



Sharing IP with the consortium

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The Central IP Service (CIPS)

- Providing advice to all Commission services on IP aspects of their activities
- Managing the IP portfolio of the Commission (trademarks, patents, logos...)
- Helping in technology transfer activities of Commission's technology
- Coordinating a network of IPR correspondents in all DG's

- Hosted with DG JRC
<https://ec.europa.eu/jrc/en/research/crosscutting-activities/intellectual-property/central-ip-service>

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Intro – what's in a title?

"**Sharing** IP with the consortium"

- Sharing – when?
 - Even before signing any agreement
 - Also after the agreement is over

- Sharing - what?
 - What members already have or have access to ("**background**")
 - What members will be creating ("**results**")

- Sharing – how?
 - Via co-ownership
 - Without co-ownership

Intro – what's in a title?

"Sharing **IP** with the consortium"

- IP covers many things:
 - **Copyright**
 - **Including copyright on software**
 - **Inventions (patents)**
 - **Data, datasets, databases**
 - **Confidential information**
 - **Trade secrets, know-how**
- **Trademarks, domain names**

The contractual context, the GA

- The Grant Agreement (GA) **contains rules** on "sharing IP with the consortium"
- The consortium agreement (CA) **may not deviate** from the GA
- The CA will **customise** the rules to the specific project

The rules in the grant agreement

- Access to **background**:
 - Obligation to identify:
 - Positive list, negative list
 - Obligation to give access to other members:
 - Royalty-free for implementing tasks under the action
 - On fair & reasonable terms for exploiting their own results
 - Somehow equivalent to a licence agreement
 - Sometimes rather a non-disclosure agreement
 - Not necessarily access by all members to all background

The rules in the grant agreement

- Ownership of **results**:
 - Results owned by the member who generated them
 - Joint ownership (automatically) if:
 - Results generated jointly and
 - Impossible to establish respective contributions or
 - Impossible to separate contributions.
 - If so: obligation to have a written joint ownership (JO) agreement
 - Only after results were generated, possibility to agree on another mechanism than joint ownership

The rules in the grant agreement

- Obligation to **protect** the results
 - Different routes
- Obligation to **exploit** the results
- Obligation to **disseminate** the results (open access), not at the detriment of protection
- Possibility to **transfer** ownership or **licence** the results
- Rights of **access** by members to the results
 - Royalty-free for implementing their tasks under the action
 - Fair and reasonable conditions for exploiting their own results

In addition to the GA, the consortium agreement

- What about derivative works created on the basis of the background? Are they "results"?
- If co-ownership is chosen as a solution:
 - Have a joint ownership (JO) agreement
 - More freedom to agree after results have been generated
 - Make sure at least the following is regulated:
 - Decision-making process between co-owners regarding all issues:
 - Choice of appropriate protection scheme
 - Rights of co-owners to use results
 - Rights of co-owners to exploit results (licensing, spin-off, joint ventures...)
 - Rights of co-owners to disseminate results

In addition to the GA, the consortium agreement:

- If co-ownership is chosen as a solution:
 - Make sure at least the following is regulated:
 - Decision-making process between co-owners (prior info, votes, veto...)
 - Equal shares or not?
 - Freedom to still go "your own way" in the future
 - Who can/must sue in case of infringement?
 - How are royalties & damages shared?
 - Can one sell its shares? Pre-emption right for the others?
 - And remember: ownership is often a source of conflicts!

In addition to the GA, the consortium agreement:

- If co-ownership is NOT chosen as a solution:
 - Who owns the results?
 - Compensation for this transfer?
 - Rights of other members, via a licence:
 - To use results for the project
 - To exploit result after/outside the project

What if the CA does not contain any clause?

- The GA imposes rules (binding all GA signatories)
- The applicable law will apply by default:
 - Which laws? Preferably BE laws?
 - What do these laws provide?
 - No harmonisation of contract law in the EU, on:
 - Rights of co-owners to grant licences
 - Rights of co-owners to grant exclusive licences
 - Rights of co-owners to sue
 - Differences regarding IP regime (copyright, patent, trademark)

Recommendations for consortium members

- Make sure they have rules in place
- Co-ownership situations are a regular source of disputes
- Even though not all situations can be covered in advance
- Have mechanisms to deal with unforeseen events:
 - Decision-making processes
 - Alternative dispute resolution (ADR) schemes

Recommendations for consortium members

- Remember: even the best contract does not replace confidence
- Not just an issue of compliance with H2020 rules
- It can be crucial for the future, in their interests:
 - investors, venture capitalists etc. will do their own "due diligence", including on IP
 - important to have a proper system in place

Recommendations for consortium members

- Sharing IP often starts even before any CA or GA is in place
- Before sharing, make sure they have an NDA (non-disclosure agreement) in place
- And start discussing IP early in the process:
 - The "Plan for Dissemination and Exploitation of Project Results" is a good tool to start this
 - It needs to be updated and followed

For useful guidelines:

Factsheets from the European IPR HelpDesk (www.iprhelphdesk.eu):

- IP joint ownership
- The Plan for the Exploitation and Dissemination of Results in Horizon 2020
- IP Management in Horizon 2020: proposal stage
- How to manage IP in Horizon 2020: at the grant preparation stage
- How to manage IP in Horizon 2020: project implementation and conclusion
- How to deal with IP related clauses within Consortium Agreements
- Intellectual property management in open innovation
- Inventorship, Authorship and Ownership
- Your Guide to IP in Horizon 2020
- Creating values – IP exploitation in Horizon 2020

Guidance from the EU Commission:

- Guidance – How to draw up your consortium agreement
- AGA – Annotated Model Grant Agreement



Thank you for your attention!

Any question?

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