



European IP Helpdesk

IP in EU funded projects

Michele Dubbini

IP and Innovation Advisor

23 May 2019





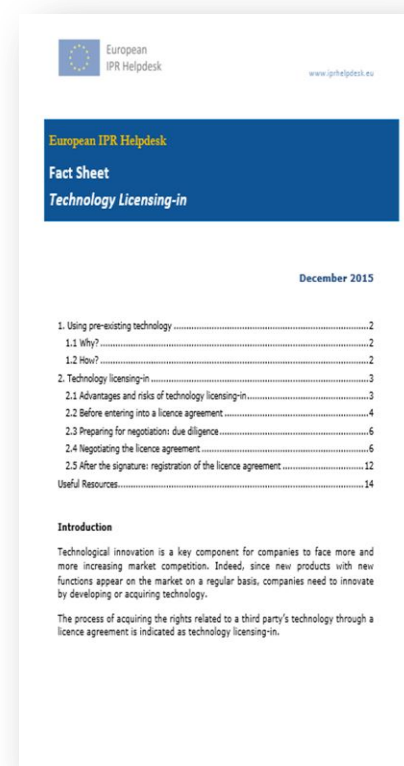
Upcoming Webinars 2019

- ~~IP Commercialisation and Licensing, 06/02/2019~~
- ~~Geographical indications, 06/03/2019~~
- ~~Technology Transfer, 13/03/2019~~
- ~~IP in EU-funded Projects/Horizon 2020, 27/03/2019~~
- ~~Consortium Agreements, 10/04/2019~~
- ~~IP Management in H2020 - with a special focus on MSCA, 24/04/2019~~
- ~~Impact and Innovation in Horizon 2020 – a Guide for Proposers 08/05/2019~~
- Freedom to Operate in Horizon 2020, 29/05/2019
- Maximising the impact of Horizon 2020 project results, 12/06/2019



Publications: our online library

- **Fact sheets:** Simple and easy to read guidelines on IP topics
 - IP Management in H2020
 - Ip business plans
 - IP in biotechnology
- **Templates:** download examples that you can adapt to your needs
 - Consortium Agreements
 - Licensing Agreements
 - Non Disclosure Agreements

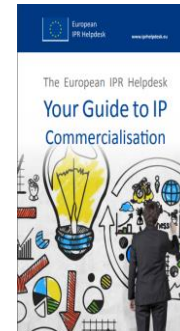




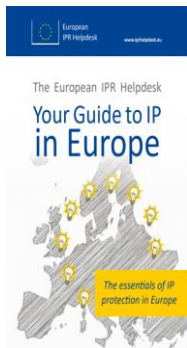
Your guides to IP:



**“Your guide to IP
in Horizon 2020”**



**“Your guide to IP
Commercialization
”**



**“Your guide to IP in
Europe”**



**“Making the most
of your Horizon
2020 Project”**



Other IPR Helpdesks

CHINA IPR 
SME HELPDESK



  European
Commission | **Mercosur IPR SME Helpdesk**



ASEAN IPR
SME HELPDESK





Roadmap

- *Importance of IP in H2020*
- *Terminology and agreements*
- *GA rules: Flexibility*
- *Further assistance: EU IPR Helpdesk services*
- *Questions received from SMEs and R&D*





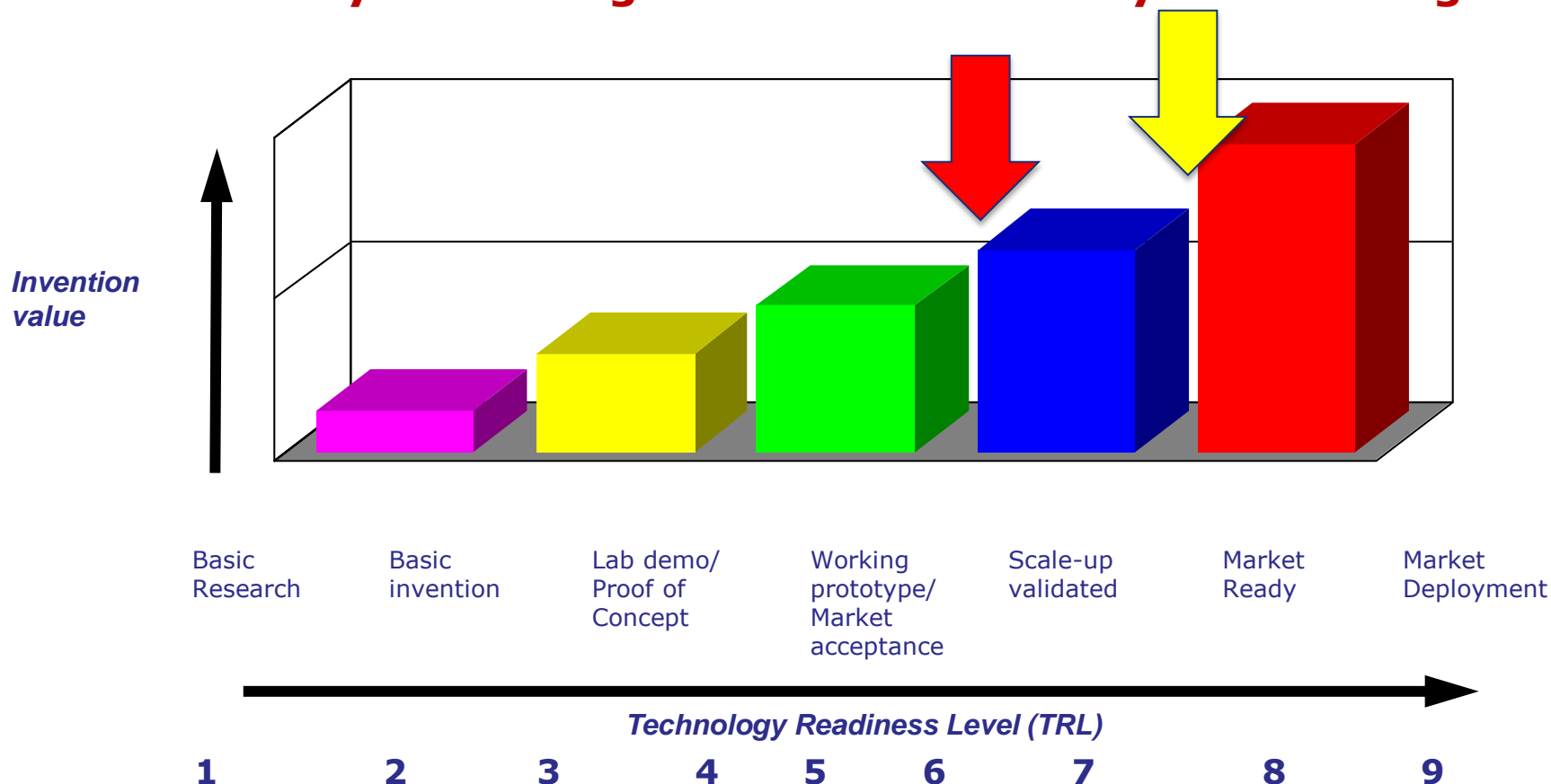
Why is it important to consider IP in H2020?

- ✧ The Rules for **Participant** establish **best efforts** commitment of participants to exploit their own results.
- ✧ IP and exploitation issues are subject to evaluation regarding **impact and feasibility** of the proposal.
- ✧ **A convincing outline of IP management and exploitation strategies** on individual and consortium level within the proposal is a relevant matter.
- ✧ Results of research and development activities require further and often substantial investments to take them to market, which is **appealing** if the results are well protected through **intellectual property**.
- ✧ Properly managing IP in the projects, helps participants to **avoid future conflicts** among the consortium.



Technology Readiness Levels

Where are you starting from and where do you want to go?



A yellow rectangular sign with rounded corners and a black border, containing the word "STOP" in bold, black, uppercase letters.

STOP

A yellow callout box with rounded corners and a black border, containing the text "Terminology and Agreements".

Terminology and Agreements



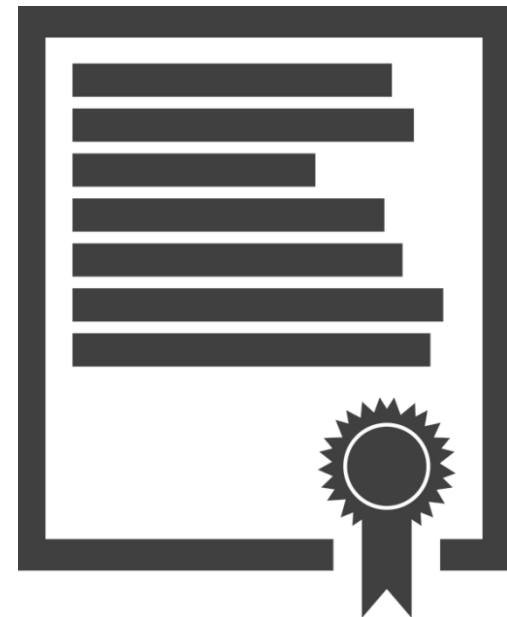
Intellectual Property Vs Intellectual Property Rights

- Intellectual Property (IP)



≠

- Intellectual property rights (IPR)





Vocabulary

Key terms in the context of Horizon 2020 projects are:

- Background
- Results
- Exploitation
- Dissemination
- Access rights





Definitions (I)

Background

Tangible or intangible input (data, knowhow, 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).

Examples: *prototypes; cell lines; database rights, licences with the right to sublicense*

Project partners **must identify their background in writing**

Results

All results which are generated under the project – whether or not protectable. Such results may include copyrights, design or patent rights, trademarks or others, and belong to the partners who have generated them.





Definitions (II)

Access rights

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

Exploitation

Utilisation (direct/indirect) of results 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.

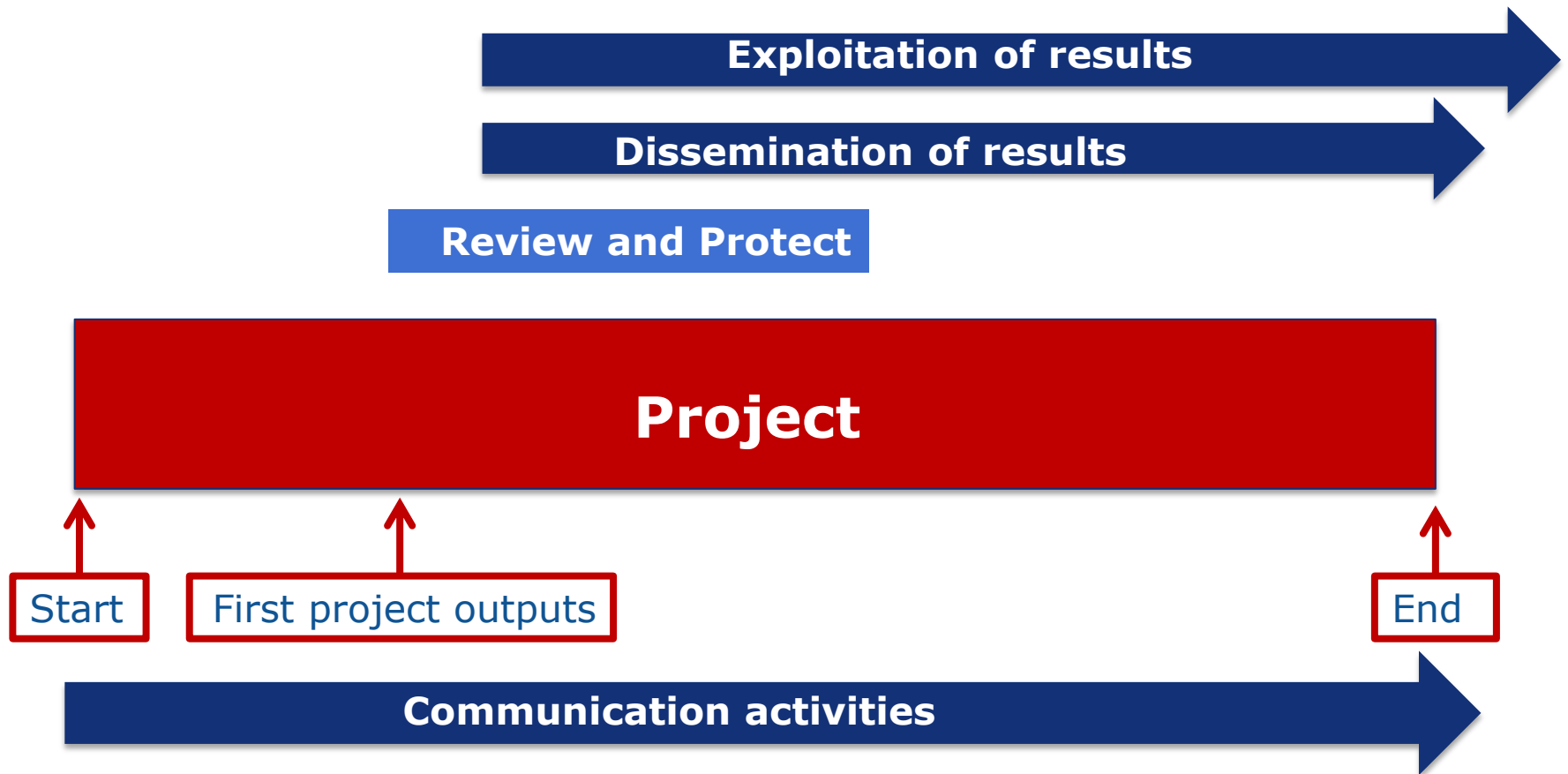
Dissemination

Means through which research results are presented to the public. Official publications (e.g. patent applications) are not considered as dissemination.



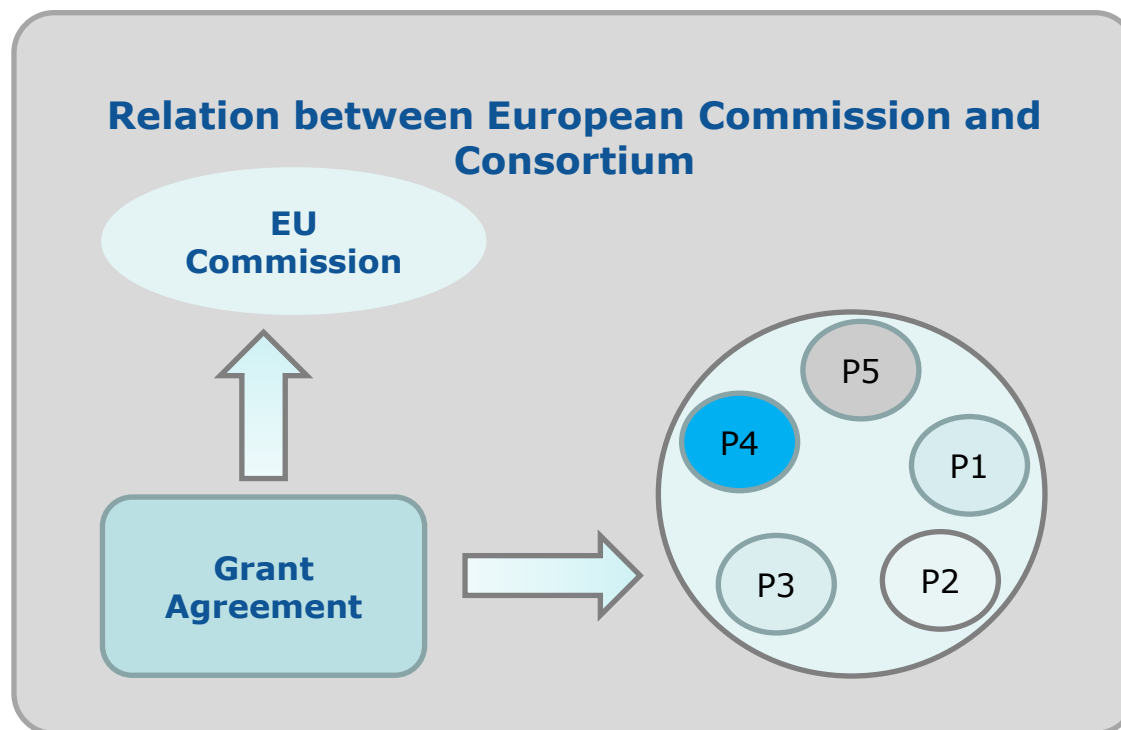


Communication of activities vs Dissemination of results





Grant Agreement (I)





H2020 – Annotated Model Grant Agreements

- **General Model Grant Agreement**

Section 3 addressing „Rights and Obligations related to Background and Results“

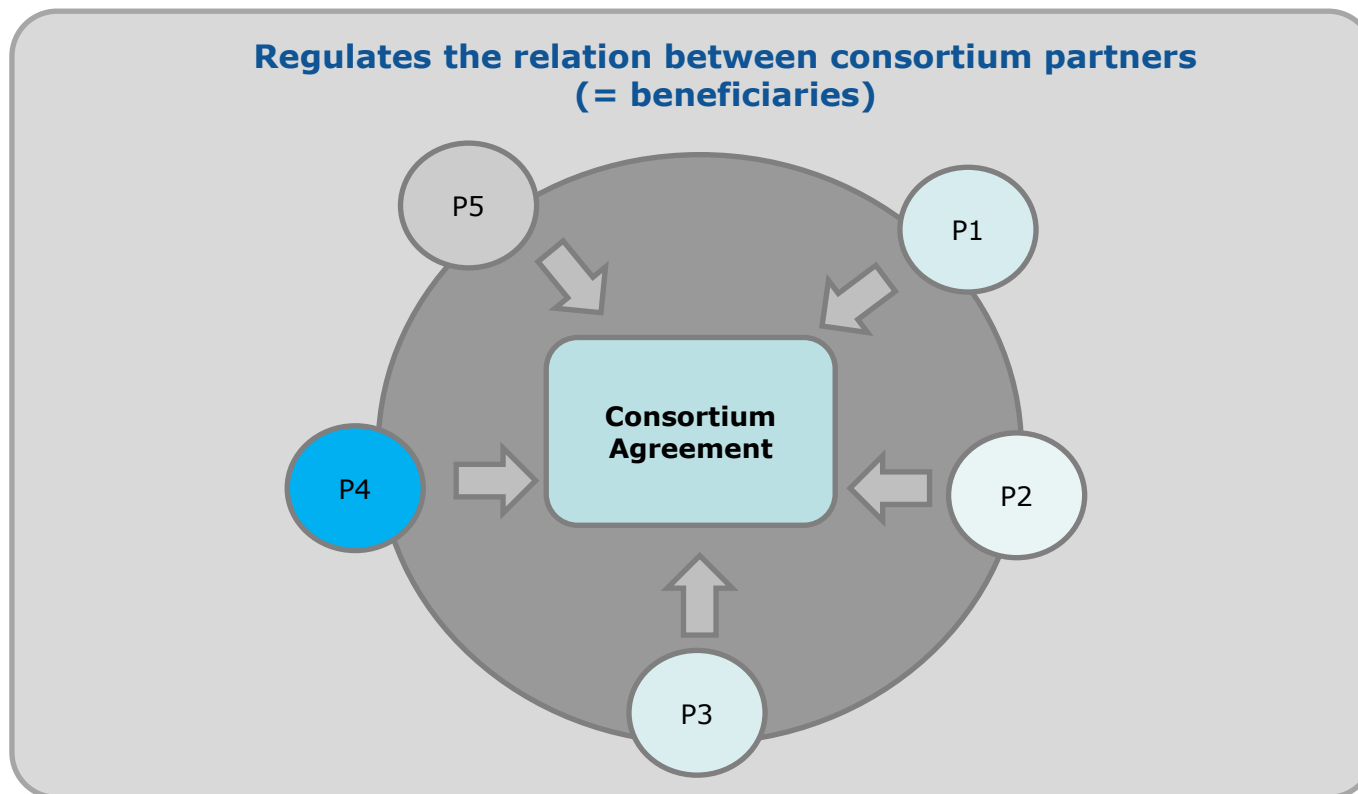
Structure:

- Core text with relevant articles
- Annotations to articles
- Examples, best practices, lists and procedures, exceptions

The document will be periodically updated with new examples and explanations, based on practical experience and on-going developments



Consortium Agreement (CA)





Consortium Agreement (II)

- A legal document that regulates the internal work of the Consortium
- Mandatory for the majority of projects
- Legal basics: Grant agreement (+ Annexes)/ RfP
- Implements the provisions of the Grant Agreement/programme rules
- May in no way contradict the prerequisites laid out in the EU Agreement/programme rules; the latter always take precedence!
- The CA should be worked out during the "time to grant" at the latest ; be prepared!
- Consortia are responsible for set up the governing rules; the Commission has no binding model, but... see participant portal
- **DESCA** (Development of a Simplified Consortium Agreement) model; Different options/modules, i.e. related to software development
MCARD-2020 - ICT industry; **EUCAR** – Automotive industry; **IMG4** - Model Consortium Agreement for the Aeronautics projects

<http://www.desca-2020.eu/>





STOP

The background of the slide features several overlapping, multi-colored lines in shades of blue, green, purple, yellow, and brown. These lines are mostly horizontal but have various steps and curves, creating a complex, abstract pattern. A yellow rounded rectangle with the word "STOP" in white capital letters is positioned on the right side of the slide.

GA Rules: Flexibility



Ownership of Results

- **In Horizon 2020, generally the grant agreement establishes that the results of the project belong to the participant generating them.**
- It is advisable to take appropriate measures to properly manage ownership issues, such as keeping laboratory books or other kinds of documentary evidence (e.g. a properly completed Invention Disclosure Form)
- Given the collaborative nature of most projects, some results can be jointly developed by several participants. Hence, situations of joint ownership might arise.
 - > **Joint Ownership Agreements** (i.e. defining specific conditions for granting licenses or issues related to costs of protection and sharing of potential revenues); Default rule in Consortium Agreement ..



Access Rights (I)

- Each project partner has the right to **request access rights** to the other project partner's background and results as long as it needs them in order to carry out its work under the project or to use its own results (these are **minimum access rights**).
- Shall be made in writing.
- To avoid conflicts, it is recommended that beneficiaries agree (e.g. in the consortium agreement) on a common interpretation of what is "**needed**".
- Are to be requested/granted throughout the duration and up to 1 year (or as otherwise agreed in the CA) after the end of the project for exploitation needs; Once requested, access rights may be exercised as long as they are needed for exploiting the results (e.g. until the background patent expires).
- Access rights do **not** confer the right to grant sub-licences.



Access Rights (II)

Granting of Access Rights

	Access to background	Access to results
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



General obligation to protect

Each beneficiary must examine the possibility of protecting its results and must adequately protect them — for an appropriate period and with appropriate territorial coverage — if:

- (a) the results can reasonably be expected to be commercially or industrially exploited and
- (b) protecting them is possible, reasonable and justified (given the circumstances).

When deciding on protection, the beneficiary must consider its own interests and the interests (especially commercial) of the other beneficiaries.



Protection by subject matters

Subject Matter	Patent	Utility Model	Industrial Design	Copyright	Trade Mark	Confidential Information
Invention (e.g. device, process, method ¹)	X	X				X
Software	X ²	X		X		X
Scientific article				X		
Design of a product			X	X	X	
Name of a technology/product					X	
Know How	X	X				X
Website			X	X	X	

¹ Except methods excluded from patentability by virtue of Articles 52(2)(c) and (3) and 53(c) EPC.

² Software patentability is still a debated issue given its exculsion as subject matter as by Article 52(2)(c) and (3) EPC.



Costs reimbursements

- **Costs of intellectual property rights (IPR)**, including protecting results (e.g. fees paid to the patent office for patent registration) **are eligible costs**
- **Cost for open access** publications are also considered **eligible** by the GA, e.g. Author Processing Charges (APCs)
- Ask your legal/financial NCP!



Obligation to disseminate

Project partners are obliged to disseminate the results swiftly (i.e. to scientific community/broader public) by any appropriate means and including the publication of results in any medium.

But:

- *no dissemination of results may take place before decision is made regarding their possible protection, and*
- *all patent applications, publications or any other dissemination (also in electronic form) shall include a statement that the action received financial support from the Union – The same applies to results incorporated in standardisation activities.*





Dissemination checklist

- Take a decision about the protection of foreground and all required steps
- Inform the other consortium partners in writing 45 days before the planned dissemination activities and include enough information to allow them to analyse whether their interests are affected or not. Note that this time limit can be changed (for more or less days) in the CA. Wait 30 days for any objection to the dissemination (unless otherwise agreed in the CA).
- Beware not to infringe third parties' intellectual property rights
- **Open access as a general principle of scientific dissemination**
- List the dissemination activities in the Exploitation and Dissemination Plan



Novelty:

A crosspoint between Protection and Dissemination activities:

- **Art 54: European Patent Convention:**

An invention shall be considered to be new if it does not form part of the state of the art.

State of the art : Everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.

Evaluate carefully disclosure and dissemination activities



Obligation to disseminate Vs. Obligation to protect

Make sure you comply with the obligation to protect...

Sometime early disclosures (dissemination or communication of results) may undermine potential future exploitation activities.

THEN!

...comply with the obligation to disseminate



General obligation to exploit

Each beneficiary must — **up to four years after the project completion** take measures aiming to ensure '**exploitation**' of its results (either directly or indirectly, in particular through transfer or licensing by:

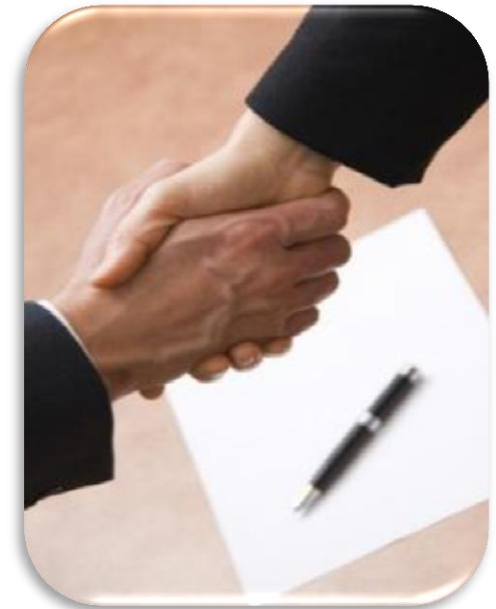
- (a) using them in further research activities (outside the action);
- (b) developing, creating or marketing a product or process;
- (c) creating and providing a service, or
- (d) using them in standardisation activities.



Routes for use/exploitation

Basic options

- Use for further research
- Developing and selling own products/services
- Spin-Off activities
- Cooperation agreement/Joint Ventures
- Selling IP rights/Selling the (IP based) business
- Licensing IP rights (out-licensing)
- Standardisation activities (new standards/on-going procedures)

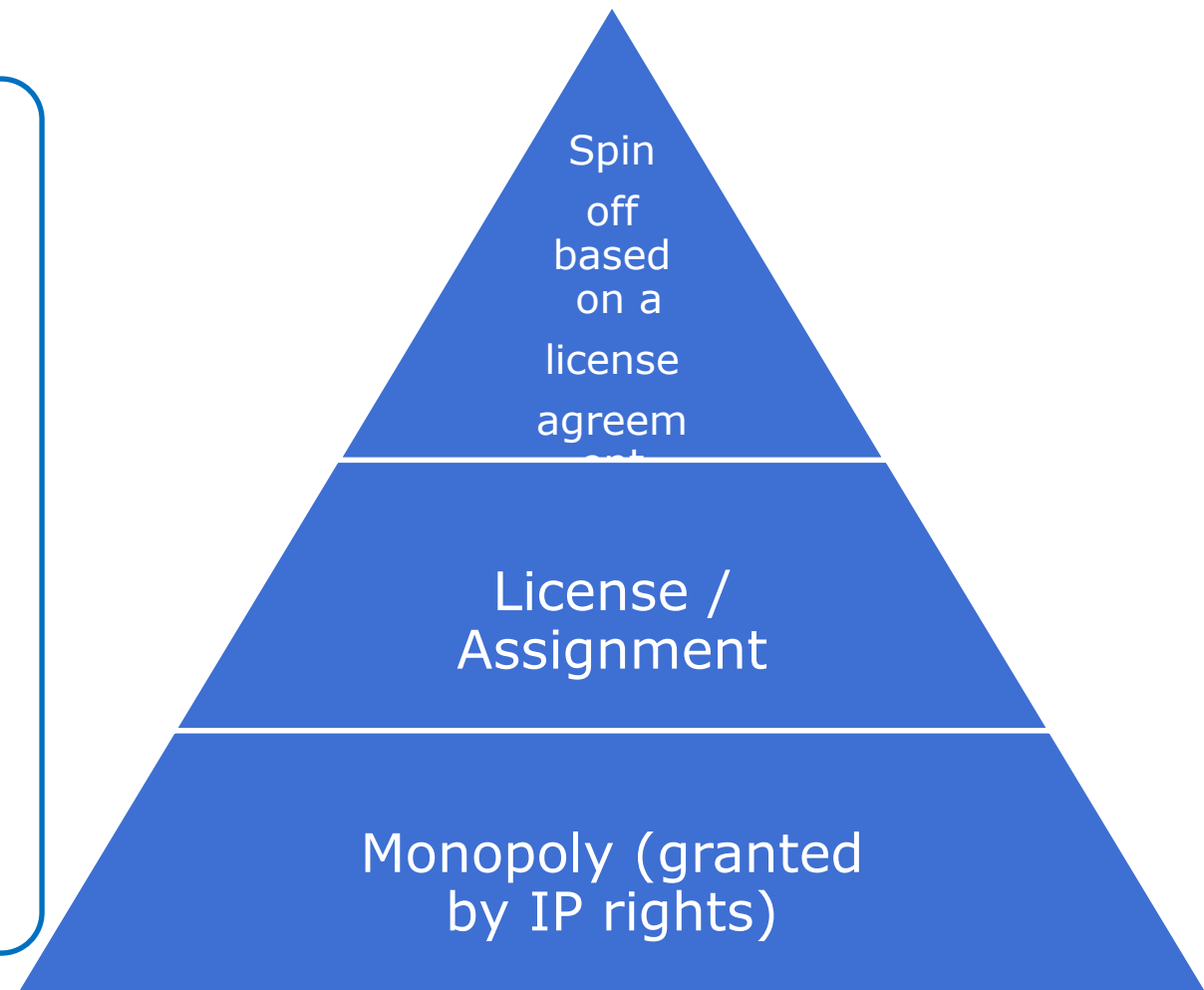




Exploitation Models

- Some exploitation ways are viable only if Project results have been duly protected before
- A license is useless with out the monopoly granted by IP rights

Be aware!





Exploitations' Limits

- Art 30.3 GA EC right to object to transfers (assignments) or licenses outside the European Union (countries non associated with H2020)
- A formal notification is needed!





Obstacles:

- Existing IP Rights belonging to competitors:
 - Be smarter: Search!



WIPO
WORLD INTELLECTUAL PROPERTY ORGANIZATION



Europäisches
Patentamt
European
Patent Office
Office européen
des brevets

- Or ask professional to search for you:
 - FTO analysis, may be very expensive but are eligible costs!



SMEs Problems:

- Passive right:



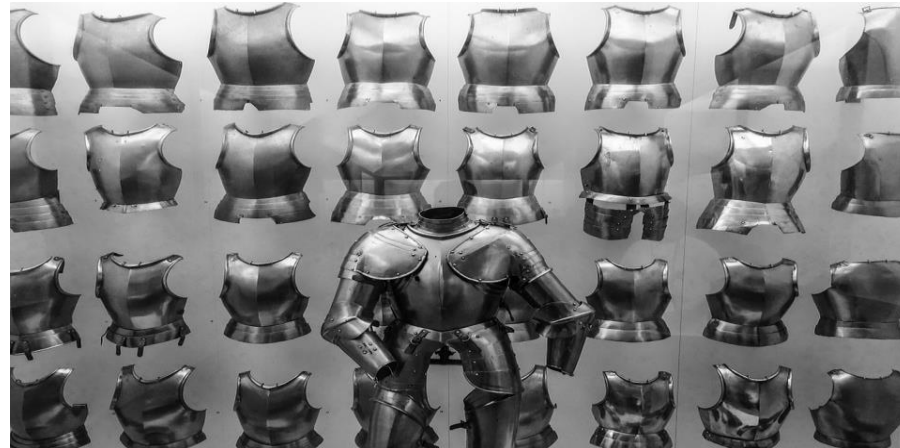
Patent ≠ Freedom to operate

- This exposes them to potential infringement risks, almost always without even knowing about it.



Rights Conferred

- An IP right grants to its owner a monopoly on the product of the mind protected. Nobody without his authorization may use, commercialize etc. the protected item.





SME Problems:

Often SMEs or researchers do not know what their options are.

Few SMEs understand that IPR protection has a territorial limit.

NATIONAL REGISTRATION

In general, an application filed before your National Patent and Trademark (**NPO**)

EUROPEAN REGISTRATION

- European protection at **NPO**, **EPO** or **EUIPO**



INTERNATIONAL REGISTRATION

By filing an international application, **to your NPO, to the EPO, EUIPO or WIPO**

EUROPEAN PATENT With Unitary effect



Principle of territoriality:





Ensure that:

- There are no early disclosures;
 - Protection activities are carried out as planned.
 - The dissemination checklist is followed thoroughly (especially by universities!).
- Exploitation activities may start as soon as possible:
 - Joint ownership agreements are concluded whenever needed/necessary.
 - Parties have access to results needed for exploitation.
Fair and reasonable access conditions!!
- There are no hidden barriers in the market;
 - Competitors' patents or other IP Rights that impede access to a certain market.
FTO studies may help and give indications about existing IP Rights.



Thank you !

- For further questions: michele.dubbini@iprhelphdesk.eu

Photos credits

istockphoto.com

- © istockphoto.com/manidav
- © istockphoto.com/Bliznetsov
- © istockphoto.com/Julie Felton
- © istockphoto.com/Angelika Schwarz
- © istockphoto.com/Rtimages
- © istockphoto.com/Daniel Lafior
- © istockphoto.com/Darijela Pavlovic Markovic
- © istockphoto.com/Warchi
- © istockphoto.com/Dave White