

TIPS

TRANSPORT R&D
FOR INNOVATION



The **TIPS** project is supported by the European Commission through the Seventh Framework Programme for Research and Technological Development / Coordination and Support Actions (CSA)

Intellectual property rights in FP7 projects

The challenge of joint ownership

TRAINING ACADEMY

“Turning research results into exploitable products and services”

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Lyon, France

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IPR = intellectual property rights

- Rights to protect intellectual property

FP7 project lifecycle

- Pre – project phase
 - Project proposal preparation & project negotiation
- Project phase
 - Project implementation
- Post – project phase
 - After the project end

BROUGHT INTO THE PROJECT

CREATED IN THE PROJECT

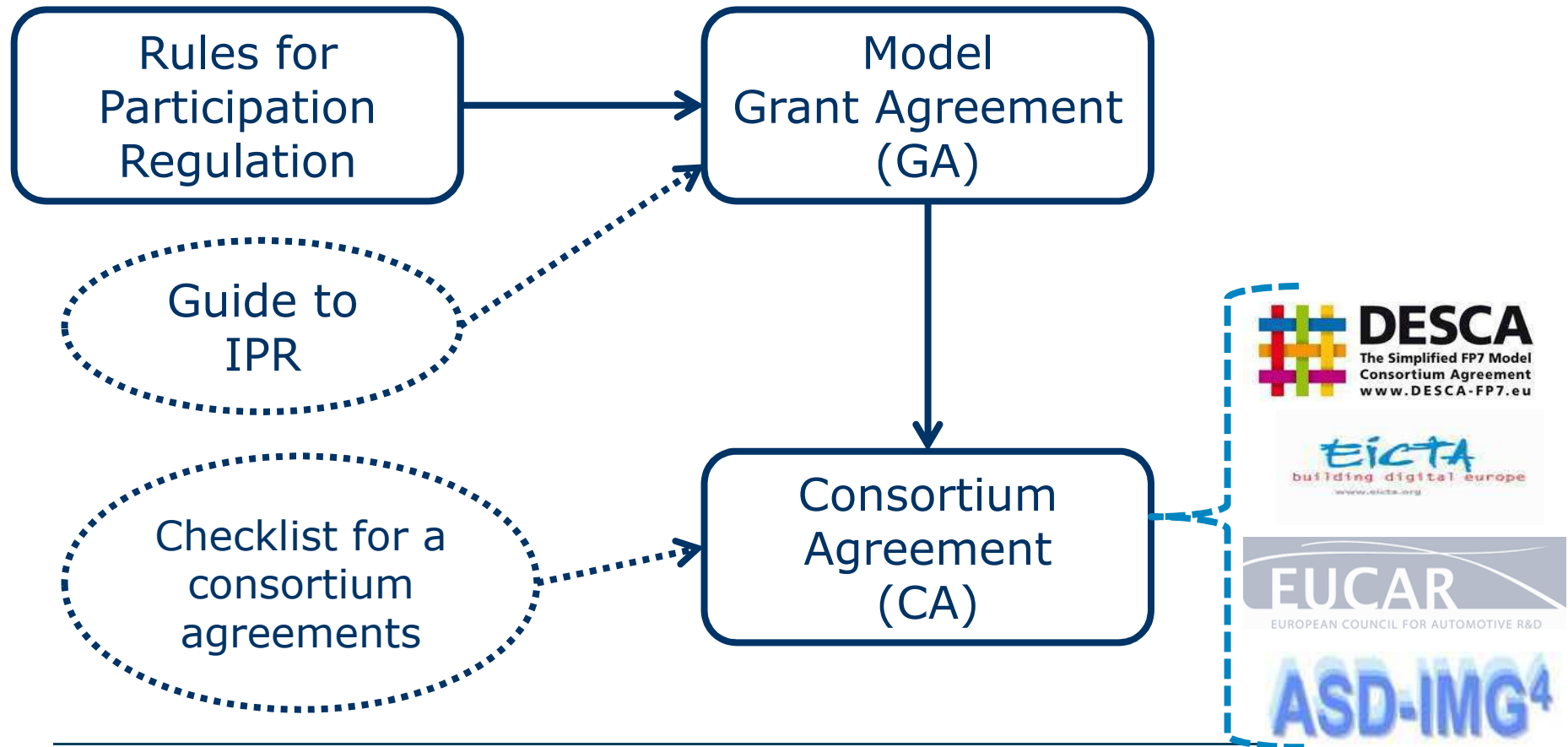
**IPR
in
FP7
projects**

=

**dealing with
“information and
pertaining IPR” :**

IPR in FP7 projects

-
described in the following binding and
non-binding documents



IPR management in FP7 projects

-
described in and performed in line with:

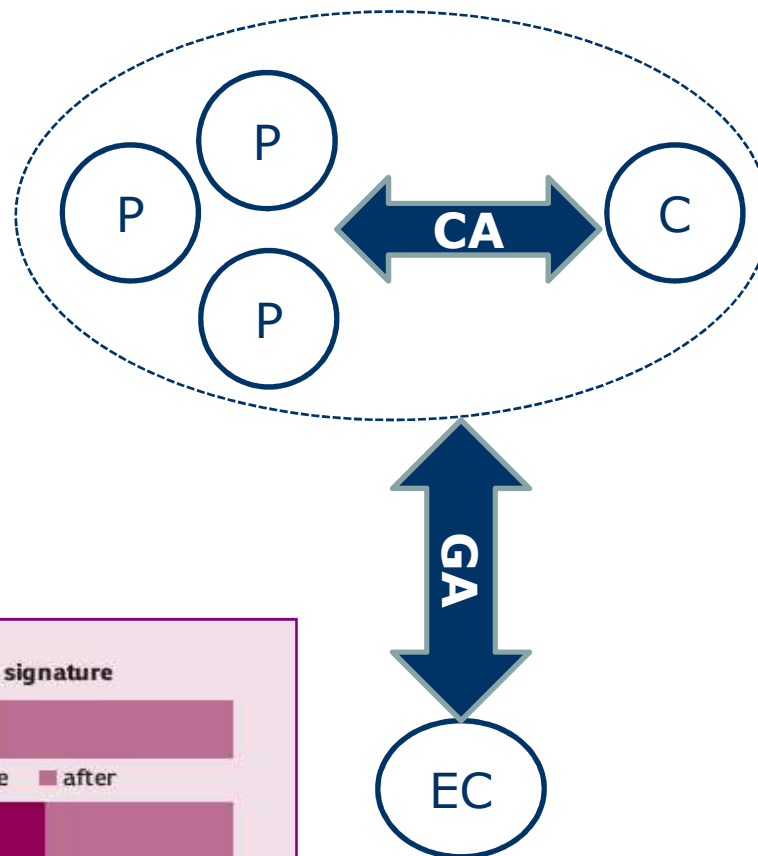
CA JK21

- Obligation to enter into, unless...
- Must be in line with GA
- Art. 1.4 GA Core Text – ... deemed to have concluded CA

...

BUT

*TC AS CR Survey 2010/2011 –
Czech Republic*



Folie 5

JK21

CA also important in relation to JO - we will have a deeper look into this later on!!!!

JK; 20.11.2013

BROUGHT INTO THE PROJECT

JK1

Background

JK2

- *information held by beneficiaries prior to their accession to GA, as well as copyrights or other intellectual property rights pertaining to such information, the application for which has been filed before their accession to GA, and which is needed for carrying out the project or for using foreground*

CA

Background included

Background excluded

Folie 6

JK1

- 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.

JK; 02.11.2013

JK2

B - This means that it is not only information or intellectual property rights that are owned by participants but the category of background broadens to any information or intellectual property rights that are held by participants. The definition of background further states that it is related only to information relevant to the project, i.e. information needed for specified purposes, which are project implementation and/or further use of the generated foreground.

JK; 02.11.2013

CREATED IN THE PROJECT

JK7

Foreground

JK8

- *the results, including information, materials and knowledge, generated in a given project, whether or not they can be protected*

CA

Folie 7

JK7

Foreground means the results, including information, materials and knowledge, generated in a given project, whether or not they can be protected [Guide to IPR, 2009]. Participants may therefore request access only to those information and rights that are relevant, i.e. needed.
JK; 02.11.2013

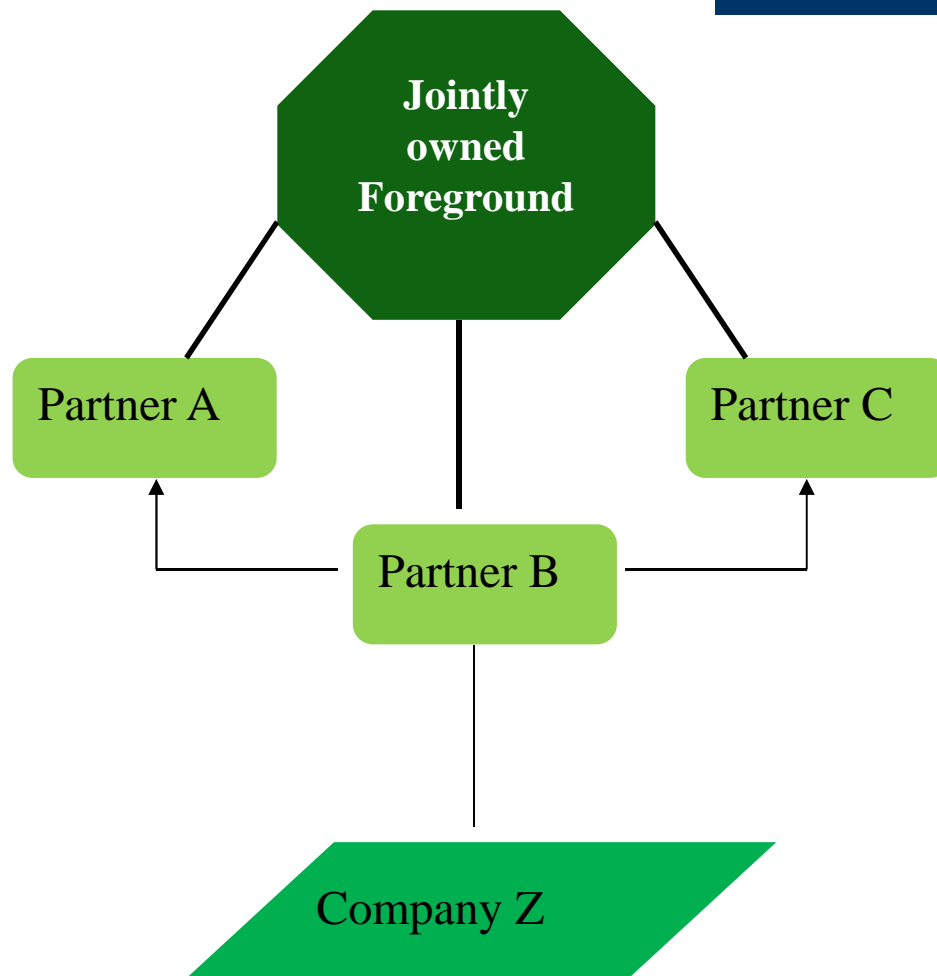
JK8

Vedle F - SIDEGROUND, in parallel!!!
JK; 02.11.2013

Ownership

Background	Foreground
Remains the property of the partner bringing the Background into the project, unless...	Foreground, resulting from the project, is owned by the participant generating it Rights of third parties Joint Ownership

Joint Ownership



Foreground

JK22

- **Joint Ownership Agreement**
- **CA**
- **GA default regime:**
 - Each of joint owners
 - Can grant non-exclusive licence to 3rd parties
 - Without right to sublicense
 - Prior notice and fair and reasonable compensation
 - NO authorisation needed

Folie 9

JK22

In any case, the best solution is JOA concluded after it is crystal clear there is jointly owned F - it can encounter all the aspects of created F.

However CAs also usually deal with JO.

In any case there is also default regime in the GA...

JK; 20.11.2013

Joint Ownership

Foreground

• CA



8.1 Joint ownership

OPTION 1:

Where no joint ownership agreement has yet been concluded:

- each of the joint owners shall be entitled to Use their jointly owned Foreground on a royalty-free basis, and without requiring the prior consent of the other joint owner(s), and
- each of the joint owners shall be entitled to grant non-exclusive licenses to third parties, without any right to sub-license, subject to the following conditions:
at least 45 days prior notice must be given to the other joint owner(s); and Fair and Reasonable compensation must be provided to the other joint owner(s).

OPTION 2:

In case of joint ownership, each of the joint owners shall be entitled to Use the joint Foreground as it sees fit, and to grant non-exclusive licences, without obtaining any consent from, paying compensation to, or otherwise accounting to any other joint owner, unless otherwise agreed between the joint owners.

The joint owners shall agree on all protection measures and the division of related cost in advance.

Folie 10

JK23

8,1 - in addition to GA, also free use by joint owner indeed. The rest equal to default regime.

8.1 option 2 - no compensation!!! No information !!!!

JK; 20.11.2013

Joint Ownership

Foreground

- Allocation of ownership
 - Only one partner to file and maintain e.g. patent appl.
- Respective shares of ownership
 - Equal/other
- Sharing of costs arising from:
 - Legal protection procedures
 - Exploitation of jointly owned foreground
- Use by joint owners, assigning and granting licenses
- Alternative regime instead of joint ownership:
 - A single owner with more favorable access rights
- Governing law, ways of solving disputes

- **Joint Ownership Agreement**

Folie 11

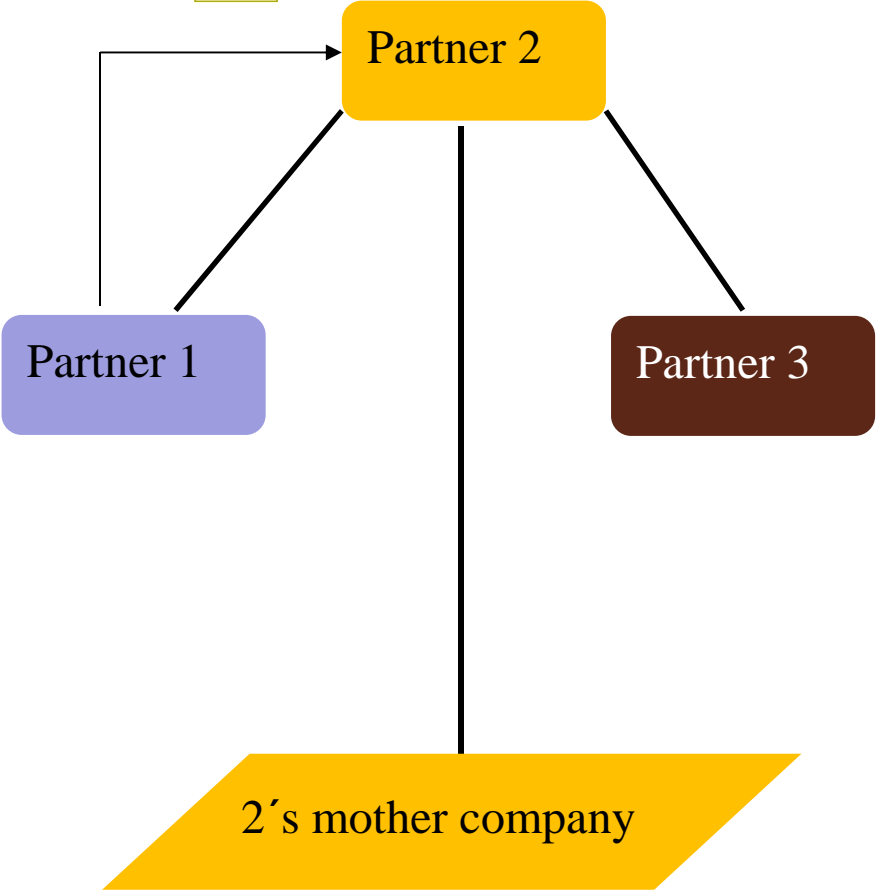
JK24

8,1 - in addition to GA, also free use by joint owner indeed. The rest equal to default regime.

8.1 option 2 - no compensation!!! No information !!!!

JK; 20.11.2013

Transfer of Ownership



Foreground

- Obligation to notify other partners
 - They are entitled to raise objections
 - Transfer not allowed if their access rights would not be preserved

JK11

PRIKLAD

B – wishes to transfer its „databases“ to its mother company
Must notify (45/other) and give time (30 days/other) to raise objections
A is raising objections...

JK; 03.11.2013

Transfer of Ownership

Partner 2

2's mother company

Foreground

- Specifically identified third parties in CA
 - No notification/objections

- Collaboration - knowledge sharing and exchange of Background and Foreground
 - = exercising Access Rights
- *Rights acquired by licensing agreements and other user rights*
- Participants **must grant access** to each other's Background and/or Foreground

JK10

CA - At least **for following specific purposes**

1. project implementation purposes
2. use of Foreground purposes

– And **under some financial and time conditions:**

JK10

Priklad PURPOSES:

Your partner approaches you saying he needs a list of your data = results of some measurements - in order to carry out his own measurements, i.e. in order to implement his tasks on the project.

In this case YOU HAVE TO give him data = grant access. OF COURSE UNDER some financial and time conditions (will see on the next slide).

If your partner approaches you saying I am working on another project and your results (F) would be help me a lot - YOU DONT NEED TO grant him access.

BUT, it depends on the CA, as CA CAN BROADEN THOSE PURPOSES!!!!

- CA can say "access will be granted to F/B for any purposes"

Be careful, but in practice this does not happen very often...

JK; 03.11.2013

Access Rights

JK9 JK14	Financial conditions		Time conditions
	Background	Foreground	
Project implementation purposes	Needs for carrying out own tasks		Anytime till project end
	Royalty – free unless otherwise agreed before GA conclusion CA	Royalty - free	
Use purposes	Needs for use of own Foreground		Up to 1 year after project end/termination of a participant participation, unless ... CA
	Royalty-free or on fair and reasonable conditions CA		

JK9

PRIKLAD!!!

Financni podminky (vc. poskytovani B za uplatu, byt nebylo predem sjednano)

- this is what I have come across as a problem - if a partner has VALUABLE B (also outside the project!) and does not really know he can ask royalties for granting access to this B
- CZ - Czech partner paid royalties for accessing B to his partner who asked for it ALTHOUGH it has not been agreed before GA conclusion!!!! Because CZ partner did not know about this rule!!!!
- CA - usually royalty-free as an option kept

Financni podminky pro poskytovani B/F for use purposes

- means more favourable conditions than on the market!
- therefore companies are willing to enter into those projects - they are sure they will access other partners F/B for favourable licence conditions!!!!
- CA - almost never for free!!!

Time conditions for use purposes

- there is a time limit of 1 year = guarantees that it will not happen that after 20 years your partner will knock on your door saying he wants your F for use his own F because 20 years ago you participated at FP7 project :)
- moreover, 1 year can be SHORTENED/EXTENDED IN CA (CZ PRIKLAD - MSP, valuable software for free, but access rights only 1 week after the project end)

JK; 03.11.2013

JK14

PRIKLAD FROM TC AS 2010 SURVEY:

- generally no problem with fin/time conditions understanding
- but due to having problems to get acquainted with FP7 IP rules in general, usually thinking that PARTICIPATION IN FP7 PROJECT OBLIGES THEM TO PARTICIPATE EVEN OUTSIDE PROJECT AND AFTER THE PROJECT END!!! NO!!!!!!!!!!!!!!!

JK; 03.11.2013

Access Rights

	Time conditions
<i>Project implementation purposes</i>	Anytime till project end
<i>Use purposes</i>	Up to 1 year after project end/termination of a participant participation, unless ...

During this time period Access Rights need to be preserved, i.e.:

- granting of **exclusive license** JK15
- **transfer of Foreground** only under some circumstances.

Non-exclusive license
OK.

Folie 16

JK15

PRIKLAD - LONI, grant exclusive licence!!!!!!!

JK; 03.11.2013

Protection

Foreground

- Valuable Foreground should be protected
- Not mandatory in all cases, but...

Foreground

Participants should

- Use own Foreground (direct use), or
- Ensure it is used (indirect use)

Use means

- Use for developing, creating and marketing a product or process, or for creating and providing a service
- Direct/indirect Foreground utilization in further research activities other than those covered by the project

Dissemination

Foreground

Participant should

- ensure that the foreground he/she owns is disseminated as swiftly as possible.

Any dissemination should be delayed until a decision about the possible protection of the foreground has been made.

Prior notice of any dissemination activity and possible objections

- dissemination may not take place until objections are resolved



THANK YOU FOR YOUR ATTENTION!

QUESTIONS?

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