



FP7 ve H2020 Projelerinde Fikri Mülkiyet Yönetimi

KOÇ
ÜNİVERSİTESİ

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Introduction

- **It is strongly recommended that the IPR issues are considered and tackled ASAP since**
 - **The way that the project conducted and the exploitation is affected**
- **A «default regime» → if no alternative agreement**
 - **Rules for Participation**
 - **Grant Agreement (mostly Annex2)**
 - **Comission Recommendation on the management of IP (2008)**



Foreground and Background

Foreground – the tangible (e.g. prototypes, microorganisms, source code and processed earth observation images) and intangible (IP) results of the project.

Background – information and knowledge held by the participants prior to the accession to the GA, also any IPR which are needed for carrying out the project or for using the foreground. (If invention is before the project but the Patent app is filed after - it is not background IP. (But still open to negotiation))

«Ownership of background is not affected by a participation in a project»



Ownership of the Foreground

- Foreground resulting from the project is owned by the **participant generating it**. When foreground is generated jointly, it will be **jointly owned**, unless the participants agree on a different solution (e.g. a single owner with favorable access rights)
- Special attention on
 - Lab notebooks with proper standards (In order to prove ownership)
 - Agreements with the employees, subcontractors, students... etc.



Joint Ownership

- An agreement on the **allocation and the terms** of exercising the ownership. If not – **a default joint ownership** regime applies.
- A 3rd party could also take place in «joint ownership»
- «J.O» may be difficult to deal with (different national IPR laws – so a default regime) acc. to the default regime «each» of the owners is entitled to grant non-exclusive licences to third parties without requesting the authorization of the other owner.
- Agreement has to deal with
 - Maintenance
 - Shares of ownership
 - Sharing of the costs
 - Exploitation



Transfer of Ownership

... is allowed with obligations such as

- **Prior notice to the other participants in the same project (in 45 days with sufficient information about the new owner)**
- **Objection may be raised by another participant with a valid reason (in 30 days)**
- **The Commission may also object (e.g. Third country not associated to the 7th FW Program; ethical, security considerations)**



Protection of Foreground

- Valuable foreground **should be protected**.
- Protection is **not mandatory** in all cases, though the decision *not* to protect foreground should preferably be made in consultation with the other participants, which may wish to take ownership.
- If valuable foreground is left unprotected, the Commission may take ownership. (obligation to inform Commission)
- If a participant does not intend to protect its foreground, it may first offer to transfer it to another participant or even to certain third parties, which may consider it worthwhile protecting this piece of foreground, rather than leaving it unprotected and available for use by competitors



Patent Applications

- When a patent application is filed, it is important that the true **inventor(s) be identified**, not only for fairness reasons, but also for legal reasons. In the USA, in particular, errors (fraud) in the designation of inventors can, under certain circumstances, lead to the invalidation of the patent.
- Patent applications concerning foreground also need to contain the following specific sentence:

«The work leading to this invention has received funding from the European Union's Seventh Framework Programme (FP7/2007-2013) under grant agreement n° xxxxxx»
- The participants should use the foreground which they own, or ensure that it is used.



Dissemination of the Results

- **OBLIGATION** to disseminate swiftly!
- Each participant shall ensure that the foreground it owns is disseminated as swiftly as possible. However, any dissemination (including publications or on web-pages) should be delayed until a decision about its possible protection has been made (through IPR or trade secrets).
- The other participants may object to the dissemination activity if their legitimate interests in relation to their foreground or background could suffer disproportionately great harm.
- However, no dissemination of foreground may take place before a decision is made regarding its possible protection.
- Indeed, any disclosure, even to a single person who is not bound by secrecy or confidentiality obligations, prior to filing for protection, may invalidate any subsequent patent application, be it written or oral.



Before publishing results on a scientific journal...

- **Obtain** the necessary permission from the participant owning the foreground (even if this participant is the employer of the author) before submitting a paper for publication;
- **Discuss** this intention with the other participants and, if some (or all) of the foreground and/or background to be published belong to (an)other participant(s), seek its/their prior approval (no background or foreground may be disseminated without the approval of its owner); it has to be noted that although each participant must disseminate the foreground it owns, several participants may agree to disseminate jointly, as for example often occurs through co-authoring of a scientific publication);
- carefully **Check** the compatibility of the GA with any publication agreement they are envisaging to sign;
- **Inform** the publisher of the obligations resulting from the GA. A contractual provision could be inserted in the publication agreement to take this into account, for example:

"The publisher agrees that the author retains the right to provide the European Commission for publication purposes with an electronic copy of the published version or the final manuscript accepted for publication."



Access Rights

- Access rights means **licences** and **user rights** to foreground or background owned by another participant in the project.
- It should be noted that under the GA access to another participant's foreground or background is **only to be granted** if the requesting participant **needs** that access in order to carry out the project or to use its own foreground.
- Participants can freely define in any manner what is needed for the project (i.e. background available for access by each other).
- Possible approaches
 - Exclusion of background
 - «Positive list» approach
- The access rights foreseen in the GA are **not automatically granted**. They must be requested **in writing**, which is important from an **IPR management** point of view.
- In principle, the granting of access rights does not include the right to sublicense (not even to parent/affiliate companies of consortium members), unless the owner of the foreground or background at stake consented hereto.



Access Right – Possible Objections

- **Information to – and objections by – the Commission:** The Commission has the **right to object** to the granting of exclusive licences to third parties established in a country not associated to the 7th Framework Programme if this could be detrimental to European competitiveness or inconsistent with ethical principles or security considerations. When a special clause to this effect is introduced, the Commission has to be notified of such an intended grant of an exclusive licence.
- **Information to – and objections by – other participants:** The other participants have no right to object to an intention of granting access rights to third parties, and do not have to be notified. However, there is a general requirement for the participants to mention any limitation to the granting of access rights (as may be the consequence of a pre-existing agreement – such as an exclusive licence – which precludes the granting of access rights). The default joint ownership regime also contains a notification requirement in respect of licences granted to third parties.



Notification Requirement

– A Summary

	Notifications to the Commission	Objections by	Notifications to other participants	Objections by
Dissemination of foreground (incl. publications)	No (except where foreground is capable of industrial or commercial application and is not protected – Article 44.2 RfP / Article II.28.3 of GA)		Yes (Article 46.4 RfP / Article II.30.3 of GA)	
Transfer of ownership of foreground	No (except for transfers or exclusive licences if a special clause is inserted in GA but this may exclude transfers or licences intended by beneficiaries not receiving EU funding – Article 42.5 RfP – but remember Article 18.6 RfP ⁵³ -)	No in most cases Yes, for transfers to third parties in “non-associated” third countries (Article 43 RfP / Article II.27.4 of GA) but this may exclude transfers or licences intended by beneficiaries not receiving EU funding if a special clause to this effect is inserted	Yes – prior notice (except in case of : – “authorised” transfers to a specifically identified third party under Article 42.3 RfP / Article II.27.2 of GA, or – overriding confidentiality obligations such as in M&A (Article 42.3 RfP / Article II.27.2 of GA))	Yes, if the access rights of other participants are affected (Article 42.4 RfP)
Granting of licences to third parties		No in most cases Yes, for granting exclusive licences to third parties in “non-associated” third countries (Article 43 RfP / Article II.32.8 of GA) but this may exclude transfers or licences intended by beneficiaries not receiving EU funding if a special clause to this effect is inserted	No (except where access rights are affected (Article 48.5 RfP / Article II.32.3 of GA) or under the default joint ownership regime (Article 40.2 RfP / Article II.26.2 of GA))	No



Summary of Access Rights

	Access rights to background	Access rights to foreground	Timing (to request access rights)
For implementing the project	<p>Yes, if a participant needs them for carrying out its own work under the project (Article 49.1-2 RfP ; Article II.33.1-2 of GA)</p> <p>Royalty-free, unless otherwise agreed before acceding to the grant agreement (Article 49.2 RfP ; Article II.33.2 of GA)</p>	Royalty-free (Art. 49.1 RfP ; Art. II.33.1 GA)	Until the end of the project (Article 48.6 RfP ; Article II.32.4 of GA)
For use purposes (exploitation + further research)	Yes, if a participant needs them for using its own foreground (Article 50.1-2 RfP ; Article II.34.1-2 of GA)		Until 1 year (unless otherwise agreed) after the end of the project or the termination of the participant concerned (Article 50.4 RfP ; Article II.34.4 of GA)
	Either royalty-free, or on fair and reasonable conditions to be agreed (Article 50.1-2 RfP ; Article II.34.1-2 of GA)		
Notes	Provided that the participant concerned is free to grant such access rights (Article 49-50.2 RfP ; Article II.33-34.2 of GA)		
	The background <i>needed</i> may be defined by the participants (Article 47 RfP ; Article II.31 of GA)		



Eligibility of IPR Costs

- IPR protection, dissemination and management activities can be an instance of "**other activities**" in an FP7 project (Financial Guidelines).
- Accordingly, the European Union financial contribution may reach a maximum of 100% of the total costs of these activities subject to the eligibility criteria being fulfilled. In particular, they must have been used *"for the sole purpose of achieving the objectives of the indirect action and its expected results, in a manner consistent with the principles of economy, efficiency and effectiveness"*



Consortium Agreement

- **Participants should prepare and sign a consortium agreement before the Grant Agreement enters into force.**
- **Grant Agreement – Basic Legal Requirements only**
- **Consortium Agreement – Internal Management Guidelines**
- **Several Consortium Agreement concerning different aspects is OK**
- **Amending the initial agreement is also allowed**
- **«*Checklist for a Consortium Agreement*» is proposed by the comission**
- **Since the consortium agreement involves only the project participants, the Commission is not a party to it and does not check its contents. It has neither reviewed nor endorsed any model consortium agreement.**



Patent Search

- Participants may wish to perform a patent search in order to ascertain the "**current state of the art**" before submitting a proposal as the state of the art is a key criterion during the evaluation process.
- Participants in any EU-funded research project aimed at producing actual research results (new products, etc.) may consider performing a patent database search to assess the state of the art.
- **Taking third parties' rights into account:** When a participant is considering exploiting its foreground, an infringement clearance search should be considered as a means of reducing the risks of being sued by a third party.



Project Names, Acronyms and Logos

Two main problems often arise in connection with the name or acronym of the project.

- Firstly, participants should refrain from choosing and using a project name/acronym/logo which is identical or close to a **trademark** registered by a third party for goods and/or services in the same area. This may not be extremely important for most projects (of limited scope or duration), but it may also happen that the name/acronym of a given project becomes extremely famous. This could represent a problem if the participants have to change to a different name/acronym/logo for trademark reasons.
- Problems may also appear if a participant, or one of its employees or subcontractors (this has already happened), protects the project name/logo/acronym/domain name on his/her own behalf, and does not allow the other participants to use it in their commercial activities during or (especially) after the end of the project. Such behaviour is clearly based on bad faith, but can create enormous legal problems.



IPR Helpdesk

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

- **Additional information relating to consortium agreements is also available from the IPR Helpdesk, a project funded by the Commission to provide free of charge IPR assistance.**
- **For example, the IPR-Helpdesk has established a short comparison of the solutions proposed to the main IPR issues in various consortium agreement models which were developed by different organisations.**
- **Moreover, it provides first line assistance to any IPR related issue through its Helpline: ipr-helpdesk@ua.es**



TEŞEKKÜRLER!

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