

NBIC IP REGULATION

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Programma

- Deel I: totstandkoming
- Deel II: inhoudelijke bespreking
- Sprekers geven eigen mening, geen officieel standpunt.
- Presentaties zijn geen excuus het niet zelf na te lezen!

Plaats en ontstaan

- De NBIC IP Regulation is een NBIC document.
 - onderdeel van het NBIC contractenkader, NGI subsidie regeling;
 - VSNU/NFU delegatie gevraagd om op basis van CTMM NBIC contract te helpen maken;
 - aanvang gesprekken september 2009;
 - deelnemers medewerkers van Philips, SP (Organon), DSM, VSNU/NFU en NBIC;
 - resultaat een document dat NBIC heeft voorgelegd aan VSNU/NFU;
 - VSNU is akkoord, laatste formele goedkeuring NFU verwacht medio oktober;
 - NPC, NGI consortium, heeft besloten de regeling over te nemen.

Doelstellingen zomer 2009

- ‘Protect or publish’ principe voor resultaten;
- breed bruikbaar document (aard en projecten);
- aansluiten bij (inter)nationale standaard (wet en kaderprogramma's)
- vereenvoudiging contract (leesbaarheid en bruikbaarheid);
- minder administratieve processen (projecten en IP);
- geen ingewikkelde meebetaal procedures voor octrooien; en
- geen automatische verdeling opbrengst voor niet eigenaren.

Kader en hiërarchie

- Subsidie voorwaarden (NGI of andere)
- Statuten & reglementen Stichting NBIC
 - ook annex 3 bij Partner agreement.
- NBIC Partner Agreement
 - annex 1 NBIC List of Definitions;
 - annex 2 NBIC IP Regulation.
- NBIC Project Agreement
 - annex 1: project beschrijving;
 - annex 2: subsidie toekenning;
 - annex 3: Background IP Statement;
 - annex 4: NBIC administrative procedures.
 - reglementen van de stichting NBIC & eventueel subsidievoorwaarden
- Vindplaats: artikel 1 NBIC Partner Agreement & artikel 1 NBIC Project Agreement

Kennis en eigendom

- Kennis: geen eigendom (geheimhouding)
- IP rechten: eigendom (verbod)
- Typen resultaten in NBIC:
 - Registered IP
 - Software copyright
 - Database rights
 - Material
 - Other copyrights

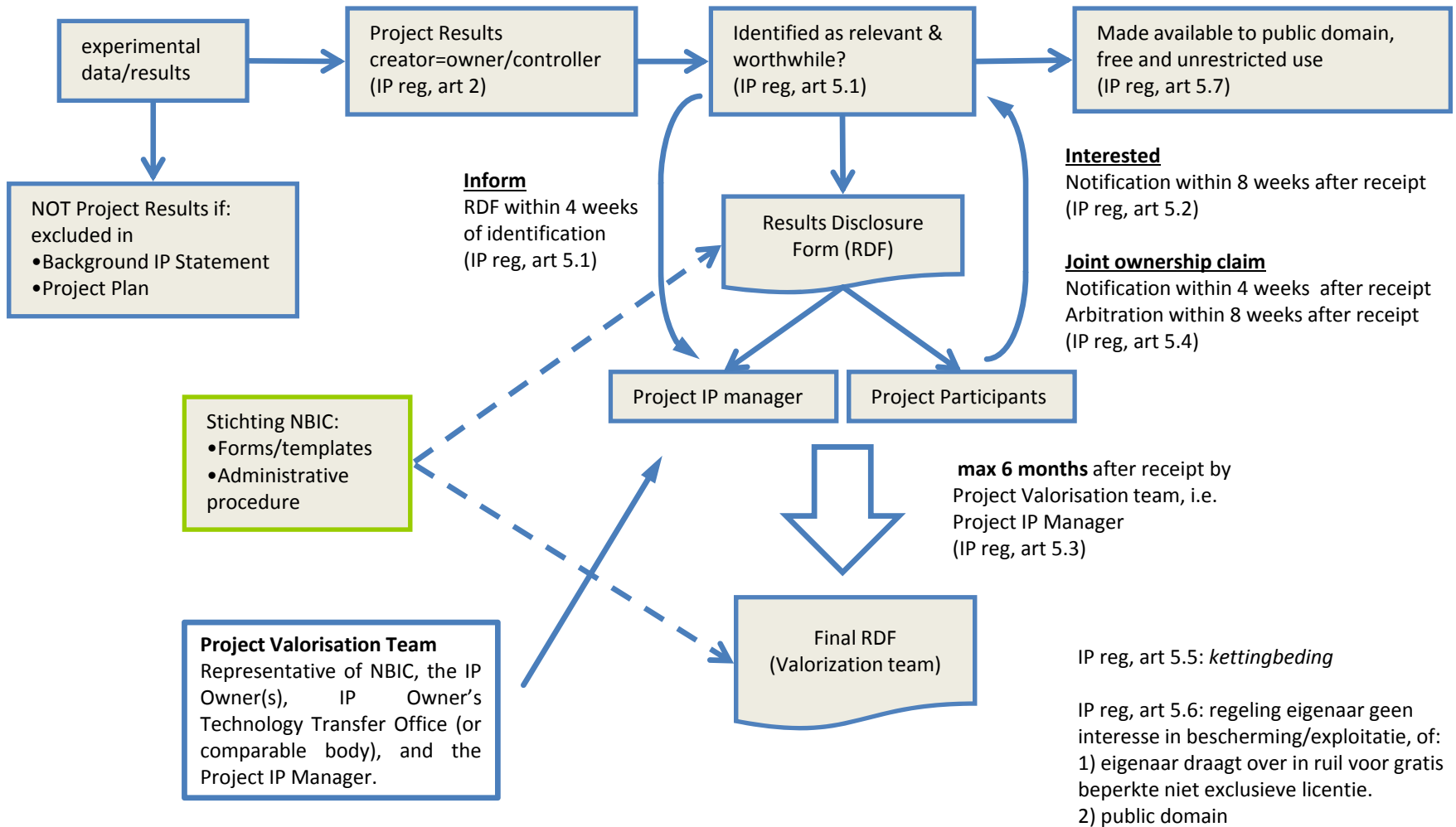
NBIC IP bepalingen

- Partner agreement
 - definitives, annex 1;
 - IP Regulation, Annex 2:
 - Artikel 1: Scope;
 - Artikel 2: IP-Ownership;
 - Artikel 3: Background IP;
 - Artikel 4: Access Rights to Background IP;
 - Artikel 5: Protection and prosecution of Project Results;
 - Artikel 6: Obligations of joint IP-Owners;
 - Artikel 7: Access to, and licenses on Project Results;
 - Artikel 8: Commercial Access;
 - Artikel 9: Dissemination; en
 - Artikel 10: Confidentiality.
- Project Agreement
 - Artikel 6: Background IP Statement

Toegang tot Background

- Access: IP Reg artikel 4.1 en 4.2
 - 4.1: Project Use
 - 4.2: *“...to relevant Background IP for use to the extent that such Access Rights are Technically Needed for the use of the requesting Project Participants’ Project Results.”*
 - Non discriminatoire condities en tot 1 jaar na het einde van het project.
- Identificatie - Background IP Statement: Artikel 6 NBIC Project agreement
 - Omvang verplichting: inspanning:
 - *“best of [your] knowledge at the time of signing”* tenzij *“restrictions unknown”* of *“did not reasonably need to be aware of”*
 - *“describing the Background IP it will make available in the Project”* en
 - *“any restrictions to grant Access Rights in accordance with article 4.1 and 4.2”*
 - NB: Background IP Statement mag ‘positief’ of ‘negatief’ zijn (IP reg, artikel 3.1);
 - Waarom: ‘freedom to operate’;
 - dus vooral van belang als *“(i) restricts the (other) Project Participant(s) from using Project Results and (ii) are not catalogue items and/or not readily and/or publicly available”*
 - NIET: *“status and/or validity [...] and/or whether it infringes Third Party rights.”*

Results



Joint Ownership

- Basis principe: gezamenlijk beheren of overdragen.
 - *“reasonable commercial efforts to conclude a Joint IP-Ownership Agreement (“JOA”) or assign its rights to another Joint IP-Owner.”* Bij overdracht krijgt de vervreemder een ‘freedom to operate licence’.
- Geen regeling: Nederlandse wet met aanvullingen.
 - Als niet binnen één jaar na de finale RDF een JOA is afgesloten dan regelt de Nederlandse wet de relatie (Titel 7 Boek 3 BW) aanvullingen
 - *“any Dutch mandatory statutory provisions in other relevant laws outside the Dutch Civil Code apply;*
 - *all out of pocket costs related to filing, prosecution, and maintenance of such Registered IP shall be shared between the Joint IP-Owners based on their respective ownership;*
 - *Joint IP-Owners shall decide on matters related to prosecution and maintenance of the Joint IP-Right by majority vote, whereby each Joint IP-Owner shall have a relative vote based on its ownership;*
 - *subject to sub (iii) the Joint IP-Owner who employed/provided the majority of the inventors/authors/creators shall take the lead in managing the Jointly Owned IP-Right;*
 - *if one of the Joint IP-Owners is (no longer) interested in filing or maintaining the Joint IP-Right in a certain territory it will inform the other Joint IP-Owner(s) in writing. It shall assign its rights to the other Joint IP-Owners. Upon such assignment, the assignor and its Affiliates shall be granted an irrevocable, non-exclusive, world-wide, fully paid-up and royalty-free license within the scope of its current and near future business activities (as specified between the assignor and assignee(s)) without the right to grant sublicenses; additionally assignor has an Internal Access as granted in Article 7.3, unless agreed otherwise.*
 - *the Joint IP-Owners shall share the benefits generated with the use of the Joint IP Rights, such benefits include monetized value of its own & Affiliate use and actual income received from Third Parties & Affiliates (or monetized value of other compensation received instead); however if the total cumulative benefits (generated in the course of its economic life) by using/licensing/applying the Joint IP-Right are likely to be less than fifty thousand (50,000) Euros, in which event a single lump sum compensation shall replace such benefit sharing;*
 - *the Joint IP-Owners shall each be allowed to grant licenses to Third Parties & Affiliates under reasonable arms length conditions;*
 - *except in case of negligence or wilful misconduct by the indemnified Joint IP-Owner, each Joint IP-Owner shall indemnify the other from claims by Third Parties based on the use of the IP Rights by the indemnifying Joint IP-Owner; under the usual conditions of notification of and intervention by the indemnifying party and its control and settlement of such claim, subject to maintaining the reasonable interests of both parties;*
 - *no Joint IP-Owners shall be obliged to grant any license to new/future IP Rights constituting improvements of the Joint IP Rights;*
 - *Joint IP-Owners shall provide each other with at least annual reports with all relevant information (for example prosecution costs, exploitation benefits) concerning the Joint IP Rights.”*
- Geen akkoord over bedragen: arbitrage voor de ‘cijfers’
 - *“In the event Joint IP-Owners are unable to agree on costs and/or total expected benefits within 1 (one) year (counting from the day of receipt of the final RDF), each Joint IP-Owner is entitled to submit such issues to the AC.”*

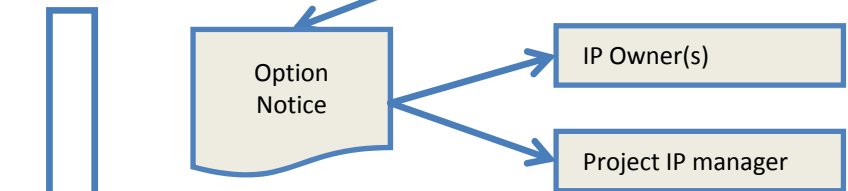
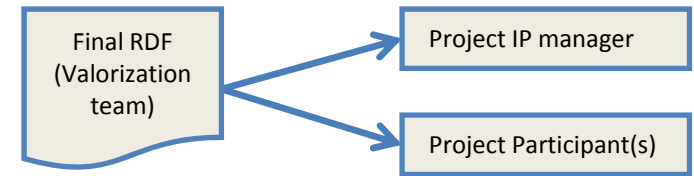
Internal Access

Rights	Inventor/creator	Project Participants	NBIC	Other Partners
Registered IP	Unrestricted	Free for Project Participant and Affiliates. Academic parties: non-assert for collaborative research with 3rd party.	Free in NBIC Projects	Free for use in NBIC projects, if available and upon request.
Software Copyright	Unrestricted, depending on license. Default: Open Source License, 'MIT 1988'	Open source: license terms. Closed: same as registered IP.	Open: license terms. Closed: Free in NBIC Projects	If open source: license terms.
Database	Unrestricted 'open access' or closed to be determined in Project agreement.	Open: confidentiality restrictions but no additional cost, unrestricted use, limited extraction Closed: use in NBIC projects	Open: Free in NBIC Projects (incl. substantial extraction).	Open: confidentiality restrictions but no additional cost. Open: free NBIC projects (incl. substantial extraction).
Material	Unrestricted	Outside of the project at cost basis; note: may request up to 3 years after project.	In NBIC Projects at cost basis, if available; note: may request up to 3 years after project.	Use in NBIC projects at cost basis, if available and upon request; note: may request up to 3 years after project.
Other copyrights	Unrestricted note: ownership not automatic, may not have access	Free, if available; note: reasonable effort by owner/employer. Academic parties: non-assert for collaborative research with 3rd party.		

Commercial Access

“Each IP-Owner shall offer the Project Participants the opportunity to express its interest in Commercial Access against Adjusted Market Price .” (IP reg, art 8.1)

Rights	<i>“If timely submitted” = binnen vier weken na (IP reg, art 8.3):</i>
Registered IP	<i>the final RDF for a given (set of) Project Result(s) was sent to the Project Participants.</i>
Software Copyright	<i>the notification by the IP-Owner(s) that the Software will be offered under a Closed Source License.</i>
Database	<i>Databases: the notification by the IP-Owner(s) that the Database will be offered under a Closed Access Database.</i>
Material	<i>Material: the final RDF (as referred to in Article 5.3) for a given (set of) Project Result(s) was sent to the Project Participants.</i>
Other copyrights	<i>Other copyright: the Project Participants were notified of the relevant work.</i>



Als niemand tijdig interesse toont is/zijn de eigenaars vrij derden te benaderen. (IP reg, art 8.4)

“license structure (e.g. exclusivity, territories, sub-licence-ability) or, subject to the decision of IP-Owner to make such an offer, an Assignment, intended field of use (e.g. technical field and/or application) and other relevant and available information to determine the intended scope and application of the Access Right.” (IP reg, art 8.2)

Optie naar licentie/overdracht

- Optiehouder(s):
 - Onderhandelingsrecht (gezamenlijk met alle optiehouders), (IP reg, art 8.5.1); en
 - betalen voor ‘out of pocket costs’ gemaakt in het kader van de eerste indiening (Registered IP) of ‘code review’ (Software Copyright), (IP reg, art 8.5.2).
- Eigenaar/Eigenaren:
 - informeren van optiehouders en relevante informatie delen (IP reg, art 8.6.1); en
 - optiehouders de mogelijkheid te bieden verbeteringen aan te dragen en redelijke verzoeken tot wijzigen in te willigen (IP reg, art 8.6.2).

Rights	Onderhandelingsperiode (IP reg, art 8.5.1)
Registered IP	5 months after the first filing.
Software Copyright	4 months after the submission of the Option Notice
Database	4 months after the submission of the Option Notice
Material	4 months after the submission of the Option Notice
Other copyrights	4 months after the submission of the Option Notice

DOEL: Inspanning om *“fair, reasonable and non-discriminatory agreement”* (IP reg, art 8.8) overeen te komen.

Indien **geen** overeenstemming in Onderhandelingsperiode:

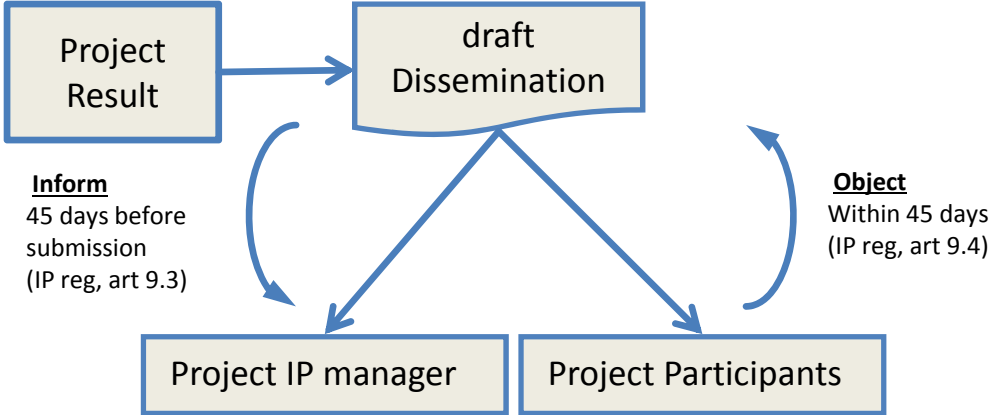
- *“each Party shall have the right to have the Market Price and Adjusted Market Price determined by the AC.”* (IP reg, art 8.7); en/of
- Vaste bepalingen tenzij anders afgesproken tussen partijen (IP reg, art 8.8.1)

License clauses

- Vaste licentie clausules, tenzij anders afgesproken (IP reg, art 8.8.1)
 - *commitment to exploit within the licensed fields (i.e. anti-shelving);*
 - *possibility of publications concerning the licensed IP Rights;*
 - *availability for research and education use of the Foreground IP Rights;*
 - *freedom for the licensee(s) to (jointly) initiate litigation or (jointly) enforce the licensed IP Rights;*
 - *licensee's right to receive information and contribute to the prosecution of licensed IP Rights;*
 - *fair distribution of contribution of patent costs reflecting the scope of the each license (fields and territory) and the number of licensees. There shall be no obligation to grant a license back by the licensee to the licensor and, provided the commitment to exploit is met, there shall be no restriction to the licensed fields.*

Dissemination

Each Project Participant shall be allowed to Disseminate any of its Project Results. (IP reg, art 9.1)



**Removed objection
Invalid objection**
Free to publish (IP reg, art 9.4)

Valid Objection:

- Specification of parts and grounds (IP reg, art 9.4)
- Work towards an amicable solution (IP reg, art 9.6)4

Timely objection:
Grounds for objection (IP reg, art 9.4):
1) objecting [party's] Confidential Information; geldig: zolang die informatie er in staat.
2) "will jeopardise a Recipient's opportunity to obtain a Registered IP-Right;" geldig: 90 dagen (+ een maal verlenging met 45 dagen als noodzakelijk vanwege complexe aard aanvrage or resultaten).

No timely objection:
Free to publish (IP reg, art 9.5)

