

---

# Workshop on International R&D and Technology Transfer Contracts – Negotiations, Intellectual Property Rights and Dispute Resolution

WIPO - Alicante, March 11, 2011

---

Agreements in R&D and Technology Transfer:  
Best Practices and Model Agreements

Dr. Lorenz Kaiser  
Division Director Legal Affairs and Contracts  
Fraunhofer Headquarter



# **A sound Agreement starts before the Agreement**

---

# Different Aspects of IP

---

IP as asset for securing a position in technology

IP as patent manifesting market power

IP as acquisition instrument for business

IP as defending instrument against competitors

IP as basis for licence revenues

IP as incentive and motivation of staff

# The IP success story

## Time Lag - Track Record MP3

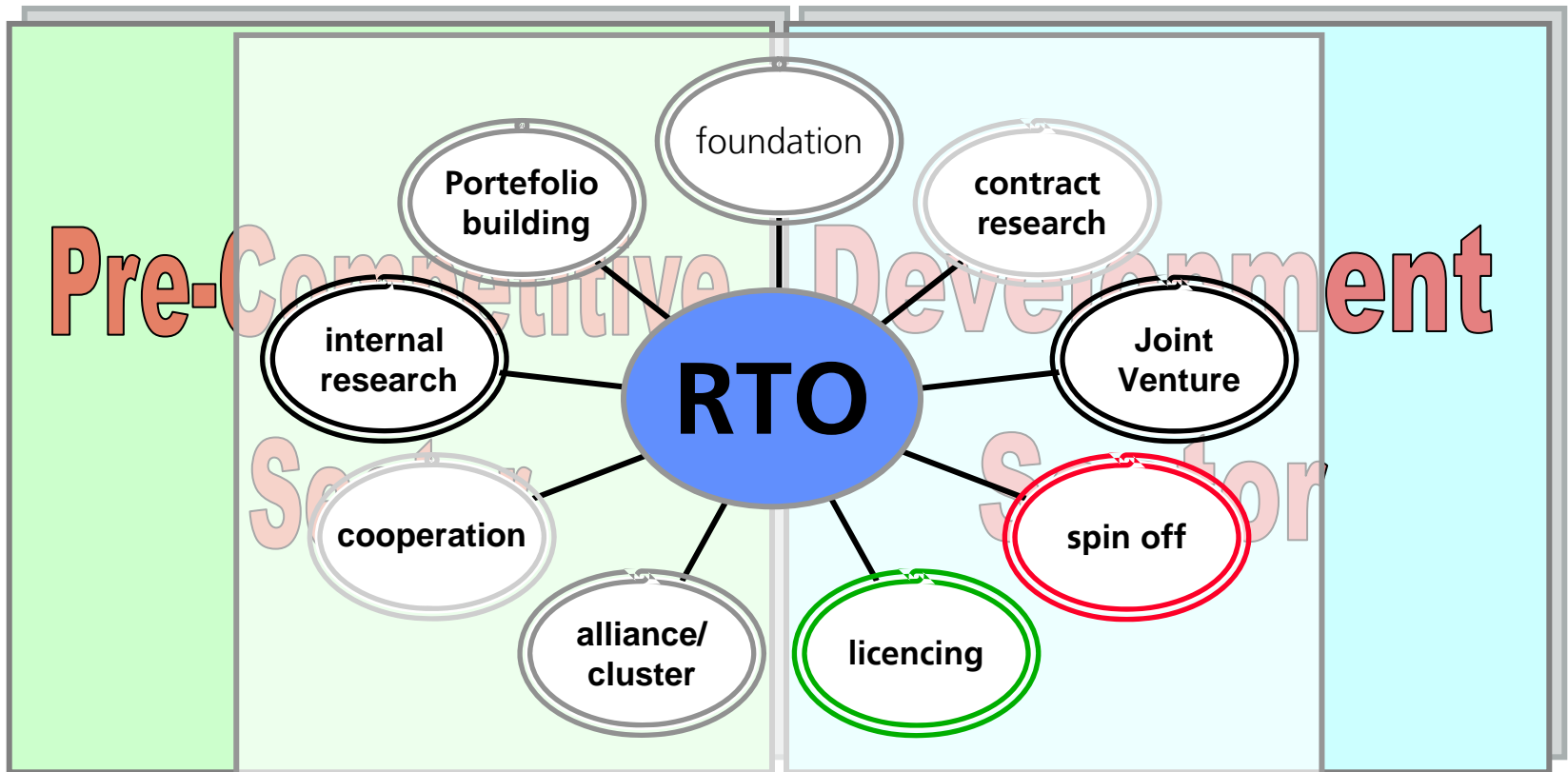


Inventors of MP3, 1987

### Development of the Audio-Coding at Fraunhofer IIS in Erlangen

- **since 1981** Field of Research at the University of Erlangen
- **since 1987** Audio-Coding at Fraunhofer IIS
- **1992** MPEG-1 Layer 3 becomes international standard
- **July 14th, 1995** the name "MP3" is defined
- **1997** starts MP3 Internet Boom
- **1997** MP3- successor MPEG-2 AAC becomes international standard
- **2000** Federal President awards the "Future-Prize" to the inventors of MP3
- **2004-2007:** licencing venues on highest level
- **2013:** basic patent protection will elapse

# Forms of Cooperation in a Research Institute



# Success and Failure close together

## The Different Applications of Service-Robots



Entertainment / Info / Guidance



Housekeeping



Windowcleaning



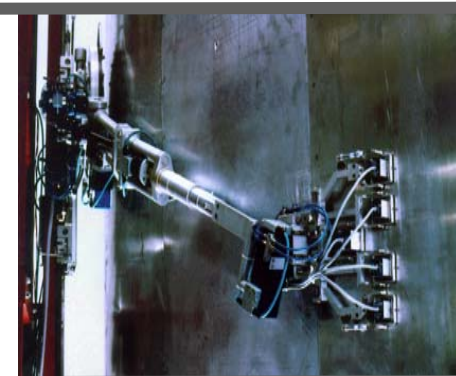
Floorcleaning



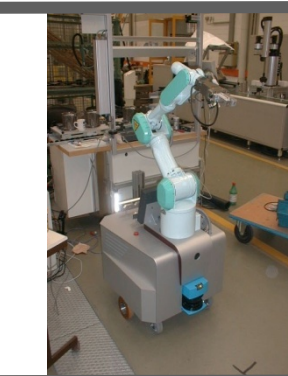
Hospital



Guarding



Maintenance and Inspection

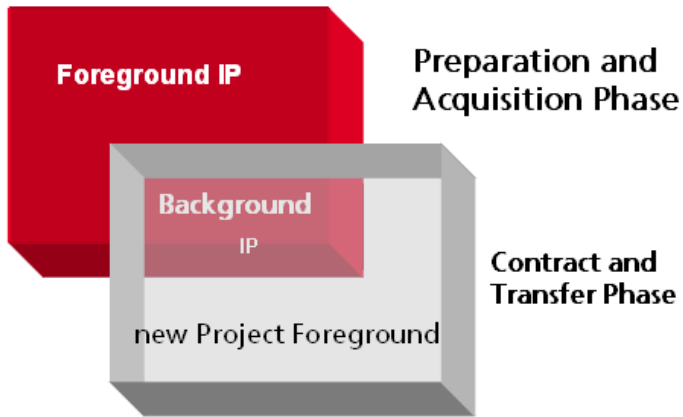


Manufacturing

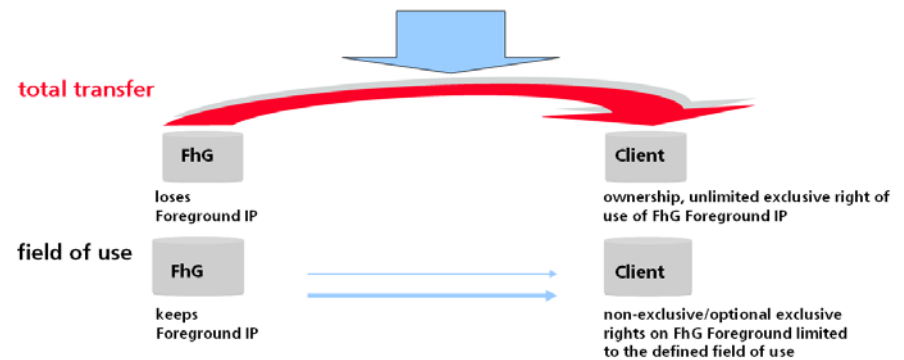


Inspection of chemical facilities

# Rights on the Results



## Contract Research Strategies:



Europe: different - mostly total transfer (see EU guidelines 2008)  
US: Universities grant regularly non exclusive license (Bay Dohle Act)  
Asia: Different situation. Similar to Europe

# The Enforcement Problem in R&D Contracts

Client: guarantee for no conflicting rights in the commercialisation phase

R&D Performer: No guarantee, but hold harmless against third party claims

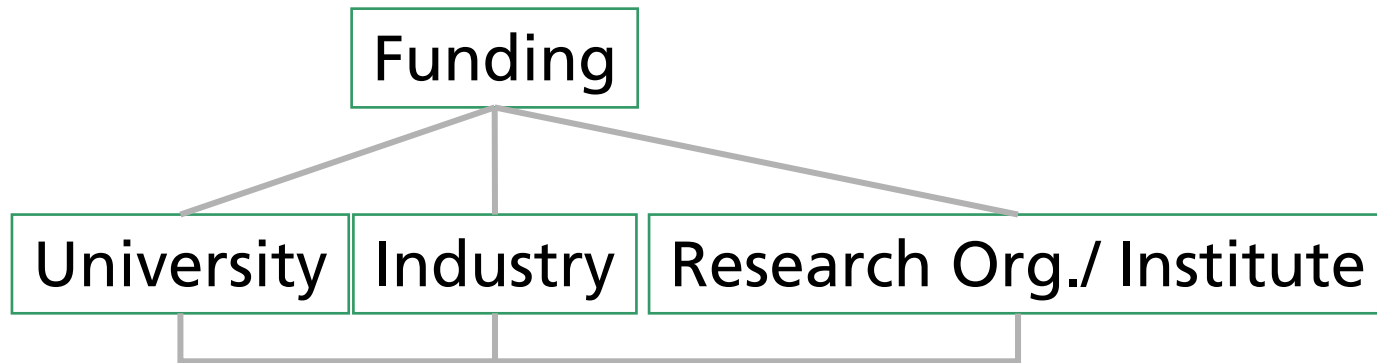


Recent and popular lawsuits about extremely high damages:

- Alcatel-Microsoft
- Csiro-Buffalo
- Nokia-Apple



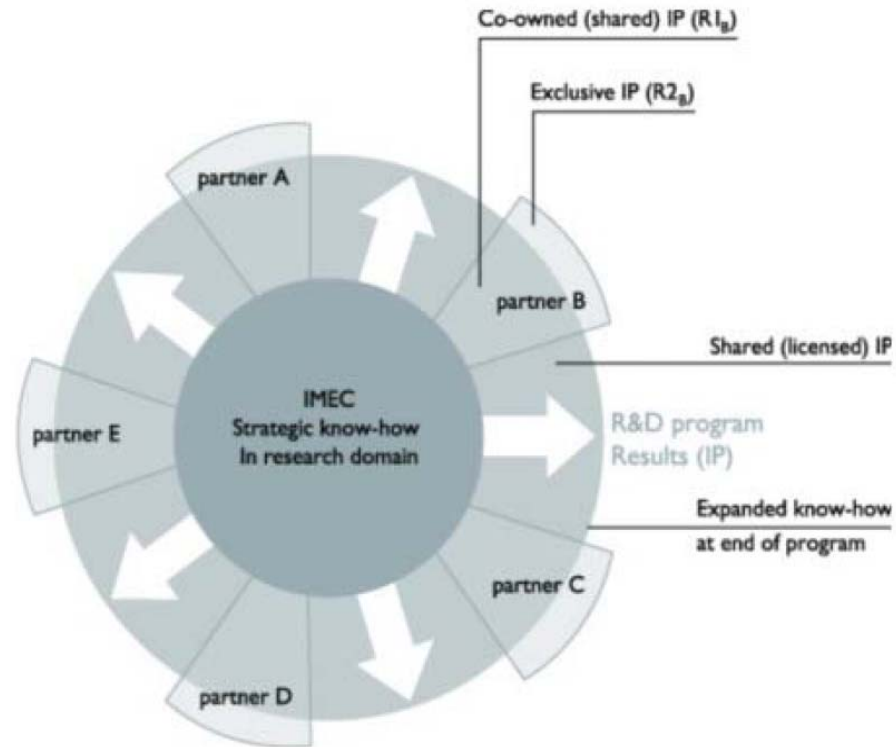
# Collaborative Research



- 1) Corporate Law matters
- 2) Funding Conditions
- 3) EU-antitrust law applies

# Collaborative Research

## IMEC-model - Best Practice



<http://www.imec.be/ScientificReport/SR2008/HTML/1225271.html>

# Rights of Use in Collaborative (and funded) Research

## Foreground

For the duration of the project

- non-exclusive rights
- royalty free

Beyond it, especially for commercial exploitation of the results

### PRO's Position

- non-exclusive rights
- against royalties

### Industry Position

Exclusive right  
Royalty free

## Background

Where required for the execution of the project

- non-exclusive rights
- free or against royalties

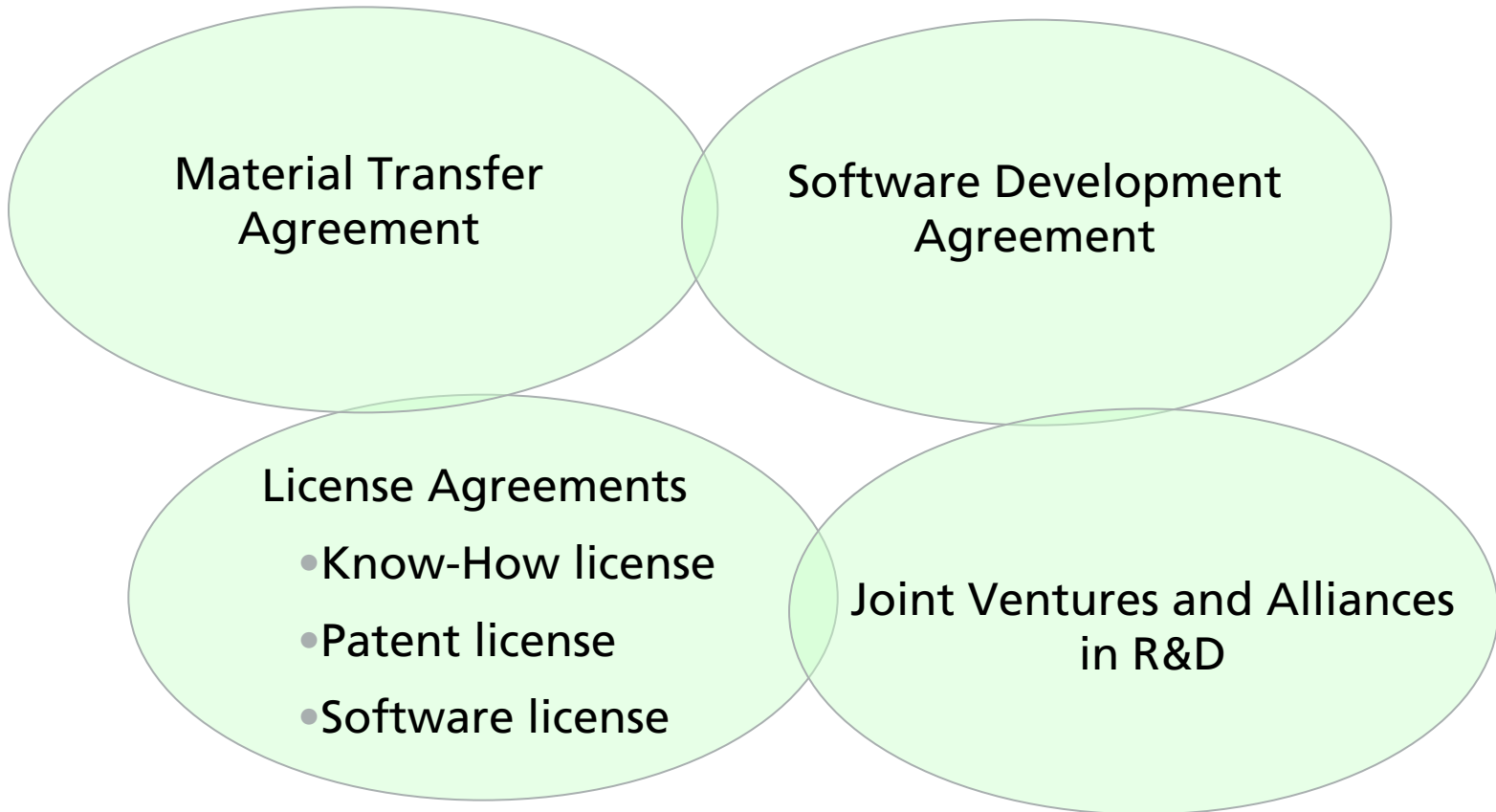
Where required for the exploitation of the results

- non-exclusive rights
- against royalties

---

# Further Special Cooperation Models

---



# Benefits and obstacles of cooperation models

**Benefits turn out to be also obstacles from time to time:**

Contracts: **specialization**,  
individual solution in each special case;  
time-limited and project-related

Collaboration: highest flexibility in design,  
variety of organization forms, expandable;  
**open access** as benefit but mostly obstacle  
(depends on point of view, for research  
institutes it is mostly an obstacle to be solved...)

national peculiarities  
in all models:

administrative bodies,

tax law,

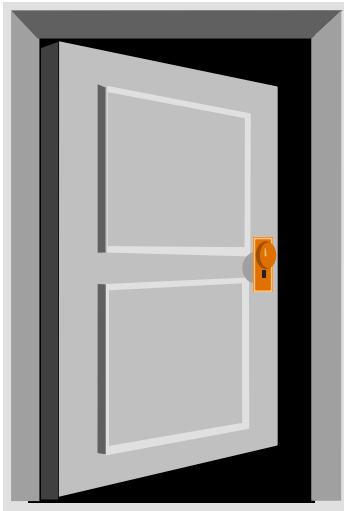
funding law,

patent law

---

# Agreements in R&D and Technology Transfer: Best Practices and Model Agreements

---



Dr. Lorenz Kaiser

**GAME OVER**