



IRUVX-PP - WP6
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‘Collaborations in View of IPRs’
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- **INTELLECTUAL PROPERTY RIGHTS HANDBOOK**
- **Improve the economic impact of the consortium and individual facilities through technology transfer**
- **‘IPR Handbook’:**
 - **Management of IPRs in Knowledge and Technology Transfer Activities and**
 - **Guide for EuroFEL Policy**
- **Adopt a common IP and KTT policy within the EuroFEL infrastructure**

- **‘The IPR Handbook’** : - provides a set of four main principles
- 1. **Collaboration agreement between the EuroFEL members**, the purpose of which is to specify among other issues, the **relationship between the Parties** concerning the management of IP in KTT activities
- 2. **The principles for an internal IP policy** constitute the basic set of principles which public research organisations such as EuroFEL should implement in order to effectively manage the intellectual property resulting from their – own or collaborative – activities in the field of research and development .
- 3. **The principles for a knowledge/technology transfer (KTT) policy** complement those relating to IP policy by focusing more specifically on the **active transfer and exploitation** of such intellectual property.
- 4. **The principles for collaborative and contract research** are meant to concern all kinds of research activities conducted or funded jointly by a public research organisation and the private sector (**provides examples of Non-disclosure Agreement, Joint Invention Agreement, Licensing Agreement and Model Contract / Consortium Agreement**).

■ Intellectual Property Rights (IPRs)

- Cover **patents**, registered **designs**, trademarks, service marks, domain names, **copyright**, design right, **trade secrets**, **know-how** and all similar property rights in inventions, computer programmes, designs, semiconductor topographies and **confidential information**

■ Knowledge and Technology Transfer

- Refers to an active process by which knowledge, including technology, know-how, expertise and skills, is transferred from one party to another leading to innovative, profitable or economic and social improvement

1. Due Diligence – Background IPRs

A review of Intellectual Property rights is normally undertaken as part of the overall due diligence process.

This includes:

- identifying the relevant (Background) Intellectual Property,
- assessing the ownership position, status or validity of rights and
- **highlighting any gaps in protection..**

Another important consideration will be:

- the effect of a change of ownership on existing agreements with third parties including licences, collaborative arrangements and joint ventures.

2. Do you need to talk to the 3rd party?

- Unprotected IPRs e.g. Know-how...?
- A specific '**Non-Disclosure Agreement**' may be signed...
- This agreement defines the access to know how and **secrecy obligations between the Parties.**
- An example of a non disclosure agreement is in the **Annex IV of the Handbook**

3. Access to Background

- The Parties shall identify the Background to which they are ready to grant Access Rights...
- In addition, if a Party wishes to exclude specific Background, it shall list such Background in ...
- Background IPRs shall be used only for the purposes for which Access Rights to it have been granted...

4. Management of IP

Purpose of which is to specify among other issues, the relationship between the Parties concerning

- confidentiality
- access to the background IP
- joint ownership,
- transfer of foreground IP,
- access rights to the background and foreground IP
(for other parties) for research and/or for exploitation purposes,
- dissemination, publication and
- dispute resolution.

5. USE AND EXPLOITATION OF INTELLECTUAL PROPERTY (ANNEX VII - Model Collaborative Agreement)

- The IP will remain the property of the Party that contributes them to the Project
- Each Party grants the other a royalty-free, non-exclusive licence to use its Background for the purpose of carrying out the Project
- *Foreground* shall be the property of the *beneficiary* carrying out the work generating that *Foreground*
- The Party grants to the Sponsor a non-exclusive royalty free licence (with the right to sub-license to any Group companies...)
- 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*.

■ Joint Invention Agreement

6. Joint Invention Agreement – Foreground IPRs

■ Collaborative R&D (Annex III – Handbook on IPRs)

■ This agreement establishes the legal framework, which defines the Parties respective rights in and liabilities under the Patents and rules to operate said co-ownership of the Patents in terms of:

- co-ownership administration,
- charges and revenues,
- sale and assignment,
- use and exploitation etc.

Can IPR make you money?

- **A patent can make you money,**
 - but only if your invention will be a **commercial success** for you or someone else so
 - take the time to investigate the financial implications and commercial possibilities before you begin your application for a patent – **can take up to 4 years.**
 - **consider a range of IP rights** (..registered designs, copyright..) **only 1 out of 10 patents get exploited**
- **Common ways of benefiting from patent rights:**
 - deciding to manufacture the patented invention yourself
 - subcontracting the work to a manufacturer and taking the revenue from selling the product
 - selling the patent outright for a one-off payment
 - licensing the patent rights in exchange for royalty payments

Happy Collaboration

Thank you