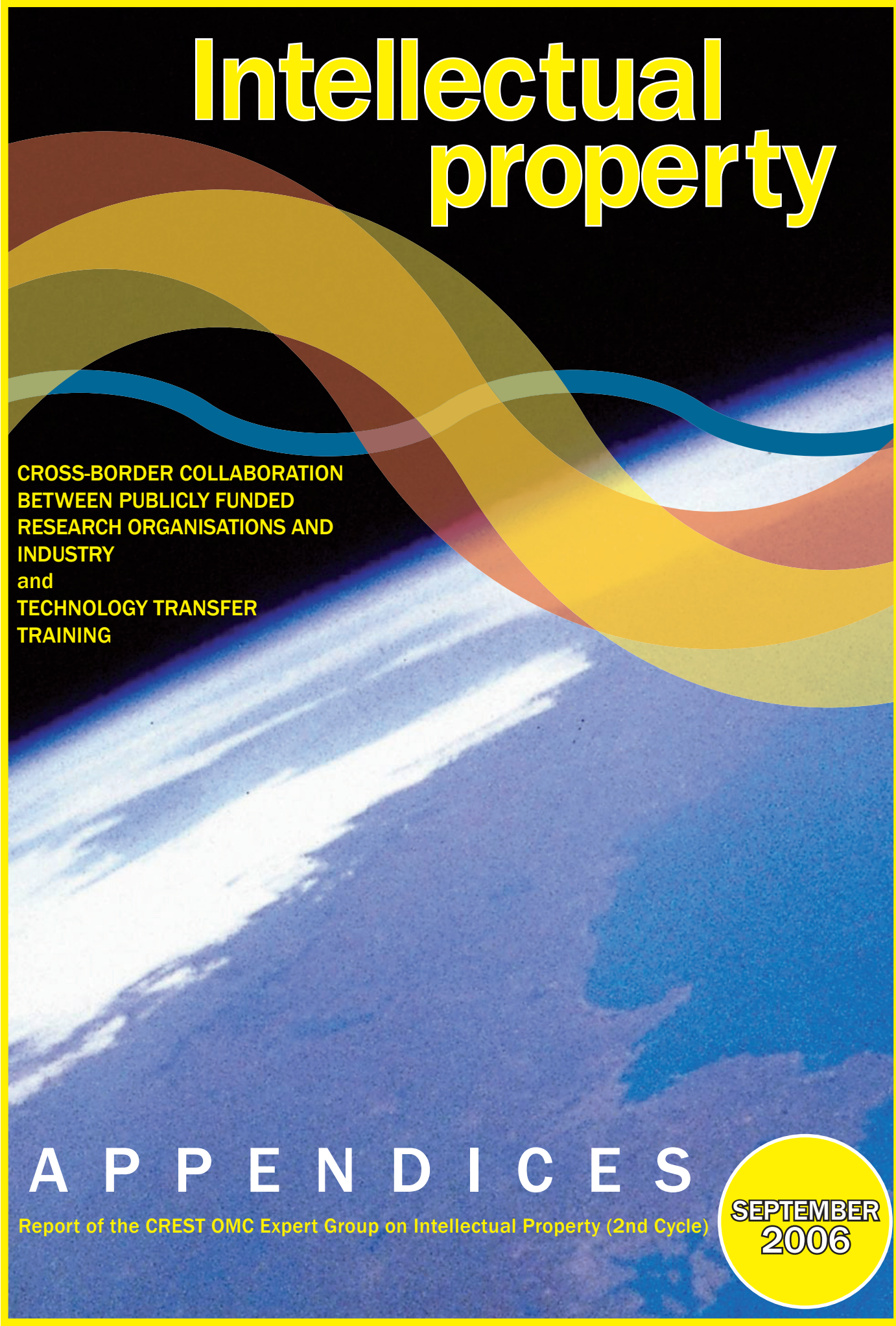


Intellectual property



CROSS-BORDER COLLABORATION
BETWEEN PUBLICLY FUNDED
RESEARCH ORGANISATIONS AND
INDUSTRY
and
TECHNOLOGY TRANSFER
TRAINING

A P P E N D I C E S

Report of the CREST OMC Expert Group on Intellectual Property (2nd Cycle)

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Appendices

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Appendix A – Presentations to the IP Group and issues raised

Part One: Presentations made to the IP Group

| Presentation Title | Organisation | Speaker(s) |
|--|---|----------------|
| An Overview of IPR in German Research | German Federal Ministry for Education and Research, IP Group Member | I. Böhringer |
| Utilisation of Rights | German Federal Ministry for Economy and Technology, IP Group Member | J. Grzondziel |
| National Codes of Practice for Managing and Commercialising IP in Ireland | Irish Office of Science and Technology, IP Group Member | P. Hennessey |
| Revising State Aid Rules | DG Research, European Commission | R. Schulte |
| Formal ministerial opening | UK Minister for Science and Innovation | Lord Sainsbury |
| The Institute of Knowledge Transfer | AURIL and IKT | P. Graham |
| Knowledge Transfer | | R. Lambert |
| Next Steps for the Responsible Partnering Initiative | EIRMA | A. Dearing |
| Cross-Border Collaboration | Pera, Ltd | I. McKay |
| Vision Structure and Present Activities | PROTON Europe | W. Lindsay |
| Objectives & Methods, Good Practices | PROTON Europe | B. Peitz |
| French Public Research and IP Training | French Ministry of Research, IP Group Member | A. Gallochat |
| Continuing Professional Development Framework for Knowledge Transfer Practitioners | AURIL | M. Haywood |
| Lambert Decision Tree and Toolkit | UK Patent Office, IP Group Member | Larry Cullen |
| Training Activities of the European Patent Academy | European Patent Academy | P. Libbrecht |
| OMC-NET proposal | Austria, Department Innovation and Technology | G. Gasteiger |
| PRO collaborations in Germany: Legal hurdles and proposed model contracts | Freshfields Bruckhaus Deringer | M. Zintler |

Part Two: Issues identified based on presentations made to the IP Group

General issues

Issues identified from presentation by Gallochat

- Implementation of a far-reaching nation-wide education programme can be effective using a partnership of industry stakeholders (LES), public bodies (INPI) and European institutions (IEEPI).

Issues identified from presentation by Libbrecht

- European Patent Academy has the resources and structure to assist in effectively disseminating the results of the IP Group's two work streams.

Issues identified from presentation by Dearing

- Industry and PROs need to be clear about their objectives for collaboration, and understand their partners' objectives.
- CREST has a role in enabling more and better cross-border collaboration by helping resolve issues relating to IPR ownership, State Aid rules, etc.
- CREST has a role in encouraging reform (attitudes, professionalism, training)

Issues identified from presentation by Lindsay and Peitz

- IP Group's more comprehensive fact sheets will provide a resource for ProTon members.
- ProTon will have a role in disseminating the results of the IP Group's two work streams to PROs.

Issues affecting Work Stream 1

Issues identified from presentation by Lambert

- The need for PROs, and national and European authorities, to see technology transfer as an extension of a PROs public duty rather than as a revenue source.
- IP issues are a significant barrier to industry/PRO collaboration.
- Model contracts (at national level) and decision tree are effective in lowering this barrier.

Issues identified from presentation by Lord Sainsbury

- It would not be practical to produce a single set of model contract provisions that could apply across Europe, but consideration should be given to adapting the Lambert Decision Tree for pan-European use.

Issues identified from presentation by Cullen

It would be practical to produce guidelines at European level (in the form of a decision tree) to facilitate cross-border collaboration by helping to resolve conflicting IP ownership aspirations.

Issues identified from presentation by McKay

- SMEs limited resources and focus on immediate business makes it difficult to get their direct participation in policy initiatives. This needs to be taken into account in planning dissemination
- Concern over IPR issues is a major inhibitor to cross border collaboration by SMEs

Issues identified from presentation by Zintler

- While various model contract modules have been published in Germany, there is no standard and collaborators will use their own contract patterns or pick those elements from the model contracts that most suit their circumstances and objectives.
- Some of these individual modules may be usefully adapted by collaborators in other countries, while other relate very specifically to conditions under German law. The “Hamburger Vertrag” represents a further approach, developed by a private law firm, to facilitate negotiations between PROs and industry under the specific conditions of German law.

Issues affecting Work Stream 2

Issues identified from presentation by Haywood

- The 6 key roles of knowledge transfer professionals require diverse range of skills: scientific and IP expertise are relatively minor parts of the required skill set.

On a national level the number of people requiring training is too low to attract professional training providers.

Appendix B – Fact sheets

1. THE FACTSHEET TEMPLATE - A CHECK LIST OF QUESTIONS

Issues to Consider when a Business in one European Country is Entering Into a Collaboration with a Public Research Organisation (PRO) from Another European Country

NAME OF COUNTRY

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in this country?

- A) E.g. Patents, Copyrights, Trademarks, Designs.
- B) Are utility models available?

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in this country?

- A) Does the PRO take responsibility for sorting out the issue of IP ownership within its organisation so that it is able to negotiate with a potential collaborator?
- B) Does ownership of IPRs at PROs in this country relate to the employment of the inventor?
- C) Does the professor or researcher have ownership rights automatically, e.g., is there a professor privilege?
- D) Does the PRO as the employer have ownership rights to the IPRs?
- E) Is it necessary to specify in the contracts that IPRs generated from work done by staff belongs to PRO, the employer or commissioner rather than the employee (or creator/inventor)? This may be more relevant to copyright, than to the other IPRs?

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in this country?

- A) Is there any legislation in this country that refers specifically to the ownership and exploitation of IPRs by PROs?
- B) Where can the text of the relevant legislation be found for this country?
 - a) Is the text of the legislation available on-line via the internet?
 - b) Is the text of the legislation available in English?
 - c) If the text is not available on-line, where/how it can be obtained?

4) Are there any differences within this country that will impact on the ownership of the IPRs?

- A) Are there differences between regions within this country that will cause a change in how IPR ownership is handled?
- B) Are there differences because of a federal system of government?

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in this country?

- A) Is there a central body that negotiates contracts on behalf of all the PROs in this country?
- B) Does each PRO negotiate its own IPR-contracts?
- C) Does the professor or researcher who carried the work that is covered by the IPR, usually a patent, have any rights in negotiating the IPR contract?
- D) Does the PRO take responsibility for sorting out the ownership issues with its staff and researchers so that it can negotiate directly with the business partner?
- E) Have postgraduate or undergraduate students been involved in the work which generated the IPRs?
- F) If so, has the PRO made the necessary arrangements to sort out the ownership issues?

6) At what terms can IPRs be obtained from PROs in this country?

- A) Is there any legal requirement to ensure that the IPR will revert back to the PRO if commercialisation is not pursued by the industrial collaborator?

7) At what price can IPRs be obtained from PROs in this country?

- A) Is there a legal requirement that IPRs that arise from research at the PRO are to be transferred to industry at market price?
- B) Does this apply if the research is funded either completely or in part by public money?

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

- A) Does the source of the funding for the research that generated the IPRs place any conditions on the ownership of the IPRs?
- B) If the funding is from a charity

9) How does funding affect exploitation of IPRs?

A) Does the source of the funding for the research that generated the IPRs place any conditions on the exploitation of the IPRs

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

A) Is there any tax arrangement in this country that will have an impact on the ownership of the IPR?

B) Is ownership of IPRs necessary to qualify for a tax credit for research & development costs?

C) Does ownership of the IPR have an effect on whether the owner will have to pay tax such as Value Added Tax (VAT)?

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

A) Are there any particular requirements in regard to PROs keeping research results confidential?

B) Are there any specific differences if the collaboration involves partners from outside your country, i.e. trans-national or cross-border collaboration?

12) Are there any particular rules or requirements regarding publication?

A) Are PROs in this country obligated by law to publish scientific results generated from research fully or partly funded by public means (i.e., by Government).

B) Are there any specific differences when it is a trans-national or cross-border collaboration?

C) Can publication of such results be delayed while an application for IP protection, such as a patent, is being made?

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in this country?

A) Do PROs in this country have an agreed policy on IPRs and business-university collaboration?

B) Is this policy available in English?

C) Is this policy available on the internet?

14) Who should I contact for more information about IPR-contracts in this country PRO?

Relevant address (e.g. email, telephone, mail) where more information can be found?

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in this country regarding where to obtain IPRs?

A) Does a patent application have to be filed at the National Patent Office of this country first before it can be filed abroad (in another EU country, the EPO or the USPTO)?

B) Where can information regarding obtaining IPRs in this country be found?

C) Is this information available on a web-site, e.g., the website of the National Patent Office?

D) Can applications for IPRs be filed electronically?

16) Who will pay for the costs of obtaining the IPRs?

A) Are there any specific arrangements available to the PRO to help them meet the costs of obtaining an IPR such as patent?

B) Are there any specific arrangements available to the SME to help them meet the costs of obtaining an IPR such as patent?

17) Who will enforce the IPRs?

A) The contract should give some information here that indicates that decisions about who will enforce the IPRs should be negotiated and specified in the collaboration agreement.

B) Which law or jurisdiction will be used if a legal dispute occurs as this agreement relates to trans-national or cross-border collaboration?

SECTION 8 Sources of Further Information

18) Where to get Further Up-to-date Information?

A) How up to date is your information about this country?

B) Do you know where to contact in this country if you have additional questions?

2. The Fact Sheets

On the following pages separate fact sheets for each country are set out.

DISCLAIMER

Neither the European Commission nor any person acting on behalf of the CREST Expert Group on Intellectual Property Rights or the Commission is responsible for the use which might be made of the following information. The content and views expressed in this report do not necessarily reflect the opinions or policies of the Member States or the European Commission.

The Fact sheets are set out in country code order as follows:

Austria, **AU**
Belgium, **BE** (Flanders Region)
Czech Republic, **CZ**
Denmark, **DK**
Finland, **FI**
France, **FR**
Germany, **DE**
Hungary, **HU**
Ireland, **IE**
Italy, **IT**
Latvia, **LV**
Netherlands, **NL**
New Zealand, **NZ**
Norway, **NO**
Portugal, **PT**
Slovak Republic, **SK**
Spain, **ES**
Sweden, **SE**
Switzerland, **CH**
United Kingdom, **UK**

AUSTRIA AU

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs) such as universities in Austria.

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in Austria?

Patents are by far the most common tools for the protection IP from Austrian PROs. Copyrights are relevant primarily in regard to software.

Trademarks, designs and utility models can also be protected according to Austrian legislation.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in Austria?

Basically, IP-ownership at Austrian PROs relates to the employment of the inventor.

According to the 2002 University Organisation and Studies Act, universities can claim right to inventions made by the institutions employees. Other PROs have to define their rights in the labour contracts. Only if there is nothing in the contracts the employee owns the IPR. Subsequently, the PRO is generally able to negotiate assignment or licensing of IPRs with industry partners or customers.

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in Austria?

An English translation of the Act is available on-line from the web-site of the Austrian Ministry of Education, Science and Arts at this link:

www.bmbwk.gv.at/universitaeten/recht/gesetze/ug02/Universitaetsgesetz_2002_inh.xml

4) Are there any differences within Austria that will impact on the ownership of the IPRs?

No.

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in Austria?

IPR-contracts must be negotiated with the PRO management in charge, and not with individual researchers. In practice, PRO managements have often authorized a patent- or technology transfer office to negotiate contracts with external partners on behalf of the institution. (Authorisation of individuals to sign contracts is published).

AUSTRIA AU

6) At what terms can IPRs be obtained from PROs in Austria?

Austrian PROs are permitted to assign or license IPRs at non-exclusive as well as exclusive conditions. However, any contract assigning exclusive rights to a single company must take into consideration that the agreed terms must not imply illegal distortion of competition or state aid to the company in question.

An organisation which claims ownership of a service invention must pay compensation to the inventor [Pat G §8(1), §9]. The amount of compensation depends on the value of the invention, not on the commercialisation results of the employer. The employer (PRO) will therefore need to ensure that any contract with an industry partner provides for the payment of adequate compensation to the employee inventor.

Within certain limits Austrian PROs are entitled to accept payment for IPRs in the form of equity in public limited companies.

7) At what price can IPRs be obtained from PROs in Austria?

In compliance with EU state-aid regulations, IPRs that arise from research which is fully or partly funded by public means are to be transferred to industry at market price – regardless of a possibly joint industry funding.

Assessment of the market price can follow various principles depending on the nature of the invention or technology in question, the expected market perspectives etc.

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

Ownership of IPR is usually integrated as a key issue of joint R&D contracts. In relation to private funding of research projects Austrian PROs are entitled to renounce in full or in part the rights of future inventions that might arise from the project. Any such renouncement or transfer of IPRs from PROs to industry should comply with market conditions. Therefore from the legal point of view funding should not influence ownership.

If an invention arises from a project funded exclusively by industry (commissioned research), it is often agreed in the contract that all IPRs should belong to the funding party. A partly funded project should not result in an exclusive and excessive transfer of rights.

If an invention arises from a project jointly funded by private and public means (co-financed research), it is often agreed in the contract that IP should belong to the inventing party.

Regarding joint inventions it is often agreed in the contract that the industry partner should have access to commercially exploit the IP.

9) How does funding affect exploitation of IPRs?

If public funding is involved, the PRO should receive a financial remuneration according to market terms.

AU, AUSTRIA

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

There are no special tax arrangements for PROs and/or their partners. So, ownership of the patent does not have an impact on the general taxation of an enterprise.

Research & development costs can be treated like investments with all the fiscal options. But this rule is not related to patenting.

Fiscal measures are only provided for the inventor's bonus (of an employed inventor) and for royalty payments to a private inventor.

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

PROs may take it upon themselves to keep confidential on specific background knowledge (including trade secrets) obtained from the private project partner as part of a joint R&D-project. It is common practice to agree on confidentiality on industrial background knowledge as part of joint R&D contracts.

In regard to confidentiality on research results, please note comments on the requirements for publication at Austrian PROs.

12) Are there any particular rules or requirements regarding publication?

No, but Austrian PROs are measured on the basis of their published scientific results generated from research funded fully or partly by public means. This puts high pressure on the PROs towards publication.

In case of research funded exclusively by an external customer, it could be agreed in the contract that results from the project in question are not to be made public at any time.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in Austria?

Austrian PROs are free to set up any contract they feel comfortable with. There is no common standard available. Most of the PROs use their own non-harmonised standards.

14) Who should I contact for more information about IPR-contracts in Austrian PROs?

Relevant contact persons for all PROs can be found at the web-site www.uniinvent.at/.

AU, AUSTRIA

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in Austria regarding where to obtain IPRs?

Patent applications resulting from joint R&D-projects with Austrian PROs could be filed optionally at the Austrian Patent Office or at any international patent authority. Information regarding services of the Austrian Patent Office is available in English at the web-site www.patentamt.at/Content.Node_opa_internet/Home/index1.html

16) Who will pay for the costs of obtaining the IPRs?

Financing of patenting costs is usually an integrated issue of joint R&D contracts. Austrian PROs will generally expect for the industrial partner to pay the cost for protecting IP that might arise from a joint R&D project. There are special programs supporting PRO in financing IPR.

17) Who will enforce the IPRs?

The general policy of Austrian PROs is to limit their responsibility as much as possible. The institutions, therefore, will rarely agree to a contractual obligation to defend a patent. However, providing assistance in connection with infringements is often agreed to. Possibilities to enforce patent rights exist. Decisions depend on the PROs risk assessment. Programmes to support exist.

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

The stakeholders for all PROs can be found at the web-site www.uniinvent.at/.

19) Where to get Further Up-to-date Information?

Last edited December 5th, 2005

Relevant contact persons for all PROs can be found at the web-site <http://www.uniinvent.at/>.

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BELGIUM, BE (Flanders Region¹)

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs) such as universities in Flanders

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in this country?

Besides the classic IPRs (patents, plant breeder's rights, copyright, trademark, designs) there are specific protection regimes for databases and semiconductors. Trademark and design protection can only be obtained by following a uniform Benelux procedure which results in a Benelux Trademark (valid in the Benelux member states) or in a Benelux Design. The Benelux Trademark is ruled by the Uniform Benelux Law on Marks of 1962 and the Benelux Design is ruled by the Uniform Benelux Design Law of 1965.

The utility model is available in the national patent law. The patent system is based on the “first-to-file” principle; there is no “grace period” for patent applications. The procedure for pure Belgian patent applications is a formal procedure (cf. the Netherlands, France) in a sense that it has only a search phase and no examination phase. This means that the patent will be delivered even if the search report is pertinent negative. Basic law is the patent act of 28 March 1984.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in this country?

Basically, IP-ownership at Flemish university PROs relates to the employment of the inventor. This principle has been brought into the Act on the Universities of 1991 in 1998 (the Universities Decree). A new article 169ter in this act says now that the commercial rights of the inventions made by the employees of the universities during the exercise of their research belong to the universities. The same goes for inventions made by beneficiaries of different kinds of public funded scholarships. Inventions must be understood as inventions that could be protected by a patent, breeding products, drawings and models, semi-conductors, computer programs and databases, which could be used for an industrial or an agricultural application for a commercial purpose.

Subsequently, the PRO can negotiate assignment or licensing of IPRs with industrial partners or customers.

At the interuniversity PROs the individual employment contract will give the IPR's to the employer. Interuniversity PROs do not fall under the application of the Universities Decree.

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in this country?

For the Flemish universities the matter of ownership and exploitation of IPRs is ruled in the Universities Decree of 1991 as revised in 1998 (art. 196ter). The other PROs must take into account the general legal regime as settled in the

BELGIUM, BE (Flanders Region¹)

basic laws (patent act of 1984, copyright act of 1994, etc.). This means that at the interuniversity PROs the individual employment contract will give the IPRs to the employer.

Another important act in the cooperation between Flemish PROs and enterprises is the Decree of 1995 on research and service contracts. This act stipulates that such contract must provide an equitable return to the PRO in case of commercialisable results. Again this act settles only the case of the university PROs (but also of the schools of higher education). This equitable return could be a financial compensation but also co-ownership.

The mentioned legal texts can be looked up at www.juridat.be/cgi_loi/wetgeving.pl (federal regulation) and at <http://212.123.19.141/> (regional regulation).

4) Are there any differences within this country that will impact on the ownership of the IPRs?

Yes, as education and research belong to the competence of the regional authorities, the IPRs related to these matters are settled in regional acts (e.g. the already mentioned Flemish Universities Decree of 1991).

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in this country?

Cooperation contracts (with IPR aspects) must be negotiated with the PRO management, and not with the individual researchers. The university PROs have technology transfer offices to negotiate contracts with external partners on behalf of the institution.

6) At what terms can IPRs be obtained from PROs in this country?

In the strict sense there is no Flemish or Belgian regulation that sets out the conditions for the transfer of results from research at the PROs to the industry. Ownership of IPR is usually integrated as a key issue of joint R&D contracts. The ownership of the IP in contract research is determined by the volume of the financing, the input of background know-how and the party that is generating the knowledge. Industry and PROs are more and more interested in a regime of co-ownership – without accounting (= sharing of property rights). The most important issue for both is that they can use the research results in their respective activities. Although there are some general ideas about the IPR regime in the different kinds of cooperation the IPR aspects in contract research are settled on a case by case basis.

7) At what price can IPRs be obtained from PROs in this country?

In the strict sense there is no Flemish or Belgian regulation that sets out the conditions for the transfer of results from research at the PROs to the industry. Neither are there legal texts containing an obligation to pay the market price at a transfer of the results from research done at PROs in the case the research is funded by public means. There is nevertheless regulation (Decree of 1995) that applies to the R&D cooperation between universities and industry. A basic principle

BELGIUM, BE (Flanders Region¹)

in this text is that collaboration with a PRO means that this collaboration must be executed in respect of the academic mission of the PRO. This has consequences for the further use of the results for education (public colleges), fundamental/basic research, research for third parties, scientific publications.

The fact that the project is funded by public means does not have much influence on the question of the ownership of IPRs and/or related (exclusive/non-exclusive) access rights. Much more important is the question whether the project is initiated by industry or by a PRO and thus fits within their mission. Other distinctive factors are the volume of financing brought in by one of the partners, the input of background knowhow and the generation of knowledge. Of course every supporting regime has its eligibilities and requirements and enterprises will only get grants for industrial project applications. The funding public authorities control whether an industrial funded project is executed and afterwards exploited in respect of the specific supporting program and can eventually sanction the executing enterprise. A common principle in the Flemish public funded innovation programs is that a substantial share of the exploitation of the results must be situated in - or return to - the Flemish region.

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

In the strict sense there is no Flemish or Belgian regulation that sets out the conditions for the transfer of results from research at the PROs to the industry. Neither are there legal texts containing an obligation to pay the market price at a transfer of the results from research done at PROs in the case the research is funded by public means. There is nevertheless regulation (Decree of 1995) that applies to the R&D cooperation between universities and industry. A basic principle in this text is that collaboration with a PRO means that this collaboration must be executed in respect of the academic mission of the PRO. This has consequences for the further use of the results for education (public colleges), fundamental/basic research, research for third parties, scientific publications.

Another important legal element in the Decree of 1995 on research and service contracts is that such contract must provide an equitable return to the PRO in case of commercially exploitable results. Again this act settles only the case of the university PROs (but also of the schools of higher education). This equitable return could be a financial compensation but also co-ownership.

The fact that the project is funded by public means does not have much influence on the question of the ownership of IPRs and/or related (exclusive/non-exclusive) access rights. Much more important is the question whether the project is initiated by industry or by a PRO and thus fits within their mission. Other distinctive factors are the volume of financing brought in by one of the partners, the input of background know-how and the generation of knowledge. Of course every supporting regime has its eligibilities and requirements and enterprises will only get grants for industrial project applications. The funding public authorities control whether an industrial funded project is executed and afterwards exploited in respect of the specific supporting program and can eventually sanction the executing enterprise. A common principle in the Flemish public funded innovation programmes is that a substantial share of the exploitation of the results must be situated in - or return to - the Flemish region.

The settlement of the ownership of research results from research done at PROs becomes more and more a regime wherein different rights (ownership and access

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rights) are to be negotiated on a case by case basis and taking into account the party's needs and missions. For the PROs it is important that their academic mission is respected, for the industry it is important that they apply the specific results related to their business and exploit them.

9) How does funding affect exploitation of IPRs?

Organisations who apply for financial support by IWT (Flemish governmental institution for the promotion of innovation) whether they are enterprises or PROs can only get approval for their project applications if they have a sufficient score not only for the scientific-technological project but also for the utilisation or exploitation plans. It is important that the utilisation or exploitation of the research results is situated – mainly – in the Flemish region. Both commitments, the commitment to execute the scientific-technological project and the commitment to fulfill the exploitation of the research results are nevertheless obligations of effort and not obligations of result.

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

There are fiscal measures related to the employment of researchers for PROs and for enterprises which have R&D cooperation projects with PROs.

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

The appropriate clauses in the Flemish Decree of 1995 on research and service contracts are based on the academic liberties and more in particular on the principle of the academic freedom of publication. The respective clauses stipulate that research and service contracts must settle the freedom of publication of the researchers. Moreover exception on this freedom is only allowed in the sense of a reasonable delay.

12) Are there any particular rules or requirements regarding publication

See answer to question 11 above.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in the Flemish region?

Although the absence of general agreed principles about the industry-university collaboration the Flemish Decree of 1995 on research and service contracts treats some basic elements of those cooperation contracts (e.g. academic liberties, freedom of publication, equitable return, price-fixing).

BELGIUM, BE (Flanders Region¹)

14) Who should I contact for more information about IPR-contracts in the Flemish region?

Contact individual PROs.

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in Belgium regarding where to obtain IPRs?

There are no specific rules for PROs for obtaining IPRs. More ample information about the specific IPRs and their procedures and protection modalities can be found at following websites:

- National Patent Office of Belgium (www.mineco.fgov.be) and in particular http://www.mineco.fgov.be/intellectual_property/patents/legislation_fr.htm
- Benelux Trademarks Office (www.bmb-bbm.org/)
- Benelux Designs Office (www.bmb-bbm.org/index-mod.htm)

16) Who will pay for the costs of obtaining the IPRs?

There are no specific arrangements to assist PROs or SMEs to obtain IPRs.

17) Who will enforce the IPRs?

The general policy of Flemish PROs is to limit their responsibility as much as possible. The institutions, therefore, will rarely agree to a contractual obligation to defend a patent. However, providing assistance in connection with infringements is often agreed to.

The applicable law and jurisdiction is indicated by the international private law which is mainly based on European law.

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

19) Where to get Further Up-to-date Information?

Last updated: May2006.

You could contact Kristel Allewijn at IWT (ka@iwt.be). She is contact person of the Flemish PROs at IWT.

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THE CZECH REPUBLIC, CZ

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in the Czech Republic

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in the Czech Republic?

Industrial Property Office of the Czech Republic:

- Results of technical creative work - patents and utility models, topography of semiconductor products
- Subjects of industrial designing - industrial design,
- Trademarks

Ministry of Culture of the Czech Republic:

- Copyright

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in the Czech Republic?

IP-ownership at the Czech Republic's PROs relates to the employment of the inventor. The employer shall exercise the right to the patent, utility model or design vis-à-vis the inventor in writing, within a time limit of three months from the inventor's written notification. If the employer shall not exercise the right, this right shall pass back to the inventor. In the Czech Republic is not a professor privilege. PRO takes responsibility for sorting out the issue of IP ownership within its organisation so that it is able to negotiate with a potential collaborator.

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in the Czech Republic?

For a list of the Laws related to the IPR (in English):

http://isdvapl.upv.cz/servlet/page?_pageid=82,114&_dad=portal30&_schema=PORTAL30

www.mkcr.cz/article.php?id=1158

www.vyzkum.cz/FrontClanek.aspx?idsekce=632

4) Are there any differences within the Czech Republic that will impact on the ownership of the IPRs?

No.

THE CZECH REPUBLIC, CZ

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in the Czech Republic?

IPR-contracts must be negotiated with the management of the individual PRO. PRO takes responsibility for sorting out the issue of IP ownership within its organisation so that it is able to negotiate with a potential collaborator. Czech PROs are permitted to license IPRs.

6) At what terms can IPRs be obtained from PROs in the Czech Republic?

Czech PROs are permitted to license IPRs.

7) At what price can IPRs be obtained from PROs in the Czech Republic?

IPRs arising from research at the PRO are to be transferred to industry at market price if the market price could be clearly determined.

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

In research collaboration projects the ownership of joint inventions is an integrated issue of the individual contract.

9) How does funding affect exploitation of IPRs?

In research projects the exploitation of IPRs is an integrated issue of the individual contract.

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

No.

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

The particular rules or requirements regarding confidentiality depend on conditions in IPR-contract.

12) Are there any particular rules or requirements regarding publication?

PROs are not obligated by law to publish scientific results generated from research.

THE CZECH REPUBLIC, CZ

There are no specific differences when it is a trans-national or cross-border collaboration.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in the Czech Republic?

Available in at:

www.vyzkum.cz/FrontClanek.aspx?idsekce=8321 (Czech)

www.vyzkum.cz/FrontClanek.aspx?idsekce=8320 (English)

www.msmt.cz/files/vedaavyzkum/legislativa/act130_2002.htm (R&D Support Act, 2002)

14) Who should I contact for more information about IPR-contracts in the Czech Republic's PROs?

Relevant address (e.g. email, telephone, mail) where more information can be found?

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in the Czech Republic regarding where to obtain IPRs?

Patent Application for the Czech Republic can be filed optionally at Industrial Property Office of the Czech Republic or the European Patent Office. Both Czech a European patent applications can be filed electronically. Applications can also use the PCT route

Patent application does not have to be filed at Industrial Property Office of the Czech Republic first before it can be filed abroad.

Information regarding the services provided by Industrial Property Office of the Czech Republic in English is available at:

http://isdvapl.upv.cz/servlet/page?_pageid=82,112&_dad=portal30&_schema=PORTAL30&445__102.menu_f=4256&446__102.folder_f=16325

16) Who will pay for the costs of obtaining the IPRs?

Financing of patent costs is an integrated issue of IPR-contracts

17) Who will enforce the IPRs?

Owners of the IPRs, and others whose rights (IPR) have been infringed.

THE CZECH REPUBLIC, CZ

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

19) Where to get Further Up-to-date Information?

Last updated: December 2005

Industrial Property Office of Czech Republic www.upv.cz

Sarka Jandova, Industrial Property Office of the Czech Republic, A. Cermaka 2a,
160 08 Prague 6, Czech Republic

sjandova@upv.cz

Frantisek Hronek, Ing, CSc., the Office of the Government of the Czech Republic,
Vladislavova 4, 110 00 Prague 1

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DENMARK, DK

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in Denmark.

SECTION 1. Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in Denmark?

Patents are by far the most common tools for the protection IP's from Danish PROs. Copyrights are relevant primarily in regard to software.

Trademarks, designs and utility models are also available under Danish legislation.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in Denmark?

Basically, IP-ownership at Danish PROs relates to the employment of the inventor. According to The 1999 Act on Inventions at Public Research Institutions PROs can claim right to inventions made by the institutions employees. Subsequently, the PRO can negotiate assignment or licensing of IPRs with industrial partners or customers.

In regard to software PROs are accorded ownership of rights by The 2003 Consolidated Act on Copyright.

Identical regulation on IP ownership is valid for Danish universities, government research institutions and public hospitals.

With few exceptions PhD students at Danish universities have status as employees of the institution. Consequently these are usually covered by the 1999 Act on Inventions at Public Research Institutions. Other students are not and therefore have all rights to their own inventions.

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in Denmark?

An English translation of the Act on Inventions at Public Research Institutions is available on-line from the web-site of The Danish Ministry of Science, Technology and Innovation at this link:

www.videnskabsministeriet.dk/cgi-bin/doc-show.cgi?doc_id=20047&doc_type=22&leftmenu=1

4) Are there any differences within Denmark that will impact on the ownership of the IPRs?

No.

DENMARK, DK

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in Denmark?

IPR-contracts must be negotiated with the PRO management, and not with individual researchers. In practice, PRO managements have often authorized a patent- or tech trans office to negotiate contracts with external partners on behalf of the institution.

6) At what terms can IPRs be obtained from PROs in Denmark?

Danish PROs are permitted to assign or license IPRs at non-exclusive as well as exclusive conditions. However, any contract assigning exclusive rights to a single company must take into consideration that the agreed terms will not imply illegal distortion of competition or state aid to the company in question.

Within certain limits Danish PROs are entitled to accept payment for IPRs in the form of equity in public limited companies.

A) Danish PROs are obliged by law to actively pursue commercial exploitation of IP that arises from the research of the institution. For this reason PROs will usually require a clause in IPR-contracts with industry for IPRs to be reverted to the institution, if commercialisation is not diligently pursued by the licensee or assignee.

7) At what price can IPRs be obtained from PROs in Denmark?

In compliance with EU state-aid regulations, IPRs that arise from research, which is fully or partly funded by public means, are to be transferred to industry at market price.

Assessment of the market price can follow various principles depending on the nature of the invention or technology in question, the expected market perspectives etc. Various methods of valuation practiced by Danish PROs are described at the web-site www.techtrans.dk. Furthermore, a professional tool "IPscore®" for valuation of IPR is available from the Danish Patent Office.

In addition to this, the payment for IPRs is basically a matter for negotiation. For example, in case of joint research projects the financial contribution of the industrial partner for the research carried out by the PRO might be taken into consideration when negotiating payment for the transfer of IP to this partner.

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

Ownership of IPR is usually negotiated as an integrated issue of joint R&D contracts. In relation to research collaboration or private funding of research projects Danish PROs are entitled to renounce in full or in part the rights of future inventions that might arise from the project. Any such renouncement or transfer of IPRs from PROs to industry should comply with market conditions.

DENMARK, DK

If an invention arises from a project funded exclusively by industry (commissioned research), it is often agreed in the contract that all IPRs should belong to the funding party.

If an invention arises from a project jointly funded by private and public means (co-financed research), it is often agreed in the contract that IP should belong to the inventing party.

Regarding joint inventions it is often agreed in the contract that the industrial party should have access to commercially exploit the IP.
However, if public funding is involved, the PRO should receive a financial remuneration according to market terms.

9) How does funding affect exploitation of IPRs?

Exploitation of IPRs is usually negotiated as an integrated issue of R&D contracts. If the industry partner contributes financially to the research carried out by the PRO, it is often agreed that this partner will have access to commercially exploit the IP generated by the PRO. The range of this access and terms of exploitation would depend on the individual circumstances.

10) Are there any fiscal measures that impact on funding or ownership of IPRs? No.

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

According to Danish legislation PROs may take it upon themselves to keep confidential on specific background knowledge (including trade secrets) obtained from the private project partner as part of a joint R&D-project. It is common practice to agree on confidentiality on industrial background knowledge as part of joint R&D contracts.

In regard to confidentiality on research results, please note comments on the requirements for publication at Danish PROs.

12) Are there any particular rules or requirements regarding publication?

Danish PROs are obliged by law to publish scientific results generated from research funded fully or partly by public means.

In case of jointly funded research the publication of results could be postponed with regard to the protection of IPRs if this is contractually agreed upon in advance. Otherwise, such delay could not exceed a period of two month from the date of notification, unless this is subsequently agreed upon with the individual researchers in question.

In case of research funded exclusively by an external customer, it could be agreed in the contract that results from the project in question are not to be published at any time.

PhD students at Danish PROs are obliged to defend their PhD thesis by a public presentation. If necessary for the protection of IPRs the PRO may decide to

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postpone this defense for a limited period of time. However, such postponement would require a mutual agreement among the parties involved. This would apply even, when the research is funded by a private sponsor.

13) Where can I learn more about IPR-contracts in Denmark?

Information regarding PRO policy on IPRs is available in English at the web-site www.techtrans.dk

A guideline for research co-operation between universities and companies has been published jointly by The Danish Rectors Conference and The Confederation of Danish Industries. The document “Contracts, contacts and codices – Research co-operation between universities and companies” is available on-line via www.techtrans.dk

A guideline for teaching hospitals entering into research agreements is also available on-line via www.techtrans.dk

Please note that these guidelines are not official documents acknowledged by legal authorities.

14) Who should I contact for more information about IPR-contracts in Denmark's PROs?

Relevant contact persons for all PROs can be found at the web-site www.techtrans.dk

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in Denmark regarding where to obtain IPRs?

Patent applications resulting from joint R&D-projects with Danish PROs could be filed optionally at the Danish Patent Office or at an international patent authority. Patent applications can be filed electronically at the Danish Patent Office. Information regarding this and other services of The Danish Patent Office is available on-line at www.dkpto.dk

16) Who will pay for the costs of obtaining the IPRs?

Financing of patenting costs is usually negotiated as an integrated issue of joint R&D contracts. Danish PROs will generally expect for the industrial partner to pay for or reimburse the cost for protecting IP, if this partner is due to exploit the IP that arise from a joint R&D project.

Various programs are available for funding of joint R&D projects and might allow also for funding of patent costs. Information on current programs is available on-line at www.vidensamarbejde.dk (in Danish only) and www.fist.dk

17) Who will enforce the IPRs?

The general policy of Danish PROs is to limit their responsibility as much as possible. The institutions, therefore, will rarely agree to a contractual obligation to defend a patent. However, providing assistance in connection with infringements is often agreed to.

DENMARK, DK

For trans-national R&D-co-operation it is common practice to specify in the contract which law or jurisdiction will be used, if a legal dispute should occur.

SECTION 8 Consultation and Updates

18) What stakeholders were consulted when preparing this fact-sheet?

19) Date when fact sheet was last updated?

12th June, 2006.

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FINLAND, FI

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in Finland.

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in Finland?

Patents, Copyrights, Trademarks, Designs.
www.ktm.fi/index.phtml?l=en&s=862

Utility models are available

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in Finland?

Basic rule: the inventor is the owner of the IPR. The organisation might get the ownership according to the Employee Invention Act.

At the university, inventor owns his/her IP if there is no agreement. Normally at the collaborative projects university and researchers make agreements to transfer the ownership to the university. Inventor must notify his/her invention to university/ employer who has right to get ownership to invention. The situation is although changing and this will be legislated.

By virtue of the Act on the Rights in Inventions made at Higher Education Institutions, research at universities is divided into open research and commissioned research. Then the university administers the rights to inventions made within research projects based on contracts concluded with external cooperation partners or on other external funding. In such a situation, the university is entitled to acquire the rights to the invention. This legislation was adopted in May 2006 and will come into force on 1st January 2007.

In collaborative research the basic principle is that each partner in the collaboration will own the intellectual property it has created during the project. Joint ownership would only apply to cases where it is not possible to identify which of the partners has created it, in which case those partners that have created it together would jointly own it.

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in Finland?

Tekes is the main funding organisation of collaborative research. Their rules are at the web-site www.tekes.fi/eng/

4) Are there any differences within Finland that will impact on the ownership of the IPRs?

No.

FINLAND, FI

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in Finland?

IPR-contracts must be negotiated with university administration, and not with individual researchers. In practice, universities have technology transfer offices to negotiate contracts with external partners on behalf of the institution.

6) At what terms can IPRs be obtained from PROs in Finland?

The following rules concern the collaborative research, which has got funding from public funding organisation.

In successfully collaborative research the owner can sell or licence the ownership to the other parties. Terms and price policy will be agreed in advance. Normally the industry partner has priority to purchase or licence rights. If industry is not interested in, the owner or the rights is free to sell it to the third party. Look at the price policy from the previous point.

7) At what price can IPRs be obtained from PROs in Finland?

Following rules concern the collaborative research, which has got funding from public funding organisation:

Selling happens at market price.

In successfully collaborative projects the owner can licence or sell the IPR to the other parties. The value of intellectual contributions will be assessed. The price of licensing depends on others' contributions. All transfer of IPR will be based on full market price. However, the actual transfer price will be calculated by reducing the full market price by the value of the receiving partner's contribution to the collaborative project in which the transferred IPR has been created. This will apply to the transfer of all types of rights, including exclusive ownership, exclusive and non-exclusive rights to use for commercial purposes, exclusive and non-exclusive rights to sell the IPR further and exclusive and non-exclusive rights to use in further R&D. Furthermore, the rules should not limit this calculation to financial contributions only, since the value of intellectual contributions might in many cases be much higher.

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

The following rules concern the collaborative research, which has got funding from public funding organisation. The rules have been agreed between partners, institutions, universities and industry and entered into force by funding organisation Tekes. Tekes is the main funding organisation in Finland.

In the collaborative research the basic principle is that all partners in the collaboration own the intellectual property they have created during the project. Joint ownership would only apply to cases where it is not possible to identify which of the partners has created it.

FINLAND, FI

9) How does funding affect exploitation of IPRs?

External funding speed up exploitation. Look at 7 and 8 above.

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

No.

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

Unless otherwise agreed, the inventor must not publish the research outcome in a manner that would jeopardise the protection or other exploitation of the invention according to HEI (the Act on Right in Inventions made at Higher Education Institutions) Inventor must not file a patent application for an invention made in commissioned research or otherwise dispose of an invention, unless the HEI informs the inventor in writing that the HEI will not acquire rights in the invention or will give the inventor the permission to patent his/ her invention. The HEI must not disclose the information given to it about the invention until the invention has been protected in a sufficient manner and there are no other particular reasons for confidentiality.

Trade secrets accepted and respected, but need an agreement.

12) Are there any particular rules or requirements regarding publication?

Open research: results normally be published (Fully funded by public money)
Commissioned or Collaboration research: the publication of results made by the university partner could be postponed with regard to the protection of IPR's. The delay should be agreed in advance with the researchers involved.

Contract research: In case of research funded exclusively by an external customer, it could be agreed in the contract that results from the project in question are not to be made published at any time.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in Finland?

Tekes is the main funding organisation. Look at their rules at the web-site <http://www.tekes.fi/eng/>

14) Who should I contact for more information about IPR-contracts in Finland's PROs?

Most of the universities have Technology transfer offices and they will help you. For example <http://oiic.tkk.fi/index.html>

FINLAND, FI

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in Finland regarding where to obtain IPRs?

Patent applications resulting from joint R&D-projects could be filed optionally at the Finnish Patent Office or at an international patent authority.

Information regarding services of the Finnish Patent Office is available at the web-site www.prh.fi/en.html

16) Who will pay for the costs of obtaining the IPRs?

The owner of the results basically apply and decide how the patenting process should be handled and if it is university, it normally try to get industry partners to be interested in the results and contribute a part of the patenting payments.

17) Who will enforce the IPRs?

The owner will enforce IPRs or defend IPR against illegal use. All depend on how the partners have agreed on terms.

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

Ministry of Trade and Industry; www.ktm.fi/index.phtml?l=en&s=862

19) Where to get Further Up-to-date Information?

Last updated 22.6.2006.

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FRANCE, FR

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in France.

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in France?

Generally speaking all rights constituting Intellectual Property: patents, trademarks, industrial designs, and copyright. There is also a Certificate of utility (“small” patent), the duration of which is 6 years from its filing date. Other technical creations can be protected for new plant varieties (Certificat d’obtention végétale – COV) and topography of a semiconductor product.

Software, as such, cannot be patented but can be protected by copyright. A French patent cannot be obtained directly through a PCT application but through the European patent system (Euro-PCT).

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in France?

As a principle, IP-ownership is vested in the inventor or the assignee (employer for instance) of said inventor.

There are specific provisions for the salaried persons both in the private sector and in the public one (civil servants and assimilated persons) when they are inventors:

- a) inventors fulfilling their duties (“service inventions”): the right to the patent is up to the employer (PROs)
- b) inventors who have not any research mission, but who used their employers’ means (technical means, knowledge) or when their invention falls within the scope of activities of their employer: the right to the patent is up to the inventors, but the employer (PRO) has a right for claiming the ownership of the invention provided the inventors receive a fair compensation
- c) in other cases than a) and b), the right to the patent is up to the inventors

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in France?

All French laws and regulations concerning IP are available in the CPI (Code de la Propriété Intellectuelle); this Code is accessible to www.legifrance.gouv.fr (click on “Les Codes”, and then on “Code de la propriété intellectuelle”).

4) Are there any differences within France that will impact on the ownership of the IPRs?

No.

FRANCE, FR

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in France?

IP-contract shall be negotiated with the PRO structure in charge of the transfer of technology and IP matter, not directly with the researchers. Each PRO (either EPST, EPIC or University) has such a structure which is duly authorized by the management of said PRO to represent this latter. As a basic principle, the researcher has no power for representing said PRO.

6) At what terms can IPRs be obtained from PROs in France?

The negotiation is free between the parties and the French PROs are free to grant either exclusive or non exclusive licenses on their results.

The 2001 Recommendations insist on the importance for the PROs of being very careful when an exclusive license is granted, in order to avoid that the licensed invention be “frozen” by the licensee; it should be then recommended to provide in the license agreement a clause according to which the exclusivity could be transformed into a non-exclusivity, should the invention not be commercialised within a given period of time.

In case the PRO decides to assign all its rights to a private party, such assignment has to be compensated by a financial contribution.

7) At what price can IPRs be obtained from PROs in France?

The price is freely negotiable between the parties, the market price being the standard.

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

Public (State) funding has no impact on the ownership of IPRs, bearing in mind that such ownership is governed by law in case of an invention from a salaried inventor. In case of a partnership agreement between a PRO and a private party, the R&D contract shall provide who will be the owner of the results of said agreement; however, the Recommendations issued by the French Research Ministry in June 2001 strongly incite the involved PRO to get at least part of the ownership through a co-ownership agreement to be negotiated between the parties at the same time the R & D agreement is negotiated.

In case of a consultant agreement or in case of an agreement which does not imply from the PRO any inventive contribution, the private party will be the owner of the results. In that case, it should be reminded that, according to the French law, anybody is entitled, for experimental purposes, to use the results, even when patented, owned by others.

FRANCE, FR

9) How does funding affect exploitation of IPRs?

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

A new law, enacted on April 18 2006, provides in article 28 an income (“impôt sur les sociétés”) exoneration for the PROs revenues coming from the valorization of their results.

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

A confidential agreement (non disclosure agreement) has to be envisaged whenever a party intends to communicate confidential information to other party (ies). Such an agreement can provide an obligation for the receiving party not to file any industrial property title on the received information.

Specific attention has to be paid in case the information consists in or comprises material (biotechnological material for instance); if the receiving party can accept not to file an industrial property title (patent application for instance) on the received product, it should be free to protect its own results.

In any case, a clear identification of what is considered as confidential (background knowledge) should be provided and possibly should be documented, through laboratory notebooks for instance.

12) Are there any particular rules or requirements regarding publication?

Among the objectives of PROs, the law provides that the PROs have to disseminate their knowledge, for instance by publishing their results.

In case of an R & D agreement, it is acceptable that the private party requests that the publication is postponed until the appropriate measures have been taken for protecting said results (more often by filing a patent application); however such a postponement shall be reasonable and clearly determined in the R & D agreement. Besides the publication of its results, another objective for PROs is, by law, the valorization of its results.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in France?

The PROs structures in charge of the transfer of technology and / or the patent departments of such PROs can provide any details concerning their policy on those issues; furthermore, several PROs, such as CNRS or INSERM, have their own website dealing with such issues proposing basic draft agreements. The 2001 Recommendations mentioned above are available on the website of the French Research Ministry: www.recherche.gouv.fr/technologie/index.htm (click on “Documentation” and then on “Recommandations”).

FRANCE, FR

14) Who should I contact for more information about IPR-contracts in French PROs?

The transfer of technology or patent department structures above mentioned.

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in France regarding where to obtain IPRs?

Priority patent applications resulting from joint R & D-projects with French PROs must be filed, in accordance with the provisions of the French law at the French Office (Institut National de la Propriété Industrielle – INPI), either for national, European or international (PCT) priority patent applications. A derogation for filing in a foreign country can be obtained through a special request at the French ministry in charge of Defence.

16) Who will pay for the costs of obtaining the IPRs?

Either the R & D agreement or the co-ownership agreement, if any, will provide which party will pay for patent costs; a possibility is that the private party bears such costs, as advanced royalties for instance.

17) Who will enforce the IPRs?

PROs are very reluctant in enforcing IPRs, mainly due to the costs involved; here also the R & D agreement or the co-ownership agreement should provide who is entitled to enforce IPRs and who will bear the costs.

In France, only the patentee or the exclusive licensee (if he is not precluded to doing so in his license agreement) is entitled to initiate a lawsuit against an infringer; any licensee can intervene in such a lawsuit in order to have his own prejudice compensated.

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

19) Where to get Further Up-to-date Information?

Last updated 23 June 2006

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GERMANY, DE

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in Germany.

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in Germany?

Inventions (including computer-implemented inventions) are usually protected by patents.

An alternative IPR for the protection of an invention is the Gebrauchsmuster (Utility Model) - Essential characteristics: No protection of process inventions, examination only as to formalities, not as to substance → quick grant, low costs; grace period of 6 months.

A special IPR for microchip design is the Halbleiterschutz (Semiconductor Protection).

Software is legally protected by Urheberrecht (Copyright), as well as scientific (or other) publications.

Marken (Trademarks) and Geschmacksmuster (Designs) are gaining increasing importance within German research.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in Germany?

IP ownership of inventions at all PROs is governed by the Employee Inventions Act (Arbeitnehmererfindungsgesetz). Generally, for inventions at PROs the same rules apply as for inventions in private enterprises, with some special clauses concerning inventions made by employees of universities (§ 42 Arbeitnehmererfindungsgesetz).

The original IP-ownership of service inventions rests with the employed inventor(s). The inventor is obliged to notify his inventions to his employer (PRO) immediately.

The PRO has the right to claim the invention within 4 months after notification. The claim (Inanspruchnahme) of an invention transfers all negotiable IP-ownership rights to the PRO. For universities, special regulations balance the researcher's right (not) to publish his or her research results with the right of the employer to claim a service invention and to file a patent application. University researchers keep a mandatory right of use for scientific purposes.

The PRO keeps all revenues earned from commercialisation of claimed inventions. The employed inventor is entitled to a specific remuneration (Arbeitnehmererfindervergütung), calculated by a legally defined method depending on the commercial value of the invention and the inventor's contribution to the invention. This legally ensured minimum of remuneration may be exceeded by IP policies or individual agreements. Non-University Research Institutions

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often grant remuneration in form of a fixed percentage of the revenues. The remuneration of inventors at universities is legally fixed (30% of revenue).

If the PRO does not claim the service invention or renounces a former claim the IP-ownership stays with (or respectively returns to) the inventor(s).

The ownership of free inventions of an employee rests with the inventor. Free inventions of employed researchers may occur e.g. in the framework of a sideline. According to Copyright Law, the IP-ownership of software developed by an employee belongs to the employer if not otherwise agreed upon. A claim is not necessary.

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in Germany?

All German IPR laws (Patentgesetz, abbrev. PatG; Gebrauchsmustergesetz; abbrev. GebrMG; Gesetz über den rechtlichen Schutz von Mustern und Modellen, abbrev. GeschmMG 2004; Gesetz über Urheberrecht und verwandte Schutzrechte, abbrev. UrhG) and the Employee Inventions Act (Arbeitnehmererfindungsgesetz, abbrev. ArbNErfG) are available online from the website of the German Ministry of Justice (http://bundesrecht.juris.de/bundesrecht/GESAMT_index.html).

English translations of German IPR Laws are available from WIPO's Collection of Laws for Electronic Access (CLEA), www.wipo.int/clea/en/index.jsp

4) Are there any differences within Germany that will impact on the ownership of the IPRs?

All relevant IPR laws are federal regulations and hence are applicable in all Federal States (Länder).

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in Germany?

IP-contracts are to be negotiated with the PRO management, not with individual researchers. In practice, PRO managements often authorise a (internal or external) patent- or tech-trans office to negotiate IP contracts on behalf of the institution.

The Fraunhofer Society as well as the Max Planck Society established central patent- and tech-trans units responsible for all their respective institutes (Fraunhofer- Zentralverwaltung and Garching Innovation, both located in Munich). The Helmholtz Association set up a common transfer agency for life sciences (Ascenion GmbH in Munich). The German universities established patent- and licensing agencies (Patent- und Verwertungsagenturen, abbrev: PVA) in each Federal State (Land).

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6) At what terms can IPRs be obtained from PROs in Germany?

German PROs are permitted to assign or license IP at non-exclusive as well as exclusive conditions. However, any contract assigning exclusive rights to a single company must take into consideration that the agreed terms will not imply illegal distortion of competition or be considered as an illegal state aid to the company in question.

A prior consent of the funding government may be necessary for the transfer of IP to non-European states.

In certain cases PROs are entitled to accept payment for IP in the form of equity in private companies (e.g. in start-ups from the respective PRO).

German PROs are expected by the funding state to actively pursue commercial exploitation of IP that arises from the research of the institution. For this reason PROs usually include a clause in IPR-contracts with industry for IP to be reverted back to the institution, if commercialisation is not or not diligently pursued by the licensee or assignee.

7) At what price can IPRs be obtained from PROs in Germany?

In compliance with EU state-aid regulations and German budgetary laws, IP arising from publicly financed research are to be transferred to industry at market price.

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

State funding (both basic funding and project funding) does not influence the IP-ownership of PROs (only exception: Governmental Research Institutes, Ressortforschung).

As far as basic funding is concerned the Federal Government expects PROs to safeguard IP of research results as an element of an innovation-oriented research system. The decision of the individual cases (objects, ways, means and extent of IP protection) rests with the PRO.

In the case of a conclusion of sub-contracts with a German RF (see response to question 9 below) as principal the results generally have to be transferred to the RF in return for payment.

In the case of participation within a national research project, e.g. within a so-called “Verbundvorhaben” (cooperation between many different “players”) the joint inventions belong to all the different “players” together.

In research collaboration projects between PRO and industry (Forschungskooperation) the ownership of joint inventions is an integrated issue of the individual contract. Inventions made by one partner alone usually belong exclusively to him and may be offered to the respective partner.

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If an invention arises from a project financed exclusively by industry (contract research, Auftragsforschung), it is often agreed in the contract that all IPRs should belong to the financing party. A special remuneration for the PRO after patent application and / or using of the invention for commercial purposes may be agreed upon. PROs often keep a non-exclusive right to use the research results for their research and educational work

9) How does funding affect exploitation of IPRs?

Concerning project funding from the Federal Government the following rules apply: The results generally belong to the recipient of the funds (RF). The RF has the right to exclusive use of the results (exception: non-exclusive rights for research and science). In return the RF is obliged to present an utilisation plan at the beginning of the project in question (utilisation = not only economic utilisation) and later on to file patent applications to make use of the results. If the RF does not fulfil his obligation to utilise the results within an appropriate period after completion of the project, his right of exclusive use expires. In that case the RF must assign third parties upon request a non-exclusive and non-transferable right of use or utilisation in the result.

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

In Germany there are no specific tax preferences for contract research.

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

It is common practice to agree on the mutual confidentiality of industrial background knowledge made accessible to the other partner within the framework of a research collaboration or contract research. Concerning research results from research collaboration or contract research it is an integrated issue of the individual contract to balance the PROs interest in publishing and the industrial partner's confidentiality interests (e.g. for a certain period of time publications or other disclosures may depend on the industrial partner's prior consent).

12) Are there any particular rules or requirements regarding publication?

German PROs are obliged to publish scientific results generated from research funded fully or partly by public means. They are likewise obliged to file the necessary IP applications. So planned publications of researchers will be screened by the PRO before edition to ensure the necessary novelty for envisaged patent applications. A Gebrauchsmuster (Utility Model) application can be even filed within 6 months after publication (grace period).

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SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in Germany?

See answer to question 14 below.

14) Who should I contact for more information about IPR-contracts in German PROs?

Relevant contact persons for all PROs can be found on the websites of the individual PRO. If no English version exists, search for “Technologietransfer”.

Model contracts for research collaboration and for contract research (Berlin Contract, Berliner Vertrag) are available on:

www.ipal.de/index.php?id=34&L=en (both in German and English).

Another model contract (Duesseldorf Contract, Düsseldorf Vertrag) is available on:

http://www.gewrs.de/files/leitfaden_duesseldorfer_vertragswerkstatt.pdf
(in German only).

Recently the Hamburg Contract (Hamburger Vertrag) has been published. All these model contracts are proposals and do not form a common view or a general standard among German PROs.

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in Germany regarding where to obtain IPRs?

Patent applications for Germany can be filed optionally at the German Patent and Trade Mark Office or the European Patent Office. Both German and European patent applications can be filed electronically.

Information regarding services of the German Patent and Trade Mark Office is available on the website <http://www.dpma.de>

16) Who will pay for the costs of obtaining the IPRs?

PROs pay for their patent costs usually from their basic funding.

Project funding of the Federal Government includes the costs of the first filing (for PROs and SMEs only).

Concerning research results from research collaboration or contract research, the distribution of costs involved in the filing, maintenance, defense and enforcement of IP is an integrated issue of the individual contract.

17) Who will enforce the IPRs?

Usually it lies upon the owner of the IP to enforce it. Concerning research results from research collaboration or contract research, the mutual responsibilities of enforcement is an integrated issue of joint R&D contracts.

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SECTION 8 Consultation and Sourced of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

Dr. Klaus Kobek (Innovations-Management GmbH Rheinland-Pfalz), Dr. Nathalie Martin-Hübner (Leibniz-Gemeinschaft), Dr. Friedrich Rückert (Forschungszentrum Karlsruhe).

19) Where to get Further Up-to-date Information?

www.dpma.de

www.bmbf.de

Last updated: June 7th, 2006

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HUNGARY, HU

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in Hungary.

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in Hungary?

All types of IPRs (patents, trademarks, utility models, designs, copyright etc.) may be acquired and assigned by the Hungarian PROs. The list of IPRs available in Hungary can be found on the website of the Hungarian Patent Office at:

[/www.mszh.hu/English/index.html](http://www.mszh.hu/English/index.html).

A grace period of six months preceding the date of priority of the patent shall apply if a disclosure of the invention (i) was due to an abuse of the rights of the applicant or his predecessors in title, or (ii) if the applicant or his predecessors in title have displayed the invention at an exhibition specified in an announcement by the President of the Hungarian Patent Office published in the Hungarian Official Gazette.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in Hungary?

Pursuant to the Hungarian industrial property laws the employer shall be entitled to acquire the IPRs created by his employees and this shall apply also to PROs (i.e. there is no professor privilege in Hungary). In case of a service invention the inventor shall notify his employer without delay, and the employer shall make a declaration within 90 days to the effect that he does or does not claim title to the service invention. If the invention was claimed by the employer, he shall be required to offer to assign to the inventor the right to a patent free of charge prior to any act or any intentional omission liable to prevent the obtaining of a patent with regard to a service invention.

In case of copyright works made in the course of employment the employer shall be the owner of the rights by virtue of law without any legal declaration once the author has delivered the work to the employer.

Since a university or a public institution itself cannot be the owner of such rights, these public bodies acquire the IPRs for the State Treasury. Although the ownership rights are transferred to the State Treasury, these PROs are practically regarded to be in owner position: they are allowed to exercise quasi property management rights, including the right to conclude licensing agreements or even to transfer the respective IPRs. Subsequently, the PRO are to negotiate assignment or licensing of IPRs with third parties.

Upon the exploitation of a service invention or a copyright work made in the course of employment (except for a software or a database) the inventor or the author is entitled to a remuneration which commensurate with the employer's income arising from exploitation.

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3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in Hungary?

In Hungary there is no specific legislation concerning the ownership regime or exploitation of the IPRs created at PROs. The ownership of IPRs is dealt with in the Copyright Act and in the industrial property acts respectively. The English translation of the Patent Act is available on the website of the Hungarian Patent Office as below:

Patents: <http://www.mszh.hu/English/jogforras/9533.html>

The texts of the other legal acts are available only in Hungarian on the website at the moment. Nevertheless, upon request the Hungarian Patent Office is willing to provide a translation to anyone (due to the recent amendments of the text the consolidated English versions are being prepared now):

Copyright: www.mszh.hu/English/szerzoi/jogforras_szjog/index.html#magyar

Utility models: www.mszh.hu/English/hami/jogforras_hami.html

Industrial designs: www.mszh.hu/English/formaterv/jogforras_forma/

Trademarks: www.mszh.hu/English/vedjegy/nemzeti_ut/jogforras_vedj.html#magyar

In addition to these, pursuant to Act CXXXIV of 2004 on Research and Development and Technological Innovation (Innovation Act) in regard of publicly-funded R&D projects PROs are explicitly obliged to ensure that the intellectual property rights arisen from such project are conferred to them up to the extent allowed by the respective legal regulations (see Copyright Act and industrial property acts). More information on this available at: www.nkth.gov.hu/main.php?folderID=907&articleID=3988&ctag=articlelist&iid=1

4) Are there any differences within Hungary that will impact on the ownership of the IPRs?

In Hungary there is no regional difference in the IP system.

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in Hungary?

It is the PRO management and representatives, not the individual researchers who are entitled to negotiate IPR-contracts. Some PROs have a specific office or appointed staff, who are responsible for negotiating IP contracts with industrial partners on behalf of the institution, while others commission an external company specialised in innovation management to find the best way of exploitation.

As a general rule for the inventions of a postgraduate or an undergraduate student the regulations on service inventions and copyright works made in the course of employment shall apply respectively. However, the wording of the Act on Universities adopted last year is not definitely clear in that aspect which IPRs shall belong to the university and which to the student.

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6) At what terms can IPRs be obtained from PROs in Hungary?

Except for the establishment of a spin-off company or acquisition a share therein, there are no specific regulations for PROs in regard to the assignment or licensing of IPRs. PROs are permitted to assign or license IPRs pursuant to the general rules of the Act XXXVIII of 1992 on Public Finance. For the Hungarian text of this Act, see www.complex.hu/kzldat/t9200038.htm/t9200038.htm.

The terms of the establishment of a PRO spin-off company are regulated in the Innovation Act (see at: www.nkth.gov.hu/main.php?folderID=907&articleID=3988&ctag=articlelist&iid=1).

Apart from the above PROs are allowed to determine the terms and conditions of an assignment or a licensing agreement on their own. Nevertheless, PROs often stipulate a clause in IPR-contracts with industry for IPRs to be reverted to the institution, if commercialisation is not diligently pursued by the licensee or assignee.

As from January 1, 2006 each Hungarian PRO shall adopt an intellectual property rights management policy (IPR Policy) which, inter alia, shall extend to the principles and requirements concerning the protection of IPRs and their exploitation, to regulations concerning the assignment and licensing of IPRs, to determination of the rights and obligations of research staff and to the responsibility of the research institute.

These IPR policies are commonly available on the website of each PRO.

7) At what price can IPRs be obtained from PROs in Hungary?

The price is to be determined by negotiation between the PRO and the third party. The PRO may only accept equity if the company has limited liability status, or where the contract limits the PROs liability.

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

In regard of commissioned research funded by industry, PRO and the industrial partner stipulate which of them will be the owner of IPRs, commonly the funding party.

Pursuant to the above-referred Innovation Act in case of publicly-funded R&D projects the funding body may require the intellectual property created in the framework of the project to be made available free of charge for public use, however, this requirement shall be determined both in the call for proposals and in the funding contract.

9) How does funding affect exploitation of IPRs?

For publicly-funded projects the funding body may prescribe in the call for proposals that the beneficiary shall proceed with reasonable diligence to acquire IPR protection concerning the result of the project for the territory of Hungary or for a territory including Hungary and/or exploit such project results in Hungary.

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10) Are there any fiscal measures that impact on funding or ownership of IPRs?

A Hungarian company is entitled to reduce its before-tax profit with 50 percent of the amount received as royalty from the assignment or licensing IPRs, further, SMEs can reduce the before-tax profit with the acquisition, maintenance and renewal fees of industrial property protection.

Pursuant to the provisions of the Act on the Research and Technological Innovation Fund a contribution (innovation fee) shall be paid to the Fund by the Hungarian companies except for companies considered as micro-enterprises. The amount of the annual innovation fee may be reduced by the direct costs of the R&D activities conducted by the company itself, and by the costs of the commissioned R&D activities ordered from PROs.

For more information on the innovation fee and tax incentives, see www.nkth.gov.hu/main.php?folderID=891&articleID=3943&ctag=articlelist&iid=1

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

There is no explicit statutory requirement for Hungarian PROs which would oblige them to publish or disseminate the results of their R&D activity. The legislation put stress rather on the exploitation of IPRs. Even in regard of publicly-funded projects the funding body may prescribe that the beneficiary shall proceed with reasonable diligence to acquire IPR protection concerning the result of the project which obligation presumes the delay of the publication while an application for IP protection is being made.

12) Are there any particular rules or requirements regarding publication?

See answer to question 11 above.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in Hungary?

The Hungarian PROs are to adopt an IPR Policy, which, inter alia, shall extend to the principles and requirements of IPRs' exploitation and contracts with third parties. The Innovation Act prescribes only the adoption of such policy without determining its content, which can be established by the PRO independently.

Nevertheless, in 2005, the Hungarian Patent Office and the National Office for Research and Technology have jointly published a guide in order to facilitate the elaboration of individual IPR policies. This guide is available only in Hungarian at www.nkth.gov.hu/main.php?folderID=466&articleID=4163&ctag=articlelist&iid=1

HUNGARY, HU

14) Who should I contact for more information about IPR-contracts in Hungarian PROs?

Each Hungarian PRO has its own staff responsible for handling IPR contracts or has an agreement with partners possessing such facilities. Contact information for the PROs can be obtained from: (i) the website of National Office for Research and Technology at <http://www.nkth.gov.hu/>; (ii) the websites of the Hungarian universities at http://www.om.hu/letolt/felsoo/fo_ang_magy_hon.pdf, (iii) the website of the Hungarian Academy of Sciences concerning other public research institutions at <http://www.mta.hu>

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in Hungary regarding where to obtain IPRs?

Hungarian applicants are basically free to decide where to apply for an IPR protection up to the below restrictions: (i) a European patent application shall be filed with the Hungarian Patent Office if the applicant is of Hungarian nationality or if his residence or principal place of business is in the country, except if, in the European patent application, the priority of such a patent application is claimed which was filed with the Hungarian Patent Office at least two months earlier and the treatment of which as a State secret was not ordered by the President of the Hungarian Patent Office; (ii) the Hungarian Patent Office shall act as a receiving Office with respect to international patent applications, where the applicant thereof is of Hungarian nationality or having residence or principal place of business in the country.

For details of how to obtain an IPR protection in Hungary, please see the website of the Hungarian Patent Office at <http://www.mszh.hu/English/index.html>

16) Who will pay for the costs of obtaining the IPRs?

The cost of obtaining IPRs is born by the applicant, which shall apply for PROs as well.

As referred above SMEs can reduce their before-tax profit with the acquisition, maintenance and renewal fees of industrial property protection.

17) Who will enforce the IPRs?

This issue is usually established as part of the negotiation between the industrial partner and the PRO.

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SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

19) Where to get Further Up-to-date Information?

Last updated: 31st March 2006

Each Hungarian PRO has its own staff responsible for handling IPR contracts or has an agreement with partners possessing such facilities. Contact information for the PROs can be obtained from: (i) the website of National Office for Research and Technology at www.nkth.gov.hu/; (ii) the websites of the Hungarian universities at www.om.hu/letolt/felsoo/fo_ang_magy_hon.pdf, (iii) the website of the Hungarian Academy of Sciences concerning other public research institutions at www.mta.hu.

In addition to the website details provided above, enquiries about obtaining IPRs can be made by telephone, fax or e-mail to the Hungarian Patent Office: phone: +36 1 312 4400, Fax: +36 1 331 2596, E-mail: mszh@hpo.hu

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IRELAND, IE

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in Ireland.

Appropriate links:

1 National Code of Practice for Managing Intellectual Property from Publicly Funded Research: www.forfas.ie/icsti/statements/icsti040407/index.html

2 National Code of Practice for Managing Intellectual Property from Public-Private Collaborative Research: www.sciencecouncil.ie/reports/#ipcode04

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in Ireland?

Copyright is relevant primarily in regard to software and to training and teaching materials. The Controller of Patents, Designs and Trade Marks is responsible for the granting of patents; the registration of industrial designs and trade marks; the provision of information on patents, designs and trade marks; and has certain statutory functions under the Copyright and Related Rights Act 2000.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in Ireland?

Copyright in works created in the course of their employment by employees is the first ownership of the employer. Trade Marks and Designs are regarded as personal property.

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in Ireland?

As a general principle of law in Ireland, ownership of inventions and other IP created by employees during the course of employment resides with their employers. Employers are advised to ensure that appropriate written agreements are in place with employees that grant them ownership of inventions and other IP arising from their work.

The text of the relevant legislation can be found at Department of Enterprise, Trade and Employment Intellectual Property Unit. It is available in English at www.entemp.ie/science/ipr/legislation.htm

4) Are there any differences within Ireland that will impact on the ownership of the IPRs?

No.

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SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in Ireland?

Each PRO negotiates its own IPR-contracts and takes responsibility for sorting out the ownership issues with its staff and researchers so that it can negotiate directly with the business partner e.g. written agreements should be in place with students confirming PRO ownership of IPRs. Academic staff may be involved in negotiations alongside PRO technology transfer staff. Incentives and benefit sharing for academic staff are according to individual PRO policies.

6) At what terms can IPRs be obtained from PROs in Ireland?

No legal requirement, however National Code of Practice for Managing Intellectual Property from Public-Private Collaborative Research (2 above) recommends having defined exploitation milestones and timelines and agreed consequences should obligations of the commercialising partner not be met.

7) At what price can IPRs be obtained from PROs in Ireland?

No legal requirement, however, advice in the National Code of Practice for Managing Intellectual Property from Publicly Funded Research (1 above) is that terms used as a basis for negotiation with commercial partners should be formulated in line with the valuation of the IP as outlined below and in accordance with the overall Technology Transfer strategy of the PRO;

The valuation of early stage IP is very unpredictable. Several factors should be considered in estimating value or potential value, for example:

- Market valuations – in other words “what is the current market willing to pay?”;
- Third party assistance including for example input from industry and state agencies;
- Study of comparable existing subject matter, licences and commercialisation practices;
- Estimating projected sales based on market research;
- Development stage of the subject matter;
- Estimated cost of getting to market;
- Barriers to entry into markets;
- Estimated cost of patent process.

For collaborative, public private co-funded research (2 above) ownership and access to IP should be negotiated on a project by project basis. In conducting such negotiations, decisions on allocating ownership and access should principally be based on a combination of funding contributions by the parties, their intellectual contribution to the research project, the optimum exploitation route for a particular technology and partner(s) best positioned to protect and exploit the IP. The agreement reached should ensure fair and reasonable incentives for all parties, and should also ensure that PROs are free to pursue similar lines of research with

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other industrial partners, while respecting existing IP ownership and confidentiality agreements. Special attention will be required in the case of IP arising from technologies with applications in multiple products and across several technology sectors.

State Aid Rules apply in all cases

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

100% publicly funded IP is owned by the PRO. For collaborative co-funded IP relative contributions from public and private sources in collaborative research projects should influence ownership. Terms and conditions of grant funding supercedes any ownership agreement.

Guidelines outlined in the National Code of Practice for Managing Intellectual Property from Public-Private Collaborative Research (2 above) recommend that discussion between parties to arrive at an agreed arrangement on ownership and access to IP should include consideration of three key factors; (1) financial input, (2) intellectual input and, (3) capacity to exploit. Issues to be addressed should include:

Financial input:

- Relative financial contribution from the parties;
- Requirement to strike a fair and reasonable incentivisation between all parties involved in the project;
- Other input to the project, including researchers, equipment and provision of materials, and a clear understanding and financial outline of in-kind contributions;
- Impact on future research – is it compromised? All parties should understand the relationship of the current research to future academic research.

Intellectual input:

- Nature and scope of the proposed collaboration;
- Level of intellectual input from both sides, is there a genuine collaborative effort?
- Relative abilities of the partners to obtain, maintain and, where necessary, defend IPR.

Capacity to exploit:

- Likely commercial applications of the IP, the optimum exploitation route and the partner(s) best positioned to execute it;
- Degree of alignment of the research with the industrial partner's technology development and acquisition strategy;
- Likely costs and resources required to develop the results of the collaboration into commercial products or services;

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- Stage of the research: early or closer to market?
- Scale and timeframe required for pre-commercial development;
- Risk associated with taking a product to market.

These guidelines recommend the following opening positions for negotiation:

I 100% Industry Funded Research

A. Where industry pays in full for the research, including both direct and indirect costs, participates in the project and is considered the key exploitation partner, it will own the IP.

B. Where a project is PRO-led and industry does not provide intellectual input to the project, title to IP should be negotiated based on best route for exploitation and the partner best positioned to execute the exploitation strategy.¹

II Collaborative Research

Always conscious of State Aid rules:²

A. Where industry provides a significant part of the funding, provides intellectual input to the project and is deemed best positioned to exploit the IP, the industrial partner(s) can own the IP. Fair and reasonable financial and non financial incentives should be provided to the PRO.

B. Where the State is the primary financial contributor to the project, the PRO will own the IP. All industrial partners will have rights of access unless it has been agreed upfront that one party will have an exclusive licence, for which it will pay market rates.³ The PRO is obliged to maximise the exploitation of IP through licensing to industrial partner(s) where the industrial partner(s) is best positioned to exploit the IP.

Exclusivity may refer to all or part of the project(s).

III 100% State Funded Research

IP arising from research fully funded by the State is owned by the PRO as outlined in the National Code of Practice for Management of IP from Publicly Funded Research.⁴

Where employees from two or more parties contribute to an invention, joint ownership may be negotiated by the parties. While the negotiation and management of joint ownership agreements can be complex, should this be an agreed option by the parties, the possibility should be included in the upfront agreement. A joint ownership management agreement, outlining exploitation rights and terms, should be negotiated. This agreement should stipulate possible exploitation routes, and should consider third party licensing arrangements by

¹ Note that this situation typically only arises in the case of research funded from philanthropic sources.

² For basic definition of State Aid, refer to “Definitions” above, and to www.sciencecouncil.ie; guidance on State Aid rules should be sought from relevant development agencies.

³ The appropriate market rate payable should be discounted based on the initial contribution made by the industrial partner to the project.

⁴ National Code of Practice for Managing Intellectual Property from Publicly Funded Research (1 above).

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all partners, with provision for further discussion on compensation via royalty payments, as appropriate.

State Aid rules apply

9) How does funding affect exploitation of IPRs?

Ownership and exploitation is negotiated on the basis of relative contributions, both Financial and in Kind and capacity of the partners to exploit. See Section D in the National Code of Practice for Managing Intellectual Property from Public-Private Collaborative Research (2 above) for details on exploitation.

State Aid rules apply

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

There are particular requirements in regard to PROs keeping research results confidential: see Section B.2 in the National Code of Practice for Managing Intellectual Property from Public-Private Collaborative Research (2 above). There are no differences for cross-border collaboration.

12) Are there any particular rules or requirements regarding publication?

There is no legal obligation for PROs to publish. Publication can be delayed while an application for IP Protection such as a patent is made.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in Ireland?

1. National Code of Practice for Managing Intellectual Property from Publicly Funded Research: www.forfas.ie/icsti/statements/icsti040407/index.html
2. National Code of Practice for Managing Intellectual Property from Public-Private Collaborative Research: www.sciencecouncil.ie/reports/#ipcode04
PRO policies by and large align with the National Codes of Practice as listed above. A number of institutions' policies are under review.

14) Who should I contact for more information about IPR-contracts in Ireland's PROs?

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SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in Ireland regarding where to obtain IPRs?

There is no requirement to file a patent application first in Ireland before filing elsewhere.

16) Who will pay for the costs of obtaining the IPRs?

Enterprise Ireland provides Intellectual Property advice on the protection, development and commercialisation of patentable technology. In appropriate cases, they can provide financial assistance with the cost of patenting to PROs or SMEs.

17) Who will enforce the IPRs?

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

19) Where to get Further Up-to-date Information?

See links at beginning of Fact Sheet.

Last updated: May 2006

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ITALY, IT

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in Italy.

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in Italy?

Patents, Utility models, Topographies of a semiconductor product, New Plant Varieties, Trademarks, Designs, Copyrights.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in Italy?

In Italy, when the employer is a University or a Public Research Organisation IPR belongs to the inventor who will receive no less than 50% of any financial return deriving from the economical exploitation of the patent.

However, according to the Italian Copyright Law, software developed by inventors belongs to the employer, including PROs.

If an industrial invention has been developed by several persons, the rights deriving from the patent shall, unless otherwise agreed upon, be shared equally by the authors.

If the inventor fails to start economical exploitation of the patent within five years after the patent being granted, all the exploitation rights are automatically but not exclusively transferred for free to the PRO.

Almost all PROs in Italy manage the relationship with their individual researchers on the basis of a contract signed by both parts before the research activity starts providing that the ownership of the potential research outcomes belongs to the relevant PRO and the compensation, the sharing of profits or revenues for that.

When students participate to academic research activities, usually (however there is no provision by the law on this issue) Universities sign a contract with them in order to agree the University right to patent the research outcomes.

There is a strong likelihood of a change in the rule (at the moment – May 2006 – the Parliament is assessing an amendment); the new rule states: in PROs, IPR belongs to the performing organisation; the authorship of the patent is acknowledged to the inventor; the inventor will receive no less than 30% of any financial return deriving from the economical exploitation of the patent. If there is more than one inventor, ownership is shared among inventors; in this case, the share of no less than 30% of any financial return deriving from the economical exploitation of the patent will be equally distributed among the inventors, unless they had defined a profit sharing criterion proportional to the contribution of each inventor.

ITALY, IT

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in Italy?

All Italian IPR laws and the Law relating to Inventions of Employees are available on-line from the website of the Italian patent and Trademark Office (www.uibm.gov.it). However at the moment only the Italian version is available.

The only source of legislation is the article 65 of the new code on industrial property and it is applied to the whole territory of the Italian State.

4) Are there any differences within Italy that will impact on the ownership of the IPRs?

The new code on industrial property is applied to the whole territory of the Italian State.

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in Italy?

IPR-contracts are negotiated with individual researchers but it often occurs that on the basis of a contract the individual researchers give the ownership of his/her research results to the PRO; in this event the PRO management negotiates the contract. In practice, a lot of PROs have a technological transfer office to negotiate contracts with external partners on behalf of the institution.

6) At what terms can IPRs be obtained from PROs in Italy?

Italian PROs are permitted to assign or license IPRs at non-exclusive as well as exclusive conditions. However, PROs prefer not to give exclusive conditions and usually include a clause in IPR-contracts with industry for IPRs to be reverted to the institution, if commercialisation is not diligently pursued by the licensee or assignee.

The PROs are also entitled to accept payment for IPRs in the form of equity in private companies in the case of start-ups.

7) At what price can IPRs be obtained from PROs in Italy?

The market price

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

State funding (both basic funding and project funding) does not influence the IPR ownership of PROs. In the event of basic research funding (FIRB), ownership is with PROs even in the presence of private participation. Further assignment of rights is conditional upon payment of a consideration to PROs even in case the invention is made by the private participant.

ITALY, IT

Concerning project funding the following rules apply: The results generally belong to the recipient of the funds (RF). The RF has the right to exclusive use of the results.

In research collaboration projects between PRO and industry the ownership of joint inventions is an integrated issue of the individual contract.

9) How does funding affect exploitation of IPRs?

If an invention arises from a project funded exclusively by industry, it is often agreed in the contract that all IPRs should belong to the funding party. PROs often keep a non-exclusive right of use for non-commercial purposes.

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

In Italy at national level there is not any tax arrangement that will have an impact on the motivation of one of the collaborators to claim ownership of the IPR on the part of an SME or PRO.

The IPRs ownership does not have any effect on whether the owner will have to pay tax such as Value Added Tax (VAT) or not.

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

It is common practice to agree on confidentiality on background knowledge as part of joint R&D contracts or to sign a non disclosure agreement. This practice is applied also in the event of trans-national or cross-border collaboration.

12) Are there any particular rules or requirements regarding publication?

There are no special requirements on these issues in the Italian IP law. In case of research funded exclusively by an external customer, it can be agreed in the contract that results from the project in question are not to be made public. There are not any differences in the event of trans-national or cross-border collaboration.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in Italy?

A model contract for research collaboration and contract research is not available at the moment. TItalian Universities Network for the Valuation of Research Results is currently working on the definition of a model contract.

ITALY, IT

14) Who should I contact for more information about IPR-contracts in Italy's PROs?

Relevant address (e.g. email, telephone, mail) where more information can be found?

The individual researchers or contact persons of TTOs who usually can be found on the websites of the individual PRO.

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in Italy regarding where to obtain IPRs?

A national patent application must be made on the appropriate form and filed with one of the Chambers of Commerce, or sent by registered post with advice of delivery to the UIBM (Italian Patent and Trademark Office), via Molise 19, 1-00187 Roma.

An international patent application (PCT) must be presented directly or sent by registered post with advice of delivery to the UIBM. An European patent application must be filed with the Chamber of Commerce of Rome or sent by registered post with advice of delivery to the UIBM.

The applicant may submit an application in person or elect a representative who must be selected from the industrial property consultants registered on the appropriate professional register kept by the Italian Patent and Trademark Office or from attorneys registered on their respective registers.

Applicants resident abroad, if they do not intend to be represented, must elect a domicile in Italy to which correspondence can be sent.

It is possible to appeal against the decisions of Italian Patent and Trademark Office (UIBM) to the Board of Appeal within a term of 30 days from receipt; this term cannot be extended. The Board of Appeal set up to hear appeals against official decisions is a body with special jurisdiction and is subject to the Code of Civil Procedure. This Board, appointed by decree of the Ministry of Productive Activities, has five members: three chosen from among magistrates with a rank of not less than appellate judge, one of whom acts as chairman, and two from among professors of law at universities. The Board decides on appeals in judgments against which it is possible to enter appeals to the Supreme Court of Cassation on grounds of legitimacy.

Information regarding services of the Italian Patent and Trade Mark Office is available on the website www.uibm.gov.it

According to the law a patent application has to be filed with Italian Patent and Trademark Office (UIBM) before it can be filed abroad in case of first application to allow the military secrecy procedures otherwise a special authorization provided by the Ministry of productive activities is required to file a first application exclusively with a national patent office of a third Country or with the WIPO office responsible for managing PCT procedures (article 198 industrial code).

ITALY, IT

Information regarding the services provided by Italian Patent and Trademark Office (UIBM) is available, only in Italian, on the web-site (www.uibm.gov.it). Within the 2006 electronic filing of applications will become operative.

16) Who will pay for the costs of obtaining the IPRs?

The individual researcher or the PRO if so provided in the contract between the researcher and the PRO.

At local level it may occur that the government of a Region or of a City provides financial incentives for patenting which usually consist in paying the patenting fees to PROs and SMEs. In this event PROs provide for the relevant information. The Financial Act concerning 2006 provides the abolition of the Italian Patent Office fees.

17) Who will enforce the IPRs?

Usually it lies upon the owner of the IPRs to enforce them.

Otherwise enforcement of patents is usually an integrated issue of joint R&D contracts.

The collaboration agreement usually provides also for the applicable law in the event of a legal dispute, otherwise the Italian law will be applied.

From 1 July 2003 in Italy 12 specialized IP sections have been established at the Courts and Courts of Appeal of Bari, Bologna, Catania, Florence, Genoa, Milan, Naples, Palermo, Rome, Turin, Trieste and Venice.

The specialised sections have jurisdiction over conflicts relating to patent, design and trademark infringement/nullity – as well as unfair competition –. The actions are heard by a panel of three judges.

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

RICCARDO PIETRABISSA, co-chair and responsible of IP management of TTO of Politecnico di Milano (Piazza Leonardo da Vinci 32, 20133 - Milano –Italy), Coordinator of the Italian universities network for the valuation of research results, chair of PROTON Working group for management and structure of TTOs e-mail: riccardo.pietrabissa@polimi.it

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PIERGIOVANNI GIANNESI, Director IP dep., Pirelli e C. SpA, responsible of IP group within the Italian Enterprises Association (CONFINDUSTRIA), Viale Sarca 222 – 20126 MILANO, Tel. 02.64423331, Fax 02.64422254 e-mail: piergiovanni.giannesi@pirelli.com

ITALY, IT

19) Where to get Further Up-to-date Information?

Updated 16th May 2006

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LATVIA, LV

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in Latvia.

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in Latvia?

Inventions are usually protected by patents. A special IPR for microchip design is the Semiconductor Topographies Protection.

Software is legally protected by Copyright, as well as scientific publications. Trademarks, designs and utility models can also be protected according to the Latvian legislation.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in Latvia?

IP-ownership at Latvian PROs relates to the employment of the inventor, unless provided otherwise in the contract. If the employer shall not exercise the right in three months, this right shall pass back to the inventor. For the time being Latvian PROs exercise their rights to a limited extent due to lack of resources. Therefore authors of most successful inventions cooperate with foreign companies which usually get half of all rights.

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in Latvia?

For a list of Laws related to the IPR (in English): www.lrpv.lv/
Selected laws, obligatory directives and regulations concerning science and technology (in English): www.em.gov.lv/em/2nd/?lng=en&cat=3&lng=en

4) Are there any differences within Latvia that will impact on the ownership of the IPRs?

No.

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in Latvia?

IPR-contracts must be negotiated with the PRO management, not with individual researchers.

LATVIA, LV

6) At what terms can IPRs be obtained from PROs in Latvia?

PROs are permitted to license IPRs at non-exclusive as well as exclusive conditions.

7) At what price can IPRs be obtained from PROs in Latvia?

IPRs arising from publicly financed research are to be transferred to industry at market price.

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

Ownership of IPR is usually integrated as a key issue of joint R&D contracts. Private funding of research projects is very negligible in Latvia at the moment. There are state projects that provide state support (also from the EU structural funds) to SMEs for the acquisition of national as well as foreign patents.

9) How does funding affect exploitation of IPRs?

See answer to question 8 above.

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

It is a common practice to agree on confidentiality on industrial background knowledge as part of joint R&D contracts.

12) Are there any particular rules or requirements regarding publication?

In case of research funded exclusively by an external customer, it can be agreed in the contract that results from the project in question are not to be made public.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in Latvia?

Contact with each PRO individually.

14) Who should I contact for more information about IPR-contracts in Latvia's PROs?

Launching activities of the technology transfer offices in the Latvian PROs is planned as of 2006. Currently competition for the attraction of staff for these

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offices has been announced. Until now the weak point of the Latvian PROs in respect to the realization of IPRs has been the lack of experience (qualified patent specialists) and funding.

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in Latvia regarding where to obtain IPRs?

Patent applications resulting from joint R&D-projects with Latvian PROs could be filed optionally at the Latvian Patent Office or at an international patent authority. Information regarding services of the Latvian Patent Office is available in English at the web-site www.lrpv.lv/

16) Who will pay for the costs of obtaining the IPRs?

Latvian PROs will generally expect for the industrial partner to pay the cost for protecting IP that might arise from a joint R&D project. Unfortunately research collaboration followed by the acquisition of patents for the time being is rather rare in Latvia.

17) Who will enforce the IPRs?

The general policy of Latvian PROs is to promote patent applications as much as possible. Latvian analysts consider that in the situation of Latvia there is a need for rising interest of inventors in submitting patent applications themselves.

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

19) Where to get Further Up-to-date Information?

Last updated: November 2005

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THE NETHERLANDS, NL

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in the Netherlands.

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in the Netherlands?

Patents, Copyrights, Trademarks, Designs

2) Who owns the IPRs at PROs in the Netherlands?

The IP-ownership at PROs relates to the employment of the inventor. The employer (in this case the PRO) owns the IP. There is no professor privilege. The PRO does take responsibility for sorting out the issue of IP ownership within its organisation so that it is able to negotiate with a potential collaborator.

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in the Netherlands?

4) Are there any differences within the Netherlands that will impact on the ownership of the IPRs?

No.

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in the Netherlands?

The owner of the IP is responsible for the negotiation. How this being done depends how the PRO has organised technology transfer. It could be through their own technology transfer office, or through a third party. The latter is an exception in the Netherlands. Most PROs do it themselves.

6) At what terms can IPRs be obtained from PROs in the Netherlands?

There is no requirement that the PROs must have a clause in IPR-contracts with industry that the IPR will revert back to the PRO if commercialisation is not pursued by the industrial collaborator. In practice we see that the more advanced Technology Transfer Offices include these clauses in their contracts.

7) At what price can IPRs be obtained from PROs in the Netherlands?

Apart from EU State Aid restrictions, there is no explicit requirement that IPRs that arise from research at the PRO, which is fully or partly funded from public sources,

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are to be transferred to industry at market price. But due to political discussions about the interference of government interventions (for example funding research) in the market, the PROs are well aware that they have to sell the IPR to industry at market prices. Besides PROs have their own financial incentive to sell it at market prices.

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

The source of funding for the research carried out by the PRO that generated the IPRs does affect the conditions on the ownership of the IPRs.

In the primary funding (1st income-stream) the universities there are no conditions set on how to handle the IP. In the 2nd income-stream (funding through Dutch Institute of Science) there can be conditions set. This depends on which subsidy-stream is being used. In the 3rd income-stream (subsidy-schemes from government to promote research and public private cooperation) there can be conditions being set. This depends on the subsidy-scheme.

9) How does funding affect exploitation of IPRs?

See answer to question 8 above.

10) Are there any fiscal measures that impact on funding or ownership of IPRs? No.

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

Depending on the subsidy-scheme (3rd income-stream) there could be requirements in regard to PROs keeping research results confidential. This confidentiality is limited in time. It may only be used to allow patent the invention. There are no specific differences if the collaboration involves partners from outside the Netherlands, i.e. trans-national or cross-border collaboration.

12) Are there any particular rules or requirements regarding publication?

No.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in the Netherlands?

There is a general document signed between the federation of universities and the industry-association. In this document general principals are defined how to do technology transfer between universities and industry. The document doesn't include basic-contracts.

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14) Who should I contact for more information about IPR-contracts in PROs in the Netherlands?

Contact the VSNU www.vsnu.nl/web/show/id=26111/langid=42) and TAK (network on Applied Academic Knowledge – secretary: Ploeg@vsnu.nl).

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in the Netherlands regarding where to obtain IPRs?

16) Who will pay for the costs of obtaining the IPRs?

17) Who will enforce the IPRs?

In principle the owner of the IPR. But it can be negotiated between the parties that the enforcement lies with the licensee.

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

19) Where to get Further Up-to-date Information?

Updated: October 2005

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NEW ZEALAND, NZ

A summary of the issues that potential research collaborators from another country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in New Zealand.

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in New Zealand?

PROs can obtain any of the IPR's available to private sector firms.

Second-tier patent protection (such as a utility model) is not available in New Zealand.

There is no general grace period provision in New Zealand's patent legislation. The only grace periods provided are those required by the Paris Convention.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in New Zealand?

The PRO takes responsibility for sorting out the issue of IP ownership within its organisation so that it is able to negotiate with a potential collaborator. The Patents Act 1953 does not contain any provision regarding the ownership of employee inventions. There are no plans to introduce such provisions. The ownership of employee inventions is a matter for negotiation between the employee and employer.

The Copyright Act 1994 states that where an employee makes, in the course of his or her employment, a literary, dramatic, musical, or artistic work, that person's employer is the first owner of any copyright in the work.

There is no statutory requirement to specify in the contracts that IPRs generated from work done by staff belongs to PRO, but, this is desirable to remove any doubts and avoid disputes.

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in New Zealand?

There is no legislation in New Zealand that refers specifically to the ownership and exploitation of IPRs by PROs.

4) Are there any differences within New Zealand that will impact on the ownership of the IPRs?

The NZ system for granting and enforcing IPRs is a national one; there are no regional differences.

NEW ZEALAND, NZ

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in New Zealand?

Each PRO negotiates its own IPR-contracts. The PRO takes responsibility for sorting out the ownership issues with its staff and researchers so that it can negotiate directly with the business partner. As regards IPR of postgraduate and undergraduate students – practice negotiated by each institution.

6) At what terms can IPRs be obtained from PROs in New Zealand?

This is a matter for negotiation on a case by case basis.

7) At what price can IPRs be obtained from PROs in New Zealand?

There is no requirement that IPRs that arise from research at the PRO are to be transferred to industry at market price.

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

IPRs generated from public service research contracts www.morst.govt.nz/?CHANNEL=INTELLECTUAL+PROPERTY&PAGE=Intellectual+property
IPRs generated from funding grants for research – IPRs resulting from research are the property of the research organisation. For health-related research, IPRs may be re-assigned, in some cases, if unexploited after a certain period.

9) How does funding affect exploitation of IPRs?

See answer to question 8 above.

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

No.

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

No.

12) Are there any particular rules or requirements regarding publication?

PROs (non-universities) are required to disseminate the findings of publicly-funded research, except where this would seriously compromise a commercial

NEW ZEALAND, NZ

opportunity, or compromises their financial viability. They are not obliged to disseminate information if this would breach other standards of ethics, safety, national security, etc.

Dissemination of information is to serve the public good for New Zealand. Dissemination internationally is not necessarily a requisite of this.

Publication can be delayed while an application for IP protection, such as a patent, is being made.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in New Zealand?

PROs (non-universities) are encouraged to commercialise, where appropriate, with private sector collaborators.

14) Who should I contact for more information about IPR-contracts in New Zealand's PROs?

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in New Zealand regarding where to obtain IPRs?

A patent application has to be filed at the National Patent Office of New Zealand first before it can be filed abroad, although it is planned to repeal this provision. Information regarding the obtaining of registered IPRs can be obtained from the Intellectual Property Office of New Zealand (IPONZ). General information on copyright can be obtained from the Intellectual Property Policy Team, Ministry of Economic Development.

The IPONZ website is www.iponz.govt.nz; copyright information can be found at www.med.govt.nz/templates/StandardSummary____172.aspx

16) Who will pay for the costs of obtaining the IPRs?

In some cases, SMEs may be able to obtain assistance with the costs of obtaining IP protection through New Zealand Trade and Enterprise – see www.nzte.govt.nz

17) Who will enforce the IPRs?

These are matters for negotiation between the PRO and any partner.

NEW ZEALAND, NZ

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

19) Where to get Further Up-to-date Information?

Updated: May 2006

General information regarding PROs in New Zealand can be obtained from the Ministry of Research Science and Technology (MoRST) www.morst.govt.nz. Information on the grant of IP rights (patents, trademarks and designs) can be obtained from the Intellectual Property Office of New Zealand www.iponz.govt.nz

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NORWAY, NO

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in Norway.

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in Norway?

Patents are by far the most common tool for the protection of IP from Norwegian PROs.

Copyrights are relevant primarily with regard to software, but in the field of copyright, in contrast to patents, the protection and IPRs arise automatically when a “work” is created, whereas a patent can only be had after applying for it, examination at a patent authority and registration.

Databases, too, are automatically protected by inter alia European legislation. They have increasing importance both as research tools and results of research. Trademarks and designs may also be protected according to Norwegian legislation. However, PROs rarely see good reasons to apply for these forms of IPR in their own right. There is no system for protecting utility models in Norway.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in Norway?

IP-ownership at Norwegian PROs relates to the employment of the inventor. According to the Act on Employees' Inventions of 1970 17/4 nr. 21 the employer has the right, to some extent, to attract the IP rights to exploit the invention the employee has made in connection with his or her work there. In those cases, it will be the employer that applies for patents in their own name, but naturally naming the inventor(s). Since 1 Jan. 2003, this general rule also applies to universities, university hospitals and colleges. On that date, the earlier so-called “Teachers' exemption” by which university/college teachers retained the full rights to all IP based on the results of their work at the PRO, was lifted.

This means that, if the PRO does not answer within a certain time limit after a DOFI (Disclosure of invention) from the part of the inventor, the inventor-employee retains the full rights to the IP resulting from that invention, and can dispose of it in the way he/she wishes.

If the institution takes over the IP stemming from an invention, it has to make reasonable efforts both to secure the relevant IPR and commercialise the invention. Therefore, the institution may choose to hand the commercialisation, including IPR, of a given invention to the inventor-employee if it feels that it does not have the resources or is not interested in actively pursuing the commercialisation of that invention itself.

According to § 6, subsection three, a small but important exception was still kept in the Act for scientists and teachers employed at universities and colleges. This exception gives the scientist or teacher the right to publish the invention, even if this harms the possibility for the institution to secure IPR, especially patents

NORWAY, NO

as long as the right to publish does not come in conflict with interests from a third party, such as co-inventors and external investors. Important to notice that students, if they are not also employed by the in a scientific position (e.g. a phd-student or post-doc scholarship contract), are not employees, which means that they retain the full rights to any invention made or work created. Problems may therefore arise in cases where a student makes an invention or creates a work together with one or more employees.

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in Norway?

www.patentstyret.no

www.patentstyret.no/templates/Page_____681.aspx (legislation text in English)

www.birkeland.uio.no

4) Are there any differences within Norway that will impact on the ownership of the IPRs?

No.

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in Norway?

Contracts concerning the commercialisation and use of IPR based on results of the work of employees at PROs which the institution has taken over, must be negotiated with the PRO management, and not with individual researchers. In practice, PRO managements have often authorized a patent- or Technology Transfer Office (TTO) to negotiate contracts with external partners on behalf of the institution.

In cases where the individual researcher/employee at the PRO owns the right to the invention or work, see above, he/she can dispose of it as he/she wishes.

6) At what terms can IPRs be obtained from PROs in Norway?

Norwegian PROs are permitted to assign or license IPRs at non-exclusive as well as exclusive conditions. However, any contract assigning exclusive rights to a single company must take into consideration that the agreed terms will not imply illegal distortion of competition or state aid to the company in question.

There is not one fixed set of conditions for such contracts. Their content depends on the individual situation. Generally, the PRO will try to secure for itself and its researchers a fair balance in rights when negotiating contracts concerning the transfer of IPR.

7) At what price can IPRs be obtained from PROs in Norway?

Market price, to be decided on a case by case basis.

NORWAY, NO

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

The TTOs at the Norwegian universities and university hospitals have the responsibility to assess the patentability and commercial viability of inventions and R&D-results from their PROs work. In cases where the PRO has taken over the IP to such inventions, it is up to it (the PRO), normally through its TTO, to pursue (and pay for) the patenting such inventions etc.

The Research Council of Norway is the main public funding institution, and the following General Terms of Contract for IPR ownership apply:

Unless otherwise agreed with the Research Council, the Project Owner will own the project results and have the exclusive right to make use of them. Where legislation requires that rights be registered to obtain protection, the Project Owner shall perform such registration to obtain legal protection against third parties.

The Project Owner is under obligation to establish the agreements with owners, employees, any partners, subcontractors or others that are required to ensure that the Project Owner is the owner of the project results and has the right to commercialise them, including licensing them to others. Unless otherwise agreed in writing with the Research Council, it is assumed that these agreements guarantee that such rights are the exclusive property of the Project Owner.

The Project Owner is entitled to sign licensing agreements regarding the project results with other parties that are subject to legal rights and duties in Norway. Further, licensing agreements may be signed with legal or artificial persons subject to rights and duties abroad for project results that the Project Owner itself or others make use of in Norway. In the event the project results are not exploited in Norway, the licensing agreements entered into with foreign legal entities will require the written consent of the Research Council.

Where the Project Owner does not wish to or is not able to protect and/or make use of (including licensing) the project results within a reasonable period of time with a view to the market and the product's useful economic life and utilisation opportunities, the Research Council shall be notified in writing and, when so required by the Research Council, the project results shall be transferred to the Research Council or to a party designated by the Research Council. Such transfers may be full or partial.

The Research Council shall be notified immediately in the event a person or an undertaking outside the European Economic Area (EEA) assumes a controlling interest in the Project Owner through the acquisition of a stake in the enterprise (shares, etc.), by agreement or by other means. In such case, the Research Council is entitled to pose conditions regarding the project and project results, including that the Project Owner shall wholly or partially transfer the project results exclusively to the Research Council, or that the Research Council shall receive full restitution for its allocations to the project.

The provision in the preceding subsection does not preclude agreements regarding remuneration schemes for rights holders corresponding to those that apply to employees' inventions pursuant to the Act related to the Right to Employees' Inventions. Nor does this provision preclude the right to share project results with consortium participants, proportionate to the parties' contributions to the

NORWAY, NO

production of the project results. Please note that the provision in the preceding subsections is not intended to limit the protection accorded the rights holder's immaterial rights pursuant to the Norwegian Copyright Act.

9) How does funding affect exploitation of IPRs?

See answer to question 8 above.

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

Terms for confidentiality are to be negotiated case by case.

12) Are there any particular rules or requirements regarding publication?

Employees are free to publish even if PRO as IPR owner decides to exploit invention. Publication must not come into conflict with third party interest.

Employees must disclose, within a reasonable timeframe after they have understood that they may have made or be about to make an invention, the invention to the institution. This is called the duty to deliver a so-called DOFI (Disclosure of invention). The PRO then has a reasonable period of time to assess the patentability and commercial viability of what has been disclosed. The inventor-employee is free to publish the invention even if PRO as IPR owner decides to exploit invention, but must tell the PRO in due time about his/her intention to do so. Publication must not come into conflict with third party interest, especially other co-inventors or external entities that have rights to the invention arising from a contract.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in Norway?

Contact each PRO individually or the Universities TTOs.

14) Who should I contact for more information about IPR-contracts in Norway's PROs?

Relevant contact information is available at website of the PROs or the Universities TTOs.

NORWAY, NO

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in Norway regarding where to obtain IPRs?

In order to apply for patent protection in Norway you need to file a patent application to the Norwegian Patent Office.

A Norwegian patent provides protection only within Norway. An international patent application (PCT) may also be submitted to the Norwegian Patent Office.

Norway is not yet a member of the European Patent Convention.

16) Who will pay for the costs of obtaining the IPRs?

Financing of patenting costs is usually an integrated issue of joint R&D contracts. Norwegian PROs will generally expect for the industrial partner to pay the cost for protecting IP that might arise from a joint R&D project.

17) Who will enforce the IPRs?

The general policy of Norwegian PROs is to limit their responsibility as much as possible. The institutions, therefore, will rarely agree to a contractual obligation to defend a patent. However, providing assistance in connection with infringements is often agreed to.

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

19) Where to get Further Up-to-date Information?

Last updated 3rd January 2006.

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PORTUGAL, PT

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in Sweden.

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in Portugal?

Patents and utility models. The applicant can choose whether to apply for one or the other. Utility models can be maintained for only 10 years after application date. Patents for 20.

Topography of semiconductor products.

Trademarks, logos and other distinctive signs of minor importance.

Designs

Copyrights - Author's Right regime, slightly different from the copyright system for it has a stronger emphasis on the author's moral rights over its creations. Also important for software - although under a special law, software is equated to a literary work.

There is a Grace Period of one year for patent applications. It applies to disclosures before scientific societies (e.g. academic papers) professional and technical associations, Portuguese or international contests, tradeshow and trade fairs officially recognized. The applicant has 3 months from the date of application to prove that the disclosure was made under those circumstances.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in Portugal?

PROs generally own the IPR that can be patent protected. There is no specific rule in the IP Code, though. The PROs are establishing their own policies. There are two typical model policies:

(i) The first follows the law to the letter. Separates personnel under the teaching career – University owns IP; from personnel under research career – Co-ownership. All other contracted staff must agree to assign IP to the University under a contract. Students own IP.

(ii) Second: States that University owns IP if relevant University resources (people, equipment, facilities, moneys) are used to develop it, regardless of contractual link with the inventor. But additional contracts are established with students or people under the research career

Under the IP Code and the policies established, PROs must apply for ownership of the IPRs within 3 months after disclosure by the inventor. If PRO does not apply for ownership or no longer wishes to keep ownership, there is a procedure for notification so the inventors can do so.

PORTUGAL, PT

In regard to copyright and software, the general rule is that the creator is the first owner of the copyright. This rule also applies to commissioned works, unless an agreement to the contrary has been made with the author, for example a contract has been signed saying that the commissioner will own the copyright. However, where such a work is made in the course of employment, the employer is the first owner of these rights.

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in Portugal?

There is no legislation in Portugal that refers specifically to the ownership and exploitation of IPRs by PROs. The rules to be applied are to be found in Industrial Property Code (2003) “Código da Propriedade Industrial”; Professors career act “Estatuto da carreira Docente”, Researchers career act “Estatuto da Carreira de Investigador”

The Code dates from 2003. The relevant article is “59.º - Special rules on ownership of patents”. Also relevant are the teacher and researcher career acts. Teacher’s career: The University owns IP. Must apply for patent and must compensate the teacher within 3 months of disclosure

Researcher’s career: Co-ownership, but the University can decide on commercialisation routes on its own.

Students: Own IP.

The text of the IP Code can be found at www.inpi.pt

Professors career www.min-edu.pt/Scripts/ASP/news_det.asp?newsID=104&categoryID=leg

Researchers career - www.fct.mctes.pt/unidades/info/est-carinvc.htm

4) Are there any differences within Portugal that will impact on the ownership of the IPRs?

No. Regional government, existing only in Madeira and Azores, has no effect on IPR ownership.

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in Portugal?

Access to IPR and contracts must be negotiated with the PRO management, and not with individual researchers.

Most PROs are creating a specific office and training or hiring staff who are responsible for negotiating all contracts with external partners on behalf of the institution.

The professor or researcher, who carried the work that is covered by the IPR, usually has the right to be informed of all ongoing negotiations and his/her collaboration is often used.

PORTUGAL, PT

The PRO takes responsibility for sorting out the ownership issues with its staff, students and researchers so that it can negotiate directly with the business partner.

6) At what terms can IPRs be obtained from PROs in Portugal?

There is no legal requirement to ensure that the IPR will revert back to the PRO if commercialisation is not pursued by the industrial collaborator but PROs usually will try to get these provisions into contracts.

PROs are permitted to assign or license IPRs at non-exclusive as well as exclusive conditions. PROs are not entitled to accept payment for IPRs in the form of equity in public limited companies.

7) At what price can IPRs be obtained from PROs in Portugal?

Access to some public funding mainly that obtained through “Agência de Inovação” (AdI) require that IPRs that arise from research at the PRO are to be transferred to industry at market price but no general rule exists.

Price is determined by negotiation between the PRO and the Business.

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

Some funding sources (AdI) may require that the PRO owns or is compensated at market prices. Others state nothing.

9) How does funding affect exploitation of IPRs?

Some sources (IAPMEI and AdI) may require the exploitation partner to be an SME.

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

SIFIDE, tax benefits for corporate R&D

Published in 3/8/2005, Law (Dec. Lei) nº 40/2005 created SIFIDE – a tax benefit package for corporate R&D – expenses of “IRC passive subjects” (corporate tax) with application and maintenance of patents, as with acquisition of patents for R&D purposes can be deducted.

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

Publication may be delayed to some small extent while an application for IP protection, such as a patent, is being made.

PORTUGAL, PT

12) Are there any particular rules or requirements regarding publication?

There are no rules in legislation that hinders publication. Financiers might set up rules to promote patenting. Researchers and professors assessments encourage them to publish, since there is no consideration of patents or patent applications in regard to career paths.

FCT – National Science Foundation, usually requires PROs in Portugal to publish scientific results generated from research fully or partly funded by its means.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in Portugal?

PROs in Portugal do not have an agreed policy on IPRs and business-university collaboration.

14) Who should I contact for more information about IPR-contracts in Portugal's PROs?

Individual PROs or researchers.

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in Portugal regarding where to obtain IPRs?

A patent application does not have to be filed at the National Patent Office first before it can be filed abroad.

Information regarding obtaining IPRs in Portugal can be found through the Portuguese patent office or the GAPI network – network of Portuguese patlib centers.

Information is available at www.inpi.pt

16) Who will pay for the costs of obtaining the IPRs?

SIUPI funding managed by INPI will support up to 75% of all patent costs, fees, honoraries and translations.

Under SIUPI SMEs can get up to 40% to 45% funding of all patent costs.

17) Who will enforce the IPRs?

Decisions about who will enforce the IPRs should be specified in the collaboration agreement.

The law or jurisdiction that will be used if a legal dispute occurs should be specified in the contract.

PORTUGAL, PT

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

No stakeholders were contacted.

19) Where to get Further Up-to-date Information?

Last update - 26-05-2006

<http://www.inpi.pt>

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SLOVAK REPUBLIC, SK

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in the Slovak Republic.

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in the Slovak Republic?

Patents, Supplementary Protection Certificates, Utility Models, Topographies of Semiconductor Products, Trademarks, Designations of Origin/Geographical Indications, Designs. (Industrial Property Office of the Slovak Republic). Copyright and related rights (f. e. software) (Ministry of Culture of the Slovak Republic). No grace period for patent applications.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in the Slovak Republic?

IP-ownership at the Slovak Republic's PROs relates to the employment of the inventor. The employer shall exercise the right to the patent, utility model or design vis-à-vis the inventor in writing, within a time limit of three months from the inventor's written notification. If the employer shall not exercise the right, this right shall pass back to the inventor. In the Slovak Republic there is no professor privilege. PRO takes responsibility for sorting out the issue of IP ownership within its organisation so that it is able to negotiate with a potential collaborator.

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in the Slovak Republic?

Laws related to the IPR (in English):

www.upv.sk/index2.php?lang=en&idd=21
www.culture.gov.sk/english/legislation.html

Selected laws, obligatory directives and regulations concerning science and technology (in English):

www.veda-technika.sk/angl/default.htm
www.eracareers.sk/version_eng/index_en.php?l1=5&l3=1

4) Are there any differences within the Slovak Republic that will impact on the ownership of the IPRs?

No.

SLOVAK REPUBLIC, SK

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in the Slovak Republic?

IPR-contracts must be negotiated with a management (director) of the PRO, not with individual researchers.

6) At what terms can IPRs be obtained from PROs in the Slovak Republic?

There is not any legal requirement to ensure that the IPR will revert back to the PRO if commercialisation is not pursued by the industrial collaborator.

7) At what price can IPRs be obtained from PROs in the Slovak Republic?

IPRs arising from publicly financed research are to be transferred to industry at market price and they are negotiable.

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

In research collaboration projects between PRO and industry the ownership of joint inventions is an integrated issue of the individual contract.

9) How does funding affect exploitation of IPRs?

Funding does not affect the exploitation of IPRs.

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

No.

11) Are there any particular rules or requirements regarding confidentiality?

No, the rules governing confidentiality will only depend upon the conditions set out in the contract.

12) Are there any particular rules or requirements regarding publication?

Publication of the scientific results generated from research or filing a patent or utility model application is not obligatory, but it is one of the PROs evaluation criteria.

SLOVAK REPUBLIC, SK

Patents:

Such disclosure of the invention shall not be considered as the state of the art provided that such disclosure occurred no earlier than six months preceding the filing of the patent application and which directly or indirectly follows from:

- an evident abuse in relation to the applicant or his legal predecessor,
- the fact that the applicant or his legal predecessor has displayed the invention at an official or officially recognised exhibition pursuant to the international convention. In such a case when filing the patent application the applicant shall be obliged to state that the invention has been so displayed and within four months of filing the patent application file a certificate on the displaying of the invention pursuant to the international convention.

Utility models:

The state of the art excludes publication of the applicant's work or that of his legal predecessor which took place not less than six months before filing an application for utility model.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in the Slovak Republic?

Act No. 513/1991 Coll. Commercial Code as amended (Art. 508-515, 556-559).

14) Who should I contact for more information about IPR-contracts in Slovak PROs?

The contact persons for PROs can be found on the websites of the individual PRO.

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in the Slovak Republic regarding where to obtain IPRs?

National Patent Application:

- Can be filed only with the Industrial Property Office of the Slovak Republic. Parties without residence or seat in the Slovak Republic shall have to be represented in the proceedings by an authorized representative (patent attorney, advocate) with the exception of acts preceding and related to the accordance of the filing date, to the payment of the fees, to the demonstration of a priority right. Application can be filed electronically but has to be supplemented by the original written application.

SLOVAK REPUBLIC, SK

International Patent Application (PCT):

- Can be filed with the Industrial Property Office of the Slovak Republic by the natural persons who are the nationals of the Slovak Republic, or by the natural persons or legal persons with a residence or seat, establishment or organisational component in the territory of the Slovak Republic. Since 2006 application can be filed electronically.
- Can be filed with the Industrial Property Office of the Slovak Republic by legal or natural persons. Since 2006 application can be filed electronically but has to be supplemented by the original written application.

Patent applications do not have to be filed at the Industrial Property Office of the Slovak Republic first before it can be filed abroad.

Information regarding the services provided by the Industrial Property Office of the Slovak Republic in English are available at <http://www.upv.sk/index.php?lang=en&idd=&idd2=>

16) Who will pay for the costs of obtaining the IPRs?

Financing of patenting costs is usually an integrated issue of joint R&D contracts. Slovak public budgeted institutions (cca. 40 budgetary Institutions of the Slovak Academy of Science, cca. 10 State Research Institutions, Slovak Military) shall be exempt from the fees (patent fees etc.). Act No. 145/1995 on Administrative Fees (in English) <http://www.upv.sk/index2.php?lang=en&idd=22>

17) Who will enforce the IPRs?

Owner of the IPR.

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

19) Where to get Further Up-to-date Information?

Last Update: February 2006

The contact persons for PROs can be found on the websites of the individual PRO. The list of the existing R&D organisations in the Slovak Republic can be found at: http://www.eracareers.sk/version_eng/index_en.php?l1=5&l3=3

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SPAIN, ES

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in Spain.

Relevant links:

www.oepm.es,

www.csic.es/ott/,

www.redotriuniversidades.net,

www.mcu.es/jsp/plantilla_wai.jsp?id=1&area=propint

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in Spain?

Concerning the inventions there are in the Spanish law two types of rights, Patents and Utility Models, whereas for the protection of distinctive signs two types of IPRs are granted, Trademarks and Trade names. The industrial designs are independently regulated. Finally, the software and the teaching materials are considered to be Copyright

A Grace Period does not exist in Spain for patent applications or utility models.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in Spain?

The PRO owns the inventions created by their employees (provide that the employee in question have research functions) so that they are those who can negotiate the IPR with any public or private organisation. The University professors are in the same situation in relation to their Universities. The employees are entitled to compensation of almost a third of the proceeds from their creations. If the PRO decides not to keep the IPR, the inventor can apply for the patent. Nevertheless the PRO keeps some right, e.g., a non-exclusive but free exploitation license. In agreements with companies it is necessary to establish who the owner is.

Ownership of IPRs at PROs in Spain is regulated for patents in Spanish Patent Law (Art. 16-20) . According to this law the contracts signed by the PRO must specify who the owner of the rights is and to whom belongs the benefits.

Professor or researcher do not have ownership rights automatically.

We do not have a specific time limit for applying ownership of the IPRs.

SPAIN, ES

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in Spain?

Patents and other industrial property are regulated by the Spanish Patent Law. Also this matter is regulated by each specific University Statute; for other PROs there is a Royal Decree 55/2002. (January 18th 2002)

The text of the legislation is available on-line at <http://www.oepm.es>
Information for applicants in English is available on-line at <http://www.oepm.es/internet/eng/ventanilla/primer.htm>

4) Are there any differences within Spain that will impact on the ownership of the IPRs?

According to the Spanish Constitution ,regional governments have not an effect on IPR ownership.

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in Spain?

There is not a central body that negotiates contracts on behalf of all the PROs in Spain.

Each PRO negotiates its own IPR-contracts

The professor or researcher who carried the work that is covered by the IPR, usually does not have any rights in negotiating the IPR contract, but it is possible in some cases.

The PRO does not take responsibility for sorting out the ownership issues with its staff and researchers so that it can negotiate directly with the business partner
There are no regulations regarding to postgraduate or undergraduate students involved in the work which generated the IPRs.

6) At what terms can IPRs be obtained from PROs in Spain?

Usually, there is not any legal requirement to ensure that the IPR will revert back to the PRO if commercialisation is not pursued by the industrial collaborator.
But sometimes some requirements concerning this subject are included in the research agreement.

7) At what price can IPRs be obtained from PROs in Spain?

There is not a legal requirement that IPRs that arise from research at the PRO are to be transferred to industry at market price. The normal laws, including EU State Aid restrictions, are applicable.

It is the same if the research is funded either completely or in part by public money.

SPAIN, ES

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

The source of the public funding for the research that generated the IPRs does not place any conditions on the ownership of the IPRs. In case of private funding, this is regulated by the agreement.

There could be any specific requirements if the funding is from a third-party.

9) How does funding affect exploitation of IPRs?

The source of the public funding for the research that generated the IPRs does not place any conditions on the exploitation of the IPRs.

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

There is not any tax arrangement in Spain that will have an impact on the ownership of the IPR.

Ownership of IPRs is not relevant to qualify for a tax credit for research & development costs.

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

There are not any particular requirements in regard to PROs keeping research results confidential.

There are not any specific differences if the collaboration involves partners from outside of Spain, i.e. trans-national or cross-border collaboration.

12) Are there any particular rules or requirements regarding publication?

PROs in Spain are not obligated by law to publish scientific results generated from research fully or partly funded by public means (i.e., by Government).

There are not any specific differences when it is a trans-national or cross-border collaboration.

The publication of such results can be delayed while an application for IP protection, such as a patent, is being made.

SPAIN, ES

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in Spain?

PROs in Spain have not an agreed policy on IPRs and business-university collaboration.

14) Who should I contact for more information about IPR-contracts in Spain PRO?

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in Spain regarding where to obtain IPRs?

For national security reasons it is necessary to apply for the patent in the Spanish Patent and Trade Mark Office as a national patent , a PCT patent or a European patent.

This information is available on the website of the Spanish Patent Office, <http://www.oepm.es>.

16) Who will pay for the costs of obtaining the IPRs?

Specific arrangements are not available to the PRO to help them meet the costs of obtaining an IPR such as patent. Only Spanish public universities are exempt from paying fees in the Spanish Patent and Trademark Office for their patents.

Specific arrangements are not available to the SME to help them meet the costs of obtaining an IPR such as patent.

17) Who will enforce the IPRs?

The contract should give some information here that indicates that decisions about who will enforce the IPRs should be negotiated and specified in the collaboration agreement.

The law or jurisdiction will be indicated in the agreement. For Public Institution it is not possible to use the arbitration.

SPAIN, ES

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

19) Where to get Further Up-to-date Information?

Last updated: May 2006

www.redotriuniversidades.net,

www.csic.es/ott/.

www.oepm.es/

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SWEDEN, SE,

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in Sweden.

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in Sweden?

Universities

As a main rule the researcher owns the patent at Swedish universities and universities themselves are not allowed under Swedish law to have commercial activities.

But regarding different kinds of contract and collaboration research that are performed at the university including EU-projects, the university negotiates the contracts with the other parties, including questions about IPR. As a main rule the university will be compensated for the costs of the research and the researcher gets a royalty for the IPR. The IPR will normally be assigned to industry. The universities have holding companies that may commercialise the research results.

There is an exception for the universities that are foundations; from them you can obtain IPR.

Research Institutes

From the research institutes you can obtain any IPR.

Available IPR

The most important IP available in Sweden are patents, copyright, trademarks, design, plant refining rights and semiconductor protection.

Protection for Utility Models is not available in Sweden.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in Sweden?

Patents:

An inventor at a university owns his/hers invention if nothing else is agreed with a financier.

If the inventor is employed by a research institute, the research institute, as a main rule, has the right to take over an invention according to the law. If the collective agreement between SAF and PTK applies then the employer will own the invention as a main rule.

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Computer programs:

The employer owns the copyright to a computer program that has been created by an employee if nothing else has been agreed.

Since the universities may not involve themselves in commercialising activities they do not in practice, as a main rule, make use of this

Universities usually take responsibility for sorting out the IP ownership situation so that it is able to negotiate with a potential collaborator.

Universities that are foundations may own IP according to an agreement with the researcher but not universities that are governmental agencies. The universities that are governmental agencies have holding companies that may commercialise the research results.

Research Institutes ownership relates to the employment. The research institutes as employers have ownership rights to the IPR, but this does not apply for universities.

The professor's privilege in Sweden applies only to universities, not to research institutes.

You should specify who will own the IP in the contract – this applies to all IPRs including copyright. You should also specify if the contract relates to researchers at a university or a research institute.

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in Sweden?

The professor's privilege for universities is stated in a law on the right to inventions made by employees (lagen (1949:345) om rätten till arbetstagares uppfinningar). There are no special rules for research institutes.

All Swedish law is available on www.lagrummet.se, only in Swedish. An English version may be available soon on <http://www.sweden.gov.se/sb/d/3288>.

4) Are there any differences within Sweden that will impact on the ownership of the IPRs?

No.

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in Sweden?

Universities: In Sweden although there is a professor's privilege, as a main rule the university negotiate contracts concerning contract and collaborative research on behalf of it self and the individual researcher. The university will then have an agreement with the individual researcher about the rights to IPR.

Since the universities may not themselves exploit IPR they have been allotted holding companies. For the time being, all of the larger universities and some of the smaller universities have holding companies. Many of the holding companies

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are functioning as support organisations to individual researchers that want to exploit their inventions. They offer support against a share in the start up company or a share from the royalty income. An example of such a holding company is Karolinska Innovation AB, connected to Karolinska Institutet, the world renowned medical university. Karolinska Innovation AB also helps inventors from other universities in Sweden and other Nordic universities within their field of specialization.

There are other organisations handling IPR stemming from university researchers. For example SweTree Technologies AB is a company owned by some of the universities holding companies, by a company owned by 46 researchers within the forest biotech sector and other companies within the forest biotech sector. The researchers assign all their patents to SweTree Technologies AB against a royalty and SweTree Technologies AB is responsible to commercialise the patent through licensing or forming a start up.

The answer to the question with whom you should negotiate IPR stemming from researchers within Swedish universities differs from situation to situation. If it's a matter of IPR that will arise (and does not already exist) from contract and collaborative research, the best thing is to address the university and to regulate these rights in the agreement with the university – obliging the university to get the negotiation rights from the researcher. If the IPR already exists, then the best thing is to ask the researcher that can negotiate himself or inform you about who to negotiate with.

Research institutes: At research institutes the rights to negotiate follow the normal rules for power of attorney.

There is no central mechanism to negotiate IPR contracts with PROs in Sweden.

6) At what terms can IPRs be obtained from PROs in Sweden?

There are no common terms. The negotiation is open between the parties. There is no requirement that the IPR will revert to the PRO if commercialisation is not pursued by the industry partner.

7) At what price can IPRs be obtained from PROs in Sweden?

There is a regulation that requires the universities to cover the full costs of research. There is no legal requirement for the research institutes.

It follows from the state aid rules that the IPR should be transferred at market price.

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

State funding does not affect IP-ownership. Private/industry funding of R&D contracts usually transfer the IPR to the industry. If the research is co-financed by the state and the industry it is often agreed that the IPR should belong to the inventing party or to the industry.

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9) How does funding affect exploitation of IPRs?

Each financier might set up conditions for their funding. You have to look at the conditions of each financier.

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

No. The ownership of an IPR is tax-wise treated in the same way as the ownership of other property. A Swedish company's right to deduct its R&D costs has no connection to the ownership of an IPR. The company shall deduct its costs, including R&D costs, according to acknowledged accounting standards. In case of a sale of an IPR the seller might be liable to pay Swedish VAT ("mervärdesskatt").

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

Universities: The universities are subject to the principle of free access to public records which means that the public may anonymously request information from the universities. If there is a support for confidentiality within the code of secrecy, as for contract research, the universities may refuse access to the information. The researchers may not publish information that constitutes business secrets. On the other hand, if it is not contract research, the public may request and receive the information (if there are no other applicable exceptions).

Research institutes: The researchers may not publish information that constitutes business secrets. But, most of the research institutes are not subject to the principle of free access to public records since they are companies. There is however research institutes that are governmental agencies and then the principle of free access apply.

The situation also applies to cross-border collaborations since the law that protects business secrets is penalty based, and penalty may only be enforced in Sweden for deeds done in Sweden.

12) Are there any particular rules or requirements regarding publication?

Except from the rules concerning business secrets there are no legislation that hinders publication.

Financiers might though set up rules in the contract to promote patenting and to postpone the publication of results with the regard to protection of IPR. The delay can be between one and three months. Swedish PROs quality of research is, among other things, measured on the basis of published scientific research.

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SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in Sweden?

There is no formal national contact point but VINNOVA, the Swedish Governmental Agency for Innovation Systems, can help you find the way.

VINNOVA, universities, research institutes and industry has together been working on a model contract for collaboration research between PROs and industry. The work will be finalized before end of September 2006. The model contract with legal comments will be available in English when finished. The latest draft of the model contract with legal comments is available at www.VINNOVA.se.

14) Who should I contact for more information about IPR-contracts in Sweden's PROs?

There is no formal national contact person. Here are some suggestions of persons. Catharina Sojde, Head Legal Officer, VINNOVA- the Swedish Governmental Agency for Innovation Systems (Catharina.Sojde@VINNOVA.se).

You might also contact the legal officer at a university or a CEO at the research institute.

Section 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in Sweden regarding where to obtain IPRs?

Patent applications resulting from joint R&D-projects with Swedish PROs could be filed optionally at the Swedish Patent Office or at an international patent authority.

Information (also in English) may be obtained from the Swedish Patent and Registration office at the web-site www.prv.se.

Applications can be filed electronically to PRV concerning protection for patents and design, but not for trademarks.

16) Who will pay for the costs of obtaining the IPRs?

Financiers.

VINNOVA currently has calls for proposal concerning support to PROs and SMEs that may include these costs. There are also other financiers such as Innovationsbron, ALMI Företagspartner AB.

17) Who will enforce the IPRs?

The owner. The universities will not be the owner and will not agree to defend a patent. However the holding companies can enter into other contractual obligations.

The jurisdiction is decided by the agreement or by international private law.

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SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

The Chief Legal Officer at Uppsala university and Legal Counsel at Research & Innovation Services, Göteborg university.

19) Where to get Further Up-to-date Information?

Last updated: June 22, 2006

Catharina Sojde, Head Legal Officer at VINNOVA, Catharina.Sojde@VINNOVA.se

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SWITZERLAND, CH

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in Switzerland.

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in Switzerland?

Inventions are protected by patents.

Software and publications are generally protected by Urheberrecht (Copyright).

Trademark and Design protection gain importance for the research society.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in Switzerland?

At most major PROs IP belongs to the PRO. Exact regulations differ from PRO to PRO.

Inventions and designs developed under a contract of employment belong to the employer (Art 332 of the Swiss Code of Obligations). Research results made by university staff during their research activity are generally owned by the universities. The rights of the partners to results which are acquired during collaborations are stipulated by contract.

ETH (Eidgenössisch Technische Hochschulen)

For the ETH institutions all intellectual property rights, with the exception of copyrights, created under a contract of employment with these institutions generally belong to the ETH institutions (Art 36 Federal Law for the ETH).

Exceptions are inventions by students: ETH Zurich cannot claim any inventions made by its students within the scope of their coursework or diploma work (i.e. without being employed or paid). However, the students may transfer their rights to ETH Zurich and will then be supported and participate in any income on the same basis as ETH employees.

For Software programmes developed under a contract of employment with an ETH institution the right to use and exploit these programmes are with the ETH institutions. For the transfer of other copyright protected products the ETH institutions can apply contractual arrangements with the right holders (Art 36, 2 Federal law for the ETH).

Usually the specific University regulations foresee that the employee-inventors are entitled to a fair participation in income.

Art 12 of the law for the ETH Zürich: The university regulates the authorisation requirements that are necessary if university staff take on paid or unpaid activities in addition to their university engagement. The university regulates of the use

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of infrastructure and university staff. Inventions and computer software made by university staff during or in connection with their official occupation belong to the university. The inventor/author will be duly compensated. The University can claim a fair share of substantial earnings (higher income than CHF 30.000) from copyright protected work (other than software) that was developed within an employee's official duties.

See also École Polytechnique Fédérale de Lausanne: http://sri.epfl.ch/Jahia/site/sri_en/pid/1275/cache/off/?print=true&matrix=8737

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in Switzerland?

1. National Swiss legislation on Intellectual Property Rights (Patents, trademarks and indications of source, Copyright and Neighboring Rights, Topographies of Semiconductor Products, design) can be found under: www.ige.ch/E/jurinfo/j150.shtm
2. Unictetra Technology Transfer Office for the Universities of Zürich and Bern, www.unictetra.ch/en/index_en.htm
3. École Polytechnique Fédérale de Lausanne, General Principales of Technology Transfer at Swiss Universities <http://sri.epfl.ch/en/page1260.html>
4. École Polytechnique Fédérale de Lausanne; Instructions regarding allocation of income resulting from commercial exploitation of inventions, <http://sri.epfl.ch/en/page1275.html>
5. Guidelines for the commercialisation of research results at the University of Zurich www.unictetra.ch/medien/Richtlinien_Verwertung_050101.pdf
6. Guidelines for the commercialisation of research results at the University of Bern www.unictetra.ch/en/infos_forscher/8_171.htm
7. ETH Zürich www.transfer.ethz.ch/index_EN

4) Are there any differences within Switzerland that will impact on the ownership of the IPRs?

Exact regulations differ from PRO to PRO.

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in Switzerland?

IPR-contracts must be negotiated with the PRO management, not with individual researchers. In practice, PRO managements have often authorized a patent- or tech trans office to negotiate contracts with external partners on behalf of the institution.

In the case of The Universities of Bern and Zürich this is done by Unictetra: www.unictetra.ch/en/index_en.htm

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For the École Polytechnique Fédérale de Lausanne this can be done by the Industrial Relations Office only.

For ETH Zürich this is done by ETH transfer: http://www.transfer.ethz.ch/index_EN

6) At what terms can IPRs be obtained from PROs in Switzerland?

Exact regulations differ from PRO to PRO. Most major PROs license their inventions at reasonable terms and do not assign their IP rights.

7) At what price can IPRs be obtained from PROs in Switzerland?

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

Exact regulations differ from PRO to PRO. At most major PROs a differentiation is made between sponsored/collaborative research and pure contract research: In case of sponsored/collaborative research the industry partner is granted an option to acquire an exclusive license to the research results. In case of fully paid contract research the IP belongs to the industry partner.

The biggest donor for publicly funded research in Switzerland is the Swiss National Science Foundation (SNF). For projects funded by the SNF the common rules of the SNF apply:

Generally, the rights on research results from SNF funded projects belong to the recipients, respectively their employer (Art 43, 1 SNF rules). The SNF does not expect refunding in case of commercial exploitation of results from funded projects. However, recipients are obliged to inform the SNF about the application of any patents or other intellectual property rights deriving from the projects as well as about their commercialisation (Art 43, 2 SNF rules).

The SNF can oblige the recipients of its funds to make data available for other researchers and follow-up research which have been achieved by funded projects. This comprises the inclusion into publicly available databases.

9) How does funding affect exploitation of IPRs?

See answer to question 8 above.

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

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SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

12) Are there any particular rules or requirements regarding publication?

Most Swiss PROs do not accept veto rights against publication of collaborative research but allow a delay in publication in order to first secure IP rights (usually up to 60 days).

According to the rules of the Swiss National Science Foundation, recipients of funding are obliged to make research results available for the general public (publication). This rule does not apply in case of justifiable interests of secrecy or in case of the application for patent rights (Art 44, 1 SNF rules). SNF has to be informed in advance about any contractual secrecy regulations.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in Switzerland?

General information:

www.unitectra.ch/en/infos_forscher/8_219.htm

Sample contracts for a clinical study agreement:

www.unitectra.ch/medien/CLINICAL_STUDY_AGREEMENT_050718.doc

www.unitectra.ch/medien/STANDARD_CRA_INSEL_051001.doc

Sample Material Transfer Agreement:

www.unitectra.ch/medien/MTA_050209.doc

14) Who should I contact for more information about IPR-contracts in Swiss PROs?

Relevant contact persons for all PROs can be found on the websites of the individual PRO. Alternatively the organisation of Swiss tech transfer professionals SwiTT can be contacted (www.switt.ch).

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in Switzerland regarding where to obtain IPRs?

Patent applications resulting from joint R&D-projects with Swiss PR's can be filed optionally at the Swiss Federal Institute of Intellectual Property, the European Patent Office or at an international patent authority.

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Information regarding services of the Swiss Federal Institute of Intellectual Property is available on the website www.ipi.ch.

16) Who will pay for the costs of obtaining the IPRs?

There are no general rules.

PROs pay their patent costs usually from their basic funding. If an invention is made within a collaborative research project with an industrial partner usually the industrial partner takes responsibility for IP protection and in return is granted an exclusive, royalty bearing license to such IP.

Some PROs encourage the contributions from industrial partners (e.g. University of Zürich) where industrial partners (licensees) cover the costs of patenting (University of Zürich, Guidelines for commercialisation, Art.5).

ETH Zürich:

If an invention is made within an internal ETH project, patents will be filed in the name of ETH Zurich (see above). The costs will be borne by the ETH Research Administration if:

- the invention appears to be patentable on the basis of the available information and is of interest to ETH Zurich;
- the exploitation strategy had been discussed in advance with ETH transfer and the Vice President Research supports an exploitation;
- there is preferably no dependence on patents by third parties; and
- a potential market or prospective customers exist.

The Vice President Research decides as quickly as possible.

17) Who will enforce the IPRs?

Usually it lies upon the owner of the IPRs to enforce them. However, the major PROs allow their exclusive licensees to enforce IPR on their behalf to secure the licensee's investments.

Otherwise enforcement of patents is usually an integrated issue of joint R&D contracts.

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

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19) Where to get Further Up-to-date Information?

Updated 1st March 2006

Relevant contact persons for all PROs can be found on the websites of the individual PRO. Alternatively the organisation of Swiss tech transfer professionals SwiTT can be contacted (www.switt.ch).

Information regarding services of the Swiss Federal Institute of Intellectual Property is available on the website www.ipi.ch.

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UNITED KINGDOM, UK

A summary of the issues that potential research collaborators from another European country need to be aware of regarding access to intellectual property rights (IPRs) generated by public research organisations (PROs), including universities, in the United Kingdom.

SECTION 1 Types of Intellectual Property Rights (IPRs)

1) What type of IPRs can be obtained from PROs in the United Kingdom?

No utility model or petty patent exists in the UK. No grace period applies in the UK.

SECTION 2 Ownership of Intellectual Property Rights (IPRs)

2) Who owns the IPRs at PROs in the United Kingdom?

Basically, PROs in the UK own any IP created by their employees. Subsequently, the PRO can negotiate assignment or licensing of IPRs with industrial partners or customers.

According to the UK Patents Act 1977, employees are entitled to fair compensation for inventions that have proved to be of 'outstanding benefit' to the employer. It is up to the employee to demonstrate that the benefit to the employer has been outstanding if he/she considers that he/she has not received fair compensation. In regard to copyright and software, the general rule is that the creator is the first owner of the copyright. This rule also applies to commissioned works, unless an agreement to the contrary has been made with the author, for example a contract has been signed saying that the commissioner will own the copyright. However, where such a work is made in the course of employment, the employer is the first owner of these rights.

3) What is the legal situation regarding IPRs generated by PROs and/or using public funding in the United Kingdom?

The text of the legal acts which concern patents, copyright, trademarks and designs in the UK can be found on the website of the UK Patent Office at <http://www.patent.gov.uk> under the required heading, for example, for patents law see www.patent.gov.uk/patent/legal/index.htm.

Ownership of patents is dealt with specifically in the Patents legislation and not under Employment law.

Information on other types of less common IPR also available in the UK can be found on the UK IP Portal at www.intellectual-property.gov.uk/resources/other_ip_rights/index.htm

4) Are there any differences within the United Kingdom that will impact on the ownership of the IPRs?

The system in the UK for application and granting of IP rights is a national one. The only occasion where differences arise can be in deciding where and how to enforce the IPRs as there are 3 different court jurisdictions in the UK: (i) England

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& Wales, (ii) Scotland and (iii) Northern Ireland. However, in practice most IP disputes are handled in the England & Wales jurisdiction.

SECTION 3 Negotiation of IPR-contracts

5) Who is entitled to negotiate IPR-contracts at PROs in the United Kingdom?

Access to IPR and contracts must be negotiated with the PRO management, and not with individual researchers. Most PROs in UK have a specific office and staff who are responsible for negotiating all contracts with external partners on behalf of the institution.

6) At what terms can IPRs be obtained from PROs in the United Kingdom?

PROs are permitted to assign or license IPRs at non-exclusive as well as exclusive conditions. The greater the degree of control required by the industrial party, the greater should be the level of remuneration to the PRO. PROs, are considered as charities in the UK and although they are not required to earn a profit they are required to make sure that they get a fair market return for any results that they assign or license that was funded by public money. However, any contract assigning exclusive rights to a single company must not result (i) in an illegal distortion of competition or (ii) state aid to the company in question.

Within certain limits PROs are entitled to accept payment for IPRs in the form of equity in public limited companies.

PROs are required to make sure that they obtain a suitable reward from exploitation of IP that arises from the research of the institution. For this reason PROs will often require a clause in IPR-contracts with industry for IPRs to be reverted to the institution, if commercialisation is not diligently pursued by the licensee or assignee.

7) At what price can IPRs be obtained from PROs in the United Kingdom?

This is determined by negotiation between the PRO and the Business.

SECTION 4 Effect of Funding on IPR Contracts

8) How does funding affect IPR-ownership?

Ownership of the IPRs is usually dictated by the source of funding but if no rules are laid down the general principle is that the PRO, if successful with the funding application, will own the IPRs. The industrial party will have a right to access the IPRs for commercial exploitation, for example through assignment or licensing, but the PRO should receive financial remuneration at market terms.

If an invention arises from a project funded exclusively by industry (commissioned research), it is commonly agreed in the contract that all IPRs should belong to

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the funding party. If the funding party wants to retain exclusive control over the publication of the results of the research, they need to compensate the PRO accordingly.

If an invention arises from a project jointly funded by private and public means (co-financed research), it is often agreed in the contract that IP should belong to the inventing party with the other party or parties having access to the IPRs upon terms agreed in the contract.

9) How does funding affect exploitation of IPRs?

See answer to question 8 above.

10) Are there any fiscal measures that impact on funding or ownership of IPRs?

A UK company who can demonstrate that they have made a significant investment in Research & Development (R&D) is entitled to claim a tax credit for the costs of the R&D. IPRs, in particular patents, are considered to be a suitable way to demonstrate such an investment in R&D. For this reason, a UK company, especially an SME may want sole or joint ownership of the IPR so that they can claim the tax credit for research & development costs. For more information on , see <http://www.hmrc.gov.uk/randd/sme.htm> (flowchart explaining role of IP in R&D Tax credits in the UK).

SECTION 5 Confidentiality & Publication

11) Are there any particular rules or requirements regarding confidentiality?

There are no rules or requirements that would prevent either party from agreeing to preserve confidentiality of the other party's confidential material.

12) Are there any particular rules or requirements regarding publication?

UK PROs have a responsibility to publish and disseminate the results of research funded wholly or partly by public money. However, PROs can agree to delay publication to allow for applications for the appropriate IPRs to be made or if the information is commercially important for the Industrial partner. It is generally acknowledged by Research Councils and HMG that publication by academics is important and to be encouraged. There are no legal rules stating this, however, it is usually part of University mission statement and objectives of departments/ academics. Contract based provisions are usually about how to manage publication on suitable timescale to allow application for IPRs first.

SECTION 6 Examples and Further Information of IPR-contracts

13) Where can I learn more about IPR-contracts in the United Kingdom?

A set of model contracts showing five different types of collaboration between a PRO and a Company and a number of tools showing how to choose the most

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suitable contracts have been prepared and widely promoted in the UK. These materials are known as the Lambert Model Agreements Toolkit and are available in CD-ROM format from the UK Patent Office as well as on the website of the UK Department of Trade and Industry (DTI) at www.innovation.gov.uk/lambertagreements/

UK PROs will usually seek an agreement (indemnity) from the industrial partner that it will cover the University and its employees against any claim that is brought against them as a result of the industrial partner's use of the results. The reason for this is that the industrial partner takes the commercial risks associated with its use of the IP. The indemnity is a conditional one and the PRO claiming the benefit of the indemnity must let the Sponsor know about the claim quickly, not make any admission, allow the Sponsor to deal with the claim, and help the Sponsor in dealing with it (at the Sponsor's expense). These conditions are imposed to make sure that the University and its employees and students do not make matters worse and potentially increase the amount of the claim. The industrial partner will not indemnify anyone if it is their negligence or deliberate breach of the agreement, or a breach of confidence that has given rise to the claim.

14) Who should I contact for more information about IPR-contracts in the British PROs?

There are just over 260 PROs in the UK which includes universities and public sector research establishments. Each one has its own office and staff responsible for handling IPR contracts or is part of a network which has such facilities. Contact information for these PROs can be obtained principally from: (i) the website of AURIL (Association for University Research and Industry Links) at <http://www.auril.org.uk/contacts> ; but also from (ii) the website of Universities UK at <http://www.universitiesuk.ac.uk/> and (iii) the website of the UK Research funding Councils at www.rcuk.ac.uk/

In addition to the website details provided above, enquiries about obtaining IPRs can be made by telephone to the UK Patent Office at (0845) 9500505 (caller within UK only) or +44 (0)1633 813930 (caller outside UK).

SECTION 7 Protection and Enforcement of IPRs

15) Are there any specific requirements in the United Kingdom regarding where to obtain IPRs?

UK applicants are free to decide which Patent Office they use to apply for a patent. The only restriction concerns patent applications for technology that affects matters of national security and/or safety of the public. Permission must be obtained from the UK Patent Office before a foreign patent application for such technology can be made. Patent Applications can be made electronically.

For full details of how to obtain a patent in the UK, please see the website of the UK Patent Office at www.patent.gov.uk/patent/howtoapply/index.htm; for information on how to apply for a trademark see www.patent.gov.uk/tm/howtoapply/index.htm and for a design see www.patent.gov.uk/design/howtoapply/index.htm

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16) Who will pay for the costs of obtaining the IPRs?

The cost of obtaining IPRs such as a patent is born by the applicant. There are no special funding arrangements to help PROs to pay the cost of obtaining IPRs. PROs who apply for a patent in order to ensure that the invention is protected, will usually seek to be reimbursed for these costs by the industrial partner who will exploit technology.

17) Who will enforce the IPRs?

This issue is usually established as part of the negotiation between the business and the PRO.

SECTION 8 Consultation and Sources of Further Information

18) What stakeholders were consulted when preparing this fact-sheet?

19) Where to get Further Up-to-date Information?

Last Update: 9 February 2005

There are just over 260 PROs in the UK which includes universities and public sector research establishments. Each one has its own office and staff responsible for handling IPR contracts or is part of a network which has such facilities. Contact information for most of these PROs can be obtained principally from: (i) the website of AURIL (Association for University Research and Industry Links) at www.auril.org.uk/contacts; but also from (ii) the website of Universities UK at www.universitiesuk.ac.uk/ and (iii) the website of the UK Research funding Councils at www.rcuk.ac.uk/.

In addition to the website details provided above, enquiries about obtaining IPRs can be made by telephone to the UK Patent Office at (0845) 9500505 (caller within UK only) or +44 (0)1633 813930 (caller outside UK).

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Appendix C – Sample project description²

Example of a Project Description Template to be attached to a collaboration agreement as an Annex or Schedule.

A Schedule [or Annex] to the collaboration agreement should contain a full description of the Project, clearly setting out what each party is to do (with a timetable if appropriate), and the human resources, facilities and equipment each party is to provide.

Below is a list of the matters that should be covered in such a Schedule [or Annex]. It is not exhaustive and there may be additional issues that are important to the Project.

This is an example that has been widely used in the UK

1. Scope of the Project
 2. Aims of the Project
 3. Any Key Personnel to be provided by the Public Research Organisation (PRO) (including the Principal Investigator)
 4. Any Key Personnel to be provided by the Industry Collaborator (including the Industry Supervisor (if any))
 5. Numbers of other full and part time staff to be provided by each party
- If either party is to recruit any key personnel, and whether the approval of the other party is necessary, should be clearly stated in this Schedule.
6. Students participating in the Project
 7. Project Management
 - a. who is to act as overall project manager
 - b. responsibilities of project manager
 - c. project meetings (frequency, location and representation of each party)
 8. Provision of information and reports to any body providing External Funding
 9. Facilities to be provided by each party
 10. Equipment to be provided by each party (and whether, if provided for use by the other, it is donated to the other or is on loan until the end of the Project. If any equipment is on loan, this Schedule [or Annex] should set out responsibility for maintaining it.)

² This was developed as part of the Lambert Model Agreements Toolkit in the UK to ensure that a suitable project description would be included with the collaboration agreement and has proved very helpful in the UK.

11. Where the Project is to be carried out
12. Any Background (including materials) that the Industry Collaborator must provide
13. Any Background (including materials) that the PRO must provide
14. Any Background (including materials) that is to be obtained by either party from a third party
15. Whether all Background is to be kept Confidential or which Background is to be kept confidential, for instance:

All of the Sponsor's Background [except ?????] is Confidential Information.
16. Anticipated Outputs or Results
17. Tasks to be performed by each party (with timetable for delivery)

Appendix D – Summary Tables of information in Work stream 1 fact sheets

Table 1: IPR Ownership [as set out in fact sheets as at 14/6/2006]

Note: In this table universities are dealt with separately from other PROs. In some countries the law treats university employees differently from PRO employees.

| Country | University owns IPR created in course of employment | University employee owns IPR ('Professors' privilege') | Students: Do they own IPRs in their creations (if not employee of PRO) | Other Research Organisation: RO owns | Other Research Organisation: Employee owns | Computer programs | Other copyright |
|---------------------------|--|--|---|--------------------------------------|--|-------------------|---------------------|
| Austria | Yes. Employer must claim the right and must pay compensation based on the actual value of the invention. | No. | Student owns IPR. | Usually - by employment contract. | If no contract. | Employer. | Individual creator. |
| Belgium (Flanders region) | Yes. | No. | Student owns IPR unless a beneficiary of a publicly-funded scholarship. Some universities' internal regulations provide for disclosure and PRO right to claim IPR created by students using university infrastructure. The IP in the thesis remain principally with the student. | By employment contract. | No. | Employer. | Individual creator. |
| Czech Republic | Yes (employer must declare interest in asserting right). | No. | Student owns IPR. | Same as university. | Same as university. | Employer. | Employer. |
| Denmark | Yes (must claim right). | No, unless the employer does not claim the IPR. | PhD = employee – PRO owns IPR. Graduate student: not – student owns IPR. | Same as university. | Same as university. | Employer. | |

Appendix D – Summary Tables of information in work stream 1 fact sheets

| Country | University owns IPR created in course of employment | University employee owns IPR ('Professors' privilege') | Students: Do they own IPRs in their creations (if not employee of PRO) | Other Research Organisation: RO owns | Other Research Organisation: Employee owns | Computer programs | Other copyright |
|---------|---|--|--|--------------------------------------|--|-------------------|---------------------------------|
| Finland | From 01/01/2007, University administers IPRs resulting from research under contracts w/3rd party. | Contract/ Collaborative Research: Employed inventor owns, but from 1/1/2007 must notify university which may claim IPR. Open Research: University can only claim if inventor has no plans to utilise. | Student owns IPR. An exception may apply if a student acts as a research assistant or does teaching on the side. | Yes. | No. | Employer. | ? |
| France | Yes (University also has right to claim IPR of non-employed researcher that has used university's means). | Only if outside course of employment + not use employer's means. | Yes, in the absence of a contract of assignment with the PRO. PRO has a right to claim IPR in inventions created using PRO's means. | Same as university. | Same as university. | Employer. | Individual creator or employer. |
| Germany | University may claim invention w/in 4 months of notice from employee. | Employed inventor owns, but must notify university which may claim IPR. Researcher retains non-exclusive right for scientific purposes. | Student owns IPR. | Same as university. | Same as university. | Employer. | Employer. |
| Hungary | Yes. PRO may claim IPRs in service invention within 90 days of notification. | No, unless no claim from employer. | Student owns IPR. ³ | Same as university. | Same as university. | Employer. | Employer. |
| Ireland | Yes. | No. | Student owns IPR. Most universities will have agreement in place with students transferring ownership to the university. | Same as university. | Same as university. | Employer. | Employer. |
| Italy | Usually, by contract. Gets non-excl. rights if patent is not exploited w/in 5 yrs of grant. | Yes (entitled to 50% of proceeds). | Student owns IPR. Most universities will have agreement in place with students in research projects, transferring ownership to the university. | Same as university. | Same as university. | Employer. | Employer. |
| Latvia | Yes (but revert to inventor if right not exercised w/in 3 months). | No. | ? | Same as university. | Same as university. | Employer. | ? |

³ Hungary: The Act on Universities of 2005 has created uncertainty as to when IPRs will belong to the university and when to the student.

Appendix D – Summary Tables of information in work stream 1 fact sheets

| Country | University owns IPR created in course of employment | University employee owns IPR ('Professors' privilege') | Students: Do they own IPRs in their creations (if not employee of PRO) | Other Research Organisation: RO owns | Other Research Organisation: Employee owns | Computer programs | Other copyright |
|-----------------|---|--|--|--------------------------------------|--|-------------------|---------------------|
| Netherlands | Yes. | No. | Student owns IPR. | Same as university. | Same as university. | Employer. | Employer. |
| Norway | Yes, but must claim w/in set time after notification). | No (since 1/1/2003) , unless no claim from employer. | Student owns IPR. | Same as university. | Same as university. | Employer. | ? |
| Slovak Republic | Yes, but must assert claim w/in 3 months of notification. | No, unless no claim from employer. | Student owns IPR. | Same as university. | Same as university. | Employer. | Employer. |
| Spain | Yes. If PRO decides not to exploit, IPRs revert to employee, subject to a non-exclusive licence to the PRO. | No. | Students who are not employees of the PRO must sign a contract of transfer of IP rights to the PRO. PRO has a right to claim IPR in inventions created using PROs means. | Same as university. | Same as university. | Employer. | Employer. |
| Sweden | No. | Yes (Universities.) | Student owns IPR. | Same as university. | Same as university. | Employer. | Individual creator. |
| Switzerland | Generally. | No. | Student owns IPR. | Same as university. | Same as university. | Employer. | Individual creator. |
| UK | Yes. | No. | Student owns IPR. | Same as university. | Same as university. | Employer. | Individual creator. |

Table 2: Contract negotiation as set out in fact sheets as at 14/6/2006

| Country | PRO negotiates | Comments | Academics/ Researchers negotiate | Comments |
|---------------------------|----------------|---|----------------------------------|--|
| Austria | ✓ | Usually TTO. | No. | |
| Belgium (Flanders region) | ✓ | TTO. | No. | |
| Czech Republic | ✓ | | No. | |
| Denmark | ✓ | Usually TTO. | No. | |
| Finland | ✓ | TTO (even where IPRs owned by employees). | No. | |
| France | ✓ | TTO. | No. | |
| Germany | ✓ | Sometimes a centralised office representing several institutes, e.g. Fraunhofer-Patentstelle in Munich. PVAs have been established to represent universities in each Federal State (<i>Land</i>). | No. | |
| Hungary | ✓ | | | |
| Ireland | ✓ | Usually TTO. | | |
| Italy | ✓ | When researcher's contract assigns rights to PRO. | | Except where researcher's contract assigns rights to PRO. |
| Latvia | ✓ | | No. | |
| Netherlands | ✓ | Usually TTO. | No. | |
| Norway | ✓ | Usually TTO. | No. | |
| Slovakia | ✓ | | No. | |
| Spain | ✓ | | No. | |
| Sweden | ✓ | If it's a matter of IPR that will arise (and does not already exist) from contract and collaboration research, the PRO will negotiate. | ✓ | There are exceptions: where university holding company or some other entity handles patents for researchers. If the IPR already exists, the best thing is to ask the researcher that can negotiate himself or inform you about who to negotiate with. |
| Switzerland | ✓ | Usually TTO. | No. | |
| United Kingdom | ✓ | Usually TTO. | No. | |

Table 3: Contract terms as set out in fact sheets as at 14/6/200

| Country | The PRO is empowered to: Assign IPR | Exclusively licence | Non-exclusively licence | Accept equity in payment | Reversion of rights required if commercialisation not pursued? | Comments |
|---------------------------|---|--|-------------------------|--|---|---|
| Austria | ✓ (but no distortion of competition, no state aid). | ✓ (but no distortion of competition, no state aid). | ✓ | ✓ (within limits). | No legal requirement for reversion. | EC State Aid regulations require market price. |
| Belgium (Flanders region) | ✓ (but no distortion of competition, no state aid). | ✓ (but no distortion of competition, no state aid). | ✓ | ✓ | No requirement but usual practice. Re-searcher can require PRO to return IPR if no commercialisation. | EC State Aid regulations require market price. |
| Czech Republic | ✓ (but no distortion of competition, no state aid). | ✓ (but no distortion of competition, no state aid). | ✓ | ✓ | No requirement, but usual practice to require reversion if no commercial exploitation. | EC State Aid regulations require market price. |
| Denmark | ✓ (but no distortion of competition, no state aid). | ✓ (but no distortion of competition, no state aid). | ✓ | ✓ (within limits). | Usual practice to require reversion if no commercial exploitation. | EC State Aid regulations require market price. |
| Finland | ✓ (but no distortion of competition, no state aid). | ✓ (but no distortion of competition, no state aid). | ✓ | ✓ | No requirement, but likely to be usual practice to require reversion if no commercial exploitation | EC State Aid regulations require market price. |
| France | ✓ (but no distortion of competition, no state aid. There must be a financial contribution from the industry partner). | ✓ (usually transformed to non-exclusive if invention not commercialised within agreed period of time). | ✓ | ✓ | Recommendation: exclusive rights transform to non-exclusive if there is no commercial exploitation within agreed time. | Freely negotiable – market price the standard. |
| Germany | ✓ (but no distortion of competition, no state aid). | ✓ (but no distortion of competition, no state aid). | ✓ | In certain cases (e.g. in start-ups in non-university PROs). | It is usual to agree to a reversion if commercialisation is not realised within the agreed time. | EC State Aid regulations require market price. |
| Hungary | ✓ (but no distortion of competition, no state aid). | ✓ (but no distortion of competition, no state aid). | ✓ | ? | Usual practice to require reversion if commercialisation not diligently pursued. | EC State Aid regulations require market price. |
| Ireland | ✓ (but no distortion of competition, no state aid). | ✓ (but no distortion of competition, no state aid). | ✓ | ? | National Code of Practice (Public/Private research) recommends agreed consequences should obligation to commercialise not be met. | EC State Aid regulations require market price. National Code of Practice (Publicly-Funded Research) sets out factors to be considered in estimating value. |
| Italy | ✓ (but no distortion of competition, no state aid). | ✓ (but no distortion of competition, no state aid). | ✓ | ✓ (In the case of start-ups). | Usual practice to require reversion if no commercial exploitation. | EC State Aid regulations require market price. |

Table 4: The Effect of Funding as set out in fact sheets as at 14/6/2006

| Country | | Effect on contractual arrangements w/industry partner: | |
|---------------------------|---|--|---|
| | Effect of public funding on ownership of fruits of research | Where wholly/partially publicly funded | Where wholly funded by industry partner (commissioned research) |
| Austria | No impact. | Contract often provides IP belongs to inventor. Joint inventions: contract often provides industry partner should be able to commercially exploit IPR. | Contract generally provides that IPR owned by industry partner. |
| Belgium (Flanders region) | Recipient(s) of funds owns IPR and must fulfil agreed exploitation obligations. In some cases there may be an obligation that the gross added value of the exploitation within/accruing to the Flemish region should be ten times the original funding grant. | Contract often provides IP belongs to inventor. Depends on input, incl. background know-how. Co-ownership without accounting very frequently used. | Industry partner will get at least necessary rights to exploit the results commercially. |
| Czech Republic | State funding does not affect IPR ownership | Depends on contract. | Depends on contract |
| Denmark | Initial ownership of IPRs is determined by the employment of the inventor and not by the source of public funding | Contract often provides IP belongs to inventor. Joint inventions: contract often provides industry partner should be able to commercially exploit IPR. | Contract generally provides that IPR owned by industry partner. Universities are permitted to renounce all rights to future inventions that might arise from a project. |
| Finland | Yes. Where research is publicly-funded 'professor privilege' will still apply and the first owner of the IPR will be the individual researcher. | Under national industry/PRO accord, IPR belongs to inventor. Joint ownership only where not possible to identify a single inventor. | Under the new law (from 1/1/2007) the PRO will have the right to acquire the right in IPR created by its employees and will therefore be able to transfer rights as appropriate to the commissioning party. |
| France | No impact. | Govt. recommends that PRO should secure at least a part ownership of the IPR. | Where no inventive contribution from PRO, industry party will generally own IPR. Patent law allows use of patents by anyone for experimental purposes. |
| Germany | State funding does not affect IPR ownership. Recipient of Funds has exclusive commercial rights (non-exclusive rights for research and science), which may be reduced to non-exclusive rights if research results not utilised within appropriate period of project completion. | Depends on contract. | Contract often provides that IPR owned by industry partner. PRO often retains non-exclusive right to use results for research and educational work. |
| Hungary | Public body funding a specific project may require that resulting IP be made available free of charge for public use. It will make such a stipulation clear in advance in the call for proposals and contract. | Generally the funding party will own the IPRs. Public body funding a specific project may require that resulting IPRs are registered and exploited within a reasonable time. | Depends on contract. |
| Ireland | 100% publicly funded IP is owned by the PRO. Terms and Conditions of grant funding supersede any ownership agreement. | Arrangement for ownership and access to IP should consider (1) financial input, (2) intellectual input and (3) capacity to exploit. | Frequently, but not always, IPR will be owned by the industry partner. |
| Italy | 100% publicly funded IP is owned by the PRO. Terms and Conditions of grant funding supersede any ownership agreement. | Arrangement for ownership and access to IP should consider (1) financial input, (2) intellectual input and (3) capacity to exploit. | Frequently, but not always, IPR will be owned by the industry partner. |
| Latvia | ? | Depends on contract. | Depends on contract. |
| Netherlands | No conditions are set on results of basic research, but conditions can be attached to funding through Dutch Institute of Science or through subsidy-schemes from government to promote research and public private cooperation. | Depends on contract. | Depends on contract. |

Appendix D – Summary Tables of information in work stream 1 fact sheets

| Country | | Effect on contractual arrangements w/industry partner: | |
|----------------|--|--|---|
| | Effect of public funding on ownership of fruits of research | Where wholly/partially publicly funded | Where wholly funded by industry partner (commissioned research) |
| Norway | Research Council of Norway (RCN) funding: Project Owner will own the IPR from project. PO under obligation to secure all necessary agreement from project partners to ensure PO has right to commercialise, incl. licence. If project results not exploited in Norway, written RCN consent required for foreign licence agreement. If project IPR not exploited w/in reasonable time, must be assigned to RCN. If non-EEA entity assumes control of PO, RCN can require assignment of IPR or reimbursement of funding. | Contract often provides IP belongs to inventor. Joint inventions: contract often provides industry partner should be able to commercially exploit IPR. | Contract generally provides that IPR owned by industry partner |
| Slovakia | State funding does not affect IPR ownership. | Depends on contract | Depends on contract |
| Spain | State funding does not affect IPR ownership | Depends on contract | Depends on contract |
| Sweden | No impact | Depends on contract | Depends on contract |
| Switzerland | Biggest donor for research is Swiss National Science Foundation. IPR belongs to Recipient of Funds and their employer. SNF can require recipients of funds to make data available for other researchers. | In the case of collaborative research, the industry partner is often granted an option to acquire an exclusive licence. | Contract generally provides that IPR owned by industry partner |
| United Kingdom | If an invention arises from a project funded exclusively by public funding, the PRO will usually own the IPRs. | Where wholly publicly-funded, PRO usually owns IPRs. Where jointly funded, contract often provides IP belongs to inventor, with other party having access according to agreed terms. | Contract usually provides that IPR owned by industry partner. |

Table 5: Confidentiality and Publication as set out in fact sheets as at 14/6/2006

| Country | Confidentiality | Publication - PROs and researchers are measured on basis of scientific publications. This puts high pressure on PROs to publish. | | | |
|---------------------------|---|--|---|--|---|
| | Keep background knowledge secret? | Required to publish if wholly/partly publicly funded? | Able to delay publication (e.g. to protect IPR by patent application) | Grace period (utility models) | Able to refrain from publication if wholly funded by industry partner |
| Austria | Common practice. | No. | Yes. | Application can be filed w/in 6 months of applicant's prior publication. | Yes |
| Belgium (Flanders region) | By law PROs task is education and research. They must be able to use know-how to do this. But can agree to keep confidential the industry partner's background knowledge. | Yes. | Yes, for a reasonable time: usually up to 12 months. | No grace period. | Can not indefinitely postpone publication of all results of a project. 12 months is the usual maximum period for postponement |
| Czech Republic | Depends on contract. | No. | Yes. | Application can be filed w/in 6 months of applicant's prior publication. | |
| Denmark | Common practice. | Required by law to publish scientific results. | Yes. | No grace period. | Yes |
| Finland | Common practice. | Open research, fully supported by public funds: normally published. | Yes if partly funded by industry. Delay should be agreed in advance with the researchers. | No grace period. | Yes |
| France | Common practice. Clear identification of confidential material needed. | By law, PROs must disseminate their knowledge, incl. by publication. | Yes if delay reasonable. | No grace period. | Yes |
| Germany | Common practice. | Required by administrative bye-law. | Yes. PRO required by law to file domestic patent application if claiming patent. | Application can be filed w/in 6 months of applicant's prior publication. | Yes |
| Hungary | Common practice. | No requirement in law. Emphasis on exploitation rather than publication. | Yes. | Use outside Hungary not a bar to grant. | Yes |
| Ireland | Yes. | No requirement in law. | Yes. | No grace period. | Yes |
| Italy | Common practice. | No requirement in law. | Yes. | No grace period. | Yes |
| Latvia | Common practice. | ? | ? | No utility model. | Yes |
| Netherlands | Common practice. | No requirement in law. | Yes. | No grace period. | Yes |
| Norway | Negotiated case by case. | Employees free to publish, but publication must not conflict with 3rd party interest. | Yes. | No utility model. | Yes |
| Slovakia | Yes, by contract. | Not obligatory, but part of evaluation criteria. | Publication screened to ensure necessary novelty. | Application can be filed w/in 6 months of applicant's prior publication. | Yes |
| Spain | Common practice. | No. | Yes. | No grace period. | Yes |
| Sweden | Yes, for up to a maximum of 10 years. | As result of Swedish principle of openness. Not apply to non-university research institutes. | Yes. | No utility model. | Yes. Act of Secrecy requires university to keep contract research results secret. |
| Switzerland | Common practice. | Yes if Swiss National Science Foundation funds. | Yes (if there are justifiable reasons for secrecy, or in order to apply for patents). | No utility model. | Yes |
| United Kingdom | Usual practice. | Not obligatory, but part of evaluation criteria. | Yes. | No utility model. | Yes |

Table 6: Protection and Enforcement as set out in fact sheets as at 14/6/2006

| Country | Is first filing required at home patent office | Who will pay for patent costs | Comments | Who will enforce IPRs | Comments |
|---------------------------|--|--|---|--|---|
| Austria | No | Depends on contract | Generally expect industry to pay all | Usually industry partner | PRO will assist. |
| Belgium (Flanders region) | No | Depends on contract | Generally expect industry to pay (a part) | Usually industry partner | |
| Czech Republic | No | Depends on contract | Publicly-funded bodies are exempt from patent/ utility model/ trade mark/ design application fees. | Owner | – |
| Denmark | No | Depends on contract | Generally expect industry partner to pay if they will be exploiting. | Usually industry partner | PRO will assist. |
| Finland | No | Owner of results | Generally expect industry to pay (a part) | Owner | Depends on contract |
| France | Yes in case of a priority patent application (either national, European or international – PCT). Possible derogation through the Defence minister. | Depends on contract | Industry partner might agree to pay as a royalty advance | Usually industry partner | Only patentee or exclusive licensee can initiate lawsuit |
| Germany | Yes, or at EPO | Depends on contract | – | Owner | Depends on contract |
| Hungary | European Patent application must be filed with Hungarian Patent Office | Depends on contract | SMEs can reduce pre-tax profits acquisition, maintenance and renewal fees | Owner | – |
| Ireland | No | Depends on contract | – | Owner | Depends on contract. Ability to enforce is one of the factors to be considered in agreeing ownership. |
| Italy | Yes | Researcher, or PRO | Regional/local govt. often provides financial incentives for patenting. Patent application fees will be abolished in 2006 | Owner | Otherwise depends on agreement |
| Latvia | No | Depends on contract | Generally expect industry to pay all | Owner | Very little industry/ PRO collaboration in LV. |
| Netherlands | No | Whoever files the patent will be responsible for the cost. | Generally expect industry to pay all | Owner | Could be licensee |
| Norway | Yes (not EPC member) | Depends on contract | Generally expect industry to pay all | Usually industry partner | PRO will often assist |
| Slovakia | No | Depends on contract | Publicly-funded bodies are exempt from patent/utility model/ trade mark/design application fees. | Owner | – |
| Spain | Yes, but can apply for national, PCT or European (EPO) patent. | Depends on contract | Public universities are exempt from patent or trademark fees. There is no assistance for other PROS | Depends on contract | Public institutions are not allowed to use arbitration. |
| Sweden | No | Financier | There are funding agencies e.g. Vinnova | Owner | |
| Switzerland | No | Varies from PRO to PRO | Some PROs encourage industry partner to bear cost. | Usually industry partner | Otherwise depends on agreement |
| United Kingdom | If technology relates to national security/public safety – must get permission before applying abroad | Applicant | PRO will seek to seek reimbursement from industry partner | Generally the partner who is commercialising the results | |

Appendix E – References for Work Stream 1

1 National IP Offices

| | Industrial Property (Patents, trade marks, designs, etc) | | | | |
|----------------|---|---|---|--------------------|-------------------|
| | Copyright (if separately administered) | | | | |
| Country | Competent Administration | Website | Address | Telephone | email |
| Austria | Federal Ministry for Transport, Innovation and Technology. Austrian Patent Office | http://www.patenamt.at | P.O.B 95 Dresdner Str. 87 A-1200 Wien | (43 1) 53 42 40 | info@patentamt.at |
| | Federal Ministry of Justice | | Postfach 63 A-1016 Wien | (43 1) 52 152 275 | |
| Belgium | Ministry of Economic Affairs Administration of Trade Policy Industrial Property Office | | North Gate III Boulevard du Roi Albert II, 16 B-1000 Bruxelles | | |
| | Ministry of Justice Department of Civic Affairs | | Boulevard de Waterloo 115 B-1000 Bruxelles | (32 2) 542 65 11 | |
| Czech Republic | Industrial Property Office of the Czech Republic | http://www.upv.cz | Antonína Cermáka 2a 160 68 Praha 6 - Bubenec | (420 2) 24 311 555 | posta@upv.cz |
| | Ministry of Culture of the Czech Republic Copyright Department | | Maltézské nám. 471/1 P.B. 74 118 11 Prague 1 | (420) 224 312 785 | |
| Denmark | Danish Patent and Trademark Office under the Danish Ministry of Economic and Business Affairs | http://www.dkpto.dk | Patent-og Varemaerkestyrelsen Helgeshøj Allé 81 DK-2630 Taastrup | (45) 4350 8000 | pvs@dkpto.dk |
| | Ministry of Culture Copyright Division | http://www.kum.dk | Ophavsretskontoret Nybrogade 2 Postboks 2140 DK-1015 Copenhagen K | (45) 33 92 33 70 | kum@kum.dk |
| Finland | National Board of Patents and Registration of Finland | http://www.prh.fi | Arkadiankatu 6 A FIN-00100 Helsinki P.O. Box 1140 FIN-00101 Helsinki | (358 9) 6939 500 | |
| | Ministry of Education and Culture | http://www.minedu.fi | Mailing address: P.O. Box 29 FIN-00023 GOVERNMENT Meritullinkatu 10 FIN-00170 Helsinki 17 | (358 9) 1341 7467 | |
| France | National Institute of Industrial Property | http://www.inpi.fr | 26bis rue de St.-Petersbourg F-75800 Paris Cedex 08 | (33) 1 53 04 53 04 | |
| | Ministry of Culture Office of Literacy and Artistic Property | | 3 rue de Valois (4ème étage) F-75001 Paris | (33) 1 40 15 38 59 | |
| Germany | German Patent and Trade Mark Office | http://www.dpma.de | Deutsches Patent- und Markenamt D-80297 Munich | (49 89) 21 95 0 | info@dpma.de |
| | Federal Ministry of Justice Copyright Section | http://www.bmj.bund.de | Jerusalemstrasse 27 D-10117 Berlin Mailing address: Bundesministerium der Justiz 11015 Berlin D-10104 Berlin | (49 30) 20 25 70 | info@bmj.bund.de |

1 National IP Offices

| | | Industrial Property (Patents, trade marks, designs, etc) | | | | |
|-----------------|--|--|--|---|---|--|
| | | Copyright (if separately administered) | | | | |
| Country | Competent Administration | Website | Address | Telephone | email | |
| Hungary | Hungarian Patent Office | http://www.hpo.hu | Garibaldi utca 2. H-1054 Budapest Mailing address: PO Box 552 H-1370 Budapest 5 | (36 1) 312 44 00 | hpo@hungary.com | |
| | Hungarian Patent Office, Legal and International Department, Copyright Section | As above | As above | As above | As above | |
| Ireland | Department of Enterprise, Trade and Employment Patent Office | http://www.patent-soffice.ie | Government Buildings Hebron Road Kilkenny | (353 56) 7720111 | patdub@entemp.ie | |
| | Department of Enterprise, Trade and Employment | http://www.entemp.ie | Intellectual Property Unit Dept of Enterprise, Trade and Employment Earlsfort Centre Lower Hatch Street Dublin 2 | (353 1) 631 2121 | ipu@entemp.ie | |
| Italy | Italian Patent and Trademark Office (UIBM) | www.uibm.gov.it | 19, via Molise 00187 Rome | (39) 06 4705 5616 fax (39) 06 47055635 | uibm@sviluppoeconomico.gov.it www.uibm.gov.it | |
| | Ministry for Cultural Assets and Activities | http://www.beniculturali.it/ http://www.spettacolo.beniculturali.it/dipart/dir_autore/dir_aut.htm | Via del Collegio Romano, 27 00186 Roma | (39) 06 6 7231 | | |
| Latvia | Patent Office of the Republic of Latvia | http://www.lrpv.lv | Citadeles Street 7/70 1010 Riga | (371) 7027 676 | valde@lrpv.lv | |
| | Ministry of Culture Copyright and Neighbouring Rights Division | | 11a Kr.Valdemara St. 1364 Riga | (3717) 22 47 72 | | |
| Netherlands | Ministry of Economic Affairs Netherlands Patent Office | http://www.octrooicentrum.nl | Octrooicentrum Nederland Patentlaan 2, 2288 EE P.O. Box 5820 NL-2280 HV Rijswijk | (31 70) 398 6655 | info@octrooicentrum.nl | |
| | Bureau of Intellectual Property | | A. Laclé Blvd. No. 3 Oranjestad | (297 8) 23 200 | | |
| Norway | Norwegian Patent Office | http://www.patentstyret.no | Københavngaten 10 N-0033 Oslo Patentstyret Postboks 8160 Dep. N-0033 Oslo | (47) 22 38 73 00 | | |
| | Royal Ministry of Cultural Affairs | http://www.dep.no/kd | Kulturdepartementet Me-avd P.O. Box 8030 Dep. N-0032 Oslo | (47) 22 24 78 39 | postmottak@kd.dep.telemex.no | |
| Slovak Republic | Industrial Property Office of the Slovak Republic | http://www.upv.sk | ul. Jána Svermu 43 P.O. Box 7 974 04 Banská Bystrica 4 | (421 48) 43 00 116/118 | upv@indprop.gov.sk | |
| | Media and Copyright Division Ministry of Culture | | Nám. SNP 33 813 31 Bratislava | (4212) 5939 233/123 | | |

1 National IP Offices

| | | Industrial Property (Patents, trade marks, designs, etc) | | | | |
|----------------|---|---|--|----------------------|---|--|
| | | Copyright (if separately administered) | | | | |
| Country | Competent Administration | Website | Address | Telephone | email | |
| Spain | Spanish Patent and Trademark Office | http://www.oepm.es | Paseo de la Castellana 75 28071 Madrid Spain | (34) 90 215 7530 | informacion@oepm.es | |
| | Ministry of Culture | http://www.mcu.es/ http://www.mcu.es/index.jsp?lang=eng (English version) | Subdirección General de la Propiedad Intelectual Plaza del Rey 1, 1ª Planta 28071 Madrid | (34) 91 701 70 00 | info.propiedadintelectual@mcu.es | |
| Sweden | Swedish Patent and Registration Office (SPRO) | http://www.prv.se | Patent- och registreringsverket Box 5055 S-102 42 Stockholm | (46 8) 782 25 00 / 1 | prv@prv.se | |
| | Ministry of Justice Division of Intellectual Property and Transportation | http://www.sweden.gov.se/sb/d/584 | Rosenbad 4 S-103 33 Stockholm | (46 8) 405 10 00 | Email Ministry of Justice through website | |
| Switzerland | Swiss Federal Institute of Intellectual Property | http://www.ige.ch | Einsteinstrasse 2 CH-3003 Berne | (41 31) 325 25 25 | | |
| United Kingdom | Department of Trade and Industry. The Patent Office | http://www.patent.gov.uk | Concept House Cardiff Road Newport, South Wales NP10 8QQ | +44 (0)1633 813930 | enquiries@patent.gov.uk | |

2. Guidelines to Collaboration on Research at National Level

| Country | Reference |
|---------|-----------|
|---------|-----------|

| | |
|----|--|
| DK | <p>A guideline for research cooperation between universities and companies has been published jointly by The Danish Rectors Conference and The Confederation of Danish Industries. The document “Contracts, contacts and codices – Research co-operation between universities and companies” is available on-line www.rks.dk/sider/publikationer/english/Contacts%20%20contrats%20and%20cod.pdf</p> |
|----|--|

A guideline for teaching hospitals entering into research agreements is also available on-line at www.forskningskontrakter.techtrans.dk/HS/viewPage.action?site=eng_HS&page=Manual%20in%20pdf

Please note that these guidelines are not official documents acknowledged by legal authorities.

| | |
|----|---|
| FR | <p>The 2001 Recommendations are available in French on the website of the French Research Ministry: ftp://trf.education.gouv.fr/pub/rechtec/technologie/charte.rtf</p> |
|----|---|

| | |
|----|---|
| HU | <p>The Hungarian Patent Office and the National Office for Research and Technology have jointly published a guide in order to facilitate the elaboration of individual IPR policies. This guide is available only in Hungarian at http://www.nkth.gov.hu/main.php?folderID=466&articleID=4163&ctag=articlelist&iid=1</p> |
|----|---|

| | |
|----|--|
| IE | <p>National Code of Practice for Managing Intellectual Property from Publicly Funded Research: The Code addresses each aspect of the management and transfer of research and development results from universities, institutes of technology and public research institutions to the commercial market place. www.forfas.ie/icsti/statements/icsti040407/index.html</p> |
|----|--|

National Code of Practice for Managing Intellectual Property from Public-Private Collaborative Research:

This Code presents the national policy position regarding Intellectual Property (IP) arising from collaborative research. It provides guidance on IP related issues to be considered by collaborating partners and an overarching framework under which parties to an IP agreement may negotiate.

This Code complements the National Code of Practice for Managing Intellectual Property from Publicly Funded Research, published in 2004. Together, these Codes form an integral part of the commercialisation infrastructure in Ireland.

www.sciencecouncil.ie/reports/#ipcode04

| | |
|----|--|
| UK | <p>Partnerships for Research and Innovation between industry and universities - a guide to better practice AURIL, April 2001</p> |
|----|--|

This document was prepared by a working party in the UK comprising representatives from industry, universities, technology transfer organisations, government and research funding council. Its intention is to look at mechanisms behind industry-academic partnerships, providing a guide to the processes and best practice tips to improve the chances of success.

<http://www.auril.org.uk/publications/pfrai>

Country Reference

UK A Guide to Managing Intellectual Property: Strategic Decision-Making in Universities: This guidance highlights the importance of good IP management, not only because of the financial returns that it can help generate, but because it contributes to other university aims and objectives. (AURIL / The Patent Office / UUK)

www.patent.gov.uk/about/notices/2002/manip/index.htm

Europe The Responsible Partnering Initiative has been developed through close collaboration between EUA, the European Industrial Research Management Association (EIRMA), the European Association of Research and Technology Organisations (EARTO) and the European Network of Knowledge Transfer Offices linked to Universities and Public Research Organisations (ProTon Europe). A major Conference was held on the Responsible Partnering theme in 2004 which brought together the main stakeholders from universities, industry and public research organisations. As a result of the conference, a handbook based on good practices in university/industry collaboration on research was published in 2005. It includes guidelines on Constructing the Collaborative Research Agreement on pp. 9-11
http://www.eirma.asso.fr/f3/local_links.php?action=jump&id=796

More guidance / reports etc can be found on http://ec.europa.eu/invest-in-research/policy/policy04_en.htm

United States of America The American Association of University Technology Managers provides a wide variety of resources for technology transfer professionals at

www.autm.net

3. Model Contracts and National Recommendations

| Country | Reference |
|---------|-----------|
|---------|-----------|

- | | |
|----|---|
| CH | <p>Samples contract for a clinical study agreement: www.unitectra.ch/medien/CLINICAL_STUDY_AGREEMENT_050718.doc www.unitectra.ch/medien/STANDARD_CRA_INSEL_051001.doc</p> |
| DE | <p>Model contracts for research collaboration and for contract research (Berlin Contract, Berliner Vertrag) are available on http://www.ipal.de/index.php?id=34&L=en (both in German and English). Another model contract (Duesseldorf Contract, Düsseldorfer Vertrag) is available on www.gewrs.de/files/leitfaden_duesseldorfer_vertragswerkstatt.pdf (in German only).</p> |
| DK | <p>A guideline for research cooperation between universities and companies has been published jointly by The Danish Rectors Conference and The Confederation of Danish Industries. The document “Contracts, contacts and codices – Research co-operation between universities and companies” is available on-line at www.rks.dk/sider/publikationer/english/Contacts%20%20contrats%20and%20cod.pdf</p> <p>Please note that the guideline is not an official document acknowledged by legal authorities.</p> |
| FR | <p>The 2001 Recommendations are available in French on the website of the French Research Ministry: ftp://trf.education.gouv.fr/pub/rech-tec/technologie/charte.rtf</p> <p>Valuation of research in Universities (La valorisation de la recherche dans les universités: une ambition nécessaire – Les Rapports du Senat – Philippe Adnot, Sénateur, Commission des finances, No 341 2005-6, ISSN 1249-4356)</p> |
| IT | <p>A model contract for research collaboration and contract research is available but at the moment only in Italian. Contact the Italian Universities Network for the Valorisation of Research Results</p> <p>This document was prepared by a working party in the UK comprising representatives from industry, universities, technology transfer organisations, government and research funding council. Its intention is to look at mechanisms behind industry-academic partnerships, providing a guide to the processes and best practice tips to improve the chances of success.</p> <p>www.auril.org.uk/publications/pfrai</p> <p>A Guide to Managing Intellectual Property: Strategic Decision-Making in Universities: This guidance highlights the importance of good IP management, not only because of the financial returns that it can help generate, but because it contributes to other university aims and objectives. (AURIL / The Patent Office / UUK)</p> <p>www.patent.gov.uk/about/notices/2002/manip/index.htm</p> |
| UK | <p>A set of model contracts showing five different types of collaboration between a PRO and a Company and a number of tools showing how to choose the most suitable contracts have been prepared and widely promoted in the UK. These materials are known as the Lambert Model Agreements Toolkit and are available in CD-ROM format from the UK Patent Office as well as on the website of the UK Department of Trade and Industry at www.innovation.gov.uk/lambertagreements/</p> |

Country Reference

More guidance / reports etc can be found on http://ec.europa.eu/invest-in-research/policy/policy04_en.htm

Europe The Responsible Partnering Initiative has been developed through close collaboration between EUA, the European Industrial Research Management Association (EIRMA), the European Association of Research and Technology Organisations (EARTO) and the European Network of Knowledge Transfer Offices linked to Universities and Public Research Organisations (ProTon Europe). A major Conference was held on the Responsible Partnering theme in 2004 which brought together the main stakeholders from universities, industry and public research organisations. As a result of the conference, a handbook based on good practices in university/industry collaboration on research was published in 2005. It includes guidelines on Constructing the Collaborative Research Agreement on pp. 9-11 www.eirma.asso.fr/f3/local_links.php?action=jump&id=796

OECD Turning Science into Business, Patent Licensing at Public Research Organisations, OECD 2003, ISBN 92-64-10022-9

United States of America The American Association of University Technology Managers provides a wide variety of resources for technology transfer professionals on its website. These include sample contracts from a number of American universities at www.autm.net/aboutTT/aboutTT_policies.cfm

4. Cost of Patenting

In 2004 the European Patent Office published a Study on the Cost of Patenting carried out by Roland Berger Market Research. The purpose was to provide a simple quantitative barometer of the level and major components of that cost, with a view to providing information to applicants with an idea of the level of cost they will incur. However, in view of the diverse cost levels - field of technology, filing routes, patentee's strategy etc. - a single figure cannot give a reasonable estimate of the expected cost of a particular patent application. Nevertheless, the figures should be informative enough for a newcomer to the EPO procedure to obtain a reasonable cost estimate.

www.european-patent-office.org/epo/new/cost_anaylsis_2005_study_en.pdf

See also: the IPR Helpdesk guide: How much does a patent cost?

www.ipr-helpdesk.org/controlador/documentos?seccion=fichaDocumento&len=en&idFicha=0000003793&localizador=doc&cod_padre=t_01.02.01.01
and BvP study on the cost of patenting - <http://econpapers.repec.org/paper/solwpaper/06-002.htm>

5. IPR Helpdesk

The IPR Helpdesk provides comprehensive information on IPR, focusing on IP questions in the context of projects co-financed under the EU Framework Programmes on research and technological development.

The IPR Helpdesk also operates an email Helpline which undertakes to provide first line assistance with answers within three working days to individual questions on IPR related issues with a special focus on Community diffusion and protection rules and issues relating to intellectual property in European research projects.
www.ipr-helpdesk.org/controlador/services/helpline?seccion=helpline&len=en

You can also find example contracts for the EU 5th and 6th Framework Programmes on the web site, and a database of model contracts drawn up by various organisations with wide-ranging experience in this area.

All IPR-Helpdesk services are free of charge and are available in the six project languages: English, Spanish, French, Italian, German and Polish.

The main Documents page can be found at:

www.ipr-helpdesk.org/controlador/documentos?seccion=documentos&len=en
This has links to documents on various IP issues under the headings: General Issues, Inventions, Designs, Distinctive Signs, Copyright, and Information Society. IPR Helpdesk guides that may be of particular interest include:

Protection of an idea or a concept:

www.ipr-helpdesk.org/controlador/documentos?seccion=fichaDocumento&len=en&idFicha=0000004263&localizador=doc&cod_padre=t_01.01

Joint Ownership in Intellectual Property Rights

www.ipr-helpdesk.org/controlador/documentos?seccion=fichaDocumento&len=en&idFicha=0000000649&localizador=doc&cod_padre=t_01.01

The website also has a comprehensive FAQ section dealing with all types of IPR and with the EU Framework Programmes.

www.ipr-helpdesk.org/controlador/resources/faqs?seccion=faqs&tipoListado=all&len=en

6. Innovation Relay Centres Network

- <http://irc.cordis.lu/home.cfm>

The mission of the IRCs is to support innovation and trans-national technological co-operation in Europe with a range of specialised business support services. IRC services are primarily targeted at technology-oriented small and medium-sized enterprises (SMEs), but are also available to large companies, research institutes, universities, technology centres and innovation agencies.

The first Innovation Relay Centres were established in 1995 with the support of the European Commission. The aim was to create a pan-European platform to stimulate trans-national technology transfer and promote innovation services. Over the past five years the IRCs - working together in close co-operation - have been of assistance in over 12,500 technology transfer negotiations, and have helped more than 55,000 client companies to meet their technology needs and to exploit their research results. IRC staff are experienced specialists with backgrounds in business, industry and research. To date, they have facilitated more than 1000 trans-national transfers of technology - signed agreements for the sale, licensing, distribution or joint development of new technologies. Today, 71 regional IRCs span 33 countries - 25 EU Member States, Bulgaria, Romania, Iceland, Israel, Norway, Switzerland, Turkey and Chile.

Services: <http://irc.cordis.lu/ircnetwork/>

Trans-national technology transfer - Bulletin Board Service

7. Resources provided by industry

The Licensing Executives Society

The Licensing Executives Society International (LESI) is an association of 31 national and regional societies. It was founded in 1965 to establish licensing as a profession, enabling its members to meet, to learn from one another and to encourage high professional standards among the individuals engaged in licensing of intellectual property rights and the transfer of technology.

Most resources provided by the LESI and its national societies are available only to members, but membership is open to all those interested in licensing. See www.lesi.org/

8. Resources provided by technology transfer associations

I. AUTM

The American Association of University Technology Managers provides a wide variety of resources for technology transfer professionals on its website. These include sample contracts from a number of American universities at www.autm.net/aboutTT/aboutTT_policies.cfm

II. ProTon Europe

ProTon Europe is a pan-European network of technology offices linked to PROs. It is supported by the European Commission as part of its Gate2Growth initiative. www.protoneurope.org/

III. AURIL

Auril provides a range of resources and a framework for continuing professional development. www.auril.org.uk

9. EC-sponsored entities promoting innovation:

Gate2Growth

<http://www.gate2growth.com>

Gate2Growth is the pan-European Business Platform for:

- Entrepreneurs seeking financing (Business Matching)
- Investors (InvestorNet)
- Technology Incubator Managers (Incubator Forum)
- Knowledge Transfer Offices (Proton Europe)
- Academia in entrepreneurship, innovation and finance (Academic Network)
- Innovative companies seeking expert service providers (Service Centre)

Appendix F – Expert Workshop Report

Report on a Workshop for Technology Transfer Professionals
22 March 2006 – Brussels

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Appendix G includes:

- 1** Workshop Agenda
- 2** Workshop Attendance List
- 3** Skills Proformas (A, B, C)
- 4** Education Programmes & Courses Proformas (D)
- 5** Existing Courses Proforma (E)
- 6** UK/AURIL Surveys & Frameworks 1999 & 2005
- 7** Results from Greek Knowledge Transfer Professionals Workshop (2006)
- 8** Responsible Partnering Initiative & Skills
- 9** Responses on Existing Courses

Martin Haywood
Director of Business Development
University of Sunderland
28 April 2006

1. Introduction

Work stream 2 of the current cycle of the CREST OMC IPR Expert Group is considering the recommendations of the previous cycle of CREST concerned with the skills, training courses and accreditation required for technology transfer professionals operating within universities and Public Research Organisations (PROs).

A key part of the Group's process was to facilitate the consideration by, and input from, experienced technology transfer professionals from across the EU, including representatives from national and European technology transfer associations. This was achieved through a one-day facilitated workshop held in the offices of DG Research in Brussels on 22 March 2006.

A small co-ordination group was tasked with preparing discussion papers for the whole group to consider. The target audience for this workshop were people who work in the field of technology transfer, both in PROs and in industry. The Member states from the IP-expert group nominated national experts to participate in this workshop. Additional national experts were selected and invited with the help from European organisations like PROTON, LES and ASTP, for non-members of the group.

This workshop aimed to accomplish several goals:

Receiving input from those stakeholders who would be affected by the possible recommendations;

It would expand the scope of the IP Group's information gathering by providing the opportunity to get the benefit of the experience and views of national experts from Member States that are not presented within the IP Group.

The results from this workshop were discussed and analysed by the IP Group in its April meeting. Based on the results from the workshop, presentations done during the IP-expert group meetings and internal discussions, the IP-expert group put together a plan of how to realise the objective of improving the professionalism of technology transfer through education.

Following the introductory plenary sessions, the professionals were allocated into 4 groups to consider the 2 key questions on skills and organisation of courses, namely

- What skills/expertise should a person possess to be able to work as a professional in the field of Technology Transfer?
- If the identified skills/expertise are going to be taught through education programmes and/or training courses, what should be the main characteristics of such programmes/courses?

22 professionals participated in the workshop (see the agenda in Appendix 1 and the attendance list in Appendix 2). To support the groups' considerations of these questions, proformas were provided (see appendices 3 & 4) to structure the detailed consideration of the questions and to facilitate the collection and analysis of the responses. The questions were first reviewed individually to identify and rank personal ideas and characteristics and then the group considered the individual contributions in order to agree and prioritise the groups' overall views. The groups were asked to report back to the plenary sessions on their results.

The attendees were also asked to feedback after the workshop on the question:

- What existing national or European courses do you know of and what are their characteristics?

Again, a proforma (see appendix 5) was provided electronically (by e-mail) to facilitate the data collection.

The following sections report on the results of the workshop, and where appropriate, on other research or initiatives relevant to the issues raised.

2. Skills

“What skills/expertise should a person possess to be able to work as a professional in the field of Technology Transfer?”

2.1 Results

a. Individual Results

The following table presents the results from the individual consideration of this question, i.e. before group consideration of the question (see appendix 3 for full details of the process). The table collects together those skills that were identified and prioritised by 2 or more people.

| Skill | Average Individual Rank | Overall Individual |
|---|-------------------------|--------------------|
| Networking | 2.0 | 1 |
| Business development skills | 2.5 | 2 |
| Project management (including finance) | 2.6 | 3 |
| Funding support programmes | 2.7 | 4 |
| IPR management knowledge | 2.7 | 5 |
| Negotiation skills | 2.8 | 6 |
| Market assessment | 3.0 | 7 |
| Interpersonal skills/comms /relationships (int & ext) | 3.2 | 8 |
| IP Valuation | 3.3 | 9 |
| Technology field understanding | 3.5 | 10 |
| Finance, budgeting, tax | 3.8 | 11 |
| Company formation/law | 4.0 | 12 |
| Legal understanding/skills | 4.3 | 13 |
| Entrepreneurial/problem solving | 4.3 | 14 |
| Strategic management/leadership | 4.3 | 14 |
| Contracting | 4.4 | 16 |
| Marketing / selling / communications (int/ext) | 4.5 | 17 |
| Venture capital | 4.5 | 18 |
| Internationalisation | 5.0 | 19 |
| Languages/English | 5.4 | 20 |
| Industry & university experience/understanding | 5.4 | 21 |
| Patenting, drafting | 5.5 | 22 |
| Knowledge/innovation management | 6.0 | 23 |
| Organisational understanding | 7.0 | 24 |
| Personal organisation (multiple projects) | 7.0 | 24 |
| Team working | 8.0 | 26 |

b. Group Results

The following table presents those skills that were prioritised by two or more of the four groups:

| Skill | Average Group Rank | Overall Group |
|--|--------------------|---------------|
| Business development | 1.8 | 1 |
| IP management/legal | 2.5 | 2 |
| Negotiating (internally & externally) | 2.8 | 3 |
| Networking & interpersonal skills (comms & relationships) | 3.0 | 4 |
| Marketing & selling | 4.5 | 5 |
| Contracting | 4.7 | 6 |
| Personal organisation (multiple projects & skills integration) | 5.5 | 7 |
| Coaching/leadership | 6.0 | 8 |
| Project management/finance | 7.3 | 9 |

The following table presents those skills that were prioritised by only one of the four groups:

Other Skills Identified by Groups (in Rank Order)

- Legal understanding
- Technical understanding
- Understanding environment
- Valuation, market analysis
- Knowledge management
- Analytical reasoning
- Personal - attitude/resilience/motivation
- Patenting, drafting etc
- Knowing when you don't know

2.2 Plenary Presentations & Discussions

The plenary presentations & discussion highlighted the following points:

- a. Certain personality traits or characteristics are important 'pre-requisites' – such as spirit, motivation, entrepreneurial, creative.
- b. Different technology transfer (TT) jobs require a different balance or profile of the skills identified, e.g. the skills profile for an R&D job will be different to that for a licensing job, and in turn both will be different for a company start-up job.
- c. The skills required may be distributed across the team – all skills are not necessarily required by all staff to the highest level. This is particularly the case in larger offices where specialist skills may be employed e.g. in finance or legal roles. However, in smaller teams, staff may need to have a greater range of the skills identified to a higher level.
- d. A key skill is the integration of all the other skills in the most effective way – and being able to judge when and how to use these personal and team skills, and, if necessary, when to outsource them.
- e. The 'bridge-building' skill is the key core skill – most other skills can be outsourced except for this one.

f. A certain level of business experience is important/desirable but not a critical pre-requisite, although it is important to be credible and confident in interactions with business.

g. There was a discussion on the difference, if any, between Technology Transfer (TT) and Knowledge Transfer (KT). Although there was a variety of views on this, overall TT was seen as a part or sub-set of the broader KT spectrum - the successful development of an open economy being seen as not just about the transfer of technology. It was also pointed out that TT is probably the lowest economic impact part of the KT spectrum.

h. The other major discussion concerned the level of scientific/technical understanding/background required to be successful. Overall, it seemed that the ability to develop good relationships with academics and researchers and to bring some key added value to the relationship was the most important skill requirement - the TT Professional needed enough technical background to be able to understand quickly the product, its use and its market potential. Again, the importance of TT as a team process was emphasised with the researcher as technical expert alongside the TT expert. The size of TT teams is again likely to be an important factor – in a small team a TT professional may have to support a number of technical areas and cannot be expected to be an expert in all of them.

2.3 Other Research & Analysis

The individual and group results generally prioritise the inter-personal and commercial skills over the ‘technical’ TT skills. Although these priority skills may be seen as ‘generic’ skills, the workshop participants highlighted the difficult context within which these skills were being exercised, i.e. internally, externally and between the two very different environments (business and academic/research), where values, priorities and expectations are often very different. In fact, the key core skill identified in the workshop was the ‘bridge-building’ skill (see 2.2/e above), which can be considered to embrace a number of the other prioritised inter-personal skills.

This prioritisation is generally consistent with other research/surveys, including those in the UK (in 1999 and 2005 – see appendix 6), and from a similar workshop in Greece recently (see appendix 7).

It is also supported by the Responsible Partnering initiative (led by EIRMA, EUA, EARTO and ProTon Europe - see appendix 8), whose handbook contains guidelines that make explicit references to “project management, entrepreneurship and business development skills” which it considers important for the effective management of collaborative R&D and knowledge transfer.

The issue about the specific contexts within which these skills are exercised in practice will be an important consideration for those designing education/training programmes and courses, not only in terms of the content but also of the delivery style and those delivering, e.g. through the use of case studies and experienced practitioners (see section 3).

The plenary discussion identified the range of different roles in TT, the need for a different profile of skills in each of these roles, and the distribution of the required skills across the different members of a TT team, some of whom may be outsourced (see 2.2/b, c, d above). The AURIL CPD Framework supports this approach by identifying a number of different roles across the TT/KT spectrum and the skills required in each role, and by providing a profiling technique (in conjunction with an web-based Training Needs Analysis tool), which helps individuals and managers to profile personal and team skills capabilities and requirements and to develop personal and group training plans (see appendix 6).

The discussion of the level of technical knowledge/background (see 2.2/h above) required for TT always generates a variety of views – probably reflecting the variety of roles and contexts involved. It is interesting to note in this workshop (and also in the Greek workshop – see appendix 7) that this skill starts with a relatively high ranking at the individual level (10th), but it gets de-prioritised following the collection and discussion of the full set of skills within the group (only prioritised/ranked by one of the four groups). In the Greek workshop, it started at 4th from the individual rankings but fell to 11th from the group rankings. The overall view expressed in 2.2/h from the plenary discussion seems to represent the most generally acceptable position.

3. Education Programmes & Courses

“If the identified skills/expertise are going to be taught through education programmes and/or training courses, what should be the main characteristics of such programmes/courses?”

The characteristics presented to the attendees for consideration and discussion were

- Who should be the target audience in terms of sectors?
- Who should be the target audience in terms of experience levels?
- What should the status of such programmes/courses?
- What topics should be covered?
- Should EU level learning & networking be provided, and if so, how?
- How should the programmes/courses be organised?

3.1 Results

a. Target audience(s) - Sectors

The table below presents the individual and group rankings for the sectors presented to, and/or identified by, the individuals/groups.

| Sector | Average Individual Rank | Overall Individual Rank | Average Group Rank | Overall Group Rank |
|---------------------------------|-------------------------|-------------------------|--------------------|--------------------|
| Universities | 1.2 | 1 | 1 | 1 |
| PROs | 1.6 | 2 | 1.3 | 2 |
| Industry | 2.4 | 3 | 2.3 | 4 |
| Govt/Policy makers (reg/nat/EU) | 3.8 | 5 | 2.7 | 5 |
| Business support/Intermediaries | 4.0 | 6 | 2 | 3 |
| Univ mgt | 4.0 | 6 | | |
| Students/researchers | 2.7 | 4 | | |

b. Target audiences – Experience Levels

The table below presents the individual and group rankings for the experience levels presented to the individuals/groups.

| Experience Level | Average Individual Rank | Overall Individual Rank | Average Group Rank | Overall Group Rank |
|------------------------------|-------------------------|-------------------------|--------------------|--------------------|
| <= 0 years (before entering) | 2.1 | 3 | 1.25 | 2 |
| 0-2 years | 1.4 | 1 | 1 | 1 |
| 3-5 years | 1.9 | 2 | 1.75 | 3 |
| >5 years | 2.3 | 4 | 2.25 | 4 |

c. Status of Programmes/Courses

The table below presents the individual and group rankings for the different types of course status presented to the individuals/groups.

| Status | Average | Overall | Average | Overall |
|--------------------------------|---------|---------|---------|---------|
| short courses (1-3 days) | 2.0 | 2 | 1.5 | 2 |
| longer courses | 4 | 4 | 3 | 5 |
| Post Graduate | 2.1 | 3 | 2.5 | 4 |
| MBA-type | 1.5 | 1 | 1.3 | 1 |
| Professional/Vocational Qual'n | 2.5 | 5 | 1.7 | 3 |

d. Topic Areas Covered

The table below presents the individual and group rankings for the topic options presented to the individuals/groups.

| Status | Average | Overall | Average | Overall |
|----------|---------|---------|---------|---------|
| All | 1.0 | 1 | 1 | 1 |
| Specific | 1.5 | 2 | 1.25 | 2 |

e. EU level learning/networking

All those who answered this sub-question reported that this was an important characteristic of such courses, especially for the more experienced staff (>3 years).

However, there was a variation in views on the extent and method. When percentages (of course time) were specified they were generally in the range 10-20%, although in 2 cases they were 95 & 100% - it was however recognised that these latter levels were unlikely to be practicable or cost-effective.

Methods suggested were:

- Secondments
- Exchanges
- Visits
- Conferences
- EU Mobility programmes for TT professionals

Some individuals and groups highlighted the need for this to go beyond the EU and to include other countries/continents, e.g. USA, Japan.

f. Course Organisation

There were various approaches adopted by individuals and groups in answering this sub-question. However, the most common messages reported were that such courses should involve the following characteristics:

Main Course Organisation Characteristics

- Practical e.g. work/project based, case studies
- Include staff exchanges
- Use of practitioner professionals/experts
- Modular -short courses
- MBA/post graduate level
- Accreditation
- Delivered by National and EU/International Professional Associations (Short courses)
- Delivered by Universities (MBA type)
- Standards based

Other characteristics reported for consideration were:

e-learning

Internships

Mentoring

Distance learning

Networking

3.2 Plenary Presentations/Discussions

The plenary presentations & discussion highlighted the following points in support of the group priorities & ranks above:

a. There was a view from a number of individuals/groups that it would be highly preferable for the audiences on each course to be a mix of sectors and especially those from universities, PROs and industry – networking and learning from each other are important. However, it was also recognised from experience that this is very difficult to achieve in practice.

b. SMEs were highlighted by some as a particular target audience, although again it was also recognised from experience that it is very difficult to attract SME staff to training courses (half-day courses are likely to be the most attractive).

c. At this stage, it was suggested that programmes should be targeted at TT staff in universities and PROs but be accessible to all.

d. Having a focus for the training on particular target sectors/groups is very important for the marketing and recruitment of such training. In addition, there is some very specific content only relevant to universities, and networking with other sectors can be achieved through other mechanisms.

e. Basic training for those in their first year is very important and this could also be used for pre-entry training.

f. The status of the course depended very much on the target audience, i.e. qualification courses were generally more important for new entrants to the profession and short courses were generally more appropriate for the experienced professionals.

- g.** The specific topics required were generally reported and prioritised to be those identified in the previous skills section (section 2). However, the course topics required also depended very much on the target audience, i.e. courses delivering all topics were more important for new entrants to the profession, and short courses with specific topics were more appropriate for the experienced professionals.
- h.** Courses should be categorised by level, e.g. Basic/Introductory, Intermediate and Advanced, with the basic courses more appropriate for delivery at the national level and the advanced courses more appropriate at the EU/international level.
- i.** Many favoured a modular short course approach where the courses and/or learning acquired could be accumulated and used to gain credits towards an MBA (and/or any intermediate qualifications).
- j.** There was a very important role for professional organisations at both national and European levels in terms of course organisation and delivery.
- k.** A number of courses are already available – from ProTon, ASTP, LES, AUTM, AURIL – but some are considered to be too expensive to justify for junior staff (especially when significant travel & accommodation costs are included). With limited budgets available in many TT offices, more quality training was needed at the regional/national level with the advanced courses available at the European level. However, there was also a view that some member states did not have the resources/infrastructure or market size to support regional/national training.
- l.** Although some felt that competition between providers should be encouraged, others felt that a more collaborative approach, especially between professional associations, was needed especially at the current stage of development and with the relatively small market size involved.
- m.** The EU could play an important role, especially in terms of supporting staff exchange, through the provision and support of Marie Curie or similar mobility programmes specifically for TT staff.
- n.** There was a perception that no certification was currently available (but see 3.3 & 4 below) although it is an important requirement for many TT staff.
- o.** The need for accreditation was clearly identified. A significant number (8/22 in the individual results) reported that accreditation was important and the need for an independent accreditation body was highlighted. Whilst one or two in the plenary felt that it is too early in the development of TT for accreditation, others argued that the time has now come to develop and recognise this professional area - it is important now to develop the status and credibility of the profession in order for it to be attractive to encourage more quality people into the role and thereby to stimulate/promote more innovation and economic development.

3.3 Other Research & Analysis

In terms of sectors (3.1/a), universities and PROs are clearly the priority for training, and it seems from the responses on existing courses (see section 4 and appendix 9) that this is where most of the development to-date has occurred. However, the results also highlighted the need, although with a lower priority, to engage other key stakeholders in training – as well as industry, the two key groups identified were staff responsible for various aspects of KT in regional, national and European Government/public agencies, and those working in business support/intermediary organisations, especially because of their important role as a route to SMEs and their potential to influence/stimulate them to invest more resources in R&D/KT.

The importance of qualifications and certification can be seen in the results (3.1/c) and the plenary discussion above (3.2). A combination of short courses in a modular approach accumulating towards an MBA-type qualification clearly emerges as the most preferred options. However, the academic criteria and constraints usually associated with this level of qualification may make these combined options difficult to achieve in practice, at least in the short-medium term.

Some attendees perceived that there were no certificated courses currently available (3.1/n). However, it is clear from the responses on existing courses (section 4 and appendix 9) that there are already some post graduate qualification courses available, e.g. in Austria, Germany and the UK. These courses are relatively new and their promotion may not generally go beyond the national boundaries, and/or issues of location and language may limit their promotion and accessibility.

The need for an independent accreditation body was highlighted (section 3.2/o). In the UK, an Institute of Knowledge Transfer has been established, although not yet operational, with this as one of its key objectives. Initial discussions are progressing on the possibilities for this to develop into a European approach.

The role of professional associations at the national and European levels was highlighted (section 3.2/j, k, l). Some member states have well-established national professional associations (e.g. France, Spain, UK), some other member states have seen them develop in recent years (e.g. Italy, Poland, Portugal), and in others they may be informal/emerging (e.g. Greece). These associations can and do play an important role in the development and delivery of training at the regional and national levels. The European associations support the sharing and dissemination of good practice across member states and between national professional associations. In addition, ProTon Europe has facilitated and supported the creation of some of the newer national associations, and in fact one of its characteristics is a 'network of networks'. However, there are a number of member states where national associations are not yet established or even emerging. For these member states, who may also not yet have other important resources/infrastructure or the market size, the role and training provision of the European associations will be particularly important.

The need for training courses to be highly practical, using case studies, being work-based, using practitioners and other experts, involving staff exchange/mobility, is clear from the workshop, and is supported by the results of other surveys (e.g. UK and Greece). However, this may also bring many challenges in terms of consolidating this type of training into MBA-type qualifications, since universities usually have specific requirements in terms of the extent and level of academic content. The AURIL/Open University Post Graduate Certificate in Knowledge Transfer is an example of an existing programme which has managed to achieve a balance between these two requirements (50% academic & 50% work/project based) (see appendix 9).

The importance and potential benefit of staff exchange/mobility programmes was highlighted, and the important role that could be played by the EU. Although the Marie Curie mobility programme already exists, a number of attempts to access it to support TT mobility have failed – it seems that the programme's objectives and assessment criteria are oriented towards academic/researcher mobility. Therefore it seems that either the Marie Curie programme needs to be amended or an additional programme devised to specifically support TT mobility.

4. Existing Courses

“What existing national or European courses do you know of and what are their characteristics?”

The responses to this question from attendees following the workshop have been collected and reported in appendix G9. The detail provided in the responses is often very limited, although links to websites and other information are generally provided.

From the information provided, it is evident that a range of short courses, workshops, and qualification programmes are already available, although they are limited in number and accessibility (e.g. because of language, location, extent of promotion).

Further work would be required to undertake a more extensive survey and to obtain comprehensive details about the courses available across the EU member states.

Appendix G – Expert Workshop Appendices & Supporting Materials

1. Workshop Agenda

CREST OMC 3% Expert Group on IPR: Work stream 2

Workshop for Knowledge Transfer Professional Representatives

Date: 22 March 2006

Location: DG Research (CDMA / Room SDR2, Brussels)

Timing: 09.30 – 16.15

Agenda

| | |
|-------|--|
| 09.30 | Registration/Administration |
| 09.50 | Welcome and Introduction by Chair (Ron Marchant) |
| 10.00 | Work stream 2 Objectives and Activities (Jeffrey Matakupan) |
| 10.20 | Identification of needs/priorities for KT professional target groups, roles, skills and knowledge (Martin Haywood) |
| 10.30 | Individual review |
| 10.40 | Small group discussions |
| 11.30 | Feedback from groups |
| 11.50 | Discussion of feedback |
| 12.20 | Lunch |
| 13.20 | Identification of needs/priorities for KT training content, levels, and delivery styles (JM/MH) |
| 13.30 | Individual review |
| 13.40 | Small group discussions |
| 14.45 | Feedback from groups |
| 15.05 | Discussion of feedback |
| 16.00 | Summary, Conclusions, Next Steps (RM/JM/MH) |
| 16.15 | Close |

2. Workshop Attendees

| Name | Organisation | Country |
|--|---------------------------------------|---------|
| Knowledge Transfer Professional Representatives | | |
| Mulder, Martin | Wageningen University | NL |
| Balling, Gert | Technical University of Denmark | DK |
| Secher, David | N8 | UK |
| Malainer, Gerhard | AT | |
| Kroner, Thomas | | DE |
| Herzog, Ruth | Deutsches Krebsforschungszentrum | DE |
| Da Silva, Nuno | Instituto Pedro Nunes | PT |
| Lopez, Oscar | University of Zaragoza | ES |
| Foniadaki, Kleri | National Hellenic Research Foundation | GR |
| Veckalns, Viesturs | Riga Technological University | LV |
| Sylvén-Troedsson, Annelie | LU Innovation | SE |
| Linschoten, Raoul | University of Utrecht | NL |
| Caillaud, Frederic | President of LES, France | FR |
| Manfroy, Willy | | USA |
| Skinner, Jeff | ASTP/University College, London | UK |
| Wolters, Willem | | NL |
| Graham, Philip | AURIL/Queens University, Belfast | UK |
| Smailes, Bob | Leiden University | NL |
| Capart, Gilles | ProTon Europe | BE |
| Kmet, Andrej | Slovak Academy of Science | SK |
| Cook, Tim | Isis | UK |
| Koeck, Markus | MCI | AT |

Facilitators

| | | |
|-------------------|----------------------------------|----|
| Cullen, Lawrence | The Patent Office | UK |
| Marchant, Ron | The Patent Office | UK |
| Matapukan, Jeffry | Ministry of Economic Affairs | NL |
| Haywood, Martin | University of Sunderland | UK |
| Dambois, Denis | DG Research, European Commission | EU |
| Moeschler, Frank | DG Research, European Commission | EU |

3. Workshop Proformas: Group Skills Exercise

1. The question forming the basis of this exercise appears at the top of the Proformas A, B & C.

“What skills/expertise should a person possess to be able to work as a professional in the field of Technology Transfer?”

2. In box A2, write down as many ideas as possible related to your answer to the question. Take about 10 minutes and do it independently of other group members.
3. In box A3, rank the ideas in box A2 in terms of 1, 2, 3, 4 – with 1 being the idea which you feel is the best/most important idea - and so on until you have ranked your ideas (at least the top 5).
4. The group facilitator then goes around the group collecting the top two ideas from each person and records them on the flipchart. The remaining ranked ideas can serve as replacements for duplicated ideas, so that if someone has already presented the same idea before you were required to declare your top two rankings then you would move onto your 3rd and 4th ideas etc. This should be done without any judgmental comments being made.
5. Once two ideas from each group member have been recorded, the group can begin the discussion of the ideas. Take about 15 to 20 minutes to openly discuss and clarify the list of ideas.

- 6.** After this discussion these ideas can be written up on proforma B (in Box B2) by all group members in the same order (as on the flipchart). Each group member then ranks all of the ideas in Box B3. So for example if there are 5 people in the group there will be a list of 10 ideas. Each group member should rank the ideas 1 to 10 with 1 being the top idea and so on.
- 7.** Once this ranking exercise has been completed, the group facilitator goes round the group to collect each of the rankings for each of the individual ideas and then sums them in Box B4. The outcome is then a list of ideas with a score related to the summed ranks such that the lowest score will be the idea that most of the group had given a high rank. The group then has some consensus of the relative significance, or value of the ideas, which can be a basis for establishing priorities for action.
- 8.** Elect a Group Rapporteur to provide feedback to the plenary session.
- 9.** Pro-forma C can help to summarise the ideas in priority order.
- 10.** After the group feedback and plenary discussion, please hand-in your individual proformas A & B to the group facilitator (it would be helpful for any later follow-up if you would write your name at the top of the proformas). The group facilitator will hand-in these proformas together with his proforma C for the group.

| PROFORMA A | |
|---|--------------------------------|
| <div>A1 Question</div> <p>“What skills/expertise should a person possess to be able to work as a professional in the field of Technology Transfer?”</p> | |
| <div>A2 Individual Ideas in Response to the Question</div> | <div>A3 Rank top 5 ideas</div> |

| PROFORMA B | | |
|---|-----------------------------|--------------------------|
| <div><div>B1 Question</div><div>“What skills/expertise should a person possess to be able to work as a professional in the field of Technology Transfer?”</div></div> | | |
| <div>B2 Complete List of Group Ideas/Responses (Sum)</div> | <div>B3 Personal Rank</div> | <div>B4 Group Rank</div> |

| FPROFORMA C | | |
|--|------|--------------|
| <div>Question</div> <p>“What skills/expertise should a person possess to be able to work as a professional in the field of Technology Transfer?”</p> | | |
| Priorities for Action or Attention List of Answers/Ideas in Priority Order – Top idea has the lowest score. | Rank | Sum Total |
| | 1 | |
| | 2 | |
| | 3 | |
| | 4 | |
| | 5 | |
| | 6 | |
| | 7 | |
| | 8 | |
| | 9 | |
| | 10 | |
| | 11 | |
| | 12 | |
| | 13 | |
| | 14 | |

4. Workshop Proformas: Group Exercise on Education Programmes/Courses

11. The question forming the basis of this exercise appears at the top of each page of proforma D.

“If the identified skills/expertise are going to be taught through education programmes and/or training courses, what should be the main characteristics of such programmes/courses?”

12. Each page of proforma D has a separate sub-question to the above main question that addresses each of the key characteristics (D1-6).

13. In box D1a, review the ideas that may be presented and write down any specific/additional ideas related to your answer to the question. Do this and steps 4 & 5 independently of other group members.

14. In box D1b, prioritise the ideas in box ‘a’ of that page in terms of 1, 2, 3, 4 – with 1 being the idea which you feel is the most important and so on.

15. Repeat steps 3 & 4 for sub-questions D2-D6 on the following pages. Take about 15-20 minutes over steps 3, 4 & 5 for D1-6.

16. For each page/sub-question:

a. the group facilitator collects any additional ideas (on the flipchart) and the priorities for all ideas from each member of the group;

b. the group discusses the ideas;

c. after this discussion the group then ranks all of the ideas (recorded by the group facilitator on the flipchart).

17. Elect a Group Rapporteur to provide feedback to the plenary session.

18. After the group feedback and plenary discussion, please hand-in your individual proformas D1-6 to the group facilitator (it would be helpful for any later follow-up if you would write your name at the top of the proformas). The group facilitator will hand-in these proformas.

| PROFORMA D | |
|--|-----------------------------|
| D Overall Question “If the identified skills/expertise are going to be taught through education programmes and/or training courses, what should be the main characteristics of such programmes/courses?” | |
| D1 Question “Who should be the target sector audience(s) of such programmes/courses?” | |
| D1a Response Universities Public Research Organisations Industry Other sectors/subgroups? | D1b Prioritise ideas |

| PROFORMA D | |
|--|-----------------------------|
| D Overall Question “If the identified skills/expertise are going to be taught through education programmes and/or training courses, what should be the main characteristics of such programmes/courses?” | |
| D2 Question “Who should be the target audience(s) of such programmes/courses in terms of their experience levels?” | |
| D2a Response People before entering the profession (e.g. students) People in the first 2 years People in years 3-5? People in years >5 Other sub-groups? | D2b Prioritise ideas |

| PROFORMA D | |
|--|---------------------------------|
| <div>D Overall Question</div> <p>“If the identified skills/expertise are going to be taught through education programmes and/or training courses, what should be the main characteristics of such programmes/courses?”</p> | |
| <div>D3 Question</div> <p>“What should be the status of such programmes/courses?”</p> | |
| <div>D3a Response</div> <p>Short Training Courses (1-3 days)</p> <p>Longer Training Courses</p> <p>Post Graduate Course (Masters Level)</p> <p>MBA-type</p> <p>Professional/Vocational Qualification</p> <p>Other types?</p> | <div>D3b Prioritise ideas</div> |

| PROFORMA D | |
|--|---------------------------------|
| <div>D Overall Question</div> <p>“If the identified skills/expertise are going to be taught through education programmes and/or training courses, what should be the main characteristics of such programmes/courses?”</p> | |
| <div>D4 Question</div> <p>“What topic areas should be covered by the programmes/courses – all topics or specific topics?”</p> | |
| <div>D4a Response</div> <p>All topics</p> <p>Specific topics (please specify below)</p> | <div>D4b Prioritise ideas</div> |

| PROFORMA D | |
|--|-----------------------------|
| D Overall Question “If the identified skills/expertise are going to be taught through education programmes and/or training courses, what should be the main characteristics of such programmes/courses?” | |
| D5 Question “Should such programmes/courses offer the possibility to learn with and from technology transfer professionals from other Member States in the European Union and offer EU-networking possibilities between participants?” | |
| D5a Response No Yes To what extent (e.g. %, no of days, or specific topics)? | D5b Prioritise ideas |

| PROFORMA D | |
|---|---------------------------------|
| <div>D Overall Question</div> <p>“If the identified skills/expertise are going to be taught through education programmes and/or training courses, what should be the main characteristics of such programmes/ courses?”</p> | |
| <div>D6 Question</div> <p>“How should such a course be organised?”</p> | |
| <div>D6a Response</div> | <div>D5b Prioritise ideas</div> |

5 Workshop Proformas: Individual Post-Workshop Activity on Existing Education Programmes/Courses

19. The question forming the basis of this post-workshop activity appears at the top of proforma E.

“What existing national or European courses do you know of and what are their characteristics?”

20. After the workshop you will be e-mailed an electronic version of proforma E.

21. Please use the proforma to provide details of any known programmes (one page for each programme/course, and including any relevant website & e-mail contact details).

22. Please e-mail the proformas to Martin Haywood at martin.haywood@sunderland.ac.uk, preferably by 7 April 2006.

PROFORMA E

E Overall Question

“What existing national or European courses do you know of and what are their characteristics?”

E1 Title

E2 Provider (including contact details, website etc)

E3 Target Audiences

E4 Status (Short course, Post-graduate etc)

E5 Topics Covered / Skills taught

E6 Other Comments

6 UK/AURIL Surveys & Frameworks 1999 & 2005

AURIL has conducted two major knowledge transfer skills surveys in the UK over the last 7 years – one in 1999 which led to the development of the first Competency Standards Framework for Knowledge Transfer professionals working in universities (see AURIL CPD Framework at <http://www.auril-cpd.org/links/publicdocs/>), and one in 2005 as part of a review of the Competency Standards Framework in order to update it and to cover KT professionals in all sectors (this survey/review was supported by the UK Government Department for Trade and Industry). The first survey involved 62 professionals and the second survey involved 94 professionals. This latter review is currently (April 2006) being extended to cover professionals across the EU with the support of ProTon Europe – the results are expected in September 2006.

The following table highlights and compares the skills mentioned by the participants of the two surveys.

| Skill | % of Respondents specifying Skill need | |
|-----------------------|--|------|
| | 1999 | 2005 |
| Communications | 92 | 88 |
| Negotiation | 68 | 84 |
| Project Management | 68 | 49 |
| Leadership | 61 | – |
| Marketing | 58 | 59 |
| Facilitation | 55 | 65 |
| Oral Presentation | 50 | 39 |
| Time Management | 47 | 49 |
| Business Planning | 47 | 45 |
| Commercial Insight | 47 | 41 |
| Conceptualisation | 45 | 31 |
| Selling | 39 | 26 |
| Financial | 37 | 61 |
| Entrepreneurial | 37 | 47 |
| Public Relations (PR) | 24 | 25 |
| Legal | 18 | 33 |

Comparing the two sets of results it seems that, despite a time gap of 6 years and the involvement in the second survey of professionals from a wider range of organisations, the differences that arise are more differences of degree rather than of kind.

However, it is interesting to highlight the following changes:

- Leadership was not mentioned in 1999 but is the 4th most significant in 2005. This seems to relate to the leading role played by KT professionals in relation to projects, to guiding and supporting client business development, and to guiding and supporting colleagues in KT developments.
- Project Management has increased significantly – the KT role is highly project oriented, often involving the management of a significant number of projects for a range of stakeholders and differing expectations.
- The significant reduction in Financial and Legal skills – probably as a result of the recent increase in the size of KT offices in the UK, especially in universities, involving the recruitment of specialist staff in these two areas. However, it is also interesting to note that interpersonal-type skills (communications and negotiation) continue to top the list.

The Framework that resulted from the 1999 Survey identified the following Key Roles:

- Manage Information and Communications
- Manage Relationships
- Manage Projects
- Manage the Commercial Interface
- Manage Operations in a Legal Context
- Problem Solve and Manage the Decision Making Process

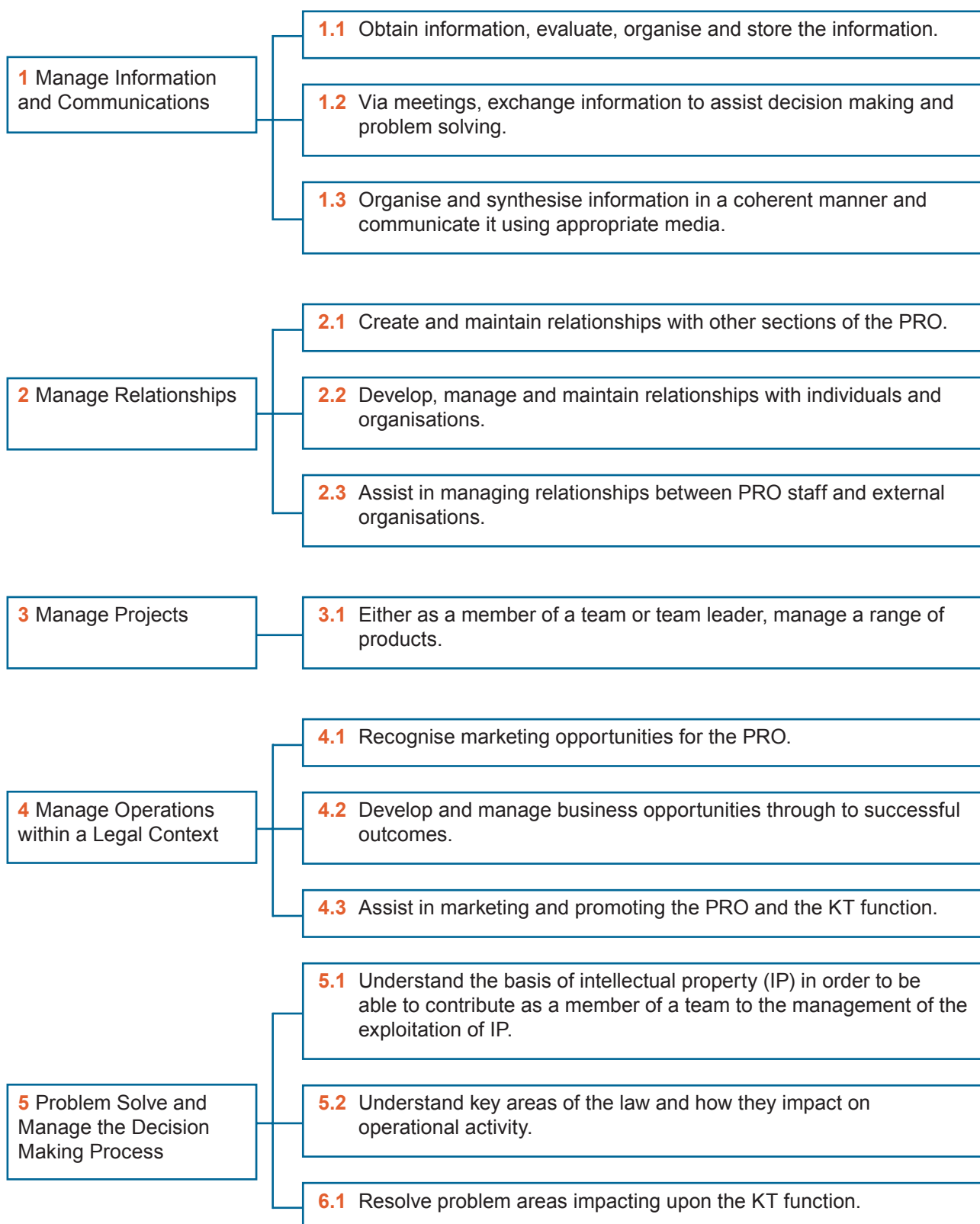
This Framework was adopted by ProTon Europe in 2003. The units comprising these key roles, together with the associated skills are shown in the following pages.

The recent survey (see following pages for copy of report) has resulted in a new draft Framework which keeps the above 6 Key Roles (with some minor amendments to the detailed units and elements), but adds 2 new Key Roles:

- Provide and be the Source of Leadership
- Provide Leadership at the Senior Management Level

The new Framework will be published in the near future and may be amended in the light of the ProTon Europe review currently in progress across the EU.

AURIL CPD Key Roles and Units



AURIL CPD Skills Matrix

| KEY ROLES | SKILLS | | | | | | | | | | | | | | | | | | | |
|---|-----------------|-----------|--|---------------------------------------|------------------|---|--|-----------------------|-------------------------------------|--------------------|-------------------------------|--------------------|----------------------------|-------------------------------------|-------------------|---|---------------------|--|-------------------|--|
| | Research skills | IT Skills | Organisational skills and co-ordination skills | Oral and written communication skills | Active listening | Meeting skills: chairing and contributing | Presentational skills and marketing skills | Editing and précising | Team leadership/team working skills | Influencing skills | Skilled in receiving feedback | Negotiating skills | Conflict resolution skills | Planning and time management skills | Business planning | Business development and selling skills | Facilitation skills | Problem solving and decision making skills | Networking skills | |
| 1. Manage Information and Communications | | | | | | | | | | | | | | | | | | | | |
| 1.1 Obtain Information | ✓ | ✓ | ✓ | | | | | ✓ | | | | | | | | | | | | |
| 1.2 Exchange Information | | | | ✓ | ✓ | ✓ | ✓ | | | | | | | | | | | | | |
| 1.3 Organise Infrmation | | | | ✓ | | | ✓ | ✓ | | | | | | | | | | | | |
| 2. Manage Relationships | | | | | | | | | | | | | | | | | | | | |
| 2.1 Relationships with other parts of PRO | | | | ✓ | | | ✓ | | ✓ | ✓ | ✓ | ✓ | | | | | | | ✓ | |
| 2.2 Relationships outside PRO | | | | ✓ | ✓ | | | | | | | ✓ | | | | | | | ✓ | |
| 2.3 Relationships between PRO and external agencies | | | ✓ | ✓ | | | ✓ | | | ✓ | | | ✓ | | | | | | ✓ | |
| 3. Manage Projects | | | | | | | | | | | | | | | | | | | | |
| 3.1 Manage a range of projects | | | | ✓ | | ✓ | | | | ✓ | | | | ✓ | | | | | | |
| 4. Manage the Commercial Interface | | | | | | | | | | | | | | | | | | | | |
| 4.1 Recognise opportunities | | | | | | | | | | ✓ | | | | | ✓ | ✓ | | | ✓ | |
| 4.2 Develop opportunities | | | | ✓ | ✓ | | | | | ✓ | | | | | | ✓ | ✓ | | | |
| 4.3 Market and promote the PRO & KTO | | | ✓ | | | | ✓ | | | | | ✓ | | ✓ | | | | | ✓ | |
| 5. Manage operations within a legal context | | | | | | | | | | | | | | | | | | | | |
| 5.1 Understand basis of intellectual property | | | | ✓ | ✓ | ✓ | | | | | | ✓ | ✓ | | ✓ | ✓ | | ✓ | | |
| 5.2 Understand areas of law & impact on operations | | | | ✓ | | | | | | | | ✓ | | | | | | | | |
| 6. Problem solve and manage decision making process | | | | | | | | | | | | | | | | | | | | |
| 6.1 Resolve problem areas | | | ✓ | | | | | | ✓ | | | | | | | | | ✓ | | |

JOB REQUIREMENTS

INDIVIDUAL CAPABILITY

1. Manage Information and Communication.

- 1.1 Obtain information, evaluate, organise and store the information.
- 1.2 Via meetings, both inside and outside of the PRO, exchange information to assist decision making and problem solving.
- 1.3 From a range of both technical and non-technical sources, organise and synthesise information in a coherent manner and then communicate it using appropriate media.

2. Manage Relationships.

- 2.1 Create and maintain relationships with the staff of other sections of the PRO.
- 2.2 Develop, manage and maintain formal relationships with people and organisations outside of the PRO.
- 2.3 Assist in managing relationships between PRO staff and external organisations.

3. Manage Projects.

- 3.1 Either as a member of a team or a team leader manage a range of projects.

4. Manage the Commercial Interface.

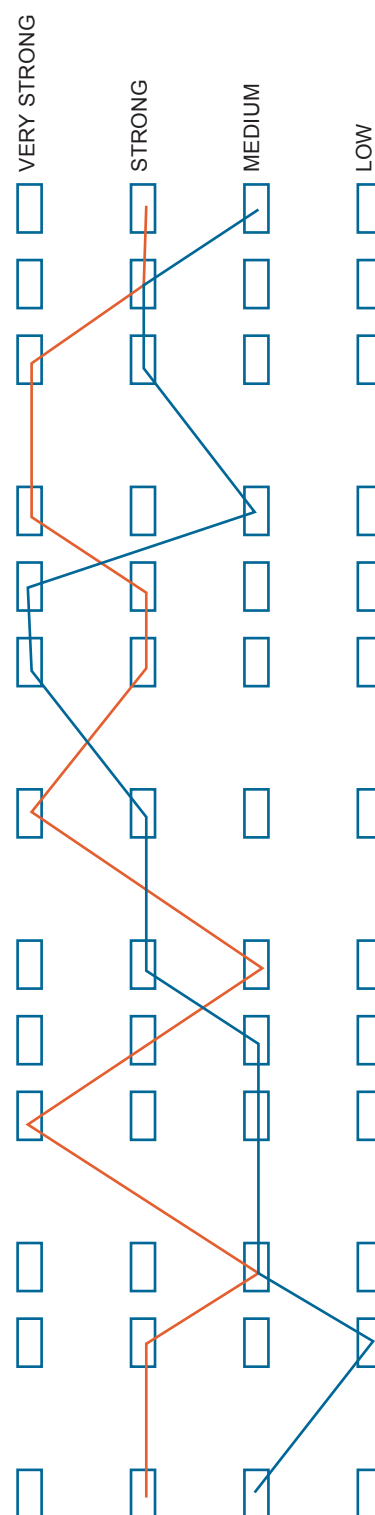
- 4.1 Recognise opportunities for marketing the capabilities of the resource base of the PRO.
- 4.2 Exercise business development skills and develop and manage business opportunities through to successful outcomes.
- 4.3 Assist in promoting and marketing the PRO and the KT function to targeted individuals, organisations and sectors.

5. Manage Operations within a Legal Context.

- 5.1 Understand the basis of intellectual property (IP) in order to be able to contribute, as a member of a team, to the management of the exploitation of IP.
- 5.2 Understanding key areas of the law and the basic tenets that underlie relevant branches of the law and how they impact upon operational activity.

6. Problem Solve and Manage the Decision Making Process.

- 6.1 Through the acquisition of data and information evaluate, review and resolve problem areas impacting upon the KT function.



Report on the Review of the AURIL CPD Framework for Knowledge Transfer Practitioners (Aug 05 – Feb 06)

1. Introduction

This report provides a brief review of the methodology used in, and the insights resulting from, under-taking the research necessary to review and up-date the AURIL CPD Framework document. The research was commissioned in order to identify the changes required to reflect any developments in the roles of Knowledge Transfer Practitioners⁴ (KTPs) in the Higher Education sector since the last research in 1999/2000, and also to take account of the needs of KTPs in other sectors, including Public Sector Research Establishments (PSREs), Science Parks, and a range of intermediary organisations. The information arising from the research activity has meant that the Framework document has seen major revisions in some parts, whilst in others amendments have been relatively minor. It is not however the intention of this report to catalogue all of the detail which has informed this revision, rather the content of this report relates to those factors which have had a significant impact on the re-write of the CPD Framework document.

The work was commissioned by AURIL (Association for University Research and Industry Links) as part of a national knowledge transfer (KT) training project funded by the Department for Trade and Industry Office of Science and Technology, and was additionally supported by the Department for Trade and Industry Innovation Unit.

2. Methodological Note

Data and information was collected using both qualitative and quantitative research approaches. The work included conducting a range of in-depth interviews, carrying out one focus group session involving two groups, and a 'self-administered questionnaire' survey.

In total 30 respondents were interviewed using a mixture of telephone and face-to-face in-depth interviews. The organisations from which respondents were drawn are listed in appendix 1 and included 10 from higher education and 20 from other organisations involved with knowledge transfer activity. A further 12 individuals (all from higher education), provided data as a result of focus group activity. A total of 52 people provided data via the questionnaire and of these 44 were from the higher education sector, whilst the remaining 8 were employed in KT roles in other organisations.⁵

As appendix 1 illustrates, respondents were employed in a broad range of organisational settings extending from higher education institutions to government advisory services, and included both public sector research organisations and private sector organisations. The various organisational forms are characterised by widely differing administrative and managerial arrangements. They extended from knowledge transfer offices (KTOs) within universities to a 'company limited by guarantee' and operating in what might best be described as a quasi-private sector capacity. A feature of many of these organisations is that they are frequently required to accommodate the interests of a wide range of stakeholders.

⁴ NB The acronym KTP is used throughout this document to refer to Knowledge Transfer Practitioner

⁵ It is not possible to list the organisations for those respondents returning questionnaire this was because for the most part this was done anonymously via an internet based survey. Questionnaires were however sent out using the Knowledge Transfer Partnership Regional Network together with a list of University KTOs. The aim was to try and ensure wide spread coverage on a geographical basis.

3. Key Results and Outcomes

3.1 Introduction

Despite the range of organisations covered and the varied job roles of the KTPs in these organisations, a significant comment from those who are aware of the CPD Framework is that the existing material is broadly sound.

Before reviewing the details it is important to re-iterate that the current CPD Framework document was based on research carried out solely amongst people who were employed in KT activity within the higher education sector. This was essentially a reflection of the fact that the focus of research activity at that time was AURIL members. As can be seen from the details listed in appendix 1, the current exercise has included a significant number of respondents currently employed in a wide range of KT organisations, not solely higher education establishments and not necessarily AURIL members.

Despite the difference in make-up of the respondents, the wide spectrum of organisational forms, and the differences in the nature of the KT job roles, differences in relation to the skills and competencies required tend to be more 'differences of degree' rather than 'differences of kind'. The differences appear to result more from the mission and consequent focus of the different organisations involved in KT activity, rather than anything fundamentally different in the skills and competencies used in order to achieve the objectives of specific job roles.

This indicates that it is possible to develop a comprehensive CPD Framework that would be of relevance to a wide range of KTPs, regardless of organisational context, without the content needing to be so generic that it has little real value as a source of CPD guidance for these KTPs.

3.2 Managing Differing Expectations

As has already been pointed out, people operating in the field of KT, work in an extremely diverse range of organisational settings. The financial basis on which many KTOs operate is frequently the result of a cocktail of different sources of finance including research grants, public sector funding and private sector finance; the result of commercial contracts or some form of partnership activity. In addition, KTPs can also be involved in working on a diverse range of projects. The net result of this is that many KTPs are working in organisations where it is necessary to respond to the requirements of a wide range of stakeholders whose objectives and agendas are not necessarily always consistent. This requirement to manage the differing expectations of a range of stakeholders, and to manage and accommodate such ambiguity, is a characteristic feature of the job role of many KTPs. Even within organisations, particularly the multi-product environment of higher education institutions, different parts of the organisation may approach KT activity in different ways. This is often a reflection of the level of autonomy that characterises the way in which faculties in many universities operate.

3.3 Pulling Technology – Pushing Technology

Differences in responses that did arise between people working in non-higher education KT organisations and those within higher education units appear to be the result of differences of focus.

Many of the non-higher education bodies operating in the field of KT are support or advisory bodies that are working towards encouraging innovation and the greater use of technology by companies - albeit companies that can be described as 'technology active'. There is a clear commitment by KTPs working in such organisations to add value to the client organisation. In order to be able to do this in an effective manner they need a strong commitment to understanding the nature

of the business, the needs of the businesses, and what will fit, given its current stage of development. A respondent from one such organisation commented that in the field of innovation they saw their role as that of “...helping organisations to help themselves”. This approach has been described by a number of respondents, from different KT organisations, as ‘pulling technology’ into the organisation.

In contrast it has been suggested that the higher education KTOs are much more focused towards exploiting their knowledge resources as part of a strategy to maximise financial returns. As a result their focus tends to be more in terms of ‘pushing’ the technology. The net result, it is suggested, is that the non-higher education sector tends to be more client centred in its approach to dealing with client businesses. Undoubtedly such broad generalisations gloss over a great many variants in approach.

There is however one notable caveat to which it is worth drawing attention. In those cases where a number of higher educational bodies have formed a consortium to act co-operatively in the market place, e.g. ‘Contact’ in the West Midlands, there is every indication that this approach results in a greater level of client focus. The KTPs working in this cluster model, rather than focusing on what a particular higher educational unit has to offer, begin with a rigorous review of client needs and then source solutions according to which higher educational unit or units they feel can best serve those needs.

3.4 Customer Focus

Despite these latter remarks, compared with the information arising from the 1999/2000 research exercise, the current data indicates that KTPs in all areas recognise a greater need for good ‘customer relationship management’ as a key competency. This change suggested that ‘customer focus’ and ‘meeting customer requirements’ needed to be made more explicit in a revised document.

3.5 Strategic Understanding

Another area of difference between the two sets of research data relates to the significance attached to a requirement for a level of ‘strategic understanding’. Current data suggests that as well as having an understanding of operational issues, KTPs are also expected to have a degree of ‘strategic understanding’. This does not necessarily infer having responsibility for the overall strategy of an operational unit, (although this is likely to be a requirement for those senior managers with overall responsibility for the KTO), it relates to the strategic demands of operating on project based activity.

There is evidence, particularly within the higher education sector, that the nature of the role of the KTP is more likely to involve working on clearly defined projects, rather more so than was the case 6 or 7 years ago. This change may well be a reflection of the impact of third stream funding. Given this project focus there is some evidence that the KTP is seen to be, (or expected to be), the most appropriate person to provide strategic leadership and clarity for a particular project. This results from the fact that in many KT projects there is often seen to be a number of different approaches that can be adopted in relation to the pathway from project initiation to commercialisation. Evidence indicates that the KTP, either implicitly or explicitly, is frequently required to provide the necessary ‘strategic leadership’.

3.6 Portfolio Building

A related area is that of building and developing organisational capacity. This relates to the strategic vision and the strategic activity that is necessary in order to develop a portfolio of KT activity, such that it is characterised by a significant degree of synergy and as a result, moves the PRO in a particular direction. Although it could be suggested that this is likely to be a feature of a senior

management role, nevertheless operational staff, particularly if they have a degree of responsibility for project or business development, will need to be aware of the impact and influence specific projects and project outcomes can have on an organisation's strategic focus.

3.7 Task Leadership

As well as the need to contribute to 'strategic leadership' there is evidence that leadership is of increasing significance for the KTP when compared with the results arising from the 1999/2000 research exercise. Within the 1999/2000 survey, 'leadership' as a skill/competency was not included in the list of skills referred to in the survey questionnaire. Respondents did however have the opportunity to cite 'leadership' under a category, 'Others please mention'. No reference was made to 'leadership'.

In the current questionnaire 'leadership' was included as a skill and 56% of respondents mentioned it as a skill they exercised in undertaking their job role, making it 7th in terms of skills highlighted, out of 17 skills listed.

Information arising from the in-depth interviews suggests that for the most part leadership is being exercised in relation to adopting a leading role in relation to specific projects. In this context the leadership role is being exercised in helping to ensure that project activity progresses according to plan and that, outcomes are achieved in accordance with agreed targets. This is clearly a more task orientated leadership role. In relation to this assessment it is worth reflecting upon the fact that many of the people working in KT in the higher education sector are likely to be working to support activity that has its origin in a department or faculty. They may nevertheless have some responsibility for outcomes. Equally they may not necessarily have definite role authority. In a similar vein, many of those working in the non-higher education sector are fulfilling a brokering or facilitation role, through which they are trying to ensure planned outcomes are achieved. Their performance is frequently measured in relation to such outcomes – outcomes over which, again, they have limited operational authority. Such factors may go some way to explaining this orientation more towards task centred leadership. A new role of 'Provide and be a Source of Leadership' has been included in the revised Framework. (See footnote 2 below).

3.8 Providing a Leadership Role for the KTO

Depending upon the size and nature of the KTO within the organisation, there is often a requirement for a senior individual to provide overall organisational leadership within the KTO. It is recognised that many of the skills are generic and are common to anyone fulfilling such a senior role and as such are well catered for in the standards presented by the Management Standards Centre.⁶ Key roles on leadership have however been included in the revised framework.⁷ This is not only to accommodate the more task orientated leadership areas outlined above but also to accommodate the requirements of such a senior role. This is not to attempt to replicate the material covered by the Management Standards Centre but rather to highlight the distinctive elements of such a role within a KTO.

3.9 Mentoring

Another skill or competency that has arisen during this current research exercise is that of mentoring. There appears to be two reasons why mentoring has achieved a degree of prominence in the interviews.

⁶ The Management Standards Centre is the standards setting body for the national occupational standards for management see <http://www.management-standards.org.uk>

⁷ Key Roles 'Provide and be a source of Leadership' and 'Provide Leadership at the Senior Management Level' have been added to the revised Framework as Key Roles 7 & 8.

Firstly, the job role of many of the KTPs employed outside the higher education sector, (and some in the sector) involves providing support, advice and guidance for client businesses. This may be in relation to encouraging the development and use of significant technology, or it may be in relation to a start-up business such as a spin-out. In such circumstances the KTP can find themselves either implicitly or explicitly fulfilling a mentoring role with regard to steering the business through a crucial development stage.

Secondly, reference to mentoring also arose as a result of discussions about training needs. When asked about training needs and the availability of training provision, a number of more experienced KTPs suggested that although there were many possibilities for acquiring skills and knowledge via attending training events, in some areas there was no substitute for 'experience' and 'learning by doing'. One such area mentioned was that of negotiating commercial agreements such as licensing agreements. It was suggested that the best approach was to work with a mentor and develop the skill experientially. Being able to act as a mentor, or recognising when to take advantage of an opportunity to be mentored, was considered an important skill or attribute.

3.10 Analytical Skills

During the in-depth interviews a number of respondents made a strong case for ensuring that 'research and analysis' skills were given the appropriate degree of significance. 'Research and analysis' covers the skills necessary to review and evaluate proposals and then to carry out necessary background research activity. Whether in relation to the feasibility work and market analysis for a 'spin out', or whether it is in relation to understanding client requirements and client problems, this is regarded as a vital competency. Key elements are the use of questioning and probing skills, and rigorous analysis, in order to ensure the collection of information, both in terms of breadth and depth, to facilitate effective decision making. It is necessary to have an understanding of which research techniques can be used and in what circumstances they might be effective, together with the ability to analyse resultant data. One respondent commented "...it also means being able to review activity in a critical fashion and build the consequences of that review back into the overall strategy".

Associated with this is the 'commercial awareness' and 'commercial insight' to be able to make judgements, at the early stages of activity, about which proposals are worth pursuing and those which are not. This is also directly linked to issues of financial awareness which are commented upon below.

3.11 Financial and Commercial Considerations

Feedback in the course of the in-depth interviewing activity also suggested that the current Framework needs to be more definitive and more robust in relation to financial and commercial issues. In relation to this information there is however some degree of conflict between the qualitative information and the quantitative data. In the results from the questionnaire survey, which attempted to identify the skills sets respondents regarded as important, 'financial awareness' recorded almost half of the mentions recorded for the 1999/2000 study and was regarded as the 4th most important skill. In the current survey it received 37% of the mentions and had fallen to 9th place in the list of skills mentioned. It is difficult to fully understand this difference.

Despite there being a question mark in relation to the significance of 'financial awareness', cognisance has been taken of the feedback and changes to the Framework document have been made accordingly.

3.12 Entrepreneurship

Another skill area that has attracted some reference is that of entrepreneurship. Many of the KTPs interviewed, recognised that understanding entrepreneurial processes was important. It was not felt necessary however to be an entrepreneur. One senior KTP suggested if someone involved in KT was too entrepreneurial “...there could be a danger that they would simply cherry pick ideas and proposals on the basis of those which appeared to have early promise”. This might then be detrimental to other ideas that did not immediately suggest themselves as winners. It was then suggested that “....In such cases the skill to stick to a rigorous and disciplined approach to review and evaluation is vital”. Another dimension of this awareness of entrepreneurial process is in relation to spin-out activity. The KTP needs the skills and competencies in relation to an understanding of these processes in order to be able to advise and assist with the early stages of spin-out development. These elements have been accommodated in the revised Framework by the inclusion of reference to ‘commercial insight skills’.

3.13 Significance of Intellectual Property (IP)

Feedback in the course of the in-depth interviews suggested that the current framework needs to be more robust in relation to IP issues. This is not to suggest that KTPs should become ‘IP lawyers’, rather that they should be able to recognise and understand when IP issues are likely to become a significant element of negotiations. When this occurs it is important that KTPs know enough about the legal issues surrounding IP to be able to decide, if and when, to seek expert legal advice. In response to this feedback, ‘elements,’ presented in Key Role 5 have been amended.

3.14 Business Planning

Similar, if less widespread, comments were made in relation to ‘Business Planning’. References to a need for competency in relation to business planning are already covered in the existing framework. In response to the current feedback however, changes have been made which, although relatively small, add further emphasis to the significance of understanding ‘business planning’.

4. Conclusions

The breadth and depth of the current data collection approach has resulted in many, even if sometimes minor, changes to the CPD Framework. To an extent some of these amendments are a response to the developments and changes that have impacted on KT activity over the last 6 or 7 years. Significant amongst such developments has been the impact of ‘third stream’ funding.

The inclusion in the research coverage of KTPs operating in the non-higher education sector has provided a different context against which the skills and competencies used by KTPs could be reviewed. This has added a valuable dimension to the review.

As has been pointed out, many of the changes add emphasis to the material already contained in the framework. In the case of Managing Relationships, Managing the Commercial Interface and Managing Opportunities within a Legal Environment changes have been somewhat more significant. These changes are a reflection of the changing nature of the job role of KTPs operating in the higher education sector, as well as of the needs of KTPs in a wider range of organisational contexts.

The most significant changes however have been in relation to Leadership. In the original Framework there was little reference to Leadership. Two key factors have however served to warrant the inclusion of Leadership in an up-dated Framework.

Firstly the impact of developments such as third stream funding and the Lambert Report has meant that for many higher education institutions responsibility for much of the external activity, and particularly income generation, has been formalised by the establishment or expansion of a dedicated department or unit with specialist staff, many of whom are recent appointments. As a result higher education institutions increasingly look to such units as a source of 'Leadership' in relation to third stream activity. Such units also require appropriate managerial leadership. Secondly the inclusion of Knowledge Transfer Practitioners from non-higher education organisations has resulted in the involvement of people, many of whom operate in a relatively autonomous manner and who frequently provide leadership, in relation to key business and technology development areas, for their client organisations.

When taken together it is hoped that these changes help to ensure that the revised CPD Framework reflects the changing role of the KTP and of the way in which the KTO is organised and managed within the context of the varied organisational settings.

Barry Warrington
People First
28th February 2006

List of the Organisations in which people responding, via an in-depth interview, were employed:

- Newcastle University
- Heriot Watt University
- NHS Innovation (SE & Northern)
- University of Durham
- RTC North
- UKSPA
- Chesterford Research Park
- Netpark Sedgefield
- Business Link Kent
- University of Hull
- Defence Diversification Agency (Scotland & Northern Ireland)
- CCLRC Rutherford Appleton Laboratory
- Smiths Institute
- University of Bradford
- PERA
- University of Teesside
- Isis Innovation (Oxford University)
- Wessex Business Link
- The Patent Office
- DTI/Knowledge Transfer Partnership – Regional Advisor
- National Physical Laboratory
- Manufacturing Advisory Service (West Midlands Area & National Representative)
- University of Central Lancashire
- SEEDA (South East England Development Agency)
- Lancaster University
- SIRA Technology Ltd (Part of the SIRA Group)

List of organisations in which people involved in the focus group activity were employed:

- University of Central England
- Keele University
- Harper Adams College
- Staffordshire University
- Coventry University
- University of Worcester

N.B. In some cases more than one individual from a single organisation provided information.

7. Results from Greek Knowledge Transfer Professionals Workshop Thessaloniki – 11/12 April 2006

1. Introduction

23 Professionals participated in the workshop. Following the introductory plenary sessions, the professionals were allocated into 4 groups to consider the 2 key questions on skills and organisation of courses, and to report back to the plenary sessions on their results. Within the group activities, the questions were first reviewed individually to identify/rank ideas/characteristics and then the group considered the individual contributions in order to agree and prioritise the groups' views.

The following sections provide a summary of the results of both the individual and the group considerations.

2. Skills

“What skills/expertise should a person possess to be able to work as a professional in the field of Knowledge Transfer?”

a. Individual Results

The following table collects together the individual ideas of important skills together with their priorities.

| Skill | Average Individual Rank | Overall Individual Rank |
|---|-------------------------|-------------------------|
| Marketing / sales | 2.0 | 1 |
| Interpersonal/communication/relationships | 3.1 | 2 |
| Industry & university experience/understanding | 3.2 | 3 |
| Technology field understanding | 3.5 | 4 |
| Organisational understanding (inc products, researchers) | 3.8 | 5 |
| KT Office/Process organisation/management | 3.8 | 6 |
| Negotiation skills | 4.0 | 7 |
| Entrepreneurial/problem solving, making money | 4.0 | 7 |
| Understanding/diagnosing Clients Business/ R&D Needs | 4.0 | 7 |
| Costing & Pricing | 4.0 | 7 |
| Market orientation/understanding/insight | 4.0 | 7 |
| Networking | 4.2 | 12 |
| Personal- motivated, proactive, reliable, trustworthy | 4.2 | 13 |
| Languages | 4.3 | 14 |
| Project management | 4.5 | 15 |
| Finance, budgeting, tax | 4.5 | 15 |
| Legal understanding/skills | 4.5 | 15 |
| IPR mgt knowledge | 4.8 | 18 |
| Idea scouting/scanning | 5.5 | 19 |
| Leadership | 5.9 | 20 |
| Knowledge/innovation management | 6.0 | 21 |
| Knowledge of public sector/funding | 6.3 | 22 |
| Team working | 7.0 | 23 |

b. Group Results

The following table presents those skills that were collected and prioritised by the groups, firstly on an individual basis and secondly on an overall group basis:

| Skill | Average Individual Rank | Overall Individual Rank | Average Group Rank | Overall Group Rank |
|---|-------------------------|-------------------------|--------------------|--------------------|
| Networking/interpersonal/communications/relationships | 4.5 | 1 | 2.3 | 1 |
| Marketing/sales | 4.6 | 2 | 2.3 | 1 |
| Understanding/diagnosing client needs | 6.4 | 3 | 3.0 | 3 |
| Idea scanning/scouting | 7.4 | 11 | 3.0 | 3 |
| Research & Market understanding/experience | 6.9 | 9 | 4.0 | 5 |
| IP law | 7.8 | 12 | 4.7 | 6 |
| Financial | 6.8 | 7 | 5.0 | 7 |
| IP management | 8.8 | 16 | 5.7 | 8 |
| Project management | 7.3 | 10 | 6.0 | 9 |
| Market trends/foresight | 8.8 | 19 | 6.5 | 10 |
| Negotiating (internally/externally) | 6.4 | 4 | 7.0 | 11 |
| Scientific/Technical understanding/credibility | 6.6 | 5 | 7.0 | 11 |
| Risk management | 8.2 | 14 | 7.0 | 11 |
| Leadership/management | 6.9 | 8 | 7.5 | 14 |
| Understanding organisation/environment | 6.7 | 6 | 8.0 | 15 |
| Understanding of KT process/capacity | 8.0 | 13 | 9.0 | 16 |
| Technology promotion | 9.4 | 20 | 9.0 | 16 |
| Entrepreneurship/making money | 9.6 | 22 | 9.0 | 16 |
| Funding Programmes | 11.3 | 27 | 10.0 | 19 |
| Costing/Pricing | 8.8 | 17 | 11.0 | 20 |
| Information management | 8.8 | 17 | 11.0 | 20 |
| Problem solving/creativity | 8.7 | 15 | 11.3 | 22 |
| Personal organisation/motivation/character | 10.3 | 23 | 11.7 | 23 |
| Knowledge mgt prior to transfer | 10.6 | 24 | 12.0 | 24 |
| Analytical | 10.7 | 25 | 12.0 | 24 |
| Legal understanding (inc public processes) | 9.4 | 20 | 13.0 | 26 |
| Ability to travel & enjoy | 15.3 | 31 | 14.5 | 27 |
| Team working | 12.0 | 28 | 15.0 | 28 |
| Languages | 13.5 | 30 | 15.0 | 28 |
| National policies/priorities | 10.8 | 26 | 16.0 | 30 |
| Business ethics | 13.0 | 29 | 17.0 | 31 |

3. Education Programmes & Courses

“If the identified skills/expertise are going to be taught through education programmes and/or training courses, what should be the main characteristics of such programmes/courses?”

3.1 Target audience(s) - Sectors

The table below presents the individual and group rankings for the main sectors presented to, and/or identified by, the individuals/groups.

| Skill | Average Individual Rank | Overall Individual Rank | Average Group Rank | Overall Group Rank |
|--|-------------------------|-------------------------|--------------------|--------------------|
| Universities | 1.8 | 1 | 1.5 | 1 |
| PROs | 2.4 | 2 | 2.5 | 3 |
| Industry | 3.2 | 6 | 3.5 | 5 |
| SMEs | 4.0 | 8 | 5 | 8 |
| Govt/regional agencies/other public agencies | 4.4 | 10 | 5.3 | 9 |
| Chambers of Commerce | 4.1 | 9 | 4.5 | 7 |
| University management | 2.5 | 3 | 2 | 2 |
| Students/researchers | 3.7 | 7 | 6 | 10 |
| NGOs | 4.5 | 11 | 6 | 10 |
| Business intermediaries/consultants | 5.3 | 12 | 6 | 10 |
| Professional/Industrial Associations | 3.2 | 5 | 2.5 | 3 |
| Science/Technology Parks | 3.0 | 4 | 4 | 6 |

3.2 Target audiences – Experience Levels

The table below presents the individual and group rankings for the experience levels presented to the individuals/groups.

| Experience Level | Average Individual Rank | Overall Individual Rank | Average Group Rank | Overall Group Rank |
|------------------------------|-------------------------|-------------------------|--------------------|--------------------|
| <= 0 years (before entering) | 3.4 | 4 | 3.5 | 3 |
| 0-2 years | 1.4 | 1 | 1 | 1 |
| 3-5 years | 2.2 | 2 | 2 | 2 |
| >5 years | 3.1 | 3 | 3.5 | 3 |

3.3 Status of Programmes/Courses

The table below presents the individual and group rankings for the different types of course status presented to the individuals/groups.

| Status | Average Individual Rank | Overall Individual Rank | Average Group Rank | Overall Group Rank |
|--------------------------------|-------------------------|-------------------------|--------------------|--------------------|
| short courses (1-3 d) | 2.2 | 1 | 2 | 1 |
| longer courses | 2.9 | 2 | 2 | 1 |
| Post Graduate | 3.3 | 3 | 2.75 | 3 |
| MBA-type | 4.6 | 5 | 4.75 | 5 |
| Professional/Vocational Qual'n | 3.3 | 3 | 3 | 4 |

The following were also mentioned by some individuals as being important:

- on the job
- exchange of expertise
- e-learning
- seminars

3.4 EU level learning/networking

All those who answered this sub-question reported that this was an important characteristic of such courses.

However, there was considerable variation in views on the extent. When percentages (of course time) were given they were within the range 20-60% with an average of 43%. Where days were specified (2 cases), the range was 3-5 days per annum – average of 4 days per annum.

The following topics were identified for delivery at this level:

| Topic | Number of Individuals specifying |
|-------------------------|----------------------------------|
| Marketing | 6 |
| Management/leadership | 4 |
| IPR/licensing | 4 |
| KT models/processes | 3 |
| Best practice | 3 |
| Negotiation | 2 |
| Policy issues | 2 |
| Networking | 2 |
| Communications skills | 2 |
| Crisis mgt | 1 |
| Developing Research | 1 |
| Business Planning | 1 |
| Valuation | 1 |
| Venture Capital/Funding | 1 |
| Forecasting/Budgeting | 1 |
| Spin-outs | 1 |

3.5 Course Organisation

There were various approaches adopted by individuals and groups in answering this sub-question. However, the most common messages reported were that such courses should involve the following characteristics:

| Characteristic | Number of Individuals Specifying |
|---------------------------|----------------------------------|
| Modular -short courses | 9 |
| Case studies | 5 |
| Work based | 3 |
| Delivery by Practitioners | 3 |
| Good Practice sharing | 3 |
| Staff Exchanges | 3 |
| workshops | 3 |
| Internships | 2 |
| distance learning | 2 |
| conferences | 2 |
| University offering | 2 |
| Project-based | 1 |
| Use of experts | 1 |
| Networking | 1 |
| Networking | 1 |
| Industrial visits | 1 |
| by sector | 1 |
| Produce written guides | 1 |
| Organised at EU level | 1 |
| Prof Organisation | 1 |

In addition, one group collectively ranked a number of characteristics as follows:

| Characteristic | Overall Group Rank |
|---|--------------------|
| on the job training for new-comers | 1 |
| exchange programs (international & national) | 1 |
| distance learning courses | |
| joint projects (different organisations in cooperation) | 4 |
| customised sessions (for different type of organisations) | 5 |
| Case studies in particular sessions (supported by an expert mentor) | 6 |
| official certification | 7 |
| certified trainers group | 8 |
| different level sessions | 8 |
| web publications - documentation | 10 |
| European level | 10 |
| Formal training presentations | 12 |
| special experts workshops | 12 |
| Background material (key literature) sent in advance to participants | 14 |
| Short term | 15 |
| active involvement of the participants | 16 |
| internships (short term visits in industry) | 17 |

8. Responsible Partnering Initiative & Skills

Responsible Partnering is an important initiative from four key European stakeholders – EIRMA, EUA, EARTO & ProTon Europe - which has produced a handbook that describes a voluntary programme aimed at improving the organisation, management and overall effectiveness of joint research and strategic knowledge transfer activities involving public research organisations and companies. The Handbook contains guidelines (not rules) intended to help senior managers in the public and private sectors responsible for the creation, transfer and application of knowledge.

The handbook is entitled “Responsible Partnering: Joining forces in a world of open innovation - A guide to better practices for collaborative research between science and industry”.

The handbook contains ten guidelines for action. These guidelines include two related to knowledge transfer skills.

- Provide the right professional skills.

“Effective management of collaborative R&D and knowledge transfer requires high quality professional supporting skills. Responsible Partnership requires commitment to establish these resources and to train people to an appropriate level.”

- Provide relevant training.

“Effective knowledge transfer requires competencies and skills in many fields beyond knowledge and IP management. For example, project management, entrepreneurship and business development skills are also important.”

Further information about the initiative and a copy of the handbook is available at www.responsible-partnering.org.

9. Responses on Existing Courses

The following information and pro-formas (see Appendix 5) were provided following the CREST Workshop by a number of the participants and identify a range of courses available across the EU member states.

E1 Title

Fundamentals of Intellectual Assets Management

E2 Provider (including contact details, website etc)

LES International plus a number of national LES chapters (e.g. LES Britain & Ireland)

E3 Target Audiences

People with less than 3 years experience in technology transfer and commercialisation

E4 Status (Short course, Post-graduate etc)

3 days curriculum based course. Has been taught to numerous students all over the world

E5 Topics Covered / Skills taught

- Basics of IP
- Licensing contracts
- Intellectual Assets Management
- Negotiations
- Valuation

E6 Other Comments

For additional info either contact me Willy MANFROY [manfroy.willy@wanadoo.fr] or Chris Goodman VC of the Education committee of LESI at cgoodman@eric-potter.com or +44 115 955 2211

There is also a SME targeted course on development, which will be Beta tested in France and Austria this fall.

E1 Title

Six courses including Fundamentals of Technology Transfer

E2 Provider (including contact details, website etc)

Praxis

www.praxiscourses.org.uk

E3 Target Audiences

Tech Transfer Professionals

E4 Status (Short course, Post-graduate etc)

Short Courses

E5 Topics Covered / Skills taught

All skills relevant to technology transfer

E6 Other Comments

UK programme of high quality courses, established with funding from Cambridge/MIT partnership

E1 Title

Licensing

E2 Provider (including contact details, website etc)

LES (Licensing Executive Society)

<http://www.lesi.org/about/societies/germany.asp>

E3 Target Audiences

industry entry-level for licensing professionals and more recently technology transfer professionals, experts attend as well

E4 Status (Short course, Post-graduate etc)

workshops mostly 1-2 days

E5 Topics Covered / Skills taught

all aspects of licensing

E6 Other Comments

E1 Title

Beginners Workshop (2 days)

Expert Workshops on a range of topics

E2 Provider (including contact details, website etc)

ProTon Europe

www.protoneurope.org

Mark Schneider mark@protoneurope.org +32 2211 3432

E3 Target Audiences

Beginners, more experienced professionals, experts, and senior managers

E4 Status (Short course, Post-graduate etc)

Short courses

E5 Topics Covered / Skills taught

Range including:

- KT Office Framework/Management
- Working in a KTO
- Supporting the creation of spin-offs
- Understanding IP and policies necessary for exploitation
- Licensing IP

E6 Other Comments

E1 Title

Range of workshops

E2 Provider (including contact details, website etc)

ASTP

www.astp.net/

E3 Target Audiences

TT professionals

E4 Status (Short course, Post-graduate etc)

One day Workshops

E5 Topics Covered / Skills taught

Range of topics

E6 Other Comments

E1 Title

Master of Laws in Intellectual Property

E2 Provider (including contact details, website etc)

Technische Universität München

http://portal.mytum.de/studium/studiengaenge/llmip_master

E3 Target Audiences

E4 Status (Short course, Post-graduate etc)

Post-graduate - Masters

E5 Topics Covered / Skills taught

The classes not only cover all areas of European and International Intellectual Property, Competition, and Media Law, but also include topics from essential related fields such as economics and business administration. For example, valuation and management of IP rights has become a key to commercial success, and yet is largely ignored in IP education; we are determined to close that gap. Our teaching methods heavily emphasize problem and case oriented learning, and training in litigation and negotiation skills forms an integral part of our classes. Students will have numerous opportunities to practice their newly acquired skills in simulated court cases, workshops, internships and exams.

E6 Other Comments

The University of Augsburg awards the degree of Master of Laws in Intellectual Property (LL.M. IP) in recognition of the completion of a one-year program jointly administered by the four MIPLC partners (the Max Planck Institute for Intellectual Property, Competition and Tax Law; the University of Augsburg; the Technische Universität München; and the George Washington University Law School, Washington, D.C.), which starts each in mid-October. All classes are held in English.

E1 Title

Post Graduate Certificate in Knowledge Transfer (in collaboration with The Open University)

Professional Award in Knowledge Transfer (in collaboration with The Open University)

Fundamentals of Knowledge Transfer (3 days)

Range of Knowledge Transfer Workshops (1-2 days)

E2 Provider (including contact details, website etc)

AURIL

www.auril.org.uk

www.auril-cpd.org

Liz Burdess, AURIL National CPD Programmes Manager, +44 191 515 2666

E3 Target Audiences

Full range – from beginners to experienced managers, in UK and across EU

E4 Status (Short course, Post-graduate etc)

Range includes post-graduate, professional/vocational and short courses

E5 Topics Covered / Skills taught

Range of topics and skills

E6 Other Comments

Many of the courses have been developed with the financial support of the UK Government Department for Trade and Industry (DTI) and the Higher Education Funding Council for England (HEFCE).

E1 Title

Master of Intellectual Property and Information Society Law

E2 Provider (including contact details, website etc)

Universidad de Alicante

<http://ml.ua.es/>

E3 Target Audiences

E4 Status (Short course, Post-graduate etc)

E5 Topics Covered / Skills taught

The Magister Lvcentinvs offers a comprehensive nine-month programme, which enables Lvcentini students to undertake a thorough study of Intellectual Property and Information Technology Law subjects

E6 Other Comments

E1 Title

Range of courses (OTRI School)

E2 Provider (including contact details, website etc)

RedOTRI (Spanish Network of University Knowledge Transfer Offices)

www.redotriuniversidades.net

st@redotriuniversidades.net

E3 Target Audiences

E4 Status (Short course, Post-graduate etc)

E5 Topics Covered / Skills taught

E6 Other Comments

E1 Title

CAP – Certificat d'Animateur Propriété Intellectuelle

E2 Provider (including contact details, website etc)

INPI

Christiane Sadrin – csadrin@inpi.fr

E3 Target Audiences

IPR specialists and consultants, KT professionals

E4 Status (Short course, Post-graduate etc)

9 x 2 day weekend schools (18 days, 126 hours)

E5 Topics Covered / Skills taught

Range of IP topics including:

- General IP
- Copyrights
- Patents
- Management of IP strategy
- Research contracts
- Licensing
- Management of IP projects

E6 Other Comments

3,600 € per person

E1 Title

Various courses/workshops

E2 Provider (including contact details, website etc)

CURIE

www.curie.asso.fr

E3 Target Audiences

E4 Status (Short course, Post-graduate etc)

E5 Topics Covered / Skills taught

E6 Other Comments

E1 Title

Short courses

E2 Provider (including contact details, website etc)

NetVal (Network per la Valorizzazione della Ricerca Universitaria)

www.netval.it

segreteria@netval.it

E3 Target Audiences

Beginners

E4 Status (Short course, Post-graduate etc)

Short courses

E5 Topics Covered / Skills taught

E6 Other Comments

E1 Title

Range of Courses

E2 Provider (including contact details, website etc)

Portuguese KT Network

Nuno da Silva nsilva@ipn.pt

E3 Target Audiences

Range

E4 Status (Short course, Post-graduate etc)

Short courses

E5 Topics Covered / Skills taught

Range of courses available/in preparation

- 1. Basic IP
- 2. Advanced IP (e.g. claim drafting)
- 3. IP management at universities
- 4. e-Learning and IP at universities
- 5. Business development
- 6. Negotiation
- 7. Contract drafting

E6 Other Comments

E1 Title

Uni:invent (Patent exploitation for universities)

E2 Provider (including contact details, website etc)

Austria Wirtschaftsservice Gesellschaft mbH

www.uniinvent.at

+43 (1) 501 75 – 557

uniinvent@awsg.at

E3 Target Audiences

Beginners – from universities and industry

E4 Status (Short course, Post-graduate etc)

Post-graduate

Part of a university curriculum

Stand alone course

E5 Topics Covered / Skills taught

Range of topics

E6 Other Comments

- lectures, seminars, work shops
- 10 to 20 participants from all target groups
- Approx 4 weeks course in 3 Modules
- “thesis” (preparation of reasonable theoretical work on a topic related to KT)
- Final exam

Appendix H – Work Stream 2

References and General References

CREST 1st Cycle

CREST report on the application of the open method of coordination in favour of the Barcelona investment objective (ISBN 92-894-8480-2):
http://europa.eu.int/comm/research/era/3pct/pdf/crest-conclusions_en.pdf

Report of the 1st Cycle OMC Expert Group on IPR and Research:
http://europa.eu.int/comm/research/era/3pct/pdf/crest-g4-final_en.pdf

Work Stream 2

Report “Investing in Research and Innovation, Realising the Potential of Public – Private Interaction” summarising the results of the conference, held in Noordwijk, the Netherlands, October 12 and 13 2004

Knowledge Transfer, a Summary Report of the EUA Conference - Dubrovnik, 28-29 September 2001
www.eua.be/eua/jsp/en/upload/DUB-summaryreport.1068735168164.doc

Continuing Professional Development Framework for Knowledge Transfer Practitioners, 2nd Edition, December 2003 produced by AURIL, supported by ProTon.

This document presents a proposed competency framework for the continuing professional development needs of knowledge transfer practitioners engaged in developing and supporting knowledge exchange links, relationships and partnerships between universities, other public research organisations, and industry and other external organisations.

www.auril-cpd.org/links/publicdocs/CPD%20Framework%20Ver%202%20Final%20Dec%202003.pdf

Business Interface Training Provision Review, a report produced for the UK Department of Trade & Industry, March 2002.
www.auril-cpd.org/links/publicdocs/bitsreview.pdf

Protection et Valorisation des Résultats de la Recherche Publique, the brochure distributed in 2003 as part of the Plan for Innovation in France: a campaign to sensitise all levels of researchers
www.recherche.gouv.fr/campagne/brevet/brochure.pdf

Improving Institutions for the Transfer of Technology from Science to Enterprises

ITTE Expert Group Report: Conclusions and recommendations
http://europa.eu.int/comm/enterprise/enterprise_policy/competitiveness/doc/itte_expertgroupreport.pdf

ITTE Typology report

http://europa.eu.int/comm/enterprise/enterprise_policy/competitiveness/doc/tti_typology.pdf

State Aid

Vademecum – Community Rules on State Aid

http://europa.eu.int/comm/competition/state_aid/others/vademecum/vademecumen2003_en.pdf

The Community Framework for State Aid for Research and Development

[http://europa.eu.int/eur-lex/lex/LexUriServ/LexUriServ.do?uri=CELEX:31996Y0217\(01\):EN:HTML](http://europa.eu.int/eur-lex/lex/LexUriServ/LexUriServ.do?uri=CELEX:31996Y0217(01):EN:HTML)

State Aid Action Plan

In June 2005, The EC adopted a State Aid Action Plan outlining the guiding principles for a comprehensive reform of state aid rules and procedures over the next five years. There is particular emphasis on the use of the EC Treaty's state aid rules to complement the Lisbon Agenda and the Barcelona Council objectives.
http://europa.eu.int/comm/competition/state_aid/others/action_plan/saap_en.pdf

Communication from the Commission: Consultation document on State Aid for Innovation

http://europa.eu.int/comm/competition/state_aid/others/action_plan/cdsai_en.pdf
In September 2005, the EC published a consultation document on State Aid for Innovation.

http://europa.eu.int/comm/competition/state_aid/others/action_plan/cdsai_en.pdf

LES

LES International Inc. Annual Report 2004 Working Groups
www.lesi.org/files/annrep2004.pdf

OECD

Intellectual Property Rights (IPR), Innovation and Economic Performance, March 2003.

Changes in IPR, along with developments in industrial innovation and the economy at large, have altered the relationships among IPR, innovation and economic performance. A new OECD study will investigate these changes and provide empirical information to guide ongoing policy debates about IPR. <http://www.oecd.org/dataoecd/12/28/2498379.pdf>

Turning Science Into Business – Patenting and Licensing at Public Research Organisations. This report released in 2003 presents the results of the first international survey on the patenting and licensing activities of public research organisation in OECD countries, which was undertaken in 2002 at the request of the OECD Committee on Scientific and Technological Policy.
www.oecd.org/dataoecd/37/24/30634128.pdf

IPR Management

Expert Group on the Management of IPR report: Management of Intellectual Property in Publicly-Funded Research Organisations: Towards European Guidelines KI-NA-20-915-EN-C
<http://europa.eu.int/comm/research/era/pdf/iprmanagementguidelines-report.pdf>

France:

Research Ministry recommendations on the management of IPR in PROs
<ftp://trf.education.gouv.fr/pub/rechtec/technologie/charte.rtf>

Ireland:

National code of practice for managing IP from publicly-funded research. April 2004

www.forfas.ie/icsti/statements/icsti040407/index.html

National Code of Practice for Managing Intellectual Property from Public-Private Collaborative Research. November 2005

www.sciencecouncil.ie/reports/acsti051125/acsti051125_ip_code_of_practice_webopt.pdf

