



European IP Helpdesk

Stay ahead of the innovation game.

**IP Management in EU-funded projects
– with a special focus on MSCA**

Léa Montesse

16.11.2022





European IP Helpdesk

- Service initiative of the European Commission
- Addressing **current and potential beneficiaries of EU-funded projects, researchers and EU SMEs**
- Free-of-charge first-line support on intellectual property (IP)
- Hands-on IP and innovation management support
- International pool of IP experts from various thematic fields
- Unique cooperation scheme with the Enterprise Europe Network: 44 ambassadors from 27 EU countries



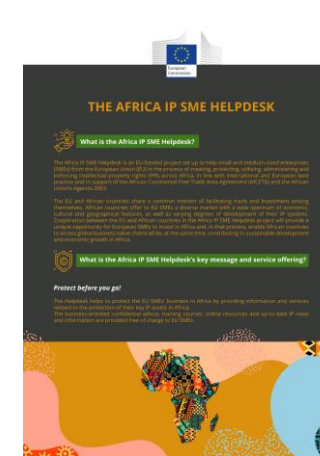
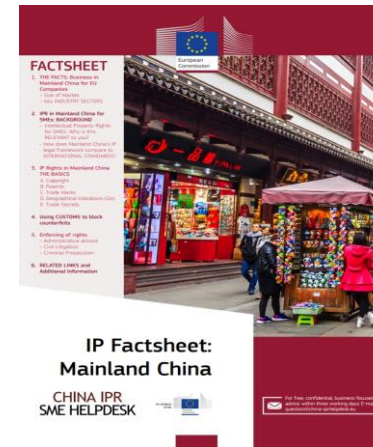
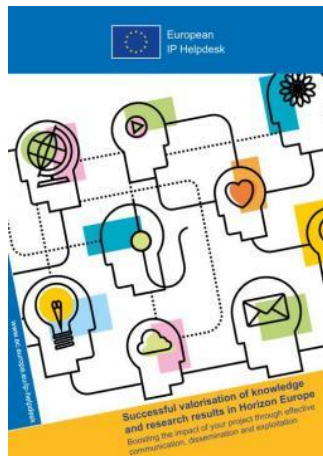


The EC IP Helpdesks





EC IP (SME) Helpdesk Hub – Gateway to Information



- E-learning modules & more
- Guides / Topic, country, sector-specific factsheets / Infographics
- Case studies



Training cooperation with the Community Plant Variety Office and CIOPORA



- 17 FEB 2022** TRAINING AND WORKSHOPS
EU - Webinar & CPVO coop: The essential role of Quality Auditing examination offices for EU Plant Variety Rights
 Live streaming available
- 12 APR 2022** TRAINING AND WORKSHOPS
EU - Webinar CPVO Coop: Constraints and opportunities for edited varieties. Is the GMO legal framework impacting the creation of new plants?
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- 21 JUN 2022** TRAINING AND WORKSHOPS
EU Webinar - CPVO Coop Webinar: Introduction to Community plant variety rights: creation of new plants and their protection in the EU
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- 08 SEP 2022** TRAINING AND WORKSHOPS
EU - Webinar CPVO Coop: The interface between plant variety rights and patents
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EU - Webinar & CIOPORA coop: Growers' Guide to Intellectual Property Protection for Plants
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EU - Webinar CPVO Coop: What's in a name: plant variety denominations and their interface with trademarks and geographical indications
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- 02 NOV 2022** TRAINING AND WORKSHOPS
EU - Webinar CIOPORA coop: Enforcement practices for Plant Variety Rights in the EU
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- 06 DEC 2022** TRAINING AND WORKSHOPS
EU - Webinar CPVO Coop: The impact of protected new plant varieties in the European Union market.
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Patent Protection for EU funding Beneficiaires

19
JAN
2022

TRAINING AND WORKSHOPS

EU - Webinar EPO Coop: Patent protection for EU funding beneficiaries - Medical Technologies

 Live streaming available

16
MAR
2022

TRAINING AND WORKSHOPS


EU - Webinar EPO Coop: Patent protection for EU funding beneficiaries - Artificial Intelligence

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EU - Webinar EPO Coop: Patent protection for EU funding beneficiaries - Green technologies

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TRAINING AND WORKSHOPS


EU - Webinar EPO Coop: Patent protection for EU funding beneficiaries - Digital communication

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EU - Webinar EPO Coop: Patent protection for EU funding beneficiaries - Biotechnology

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Patent protection for EU funding beneficiaries

An IP training series offered by the European Patent Office and the European IP Helpdesk





Ambassador Scheme

- **Cooperation scheme** with the Enterprise Europe Network (EEN): 44 ambassadors – 27 countries
- **Building IP capacities** among European SMEs
- **Overcoming language barriers**
- Making the topic **more accessible**
- Exchange and feedback from ambassadors on **needs of SMEs**
- Local **awareness** and **training events**





Further learning opportunities:

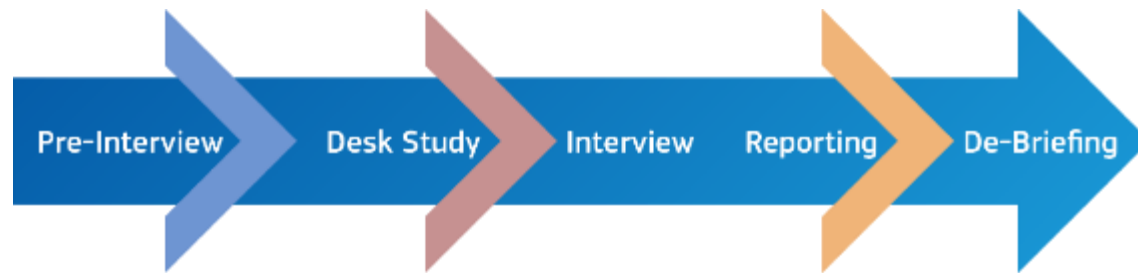
1. [European IP Helpdesk Ambassadors and EEN](#)
2. [EUIPO learning portal](#)
3. [EUIPO – Ideas Powered for business website](#)
4. [WIPO Academy / Diagnostics](#)
5. [The Ideas Powered for business SME Fund](#)
6. [IPA4SME](#)
7. [Horizon IP Scan](#)
8. [\(IP Booster\)](#)
9. [Horizon Results Booster](#)
10. [Leadership4SMEs](#)
11. [EPO Academy](#)
12. [4IPCouncil](#)





Horizon IP Scan

IP Support Service for SMEs in Collaborative EU-funded Research Projects



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www.horizon-ipscan.eu



Thank you!

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- helpline@iprhelpdesk.eu
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Note:

This presentation focuses on MSCA actions carried out under the Horizon 2020 and Horizon Europe frameworks.

References to clauses / articles of the respective Model Grant Agreements are provided when relevant. Generally speaking, the IP rules are very similar in both programmes.





Roadmap

- **Rules and Agreements**
- **Specific Vocabulary**
- **IP management in the MSCA project life cycle**
- **MSCA examples & FAQs**





Rules & Agreements





Intellectual Property rules in H2020 MSCA

The IP rules in H2020 MSCA can be found in:

- (i) the **H2020 Rules for Participation** (legal basis)
- (ii) the (model) **Grant Agreement** (IF, ITN, RISE, COFUND) + additional guidance: [annotated MGA](#)
- (iii) the applicable **work programme**
- (iv) **H2020 Online Manual**



How to find them: **EC Funding & Tenders Portal** [here](#)



Intellectual Property rules in HE MSCA

The IP rules in HE MSCA can be found in:

- (i) the **HE Rules for Participation** (legal basis)
- (ii) the (model) **Grant Agreement for UNIT GRANTS** and **its Annex 5** (PF, DN, SE, COFUND) + additional guidance: [annotated MGA](#)
- (iii) the applicable **work programme**
- (iv) the **Online Manual**



How to find them: **EC Funding & Tenders Portal** [here](#)



Agreements in MSCA

- (i) **Grant agreement** (signed between the EC/REA and the beneficiaries) – cannot be contradicted by other subsequent agreements.
- (ii) **Consortium agreement** (signed amongst the beneficiaries) – general, “non-official” models to be adapted: [LERU](#) and [BAK](#) models for H2020 MSCA, [DESCA 2020](#), [EUCAR 2020](#), [MCARD](#) for general H2020. **New!** [DESCA for Horizon Europe](#)
- (iii) **Partnership agreement** (signed with partner organisations) – no “official” model but [a model created by KoWi](#) for H2020 MSCA, and the [IARU model](#)
- (iv) **Researcher’s agreement**
- (v) If needed: **confidentiality agreement** / [NDAs](#).





Specific Vocabulary





Vocabulary

Key terms in the context of Horizon projects are:

- Background
- Results
- Exploitation
- Dissemination
- Access rights





Definitions (I)

Background

Tangible or intangible input (data, knowhow, information) which is held by the project beneficiaries prior to their accession to the GA and that is needed to implement the action or exploit its results. Includes IP such as copyright, patents/ patent applications (filed prior to access to GA).

Rule: taking part in Horizon projects does not have any influence upon the ownership of background = your background remains yours!

Results

All the outputs generated during the project – whether or not protectable by IPR. Such results may include copyright, design or patent rights, trademarks or others, and **belong to the beneficiary that generated them.**





Definitions (II)

Access rights

User rights (incl. licences) to results or background of project beneficiaries.



Exploitation

Use (direct/indirect) of results in research activities, which are not part of the project, as well as use (direct/indirect) for further development, creation and marketing of a product or process.

Dissemination

Means through which research results are disclosed to the scientific community and more generally to the public: website, conferences, research papers... Official publications (e.g. patent applications) are not considered as dissemination.





IP Management in the MSCA Project Life Cycle



Expectations on IP management

Expectations on sound IP management in H2020/HE differ depending on:

- Specific Programme
- Applicability of results/Technology Readiness Level (TRL)
- Participation of SMEs/Industry
- Financing Instrument (i.e. Innovation actions)
- Size of consortium/International partners
- Stage of proposal/maturity of project implementation
- Many others: **Check the work programme/topic description carefully!!!**



Before Project Start

Every project starts with an idea ...

- Define **the state of the art**: was this already done?
 - ✓ Search in **patent databases & documents**
- Protect **your background** (e.g. technical drawings...)
- Protect **all information linked to the idea**: make use of NDAs / [Confidentiality Agreements](#) when contacting potential partners.
 - ✓ *Project ideas are as such not protectable by IPR! So it is very important to keep them confidential as this is the only way of avoiding third parties “stealing” them!*
- Beware of **infringing third parties’ IPR** (check acronyms against registered Trade Marks)



Contact your legal department as early as possible!



Before Project Start

Exploitation and dissemination planning starts in the proposal

IP & exploitation issues are subject to evaluation regarding **impact and implementation**:

- **Draft PEDR / D&E Plan**: draw a convincing outline of **exploitation strategies** at individual/consortium level. **In HE MSCA: outline required in the proposal, and a full-fledged D&E plan will be required within 6 months into the project.**
- Identifying **relevant bodies and competences** within the consortium should demonstrate the potential of addressing IP management properly
- Include relevant **activities/deliverables**: PEDR / D&E Plan, Market Analysis, Business Plans, Risk-Analysis, Freedom-to-Operate analysis, specific contracts/agreements...



MSCA fellows: do not draft this part alone. Contact your legal department as early as possible!



Exploitation and Dissemination Plan

Beneficiaries have an obligation to **define the expected results** and their **strategy for exploitation and dissemination** (draft PEDR / D&E Plan in the proposal, then proper deliverable to be updated regularly).

Hence the following information must be included:

- A list of expected results that might be exploited (i.e. with commercial or industrial applicability) including their:
 - description
 - ownership status
 - sector of application and exploitation route intended, and
 - protection measures
- A list of all the means through which they intend to bring the results to the public knowledge (dissemination)
- A potential/expected impact – quantifiable – in terms of marketability and research advancement. *In MSCA, proposers should also show the expected impact on the researcher's career!*
 - See our brochures on [Making the Most of your H2020 project](#) and [Successful Valorisation of knowledge and research results in Horizon Europe](#)



During implementation

Secure and manage research results:

- **Have a clear strategy for securing and managing newly generated knowledge: who owns what, which protection steps are taken... (do not wait until the end of the project!)**
- *For example: appoint an IP manager, keep lab notes / work logs, schedule regular checks on ownership claims, prepare draft ROL, schedule regular checks on protection steps...*
- **Continuously update the PEDR / D&E Plan**
- **Monitor regularly relevant external factors** affecting your exploitation potential (other projects, publications, patents, markets, competing technologies, standards, norms, etc.)





Ownership of results: clarify early

- Internally, keep track of the work done: it is advisable to take appropriate measures to properly **monitor the creation of results and manage ownership issues**, such as keeping laboratory books or other kinds of documentary evidence (e.g. a properly completed Invention Disclosure Form).
 - ✓ *Also keep tabs on ownership claims: you may think you own a result, others may disagree!*
- **In MSCA, the grant agreement generally establishes that the results of the project belong to the beneficiary generating them** (meaning! not to the fellow, not to the partner organisations!). But this is a default rule: beneficiaries can reach different arrangements. In particular:
 - **Common case in MSCA: frequent (co-)ownership requests from partner organisations / associated partners (e.g. US universities) as condition for their participation. These claims may be legitimate** (eg. if they contributed to the fellow's work) = need to negotiate compatible solutions (e.g. transfer, joint ownership...) beforehand, in the partnership agreement.
 - **If the partner organisation is entitled to claims to the entire results** (eg. if they created the whole result): the beneficiary must at least secure minimum rights to comply with its GA obligations (transfer or licence).
- Given the collaborative nature of most projects, some results can be jointly developed by several participants. Hence, situations of **joint ownership** might arise.
 - **Joint Ownership Agreements** (i.e. defining specific conditions for granting licences or issues related to costs of protection and sharing of potential revenues) should then be concluded. A default joint ownership regime can also be set up in the Consortium Agreement.

In H2020:
MSCA MGA art. 26

In HE:
UNIT MGA Annex 5
for article 16



Access Rights

Grant of Access Rights amongst beneficiaries

	Access to background	Access to results
Project implementation	Royalty-free <i>Unless agreed otherwise before GA is signed</i>	Royalty-free
Exploitation of results	Royalty-free, or on fair and reasonable conditions	Royalty-free, or on fair and reasonable conditions

Grant of Access Rights to the MSCA fellow/researcher

	Access to background	Access to results
If needed by the researchers for their activities	Royalty-free	Royalty-free

In H2020:
MSCA MGA art. 25
& 31

In HE:
UNIT MGA Annex 5
for articles 16 & 18



General obligation to protect

Each participant **must adequately protect its results** — for an appropriate period and with appropriate territorial coverage — if:

- (a) the results can reasonably be expected to be commercially or industrially exploited and
- (b) protecting them is possible, reasonable and justified (given the circumstances).

When deciding on protection, the beneficiary must consider its own interests and the legitimate interests (especially commercial) of the other beneficiaries.

Protection can be secured by IPR or other means (e.g. trade secret protection).

In H2020:
MSCA MGA art. 27

In HE:
UNIT MGA Annex 5
for article 16



Protection of results

IPR	What for?	Registration?
Patent	New inventions	Registration is required
Utility model	New inventions	Registration is required, but conditions are less stringent than for patentability
Trade Marks	Distinctive signs	Registration is required
Industrial Design	Appearance of products	Registration is usually required, but it is possible to acquire an unregistered design right
Copyright	Literary, artistic and scientific works incl. software and original databases	Not required, but it can be registered in some countries
Confidentiality	Confidential business information/trade secrets	Not required, but internal protection measures needed (i.e. NDAs)

Always use IPR symbols, such as © for copyright, ™ and ® for trademarks, or any other equivalent indicating that it is protected by one or more different IPR



General obligation to exploit

Each participant receiving EU funding must — **up to four years** after the project completion take measures aiming to ensure 'exploitation' of its results by:

- (a) using them in further research activities (outside the action);
- (b) developing, creating or marketing a product or process;
- (c) creating and providing a service, or
- (d) using them in standardisation activities.

✓ *Exploitation can be direct or indirect, commercial or non-commercial > discretionary*

Strategic plans for the exploitation of results must be based on the PEDR / D&E Plan and should include the following elements: purpose of the results, how will they be exploited, where, by whom, IPR exploitable measures taken or intended, further R&D required, potential / expected impact.

In H2020:
MSCA MGA art. 28

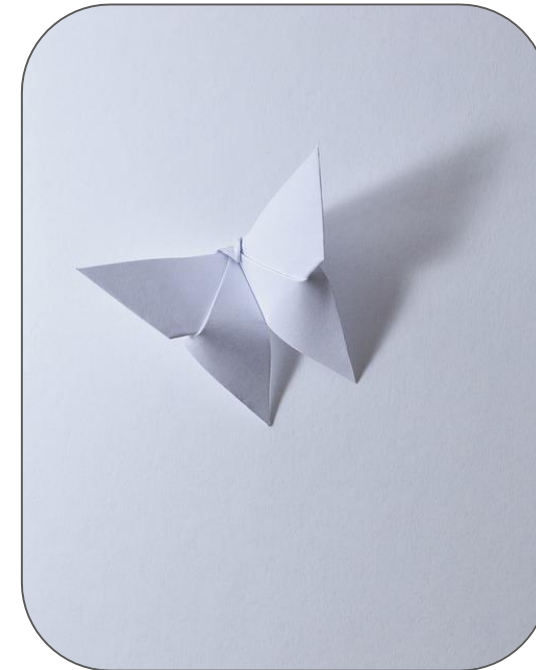
In HE:
UNIT MGA Annex 5
for article 16



Routes for exploitation

Basic options

- Use for further research (*attention! if the MSCA fellow wants to use the results in his/her own further research, no automatic right: need to negotiate assignment/licence with the institution*)
- Developing and selling own products/services
- Spin-Off activities
- Cooperation agreement/Joint Ventures
- Transferring the IP (*mind transfer rules and possible restrictions!*)
- Licensing IP rights (out-licensing) (*mind restrictions to exclusive licensing*)
- Standardisation activities



Check it out: **Horizon Results Platform**– browse results, look for investors, look for business partners, transfer your results IP and more! *The use of the HRP is compulsory in HE if no exploitation activity is achieved within 1 year of the action's end.*

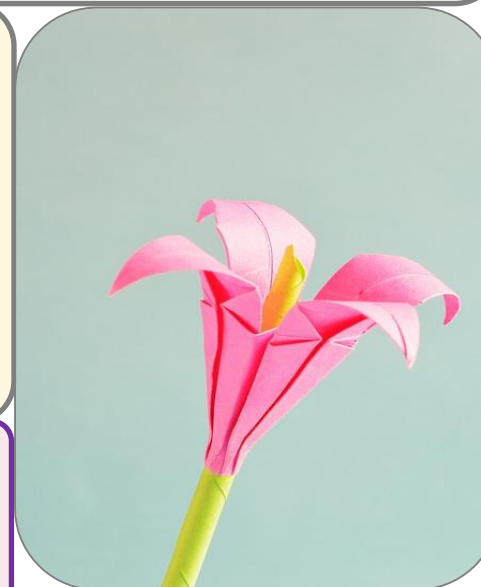


Obligation to disseminate

Project partners are obliged to disseminate the results swiftly (i.e. to scientific community/broader public) by any appropriate means other than that resulting from the formalities for protecting it or exploiting the results, and including the publication of results in any medium.

But:

- *no dissemination of results may take place before decision is made regarding their possible protection, and*
- *All publications or any other type of dissemination (also in electronic form) shall include a statement that the action received financial support from the Union – the same applies to results incorporated in standardisation activities.*



**For scientific publications: Open Access requirement. For data: Open Data.
In HE according to call: possible additional Open Science obligations.**

Questions on OA/OD/OS? www.openaire.eu



Dissemination checklist

- Take a decision about the **protection** of results and take all required steps
- **Inform the other consortium partners** in writing 45 days (H2020) / 15 days (HE) before the planned dissemination activities and include enough information to allow them to analyse whether their interests are affected or not. Note that this time limit can be changed (for more or fewer days) in the CA. Wait 30/15 days for any objection to the dissemination (unless otherwise agreed in the CA).
- Beware not to infringe third parties' intellectual property rights
- **Open access** as a general principle of scientific dissemination. **New in HE: compulsory use of the CC BY licence! More information [here](#).**
- List the dissemination activities in the **PEDR / D&E Plan**.

In H2020:
MSCA MGA art. 29

In HE:
UNIT MGA Annex 5
for article 17



Costs Reimbursement

- Costs of intellectual property rights (IPR), including the costs of protecting results (e.g. fees paid to the patent office for patent registration, attorney fees) and royalties on access rights are **eligible costs**.
- Cost for open access publications are also considered eligible by the GA, e.g. Author Processing Charges (APCs)
- For more information on costs eligible for reimbursement in Horizon projects: contact your Legal & Financial [National Contact Point!](#)



MSCA examples & FAQs





I am a researcher participating in MSCA. I know that the beneficiary I work for is obliged to protect the results of my project. However, my results will not fulfill the patentability criteria. What shall I do?

In terms of protection, indeed, Horizon 2020 poses a general obligation to protect the project results - please see article 42 of the Horizon 2020 Rules for Participation and article 27 of the Model Grant Agreement.

- This obligation **does not apply to all results** - it will only apply insofar as the results that are capable of (or can be reasonably expected to be capable of) commercial or industrial application and their protection is 'possible, reasonable and justified'. Therefore, in many cases there will be no obligation to protect and the dissemination activities will suffice. Hence, no protection is necessary if protection is impossible under Union or national law or not justified.
- Horizon 2020 rules leave it up to the project participants to **set up their own protection strategies**. The choice of the most suitable form of protection should be made on the basis of the specificities of the action and the type of result - for instance, you may resort to confidentiality measures instead of filing for a specific intellectual property title (patent, utility model, industrial design etc.). **The obligation to protect is not necessarily an obligation to patent.**
- Project related publications and presentations also constitute project results. If original, these works will be protected by **copyright**. Copyright arises automatically upon the creation of the work: you will not need to register it or pay any fees. This means that once an original work is created, the copyright holder can prevent others from, for instance, copying or distributing these works without its consent. Please note that copyright will not protect the information or ideas contained in your publication but only the way in which they are expressed.

-- same answer for protection obligations in HE



Should the partner organisation in a MSCA project also sign the Consortium Agreement?

- The consortium agreement is an agreement between members of the consortium, to set out their internal arrangements regarding the implementation of the grant. It is purely internal. Partner organisations are not signatories to the grant agreement and have neither rights nor obligations under it. They do not form part of the consortium, and hence, should in principle NOT sign the consortium agreement.
- Partner organisations will, of course, have an interest in some/all project results (e.g. those developed by researchers while on secondment at their premises). Those issues will usually be dealt with in a separate arrangement - **partnership agreement**. Partners do not have a general interest in all results, nor should they be involved in consortium decisions regarding exploitation or dissemination strategies: they are, after all, only third parties to the project.
- Some coordinators sometimes prefer to have all parties (beneficiaries and partner organisations) sign the CA together in order to have one global contract. If you go this way: draft each clause very carefully! Distinguish whether each clause applies to beneficiaries, to POs, or to all parties.

-- same answer for Associated Partners in HE



Our fellow is going to spend his secondment period at another partner organisation's premises. Will this partner organisation have any IPR over the results developed during the secondment?

- In MSCA, the rules surrounding the ownership of project results are the same as those applicable in other Horizon 2020 actions: **project results are owned by the beneficiary generating them.**
- This means that even the **results generated by your fellow while on secondment** would belong to your institution, in accordance with the default rules applicable in the Grant Agreement. In other words, your **partner organisation will not automatically be entitled to any IPR over the results** developed on secondment, since it is not a beneficiary in the project, but a third party which does not employ the researcher within the action but only provides additional training and hosts him during the secondment.
- However, this default rule is **not always compatible with a third party institution's internal policy**. It is indeed not uncommon for partner organisations to require that the ownership of the results developed on secondment be granted to them, because this is what their IP policy requires. For this reason, and to avoid any dead-end, your institution should **adopt a flexible approach**. Since your partner organisation might not be aware of your own obligations under the Grant Agreement, you should clarify this point beforehand and outline your rights and obligations in terms of ownership, access rights, protection, exploitation and dissemination. This will allow your partner to understand the framework in which you can negotiate, and the rules and limitations which you have to comply with on your side. Then, remember that it is ok to agree on **joint ownership of the results** if your fellow has developed them jointly **with a contribution from the host institution (infrastructure, tutoring...)**. In other cases, remember that the Grant Agreement allows you to **license or to transfer project results to third parties**, under certain conditions. This means that, providing that these conditions are met, you can agree to license or transfer to your partner institution the project results developed by your fellow while on secondment. The terms of such agreement will vary depending on both parties' interests, but this will allow you to settle on a different ownership regime which will be beneficial to you and your partner alike.

-- same answer for ownership issues with
Associated Partners in HE



Common questions received

- Questions sent by **beneficiaries** of MSCA actions:
 - Who owns the results generated during the secondment period?
 - Can we reach an agreement transferring some of our results to our partner organisation if this partner is located outside the EU? **Clause 30.3 H2020 GA // Possible restrictions to international transfers if the HE call says so!**
 - Which IP clauses should we include in our consortium agreement? Is there a model consortium agreement applicable to MSCA?
- Questions sent by **partner organisations**:
 - We have been contacted to become involved in an MSCA action as a partner organisation (non-beneficiary). Will we have any rights over the results?
- Questions sent by **individual researchers**
 - I am preparing a proposal to be submitted under a Horizon MSCA call. Which issues should my proposal address in the section dedicated to IP management?
 - Which rights will I get over the results I generate during the action? Can I ask to retain access rights to results after the end of the project?



Any Questions?





Contact:

- Website: ec.europa.eu/ip-helpdesk
- training@iprhelpdesk.eu
- helpline@iprhelpdesk.eu
- Twitter [@iprhelpdesk](https://twitter.com/iprhelpdesk)
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Thank You!

DISCLAIMER

The European IP Helpdesk provides free-of-charge first-line support on IP-related issues aiming to help current and potential beneficiaries of EU-funded projects, as well as EU SMEs, manage their Intellectual Property assets.

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