

European IPR Helpdesk

Get your ticket to innovation!

**WŁASNOŚĆ INTELEKTUALNA W
PROJEKTACH ZE SZCZEGÓLNYM
UWZGLĘDNIENIEM PROGRAMU
HORYZONT 2020**

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Warszawa, 26 listopada 2018





Roadmap - Introduction to IP in Horizon 2020

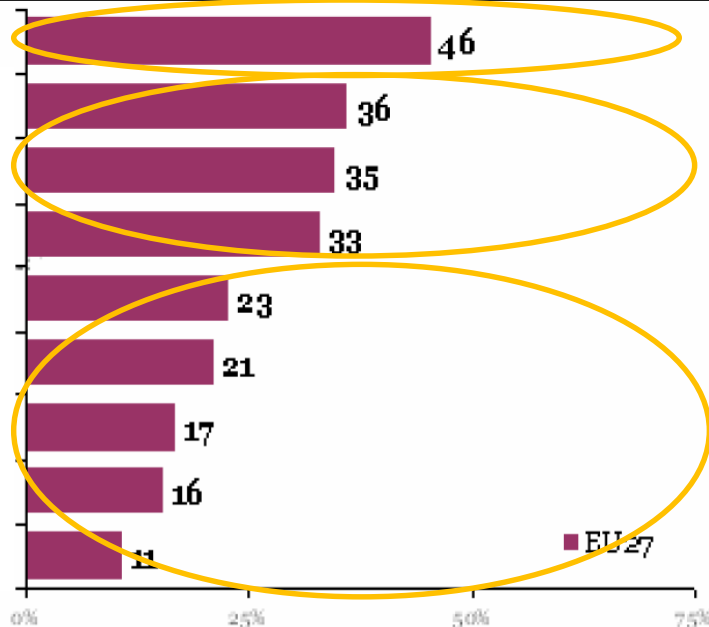
- **Introduction: Protect what you own**
- **Rules and Agreements**
 - *Intellectual Property rules*
 - *Grant Agreement*
 - *Consortium Agreement*
 - *Agreement on Background*
 - *Specific Vocabulary*
- **IP management - project life cycle**
 - *Before the start*
 - *Exploitation and Dissemination Plan*
 - *Implementation*
 - *Ownership*
 - *Intellectual Property assets and rights*
 - *Dissemination vs. Exploitation*
 - *Open Access*
- **Particularities of MSCA**



Problems of a today's SME (years 2011-2013)

How does IP rate amongst an SME's problems?

Constraints/difficulties encountered in the last two years (%)





Problems of a today's SME

Outcome: European SMEs seem to have no IP relevant problems

- “We do not own any IP assets”
- “IP is something owned by other large enterprises”
- “So, what has IP got to do with me?”



Identifying IP

- How much harm would you suffer if a competitor hijacked your website?
- Would your reputation be damaged if your name (even if not registered) would be used by someone else to offer goods / provide services of a drastically poor quality?
- You have trained a skilled employee. You entrusted him with the production secrets of your company. Now he is leaving you and going to work for your competitor.

How much money would you be able to pay to prevent the loss?

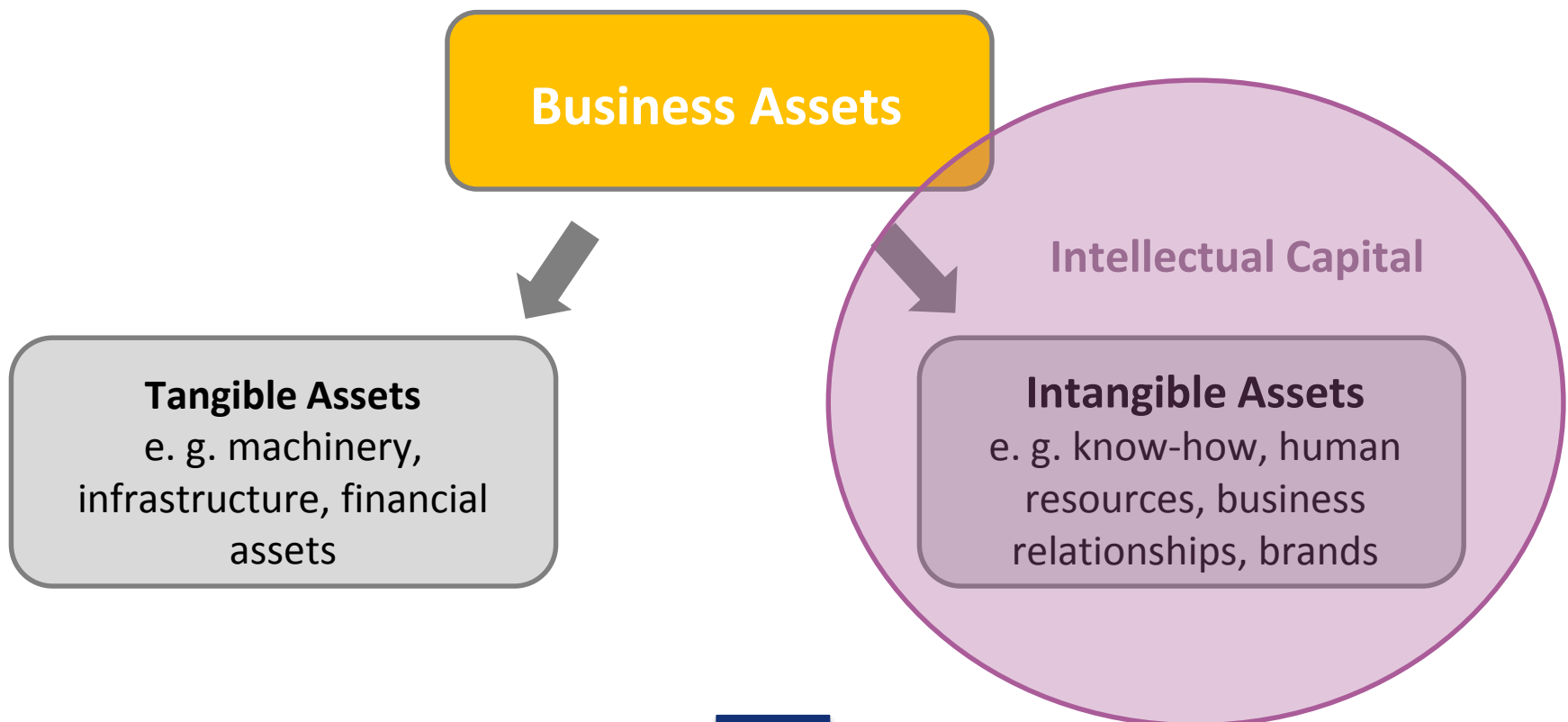
We just identified and valued some IP



What do I actually own?

Knowledge Society

Changing business environment in the knowledge society



Why is IP important to business and research?

- The last decades - a fundamental growth in the importance of the value of intellectual property assets in the business activity.
- **The Europe's most valuable brands (examples):**
 - BMW – EUR 20 billion
 - Louis Vuitton – EUR 20 billion
 - Mercedes-Benz – EUR 17 billion
- Reputation, customers'/users' loyalty, quality of products or services (TM)
- Securing expenses for research and technical development (Patent)
- Securing designer's ideas (Industrial Design)
- Securing programmer's creativity (Copyright)
- Securing secret recipe, process of manufacture or an algorithm (Trade Secret)

Intellectual Property is a financial asset that has a value and that can be bought, sold, licensed, given or exchanged.

Intellectual Property Rights (Overview)

Ways to protect intangible assets

Industrial Property

Trade Marks
Patents
Industrial Designs



Literary & Artistic Works

Copyrights
Related rights



«Soft IP»

Production secrets
Know-How
Research results
Ideas
Algorithms



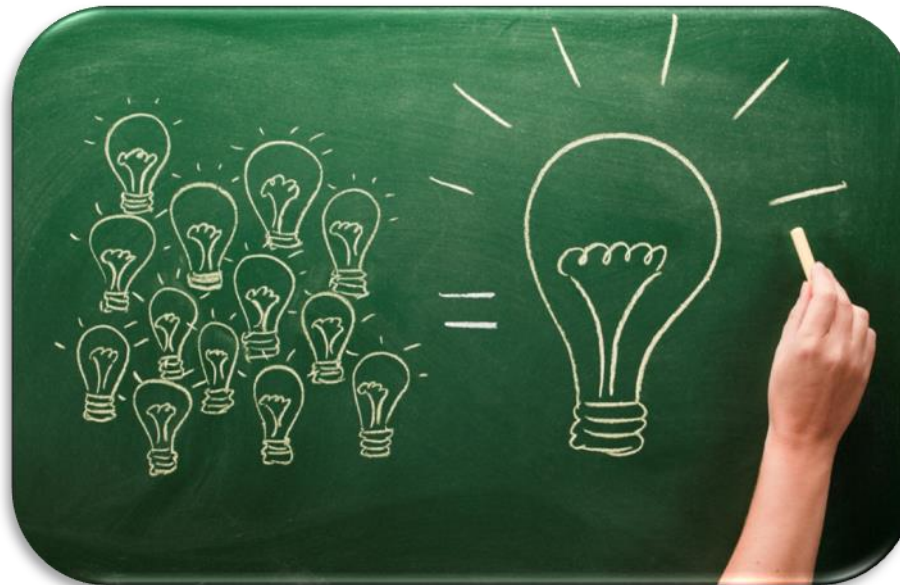


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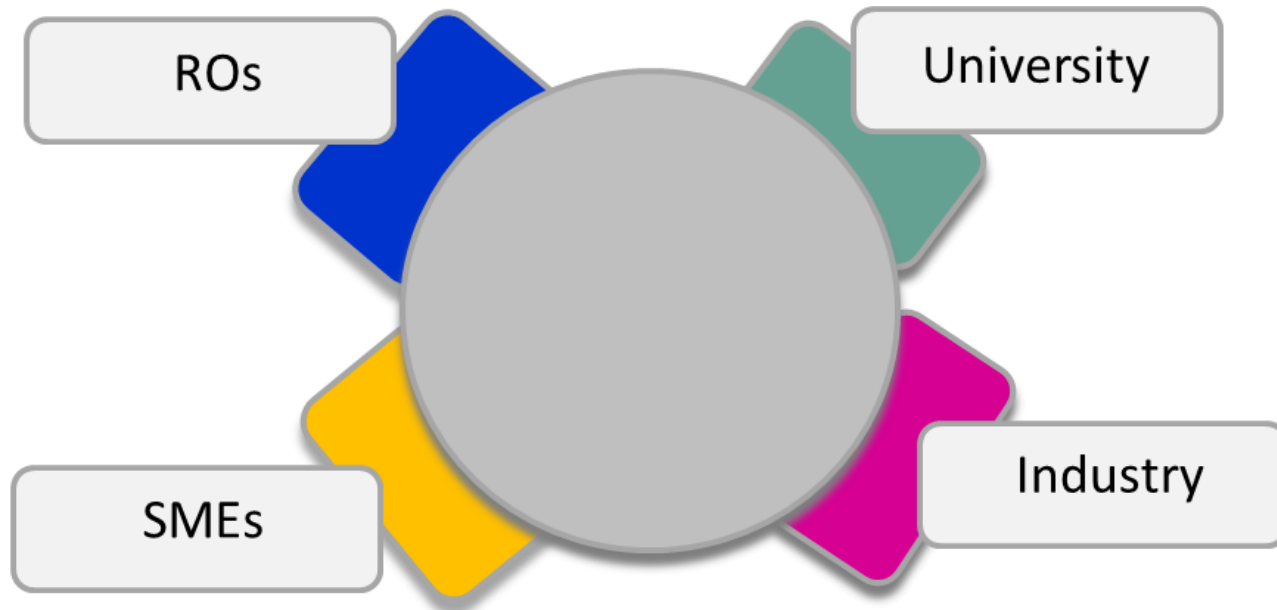
Rules and Agreements

Cooperation → Innovation

- Cooperation fosters innovation;
- Collaborative projects bring together individual know-how and turn it into one “big” idea



Collaborative Projects



Intellectual Property rules in H2020

The IP rules in Horizon 2020 can be found in:

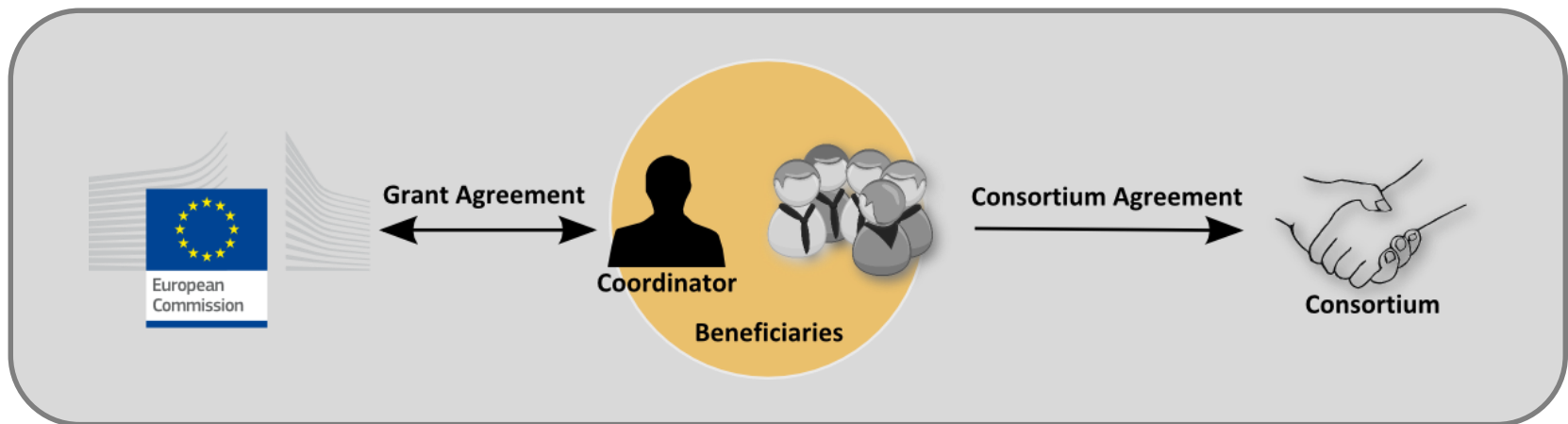
- (i) the H2020 Rules for Participation
- (ii) respective work programmes
- (iii) Grant Agreement (IF, ITN, RISE, COFUND)
- (iv) remaining EU legislation

Additional guidance:

- (i) Annotated Model grant agreement (AGA)
- (ii) H2020 Online Manual: IP section is a work in progress (not binding)

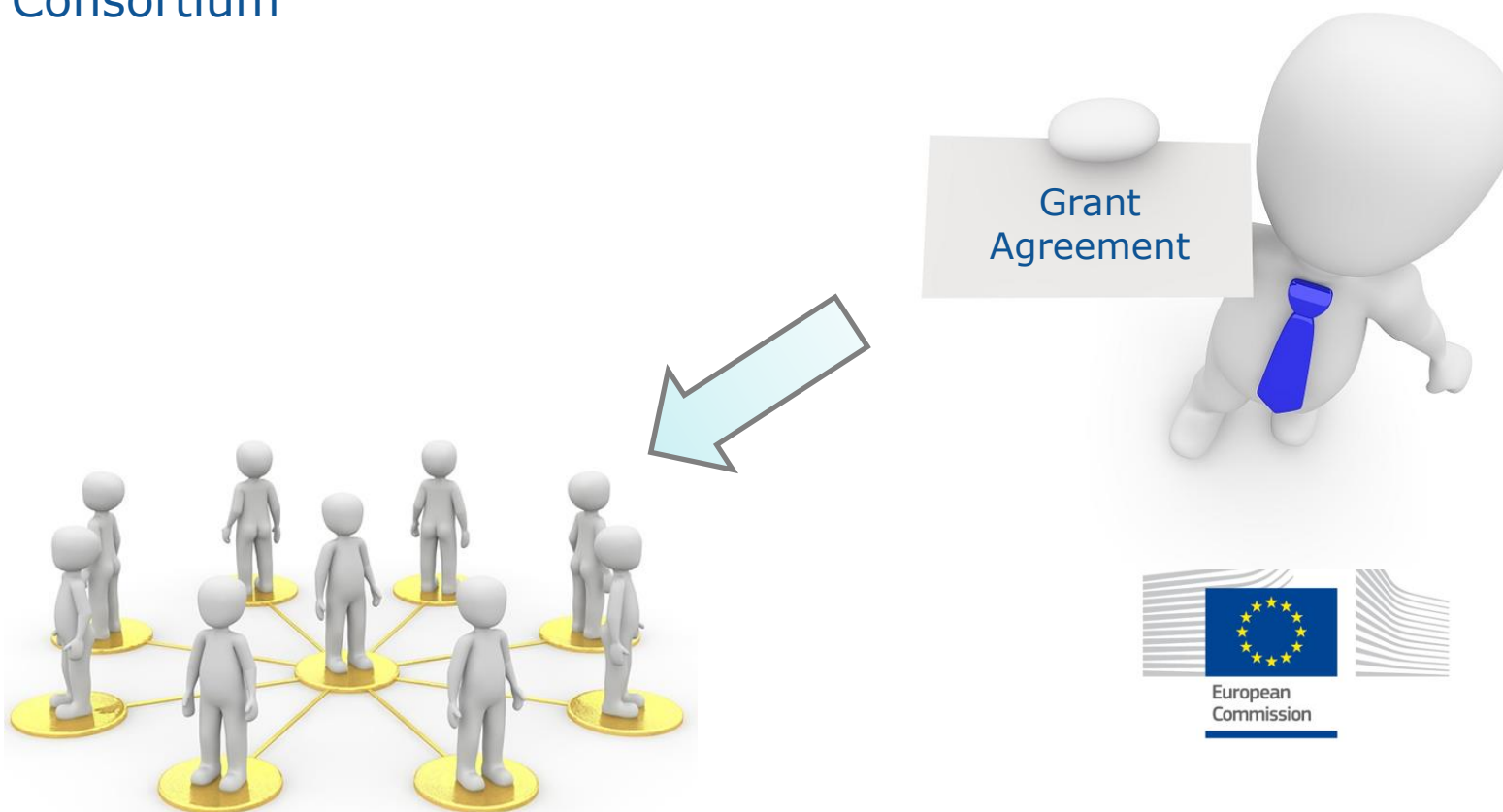


Overview: Agreements



Grant Agreement (GA)

Relation between European Commission and Consortium



Consortium partners

Consortium Agreement (CA)



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- Article 24 (2) (RfP) / Article 41 (3) MGA
- Internal arrangements regarding operation and coordination of the consortium to ensure that the action is implemented properly;
- In written;
- No time frame .. But
- “non-official” CA templates:
 - general models: DESCA 2020, EUCAR 2020, MCARD)
 - LERU template for MSCA ITN ETN
 - BAK Consortium Agreement model for Marie Skłodowska-Curie-Projects



Agreement on Background

- Article 45 RfP / Article 24 MGA
- Usually concluded as a part of Consortium Agreement (hence, no Agreement on Background in mono-beneficiary Projects)
- In writing;





- **Collaboration Agreement**
 - Relationship with complementary beneficiaries – 41.4 MGA
- **Coordination Agreement**
 - Relationship with partners of a joint action – 41.5 MGA
- **Partnership Agreement** – MSC Actions (e.g. RISE, IF and ITN)
 - Relationship with partner organisations involved in the project
- **Researcher Agreement** - MSC Actions
 - Relationship between the appointing beneficiary and the researcher



STOP

Specific Vocabulary

Vocabulary

Key terms in the context of Horizon 2020 projects are:

- Background
- Results
- Exploitation
- Dissemination
- Access rights

Background



Tangible or intangible input (prototypes, data, know-how, information) which is

- held by the project partners prior to their accession to the GA and
- is needed to implement the action or exploit the results

Includes IP such as copyright, patents/ patent applications (filed prior to access to GA).

Rule: taking part in Horizon 2020 **does not have any influence upon the ownership of background** = your background remains yours!

Results

All outputs which are generated under the project – whether or not protectable. Such results may include data, knowledge, information, copyrights, design or patent rights, to name a few.



Access rights

rights to use results or background of other project partners in accordance with Horizon 2020 rules.



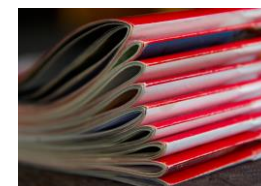
Exploitation

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.





Access Rights (I)

- Each project partner has the right to **request access rights** to the other project partners' background and results as long as it **needs them** in order to carry out its work under the project or to exploit its own results (these are **minimum access rights**).
- Shall be requested in writing. Can be granted in any form.
- 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 minimum Access Rights (*note: additional Access Rights can always be agreed upon!*)

	Access to background	Access to results
Project implementation	Royalty-free	Royalty-free
Exploitation of results	On fair and reasonable conditions	On fair and reasonable conditions



STOP

IP in Project Life Cycle



Why is it important to consider IP in H2020?

- **IP and exploitation** issues - **subject to evaluation** regarding impact and feasibility of the proposal.
- A **convincing outline of IP management, exploitation and dissemination strategies** on individual and consortium level within the proposal is a must.
- **Obligation to exploit/disseminate results.** Exploitation vs. Dissemination
- **Results** – when wisely managed – **allow recoup of research and development costs** / provide revenue stream / encourage further innovation.
- Many **results** require **further investments** before taking them to market - **protection through intellectual property protection mechanisms advisable.**
- Proper management of IP in the projects, helps participants **avoid future conflicts** in the consortium.
- Management of **ownership issues** and related problems

IP in Horizon 2020 Project Life Cycle



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Before Project Start

- Defining project goals
- Defining project-related know-how (background)
- Proposal preparation, incl. PEDR (plan for exploitation and dissemination of research results)
- Negotiating a CA/NDA

During Implementation

- Strategy for securing and managing research results
- Granting of access rights

After Project End

- Disseminating and securing generated IP
- Exploitation of the results
- Valorisation of intangible values
→ Commercialisation

IPR issues are relevant at all stages of the project

Before Project Start

Every project starts with an idea ...

- Define the **state of the art**
- Search in **patent databases & documents**
- Protect all **information linked to the idea: make use of Confidentiality Agreements**
- No project without partners – no partners without negotiations
- **Beware of Third Parties' IPR infringement** (check acronyms against registered Trade Marks)

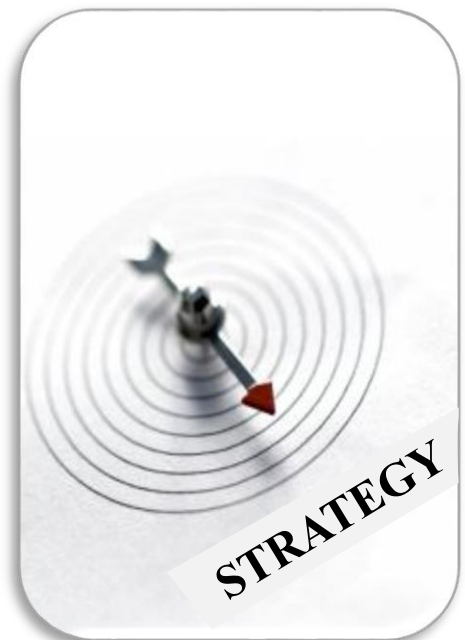
Contact your legal/patent department as early as possible!



Before Project Start

Exploitation and dissemination planning

- Draw a convincing outline of exploitation strategies at individual/consortium level
- IP exploitation issues are subject to evaluation regarding impact and implementation. Identifying relevant **bodies/competences** within the consortium should demonstrate the potential of addressing IP management properly
- Include relevant **activities/deliverables**: PEDR, Innovation-related workshops, Market Analysis, Business Plans, Risk-Analysis, Freedom-to-Operate analysis, Specific contracts/agreements



Plan for the Exploitation and Dissemination of Results

Beneficiaries have an obligation to define the expected results and their strategy for exploitation and dissemination.

Hence the following information must be included:

- A list of expected results that might be exploited (i.e. with commercial or industrial applicability) including their:
 - description
 - sector of application, and
 - protection measures
- A list of all the means through which they intend to bring the results to the public knowledge
- A potential/expected impact – quantifiable – in terms of marketability and research advancement

Confidentiality agreement

- Identify **relevant information**
- **Define use of information** as well as **restrictions**
- Already very **important at the proposal stage**, when valuable information is exchanged between potential project partners
- Includes **possible sanctions**



IP in Horizon 2020 Project Life Cycle



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During Implementation

- Strategy for securing and managing research results
- Granting of access rights
- Ownership management

Before Project Start

- Proposal preparation, incl. plan for the use and dissemination of research results
- Defining project-related know-how
- Defining IP protected areas
- Negotiating a CA/NDA

After Project End

- Disseminating and securing generated IP
- Exploitation of the results
- Valorisation of intangible values
→ Commercialisation

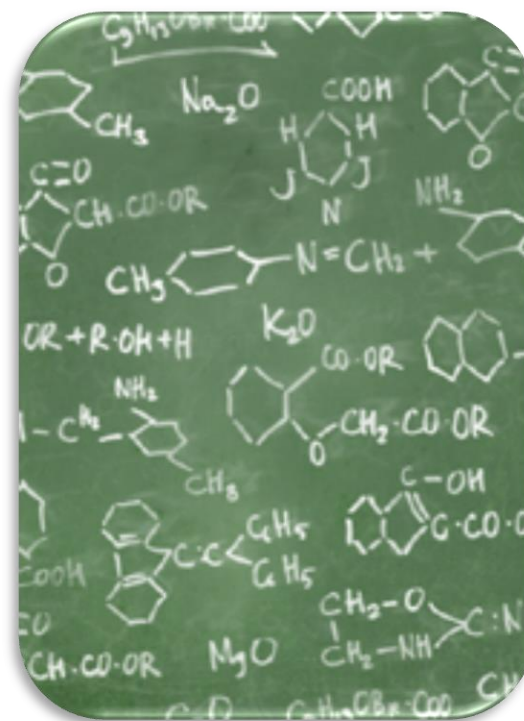
IPR issues are relevant at all stages of the project



During implementation

Secure and manage research results:

- Have a **clear strategy for securing and managing** newly generated knowledge
- **Continuously update** the plan for the exploitation and dissemination of results
- **Monitor regularly relevant external factors** affecting your exploitation potential (other projects, publications, patents, markets, competing technologies, standards, norms, etc.)
- Be clear about ...
 - ... publication regime
 - ... access right regime





Reminder: asserting the ownership of results

Ownership rules can be found in the GA (default regime) and in the CA.

Principle = results belong to the participant generating them.

If results have been generated by several partners jointly = joint ownership. GA = default joint ownership regime.

Best practice: agree on a tailored joint ownership agreement adapted to each jointly owned result.

It is always advisable to clarify the ownership of results within the consortium once they have been created, in line with your CA, before the partners start setting up exploitation strategies!

IP in Horizon 2020 Project Life Cycle



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Before Project Start

- Proposal preparation, incl. plan for the use and dissemination of research results
- Defining project-related know-how
- Defining IP protected areas
- Negotiating a CA/NDA

During Implementation

- Strategy for securing and managing research results
- Granting of access rights

After Project End

- Disseminating and securing generated IP
- Exploitation of the results
- Valorisation of intangible values
→ Commercialisation / further research

IPR issues are relevant at all stages of the project

General obligation to protect

Each participant 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 can be secured by **IPR or other means** (e.g. trade secret protection).

Protection by IPR

IPR	What for?	Registration?
Patent	New inventions	Registration is required
Utility model	New inventions	Registration is required, but conditions are less stringent than for patentability
Trade Marks	Distinctive signs	Registration is required
Industrial Design	Appearance of products	Registration is usually required, but it is possible to acquire an unregistered design right
Copyright	Literary, artistic and scientific works	Not required, but it can be registered in some countries
Confidentiality	Confidential business information/trade secrets	Not required, but internal protection measures needed (i.e. NDAs)

Always use IPR symbols, such as © for copyright, ™ and ® for trademarks, or any other equivalent indicating that it is protected by one or more different IPR



Obligation to disseminate

Project partners are obliged to disseminate the results swiftly (i.e. to scientific community/broader public) by any appropriate means other than that resulting from the formalities for protecting it or exploiting the results, and including the publication of results in any medium.

But:

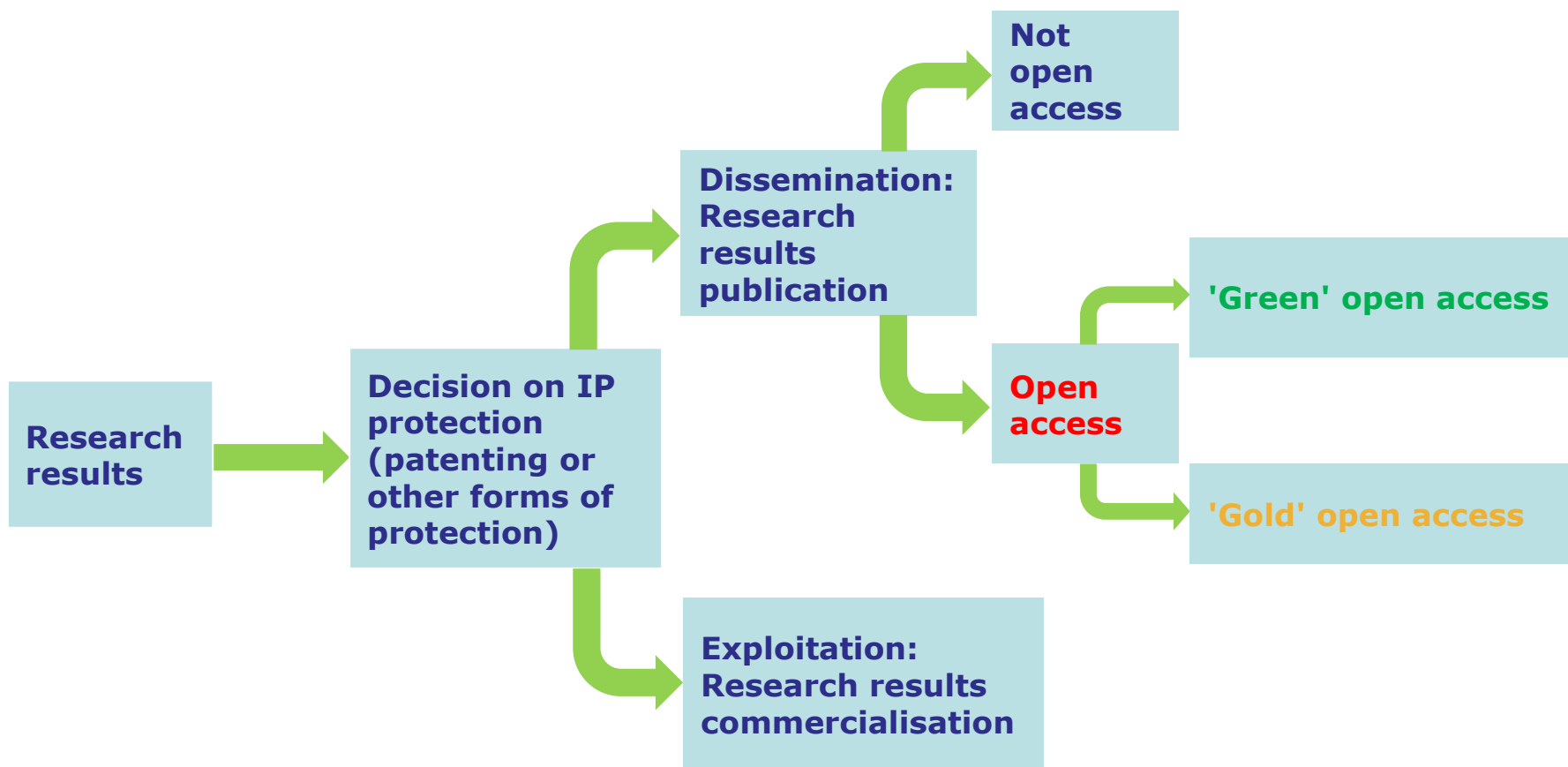
- *no dissemination of results may take place before decision is made regarding their possible protection, and*
- *all patent applications and publications or any other type of dissemination (also in electronic form) shall include a statement that the action received financial support from the Union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





Dissemination checklist

- Take a decision about the protection of results 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





Questions about Open Access?

The European Commission has published a **fact sheet** and **guidelines** on Open Access to Scientific Publications and Research Data in Horizon 2020, that can be downloaded at:

- https://ec.europa.eu/programmes/horizon2020/sites/horizon2020/files/FactSheet_Open_Access.pdf
- http://ec.europa.eu/research/participants/data/ref/h2020/grants_manual/hi/oa_pilot/h2020-hi-oa-pilot-guide_en.pdf

For more guidance and support on Open Access: **the OpenAIRE initiative** aims to support the implementation of the Open Access policies of the European Commission and the European Research Council. <https://www.openaire.eu/>

Costs Reimbursement

- **Costs of intellectual property rights (IPR)**, including protecting results (e.g. fees paid to the patent office for patent registration) and royalties on access rights **are eligible costs**
- **Cost for open access** publications are also considered **eligible** by the GA, e.g. Author Processing Charges (APCs)
- For more information on costs eligible for reimbursement in H2020: contact your Legal & Financial [National Contact Point!](#)



General obligation to exploit

Each participant receiving EU funding 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.

Setting up an Exploitation Strategy

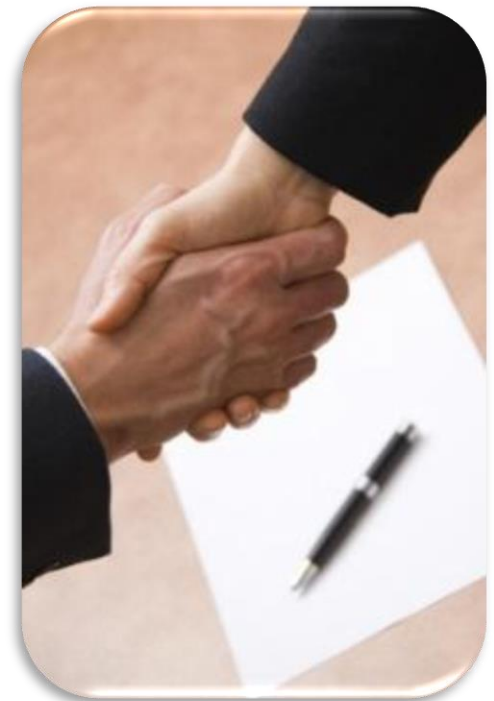
Strategic plans for the future exploitation of results should include the following elements:

- ✓ The purpose of the results;
- ✓ How they might be exploited, when and by whom;
- ✓ IPR exploitable measures taken or intended;
- ✓ Further research required, if any;
- ✓ Potential/expected impact (quantifiable)

Routes for 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)



Additional information

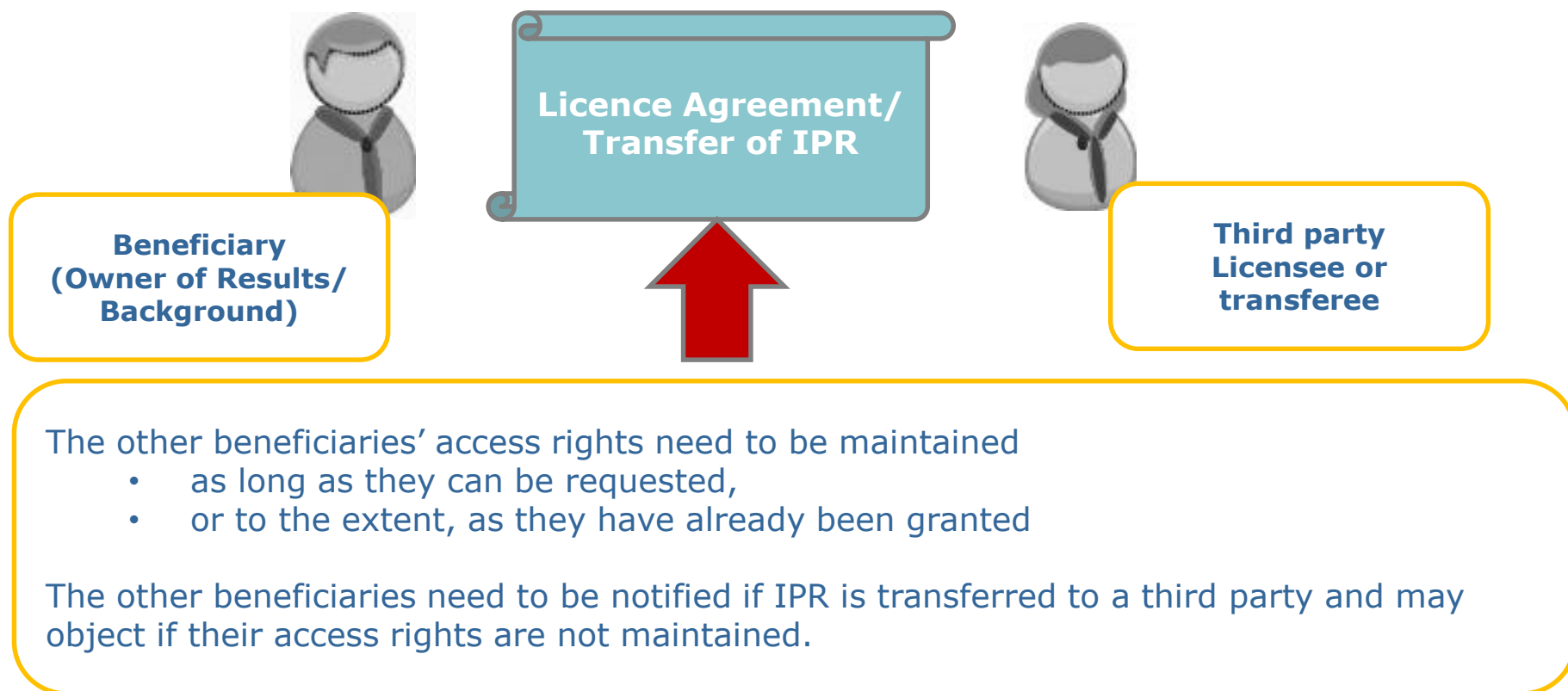
Helpdesk Fact sheets on commercialisation

- Commercialising Intellectual Property: Joint Ventures
- Commercialising Intellectual Property: Licence Agreements
- Commercialising Intellectual Property: Spin-offs
- Commercialising Intellectual Property: Internal Product Development
- Commercialising Intellectual Property: Assignment Agreements
- Commercialising Intellectual Property: Knowledge Transfer Tools
- Commercialising Intellectual Property: Franchising
- Exploitation channels for public research results
- Technology Licensing-in

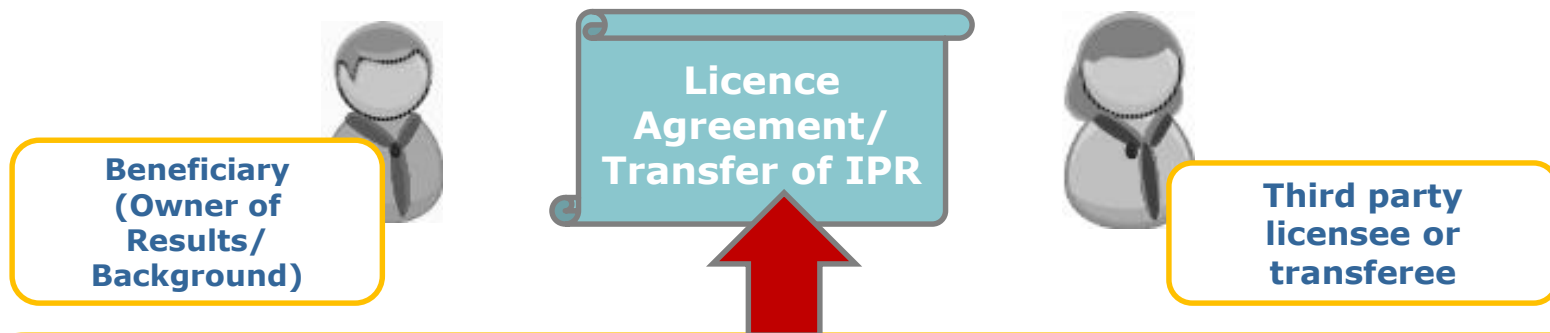


<https://www.iprhelphdesk.eu/library/fact-sheets?>

H2020 IP exploitation: remember access rights!



H2020 IP exploitation: limits to transfers and exclusive licences



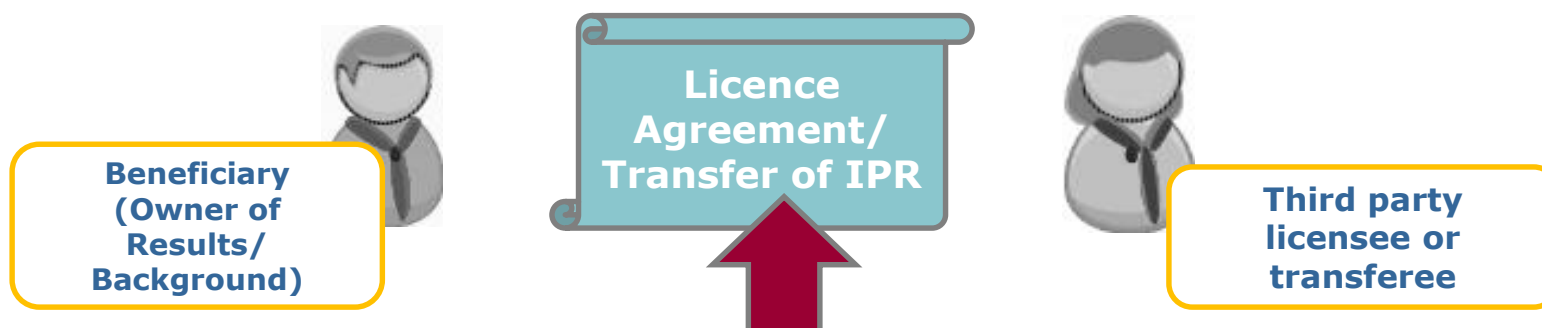
Consequences:

- Non-exclusive licenses can be granted to third parties at anytime
- In an exclusive license the obligation to grant access rights has to be passed on to the third party – not really “exclusive”
- In a transfer of ownership the obligation to grant access rights must also be passed on to the transferee

Exceptions:

- For licensing: “real” exclusive licensing is possible if the other beneficiaries waive their access rights in writing
- For transfers: notification is not necessary in case of a transfer to specifically identified third parties

H2020 IP exploitation: further limits to transfers of results



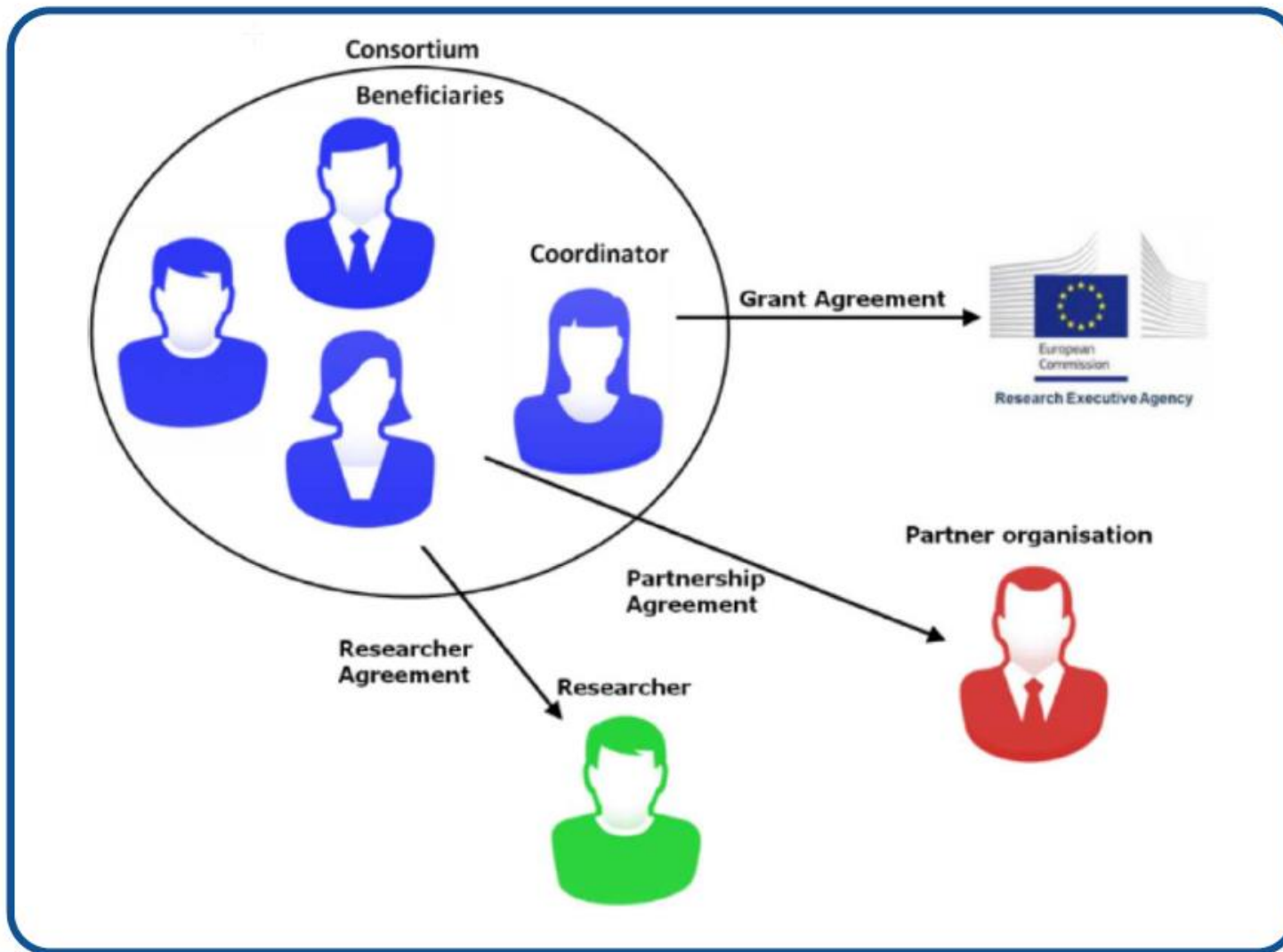
Further obligations to remember in case of a transfer:

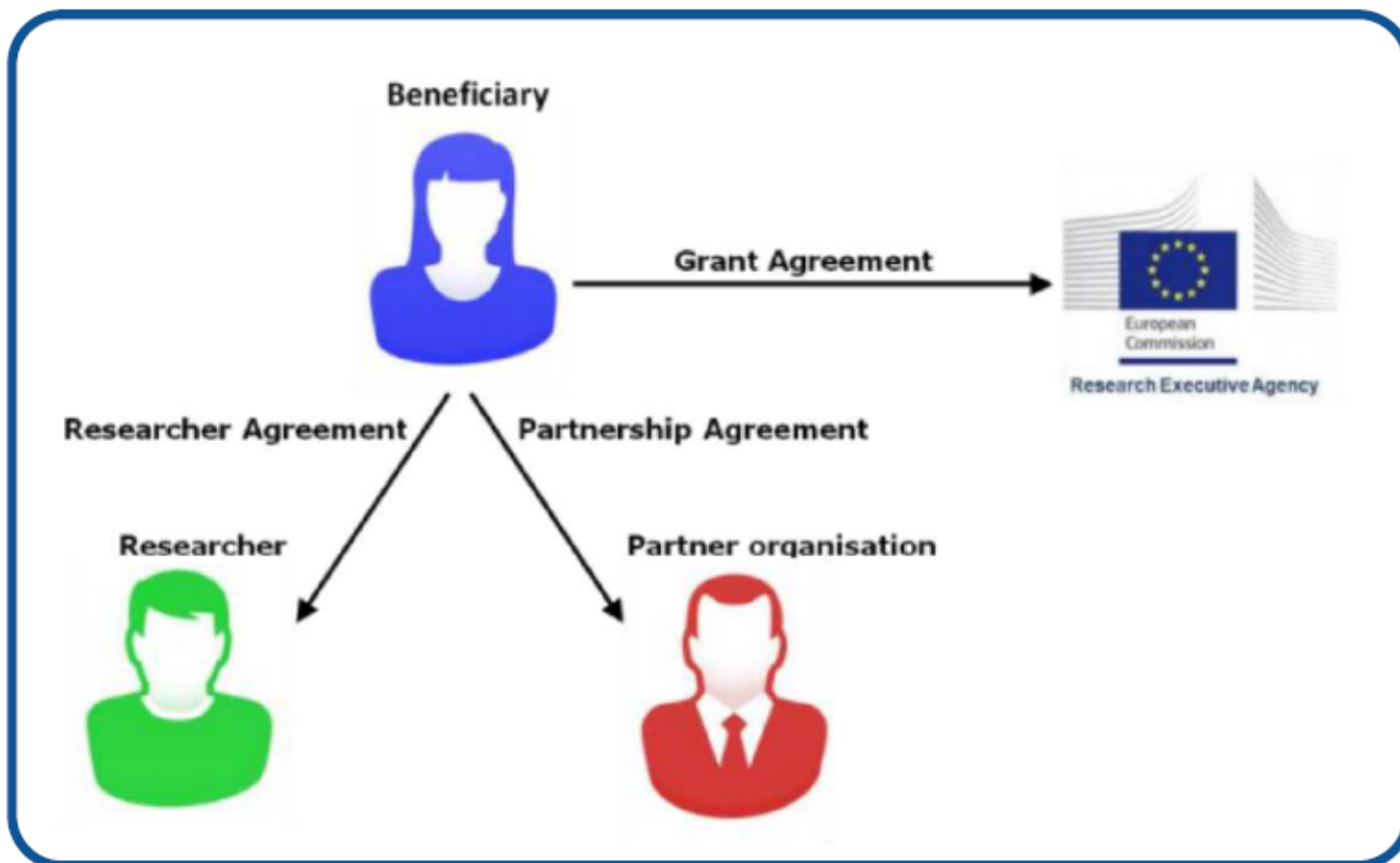
- Obligation to pass on **all obligations linked to the results to the transferee**: access rights, but also obligations linked to the protection, exploitation and dissemination of results
- *If clause 30.3 is included in your Grant Agreement:* **obligation to notify the Commission** before you transfer the results to a third party located in a non-EU country non-associated to H2020. The EC may in this case object to the transfer.
 - The same clause also applies to exclusive licences!



STOP

Particularities of MSCA







- **Partnership Agreement** – MSC Actions (e.g. RISE, IF and ITN)
 - Relationship with partner organisations involved in the project
- **Researcher Agreement** - MSC Actions
 - Relationship between the appointing beneficiary and the researcher/fellow



Particularities of MSCA

- access rights to the beneficiaries' background and results for the MSC Fellows;
- results generated by the researcher during the secondment period at partner organisation's premises belong to the beneficiary which has appointed the researcher;
- Frequent conflicts between beneficiaries and partner institutions concerning allocation of project results (partner institutions as autonomous entities follow their own institutional regimes);
- No consortium agreement in mono-beneficiary projects

Further information

Fact sheets

- IP management in Horizon 2020: at the proposal stage
- IP management in Horizon 2020: at the grant preparation stage
- IP management in Horizon 2020: implementation and conclusion
- IP management in Horizon 2020 Marie Skłodowska-Curie Actions
- Open access in Horizon 2020
- Publishing v. patenting
- Exploitation channels for public research results, and series on “Commercialising IP”

Check www.iprhelphdesk.eu/library !



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Thank you.

We look forward to getting in touch with you!

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This project receives funding from the European Union's Horizon 2020 research and innovation programme under Grant Agreement No 641474.

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