

DESCA Case study on 'Options'

Case study Part 1

A H2020 consortium involving a university partner and an enterprise has prepared a proposal in the automotive field. The enterprise is an 'OEM' ('Original Equipment Manufacturer'). They manufacture and supply Exhaust Gas Temperature (EGT) Sensors and associated software for engine management systems to global automotive companies. The university focuses mainly on teaching and research although they are starting to try and license more of their research results to companies with support from their Technology Transfer Office. However, they do not have much internal funding for patent protection.

Their anticipated Results from the H2020 project will include a new 'feature' for an EGT sensor.

It is expected that this result will be produced through a close collaboration by the enterprise and the university on a single work-package (WP3).

- 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?
- What other issues might need to be considered by the 2 partners (think about protection of Results) and how might these influence the issue of Joint ownership?

(10 minutes to discuss in groups and then feedback)

Reminder of the 2 DESCA Options:

Option 1:	Option 2:
<p>Unless otherwise agreed:</p> <ul style="list-style-type: none"> - 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: <ul style="list-style-type: none"> (a) at least 45 calendar days advance notice; and (b) Fair and Reasonable compensation. 	<p>In case of joint ownership, each of the joint owners shall be entitled to</p> <ul style="list-style-type: none"> • Exploit the joint Results as it sees fit, and • to grant non-exclusive licenses, without <ul style="list-style-type: none"> • obtaining any consent from, • paying compensation to, or • otherwise accounting to any other joint owner, <p>unless otherwise agreed between the joint owners.</p>
<p>The joint owners shall agree on all protection measures and the division of related cost in advance.</p>	

Case study Part 2

The enterprise and the university also have individual work packages:

Under WP5 the enterprise expects to generate a totally new feature for a car engine sensor which it can then protect through the patent system. It believes it will be the only OEM in the world to be able to offer this new sensor to automotive companies.

One of the University's individual work packages (WP6) is expected to generate software Results which will be needed by the enterprise to make their new feature work. The results will be generated by a PhD student as part of their PhD work.

- What are the issues to be considered in access to Results from WP6 for exploitation?
- Which exploitation option might you prefer as
 - Group 1: The enterprise
 - Group 2: The university
- And why?
- What other issues might need to be considered by the 2 partners (think about protection of the software Results and dissemination of the PhD thesis).

(10 minutes to discuss in groups and then feedback)

Reminder of the 2 DESCA Options:

Option 1:	Option 2:
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.	Access Rights to Results if Needed for Exploitation of a Party's own Results shall be granted on a royalty-free basis.