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TRAININGS

Europa Media Trainings

IP, assets and protection

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Exploitation and IPR in EU R&I projects
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Online Course

CONTENT

1. IP and IPR
2. IPR Management
    1. Proposal
    2. Proposal Implementation
3. Legal Agreements

Our case study: FeliCity

- WHAT? Integrated decision-support tool
- WHY? Strategic energy planning, new retrofitting concepts for cities and urban developers
- HOW? The tool uses a comprehensive European 3D building database which serves as an extendible basis for real-time thermal simulation and data visualisation. Life Cycle-wide evaluation of energy retrofitting measures and innovative analysis functions for future-oriented technologies on neighbourhood level are included.

1. Different types of IP and IPR

Results, Assets = IP (Intellectual Property)

- Invention
- Software
- Report
- Design
- Database
- Book
- Work of art
- Video
- Roadmap
- …

Our case study: IP

- Software: code on analysis functions for future-oriented technologies on neighbourhood level (RES, Energy networks, smart grids, storage systems); assessment functions for the building stock regarding energetic figures and building renovation cost
- Database (European 3D building database)
- Data-processing method
- User manual
- Images

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Types of IPR

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Legal Right	What for	How
Patents	New inventions	Application and examination
Utility Models	New inventions	Application and registration
Copyright	Original creative or artistic forms	Exists automatically
Trademarks	Distinctive identification of products or services	Use and/or registration
Registered Designs	External appearance Valuable information	Registration
Trade Secrets	Valuable information not known to the public	Reasonable efforts to keep secret

One product – many IP rights

Source: EPO Training

Our case study: IPR

- Copyright for software, user manual, database and images
- Patent for Data processing method

NB:
A database, on the other hand, can have a thin layer of copyright protection. Deciding what data needs to be included in a database, how to organize the data, and how to relate different data elements are all creative decisions that may receive copyright protection.
Because of the different copyright status of databases and data content, different mechanisms are required to manage each. Copyright can govern the use of databases and some data content (that which is itself original), but contract law, trademarks, and other mechanisms are required to regulate factual data.
Source: IPR in data management

Access and ownership

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1 Background

- = information/intellectual property rights necessary for the project;
- It remains the property of the participant that brings it into the project.
- Beneficiaries must give each other access — on a royalty-free basis — to background needed to implement their own tasks under the action.
- Beneficiaries must give each other access — under fair and reasonable conditions — to background needed for exploiting their own results.

2 Sideground

- knowledge/IP that is relevant to a collaborative venture or open innovation project, but produced **outside the project** by any of the partners **during the project**'s tenure.
- Sideground IP belongs to the party creating the right, and it is not subject to whatever mutual undertakings the parties may have entered into with respect to the Foreground IP

3 Results

- Results are owned by the beneficiary that generates them, but participants may agree on a different ownership regime
- Two or more beneficiaries own results jointly if: (a) they have jointly generated them and (b) it is not possible to: (i) establish the respective contribution of each beneficiary, or (ii) separate them for the purpose of applying for, obtaining or maintaining their protection (see Article 27).

Our case study: IPR

- Background: Data available at partners
- Sideground: European 3D building database (made available for implementation)
- Results: software code, images from test sites, method for data processing; user manual

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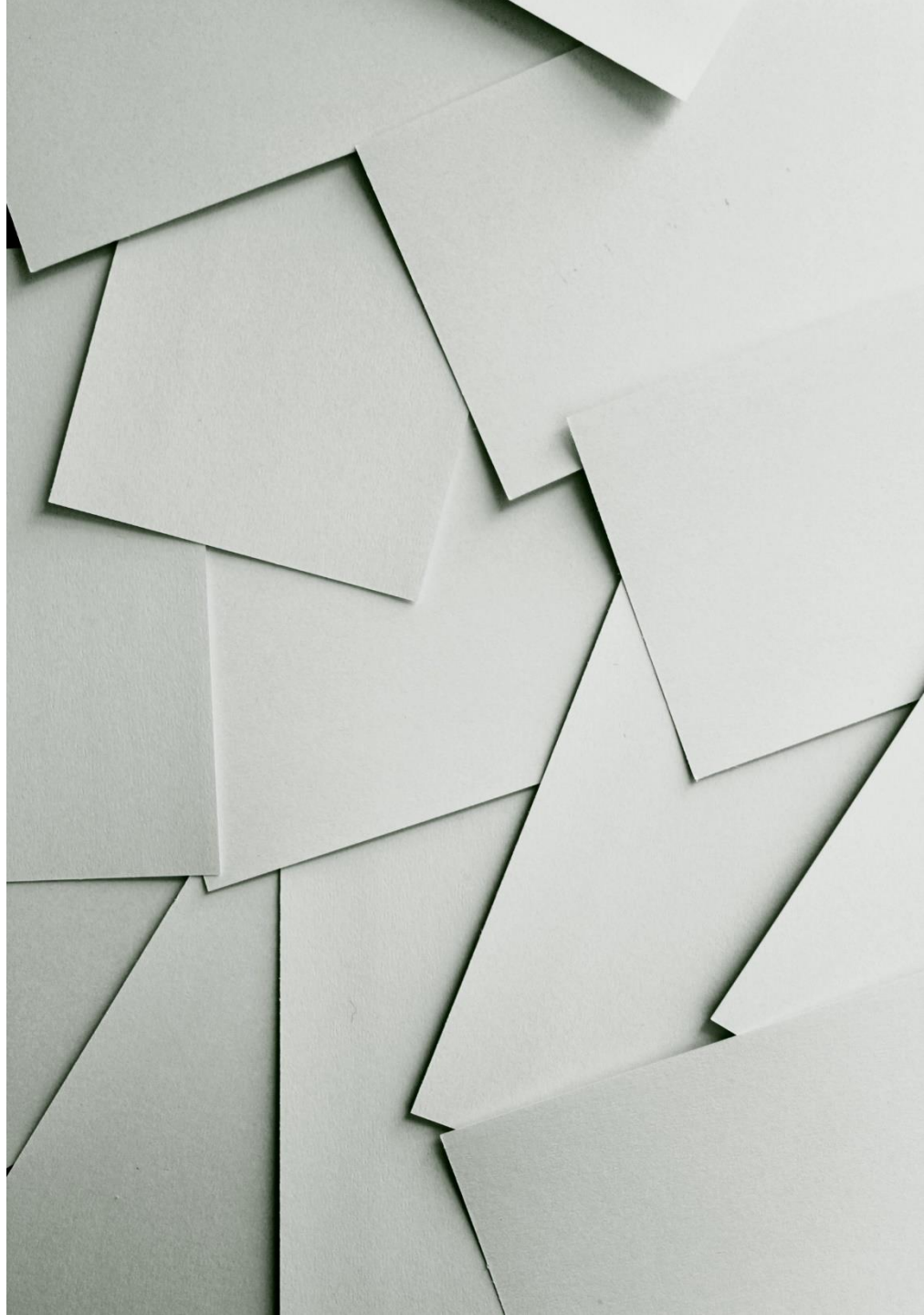
2.1 IPR Management: Proposal Writing

IPR and innovation management

- Which knowledge are we exchanging?
- Under which conditions?
- Who will be the owner of the results?
- What happens in cases of joint ownership?
- Who will exploit the results, and how?
- How are we protecting confidential information?
- How will you manage IPR and innovation?



Our case study:
IPR issues - proposal writing

- Basic exploitation routes planned in the proposal

Exploitable result	Partners involved	Exploitation route	IPR (protection)	End-users	Timeframe
Test site data	8 local partners (energy agancies)	Data licencing (selling the data)	Ownership on data created (copyright)	ES SME Energy consultants Research organisations	At the end of the project
Data processing method	DE UNIV	Open access - publishing	Copyright	Research community	Within project implementation
Decision-support tool	ES SME	Commercial services offered to cities and urban developers	Copyrighted code	City governments City planners	6 months after the end of the project

The partners' plans

Partner	Background	Foreground	Results of interest	Exploitation route
(all or most)	What is the partner bringing to the project?	Which results is the partner contributing to develop?	Which results is the partner interested in?	What is the partner planning to do with the results?

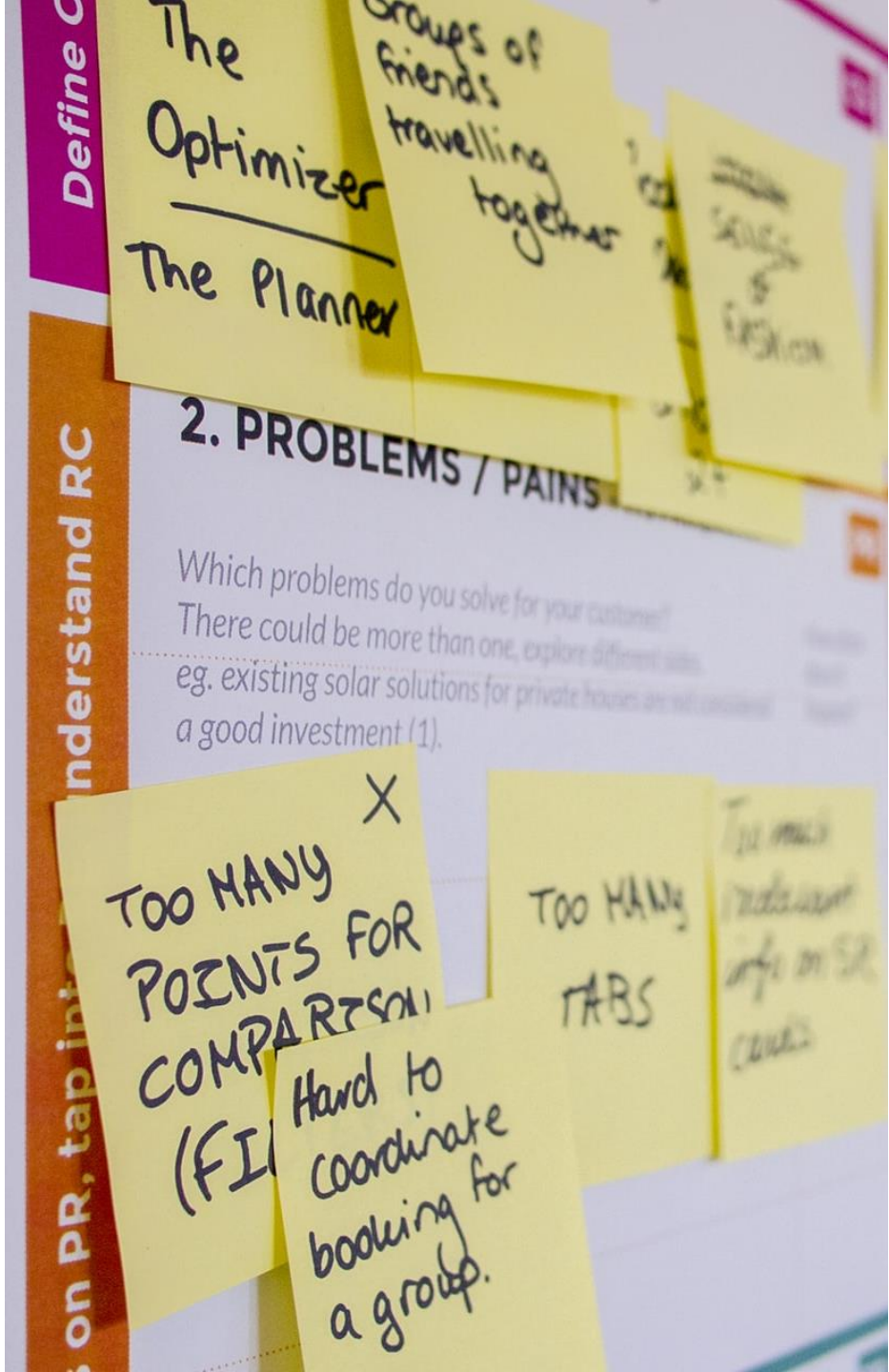
Our case study:
IPR issues – proposal writing

Partner	Background	Foreground	Results of interest	Exploitation route
P3, P4 energy agencies	Data from previous studies	Data from test sites	Decision-support tool Data from test sites	Free internal use in their city Licencing data
Other energy agencies	Data from previous studies	Data from test sites	Decision-support tool Data from test sites	Free internal use in their city Open access
P2 DE UNIV	Decision-support scenario analysis knowledge	Data processing methods	Decision-support tool	Open source code, free use
P5 ES SME	Decision-support programming	Decision-support tool	Decision-support tool	Protection and commercial exploitation

2.2 IPR Management: Project Implementation

Innovation Management

- Understanding the market needs and opportunities.
- Being responsible for the overall strategic approach.
- Continually monitoring the market, IP and technology landscapes.
- Steering the development plan to meet the project objectives and market needs.
- Ensuring that the project's foundations and management processes and structures for innovation are sound and working effectively.



Source: IPR Helpdesk

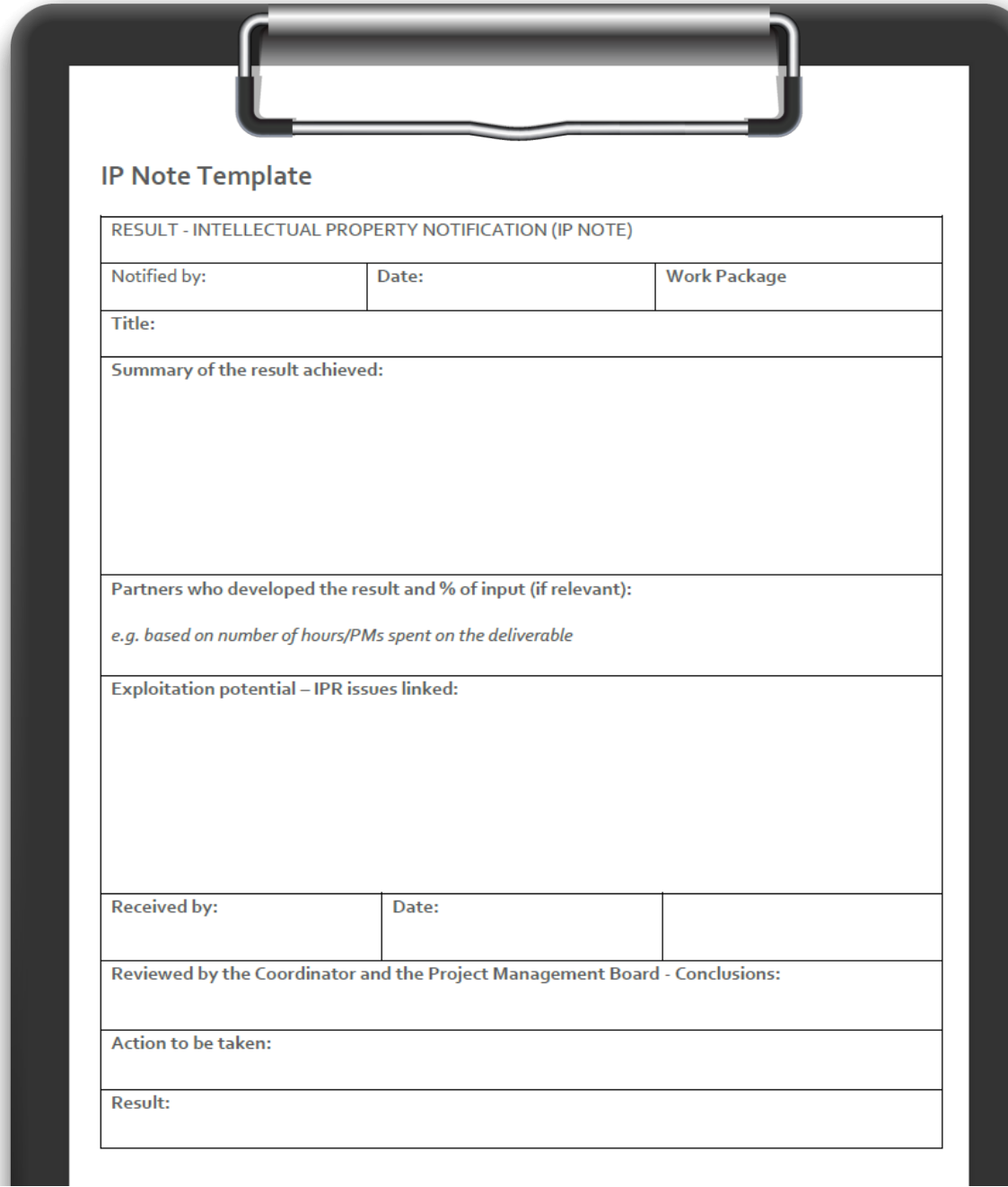
IP Management

- Market assessment
- Identifying results – monitoring asset development (IP note)
- Ownership regimes
- Protection
- Dissemination and exploitation

Source: IPR Helpdesk

IP note

- **The IP note:** in the form of Innovation notification table aims at listing all research materials and project outcomes
- Whenever a new result (foreseen/ not foreseen) is developed in the project, **the author of the result will have to fill in the IP Note and send it to the Coordinator**
- It will support the Partners / Steering Committee jointly decide on the **need for protection of each output** based on partners' recommendations and project's IPR protection strategy



IP Note Template

RESULT - INTELLECTUAL PROPERTY NOTIFICATION (IP NOTE)		
Notified by:	Date:	Work Package
Title:		
Summary of the result achieved:		
Partners who developed the result and % of input (if relevant): *e.g. based on number of hours/PMs spent on the deliverable*		
Exploitation potential – IPR issues linked:		
Received by:	Date:	
Reviewed by the Coordinator and the Project Management Board - Conclusions:		
Action to be taken:		
Result:		

Our case study: IPR management

- **Market assessment**
  - Turns out there is no such flexible analysis opportunity on the market. The clients want to use their own data for the assessment so data integration and easy visualisation becomes a key function – clients will be the city governments.
- **Identifying results – monitoring asset development (IP note)**
  - The sideground database became open and free for any user – thus also the ES SME can use it.
- **Ownership regimes**
  - The software code belongs fully to ES SME
  - The data processing method is fully owned by the DE UNIV
  - Data from energy agencies are owned by them – but not needed for the final product.

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Our case study: IPR management

- **Protection**
  - Copyright protection is automatic – patent registration is not needed for the data processing method
- **Dissemination and exploitation**
  - ES SME and DE UNIV professor agreed to establish a joint venture and work on an updated data processing method - exploitation timeline got extended to 1 year till market launch after the end of the project

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3 Legal Agreements

Our case study: Initial questions

- Is there any **connection between the EU project partners and the new venture**?
- Does the professor have **the right to set up a joint venture with the ES SME**? Should he have a **licening agreement** with his University?
- What if the new joint venture would need to **pay for the database**?

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Consortium Agreement

- It is mandatory to have a Consortium Agreement before (!!!) signing the Grant Agreement
- All parties have to agree and sign!
- Anything can be agreed in the Consortium Agreement that is not in conflict with the Grant Agreement
- Use model CA whenever possible, and keep it simple but efficient!

Licensing Agreement

- **Who:** between a Beneficiary and a licensor
- **When:** when needed
- **Why:** to legitimately use, sell, offer to sell, and import the invention protected by intellectual property rights
- **Particulars:**
    - Acquiring the rights related to a third party's technology through a licence agreement is indicated as technology ***licensing-in***.
    - Granting the right to use an IP protected technology is
    - called technology ***licensing-out***.
    - *Definitions*
    - *License grant provisions*
    - *Considerations*
    - *Warranties*
    - *Indemnity*
    - *Termination*

Option and Evaluation agreements

Option Agreement	Evaluation Agreement
It's a contract between the parties allowing the potential licensee with an option to evaluate a technology and to negotiate a licence during a defined period. The licensee is provided with an option to obtain an exclusive licence and the licensor abstains from negotiations with other prospective licensees till the end of the contract. An option agreement usually entails the payment of a lump sum to account for the exclusive option	This type of agreement allows the potential licensee to evaluate the IPR in order to decide whether or not to enter in a license agreement. After the evaluation, the evaluator will either enter into an agreement to exploit the IP or promise not to use or disclose it. It is advisable to limit the scope of the agreement and negotiate terms on a short duration (usually 30 days), payment, confidentiality and obligation for nor reverse engineering. During this period the technology cannot be used for commercial purposes.

Joint Ownership Agreement

- **Who:** between co-owners of IP
- **When:** ideally during CA preparation or as soon as joint IP is detected
- **Why:** to define in detail the rules governing joint ownership
- **Particulars:**
  - Shares: assignment of shares within the joint ownership
  - IP management: responsibilities for filing and maintaining (including the costs incurred) of the IP rights
  - Protection of rights: obligation imposed on all participants to monitor and report any infringements of the foreground; indication of the partner empowered to conduct legal actions for protection of the foreground
  - Conditions of the use of the foreground: Use in further research; Individual exploitation; Licensing; Transfer
  - Additional clauses: standard contractual matters, i.e. applicable law, jurisdiction or alternative dispute resolution systems

Collaboration agreement

Collaboration agreements are quite common in the research in the field of science and technology. CAs do not foresee exchange of funds for the carrying out of the activities, but concern **research activities of common interest** where the leading principle is that each partners bears its own costs. Parties usually give access rights to each other to use the IPR developed and owned by them – but only in the framework of the implementation of the project. The access rights are the rights granted by the parties to each other.

Joint owners of the results agree on who shall be responsible for the timely prosecution and maintenance of all such resulting IPR. In the absence of any agreement to the contrary between joint owners the costs are equally shared.

Our case study:
Remember the questions?

- Is there any *connection* between the EU project partners and the new venture?
- Does the professor has the right to set up a **joint venture with the ES SME**? Should he have a licening agreement with his University?
- What if the new joint venture would need to **pay for the database**?

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Next steps: commercialisation

- How to launch on the market?
  - Open source code and service linked?
  - All closed – service-based business plan?
  - Licencing? Open or closed?
- What is needed to launch a commercial spin-off?
- What other assets or actions or investments are needed?

After the break…

thank you

for your attention

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