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**CONSORTIUM AGREEMENT AND INTELLECTUAL
PROPERTY RIGHTS WITHIN THE EUROPEAN UNION
RESEARCH AND INNOVATION PROGRAMME**

Paolo Guarda

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CONSORTIUM AGREEMENT AND INTELLECTUAL PROPERTY RIGHTS WITHIN THE EUROPEAN UNION RESEARCH AND INNOVATION PROGRAMME

ABSTRACT

This paper aims to analyse the main sections of the Consortium Agreement (CA) dedicated to the discipline of rules on Intellectual Property Rights (IPRs) within the European Union Research and Innovation Programme. The purpose of the study is to create a shared knowledge based on key aspects of the CA in European research projects. It should also be able to provide guidance to managers and operators of the University Technology Transfer Offices (TTOs), that are, in fact, involved, at different levels, in providing general advisory activities in relation to researchers and in developing best practices. Finally, the key role that contract is assuming in a changing social and legal context will be highlighted.

KEYWORDS

Confidentiality – EU Law - Intellectual property – Research and development

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CONSORTIUM AGREEMENT AND INTELLECTUAL PROPERTY RIGHTS WITHIN THE EUROPEAN UNION RESEARCH AND INNOVATION PROGRAMME

SUMMARY: 1. Premise: European Union context and research and innovation programme - 2. Main features, definition and available models of Consortium Agreement - 3. Discipline of intellectual property rights within the Consortium Agreement – 3.1. Background – 3.2. Research results and ownership regime – 3.3. Protection of results – 3.4. Exploitation, transfer and licensing of results – 3.5. The dissemination – 3.6. Access rights – 3.7. Special provisions concerning software – 3.8. Confidentiality – 4. Final remarks

1. Premise: European Union context and research and innovation programme

The Framework Programme for Research and Technological Development (now in its eighth edition) is the main instrument for European research funding through which the European Commission (EC) aims to achieve several goals, such as strengthening the scientific and technological bases of industry, enhancing competitiveness and promoting international research activities in the European Union (EU), as enshrined in art. 163 contained in Title XVIII “Research and Technological Development” of the European Treaty – “Consolidated versions of the Treaty on European Union and the Treaty establishing the European Community” (2002/C 325/01).

Horizon 2020 represents the biggest EU research and innovation programme ever with nearly €80 billion of funding available over 7 years (2014 to 2020)¹. It is a multi-year programme designed to support and strengthen scientific and technological research in Europe through co-financing of

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¹ See the Web site: <<http://ec.europa.eu/programmes/horizon2020/>>. For further analysis, see M. GRANIERI, A. RENDA, *Innovation Law and Policy in the European Union. Towards Horizon 2020*, Milano, Springer, 2012.

European Union (EU) research projects. The Framework Programme involves the most important scientific and technological fields of basic and applied research.

Within the funding programmes, where there is more than one beneficiary, it is necessary to regulate the relations between them in such a way as to ensure, in the proper and most effective way possible, the execution of the obligations, arising from the commitment given by the Commission to financing, which have their expression in the “Grant Agreement” (GA). The “Consortium Agreement” (CA) responds to this requirement²: namely it is the agreement signed between the participants in the project in order to establish the respective rights and obligations. This legal instrument (art. 24 of Regulation (EC) no. 1290/2013 of the European Parliament and of the Council of 11 December 2013 laying down the rules for the participation and dissemination in “Horizon 2020 – the Framework Programme for Research and Innovation (2014-2020)” and repealing Regulation (EC) n. 1906/2006 (henceforth: RfP)) governs relations among the members of the consortium.

The CA acts as an essential tool, widely supported and encouraged by the Commission, although the latter does not take part in it³. Once again, the contract assumes a key role in a changing social and legal context. It emerges as supra-national, which tends to bring the application of legal rules in ways and paths not always within a well-balanced IPR-oriented approach. The contract is increasingly representing “a source of law” to which the interpreter must refer in order to analyse and understand the legal framework of reference. Since we are experiencing a decrease in the importance of the laws enacted by the State as an instrument that can regulate new phenomena, the negotiating tool is strengthening its function and is acquiring a crucial position: in many cases, the contract is entrusted with the task of determining the rules applicable in practice. The globalisation of economy promotes the assignment of this important role⁴. The sets of certain interests find their effective

² Regarding the former FP7 regime, see K. BARKER, H. CAMERON, *European Union science and technology policy, RJV collaboration and competition policy*, in Y. CALOGHIROU, N.S. VONORTAS, S IOANNIDES (eds.), *European Collaboration in Research and Development: Business Strategy and Public Policy*, Edward Elgar Pub, 2004, 154, 175-184; R. CIPPITANI, *Il Consortium Agreement*, in R. CIPPITANI, L. FULCI (eds.), *I programmi comunitari per la ricerca e l'innovazione*, Perugia, 2007, 247-280; M. BORMIDA, *Il Consortium Agreement nell'ambito dei progetti europei di ricerca e sviluppo*, in *Diritto d'Autore e Nuove Tecnologie*, 2005, fasc. 2, 135-144.

³ The Commission has the ability to produce guides for drawing it. See, for instance, the Web page dedicated to Horizon 2020 and FP7: <http://ec.europa.eu/research/participants/portal/desktop/en/funding/reference_docs.html#h2020>; and the European IPR Helpdesk: <<http://www.iprhelpdesk.eu/>>.

⁴ For further analysis on European contract law, see in general R. SCHULZE, J. STUYCK (eds.), *Towards a European contract law*, Sellier European law publishers, 2011; C. VON BAR, E. CLIVE (eds.), *Principles, definitions and model rules of European private law: draft common frame of reference (DCFR), prepared by the Study Group on a European Civil Code and the Research Group on EC Private Law (Acquis Group)*, Sellier European law publishers, c2009; H. BEALE, H. KÖTZ, A. HARTKAMP, D. TALLON (eds.), *Cases, Materials and Texts on Contract Law*, Hart Publishing, 2010. With reference to the Italian legal system see, among others, F. GALGANO, *Il contratto*, II ed., Cedam, 2011; V. ROPPO, *Il contratto*, in *Trattato di diritto privato* (edited by G. IUDICA, P.

discipline on the basis of a negotiation among the holders of those interests. The relationships that are born in the network are governed under the agreement that parties conclude when they enter into the relationship⁵.

This paper aims to analyse the main sections of the CA dedicated to the discipline of rules on Intellectual Property Rights (IPRs). The purpose of this study is to create a shared knowledge based on key aspects of the CA in European research projects. It should also be able to provide guidance to managers and operators of the University Technology Transfer Offices (TTOs)⁶: these are, in fact, involved, at different levels, both in providing general advisory activities in relation to researchers, but also in the development of best practices to be transferred directly to the latter.

Following this introduction, the second paragraph will provide the definition of the CA models available describing their main features; the third paragraph will be devoted to analysing the key issues with regard to IPRs regulated under the CA; finally, the concluding part of the essay will draw some general considerations.

2. Main features, definition and available models of Consortium Agreement

The Consortium Agreement (CA) is defined as a multilateral agreement, with a common goal, namely the realisation of the object of the research project. It is an agreement connected to the one that partners conclude with the funding body, the EC Grant Agreement (GA)⁷: from this perspective, the CA has the aim of integrating and better specifying the obligations already entered and governed in the main agreement. It must be in writing.

It finds its discipline in the legal basis of the reference programme and other relevant Community rules. It is also necessary to establish a national law in order to integrate the European rules, if they fail to settle a given case. One possible solution is to indicate as applicable national law the one provided for

ZATTI), II ed, Giuffrè, Milano, 2011. Finally, with specific reference to the digital age law, see G. PASCUZZI, *Il diritto dell'era digitale*, Zanichelli, Bologna, 2010, 297-298.

⁵ With reference to the role of the contract intended to replace the rigidity of IP systems, at least with respect to the digital context, see M. GRANIERI, *Proprietà, contratto e status nell'industria dell'informazione. Per una visione criticamente relazionale dell'economia digitale*, in *Mercato Concorrenza e Regole*, 2006, 111. See also P. ZUMBASEN, *The Ubiquitous Return to Contract*, 14 *Ind. J. Global Legal Stud.* 181 (2007); R.P. MERGES, *Contracting Into Liability Rules: Intellectual Property Rights and Collective Rights Organizations*, 84 *Calif. L. Rev.* 1293 (1996); R.D. COOTER, *Decentralized Law for a Complex Economy: The Structural Approach to Adjudicating the New Law Merchant*, 144 *U. Pa. L. Rev.* 1643 (1996); M. GRANIERI, *Soluzioni contrattuali agli anticommons (pooling, collecting, standards). Esperienze europee e statunitensi a confronto*, in *AIDA*, 2013, 277.

⁶ Also known as “Industrial Liaison Office”, “Tech Transfer”, or “TechXfer”.

⁷ Grant Agreement models are available at the “Participant Portal” Web site: <http://ec.europa.eu/research/participants/portal/desktop/en/funding/reference_docs.html#h2020-mga-gga>.

in the GA (that means the Belgian or Luxembourg one)⁸. The applicable discipline is due to a complex relationship between rules coming from different legal contexts. In particular, with reference to issues relating to IPRs, the European rules will be enforced, as well as those arising from the private autonomy as expressed within the CA clauses. The elected national law will be used, however, for the interpretation and regulation of the agreement itself (on the possible resolution of any disputes).

In some respects, the CA can also be considered the translation of legal commitments that the parties assume among themselves with regard, from our perspective, to the exploitation of the products that will result from scientific research; therefore, it should be an expression of the balancing between the interests of all parties to strive for the right compromise between different realities and positions, sometimes even conflicting: universities, private companies, research centres, small-medium enterprises (SMEs), etc. From here arises the requirement that at least the fundamental aspects of this tool, connected to all the activities of the project, are designed and established from the very beginning, before the signature of the GA, and, if possible, at the proposal stage of the same project. Unfortunately, these issues are not often properly weighted. In the CA, however, the parties identify their interests with respect to the research that they are going to put in place. The law in this area serves to balance the interests, sometimes conflicting, of the partners; when a member of the consortium does not advocate its own ones, someone, more aware, could insert their own needs into the agreement, enhancing and making them prominent throughout the consortium. You should, indeed, be aware of the reasons of the involvement in such a contractual arrangement and of what you can do as part of it.

The CA has generally fixed content. We take as a paradigmatic model the CA rules with respect to the Horizon 2020 programme. Pursuant to the provisions of art. 24 RfP, it covers the: a) internal organization of the consortium (*rectius*, the governance of the project); b) distribution of the Union funding (then the tax and financial aspects related to the management of the project); c) rules on dissemination, use and access rights (the IPRs issues); d) arrangements for settling international disputes; liability, indemnification and confidentiality arrangements between the participants.

In more detail, the CA is normally divided into several sections: identification of the parts; a preamble; a section dedicated to the definitions; the object of the agreement; the technical provisions; rules related to financial

⁸ The question of applicable law is certainly a crucial one. The CA is a contract of a highly international nature. Although it therefore derives its discipline from a European Regulation, actually it will be adapted and implemented, if necessary, through reference to national private law in order to assess and accurately determine the applicable rules. With reference to the intersections between IPRs and international law see, at first glance, T. KONO, *Intellectual Property and Private International Law*, Hart Publishing Limited, Oxford, 2012; J.J. FAWCETT, P. TORREMANS, *Intellectual Property and International Private Law*, Clarendon Press Oxford, Oxford, 1998, in part. 455 ff.

management; rules related to the IPRs, dissemination and use of research products; a final section containing the general provisions.

Specific attention has to be given to the rules governing ownership regimes⁹, and to the exploitation of research results through contractual means (assignments and licenses). The regulatory framework in this field, which is often opaque due to the different regulations that characterize the several forms of IPRs, is made even more complex by providing different legal regimes according to the *status* of the person who has produced the research (professors, lecturers, fellows, graduate students, etc.)¹⁰. This is a crucial point with respect to the management of this issue at the university. That, indeed, happens with respect to many calls for projects set at a national and international level. As a paradigmatic example we could cite art. 41 RfP that expressly provides that the results [of the project] shall be owned by the participant generating them and that the latter is committed to ensuring that any right on the part of others (e.g. its employees) are compatible with the obligations arising from CA and GA signed with the financial institution (*rectius*, the Commission). In order to be compliant with this former disposition, contractual arrangements are (should be) created for providing for (preventive) assignment of rights¹¹. There are a whole series of tensions with

⁹ When we deal with the issue of products enhancing scientific research, it is necessary to feed back what is the source of the funding and which rules may be established in this regard. One of the main issues usually referred by these basic rules is the discipline of the applicable regime of ownership. The attribution of ownership on the part of the lender certainly reduces the possible transaction costs related to the exploitation phase; at the operational level, however, problems may arise: a regulation providing for the ownership in the hands of the lender, for example, would create difficulties with regard to the activity of a researcher perhaps being carried out at a research centre abroad, where, usually, she will be asked to sign an agreement of co-ownership of the results.

¹⁰ For further details, see A.L. MONOTI, *Is it Time to Codify Principles for Ownership of Academic Employee Inventions? The Disconnect Between Policy and the Law*, (2012) 38(1) Monash University Law Review 102, Monash University Faculty of Law Legal Studies Research Paper No. 2012/02, available at SSRN: <<http://ssrn.com/abstract=2216373>>; J. PILA, *Who Owns the Intellectual Property Rights in Academic Work?*, 2010 *European Intellectual Property Review* 609, also available at: <http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1618172>; A. MONOTI, S. RICKETSON, *Universities and Intellectual Property. Ownership and Exploitation*, OUP, Oxford, 2003. Regarding the importance of initial allocations of property rights (since whoever starts out holding the rights helps determine the right), see C. LONG, *Proprietary rights and why initial allocations matter*, 49 *Emory L.J.* 823 (2000). Although dedicated to software, see as expressed in general on this issue P. GUARDA, *Creation of Software Within the Academic Context: Knowledge Transfer, Intellectual Property Rights and Licences*, in *IIC – International Review of Intellectual Property and Competition Law*, 2013, vol. 44, 494-523.

¹¹ These types of contracts are not necessarily to be understood in a negative sense by the person to whom the transfer is sought. From a certain point of view, you can record that at least there is the recognition of the moral rights of the author/inventor - sometimes “forgotten” in the activity engaged in by many young researchers in a wide variety of projects. The prime mover of the university is prestige. See R.K. MERTON, *The normative structure of science*, Chicago, 1942; ID., *Science and Technology in a Democratic Order*, in *Journal of Legal and Political Sociology*, 1942, vol. 1, 115; see also M. POLANYI, *The Republic of Science: Its Political and Economic Theory*, in *Minerva*, 1962, vol. 1, 54.

regard to this aspect that must be managed as part of an increase in litigation between the parties involved.

This is not the place to address the interesting, although very complex, problem of managing these issues: it is, anyway, worth simply recording how, unfortunately, there is not often the correct sensitivity in understanding the need for managing appropriately and timely (or rather, before the research begins) these relations with the employees, with reference to the rules of intellectual property and, therefore, especially within the academic scenario.

There is not a model agreement directly proposed by the European Commission. The choice is certainly acceptable. To do otherwise would inevitably result in the conditioning of the choices of the individual in a context where freedom should characterize the definition of contractual settlements. However there are models that have established themselves in practice and which have been prepared by groups of institutions and/or companies: therefore, various contract models made their appearance,

First of all, we should mention DESCA – Development of a Simplified Consortium Agreement. A profiled version of Horizon 2020 has been quite soon published¹². It is the result of collaboration between different organizations, especially research ones. This agreement aims at balancing the interests of different types of beneficiaries (universities, industries, research centres, etc.). It avoids complex structures (content and language) and favours modular composition: it often offers more options and needs to be adapted to the specific project. The DESCA CA is definitely better aligned with the interests and needs of public research institutions, in order to protect and properly manage the products of research.

Then we have the MCARD2020 - Model Consortium Agreement for Research, Development and Innovation -. It is similar to the Integrated Project Consortium Agreement (IPCA) developed by DIGITALEUROPE for Horizon 2020's predecessor, FP7.¹³ This CA is on large collaborative projects in the field of communication and information technologies, but consortia in any scientific field are free to adapt and use it. It consists of two parts: a first part devoted to the list of parties involved in the project and some advances on project management requirements; a second part dedicated to the clauses that define the roles and tasks of participants, the regime of IPRs, the responsibilities and exit conditions from the project and the exploitation of the results. It has been designed to meet the particular needs of the industrial partners. This CA definitely supports the commercial exploitation of results. There are also a number of other models based on specific sectors and/or projects¹⁴.

¹² See the Web site: <<http://www.desca-2020.eu/about-desca/>>.

¹³ See the Web site: <<http://www.digitaleurope.org/Services/H2020ModelConsortiumAgreement.aspx>>.

¹⁴ See, among others, the “EUCAR Model for Projects Consortium Agreement Horizon 2020”, elaborated by the EUCAR - European Council for Automotive R&D

In general, you can definitely affirm that there is no “good or bad” model. There is, however, one application scenario that must be properly understood with reference to what you wish to do with your research results and regarding the role that realistically the partner plays within the consortium. The reference scenario makes the specific agreement more or less tailored to your needs¹⁵.

3. Discipline of intellectual property rights within the Consortium Agreement

When we deal with IPRs, the issues to be analysed and taken into consideration are obviously many and often very critical. Besides the traditional rules that span multiple products typically protected by industrial property, we also have provisions for the dissemination of scientific content and relating to commitments linked to the emergent phenomenon called “Open Access” (OA) to scientific publications¹⁶. More generally, there is a series of questions to be answered in the contractual settlement. We need to identify what kind of knowledge can be shared or exchanged and under what conditions; who will be the owner of the scientific results and what are the rules, indeed, in the case of joint ownership; who will enhance the results, and how; in which way and by whom these will be exploited; how confidential information should be protected; etc.

In the following pages we will analyse the key issues with regard to IPRs regulated under the CA. The subsections will resume, at times, the typical parts of this agreement.

3.1 Background

Pursuant to art. 2, par. 1, n. 4 RfP, project “background” “*means any data, know how or information whatever its form or nature, tangible or intangible, including*

(<<http://www.eucar.be/news-and-events/EUCAR%20Model%20Consortium%20Agreement>>),.

¹⁵ The collaboration between the academic institutions and their Technology Transfer Offices (TTOs) is, in this context, crucial. The role of TTOs should be emphasized and their activities greatly enhanced: the collaboration and sharing of ideas, interests, goals upstream of the creative process, even before beginning research and development, all leading to the creation of product, protectable and exploitable through the tools provided by intellectual property rights, is of crucial importance and it is vital for the success of correct exploitation activities. Intellectual property should be taught at all levels of study and specialization. For further analysis, see I. MACHO-STADTER, D. PÉREZ-CASTRILLO, R. VEUGELERS, *Licensing of university inventions: The role of a technology transfer office*, in *International Journal of Industrial Organization*, Vol. 25, Issue 3, June 2007, 483–510; K. DEBACKERE, R. VEUGELERS, *The role of academic technology transfer organizations in improving industry science links*, in *Research Policy*, Vol. 34, Issue 3, April 2005, 321–342; L. MANDERIEUX, *Guía práctica para la creación y la gestión de oficinas de transferencia de tecnología en universidades y centros de investigación de América Latina: el rol de la propiedad intelectual*, World Intellectual Property Organization (WIPO), June 2011 (WIPO Publication 1026 (S), available at: <http://www.wipo.int/edocs/pubdocs/es/intproperty/1026/wipo_pub_1026s.pdf>).

¹⁶ This movement will be duly described below.

*any rights such as intellectual property rights, which is: (i) held by participants prior to their accession to the action; (ii) needed for carrying out the action or for exploiting the results of the action; and (iii) identified by the participants in accordance with Article 45*¹⁷.

Thus, this category consists in any kind of knowledge, in the broader and more general definition that can be assigned to such term, and in any type of IPRs that appear to be necessary to carry out the planned activity or project in order to exploit the results of future research.

Taking into account that the project participants hold the qualification of legal persons, the background has to be considered with reference to the entire university or company and should not be limited to the specific department involved in the research (unless the latter is not endowed with legal personality). It will, therefore, be advisable to identify accurately which background will be considered accessible by the project partners (stating explicitly the background to share, or specifying which is expressly excluded).

The ownership of the background is not affected in any way by participating in the project. However, the insertion already in the proposal and the technical annex, and then within the CA, of certain technologies and database skills implies the sharing of these for the purposes of the project.

It should also be pointed out that the background is not limited only to data, know-how or information that a partner owns, but is also extended to information or IPRs that the participant holds, for example, under a licence agreement. The use of the term “holds” extends, therefore, the spectrum of backgrounds that are attributable to a participant. It will be necessary to clarify which rights contained in the background will be granted access.

With regard, instead, to the situation in which you intend to use IPRs to file a patent application, the definition of the background only includes those used for such an application before the conclusion of the GA (and therefore before starting the activity on the project). In the opposite case, i.e. when the patent application, relating to a previously invention, was filed only after the beginning of the project, it will not be considered part of the background (of course, the parties may agree otherwise).

A pivotal point is the definition of what background is considered. Under the DESCA model in force for the FP7, for example, it was possible to provide two different approaches: on the one hand, a so called “Positive list” approach, which involved listing any data, know how or information that you intend to share (certainly a more defensive solution); on the other hand, a so called “Negative list” approach, which provided the listing of only such information as you intend to exclude from the project. You could also integrate the two approaches and provide next to a positive list a negative one.

¹⁷ The definition of background has been improved compared to the one provided for the FP7 at art. 2, par. 1, n. 5 Regulation (EC) No 1906/2006: “*background*’ means information which is held by participants prior to their accession to the grant agreement, as well as copyrights or other intellectual property rights pertaining to such information, the application for which has been filed before their accession to the grant agreement, and which is needed for carrying out the indirect action or for using the results of the indirect action”.

Now the scenario has changed. The Model GA for H2020 obliges the parties to “identify and agree” upon the Background for the Project. Therefore, it seems reasonable to work with an actively listed Background¹⁸. Then, the parties will have the responsibility to conclude this specific “agreement on Background”. Indeed, if parties know of a specific need for access rights to a specific Background, they will be able to identify this up front. In any case, Article 25.2 and 25.3 of the GA explicitly mention such a duty to inform and this information shall be shared before accession to the GA¹⁹.

It should however be taken into consideration that the inclusion of knowledge in the project background subjects the participant to a number of constraints (especially with reference to the access rights of which we will deal below), that may conflict with other possible “parallel” commitments previously made with other universities/partners in other consortia.

It is, however, always requested that the requirement of “needed” for carrying out the project (*rectius*, “for the implementation of the action”) or for using the results (*rectius*, for use of own result) would be addressed in order to get access to the inserted background. It would be advisable to add a definition of this term in order to make this condition more precise and easier to work with.

Finally, it is worth remembering that knowledge is an asset of an incremental nature: in that way more knowledge is shared in the project the easier it will be for the activity to have a truly innovative outcome; the less sharing is provided, the easier it appears that you can waste energy on lines of research aimed at creating knowledge that the partners, perhaps, already have. This is inefficient not only for partners but also, and especially, for the EC.

3.2 Research results and ownership regime

Pursuant to art. 2, par. 1, n. 19 RfP, the “*results’ means any tangible or intangible output of the action, such as data, knowledge or information, that is generated in the action, whatever its form or nature, whether or not it can be protected, as well as any rights attached to it, including intellectual property rights*”. The term “result” replaces the former “foreground” used in the FP7²⁰.

The discipline governing the ownership of the results is regulated by art. 41RfP²¹. The general rule is that “*Results shall be owned by the participant generating them*” (art. 41, par. 1).

Par. 3 points out that “*if employees or any party working for a participant are*

¹⁸ DESCA2020 proposes this solution.

¹⁹ Approaching the issue by working with a positive list, like the one suggested by DESCA2020, the parties fully accept that anything not listed simply is not Background. Thus, there is no longer any need to explicitly exclude background in Attachment 1 such as the background of research units not involved in the Project as was standard in FP7 CA.

²⁰ See art. 2, par. 1, n. 4 Reg. (EC) 1906/2006: “*‘foreground’ means the results, including information, whether or not they can be protected, which are generated by the indirect action concerned. Such results include rights related to copyright, design rights, patent rights, plant variety rights or similar forms of protection*”.

²¹ See also art. 26 GA (“Ownership of result”).

*entitled to claim rights to the results generated, the participant concerned shall ensure that it is possible for those rights to be exercised in a manner compatible with its obligations under the grant agreement*²². We have already had the chance to cite this provision above. It takes up the *vexata quaestio* of the management of IPRs with respect to non-formal employees especially within the academic scenario (i.e. graduate students, PhD students, staff, fellows, etc.). This rule needs to be analysed within the (sometimes confusing) national regulative framework of reference²².

The cases of joint ownership are also very frequent: in such a situation, par. 2 provides that “*Where participants in an action have jointly generated results, and where their respective contribution to the joint results cannot be ascertained, or where it is not possible to separate such joint results for the purpose of applying for, obtaining or maintaining the relevant intellectual property rights protection, they shall have joint ownership of those results*”²³.

Regarding that, it is a good idea to keep all documents that attest the development of the activity that led to the creation of new knowledge and, in general, to the final result of the research. This will help easily prove, should it be necessary, the ownership of the result and the date of creation (see, for example, laboratory notebooks). Especially in cases of joint ownership, the decision related to percentages of ownership of each participant is always very difficult and inherently discretionary. You can make reference to objective values, but, in the context of creativity, they often seem a little forced. For example, you may consider the budget used, the man/months criteria. This means little in this area, since the time of “creation” of an idea, invention or intellectual work is not predictable. If you can, therefore, produce documentation in order to demonstrate the activity that took place within the specific working package, then it will be easier to negotiate with the partners the percentage of ownership. Anyway different logic related to the costs of protection of industrial property often comes into play.

The joint owners shall “*establish an agreement regarding the allocation and terms of exercise of that joint ownership in accordance with their obligations under the grant agreement. The joint owners may agree not to continue with joint ownership but decide on an alternative regime, inter alia by transferring their ownership shares to a single owner with access rights for the other participants, once the results have been generated*” (art. 41, par. 2 RfP). Already the definition points out the importance of an agreement on managing the issue of joint ownership - an agreement that, unfortunately, is often lacking in practice. The joint ownership of an information asset is difficult to manage through traditional rules (for instance those provided by

²² For further details, see MONOTTI, RICKETSON, *Universities and Intellectual Property. Ownership and Exploitation*, cit., 141-214; GUARDA, *Creation of software within the academic context...*, cit., 497-512.

²³ We could note that this wording is not consistent with itself. We may have cases of joint ownership also where the sharing of the work can be ascertained. It is rather a question of whether it is possible to separate the results jointly developed for the purposes of protection. Where the result is not separable, there will have to be joint ownership; either according to the ascertained shares, or according to another principle.

the private law). It is hard to decide when the enjoyment of the information by a joint owner would harm the ability to enjoy the same good by another joint owner. The agreement lowers transaction costs and avoids the risk that the exploitation is paralyzed. There are no pre-packaged models of such agreement. However, it should provide for the following contents: value of the shares; rules of administration of the goods (the majority, protection and maintenance of the IPRs, protection, etc.); policies on the direct exploitation or licensing; methods of liquidation of shares.

The European Regulation provides a default rule “*unless otherwise agreed in the joint ownership agreement*” (or, therefore, in the case of its absence): “*each joint owner shall be entitled to grant non-exclusive licenses to third parties to exploit the jointly owned results, without any right to sub-license, subject to the following conditions: (a) prior notice shall be given to the other joint owners; (b) fair and reasonable compensation shall be provided to the other joint owners*”. This rule is often adapted in the CA and then modified. When you are about to draw up the terms of the CA that will manage the possible use of the results of scientific research, it is important to pay attention to the fact that the interests in the field change when the project partner is a university, a research centre, or a market player, such as a company²⁴.

3.3 Protection of results

Pursuant to art. 42, par. 1 RfP the “*Where results are capable of or may reasonably be expected to be capable of commercial or industrial exploitation, the participant owning those results shall examine the possibility of protecting them. The participant shall, if possible, reasonable and justified given the circumstances, adequately protect them for an appropriate period of time and with an appropriate territorial coverage, having due regard to its legitimate interests, and the legitimate interests, particularly the commercial interests, of the other participants in the action*”²⁵.

A result that may have industrial or commercial application shall be protected in the most appropriate and effective manner, taking into account any possible interests, particularly commercial, of the other participants. Actually, there is not a formal obligation to consult the other partners whether to protect a specific part of the result, even if it seems a good rule to ensure that they would be notified of it, in order to give them the opportunity to demonstrate the possible injury to their interest.

When the participant does not intend to protect her own result, it must be offered to another participant or to a specific third party. If the result is not

²⁴ The rewording of this discipline appears to be improved compared with the rules relating to FP7. In this one, actually, if there were no agreement between the parties, the default rule would make use by joint owners possible, subject to prior notice and to a fair and reasonable compensation. Now only possible licensing receives a default regulation: any other activity must be settled by an agreement.

²⁵ Actually, clarification of some of the terms would be useful. That is with respect to “commercial application”, “industrial application” and the difference between the two. See also art. 27 GA (“Protection of results”).

protected in any way, the Commission must be notified and, with the agreement of the participant concerned, assume ownership of that result and adopt measures to protect them adequately (see art. 42, par. 2 and, in case of abandonment or not extension of the protection, par. 3)²⁶.

At the core of a CA, or even before its own conclusion, there must be plans for development of the products of scientific research. To this end, it is useful to check if there are clauses in the CA and legal structures designed to convey this important function (especially with reference to the funds provided within the project for expenses relating to the protection of the results).

3.4 Exploitation, transfer and licensing of results

Art. 43, par. 1, RfP states that “*Each participant that has received Union funding shall use its best efforts to exploit the results it owns, or to have them exploited by another legal entity, in particular through the transfer and licensing of results in accordance with Article 44. Any additional exploitation obligations shall be laid down in the grant agreement. In the case of research with the potential to address major societal challenges, additional exploitation obligations may include licensing on non-exclusive terms. Any such additional obligations shall be indicated in the work programme or work plan*”²⁷.

The term “exploitation” is defined by art. 2, par. 1, n. 9²⁸: “*the use of results in further research activities other than those covered by the action concerned, or in developing, creating and marketing a product or process, or in creating and providing a service, or in standardisation activities*”.

Art. 44, par. 1, deals with the transfer of the result: “*Where a participant transfers ownership of results, it shall pass on its obligations under the grant agreement regarding those results to the transferee, including the obligation to pass them on in any subsequent transfer.*

Without prejudice to confidentiality obligations arising from laws or regulations in the case of mergers and acquisitions, where other participants still enjoy access rights or may still request the granting of access rights to the results to be transferred, a participant which intends to transfer the results shall give prior notice to the other participants, together with sufficient information concerning the intended new owner of the results, to permit the other participants to analyse the effect of the intended transfer on the possible exercise of their access rights.

Following notification, a participant may object to the transfer of ownership if it demonstrates that the intended transfer would adversely affect the exercise of its access rights. In such a case, the transfer may not take place until agreement has been reached between the participants concerned. The grant agreement shall lay down time-limits in this respect.

The other participants may by prior written agreement waive their right to prior

²⁶ The GA shall lay down time limits in this respect. This is a good approach but should be more specific. The maximum time span should be at least set out preferably 45 days before any dissemination activity (as foreseen in FP6).

²⁷ See also art. 28 (“Exploitation of results”) and 30 (“Transfer or licensing of results”) GA.

²⁸ The former art. 46 Reg. (EC) 1906/2006 spoke of “use” instead of “exploitation”.

*notice and to object to transfers of ownership from one participant to a specifically identified third party*²⁹.

The owner can transfer the knowledge gained to any legal entity, observing however the functional specifications for the project. The one set by art. 44 is defined as a typical obligation “*propter rem*” (it pertains to the good, to the object). You are, obviously, allowed to transfer the knowledge, but, since this was created under the project, a range of access rights are inherent in it: the new owner will be required to guarantee the rights of access to the other participants referred to in the CA. To dispose otherwise would have given rise to elusive activity of the access rights (this “burden” may have an impact on the price paid to acquire the property).

If the participant transfers ownership of the acquired knowledge, one of the obligations that must be transferred in turn is related to the exploitation of the results. In this context, the occurrence of certain circumstances may be an efficient solution to oblige the user of the result using so called “due diligence”. We refer, for example, to a clause providing the constraint to market products incorporating the technology by a certain date, to put on the market a certain number of products per year, etc.

There are other obligations. For example, the requirement of prior notice to the other parties (art. 44, par. 2, 3 and 4), providing advance notice of the transfer to other partners, since they may assert against the legitimate interests violated by the assignment³⁰.

Finally, the Commission may also object to the transfer or the granting of an exclusive license to third parties established in a third country not associated with Horizon 2020 for issues relating to the preservation of European competitiveness and ethical principles.

The contractual solutions implemented by various models of CA can be designed to facilitate the transfer by providing a list of possible third party transferees, linking it to the elimination of the obligation of prior notification; sometimes a similar result is reached by better defining the category of possible affiliates.

3.5 The dissemination

Subject to any restrictions due to the protection of IP, security rules or legitimate interests, each participant shall disseminate the results it owns as soon as possible³¹: it responds to the logic underlying the Horizon 2020 itself. Before you engage in any dissemination activity, the other participants must be advised by notice. According to the default clauses of GA (Article 29) such notice must be given at least 45 days prior to dissemination, provided in writing and containing all the useful details. Following this, the other participants may object within 30 days of the event claiming that their

²⁹ Similar rules apply to licensing: see art. 44, par. 2.

³⁰ You often do that, because you can also provide for a right of first refusal.

³¹ See art. 43, par. 2.

“legitimate interests” in relation to the result or background could be compromised by the activity of diffusion. In the case of opposition, the dissemination cannot take place before the necessary changes have been adopted in order to safeguard these affected interests.

One of the major innovations in terms of IPR by Horizon 2020 is the importance that has been given to the issue of Open Access (OA)³². It refers to the practice of granting free Internet access to research articles. The final goal is to remove all economic, legal and technical access barriers to scientific information in order to ensure scientific and technological progress in favour of the social, cultural and economic collective. This vision aims to encourage scientists and scholars to disseminate their works, making them freely available on the net for the whole community, not only for the community closely involved in the research. The logic of OA is echoed by some (solemn) statements and guidelines. Among the many: the “Budapest Open Access Initiative” in 2002, the “Berlin Declaration on Open Access Publishing” in 2003, and the “Bethesda Statement on Open Access Publishing” in 2003. OA allows the university to achieve the goal of preserving the existing knowledge and disseminating it in an effective and potentially free way³³; it provides the author the opportunity to increase her prestige in the academic context; and, finally, it makes it possible for the university system to “break the (technological and economic) chains” of the centralized control of scientific knowledge³⁴.

OA is characterized by two main approaches. The so called “Green Road” is based on (self) archiving in a OA repository of published, peer-reviewed articles, usually after an embargo period; the so called “Golden Road” is based on publishing works *ab origine* on an OA journal (eventually with a payment by the author)³⁵.

³² See also *Guidelines on Open Access to Scientific Publications and Research Data in Horizon 2020*, Version 1.0, 11 December 2013, available at: <http://ec.europa.eu/research/participants/data/ref/h2020/grants_manual/hi/oa_pilot/h2020-hi-oa-pilot-guide_en.pdf>.

³³ In MONOTTI, RICKETSON, *Universities and Intellectual Property. Ownership and Exploitation*, cit., at 545: “*Despite these changes in university roles and missions and the wide differences that exist among modern universities, they continue to share a continuity of meaning that makes them ‘special’ and distinguishes them from other social and economic institutions. Above all, they remain, at their core, institutions that foster free and open intellectual inquiry*”.

³⁴ See P. SUBER, *Open Access*, MIT Press, Cambridge (Massachusetts) – London (England), 2012; G.B. FROSIO (under the supervision of Estelle Derclaye), *Open Access Publishing: A Literature Review*, CREATE working paper 2014/1, available at: <<http://www.create.ac.uk/wp-content/uploads/2014/01/CREATE-Working-Paper-2014-01.pdf>>. For further analysis see also R. CASO, *Open Access to Legal Scholarship and Copyright Rules: A Law and Technology Perspective*, in G. PERUGINELLI, M. RAGONA (eds.), *Proceedings law via the internet: free access, quality of information, effectiveness of rights*, European Press Academic Publishing, Florence, 2009, 97-110, available at SSRN: <<http://ssrn.com/abstract=1429982>>.

³⁵ See Y. GARGOURI, V. LARIVIÈRE, Y. GINGRAS, S.HARNAD, *Green and Gold Open Access Percentages and Growth, by Discipline*, 2012, available at: <<http://arxiv.org/abs/1206.3664>>; L. GUIBAULT, *Owning the Right to Open Up Access to Scientific Publications*, in L. GUIBAULT, C.

As all research and innovation build on earlier achievements, an efficient system for broad dissemination of and access to research data and publications can accelerate scientific progress.

The Commission's goal is to optimize the impact of publicly funded scientific research, both at a European level (FP7, Horizon 2020) and at a Member State level. Results of publicly funded research can therefore be disseminated more broadly and faster, to the benefit of researchers, innovative industry and citizens. OA can also boost the visibility of European research, and in particular offer small and medium-sized enterprises (SMEs) access to the latest research for use.

The Commission's strategy is to develop and implement OA to research results from projects funded by the EU Research Framework Programmes³⁶.

OA to publications and, to a limited extent, to research data is the default rule for Horizon 2020. This represents a turning point for OA in Europe.

Pursuant to art. 43, par. 2 *“With regard to the dissemination of results through scientific publications, open access shall apply under the terms and conditions laid down in the grant agreement. Costs relating to open access to scientific publications that result from research funded under Horizon 2020, incurred within the duration of an action, shall be eligible for reimbursement under the conditions of the grant agreement. With due regard to Article 18 of Regulation (EU) No 1291/2013, the grant agreement shall not stipulate conditions regarding open access to publications which would result in additional publishing costs after the completion of an action”*.

Accordingly to that, the GA (to which the CA directly refers dealing with the dissemination issue) provides for specific rules regarding OA. Art. 29.2 of the proposed model of GA for Horizon 2020 (“Open Access to Scientific Publication”) states³⁷: *“Each beneficiary must ensure open access (free of charge, online access for any user) to all peer-reviewed scientific publications relating to its results. In particular, it must:*

- a) as soon as possible and at the latest on publication, deposit a machine-readable electronic copy of the published version or final peer-reviewed manuscript accepted for publication in a repository for scientific publications;*
- Moreover, the beneficiary must aim to deposit at the same time the research data*

ANGELOPOULOS (eds.), *Open Content Licences: From Theory to Practice*, Amsterdam, Amsterdam University Press, 2011, 137–67, 157; S. HARNAD, T. BRODY, F. VALLIERES, L. CARR, S. HITCHCOCK, Y. GINGRAS, C. OPPENHEIM, H. STAMERJOANNS, E.R. HILF, *The green and the gold roads to Open Access*, in *Nature (web focus)*, 2004,

available at: <<http://www.nature.com/nature/focus/accessdebate/21.html>>.

³⁶ For further details, see OpenAire Web site <<https://www.openaire.eu/>>, and the former “Open Access Pilot in FP7” <<http://ec.europa.eu/research/science-society/index.cfm?fuseaction=public.topic&id=1300&lang=1>>.

³⁷ See the Horizon 2020 GA model at: <http://ec.europa.eu/research/participants/data/ref/h2020/mga/gga/h2020-mga-gga-multi_en.pdf>.

- needed to validate the results presented in the deposited scientific publications.*
- b) *ensure open access to the deposited publication — via the repository — at the latest:*
- (i) *on publication, if an electronic version is available for free via the publisher, or*
 - (ii) *within six months of publication (twelve months for publications in the social sciences and humanities) in any other case.*
 - (iii) *ensure open access — via the repository — to the bibliographic metadata that identify the deposited publication (...)*³⁸.

This type of provisions, aimed at fostering the dissemination of scientific knowledge through the OA, may encounter difficulties in their enforcement phase due to the harmonization with national rules devoted to OA (i.e. the possible contrast with different embargo periods) and, again, with issues relating to the ownership of IPRs with respect to the scientific results³⁹. Finally, they should be coordinated with any licence to publish signed by the authors/researchers with the several scientific publishers.

The dissemination activities must be reported in the “plan for the exploitation and dissemination of results”, with all the necessary details to enable the Commission to trace the activity in question.

Finally, art. 43, par. 4, establishes that any patent applications, standards or publication or any other disseminations shall, if possible, include a statement that the action received financial support from the Union. See GA art. 29.4: “*This project has received funding from the European Union’s Horizon 2020 research and innovation programme [Euratom research and training programme 2014-2018] under grant agreement No [Number]*”.

³⁸ Specific rules are devoted to OA to research data: see art. 43, par. 2 “*With regard to the dissemination of research data, the grant agreement may, in the context of the open access to and the preservation of research data, lay down terms and conditions under which open access to such results shall be provided, in particular in ERC frontier research and FET (Future and Emerging Technologies) research or in other appropriate areas, and taking into consideration the legitimate interests of the participants and any constraints pertaining to data protection rules, security rules or intellectual property rights. In such cases, the work programme or work plan shall indicate if the dissemination of research data through open access is required*”; and the art. 29.3 of the GA. See also *Guidelines on Data Management in Horizon 2020*, Version 1.0, 11 December 2013, available at: <http://ec.europa.eu/research/participants/data/ref/h2020/grants_manual/hi/oa_pilot/h2020-hi-oa-data-mgt_en.pdf>. For further details on this issue, see N. DIETR, L. GUIBAULT, T. MARGONI, K. SIEWICZ, G. SPINDLER, A. WIEBE, *Safe to Be Open: Study on the Protection of Research Data and Recommendations for Access and Usage (2013)*, OpenAirePlus, Forthcoming, available at SSRN: <<http://ssrn.com/abstract=2391280>>.

³⁹ There is no space here to delve into this kind of problem. It is worth at least mentioning the fact that the various national legislatures are equipping themselves with *ad hoc* disciplines in the field of dissemination of scientific production by OA. For example, among others, see, within the Italian legal system, article 4 of Law No. 112 of 7 October 7 2013, which converts with amendments Decree Law No. 91 of 8 August 2013 on urgent dispositions for the protection, esteem and promotion of cultural property and activities, and tourism, which regulates Open Access to Scholarly Works, and, as regarding to the German context, Law of October 1, 2013 (BGBl. I S. 3714) *Gesetz zur Nutzung verwaister und vergriffener Werke und einer weiteren Änderung des Urheberrechtsgesetzes*, that modifies Section 38 of the German Copyright Act (*Urheberrechtsgesetz -UrbG*).

3.6 Access rights

The “access rights” category identifies the set of licences and user rights to results or background owned by another participant in the project - in order to allow the conduct of the research and, if appropriate, to economically exploit the results. Regulation of these rights is contained in Section II, articles. 45-49 RfP⁴⁰. This category represents a peculiar, and legally interesting, element of the CAs: it details legal obligations of cooperation that should exist between the various participants in the projects.

The access to results or background of another participant is allowed only if the applicant will “need” it in order to carry on its research activities (“Access rights for implementation”, see art. 47), or to use the result she owned (“Access rights for exploitation”, see art. 48).

The evaluation of the “*needed*” requirement is pivotal in this context. It must be assessed on a case-by-case basis⁴¹. Although a general rule, however, cannot be established, access could be considered necessary when: without it, some of the objectives assigned to the participant by the project would not be attainable, or would be significantly delayed, or require significant additional investment in both economic and human resources (see the relationship between the various Working Packages)⁴²; or without it, the use of a given element of the result by the same owner would make it technically or legally impossible, or would require a significant increase in work outside the limits established by the project (e.g. purposes of its enhancement , marketing, etc.)⁴³.

Requests for access rights, or for waiving them, shall be made in writing (art. 46, par. 1). Following a request in writing to an access right, the participant concerned must evaluate how to correctly answer and act accordingly. It must first be borne in mind that the access rights are included in the CA, and then they are binding for the parties (resulting in a *de facto* compulsory licence). The recommended solution would be to provide an agreement connected to the CA, under which to define what are the limits to the use of that background or result.

As a rule, and if it is otherwise agreed between the parties, the rights of access does not in any way confer the right to grant sub-licences. This answers the need for legal certainty in relations between participants (the possibility of granting sub-licences would have the potential danger of having a chain of licences, without which the original owner can no longer make its consent) (art. 46, par. 2)⁴⁴.

⁴⁰ See also articles 25 (“Access rights to background) and 31 (“Access rights to results”) GA.

⁴¹ Participants may possibly want to determine what must to be understood as “needed” for the purposes of the project, including this definition in the CA.

⁴² Milder interpretation: e.g. the case in which getting from other the same product could be expensive.

⁴³ Strictest interpretation: e.g. it does not apply if I can get on the market similar knowledge.

⁴⁴ It is therefore theoretically possible to grant exclusive licences also on results or background, providing that all participants declare in writing to waive their access rights.

One point that could be inferred from the former regulation is now clearly explained. The participant in the same action has the obligation to inform others, before signing the GA, about the existence of possible restrictions or limitations with regard to access rights to the background (i.e. the case in which the participant is already taking part in another research project and CA), guaranteeing that any future agreement regarding background shall ensure that any access rights may be exercised (art. 46, par. 3).

The access rights can be granted to certain conditions: on a “royalty-free basis”, or under “fair and reasonable conditions”. This last general clause may produce definitional difficulties, although art. 2, par. 1, n. 10 RfP provides us with a definition: “*‘fair and reasonable conditions’ means appropriate conditions, including possible financial terms or royalty-free conditions, taking into account the specific circumstances of the request for access, for example the actual or potential value of the results or background to which access is requested and/or the scope, duration or other characteristics of the exploitation envisaged*”. It will be, therefore, appropriate to choose objective values and standards in order to establish them.

Final general provisions set some rules with respect to the possible defaulting participants (art. 46, par. 4 and 5 RfP).

As regards to access rights for implementation of the results or the background, it can be requested by a participant if it is “needed” in order to carry out her research activities within the project and until the end of this (e.g. the case of a research project that includes the creation of a database (repository) by a specific Working Package that will then be used by a different WP in order to experience a certain edge technology). Access to the result shall be granted "on a royalty-free basis"⁴⁵; access to background as well, unless it is otherwise provided before the accession to the GA by participants (art. 47 RfP)⁴⁶.

Access may also be required for exploitation related to the marketing of the results of the project. This can happen only if a participant has the need in order to be able to use her own result deriving from the project (see, for instance, the case in which you could be not able to market your product without having access to the results produced by others in the project, perhaps protected by IPRs too). Subject to agreement, such rights shall be granted under fair and reasonable conditions (art. 48, par. 1 and 2 RfP)⁴⁷. In any other situations, access can certainly be the subject of separate and specific

⁴⁵ It has its own logic. All WPs are working on a final result; it then seems to be efficient that all participants, in order to develop the project, have access to knowledge produced by others within the same research project.

⁴⁶ The MCARD2020 model often provides that all accesses are free of charge, trying to encourage maximum exploitation of the result. Providing fair and reasonable costs also triggers transaction costs: this must be taken into account when establishing the regulatory framework of the consortium.

⁴⁷ The provision set by the former regulation which provided for the possibility of granting such access rights also on royalty-free basis has failed (see art. 50 Reg (EC) 1906/2006).

negotiation; but there is no obligation for that. Finally, the owner of the results and background could have the obligation to grant access rights even to affiliated entities in the light of the provisions of art. 48, par. 3 RfP⁴⁸.

Pursuant to art. 48, par. 4 RfP, access rights last for one year from the end of the action, unless the participants agree on a different time-limit (actually this term often becomes extends to two years in CA implementation)⁴⁹.

3.7 *Special provisions concerning software*

The research projects that have software as their main core must clearly specify in the CA the rules which govern access to it within the activity of the project.

We have obviously no claim to address the topic in detail here, as such analysis is beyond the scope of this study. Let's describe the main issues.

In this section of the CA some specific definitions should be inserted: “Application Programming Interface”; “Controlled Licence Terms”; “Object Code”; “Software Documentation”; “Source Code”; etc.

In addition, you could evaluate the possibility of adding another category, in some respects, intermediate between those of background and result called “*sideground*”. The definition is derived from the IPCA model under FP7: “*all IPR / information generated during the project but not resulting therefrom, to a limited scope*”. This concept envisaged under the FP6 but omitted in FP7 and in Horizon 2020, refers to information, results, know-how and IPRs developed in parallel with the project in the CA. This omission results in the fact that the participants are not, as a rule, obliged to ensure access rights to their sideground. The IPCA model, precisely, included its definition and manages the levels of access to this type of knowledge in the same manner as those related to the background.

Software is generally considered by companies operating in the ICT sector as a sort of *sui generis* category of IPR. The same approach is recorded within the most commonly used CA models: on the one hand the MCARD2020 provides for a system of open-access rights to all parties and ensures access to all the “object code” and the API resulting from the project

⁴⁸ Pursuant to art. 2, par. 1, n. 2: “*'affiliated entity' means any legal entity that is under the direct or indirect control of a participant, or under the same direct or indirect control as the participant, or that is directly or indirectly controlling a participant. Control may take any of the forms set out in Article 8(2)*”. The definition that is given within the CA sometimes differs in the various models in force under the FP7. For example, IPCA and EUCAR models provided a more detailed definition, which generally led to qualify as affiliated a greater number of entities, while recognizing these ones broader access (compared to DESCAs).

⁴⁹ Finally, art. 49 RfP provides for access rights for the Union and the Member States limited to non-commercial and non-competitive use. Such broad royalty-free access rights for the Union institutions are problematic in several respects: the burden of the Union’s access rights that the results would carry with them can discourage or hinder future exploitation activities, also because there is no time limit and participants would need to keep track for years and years of the possible restrictions.

(result), allowing also the possibility of sub-licensing to third parties; DESCAs, on the other hand, has a more restrictive regime (“Value Model”), allowing the party to gain access to the software if it is required to “use” its foreground and sub-licensing only if directly connected to this.

Access to software does not include the right to obtain the source code or the object code tailored to a specific hardware platform, source code, object code software or related documentation in any particular form, but just as it is available to the part that grants the access.

3.8 Confidentiality

The CA provides a section dedicated to confidentiality obligations which the parties agree among themselves with reference to the information that will be exchanged or brought to their knowledge, in any way, during the activity of the project. These are, however, already partially defined in the GA (Article II.36), but may be further specified in the CA. In particular, this section is concerned with: (i) what information should be considered confidential (e.g. purposes and exceptions); (ii) what procedures should be used to identify the information as confidential and to transfer it; (iii) to whom such confidential information may be disclosed and under what specific conditions; (iv) the final term with reference to the obligation of confidentiality.

The rules on confidentiality (also referred to as “non-disclosure agreement” (NDA)) are a very important aspect of the CA, as the violation of which is normally connected to a claim for damages. They are essential in order to protect the novelty of the products of scientific research and any trade secrets that originate from it⁵⁰.

This section must necessarily be coordinated with the plan for the exploitation of technology.

4. Final remarks

The rules applicable to Horizon 2020 are actually based on the FP7 rules, with some further improvements and clarifications⁵¹.

With respect to IPR regulation, there are however a few differences that we have already had the chance to deal with. First of all, some definitions (e.g. definition of background or affiliated entities) have been slightly modified. The main and most important change is due to the new policy for

⁵⁰ The NDA should be signed also under the preparation of the application phases, in order to discourage the possible disclosure by imposing a contractual liability (penalty clause).

⁵¹ Anyway, the new programme expands the knowledge, with more emphasis on the societal impact of research versus the deepening of knowledge (FP7). More emphasis is also put on the collaboration with industry and governing bodies, focusing on the market potential and the concrete and useful applicability of the research deliverables. Greater financial support has been provided for the SMEs (overall up to 20% of the total Horizon 2020 budget, that has been increased compared FP7).

OA. It has more emphasis than in FP7 as it is now a general requirement. In order to help potential participants, the EC has published a fact sheet dedicated to OA in Horizon 2020⁵². Together with that, the Open Research Data Pilot has been launched with the goal of fostering and maximizing access to and re-use of research data generated by certain specific projects⁵³.

What we have so far analysed demonstrates the need to put more and more attention on this kind of issues. IP management is not only a matter of regulating the relationship between the parties involved in a project with reference to the results of their research; it becomes a tool itself of enhancing and incentive to engage in effective and efficient research activities responsive to interests of the funding body (the Commission) and the participants involved (public research institutions and private parties). These skills and competencies are necessary. It is surely pivotal that offices designed to handle this kind of issues will be more and more established and strengthened (we have already had the chance to mention how important TTOs are, especially within the academic scenario). However, it is also essential that universities must do their part and try to transfer this peculiar knowledge, participating in training new, future jurists working on these issues.

From a general and dogmatic perspective, the key point is that European regulation does not solve the problems that characterize the more particular context of the discipline of IPRs and contract law at a European level; rather it raises other ones. The obligations that are established at the level of regulation and then filtered by the contractual instrument have an impact on the internal discipline with reference, for instance, to the rules for the dissemination of the products of scientific research (see the OA provisions), and for the allocation of the ownership of IPRs (a critical issue, especially within the academic context). Then, obligations arise without any changes to regulations on IPRs. Another paradigmatic topic is represented by the complex question related to joint ownership, where contractual rules are imposed in order to regulate the management of the research results shared between participants in the project, but the more problematic issue of the management of rights of communion with reference to information goods is not solved at the dogmatic level.

The legal framework introduced by Horizon 2020, which had the aim of simplifying the regulatory framework proposed by FP7, is still too complex and does not fully clarify the problematic issues that the past experience of European funding had shown: it is still quite common to those who deal with this kind of issues to manage critical situations arising from practical scenarios. Furthermore, the proposed contractual models surely represent an interesting

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See https://ec.europa.eu/programmes/horizon2020/sites/horizon2020/files/FactSheet_Open_Access.pdf.

⁵³ For further details as to the core areas of Horizon 2020 participating in the Open Research Data Pilot as well as to the types of data which the pilot will be applied to, see the aforementioned EC fact sheet.

experience, since, to some extent, they reflect a kind of bottom-up law aimed to improve and integrate the discipline resulting from statutory law. These same models, as matter fact, are anyway themselves imposed; furthermore, even if they can be modified, they often appear to be too rigid for derogation in terms of transaction costs.

There is still a lot to do with reference to the study of the intersections between contract law and IPRs regulation. Legal scholarship can definitely plays a pivotal role in providing an appropriate knowledge base and useful models in order to be a stimulus to the European legislator.