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Community Research



DRAFT Guide to Intellectual Property Rules
for FP7 projects

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Disclaimer

The information and advice contained herein is not intended to be comprehensive and readers are advised to seek independent professional advice before acting upon them. The Commission does not accept responsibility for the consequences of errors or omissions herein enclosed.



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1. INTRODUCTION

This document provides an overview of the Intellectual Property Rights (IPR) provisions applicable in *the Seventh Framework Programme (FP7) of the European Community for research, technological development and demonstration activities (2007-2013)*¹.

It is a guide to the various issues and potential pitfalls regarding IPR that participants may encounter when preparing and participating in an FP7 project.

Overall, participants are strongly encouraged to consider and tackle IPR issues as soon as possible during the preparation of their project and to negotiate any relevant questions with the other participants before starting the project. Indeed, IPR issues can affect both the way a project is conducted, and the exploitation of results after the end of a project. Moreover, certain provisions foresee a default regime if no alternative agreement has been reached.

This guide should be considered in conjunction with the applicable legislation, in particular the "Rules for Participation"² ("RfP") and the "EC model Grant Agreement"³ ("ECGA"). These official documents prevail over any statement contained in this guide.

Where possible, reference is made throughout this guide to the relevant articles. Most of the provisions referred to in this guide are part of Annex II of the EC Grant Agreement (thus, a reference such as "Article II.30 of ECGA" refers to Article 30 of Annex II of the EC Grant Agreement). However, for certain types of FP7 projects, more specific IPR provisions may be found in Annex III, such as the ones applicable to research actions for SMEs or for SME associations⁴. In specific cases, "special clauses" may also be included in Article 7 of the core grant agreement; a list of all such clauses is available⁵.

Moreover, *Frontier research actions* (conducted under the European Research Council – ERC) do not rely on the EC Grant Agreement but on a separate "*ERC Grant Agreement*", referred to as *ERC-GA* in this guide.

2. PARTICIPANTS AND THIRD PARTIES

A "**participant**"⁶ is a legal entity taking part in an indirect action (i.e. a specific FP7 project undertaken by one or more participants) and having the rights and obligations defined by the EC Grant Agreement entered into with the European Commission (on behalf of the European

¹ Decision No 1982/2006/EC of the European Parliament and of the Council of 18.12.2006 – http://eur-lex.europa.eu/LexUriServ/site/en/oj/2006/l_412/l_41220061230en00010041.pdf.

² Regulation 1906/2006 (http://eur-lex.europa.eu/LexUriServ/site/en/oj/2006/l_391/l_39120061230en00010018.pdf). Similar Rules apply to the Euratom Framework Programme (Regulation 1908/2006 – http://eur-lex.europa.eu/LexUriServ/site/en/oj/2006/l_400/l_40020061230en00010059.pdf).

³ The text of the EC Grant Agreement (including Annexes) may be found at http://cordis.europa.eu/fp7/calls-grant-agreement_en.html.

⁴ Hence references such as "Article III^{SME}.of ECGA".

⁵ See http://cordis.europa.eu/fp7/calls-grant-agreement_en.html.

⁶ The term "participant" as used here is equivalent to the term "beneficiary" used in the EC Grant Agreement.

Community). For the sake of simplicity, hereafter the word "participant(s)" will be used to indicate those participating in a given project.

A "**consortium**" is the term used to describe all of the participants in the same project.

The term "**third party**" is used to describe a legal entity which does not participate in the same project⁷, even though such third party may participate in another FP7 project.

Only a "**legal entity**" as defined in the Rules for Participation⁸ (e.g. company, university, research centre, individual) can become a participant in a FP7 project. A department (or faculty, university institute etc.) which does not have legal status cannot⁹.

The "**coordinator**" has a very specific role amongst the participants in a given project. It has to "*monitor the compliance by participants [beneficiaries with their obligations under this grant agreement]*" (Article II.2.3.e of ECGA), which includes the participants' obligations regarding IPR, dissemination and use issues.

3. FOREGROUND AND BACKGROUND

"**Foreground**"¹⁰ means the results, including information, materials and knowledge, generated in a given project, whether or not they can be protected. It includes intellectual property rights (IPRs such as rights resulting from copyright protection, related rights, design rights, patent rights, plant variety rights, rights of creators of topographies of semiconductor products), similar forms of protections (e.g. sui generis right for databases) and unprotected know-how (e.g. confidential material).

Thus, foreground includes the tangible (e.g. prototypes, micro-organisms, source code and processed earth observation images) and intangible (IPR) results of a project. Results generated outside a project (i.e. before, after or in parallel¹¹ with a project) do not constitute foreground.

"**Background**"¹² is information and knowledge (including inventions, databases, etc.) held by the participants prior to their accession to the EC grant agreement, as well as any intellectual property rights which are needed for carrying out the project or for using foreground. Regarding intellectual property rights for which an application must be filed, only those intellectual property rights for which the application was filed before the accession of the participant to the EC Grant Agreement are included.

The fact that participants are legal entities is important in this respect. If a specific department of a university or company is involved in a project, the background will be that of the whole university

⁷ If foreseen in the EC grant agreement, some third parties may carry out some work in the project (e.g. subcontractors, affiliates or members of a joint research unit). However, such third parties do not become participants as defined above.

⁸ See Articles 2.1 and 4.1 RfP; Note that, in exceptional cases, a participant may be a natural person.

⁹ Where such a department (with no legal status) takes part in a project, the participant is considered to be the legal entity to which the department belongs (i.e. the university / company).

¹⁰ The definition is in Article 2.4 RfP and Art. II.1.7 ECGA. Under FP5 and FP6, the results were designated as "knowledge", which may however have been slightly confusing to some new users due to the generic meaning of this expression.

¹¹ Results generated in parallel with a project are often informally referred to as "sideground".

¹² The definition is in Article 2.5 RfP and Article II.1.4 of ECGA.

or company (subject to its relevance to the project), not just that of the specific department (unless the department constitutes a legal entity and is the participant). This is important as a participant may have to grant the other participants in the project access rights to the background of other departments under certain conditions. However, there are several mechanisms in the EC Grant Agreement which make it possible for participants to decide accurately what background will be available to each other (e.g. by defining background and/or specifying which background is excluded from the obligation to grant access). This is explained in more detail in section 8 on access rights.

Ownership of background is not affected by participation in a FP7 project.

The definition of background specifies that it relates only to information **relevant to the project (i.e. needed to implement the project or needed to use the foreground generated)**. This further limits the scope of information and rights which could potentially be considered to constitute background, and to which other participants could request access.

In addition, it should be noted that the background of a given participant is not limited to the information *it owns*, but also extends¹³ to any information or IPR which *it holds* – for instance through licensing agreements or material transfer agreements (MTAs). Even though restrictions may be attached to such information or IPR (in which case they should be clearly mentioned to the other participants, see Article 48.5 RfP – Article II.32.3 of ECGA), it is nevertheless included in the background of its holder. However, also here there are several mechanisms in the EC Grant Agreement which make it possible for a participant not to have to grant access to (all) such background, especially if a pre-existing agreement prevents it. This is why the access rights to background only need to be granted "*provided that the participant [beneficiary] concerned is entitled to grant them*" (Articles 49.2 and 50.2 RfP – Articles II.33.2 and II.34.2 of ECGA). In addition, participants may define background and/or specify which specific background is excluded from the obligation to grant access. This is explained in more detail in section 8 on access rights.

As indicated above, regarding IPRs for which an application has to be filed (e.g. patents), the definition of background only includes those IPRs for which such an application was filed before acceding to the grant agreement (i.e. before starting the project). While this is coherent with the aim of legal certainty, this means for example that if an invention was made before starting the project, but a patent application for it was filed after starting the project, this application (and the resulting patent, if any) will not be considered as background. If participants wish to avoid this, especially when during their negotiations it appears that such an event is possible, they may of course agree to also include such later-filed IPRs in the definition of background.

4. OWNERSHIP OF FOREGROUND

References : Articles 39-41 RfP – **Article II.26 of ECGA** (Euratom : Article. 39-40 RfP).

4.1. General principles

¹³ Unless, of course, such information is explicitly excluded, or is not mentioned in the positive list (if any) defining which background can be accessed by the other participants – see section 8.3 below.

Foreground resulting from the project is owned by the participant which generated it. When foreground is generated jointly (i.e. where the separate parts of some result cannot be attributed to different participants), it will be jointly owned, unless the participants concerned agree on a different solution (see "Joint ownership" below).

As in FP6 and FP5, **foreground** resulting from the project belongs to that participant which generated it.

In order to be able to **prove** ownership (as well as the date of generation) of foreground, it is strongly recommended that all participants maintain documents showing the development of the generation of knowledge or results, e.g. laboratory notebooks, in accordance with proper standards¹⁴. This may help avoid or resolve disputes between participants about the origin of certain results and any attached IPR¹⁵.

In addition, participants must ensure that, where necessary, they reach an agreement with their employees **and other personnel if the latter are entitled to claim rights to foreground** (including personnel of third parties such as subcontractors, students, etc.), in order for the participant to be able to meet its contractual obligations¹⁶. Such agreements may for instance involve a formal transfer of ownership, or at least the granting of appropriate access rights (with a right to sub-license).

For **academic institutions**, this is especially relevant regarding (a) "non-employees" such as students (both undergraduate and postgraduate, e.g. PhD students), and (b) researchers in those countries having a specific type of "professor's privilege" regime (according to which the researchers concerned may have some personal rights to the results of university research).

4.2. Joint ownership

References : Articles 40-41 RfP – **Article II.26.2 of ECGA** (Euratom : Article 40 RfP).

Joint owners must agree among themselves on the allocation and the terms of exercising the ownership of the foreground. In the absence of such an agreement (or pending its conclusion), a default joint ownership regime applies.

Joint ownership arises (automatically, by default) in two specific cases:

- in regular actions (collaborative projects, etc.), in respect of *foreground generated jointly* by two or more participants, where their respective share of the work cannot be ascertained (Article 40.1 RfP – Article II.26.2 of ECGA); and
- in *actions for the benefit of specific groups* (see Article 41 RfP and section 9 below).

Evidently, participants are free to agree amongst themselves on alternative regimes, such as the joint ownership of the foreground resulting from the project. A participant could also place a given piece of foreground in joint ownership with a third party (e.g. its mother company), but this necessitates a (partial) transfer of ownership, which will be subject to the relevant provisions regarding transfer of ownership (see 4.2 below).

¹⁴ See for instance http://www.btgplc.com/btguploads/BTG_LabNotebook_Mar06.pdf

¹⁵ This may also be important where patenting in the USA is concerned, due to their "first-to-invent" regime.

¹⁶ This is particularly important for the granting of access rights to foreground to other participants – see Article 39.2 RfP and Article II.26.3 of ECGA.

Joint owners have to agree among themselves on the allocation and the terms of exercising the ownership of the foreground, typically by incorporating appropriate provisions in their consortium agreement regarding joint ownership or entering into a *joint ownership agreement* (Article 40.1 RfP, last sentence – Article II.26.2 of ECGA, second sentence).

Insofar as allocation of ownership is concerned, the joint owners may agree, for instance, that patent applications will be filed and maintained by only one participant on behalf of the others (in such a case there will be a partial transfer of ownership). They should also define the respective shares of ownership, if they are not divided equally.

With respect to the terms of exercising the ownership, it is highly advisable that joint ownership arrangements clarify management issues such as the sharing of the costs arising from legal protection procedures (e.g. patent filing and examination fees, renewal fees, prior state of the art searches, infringement actions, etc.) and the exploitation of the jointly owned foreground (e.g. sharing of any revenues or profits). Such joint ownership arrangements should also take into account the different national joint ownership regimes to avoid their potential pitfalls¹⁷.

The joint owners may of course agree not to continue with joint ownership but decide on an alternative regime (for example, a single owner with more favourable access rights for the other participants that transferred their ownership share or any other fair counterpart).

To avoid problems regarding the joint ownership provisions of national IPR laws (in particular regarding the right to grant licences by joint owners), a **default regime for joint ownership** has been introduced which is applicable only in the absence of a specific agreement between the participants concerned or pending its conclusion (Article 40.2 RfP – Article II.26.2 of ECGA). Nevertheless, it remains advisable for participants to reach a specific agreement as soon as possible after the generation of the jointly owned foreground.

According to the default regime each of the joint owners is entitled to grant non-exclusive licences to third parties, without requesting the authorisation of the other joint owner(s).

However, the other joint owner(s) must (a) be given 45 days prior notice and (b) is (are) entitled to fair and reasonable compensation, in particular in the case of a profitable exploitation (if no profitable exploitation takes place and depending on the circumstances, it may be that no compensation would appear to be fair and reasonable). In addition, in order to make it possible for the other joint owner(s) to verify whether the proposed compensation is fair and reasonable, any necessary information regarding the granted license, including any direct or indirect benefits given in return, should be provided. The participants could foresee a specific procedure in their consortium agreement to deal with issues relating to possible joint ownership agreements.

Whether or not a patent relating to foreground is jointly owned depends on the exact scope of work done by each of the joint owners and the claims (of the patent application(s) as well as, where different in scope, that of the patent(s) granted). For instance, it might happen that a patent application covers (claims) both a new process A (developed jointly by organisations X and Y) and an improvement B (developed by Y only). This patent application would clearly be jointly owned by organisations X and Y. However, if it appears (during the official prosecution of the application) that process A is not patentable, the patent eventually granted will cover only improvement B (developed by Y only) and should therefore belong exclusively to organisation Y. In short, the (joint) ownership of a patent may need to be reviewed during the prosecution (examination or opposition, if any) procedure.

¹⁷ For example, care should be taken when considering employees' rights, etc. as these may differ significantly from country to country. Ideally the participants will have clarified the steps to be taken if a dispute arises, such as the possible use of a mediator, and the governing law applicable etc.

4.3. Transfer of ownership

References : Article 42 RfP – [Article II.27 of ECGA](#) (Euratom : Article 41 RfP)

Transfers of ownership of foreground are allowed, though the obligations regarding that foreground must be passed on to the transferee. In principle, as long as the participant concerned is required to grant access rights, at least 45 days notification must be given to the other participants, during which time they have the right to object. However, they may agree in advance that no prior notification is necessary with regard to a specifically identified third party. Contrary to FP6, the Commission must only be notified in very limited cases.

When ownership is transferred, the assignor must conclude **appropriate arrangements** to ensure that its contractual obligations with respect to dissemination, use, and the granting of access rights (Article 42.2 RfP; Article II.27.1 of ECGA) are passed on to the new owner (the "assignee"), as well as by the latter to any subsequent assignee. Moreover, prior notice must be given to the other participants, and to the Commission in certain cases.

Information to – and objections by – other participants

There is a requirement to give **prior notice to the other participants in the same project** (as long as the participant concerned is required to grant access rights), with a time limit of 45 days or a different time-limit agreed upon (Article 42.3 RfP – Article II.27.2 of ECGA). Moreover, the rights of the other participants are even better protected than before as this prior notification should contain "*sufficient information about the new owner of the foreground to permit them [i.e. the other participants] to exercise their access rights*".

Objections by another participant may only be raised – within 30 days or a different time-limit agreed upon – if such a transfer would adversely affect its access rights. If this adverse effect is demonstrated, the intended transfer cannot take place until an agreement has been reached (Article 42.4 RfP, § 2 – Article II.27.3 of ECGA).

Regular transfers to a specific third party

References : Article 42.3 RfP – [Article II.27.2 of ECGA](#)

A simplification introduced in FP7 is that, subject to prior agreement by all participants in a project (for example in the Consortium Agreement), one of them (X) can be authorised to **transfer** the ownership of any foreground it generates to a specifically identified third party (for instance its mother company or an affiliate). Once such a global authorisation has been provided, participant X no longer has to give prior notice to the other participants of each individual transfer and therefore the latter will no longer have the possibility to object. This should address concerns expressed for example by large industrial groups where it is sometimes clear from the beginning that all foreground generated will be transferred to another entity of the group, without being detrimental to other categories of participants (as they need to provide their agreement). Nevertheless, before agreeing to such an exemption, the other participants should carefully consider the situation, and in particular the identity of the third party concerned to determine if their access rights could be properly exercised in case a transfer takes place. In security research projects, the transfer to third parties should only be decided on a case-by-case basis and should be handled with greatest caution.

Other transfers

Transfer of ownership of foreground can take place explicitly ("intended" transfer) but may also arise in the context of a take-over, the merger of two companies or similar cases. IPR-related obligations under the EC Grant Agreement will also have to be passed on and respected in those cases, and the same provisions of the EC Grant Agreement apply. However, in this case, the limitation "*subject to its obligations concerning confidentiality*" (Article 42.3 RfP; Article II.27.2 of ECGA) clarifies that **legal confidentiality constraints** (relating e.g. to mergers and acquisitions – "M&As") prevail, and may for instance justify that the other participants are only informed ex-post, instead of being notified ex-ante, in order to comply in particular with legislation relating to M&As.

Information to – and objections by – the Commission

References : Article 43 RfP – [Article II.27.4 of ECGA](#)

Although foreground may be transferred by a participant to any legal entity (Article 42.1 RfP), the Commission **may object** to intended transfers to "non-European" third parties (more accurately, to third parties established in a third country not associated to the Seventh Framework Programme), if it considers that it is detrimental to European competitiveness or inconsistent with ethical principles or security considerations.

When could the Commission consider that the intended transfer of ownership is:

- not in accordance with the interests of developing the competitiveness of the European economy ?

A transfer of ownership could for example be viewed not in accordance with these interests if the result of the transfer would mean that important foreground would become inaccessible for European companies or that it would create a major competitive disadvantage for European companies.

- inconsistent with ethical principles ?

An intended transfer of ownership would be inconsistent with ethical principles if, as a consequence, the foreground would be used (in further research or commercially) in a way that is not in accordance with the fundamental ethical rules and principles recognised at European and international level. It is clear that if foreground is to be used in a certain country, such use must respect the legislation of that country.

- inconsistent with security considerations ?

This could for example occur if the intended transfer of ownership could – from a security standpoint – cause significant foreground not to be readily available on the European market, or if "sensitive" foreground is intended to be transferred to third parties established in third countries that are deemed a security risk.

The grant agreement does not foresee automatic notification of the Commission in case of an intended transfer of ownership, except where a special clause is introduced to this effect (see below). However, the Commission may become aware of the intended transfer by other means. If it considers that it might be necessary to use its right to object, it will immediately inform the participant(s) concerned, and request it to suspend the intended transfer. Once it has examined the issue, it will notify the requirements for such a transfer to take place. The transfer of ownership

shall not take place until the Commission is satisfied that appropriate safeguards will be put in place.

Contrary to previous Framework Programmes, transfers of ownership between participants as well as within Member States and Associated countries are now allowed **without any prior information to the Commission**. Where appropriate, a special clause may be included in the EC Grant Agreement, requiring the participants to notify the Commission of any intended transfer of ownership of foreground to a third party established in a non-associated third country (see Articles 19.5 and 42.5 RfP – special clause 11).

Participants which have been notified of an intended transfer by another participant of ownership of foreground to a third party established in a third country not associated to the Seventh Framework Programme should inform the Commission of the intended transfer if they have serious concerns about it (Article 18.6 RfP). This will entitle the Commission to use its right to object.

Annex II to this guide summarises the various provisions relating to prior notifications and rights to object.

5. PROTECTION OF FOREGROUND

References : Article 44 RfP – [Article II.28 of ECGA](#) (Euratom : Article 43 RfP)

Valuable foreground should be protected. Protection is not mandatory in all cases, though the decision *not* to protect foreground should preferably be made in consultation with the other participants, which may wish to take ownership. If valuable foreground is left unprotected, the Commission may take ownership.

Where foreground is capable of industrial or commercial application (even if it requires further research and development, and/or private investment), it **should be protected** in an adequate and effective manner in conformity with the relevant legal provisions, having due regard to the legitimate interests of all participants, particularly the commercial interests of the other participants. Participants should, individually and preferably collectively, reflect on the best strategy to protect in view of the use of the foreground both in further research and in the development of commercial products, processes or services.

The reference to industrial or commercial applicability and to the legitimate interest of the participants means that Intellectual Property protection is not mandatory in all cases. Apart from a lack of industrial or commercial applicability (e.g. certain fundamental research results), there are also situations where journal publication or other means of putting foreground in the **public domain** constitute appropriate alternatives, taking into account the specificity of the project, the nature of the results concerned and the legitimate interests of the participants. The *free and open source software* (F/OSS) approach is perfectly valid in certain cases, but evidently it is preferable that all participants in the project are informed of this strategy before the project starts in order to avoid possible conflicts.

In other cases, it might prove advisable to keep the invention confidential and to **postpone** the filing of a patent (or other IPR) application (and consequently any dissemination), for instance, to allow further development of the invention while avoiding the negative consequences associated with premature filing (earlier priority and filing dates, early publication, possible rejection due to lack of support / industrial applicability, etc.).

Although a participant does not have to formally **consult the other participants** before deciding to protect or not to protect a specific piece of foreground it owns, they should **preferably be informed**, so that they be in a position to express (and substantiate) possible legitimate interests. They should also preferably be informed after protective measures have been taken. These issues may be covered in detail within the consortium agreement or through specific separate arrangements.

The FP7 IPR provisions now state explicitly that, where a participant **does not intend to protect** its foreground, it may first offer to transfer it to another participant or even to certain third parties, which may consider it worthwhile protecting this piece of foreground, rather than leaving it unprotected and available for use by competitors (see Article 44.2 RfP : “... *and does not transfer it to another participant ...*” – similar wording exists in Article II.28.3 of ECGA).

5.1. Protection by the Commission

If valuable foreground **has not been protected**, the Commission must be informed (at the latest 45 days prior to any dissemination activity) and may protect it on behalf of the European Community, with the agreement of the participant(s) concerned¹⁸ (Article 44.2 RfP – Article II.28.3 of ECGA). More specifically, in such a case, protection measures could be taken by the Joint Research Centre, which manages the IPR portfolio of the Community.

This principle – including the obligation to inform the Commission – may be applied also by participants (1) when some foreground was protected by a participant but the owner considers abandoning the protection (e.g. by not paying the official prosecution or renewal fees for a patent application), and (2) when protection was applied for in a first country ("priority application"), but the owner does not consider extending the protection to foreign countries before the end of the priority period.

In these cases (intention not to protect, or to abandon protection of, foreground), the Commission should be informed well in advance of any applicable official deadline (such as those associated to the payment of renewal fees or with the end of the priority period); preferably with at least 2 months prior notice), so as to be able to take appropriate measures.

5.2. Specific issues relating to patent applications

When a patent application is filed, it is important that the **true inventor(s) be identified**, not only for fairness reasons, but also for legal reasons. In the USA, in particular, errors (fraud) in the designation of inventors can, under certain circumstances, lead to the invalidation of the patent. Accordingly, systematically designating a head of department as one of the inventors (a common practice in some universities) should be avoided if this does not correspond to the facts.

Patent applications concerning foreground also need to contain the following specific sentence (or a translation thereof) in the description referring to FP7 funding (Article 45 RfP – Article II.28.2 of ECGA):

The work leading to this invention has received funding from the European Community's Seventh Framework Programme (FP7/2007-2013) under grant agreement n° xxxxxx.

¹⁸ The participant concerned may refuse consent only if it can demonstrate that its legitimate interests would suffer disproportionately great harm.

Translations of this sentence in all Community languages are available on the Internet ([LINK TO BE ADDED](#)), and the wording given must be used for patent applications filed in these respective languages.

It should also be noted that the legislation of certain countries (e.g. Germany, France) states that employed inventors are entitled to a specific remuneration in respect of new patent applications filed on behalf of their employer.

6. USE OF FOREGROUND

References : Article 46.1 RfP – [Article II.29 of ECGA](#) (Euratom : Article 45.1 RfP)

The participants should use the foreground which they own, or ensure that it is used (Article 46.1 RfP – Article II.29 of ECGA). "Use" means the direct or indirect utilisation of foreground in further research activities other than those covered by the project, or for developing, creating and marketing a product or process, or for creating and providing a service. Direct utilisation is done by the participant owning the foreground (e.g. through further research or commercial or industrial exploitation in its own activities) while indirect utilisation is done by other parties (e.g. through licensing¹⁹). It is clear that commercial use must only be undertaken if it makes sense from an economic point of view. When ownership of foreground is transferred, one of the obligations to be passed on is the obligation to use the foreground concerned.

7. DISSEMINATION (INCLUDING PUBLICATION) OF FOREGROUND

References : Articles 3 and 46 RfP – [Articles II.9](#) and [II.30 of ECGA](#) (Euratom : Articles 3 and 45 RfP).

Each participant shall ensure that the foreground it owns is disseminated as swiftly as possible. However, any dissemination (including publications or on web-pages) should be delayed until a decision about its possible protection has been made (through IPR or trade secrets). The other participants may object to the dissemination activity if their legitimate interests in relation to their foreground or background could suffer disproportionately great harm.

Where dissemination of foreground does not adversely affect its protection and use, there is an **obligation to disseminate** it swiftly. Should the participants fail to do so without any justification, the Commission may disseminate the foreground without seeking permission (Article 46.2 RfP – Article II.30.1 of ECGA).

However, no dissemination of foreground may take place before a decision is made regarding its possible protection. Indeed, any disclosure, even to a single person who is not bound by secrecy or confidentiality obligations (typically someone from a different organisation outside the consortium), prior to filing for protection, can be considered as constituting a

¹⁹ Note that if access rights to other participants' foreground or background is needed this may require the consent of the participant owning the foreground or background as access right do not give the right to sub-licence unless otherwise agreed (see section 8.5 below).

disclosure detrimental to patentability, be it by written (including by e-mail) or oral (e.g. at conferences, or even to a single person) (Article 46.3 RfP – Article II.30.2 of ECGA).

Evidently, no dissemination at all may take place if it is intended to protect the foreground as a trade secret (i.e. confidential know-how).

It is recommended that confidentiality obligations (additional to Article 3 RfP – Article II.9 of ECGA) be detailed in the consortium agreement or a specific confidentiality agreement (which might even be concluded prior to submitting a project proposal). Any data which is to remain secret should be clearly labelled as **confidential** and appropriate measures should then be taken by the other participants and the Commission to maintain confidentiality, even after the end of the project (Article 3 RfP – Article II.9 of ECGA). For the dissemination of foreground subject to rules on classification, please refer to section 7.4. below.

The **other participants must be given** at least 45 days **prior notice** in writing of any planned dissemination activity (including new web-pages divulging any results attained), together with sufficient information about the intended dissemination (Article 46.4 RfP – Article II.30.3 of ECGA) to allow them to assess whether their legitimate interests could suffer disproportionately great harm in relation to their foreground or background (for example if the dissemination would disclose valuable background held as a trade secret), in which case they would have 30 days from that notification to **object** to such dissemination (Article II.30.3 of ECGA). In such cases, the dissemination activity may not take place unless appropriate steps are taken to safeguard these legitimate interests. Such steps could be omitting certain data, or postponing dissemination, until protection is obtained.

The participants may agree in writing (for example in the Consortium Agreement) on different time-limits to those set out above, which may include a deadline for determining the appropriate steps to be taken to ensure that for example **publications** relating to a specific piece of foreground are not postponed or delayed unreasonably.

Under FP7, the Commission only needs to be notified ex-ante of dissemination intentions when the foreground to be disseminated is capable of industrial and commercial application and has not been formally protected (see 5.1 above). Where this is the case, no dissemination activities can take place before the Commission has been informed (Article 44.2 RfP – Article II.28.3 of ECGA), in order to give the Commission an opportunity to protect that foreground on its own behalf.

7.1. Statement of financial support

In order to facilitate their identification by the public and the Commission, dissemination materials (e.g. publications, websites, etc.) concerning results from FP7 projects need to contain the following specific sentence, included in the EC Grant Agreement (Article 45 RfP – Article II.30.4 of ECGA):

The research leading to these results has received funding from the European Community's Seventh Framework Programme (FP7/2007-2013) under grant agreement n° xxxxxx.

Translations of this sentence in Community languages other than English are available on the Internet ([LINK TO BE ADDED](#)) and must be used where applicable.

7.2. Reporting

Any dissemination activity shall be reported in the *plan for the use and dissemination of foreground*, including sufficient details/references to enable the *Commission* to trace the activity.

With regard to scientific publications relating to foreground published before *or after* the final report, such details/references and an abstract of the publication must be provided to the Commission at the latest within two months following publication (Article II.30.4 of ECGA).

Furthermore, an electronic copy of the published version or the final manuscript accepted for publication shall also be provided to the Commission for publication purposes (cf. Article II.12.2 of ECGA) at the same time if this does not infringe any rights of third parties.

7.3. Relations with publishers of scientific journals

FP participants sometimes face problems when they consider the publication of a paper in a scientific journal. Indeed, many publishers require that the participant or author of the paper enters into an agreement with them, by which he/she would transfer/exclusively licence his/her copyright to them without allowing the author to publish it himself/herself (elsewhere) and to deposit it into an accessible repository (archive) without the publisher's agreement.

A number of remarks should be made regarding such publication agreements:

- First of all, the provisions of a publication agreement apply only to a piece of text. They do not apply to any inventions or other knowledge (mathematical models, etc.) described in that text. The use, ownership, etc. of such inventions or knowledge are not affected by the publication agreement. Some publication agreements explicitly mention that such rights are retained by the participant or author(s).
- The main provision of such a publication agreement usually relates to the **transfer of the copyright** attached to the concerned text. Although it could be considered that such transfer only prevents the author(s) of the text from publishing this specific text, it must be noted that several publication agreements provide for the transfer of "copyright in the text *and any modifications of it*", which is of course much broader and rather vague, and should therefore be avoided. However, it should not be considered that a publication (copyright transfer) agreement prohibits the publication of any further paper by the project participants regarding their project in so far as no parts of first text are used (the underlying ideas may of course be used again but must be expressed differently).
- The obligations defined in the EC grant agreement are **not affected** by any subsequent publication (or other) agreement (cf. Article 18.3 RfP – Article II.3.i of ECGA). In particular, the Commission is allowed to publish any non-confidential project results or related information, if it considers it appropriate, including by electronic means. It is the participants' responsibility to ensure that any subsequent agreement they might enter into with a publisher does not conflict with the EC grant agreement provisions (for instance Article II.30 of ECGA)).
- In many countries (including most Member States) and under the European Patent Convention, an invention is no longer patentable once it has been disclosed; therefore, special care should be exercised if the contemplated publication discloses unprotected foreground (cf. Article 46.3 RfP – Article II.30.2 of ECGA).

It is suggested that FP project participants, considering publishing results in a scientific journal, should:

- **discuss** this intention with the other participants and, if some (or all) of the foreground and/or background to be published belong to (an)other participant(s), seek its/their prior approval (as a rule, no background or foreground may be disseminated without the approval of its owner); it has to be noted that although each participant must disseminate the foreground it owns several participants may agree to disseminate jointly, as for example often occurs through co-authoring of a scientific publication);
- carefully **check** the compatibility of the EC grant agreement they have signed, with any publication agreement they are envisaging to sign;
- **inform the publisher** of the obligations resulting from the EC grant agreement (in particular Art. II.3. and II.30.4 ECGA). A contractual provision could be inserted in the publication agreement to take this into account, for example:

"The publisher agrees that the author retains the right to provide the European Commission for publication purposes with an electronic copy of the published version or the final manuscript accepted for publication."

The publisher will also have to be made aware of the statement of financial support (see 7.1 above) which must be mentioned.

Finally, if the author takes the initiative, she or he must obtain the necessary permission from the participant owning the foreground (even if said participant is the employer of the author) before submitting a paper for publication. The participants should ensure that they have internal procedures in place which ensure this as they remain liable for the fulfilment of their obligations regarding the foreground vis-à-vis the other participants (including regarding protection and dissemination).

7.4. Dissemination of foreground in security research projects

Security research projects may include classified²⁰ data or information qualifying as foreground. In order to protect the participants and to make sure that the relevant national, Community and – if relevant international - rules on handling such data or information are respected by the participants, the dissemination of foreground can be limited to specific participants or purposes.

Upon the decision of the participants – in agreement with the Commission – the dissemination of foreground subject to such legal restrictions can be extended to third parties which are not part of the consortium.

Due to the sensitive character of classified information and data, a special clause may be inserted in security research projects which – as a general rule – excludes the dissemination of foreground

²⁰ The term "classification" means the allocation of an appropriate level of security to data or information the unauthorised disclosure of which might cause a certain degree of prejudice to Community or to Member States interest. The level of classification and the treatment of classified data or information is subject to national and Community regulations, especially the Commission decision of 29 November 2001 (2001/844/EC, ECSC, Euratom), OJ L 317/1 and its amending Commission decisions (e.g. Commission Decision of 2 August 2006 (2006/548/EC, Euratom), OJ 215/38.

The term "classified data or information" means any data or information, an unauthorised disclosure of which could cause varying degrees of prejudice to EU interests, or to one or more of its Member States, whether such information originates within the EU or is received from Member States, third States or international organisations.

to parent and/or affiliate companies or any legal entity which does not form part of the consortium. The exception hereto is allowed, but only upon a joint decision of participants and Commission, taken on a case-by-case-basis.

The responsibility for classifying information lies with the originator of such information. In cases of joint development, the participants concerned are responsible for defining the appropriate level of classification. The level of classification is solely based on the content of the information and has to follow the existing security classifications established on national and Community level e.g. "restricted", "confidential", "secret", "top secret".

8. ACCESS RIGHTS – GENERAL PRINCIPLES

*References : Articles 47-51 RfP – **Articles II.31-32 of ECGA** (Euratom : Articles 46-49 RfP)*

8.1. What are access rights?

Access rights means **licences and user rights** to foreground or background owned by another participant in the project. The EC Grant Agreement's provisions relating to access rights to foreground and background constitute "minimal" provisions that, unless otherwise indicated, cannot be set aside or restricted. However, additional access rights may be granted (for example to sideground or all foreground, i.e. not only to those needed to use own foreground), as well as access rights on more favourable conditions than those required by the EC Grant Agreement (cf. Article 48.4 RfP – Article II.32.6 of ECGA). Such additional provisions may e.g. be included in the consortium agreement (cf. Article 24.1.c RfP – Article II.2.4.c of ECGA) but can also be determined in separate agreements between two or more participants.

8.2. Access rights to foreground and background

It should be noted that under the EC grant agreement **access to another participant's foreground or background is only** to be granted if the requesting participant *needs* that access in order to carry out the project or to use its own foreground.

Assessing whether or not access rights are *needed* must take place on a case-by-case basis, with all due care and in good faith. While no universal rules can be drawn up, the following situations are examples where access rights would appear to be *needed*:

- (a) without the access rights concerned, some of the R&D tasks assigned to a participant under the project would be impossible to be carried out, or significantly delayed, or require significant additional financial or human resources;
- (b) without the access rights concerned, the use of a given element of foreground by its owner would be technically or legally impossible, or would require very significant additional R&D work outside the frame of the project (in order to develop an alternative solution equivalent to that foreground or background of another participant to which access is refused).

The participants may agree (e.g. in the consortium agreement) on the interpretation of the "need-to" requirement. More broadly, as further explained below, the participants may also define

accurately which background is needed. They may even exclude specific background from the obligation to grant access.

The granting of access rights may be **refused** by the owner of the foreground or background concerned, if it considers that such access rights are not *needed* by the other participant requesting them. In such a case, this other participant will have to better substantiate its request and negotiate (in good faith) with the owner, or to withdraw its request. In case of continued disagreement, the issue will have to be solved through the applicable conflict resolution mechanisms as agreed between the participants (see also Section 19 – Useful resources).

8.3. Access rights to background

References : Article 47 RfP – **Article II.31 of ECGA** (Euratom : Article 46 RfP)

Participants can freely define in any manner (for example in a positive or negative way) what is needed for the project (i.e. background available for access by each other).

The participants can **define** what is background, i.e. what is considered to be "needed" in respect of the obligation to grant access rights. This means that they have a total flexibility to decide, for instance:

- that they wish to continue applying the regime which was applicable under FP6, according to which a participant X is able to access any background of participant Y which X needs (either for carrying out its own part of the work or for using its own foreground), with exceptions ("exclusions") hereto clearly listed (for instance the background generated by other departments of the legal entity participating in a FP7 project);
- that they prefer to use a “positive list approach”, under which only those elements which have been specifically identified/listed are available for access by the other participants.

Below are some comments relating to these two options (while noting that many other arrangements are conceivable). It should be noted that there is no requirement for participants to set up exhaustive lists of all their background.

- **Exclusion of background**

It is possible for a participant to give access to most of its background, while **explicitly excluding** some specific elements of its background from the obligation to grant access rights to other participants. Any background that is to be excluded should be defined in such a way that it is sufficiently clear to avoid uncertainty, yet broad enough to avoid detrimental disclosure if it relates to undisclosed information (example: "*proprietary know-how relating to the manufacture of X according to the process Z*").

To ensure legal certainty and transparency, thereby allowing better assessment of the benefits and burdens of launching the envisaged collaboration under the project, such exclusions, if any, should be agreed in writing by all participants, preferably before they sign the EC Grant Agreement, for instance in the consortium agreement or, if it concerns only certain participants, in a separate agreement between these participants.

It should be noted that access to another participant’s (foreground or) background is only to be granted if the requesting participant *needs* access in order to carry out the project or to use its own foreground. Therefore, in many projects, it may not be necessary to exclude any pieces of background: either they will be central to the project and should not be

excluded, or they will be remote enough that any request to grant access rights can safely be rejected.

It is possible to exclude only certain "aspects" of a specific piece of background. For instance, a pre-existing source code might be excluded while access would remain available to the executable software (to run it) ; or, access to some piece of background for use purposes could be excluded in some application areas whilst it would remain possible in other areas ; etc. Another possibility is to only temporarily exclude certain specific background (e.g. to permit the adequate protection of the background prior to providing access).

Where appropriate, the scope of exclusions may also be different for different participants.

In order to ensure that any exclusion will not hamper the proper implementation of the project, a participant should only exclude background where this is really necessary in view of its legitimate interests. This would ensure that most of the access rights which are *needed* by other participants are actually available to them. As background is by definition considered to be needed for implementation or use, the impact of such an exclusion on the project, particularly regarding an exclusion which does not have a temporary character, should be carefully examined by the participants. It is clear that if the project cannot be completed without access to the excluded background, this may, in the worst case, lead to the termination of the project.

- **"Positive list" approach**

This approach has the advantage of clearly identifying which background is available for access by the other participants. It also allows for selective availability, i.e. with access to some elements of background being available only to some of the consortium members. Furthermore, it has the advantage of making it clear for the owners of the background concerned that they must refrain from granting exclusive licences to it (see Section 8.6 below).

However, before opting for such an approach, participants should pay attention to some potential drawbacks, such as:

- risk of problems if some important elements of background are not identified as being available for access (either by mistake or by bad faith) ;
- need for (possibly difficult) re-negotiation if the scope of the project (technical annex) is substantially modified, in a way requiring the inclusion of additional background (risk of blockage and resulting termination of the project).

Variants of these approaches are possible. For instance, access rights to background may be defined as being much broader within a "work package" of a project, whereas they would be more restricted between different work packages.

Evidently, it is the responsibility of all participants to ensure that the list of "available background" they agree on is not so narrow (or inflexible) that it hampers the proper implementation of the project. This is why such a list preferably should be prepared (if at all) before the signature of the EC grant agreement.

8.4. How to request access rights?

The access rights foreseen in the EC grant agreement are not automatically granted. They must be requested in writing, which is important from an IPR management point of view. The granting of

access rights may be made conditional on the acceptance of specific conditions aimed at ensuring that these rights will be used only for the intended purpose and that appropriate confidentiality obligations are in place. If such specific conditions are attached it is preferable that these are set out in writing as well.

8.5. Do access rights give the right to sub-license?

References : Article 48.2 RfP – **Article II.32.5 of ECGA** (Euratom : Article 47.2 RfP)

In principle, the granting of access rights does not include the right to sublicense (not even to parent/affiliate companies of consortium members), unless the owner of the foreground or background at stake consented hereto.

The reason why access rights (those which are obligatory under the ECGA) do not automatically include the right to sublicense is to reduce legal uncertainty as much as possible for the participants. Indeed, if sublicensing was freely allowed, this would imply that access rights to the background and foreground of participant X could be extended, without its consent, to virtually any company in the world, including X's competitors. So even while "use" includes indirect utilisation, this rule means that access rights for use are only available to participants, unless otherwise agreed by the owner of the background or foreground concerned.

Indeed, participants are free to grant permission to sublicense (Article 48.2 RfP – Article II.32.5 of ECGA). The terms and conditions of such sublicensing must be agreed, preferably in writing. For example, this can be specified in a consortium agreement or in a separate agreement. Specific conditions can be established, for instance sublicensing can apply to the foreground (or part of it) but not the background, or to affiliates of (some of) the participants but not to other third parties. Moreover, sublicensing does not have to be royalty-free even if the access rights concerned are.

While access rights cannot be automatically sub-licensed to **affiliates** or parent companies of participants – which are third parties to the grant agreement – without the explicit consent of the participant concerned (owner/holder of the foreground or background at stake), affiliates may enjoy certain access rights – see below.

There may be other cases in which a sublicense (of foreground or background belonging to another participant) is necessary for a participant. For example, a university may need the right to sublicense²¹ to third parties to make it possible to derive value from its own foreground. In large industrial groups, on the other hand, it is quite common that research is conducted by one affiliate and exploitation by one or several other affiliates. Access rights enjoyed by the "research affiliate" but not by the exploitation affiliate(s) would pose problems for them. As the limited access rights for affiliates foreseen in the grant agreement may not suffice in circumstances such as these, more favourable sub-licensing arrangements or direct licences to such entities would appear appropriate and should not be unduly refused.

Furthermore, sublicensing is only an issue where access rights granted by other participants (to their foreground or background) are concerned. There are no rules preventing a participant to grant licenses to *its own* foreground or background to any affiliate entities, or to other third parties, with the possible exception of exclusive licences as mentioned below (Article 48.4 RfP – Article II.32.6 of ECGA).

²¹ More accurately: to sub-licence access rights it has received to foreground and/or background of other participants.

8.6. Can exclusive access rights be given to another participant or third party?

The owner of foreground and background can be considered to enjoy (and entitled to grant) quasi-exclusive rights to it, except for the obligation to provide access, if *needed* by the other participants for the purposes set out below. However, the other participants can waive their access rights to allow the owner to grant an exclusive licence.

Under FP6, the granting of "truly" exclusive licences was not possible (in the field of application targeted by the project at least), as access rights had to remain available to all participants until at least 2 years after the end of the project (for use purposes). In FP7, this duration has been reduced to one year – in addition, the participants can agree on a different (possibly shorter or longer) period (Article 50.4 RfP – Article II.34.4 of ECGA).

Moreover, an even more significant change has been introduced in FP7, namely the possibility, if all participants agree thereto, for them to **waive** their [right to request] access rights, in order to allow the owner of the foreground or background concerned to grant an exclusive licence to a third party (Article 48.3 RfP – Article II.32.7 of ECGA).

Evidently, such waivers can only be made on a case-by-case basis, after the foreground concerned has been generated. Participants should refuse to waive a whole range (or all) of their access rights until they know what their foreground is exactly and how they will use it. They should also ensure that their waiver is not broader than what is actually required for the purpose of granting the exclusive licence (regarding application fields, geographical coverage, etc.).

Note that this possibility to waive access rights also applies to background. Indeed, the granting of exclusive licences in respect of background may also conflict, in certain cases, with the obligation to grant access rights to those participants which need them (Article 48.4 RfP – Article II.32.6 of ECGA). Thus, before a participant grants an exclusive licence to its background to a third party, this participant should obtain the agreement of all other participants (regarding the definition of the background, cf. section 7.1 – Article 47 RfP).

Moreover, it may be wise that the participants agree, in such a situation, that any waiver will lapse if the intended exclusive license has not been granted within a certain period, or if the foreground or background concerned is not exploited by the licensee within a certain period.

If this new possibility (of waiving access rights in the perspective of granting an exclusive license) is not relied on, evidently, a participant is still free to grant a "quasi-exclusive" licence to a third party, i.e. subject to the possibility that another participant may request access rights if it needs them (a risk which is normally not present in areas clearly different from the one targeted by the project). Indeed, in such a case, the general obligation still applies, that access rights must remain available for all participants (Article 48.4 RfP – Article II.32.6 of ECGA). This also applies to background, which means that participants also need to be very careful about the exclusive licensing of their background to third parties.

Insofar as the granting of licences is concerned, it is obvious that competition law has to be observed (cf. Article II.3.j of ECGA).

8.7. Access rights – Possible objections

The Commission has the right to object to the granting of exclusive licences to third parties established in a country not associated to the Seventh Framework Programme if this could be detrimental to European competitiveness or inconsistent with ethical principles or security considerations. When a special clause to this effect is introduced, the Commission has to be notified of such an intended grant of an exclusive licence. The other participants have in principle no right to object.

Information to – and objections by – the Commission

Whether or not a participant notifies the Commission of its intention to grant an exclusive licence (indeed, the Commission might become aware of such cases via the regular reporting procedures or via information by other participants), **the Commission retains the right to object** to the grant of an exclusive licence to a third party established in a third country which is not associated to FP7 if it considers that this is not in accordance with the interests of developing the competitiveness of the European economy or is inconsistent with ethical principles or security considerations (Article 43 RfP ; Article II.32.8 of ECGA). Moreover, if a special clause to this effect is inserted in the grant agreement, participants are **obliged to notify the Commission** (Article 42.5 RfP; special clause 17).

When could the Commission consider that the intended grant of an exclusive licence is:

- not in accordance with the interests of developing the competitiveness of the European economy ?

For example, depending on the importance of the foreground concerned, an exclusive licence which would prohibit European researchers from further researching the foreground concerned, or which could have as effect that this foreground is not commercially available on fair and reasonable terms, could be viewed as not in accordance with the interests of developing the competitiveness of the European economy.

- inconsistent with ethical principles ?

A grant of an exclusive licence would be inconsistent with ethical principles if, as a consequence, the foreground would be used (in further research or commercially) in a way that is not in accordance with the fundamental ethical rules and principles recognised at European and international level. It is clear that if foreground is to be used in a certain country such use must respect the legislation of that country.

- inconsistent with security considerations ?

This could for example occur if the granting of such an exclusive licence could – from a security standpoint - cause foreground considered significant from a security standpoint not to be readily available on the European market or if "sensitive" foreground is intended to be transferred to third parties established in third countries that are deemed a security risk.

In case the Commission considers that it might be necessary to use its right to object, it will immediately inform the participant concerned, and request it to suspend the granting of an exclusive licence. Once it has examined the issue, it will notify the requirements for such a granting to take place. The grant of the exclusive licence shall not take place until the Commission is satisfied that the appropriate safeguards will be put in place.

Participants who have been notified of an intended granting of an exclusive licence by another participant to a third party established in a third country which is not associated to FP7 should inform the Commission of the intended granting if they have serious concerns about it (Article 18.6 RfP). This will entitle the Commission to use its right to object.

Information to – and objections by – other participants

The other participants have no right to object to an intention of granting access rights to third parties, and do not have to be notified. However, there is a general requirement for the participants to **mention** any limitation to the granting of access rights (as may be the consequence of a pre-existing agreement – such as an exclusive licence – which precludes the granting of access rights) (Article 48.5 RfP – Article II.32.3 of ECGA). The default joint ownership regime also contains a notification requirement in respect of licences granted to third parties (see Article 40.2 RfP – Article II.26.2 § 2 of ECGA).

Any agreement providing access rights (to background and to foreground) to participants and/or third parties must ensure that potential access rights for the other participants are maintained (Article 48.4 RfP – Article II.32.6 of ECGA). Accordingly, any breach of this obligation²² would conflict with the EC Grant Agreement, and might be brought to the attention of the Commission services by any participant, or invoked directly in legal proceedings between participants (or in any other dispute resolution system agreed by them).

It should be noted that Annex II to this Guide summarises the various provisions relating to prior notifications and rights to object.

8.8. Conditions for access rights: Royalty-free or fair and reasonable conditions

The conditions under which the mandatory access rights foreseen in the EC Grant Agreement must be granted vary. As set out in the following sections, depending on the reason for which access is requested, these access rights shall be granted either under fair and reasonable conditions or be royalty-free.

Royalty-free use means that the participant requesting the access rights will have access to the foreground and/or background concerned for free, if it needs such access for the purposes set out in the following sections.

Fair and reasonable conditions means appropriate conditions including possible financial terms (market conditions or other) taking into account the specific circumstances of the request for access, for example the actual or potential value of the foreground or background concerned and/or the scope, duration or other characteristics of the use envisaged (see Article 2.3 RfP ; Article II.1.6 of ECGA).

Non-financial terms could for example include a requirement for the participant requesting access to (a) grant access to other technology in its possession, or (b) agree on cooperation in a different field or in a future project.

Financial terms mean that some kind of monetary compensation must be provided to the owner of the foreground or background concerned. Such monetary compensation can for example take the

²² resulting for instance from the granting of an exclusive license – subject to possible exceptions – see section 8.6 above.

form of a lump sum or a royalty-percentage (e.g. on sales, turnover or net income) or a combination of both.

In case financial terms are involved, it may not be always possible to determine, at the moment of agreeing to these terms, what fair and reasonable financial conditions are, as the potential value of the foreground or background, and the use thereof, may not be clear. Participants could in such cases opt for an open system which allows them to take into account unexpected developments, for example by adjusting royalty percentages in case certain milestones are reached. After all, it is normally unrealistic to expect a high immediate return if the technology in question remains unproven.

To avoid disputes, it may also be in the interest of the participants, in case royalties must be paid, to define a clear method of calculation and a payment schedule, combined with an obligation to keep adequate records and a right to audit the relevant accounts.

Finally, in negotiating which access rights conditions will apply to their project participants are advised to take into account each others interests and look for benefits also in the longer term.

8.9. Access rights for implementing the project

References : Article 49 RfP – [Article II.33 of ECGA](#) (Euratom : Article 48 RfP)

Access rights may be requested by any participant if it needs them for carrying out its own work under the project, until the end of the project.

A participant can request access to another participant's background or foreground if it needs it for carrying out its own work under the project, as defined in the description of work in Annex I (the "technical annex") to the EC Grant Agreement.

These access rights may be requested until the end of the project, even from a participant who left the project before its end (Article 48.6 RfP ; Article II.32.4 of ECGA).

Access rights to background for implementing the project will be granted on a royalty-free basis, unless otherwise agreed by all participants before acceding to (or signing in case of the coordinator) the EC Grant Agreement (Article 49.2 RfP – Article II.33.2 of ECGA). And where otherwise agreed, it is advisable to avoid leaving the conditions of such access rights totally open, so as to avoid unforeseen circumstances arising later. It is highly recommended to cover these aspects in the consortium agreement. Alternatively or in addition, they may be the subject of specific arrangements between the participants concerned as, depending on the work to be performed, this may not involve all the participants.

Access rights to **foreground** for implementing the project (i.e. not for *use* – see below) must be granted on a royalty-free basis (Article 49.1 RfP – Article II.33.1 of ECGA).

8.10. Access rights for use purposes

References : Article 50 RfP – [Article II.34 of ECGA](#) (Euratom : Article 49 RfP)

Access rights for use purposes (i.e. in further research or for exploitation) may be requested by a participant only if it needs them for using its own foreground resulting from the project.

Access rights for use purposes may be requested by a participant only if it needs them for using *its own* foreground resulting from the project. In all other situations, appropriate access rights may be freely negotiated, but there is no requirement to grant them.

Access rights for use purposes, both to background and to foreground, may be granted either royalty-free, or on fair and reasonable conditions to be agreed (Article 50.1-2 RfP, § 2 – Article II.34.1-2 ECGA, § 2). Participants may of course opt for a combination of the two (for example royalty-free for further research purposes and, as is often the case, on fair and reasonable conditions for other use purposes).

Under FP7, the conditions for such access rights can be agreed at any time, which means that the choice between royalty-free and fair and reasonable conditions need not be made before the signing or acceding to the grant agreement. However, making this choice before may be preferable for reasons of legal certainty. For instance, certain potential participants may prefer to pull out of the project before it starts, rather than embarking in it under detrimental conditions (if the terms and conditions appear to be unacceptable).

Again, additional (or more favourable) access rights may be agreed between the participants.

Participants which remain in the project up to its end can request such access rights, and may be requested to grant such access rights (for use purposes), until 1 year²³ after the end of the project, unless a different period – shorter or longer – is agreed (Article 50.4.a RfP – Article II.34.3 of ECGA).

Similarly, participants leaving the project before its end can also request – and be requested to grant – access rights for use purposes during 1 year (unless otherwise agreed) after the end of their participation in the project (Article 50.4.b RfP – Article II.34.3 of ECGA).

Note that the actual duration of such access rights has to be negotiated by the participants concerned (for instance, it can extend until the expiry of a patent) and may vary between participants.

Summary of the main (mandatory) access rights

	Access rights to background	Access rights to foreground	Timing (to request access rights)
For implementing the project	Yes, if a participant needs them for carrying out its own work under the project (Article 49.1-2 RfP ; Article II.33.1-2 of ECGA)		Until the end of the project (Article 48.6 RfP ; Article II.32.4 of ECGA)
	Royalty-free, unless otherwise agreed before acceding to the grant agreement (Article 49.2 RfP ; Article II.33.2 of ECGA)	Royalty-free (Art. 49.1 RfP ; Art. II.33.1 ECGA)	
For use purposes (exploitation + further research)	Yes, if a participant needs them for using its own foreground (Article 50.1-2 RfP ; Article II.34.1-2 of ECGA)		Until 1 year (unless otherwise agreed) after the end of the project or the termination of the participant concerned (Article 50.4 RfP ; Article II.34.4 of ECGA)
	Either royalty-free, or on fair and reasonable conditions to be agreed (Article 50.1-2 RfP ; Article II.34.1-2 of ECGA)		
Notes	Provided that the participant concerned is free to grant such access rights (Article 49-50.2 RfP ; Article II.33-34.2 of ECGA)		

²³ This is a change over FP6, under which this period was at least 2 years.

	The background <i>needed</i> may be defined by the participants (Article 47 RfP ; Article II.31 of ECGA)
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8.11. Access rights for affiliates

References Article 50.3 RfP – **Article II.34.3 of ECGA** (Euratom : Article 49 RfP)

FP7 provides certain access rights to affiliated entities established in a Member State or associated country (as defined in Article 2.2 RfP – Article II.1.2 of ECGA).

Any such affiliate of a participant now enjoys access rights to foreground or background of another participant, if it is needed by that affiliate to use its own foreground. As an affiliate does not carry out any work under the project, the former will only have own foreground in the event the ownership of the foreground concerned (to be used) has been transferred from a participant to (or possibly placed in joint ownership with) said affiliate. The same conditions as for the participant to which it is affiliated, will apply.

Note that special clause 12, if included in the grant agreement, suppresses such access rights for the above-mentioned affiliates. The participants may also exclude such access rights for these affiliates by inserting a provision to this effect in their consortium agreement.

The general principle according to which the participants may agree on more favourable or broader access rights also applies here. For example, participants could agree in their consortium agreement to attach a right to sub-license to such access rights, or to grant access rights to affiliates other than those mentioned above. Other arrangements may also be foreseen, including any notification requirements which apply (for example regarding a participant's group structure or which of its affiliates will or are likely to requests such access rights).

As discussed in more detail in point 8.5, where a request for more favourable or broader access rights seems justified given the circumstances (i.e. if it could optimise the use of foreground generated under the project), it should not be unduly refused. However, it is clear that the grant of such access rights may be subject to an agreement, e.g. the consortium agreement, on the appropriate conditions, such as regarding royalties or reciprocity.

8.12. Frontier research actions (ERC projects)

References : Article 51.1 RfP

Indirect actions to support *frontier research* projects funded in the framework of the *European Research Council* are also governed by the Rules for Participation. However, they do not rely on the ECGA but on a separate "ERC grant agreement" ("ERC-GA" hereinafter). While the IPR provisions contained in the ERC-GA are similar to those of other FP7 projects, there are nevertheless a number of differences, in particular regarding access rights (cf. Article 51.1 RfP – a table summarising the some of the specific conditions applicable to access rights for ERC projects is presented below).

		Access rights to background and foreground
For implementing the project →		Royalty-free
For use	For use in further research →	

	For other use purposes (exploitation, ...) →	Royalty-free, unless otherwise agreed in the grant agreement
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8.13. "Joint research units" (JRUs)

A JRU is a structure having no legal personality, set up by two or more distinct research organisations, e.g. in order to run a joint laboratory. A typical example is the French "Unité Mixte de Recherche" structure. Since JRUs have no legal personality they cannot participate as such in FP projects. Either one of their individual "members", or several or all of them, can participate in a FP project.

If one of the members is a participant in a FP7 project, it becomes the owner of any foreground it generates. This may lead to problems if the internal arrangements governing the JRU state that any result generated within the JRU will be co-owned by all members of the JRU. In that case, care must be taken by the JRU member which is a participant as it will have to fulfil the contractual obligations, especially regarding the granting of access rights to other participants and regarding the transfer of foreground (indeed, placing foreground in joint ownership is a form of transfer).

In addition, the other participants should be informed as soon as possible of the fact that one participant is a member of a JRU (in accordance with Art. 48.5 RfP and Article II.32.3 of ECGA) and may, if necessary, make the appropriate arrangements in their consortium agreement. However, in case where a member of a JRU participates in a FP7 project and intends to use resources of (an) other member(s), a special clause is introduced in the EC grant agreement, indicating the other members of the JRU, and the work that they may contribute to the project is identified in the technical annex (Annex I to the grant agreement) (see special clause n° 10).

8.14. The common legal structure (Sole participants)

Where the grant agreement is signed by a single legal entity representing several other legal entities – a "common legal structure" (CLS), for instance an European Economic Interest Grouping (EEIG) – as foreseen in Article 10 RfP, the IPR provisions apply to this CLS and not to the individual participants which are its members. The CLS will therefore be the owner of the foreground, and the provisions relating to access rights do not apply to the members of the CLS.

However, transfer of ownership from the CLS to one of its "members" is not prohibited, provided that access rights remain available for the CLS itself and, if so agreed, for the other members.

As a consequence, it is strongly recommended that the members of a CLS that is a participant in an EC-funded project agree on specific arrangements, relating in particular to ownership and access rights issues.

9. ACTIONS FOR THE BENEFIT OF SPECIFIC GROUPS

References : Articles 41 and 51.2 RfP

Under FP7, the new category of "*actions for the benefit of specific groups*" include (1) actions for SMEs, (2) actions for SME associations²⁴, as well as (3) actions for civil society organisations ("CSOs").

The group of the SMEs, SME associations or CSOs participating in these actions is designated as "*the specific group benefiting from the action*".

In case (2), if individual SMEs are participating in a project in addition to one or more SME associations, it is essential to note that the "*specific group benefiting from the action*" includes only the SME association(s), not the individual SMEs.

Unless otherwise agreed, **foreground is jointly owned** by the participants²⁵ that are members of the *specific group benefiting from the action* (Article 41 RfP). In such case, the joint owners should agree amongst themselves on the allocation and terms of exercising the ownership of foreground, within the consortium agreement or through specific separate arrangements (see Section 4.2 on joint ownership). The default joint ownership regime (Article 40.2 RfP – Article II.26.2 § 2 of ECGA) also applies to this category of actions.

If it is agreed not to jointly own the foreground, the group must be provided with all the necessary access rights to the foreground to use and disseminate such foreground. RTD performers must grant access rights to background needed for carrying out the project on a royalty-free basis (Article 49.2 §3 RfP). Access rights to background needed to use the foreground must also be granted by the RTD performer on a royalty-free basis, unless fair and reasonable conditions have been agreed prior to the signing of the grant agreement (Article 50.6 RfP).

In the specific case of *actions for SME associations* or *CSOs*, a further provision (Article 51.2 RfP) specifies that these associations or organisations are entitled (i.e., without negotiating any separate agreement) to sub-license to their members any access rights they may have received from other participants, if these members are established in a member State or Associated country²⁶. This may indeed be necessary in the perspective of the exploitation of the results (as these associations or organisation are usually not in a position to use the foreground themselves).

In actions for SMEs and actions for SME associations, it is explicitly foreseen that the consortium must enter into an agreement (the "Transaction") regarding the ownership of foreground and access rights to be provided to any SME or SME associations and the remuneration paid to it by a RTD performer (Article III.1^{SME} of ECGA). This transaction will become part of Annex I of the EC Grant Agreement and any modification thereof is subject to approval of the Commission.

Finally, RTD Performers (the main researchers/technological developers) may be provided with access rights to foreground on fair and reasonable conditions to conduct further research (Article 50.5 RfP). These access rights may be limited to areas other than that targeted by the project.

²⁴ Under FP6, the first two categories were designated as *co-operative* and *collective* research actions respectively.

²⁵ It should be noted that a given piece of foreground will only be the joint property of those members of the specific group benefiting from the action which were in the consortium at the time the piece of foreground was generated. For instance, if one of them leaves the project before its end, any foreground generated after its departure will only be the joint ownership of the remaining ones.

²⁶ For members established in other (third) countries, sublicensing needs to be agreed on a case-by-case basis, and is not mandatory (can be refused).

The following table summarises the conditions for access rights ("ARs") applicable to *actions for the benefit of specific groups*²⁷. The limitation according to which access rights are available only if they are *needed* has not been repeated in the table but is still applicable.

	Access rights to background	Access rights to foreground
For implementing the project	Royalty-free, unless otherwise agreed before acceding to the grant agreement (Article 49.2 RfP ; Article II.33.2 of ECGA) <i>Note</i> : Access to the background of RTD Performers is always royalty-free (Article 49.2 RfP, last sentence ; Article III..... of ECGA)	Royalty-free (Article 49.1 RfP ; Article II.33.1 of ECGA)
For use purposes (exploitation + further research)	Either royalty-free, or on fair and reasonable conditions to be agreed (Article 50.1 RfP ; Article II.34.1-2 of ECGA)	
	<i>Note</i> : For ARs to be granted by RTD Performers, conditions must be agreed before acceding to the grant agreement (Article 50.6 RfP ; Article III..... of ECGA)	<i>Note</i> : ARs may be granted to RTD Performers for further R&D purposes (Article 50.5 RfP ; Article III..... of ECGA)

A full table of the access rights (for all categories of projects) is included in Annex III to this guide.

10. ELIGIBILITY OF IPR COSTS

IPR protection, dissemination and management activities are an instance of the "other activities" of a FP7 project (as referred to in Article 33.4 RfP – Article II.16.4 of ECGA). Accordingly, the Community financial contribution may reach a maximum of 100% of the total costs (direct + indirect) of these activities subject to the eligibility criteria being fulfilled. In particular, they must have been used "*for the sole purpose of achieving the objectives of the indirect action and its expected results, in a manner consistent with the principles of economy, efficiency and effectiveness*" (Article 31.3.c RfP – Article II.14.1.e of ECGA).

It is evident that costs associated with patents (or other IPRs) relating to results obtained outside of the project (e.g. in parallel with it, or after its end, or before its start) would not be eligible for Community funding.

Regarding licensing royalties, the following principles should be used as guidelines, although exceptions are possible on a case-by-case basis:

- *Royalties to be paid to a third party* (i.e. not a participant):

In principle, such royalty fees (and by extension any down payments, etc.) can be considered as being eligible if the other applicable conditions are met (necessary for the implementation of the project, etc.). On this basis, however, eligibility might be limited in specific cases, for instance regarding royalty fees with respect to an exclusive licence, unless it is demonstrated that the exclusivity (and the higher royalty fees which are likely to be associated with it) is absolutely necessary for the implementation of the project. Regarding licensing agreements which were already in force before the start of the project,

²⁷ other than the general conditions – duration, "need-to" limitation, etc. – already mentioned in the general table for access rights above.

as a rule only a fraction of the corresponding licence fees should be considered eligible, as the licence was presumably taken for reasons other than participation in FP7.

– *Royalties to be paid for access rights granted by other participants:*

As a rule, such royalty fees are eligible (during the project) if they relate to access rights granted before the start of the project, subject to the last sentence of the previous paragraph (partial eligibility), to the comments above relating to exclusivity, and to the basic eligibility criteria. For access rights granted after the start of the project, eligibility will be assessed on a case-by-case basis.

Licensing royalties received by a participant, as well as any other income resulting from the use of the foreground, must *not* be considered as a receipt of the project (Article II.17.b.ii of ECGA).

11. CONSORTIUM AGREEMENT

References : Article 24 RfP – [Article II.2.4.c.ii of ECGA](#) (Euratom : Article 23 RfP)

Participants should prepare and sign a consortium agreement before the grant agreement enters into force.

In view of the large flexibility FP7 participants have in implementing their projects, and the fact that the EC Grant Agreement sets out the basic legal requirements but not all details, it is mandatory for them to enter into a specific consortium agreement (as reflected in optional Article 1.4 of ECGA, if included), unless this has been specifically exempted by the call for proposals. Even where the consortium agreement is not obligatory, it is strongly recommended.

A consortium agreement sets out the internal management guidelines for the consortium and can, for example, provide arrangements regarding the granting of specific access rights in addition to those provided for in the standard IPR provisions (Article II.2.4.c.ii of ECGA)²⁸.

Consortium agreements can not conflict with the provisions of the EC Grant Agreement, which always prevails. They should be prepared as soon as possible, preferably before signature of (accession to) the grant agreement.

Nothing prevents the participants from preparing several consortium (sub-)agreements governing different aspects of the project (some before the signature of the grant agreement and some possibly after), or from amending their initial consortium agreement according to their needs and the evolution of the project. They may also consider preparing bilateral or other arrangements involving smaller groups of participants. Certain specific issues which are not essential at the start of the project can be negotiated later, with the advantage that the corresponding (negotiation) costs may then be considered as being eligible.

The Commission's proposed *Checklist for a Consortium Agreement* is available on its EC Grant Agreement web page²⁹. Additional information relating to consortium agreements is also available

²⁸ The [ADD NAME] has in-depth financial advice which may provide useful advice to those intending to set up a consortium – see [ADD LINK].

²⁹ [LINK TO BE ADDED].

from the IPR-Helpdesk³⁰, a project funded by the Commission to provide free of charge IPR assistance.

Since the consortium agreement involves only the project participants, the Commission is not a party to it and does not check its contents.

Relations with other agreements (Articles 18.3 and 48.4-5 RfP – [Articles II.3.i](#) and [II.32.3+6 ECGA](#))

It may of course happen that **pre-existing agreements** contain provisions regarding the granting of access rights. If such pre-existing agreements contain provisions conflicting with the EC Grant Agreement, they should be brought to the attention of the other participants and the Commission as soon as possible, preferably before the signature of the grant agreement. They should be analysed in detail by the other (future) participants, to make sure they won't interfere with the proper implementation of the project, nor with the exploitation of its results. In serious cases, this analysis may lead to changes in the composition of the consortium.

Regarding **future agreements** – to be signed with third parties *after* the signature of the EC grant agreement – no conflicting agreements may be signed subsequently (see Articles 18.3 and 48.4 RfP : "*any agreement providing access rights to foreground or background to participants or third parties shall be such as to ensure that potential access rights for other participants are maintained*" – similar wording in Article II.32.6 of ECGA). E.g., no exclusive licence relating to *foreground* or *background* may be granted to a third party as long as access rights to it can be requested by other participants (unless of course they have waived some of their access rights – see Article 48.3 RfP; Article II.32.7 of ECGA), as they might then be deprived from the possibility to request access rights.

It is also recalled that the participants must ensure that the Commission is informed of any event which might affect the implementation of the indirect action or the interests of the Community (Article 18.6 RfP; Articles II.3.f § 2 and II.8.1 of ECGA).

12. PARTICULAR RULES APPLICABLE TO EURATOM PROJECTS

IPR provisions are substantially the same in the EC Framework Programme and in the EURATOM Framework Programme. However, these two programmes are governed by two different Rules for Participation, which are not totally identical.

What follows is a summary of the main differences between both:

- Dissemination activities need to be compatible with the defence interests of the Member States (Article 45.3 of the Euratom RfP);
- These defence interests are also mentioned in Article 42 of the Euratom RfP (equivalent to Article 43 of the EC RfP), defining the cases in which the Commission may object to a transfer of foreground or to the granting of any licence regarding foreground (contrary to

³⁰ <http://www.ipr-helpdesk.org>

the EC Framework Programme, in this case the Commission may also object to the grant of a non-exclusive licence);

- Patent applications and dissemination material must contain a slightly different statement referring to the "*European Atomic Energy Community's Seventh Framework Programme (FP7/2007-2011)*" instead;
- Where relevant, special clause 11 *bis* should be used instead of clause 11;
- For activities under the thematic area "Fusion energy research", the procedures and rules for dissemination and use may be substantially redefined in the respective frameworks: Contracts of Association, European Fusion Development Agreement, etc. (see chapter IV of the Euratom RfP).

13. OTHER RELATED ACTIVITIES

The provisions relating to ownership, protection and access rights are just one part of a broader set of measures aimed at promoting the actual exploitation of projects' results. Other examples of such measures include:

- studies on socio-economic aspects: assessment of the expected socio-economic impact of the foreground and technology generated, as well as analysis of the factors that would influence their exploitation (e.g. standardisation, ethical and regulatory aspects, etc.);
- activities promoting the exploitation of the results: development of the plan for the use and dissemination of the foreground produced, feasibility studies for the creation of spin-offs, etc, take-up activities to promote the early or broad application of state-of-the-art technologies. "Take-up" activities include the assessment, trial and validation of promising, but not yet established technologies and solutions, and easier access to and the transfer of best practices for the early use and exploitation of technologies. In particular, they will be expected to target SMEs.

14. PLAN FOR THE USE AND DISSEMINATION OF FOREGROUND

Promoting the use and dissemination of FP projects results is a key objective of FP7, as mentioned in Annex I to the Decision on FP7 (Decision 1982/2006/EC³¹) and with more detail in Annex I to the Decision concerning the Specific Programme "Cooperation" (Decision 2006/971/EC³²).

IPR and related issues should be considered when preparing the proposal, since the Rules for Participation state that one of the evaluation criteria in the Cooperation and Capacities Programmes relates to the "*the potential impact through the development, dissemination and use of project results*" (Article 15 RfP).

³¹ http://eur-lex.europa.eu/LexUriServ/site/en/oj/2006/1_412/1_41220061230en00010041.pdf

³² http://eur-lex.europa.eu/LexUriServ/site/en/oj/2006/1_400/1_40020061230en00860242.pdf

Therefore, the grant agreement requires the submission to the Commission of a plan for the use and dissemination of foreground (Article II.4.2.b of ECGA), which must contain information about the expected use of the project results sufficiently detailed to permit the *Commission* to carry out any related audit (Articles II.29.2 and II.23 of ECGA). Any technical audit which may be initiated at any time and up to five years after the project can assess also the participants' plan for the use and dissemination of foreground.

Should the Commission refuse to approve (revised) reports, or consider that the use potential of the results is reduced to a considerable extent, it may terminate the project (Article II.38.1.e-g of ECGA).

15. PATENT SEARCHES

Participants may wish to perform a patent search in order to ascertain the "current state of the art" before submitting a proposal as the state of the art is a key criterion during the evaluation process.

As mentioned above, proposals for FP7 projects need to demonstrate their "scientific and technical excellence" (as well as, for the "Cooperation" and "Capacities" specific programmes, "*the potential impact through the development, dissemination and use of project results*" – cf. Article 15.1.a RfP). A particular aspect of these criteria is that proposals are (evidently) expected to possess an innovative nature. One way of demonstrating this is to identify the state of the art by conducting not only a bibliographic search in classical scientific literature but also a search in patent databases. It is clearly in the interest of the participants and the Commission to avoid duplication of research efforts and potential waste of both public (Community) and private (participants') funds.

In this context, participants in any EC-funded research project aimed at producing actual research results (new products, etc.) may consider performing a patent database search to assess the state of the art³³. A variety of such databases are available, including the free ESP@CENET database maintained by the EUROPEAN PATENT OFFICE³⁴. It is also possible to have such searches performed by experienced searchers at National Patent Offices or at PATLIB centres³⁵, by other institutions such as libraries, or by private operators.

The costs of such an initial patent search are not usually very high (e.g. less than 2000 €). In addition, such costs can be shared amongst the different participants of a given project, leading to a modest amount for each. However, such costs (incurred before the start date of the project) are not eligible and will not be refunded. Nevertheless, if additional searches of this kind are carried out (and are necessary) during the project, they may be considered eligible, depending on their necessity for implementing the project.

Taking third parties' rights into account

³³ for a general introduction to patent searches, see e.g. http://www.wipo.int/sme/en/documents/prior_art.html

³⁴ <http://ep.espacenet.com>

³⁵ see <http://patlib.european-patent-office.org/directory/overview.pl>

When a participant is considering exploiting its foreground, an infringement clearance search should be considered as a means of reducing the risks of being sued by a third party.

Where a participant considers exploiting a given technique for commercial or industrial purposes, care should be taken not to infringe existing third parties' rights.

Patent searches (as opposed to literature searches) do not only provide considerable technical information, but also make it possible to identify third parties' patents which are in force (as well as patent applications which are pending) and which may possibly prevent or limit the exploitation of the intended results of the project.

Therefore, before and/or during a project, it could be recommended to conduct or have conducted an "infringement clearance search" (also known as a "freedom of use" search or risk assessment) so as to identify potentially relevant patents and published patent applications which may cover one or the other aspect of the (intended) project results. This assessment could be carried out for all countries in which manufacturing, commercialisation, exportation or use is considered. Such assessments require specific skills and resources, including access to suitable databases and may be relatively expensive (> 2000 €) but are key in reducing potential problems and risks that could arise later (such as counterfeit). Similar consideration should be given to copyrights or any other possible exclusive rights (for instance, if the picture of a building is to be included in a brochure or on a website, the agreement of the photographer and/or of the architect(s) may be required). For more info see e.g. http://www.wipo.int/sme/en/documents/wipo_magazine/9_2005.pdf.

This section was only dealing with third parties' rights on projects' results, and in particular patentable inventions. Third parties' rights linked to names, acronyms and logos are addressed in the next section.

16. PROJECT NAMES, ACRONYMS AND LOGOS

Two main problems often arise in connection with the name or acronym of the project.

Firstly, participants should refrain from choosing and using a project name/acronym/logo which is identical or close to a trademark registered by a third party for goods and/or services in the same area. This may not be extremely important for most projects (of limited scope or duration), but it may also happen that the name/acronym of a given project becomes extremely famous. This could represent a problem if the participants have to change to a different name/acronym/logo for trademark reasons. Comprehensive trademark searches can be done by trademark agents or by certain National Patent / Trademark Offices (who often have cost-free online search engines). For a quick and cost-free search we recommend that the OHIM's search tool be used³⁶.

Problems may also appear if a participant, or one of its employees or subcontractors (this has already happened), protects the project name/logo/acronym/domain name on his/her own behalf, and does not allow the other participants to use it in their commercial activities during or (especially) after the end of the project. Such behaviour is clearly based on bad faith, but can create enormous legal problems.

If at some stage of the project the participants suspect that the name/acronym of their project may acquire substantial commercial value, they should consider the possibility of registering it as a

³⁶ Office of Harmonization of the Internal market (Trademarks and Designs) – search tool available at <http://oami.europa.eu>

trademark for the relevant products/services. In such a case, they should also agree on clear rules regarding the use of this trademark by the participants other than the owner(s) of the trademark, including after the end of the project.

To some extent, the above recommendations also apply to the names of products, processes, services, software, etc. resulting from a project, although the corresponding decisions and possible actions (such as filing a trademark registration application or a domain name) will usually concern a single participant and not the whole consortium.

Regarding the name or acronym of the project, more serious difficulties can even be faced in the case of projects/networks/etc. which are expected to remain in existence after the expiration of the EC Grant Agreement and funding. For instance in the case of Networks of Excellence, or of any other network which is expected to become self-supported after the end of the contractual period, it is important that the participants make whatever arrangements are necessary to ensure that all of them will be able to continue using the project name, logo or acronym after the expiration of the grant agreement with the Commission.

Use of the EU emblem

Insofar as logos are concerned, a few specific rules (summarised in Article II.12.1 of ECGA) should be observed in addition to the recommendations mentioned above. The EU emblem may be used only with the prior agreement of the Commission. As the European emblem is protected under article 6ter of the Paris Convention, participants are formally prohibited to register the European emblem, or any sign identical or similar to the European emblem, as a trademark. When participants are allowed to use the European emblem, they should do so in its entire and original form, and always separately from their own logo or trademark. Once the contractual relationship between a participant and the European Commission has expired, the participant should cease to use the European emblem, and withdraw its representation from any new documentation. See also Annex I to this Guide (at the end).

17. SURVIVING THE (END OF THE) EC GRANT AGREEMENT

Various provisions of the EC Grant Agreement have a limited duration (e.g. access rights). Agreements between participants may be needed to properly manage the post-contract phase.

Even after the end of the project, a number of IPR provisions remain in force (e.g. obligations regarding confidentiality (Article 3 RfP – Article II.9 of ECGA), use, dissemination (including the notification of patent applications (Article II.28.2 of ECGA)), access rights (Article 50.4 RfP – Article II.34.4 of ECGA)), as might some provisions of the consortium agreement.

However, the grant agreement provisions have a limited duration, expiration of which may lead to potential problems. For instance, if access rights for use purposes have been granted for a limited duration, a problem might occur when they lapse, since failure to renew or to extend them could bring some exploitation activities to a halt. Therefore, participants are encouraged to consider in due time if they need to agree on specific provisions for ensuring a smooth transition to the "post-contract" phase, especially as far as the management of foreground and intellectual property is concerned.

This is particularly relevant for Networks of Excellence (NoEs), since some of the joint activities are expected to result in lasting integration of the participants' activities i.e. well beyond the

expiry of the EC Grant Agreement. Therefore, participants in NoEs are strongly encouraged to agree, in due time, on provisions which would enable them to properly manage their intellectual property "post-contract". They should consider not only those provisions of the EC Grant Agreement which remain in force after the end of the project, but they should also define particular rules in their consortium agreement (or provide for a longer access request period as foreseen in Article 50.4 RfP (Article II.34.4 of ECGA) so as to clarify the ownership of and access rights to subsequent new inventions.

18. ADVANCED IPR STRATEGIES

Where appropriate, the participants (or some of them) may consider specific strategies for managing and exploiting their foreground and intellectual property, for instance by setting up:

- one or more "**patent pools**" (groups of patents or other IPRs relating to a given technology) which could be freely used or cross-licensed among themselves and/or jointly licensed to third parties; or
- a **new legal entity** which would own the intellectual property concerned and exploit it jointly, in order to manage it in a more flexible and effective way (subject to the granting of access rights and fulfilment of other commitments under the EC grant agreement); or
- clustering expertise to minimize knowledge management / technology transfer or product development costs.

Details on these aspects must be provided in the *plan for the use and dissemination of foreground*.

Such strategies may also prove helpful in ensuring continuity after the end of the project. It is clear that they need to comply with competition law. Information relating to EC competition law can be found on the Internet³⁷.

19. USEFULL RESOURCES

The Commission is providing information and assistance regarding the EC Grant Agreement:

- on the EC Grant Agreement webpage (http://cordis.europa.eu/fp7/calls-grant-agreement_en.html);
- FP7 checklist for consortium agreements ([LINK TO BE ADDED](#));
- FP7 Helpdesk (<http://ec.europa.eu/research/enquiries>).

Additional information and assistance with respect to IPR-related issues may be obtained from different sources, including:

- the [IPR HELPDESK](#),
- the [EUROPEAN PATENT OFFICE](#), (see their [e-learning modules](#))
- the [National Patent Offices](#),

³⁷ see e.g. http://ec.europa.eu/comm/competition/antitrust/legislation/entente3_en.html#technology

- the World Intellectual Property Organization (WIPO), whose [website](#) also contains specific [information for SMEs](#) ; it should also be noted that WIPO runs a [mediation and arbitration facility](#),
- the Organisation for Economic Co-operation and Development (OECD) – see in particular their [Guidelines for the licensing of genetic inventions](#).

Moreover, innovation-related information is available:

- from the [INNOVATION RELAY CENTRES](#),
- from the [GATE2GROWTH](#) project

20. ANNEX I – USE OF THE EUROPEAN UNION EMBLEM

According to the current practice, the European emblem may be used only if there is no likelihood of the user of the emblem being confused with the European Community or the Council of Europe; and if the emblem is not used in connection with objectives or activities which are incompatible with the aims and principles of the European Community or of the Council of Europe.

Permission to use the European emblem does not confer on those to whom it is granted any right of exclusive use, nor does it allow them to appropriate the emblem or any similar trademark or logo, either by registration or any other means.

Each case will be examined individually to ascertain whether it satisfies the criteria set out above. This will be unlikely in a commercial context if the European emblem is used in conjunction with a company's own logo, name or trade mark.

Furthermore, no sign including or resembling the European emblem may be registered as a trademark. This is a consequence of the protection granted by Article 6ter³⁸ of the "*Paris Convention for the Protection of Industrial Property*" to the emblems and flags of international organisations :

(1) (a) The countries ... agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorisation by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries ..., and any imitation from a heraldic point of view.

(1) (b) The provisions of subparagraph (a), above, shall apply equally to armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organisations ...

For more information, see http://europa.eu/abc/symbols/emblem/graphics2_en.htm#parties, which also provides contact details (e.g. in order to check whether a specific use of the EU emblem is in line with the above criteria).

³⁸ See http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html for the full text of the Paris Convention.

21. ANNEX II – SUMMARY OF THE NOTIFICATION REQUIREMENTS AND OF THE POSSIBILITIES TO OBJECT

	Notifications to the Commission	Objections by	Notifications to other participants	Objections by
Dissemination of foreground (incl. publications)	No (except where foreground is capable of industrial or commercial application and is not protected – Article 44.2 RfP / Article II.28.3 of ECGA)		Yes (Article 46.4 RfP / Article II.30.3 of ECGA)	
Transfer of ownership of foreground	No (except if a special clause is inserted in GA – Article 42.5 RfP – but remember Article 18.6 RfP ³⁹)	No in most cases Yes, for transfers to third parties in “non-associated” third countries (Article 43 RfP / Article II.27.4 of ECGA)	Yes – prior notice (except in case of : – “authorised” transfers to a specifically identified third party under Article 42.3 RfP / Article II.27.2 of ECGA, or – overriding confidentiality obligations such as in M&A (Article 42.3 RfP / Article II.27.2 of ECGA))	Yes, if the access rights of other participants are affected (Article 42.4 RfP)
Granting of licences to third parties		No in most cases Yes, for granting exclusive licences to third parties in “non-associated” third countries (Article 43 RfP / Article II.32.8 of ECGA)	No (except where access rights are affected (Article 48.5 RfP / Article II.32.3 of ECGA) or under the default joint ownership regime (Article 40.2 RfP / Article II.26.2 of ECGA))	No

³⁹ Article 18.6 RfP : "Participants shall ensure that the Commission is informed of any event which might affect the implementation of the indirect action or the interests of the Community."

22. ANNEX III – SUMMARY OF THE ACCESS RIGHTS

General = all cooperative projects

FRAs = Frontier research actions

ABSGs = Actions for the benefit of specific groups (in the table below, the "ABSGs" rows relate only to provisions *additional* to those applicable to general projects)

	Projects	Access rights to background	Access rights to foreground
For implementing the project	General	Yes, if a participant needs them for carrying out its own work under the project (Article 49.1-2 RfP ; Article II.33.1-2 of ECGA)	
	FRAs	Royalty-free, unless otherwise agreed before acceding to the grant agreement (Article 49.2 RfP ; Article II.33.2 of ECGA)	Royalty-free (Article 49.1 RfP ; Article II.33.1 of ECGA)
	ABSGs	Royalty-free (Article 51.1 RfP)	
For use purposes (exploitation + further research)	General	Access to the background of RTD Performers is always royalty-free (Article 49.2 RfP, last sentence ; Article III..... of ECGA)	
	FRAs	Yes, if a participant needs them for using its own foreground (Article 50.1-2 RfP ; Article II.34.1-2 of ECGA)	
	ABSGs	Either royalty-free, or on fair and reasonable conditions to be agreed (Article 50.1-2 RfP ; Article II.34.1-2 of ECGA)	
	FRAs	For further R&D : <i>royalty-free</i> For other use purposes (exploitation) : <i>Royalty-free, unless otherwise agreed in the grant agreement</i> (Article 51.1 RfP)	
	ABSGs	RTD Performers shall grant access on a royalty-free basis, or on fair and reasonable conditions to be agreed prior to signing of the grant agreement (Article 50.6 RfP)	ARs may be granted to RTD Performers on fair and reasonable conditions for further R&D purposes (see Article 50.5 RfP)