

ExtreMat Training Course

"Protecting and Exploiting Intellectual Property Generated in ExtreMat"

European Patent Academy, Munich, April 3-4, 2008

Isar building, Erhardtstr. 27, 80469 Munich, Germany

<http://www.epo.org/contact/munich-1/isar.html>

Room No 128

Programme

Thursday April 3, 13:00 - 13:10

Welcome

Noel Campling, Director of Know-how, European Patent Academy

Thursday April 3, 13:10 – 15:00

"Protecting rights in joint Research Projects"

Jeremy Philpott, European Patent Academy at the European Patent Office

What rights arise?

- inventions & hence patents
- know-how & trade secrets & confidential information and hence non-disclosure agreements and material transfer agreements
- copyrights & how to protect and enforce them
- database rights & how to protect and enforce them

Patents

- basic facts on patentability (novelty, inventive step etc; exclusions e.g. surgical methods)
- basics of the application procedure (national / EPO / PCT)
- how they are used (licensing-in and -out; sale etc). Include "Research Exemption" & compulsory licensing.
- patent information as source of technical information & commercial intelligence

Ownership & collaboration

- the hazards of "co-invention" (e.g. McGriskin versus Webb)
- Lambert Model Agreements

Thursday April 3, 15:00 – 17:00

“Prerequisite for Patent Protection: 'Novelty' and 'Inventive Step' and the threat of their unintended loss by publication, presentation or cooperation”

Matthew Foulger, Examiner, European Patent Office

Patentability

Which criteria and aspects apply when assessing the Novelty or the Inventiveness of an invention (absolute concept of Novelty; 'problem-solution approach')

Loss of rights

Pitfalls to avoid and obey as Inventor/Applicant - e.g., oral disclosure at consortiums, conferences, abstracts or presentations at seminars

Research exemptions

- Extent and Implications
- Material/Data exchange; Material transfer agreements

Friday April 4, 09:00 – 12:00

“(Joint) Patent Application and Exploitation: Rights and obligations arising from being a partner in the FP6-funded ExtreMat project”

Salvatore Amico-Roxas, IPR-Helpdesk

Background: FP6 rules and Definitions

Protection Issues

(Joint-)Ownership Issues

Conditions for the Use and the Dissemination of the Results

The presentation will cover the following questions:

- What are possible "legitimate interests of other ExtreMat partners"?
- Do I have to inform all other ExtreMat project partners and the CEC before filing a patent application?
- How do I have to do this? How long in advance?
- What information do I have to unveil in this announcement? How does this interfere with confidentiality and protection?
- Do I have to file patent applications jointly, if there were other partners involved in the research? Or can I file it alone in a first step and then include further partners later?
- Can other partners object my announcement of filing of a patent? For what reasons? What happens then?

- Can they still object after my patent application is filed?
- May other ExtreMat partners express interest in using my results in other geographical areas or application fields, where I don't intend to use them?
- Am I obliged to file a European or PCT application if I only want to use the result locally?
- Am I obliged to protect applications only other ExtreMat project partners are interested in, but I am not?
- Who pays the additional costs, then? What will be the terms of use?
- How can I proceed if we do not agree on a joint strategy? Do I have to delay patent application before this disagreement is settled?
- Do I have to mention the FP6-funded project ExtreMat in the patent application?
- If I generated an exploitable result in ExtreMat and want to commercialise it externally, e.g. by selling or licensing it to someone outside the ExtreMat consortium:
- Do I have to inform the ExtreMat partners and the CEC in advance on my plans?
- Do I need their approval? May they object to this licensing? What are the rules for this case? What are the deadlines for objection?
- What are the terms of use I have to offer to them? What are "fair conditions"?

Friday April 4, 13:00 – 14:30

“Exploitation of IP generated in Research Projects: Options, Benefit, Routes, Success Stories”

Dr Klaus Hoppstock, Technology Transfer Office Forschungszentrum Jülich GmbH

Forschungszentrum Jülich: Research on 2,2 km²

Technology Transfer: Jülich's Way to do it

Results in "Dry Figures"

Success Stories: GMR-Effect and others

Friday April 4, 14:30 – 15:00

“Dissemination and Exploitation of Research Results via the new Enterprise Europe Network”

Dr Uwe Schüssler, EU-Kooperationsbüro der Bayern Innovativ GmbH

The Innovation Relay Centres: Largest Network for Transnational Technology Transfer

The new Enterprise Europe Network: Continuing the work of the IRCs

Services for Dissemination and Technology Transfer