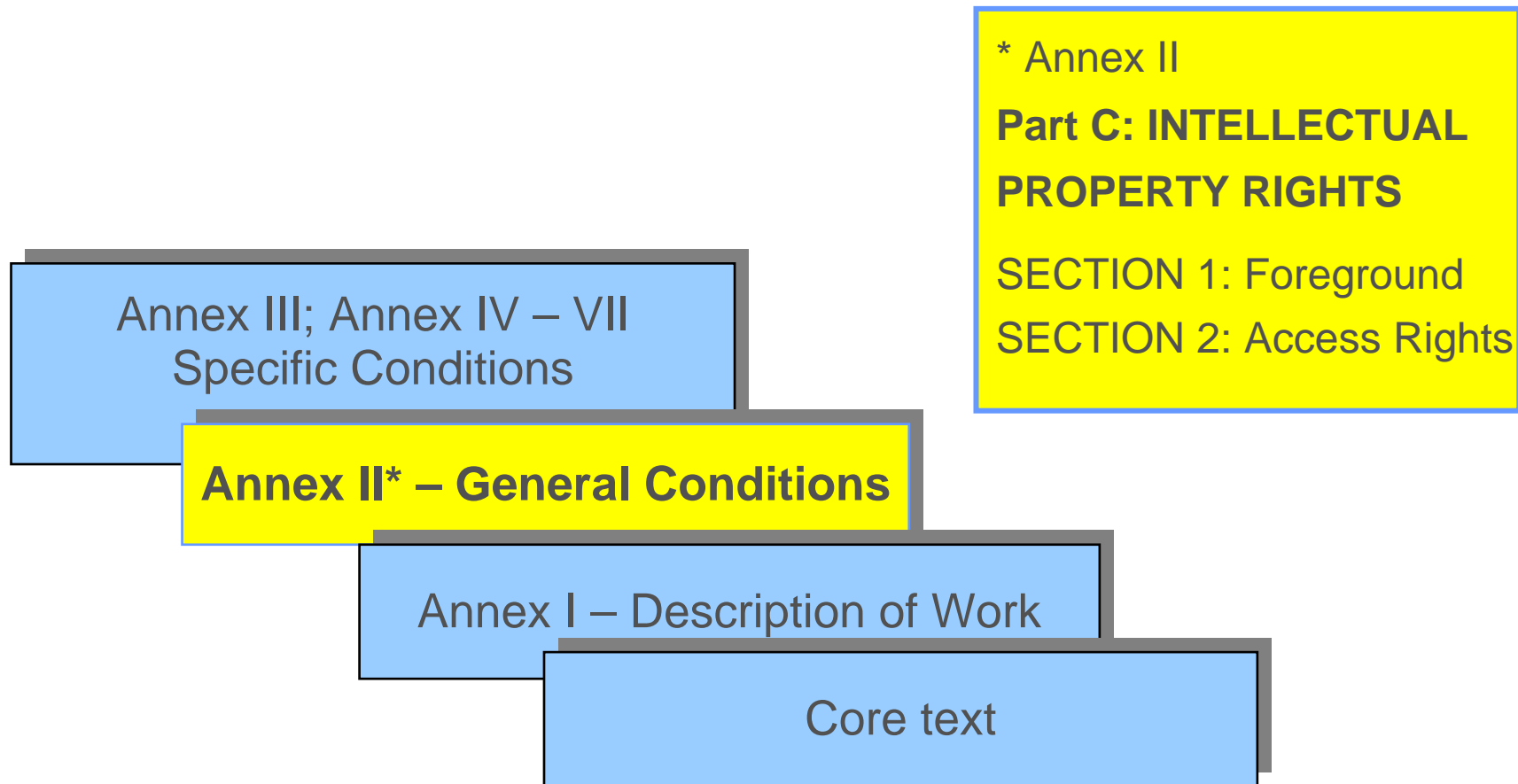
Specific Programs and Funding Schemes

I. COOPERATION	1. Health	2. Food, Agriculture & Biotechnology	3. Information & Communication Technologies	4. Nanosciences, Nanotech, Materials & Prod. Tech.	5. Energy	6. Environment (incl. Climate Change)	7. Transport (incl. Aeronautics)	8. Socio-Economic Sciences & the Humanities	9. Security and Space
Collaborative Projects & Networks				Thematic Domains and Objectives					
Joint Technology Initiatives				Responding to New Opportunities and Needs					
Co-ordination of non-Community Research Programmes	ERA-NET and Article 169 activities								
International Cooperation									
II. IDEAS	European Research Council								
III. PEOPLE	Marie-Curie Actions								
IV. CAPACITIES	Research Infrastructures								
	Research for the Benefit of SMEs								
	Regions of Knowledge								
	Research Potential								
	Science in Society								
	Activities of International Cooperation								
NON-NUCLEAR ACTIVITIES OF THE JOINT RESEARCH CENTRE									

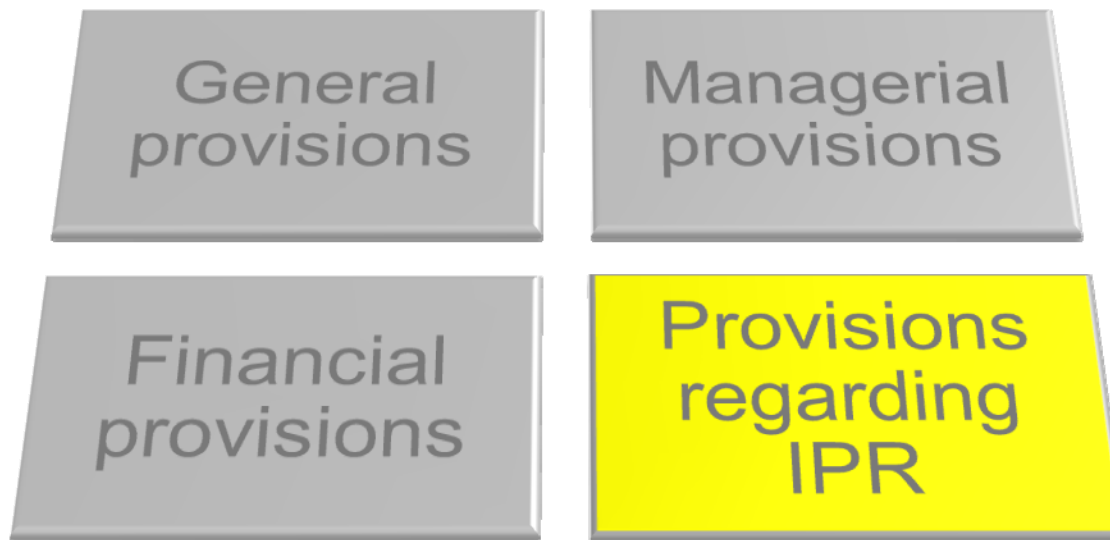
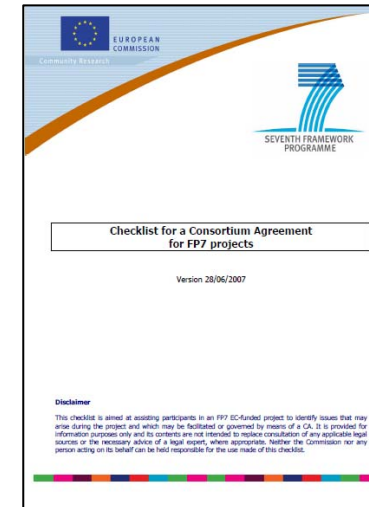
Contract Relations in FP7



Grant Agreement – Structure and Content



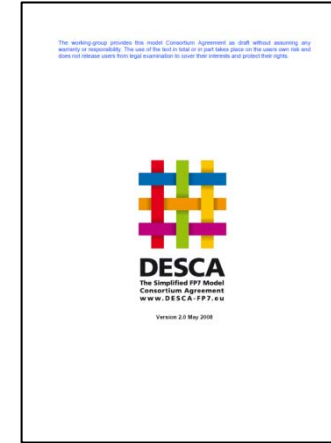
Consortium Agreement – Structure and Content



ftp://ftp.cordis.europa.eu/pub/fp7/docs/checklist_en.pdf



“DESCA“: Development of a Simplified Consortium Agreement



<http://www.desca-fp7.eu>

Core Group: ANRT, EARTO, UNITE, Eurochambres, VTT, CA-Team Germany (KoWi, FhG, Helmholtz)

Consultation Group: Airbus, Alcatel, CEA, CNRS, Daimler, Dassault, EARMA, ECTRI, EICTA, Eurocopter, IFP, INRETS, Uni Wageningen, Yellow Research, Motorola



Other FP7 Model Consortium Agreements

- **IMG4**

drafted by ASD-IMG4, the industrial Management Group that presents the biggest aerospace companies in Europe www.aerosme.com


- **IPCA**

(Integrated Projects Consortium Agreement) published by the European Information & Communications Technology Industry Association (EICTA) www.eicta.org

- **EUCAR**

drafted by the European Council for Automotive R&D www.eucar.be

DESCA: Characteristics

- **Simplified:** Reduced to the necessary minimum
- **Balanced:** Respects the interest of research and industry, big and small
www.responsible-partnering.org
- **Single:** One balanced core text where possible
- **Modular:** Options where necessary
 - alternative modules for large projects and small projects
 - an optional module for projects with a software focus
 - optional clauses in the IPR section
- **Didactic:**  Explanatory texts to illustrate and explain clauses and options, examples for different project types

IPR Provisions Grant Agreement / Consortium Agreement

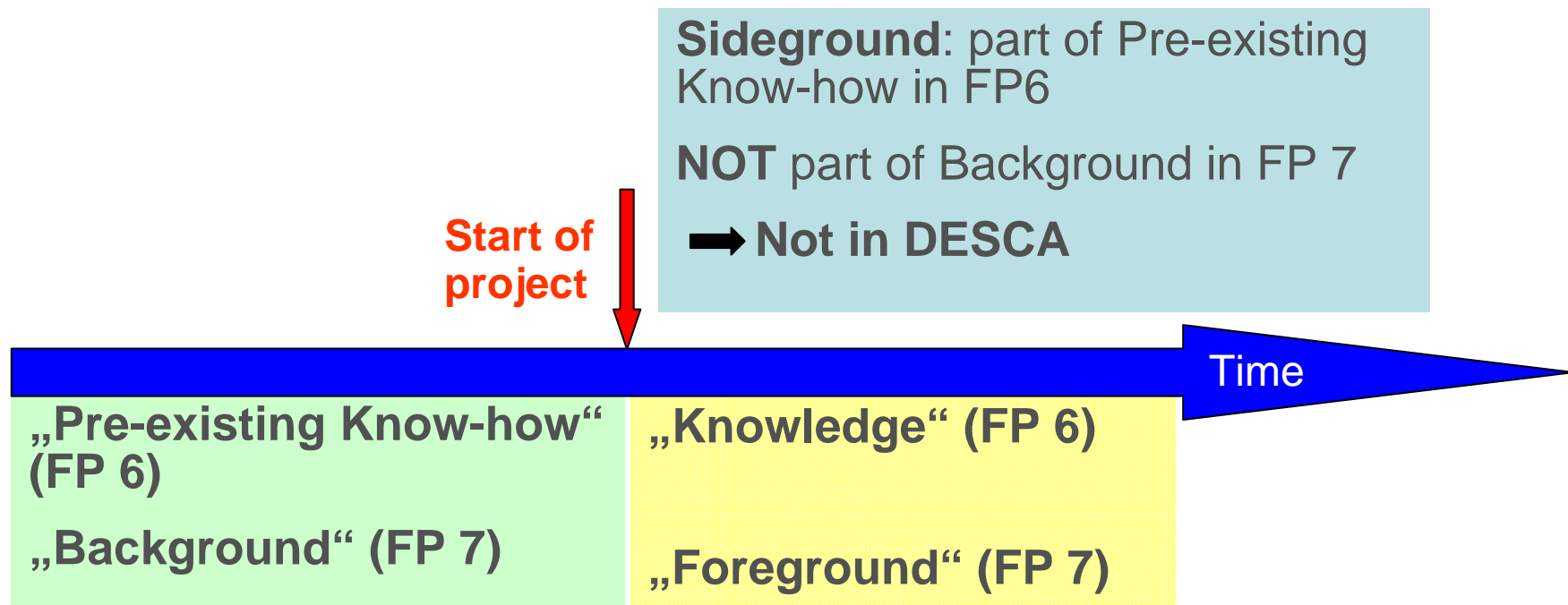
What is intellectual property (IP) and why is IP-management important?

FP7 Legal Framework

IPR Provisions Grant Agreement / Consortium Agreement

Research for the benefit of SMEs

Terminology in FP7



IPR Provisions (GA / DESCA)



Model Grant Agreement, Annex II

Part C INTELLECTUAL PROPERTY RIGHTS

SECTION 1 – FOREGROUND

- II.26. Ownership
- II.27. Transfer
- II.28. Protection
- II.29. *Use*
- II.30. *Dissemination*

SECTION 2 – ACCESS RIGHTS

- II.31. *Background* covered
- II.32. Principles
- II.33. *Access rights* for implementation
- II.34. *Access rights* for use

DESCA

SECTION 8 - FOREGROUND

8.1 Joint ownership

8.2 Transfer of Foreground

9.5 Access Rights for Affiliated Entities

9.6 Additional Access Rights

9.7 Access Rights for Parties entering or leaving the Consortium

9.8 Specific Provisions for Access Rights to Software

9.2 Principles

Sec. 10: Non-disclosure of information

9.4 Access Rights for Use

IPR Rules regarding FOREGROUND

FOREGROUND

- Ownership
- Transfer
- Protection / Use
- Dissemination

ACCESS RIGHTS

- Background covered
- Principles
- Access rights for implementation
- Access rights for use

Ownership / Joint Ownership

Grant Agreement II.26

- **Foreground** resulting from the project is **owned by the Beneficiary generating it**
- **Joint ownership** : Where several Beneficiaries have jointly carried out work generating Foreground and where their **respective share of the work cannot be ascertained**, they shall have joint ownership of such foreground
- **Default regime for joint ownership**: Any joint owner is entitled to grant a **non exclusive license to third parties without any right to sublicense** subject to **prior notification** (45 days) and **fair and reasonable compensation** of the other owner

DESCA on Joint Ownership 8.1

- **Option 1** : Grant Agreement applies
- **Option 2**: Right to **use and sublicense without consent, information to or compensation** of the other owner

Transfer

Grant Agreement II.27

- Transfers of ownership are **allowed** though the **obligations regarding Foreground must be passed on** to the transferee
- 45 days **prior notice** of any transfer of Foreground to a third party, Beneficiaries have **right to object** within 30 days if their Access Rights are adversely affected
- Beneficiaries **can waive right to prior notice** or change time-limit for specifically identified third parties

DESCA 8.2

- Grant Agreement applies
- Parties **waive right to prior notice** regarding the third parties if identified in an attachment to the CA

Protection and Use

Grant Agreement II.28 and 29


- Foreground **capable of industrial or commercial application should be protected**
- If no protection and no transfer to other Beneficiary or Affiliated Entity in a Member State (MS) or Associated country (Ac) or to any other third party in a MS or Ac, no dissemination before the Commission has been informed
- Owner shall use Foreground or ensure that it is used

DESCA

- Grant Agreement applies, no (additional) rules concerning Protection and Use

Dissemination

Grant Agreement II.30.3

- Obligation to disseminate Foreground
-  No dissemination before decision regarding possible protection!
- 45 days prior notice of any dissemination – Beneficiaries have right to object within 30 days if legitimate interests regarding their Foreground or Background could suffer disproportionately great harm

DESCA 8.3

- Procedure of Grant Agreement applies
- The Party objecting a publication has to show that its legitimate interests will suffer disproportionately great harm and shall include a request for necessary modifications
- Publication of other Party's Foreground only with prior approval
- Cooperation obligation regarding thesis or degree

IPR Rules Regarding ACCESS RIGHTS

FOREGROUND

- Ownership
- Transfer
- Protection / Use
- Dissemination

ACCESS RIGHTS

- Background covered
- Principles
- Access rights for implementation
- Access rights for use

BACKGROUND Covered

Grant Agreement II.31

- Beneficiaries **may define the Background *needed*** for the purposes of the project in a written agreement and, where appropriate, **may agree to exclude specific Background**

DESCA 9.1

- **Option 1: Positive list:** The Parties list Background available for the Parties (if Needed) – all other Background is excluded from the obligation to grant Access Rights
- **Option 2: Negative list:** The Parties list specific Background excluded from the obligation to grant Access Rights – all other Background is available (if Needed).
- For both options, access to Background **after signature of the CA may only be reduced if the General Assembly approves**

Access Rights - Principles

Grant Agreement II.32

- All requests shall be **in writing**
- **Information** of the Consortium of **any limitation** to the granting of Access Rights to Background
- **Termination** of the participation of a participant **shall not affect obligation of granting Access Rights**
- **No right to grant sub-license**
- **Exclusive licenses** to Background and Foreground **possible if** other participants waive their Access Rights in writing
- **Commission may object** to the granting of exclusive licenses to Foreground to third parties established in **third countries not associated to FP7**

DESCA 9.2

- Principles of Grant Agreement apply
- General Assembly decides whether restriction of Access Rights have impact on the Consortium Plan and may decide to update it accordingly

Grant Agreement - Access Rights

DESCA - Access Rights

	Access rights to Background	Access rights to Foreground resulting from the project
For implementing the project	Yes, if a participant needs them for carrying out its own work under the project	
	Royalty-free, unless otherwise agreed in Attachment 1 (Background list)	Royalty-free
For use purposes (exploitation + further research)	Yes, if a participant needs them for using its own Foreground	
	On fair and reasonable conditions to be agreed	<u>Option 1</u> : on fair and reasonable conditions to be agreed; internal research royalty-free <u>Option 2</u> : Royalty-free

Definition of “Needed“

Grant Agreement

- No definition

DESCA 1.2

- **Access Rights granted for the implementation of the Project:**
Access Rights are Needed if carrying out the tasks assigned to the recipient Party would otherwise be impossible, significantly delayed or require significant additional financial or human resources.
- **For Use of own Foreground:**
Access Rights are Needed, if the Use of the recipient Party's own Foreground would otherwise be technically or legally impossible.

Access Rights for Use for Affiliates

Grant Agreement II.34.3

- Affiliates established in a Member State or Associated Country have Access Rights for use under the same conditions as Beneficiaries

DESCA 9.5

- **Option 1:** Grant Agreement applies
- **Option 2:** Grant Agreement applies
 - In addition, Affiliated Entities shall also enjoy Access Rights if they can show that they hold a license on Foreground developed by a Party they are affiliated to; and they Need Access Rights in order to Use such Foreground; they are established in a Member State or an Associated State; and they are listed in Attachment 4 to the Consortium Agreement (OPTIONAL).
- **For both options:**
 - Access Rights for Affiliates upon written bilateral agreement and under fair and reasonable conditions;
 - Parties may refuse to grant Access Rights to Affiliates if it would be contrary to their legitimate interests.

Confidentiality

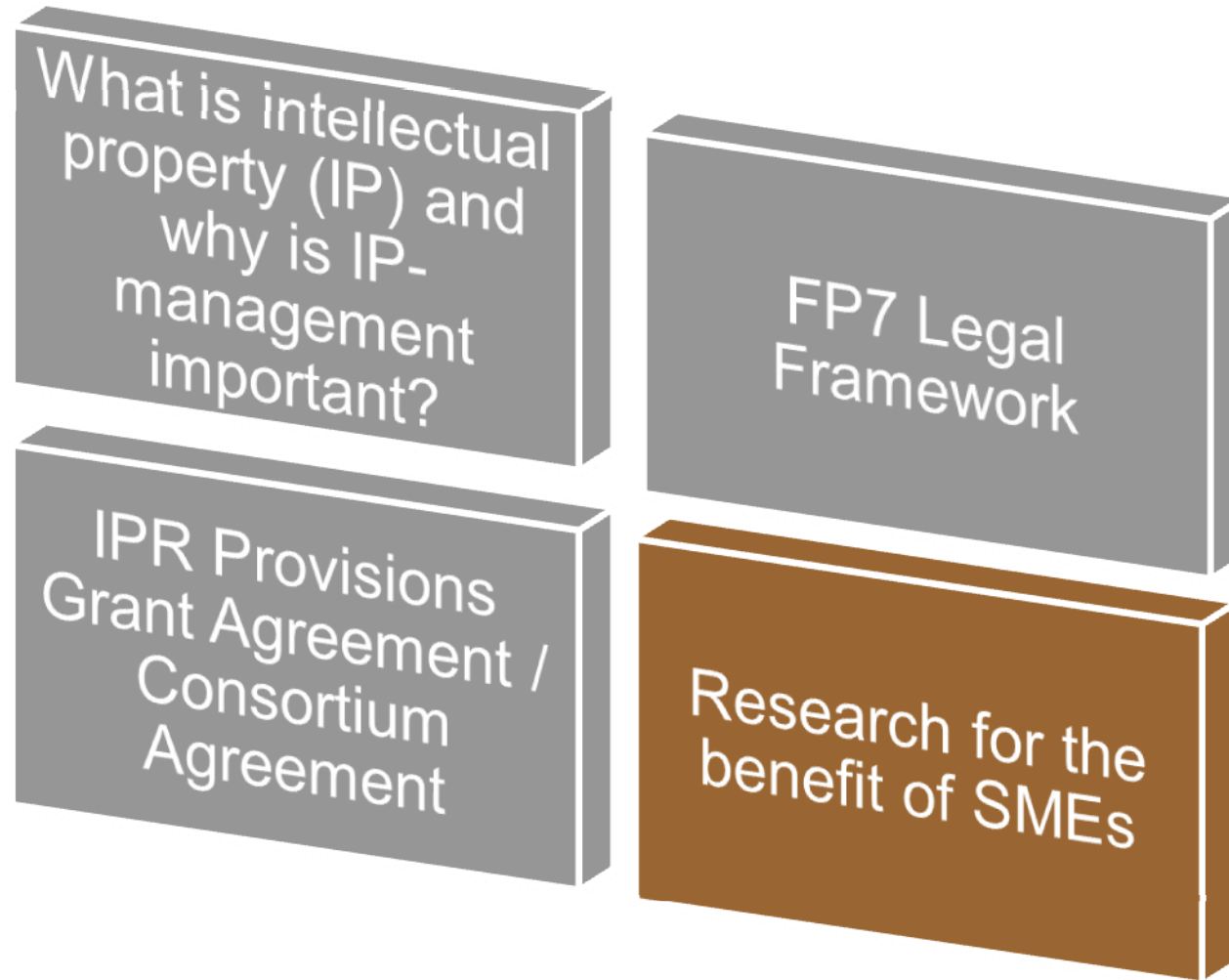
Grant Agreement II.9

- During the project and for a period of **five years after its completion or any other period** thereafter as **established in the CA**, the beneficiary undertake to preserve the confidentiality of any data, documents or other material that is **identified as confidential** (...)

DESCA 10.

- Based on Grant Agreement clause
- **Range of confidentiality:** only information marked as confidential
- **Duration:** five years after the end of the Project

Research for the benefit of SMEs



Specific Action: Research for the Benefit of SMEs

Objective

- Strengthen the innovation capacity of SMEs

Basic types of participants

- **SME participants** or SME associations
- **RTD performers** (research organisations and industrial companies)

Default regime

- **SME becomes owner of the results** generated by the RTD performers
- Participants **may decide** that the RTD performers will own project the results

Main issues

- **Ownership of the results; access to the results** by SME participants/RTD performers;
access rights to the RTD performers
background for SME participants;
remuneration to be paid to the RTD performers

Further Information

- **European Commission** documents and guides

http://cordis.europa.eu/fp7/find-doc_en.html

- **DESCA**

<http://www.desca-fp7.eu/>

- **IPR-Helpdesk**

<http://www.ipr-helpdesk.org/>

- Guide to Intellectual Property Rules for FP7 projects

ftp://ftp.cordis.europa.eu/pub/fp7/docs/ipr_en.pdf

- How to manage Intellectual Property under FP7? A practical guide for SMEs

http://www.ipr-helpdesk.org/documents/IPR_Guide_for_SMEs.pdf

- Comparison of FP7 consortium agreement models

http://www.ipr-helpdesk.org/documents/ComparisonFP7Models_0000006611_00.xml.html

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Thank you for your attention!

Questions?

