

CERN

European Organization for Nuclear Research

Organisation Européenne pour la Recherche Nucléaire

## RD51 collaboration meeting

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## MoU section on Intellectual Property

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# Managing IP in R&D collaborations

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*Defining **access** to pre-existing IP (so called background IP) in the framework of the collaboration*

*Defining **access** to results (so-called foreground IP)*

*Defining the principles for IP **ownership***

*Clarifying rules for the **dissemination** of results*

*Defining the mechanisms for the **exploitation** of jointly owned results:*

- who take the lead to protect?
- how the revenues from commercial exploitation will be shared?
- what kind of agreement are needed? who will draft the contracts?



# Principles (proposed at the Nikhef workshop)

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## *Declaration of background IPR*

The members of the collaboration declare what background IPR they make accessible to the collaboration and the possible limitations.

## *Free **access** for research*

The members of the collaboration give to all members of the collaboration a royalty-free, non-transferable, non-exclusive right to use declared background IPR and foreground IPR for research purpose and for use in high energy physics, nuclear physics and astroparticle physics experiments.

## ***Ownership** of foreground IP*

IP owned by the party generating it.

## ***Dissemination and exploitation** of results*

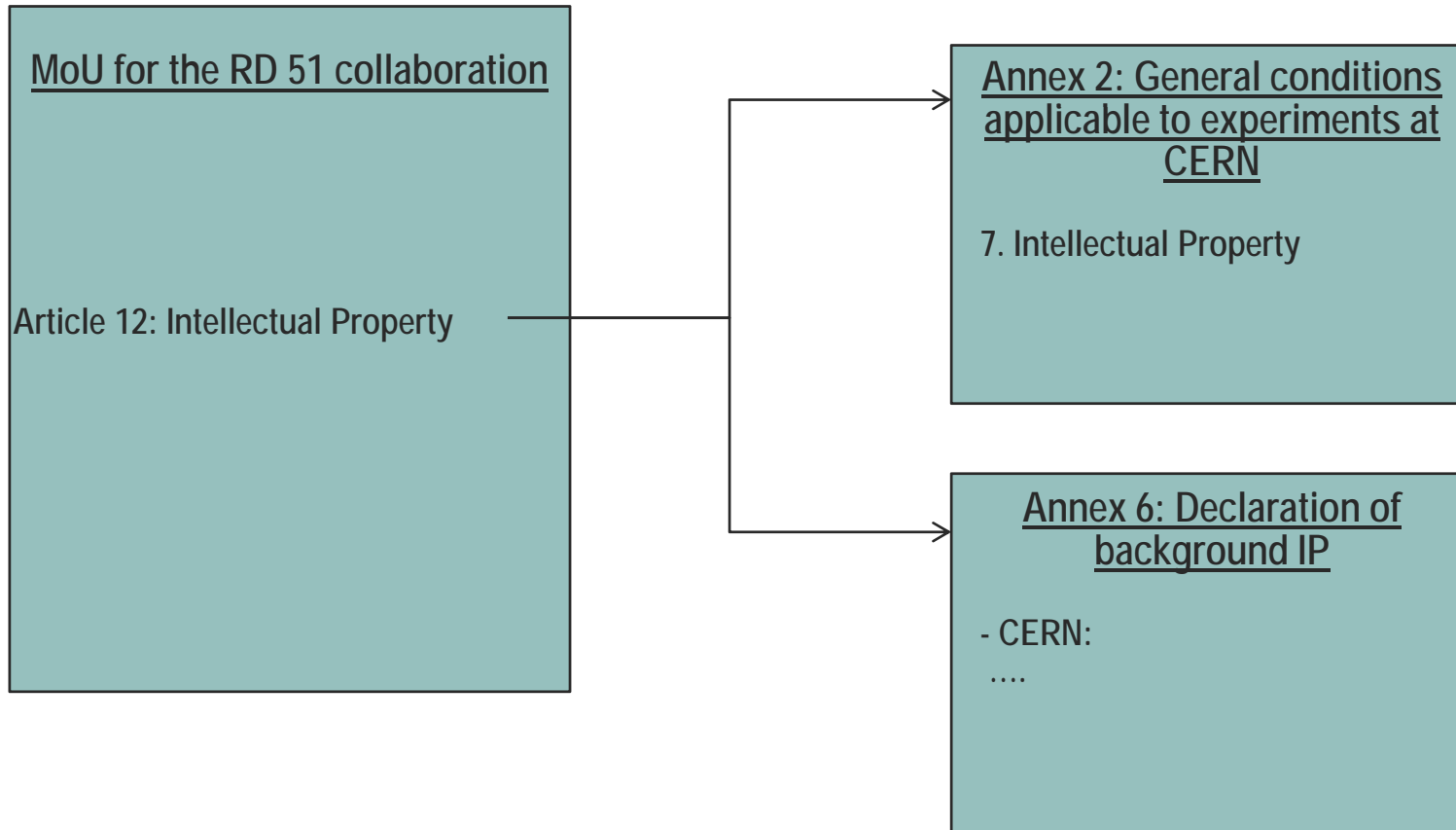
Results published in reviewed journals and presented to conferences referring to the authors of the collaborating institutes.

The parties owning the foreground IP make the decision to protect it or not.



# RD 51 MoU structure

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# Annex 2: General conditions applicable to experiments at CERN

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## *Publication and use of data and knowledge*

- [...] The Collaborating Institutions shall strive to publish [...] through Open Access journals [...]

## *Contribution of proprietary information*

- A Collaborating Institution contributing proprietary information to the Collaboration shall ensure that it has [...] the rights to use, and to contribute to the Collaboration for use by the other Collaborating Institutions, such proprietary information for the execution of the Experiment.[...]

## *Use of proprietary information*

- The contribution by a Collaborating Institution of any proprietary information, including information protected by trademark, patent or copyright, [...] a free, irrevocable and non-exclusive licence to use such information in the execution of the Experiment.

## *Publication and disclosure of proprietary information*

- [...] the Collaborating Institutions shall strive to publish and make publicly available all proprietary information contributed to the Collaboration. In particular, they shall consider making any software available under Open Source licence conditions.

## *Limitation of liability*

Dissemination

Access



# MoU Article 12

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Each Party shall, prior to entering into this MoU, identify to the best of its knowledge at the time, the protected intellectual property (“IP”) it owns and contributes to the Collaboration for the execution of the RD-51 programme, and list such IP in Annex 6 together with any applicable restrictions. [...] **Declaration of and access to background IP**

Any IP developed in the execution of the RD-51 programme (“Foreground IP”) shall belong to the Party having generated such Foreground IP. Such Party shall be free to protect and/or exploit the same at its own cost and risk, subject always to the provisions of this MoU.

## **Ownership and exploitation**

In case Foreground IP has been generated by more than one Party, and either their respective share of the Foreground IP cannot be distinguished, or cannot be dissociated for the purpose of its protection, such Foreground IP shall be owned jointly by the Parties having generated it [...] **Ownership**

The conditions of access to IP of a Party for the purpose of executing the RD-51 programme are set out in Annex 2. Access for all other uses, including but not limited to commercial exploitation, shall be the subject of a separate written agreement involving the Parties concerned. **Access and exploitation**

Any publication by a Party relating to the execution and results of the RD-51 programme shall acknowledge the contribution of the other Parties.



# Annex 6: Declaration of background IP

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## CERN IP to be contributed to the RD51 Collaboration:

(1) The first 'patent family' covers the use of GEM foils as gas detectors. In the US, 2 patents have been granted: US6198798 (Planispherical parallax-free X-ray imager based on the gas electron multiplier) and US6011265 (Radiation Detector of very high performance). A PCT application has been filed, and is now being examined at the national level.

Furthermore, the use of GEM foils as gas detectors is also covered by a patent owned by CNRS (the CAT patent). CERN and CNRS have concluded an agreement in 2006, whereby CERN has obtained a sub-licensable license for the CAT technology. Under this agreement, CERN can manufacture and sell GEM foils with attached licenses covering both the GEM and the CAT patents.

Applicable restriction: no exploitation of the GEM technology can be carried out in the field of 'dosimetry in water phantom'.

(2) A second 'patent family' covers part of the method implemented by CERN for manufacturing GEM foils (MCML patent WO03055288: Method for making a multilayer module with high-density printed circuits).

Applicable restriction: no use of this method may be made in Poland.

(3) CERN is also considering filing a patent concerning the manufacture of large area GEM foils. This could be relevant for both the RD-51 programme and for the exploitation of the Collaboration's results.



# Summary

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## *Declaration of background IPR*

The members of the collaboration declare what background IPR they make accessible to the collaboration and the possible limitations.

*MoU Art12, Annex 6*

## *Free access for research*

The members of the collaboration give to all members of the collaboration a royalty-free, non-transferable, non-exclusive right to use declared background IPR and foreground IPR for research purpose and for use in high energy physics, nuclear physics and astroparticle physics experiments.

*Annex 2 (“General cond...”)*

*Access in the framework of the collaboration only!*

## *Ownership of foreground IP*

IP owned by the party generating it.

*MoU Art12*

## *Dissemination and exploitation of results*

Results published in reviewed journals and presented to conferences referring to the authors of the collaborating institutes.

*MoU Art12*

The parties owning the foreground IP make the decision to protect it or not.

