


Session 5: Understanding IP in the Model Contract Agreements




DESCA
Horizon 2020 Model Consortium Agreement
www.DESCA-2020.eu







Grant Agreement (GA)

Silent/" unless otherwise agreed"



Consortium agreement




Model Contract Agreements

H2020


- DESCA (**Development of a Simplified Consortium Agreement**) (academic and research industries)
- DE: ICT
- EU-Car: Automotive industry

FP7

- IMG: Aerospace industries
- IPCA: ICT telecom industries



Overview of IPR in H2020 Model Consortium agreements



DESCA (academic and research industries)

- Optional clauses (1 or 2) including for for IPR
 - Joint ownership of Results
 - Access rights for Exploitation
 - Additional Access rights
 - Background (how it is 'captured')

DE (ICT)




- IPR, liability and software sections different to DESCA
 - Access rights to foreground much broader
 - Access rights to side ground are granted

EU-Car (automotive industry)


- IPR provisions strongly favor commercial project participants

IMG (aerospace industries)




- Differ from DESCA in IPR, liability and governance clauses
- Flexibility of different options (DESCA) are not provided


DESCA



- One balanced core text
- Two modules for Governance Structure:
 - Module GOV LP for Medium and Large Projects: Complex governance structure: two governing bodies, General Assembly and Executive Board [Module GOV LP].
 - Module GOV SP for Small Projects: Simple governance structure: only a General Assembly [Module GOV SP].
- Optional clauses
 - Optional clauses in the IPR sections (8&9).
 - See example RESULTS p. 25
 - Optional module for projects with a strong software focus [Module IPR SC]








DESCA 2020 IPR



- **Section 1 (p. 6) : Definitions ("Needed" p. 7)/ GA**
- **Section 3 (p. 8) : Termination (3.3. Survival of rights/ obligations)**
- **Section 8 (p. 25) : Results**
- **Section 9 (p. 28): Access Rights**
 - Attachment 1 (p.41) : Background
- **Section 10 (p. 33) : Non disclosure of info**
- **Attachment 3 (p. 43) : Third parties for IPR transfer**
- **Specific Software provisions [MODULE IPR SC] p. 51**

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

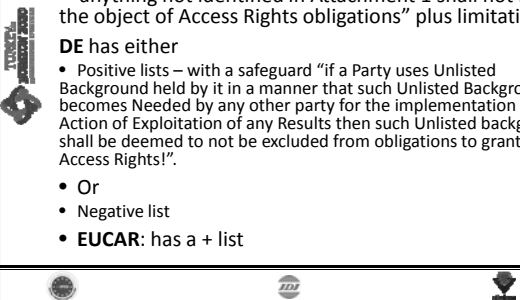
Agreement on background (needed): + and - lists

DESCA has a 'positive' list (p. 40 Attachment 1)

- not on the list then not included! (section 9.1.1)
- "anything not identified in Attachment 1 shall not be the object of Access Rights obligations" plus limitations


DE has either

- Positive lists – with a safeguard "if a Party uses Unlisted Background held by it in a manner that such Unlisted Background becomes Needed by any other party for the implementation of the Action of Exploitation of any Results then such Unlisted background shall be deemed to not be excluded from obligations to grant Access Rights!".
- Or
- Negative list
- **EUCAR**: has a + list



Grant Agreement (GA)
 ↓ Silent/ unless otherwise agreed
Consortium agreement
 OR
 Option 1 ↓ IPR: Option 2

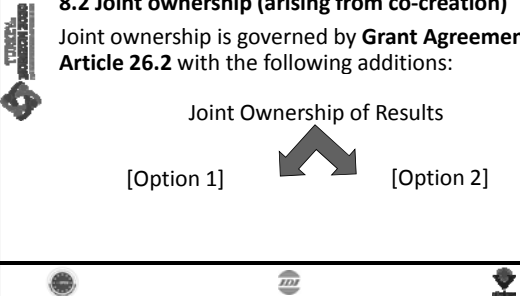
- Section 8.2 Joint ownership of Results
- Section 9.4 Access Rights for Exploitation
- Attachment 1: Background included (+/-)
- Software



DESCA Options: Joint ownership of results: 'Co-creation)

Section 8 p.25
 8.1 Results are owned by the Party that generates them.
8.2 Joint ownership (arising from co-creation)
 Joint ownership is governed by **Grant Agreement Article 26.2** with the following additions:


Joint Ownership of Results
 [Option 1] ↓ [Option 2]



DESCA Ownership of results: Section 8 p.25

[Option 1:]
 Unless otherwise agreed:

- each of the joint owners shall be entitled to use their jointly owned Results for non-commercial research activities on a royalty-free basis, and without requiring the prior consent of the other joint owner(s), and
- each of the joint owners shall be entitled to otherwise Exploit the jointly owned Results and to grant non-exclusive licenses to third parties (without any right to sub-license), if the other joint owners are given:
 - (a) at least 45 calendar days advance notice; and
 - (b) Fair and Reasonable compensation.




DESCA Joint Ownership of results: Section 8.2

[Option 2:]
 In case of joint ownership, each of the joint owners shall be entitled to

- Exploit the joint Results as it sees fit, and
- to grant non-exclusive licences, without
 - obtaining any consent from,
 - paying compensation to, or
 - otherwise accounting to any other joint owner,
 unless otherwise agreed between the joint owners.


The joint owners shall agree on all protection measures and the division of related cost in advance.



Case Study/ Group work 1: Joint Ownership

A H2020 consortium has prepared a proposal in the automotive field. Their anticipated results will include a new 'feature' for an engine management system. It is expected that this result will be produced through a close collaboration on a single work-package by an enterprise (an 'OEM' to the automotive industry) and a university.

- What are the issues to be considered in joint ownership?
- Which Joint Ownership option might you prefer as
 - Group 1: The enterprise
 - Group 2: The university
- And why?







Feedback and discussion

Preferred Option for the enterprise ('OEM')

Preferred Option for the university

Issues










Access Rights to Results for exploitation
(Section 9.4 p. 30)

[Option 1:]
Access Rights to Results if Needed for Exploitation of a Party's own Results shall be granted on Fair and Reasonable conditions.

Access rights to Results for internal research activities shall be granted on a royalty-free basis.

[Option 2:]
Access Rights to Results if Needed for Exploitation of a Party's own Results shall be granted on a royalty-free basis.





Case Study/ Group work 2: Access to results for exploitation

The enterprise and the University also have individual work packages.

The enterprise expects to generate a totally new feature for a car engine which is can then protect through the patent system. It will be the only engine supplier in the world to be able to offer this new feature.

One of the University's individual work packages is expected to generate software Results which will be needed by the enterprise to make their new feature work.





- What are the issues to be considered in access to Results for exploitation?
- Which exploitation Option might you prefer as
 - Group 1: The enterprise
 - Group 2: The university
- And why?

Feedback and discussion

Preferred Option for the university?
Preferred Option for the enterprise ('OEM')?

Issues








Access rights to Results – rational for options

Option 1 in the IPR clauses reflects the preference of most stakeholders (some Industry sectors as well as universities and research organisations) where fair and reasonable remuneration for having access to other partners' project results for exploitation is foreseen.


Option 2 in the IPR clauses reflects a situation preferred by some industries, where all project results are available for Exploitation without any form of remuneration to the owners.

Advice note: A mix of Option 1 and Option 2 can in some cases lead to inconsistencies.





"Mr. Osborne, may I be excused?
My brain is full."



Documents and resources

- Grant agreement, Annotated Model grant agreement Guidance "How to draw up your consortium agreement"
 - http://ec.europa.eu/research/participants/data/ref/h2020/other/gm/h2020-guide-cons-a_en.pdf
- DESCA
 - www.desca-2020.eu
- Digital Europe
 - www.digitaleurope.org
- EUCAR
 - www.eucar.be
- IPR Helpdesk (MoU)
 - www.iprhelpdesk.eu

Summary: IP in Horizon 2020?

Pre-proposals

- Confidentiality (NDA) and MoU

Proposal

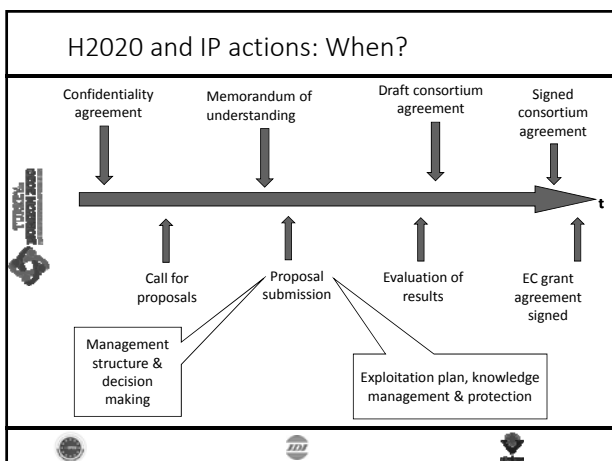
- 'Measures to maximise impact'
 - Dissemination and exploitation of results
 - Knowledge management and protection strategy
 - Open access
 - Green/ Gold model of publication

Grant Agreement

- Section 3

Consortium Agreement (DESCA)


- Results (DESCA Section 8)
- Access Rights (DESCA Section 9)
- Non-disclosure of information (Section 10)




Summary of useful resources

1. Open Access in Horizon 2020 (Fact sheet)
https://ec.europa.eu/programmes/horizon2020/sites/horizon2020/files/FactSheet_Open_Access.pdf
2. How to manage IP in Horizon 2020: grant preparation stage
3. IP management in Horizon 2020: project implementation and conclusion
4. IP Management in Horizon 2020: proposal stage
5. The Plan for the Exploitation and Dissemination of Results in Horizon 2020
6. NDA/ MoU
7. Your Guide to IP in Horizon 2020


European IPR Helpdesk
<https://www.iprhelpdesk.eu>



The European IPR Helpdesk
Your Guide to IP in Horizon 2020



https://www.iprhelpdesk.eu/sites/default/files/documents/EU_IPR_IP-Guide.pdf



Open Discussion: H2020



HORIZON 2020




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 **TURKEY IN HORIZON 2020**
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