



**European Academy**  
for Taxes, Economics & Law

# IP Management in European Research Co-operations

European Conference  
7<sup>th</sup> and 8<sup>th</sup> September 2009, Berlin

Brochure

# EUROPEAN CONFERENCE

## IP Management in European Research Co-operations

### BACKGROUND

In light of the Commission's objective to raise European investment in research towards 3% of GDP, the funding of, investment in and focus on industry-university relations has increased significantly. The possibilities for transnational and international cooperation between enterprises, SMEs, universities, research institutions and clusters have widened, but so has the potential for patent piracy.

Intellectual Property has become increasingly important. A for Europe typical fragmentation of the Knowledge Triangle (Higher Education, Research, Business-Innovation) has led to the outflow of knowledge. Linking businesses, research institutions and universities and furthering their cooperation is seen as a remedy for loosing IP as well as boosting European innovation.

With programmes such as the FP7 or CIP the Commission intends to elevate innovation and make Europe a more innovative and creative place. But for many research projects the participants still decide to make do without EU funding due to the administrative burden involved and seek out alternative means of financial support. These R&D cooperations depend on individual agreements, meaning there are no structured programmes involved. This can and often does lead to difficulties, especially with respect to intellectual property. In order to try and avoid conflicts between collaborating parties as well as trying to protect and secure intellectual property, individual research consortia have come up with a number of different models for cooperation (e.g. model collaborative agreement by the German Ministry of the Economy, the Lambert Toolkit for Collaborative Research, Berliner Vertrag, EU model agreements). However, they are only guidelines for collaborations in R&D. Clear strategies behind formulating agreements are necessary to avoid later financial risk or loss of intellectual property, protect research results and preserve their economic value and impact on European competitiveness.

### CONFERENCE CONTENT

This conference provides organisations in the research sector with a detailed overview of the various Intellectual Property issues involved in innovation through cooperation. Attendees learn about different models, such as the Lambert Tool Kit for Collaborative Research and the DESCA-Consortium Agreement, but also about new initiatives such as the IP Charter and the European Institute of Innovation and Technology (EIT). The conference highlights strategies for cooperation outside the scope of model agreements and support programmes, and also deals with the possibilities available for arbitration and mediation for cases where disputes arise. Further, it shows how to secure IP and face international challenges. It presents issues of the current European patent system and how to deal with them.

### YOUR BENEFIT

- Obtain knowledge of how to secure IP, its exploitation and management
- Acquire knowledge about the management of IP in KT activities, the exploitation of science research potential for economic development and the new European Research Area
- Learn about alternative dispute resolution – arbitration and mediation.
- Understand how different model agreements deal with IP
- Benefit from best practice reports and case-related presentations (“use in practice”)
- Learn about the impact of IP on different forms of cooperation in R&D and become acquainted with the latest developments.
- Profit from international exchange of knowledge and expertise, compare experiences.

### TEACHING METHODS

- Lectures and case studies
- Discussions and Q&A- sessions
- Best practice reports
- Rich course material

### TARGET GROUP

Public/governmental services, research institutions at international, national, regional and local level, enterprises with an interest in research and innovation:

- Ministries for Research and Technology
- Intellectual Property and Patent Agencies and Business Development Agencies
- Mature and Spin-Off Companies
  - Actively involved in research cooperations
  - Dealing with intellectual property issues
- Departments for
  - Innovation, R&D, Product Development
  - Patents and Licensing
  - Business Development
- Law firms and consultancy companies specialised in intellectual property

And others wishing to improve their knowledge of this area

# SPEAKERS

## IP Management in European Research Co-operations



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**PROF. DR. ARNO BASEDOW,  
MANAGING DIRECTOR TECHNOLOGIE-LIZENZ-BÜRO (TECHNOLOGY LICENSING OFFICE), GERMANY**

Arno Basedow is Managing Director of Technologie-Lizenz-Büro (TLB) der Baden-Württembergischen Hochschulen GmbH. He is Adjunct Professor of chemical engineering at the University of Heidelberg and Chair-Elect of ProTon Europe. Previously he was involved as project manager at Fraunhofer-Patentstelle für die Deutsche Forschung (Patent Centre for German Research of Fraunhofer-Gesellschaft, München) and at N-transfer GmbH (Hannover).

He was Director Research and Development and authorised officer of Fine Chemicals Division at Merck KgaA (Darmstadt). Furthermore, he was Director Research and Development, Quality Management, Information, Documentation and Patents Management and authorised officer at Lohmann GmbH & Co. KG (Neuwied). Arno's activities cover physical chemistry, chemical engineering, pharmaceutical technology, drugs, food additives, fine chemicals, wound management, adhesive systems and patent management. He published more than 25 original articles mainly in the field of polymers and registered 12 patent families.

**GERRIT R. BORNEMANN,  
HELMHOLTZ-GEMEINSCHAFT, GERMANY**

Gerrit R. Bornemann completed his legal studies in Bonn, Caen (France) and Berlin and is a member of the German Bar Association. He obtained a Master Degree in Mediation and Conflict Resolution at the European University Viadrina, Frankfurt (O.). Since October 2008 he has been the co-coordinator of the DESCA Core-group. In the Brussels office of the Helmholtz-Association of German Research Centres he represents the interests of the Helmholtz-research centres with regard to administrative and legal questions on a European level and advises the research centres in legal and administrative matters concerning European funding schemes.

**BETTINA CARR-ALLINSON  
COUNSEL, DLA PIPER UK LLP, GERMANY**

Bettina Carr-Allinson is Counsel at the international law firm DLA Piper in Frankfurt, Germany and supports clients on all matters of IP, in particular on drafting and negotiating license agreements and litigation proceedings. She is a German lawyer by training. Prior to joining DLA, Bettina worked for Clifford Chance and for Motorola. She spent over seven years in the IP department of the law firm Clifford and Chance, where she advised clients on a substantial number of M&A and banking transactions. From 2006 to 2009 Bettina was Senior IP Counsel EMEA at Motorola and in this capacity was responsible for supporting all businesses on all IP related matters in the region. She inter alia provided legal support to the regional research organization and drafted and negotiated a substantial number of cooperation agreements on national and European level.

**DR. OLIVIER EULAERTS  
LICENSING MANAGER, UNIT IP AND SCIENTIFIC-COLLABORATION, DG JOINT RESEARCH CENTRE,  
EUROPEAN COMMISSION**

Holding a PhD in chemistry and an MBA, Olivier Eulaerts is working in the promotion, management and exploitation of research since 2003. His current employment at the Joint Research Centre of the European Commission has provided him with a broad experience in transferring technologies both from the practical and policy point of view. A thorough grounding for this was gained in previous positions in the private sector and in the University of Liège. There he concentrated on research income maximisation and participate to the creation and management of spin-off companies.

**CHRISTOPHER JOHN HULL,  
SECRETARY GENERAL, EARTO**

During the past 20 years Christopher John Hull has specialised in European innovation, technology transfer and R&D policies. He has worked, inter alia, as an expert for the European Commission and served as Secretary General of three European trade associations in these areas: TII, FEI-CRO, and now EARTO.

In an earlier career (1974-1986) he worked on the design and evaluation of public programmes in the fields of regional economic development, employment, and small firms. He has recently been Chairman of DG Research's Expert Advisory Group on SMEs and a member of Commissioner Potočnik's Sounding Board for Smaller Framework Programme Actors.

# SPEAKERS

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## IP Management in European Research Co-operations

**DR. LORENZ KAISER,  
DIVISION DIRECTOR FOR LEGAL AFFAIRS AND CONTRACTS, FRAUNHOFER-GESELLSCHAFT, GERMANY**

Dr. Lorenz Kaiser is Division Director for legal and contractual affairs at Fraunhofer Gesellschaft. He is responsible for the departments „Law“, „R&D Contracts“ and „Public Sponsoring“ rendering centralized services for the 57 Fraunhofer Institutes. He is specialized in the development of models for research cooperations, negotiations and contractual solutions, which includes also the transfer of knowledge through spin-Offs from Research facilities. Dr. Kaiser has 25 years experience in negotiating research contracts with industry and is member of several national and international expert groups for Research funding and IPR-questions. Dr. Kaiser engages also in private practice as attorney at law in his specialization. He is especially giving lectures and seminars in the field of research contracts.

Special fields:

- contracting in research and development
- civil law - contract law
- legal questions of funding regulations
- EU-law relating research and development
- seminars and lectures

**KEVIN NACHTRAB,  
SENIOR PATENT ATTORNEY, JOHNSON & JOHNSON**

Kevin Nachtrab is a Vice-President of LES International and a Senior Patent Attorney for Johnson & Johnson, responsible for European IP Litigation and Licensing in the pharmaceutical sector. Previously, he has served as the Director of Licensing & Technology for Innogenetics N.V. (2000-2006), Global Head of the Chemical & Life Sciences Patent Units of Solvay S.A. (1993-1999) and Resident Managing Attorney of the Brussels, Belgium office of the Law offices of Leonard Bloom (1987-1993). Registered as a Patent Attorney before the United States Patent and Trademark Office, he has extensive experience before both the European and United States Patent Offices, as well as in technology transactional matters and litigation on an international level. Mr. Nachtrab is a member of the Bars of the State of Maryland (U.S.A.), the United States District Court for the State of Maryland (U.S.A.), the United States Court of Appeals for the 4th Circuit, the United States Tax Court and the United States Bankruptcy Court.

**DR. DOUGLAS ROBERTSON,  
DIRECTOR OF BUSINESS DEVELOPMENT AND REGIONAL AFFAIRS, UNIVERSITY OF NEWCASTLE UPON TYNE,  
UNITED KINGDOM**

As Director of Business Development at Newcastle University Douglas oversees the contractual and financial aspects of all externally funded projects across research, consultancy, technology transfer and teaching. The total project portfolio runs at around 110m Euro per annum. The University has a substantial EU Framework portfolio with over 150 projects involving 1700 partners. Over the last 25 years he has have worked in research and technology transfer at the universities of Leeds, Strathclyde, Nottingham and Newcastle. He is a board member of UNICO which services Technology transfer community in the UK and a board member of Praxis which has delivered TT training to over 1700 delegates.

# SPEAKERS

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## IP Management in European Research Co-operations



Europäische Akademie  
für Steuern, Wirtschaft & Recht

### **BRIAN MCCAUL**

#### **DIRECTOR OF COMMERCIALISATION, ENTERPRISE & INNOVATION OFFICE, UNIVERSITY OF LEEDS, UNITED KINGDOM**

Brian McCaul has been involved in knowledge transfer for the best part of 20 years – working at a wide range of universities, spanning the whole spectrum of knowledge transfer roles. Early roles included heading-up research support units, from which he then moved into business development and following that establishing an ICT spinout institute. Along the way Brian has been a contributor to research programmes on innovation. He is currently Director of Commercialisation at the University of Leeds, where he has overall responsibility for commercial KT activity – including all spinout, licensing and portfolio management. Through his company creation activity Brian has board experience on a diverse range of companies, often also taking on the role of Company Secretary, being a qualified Chartered Secretary. He also holds advanced legal certificates in Intellectual Property Law, Company Law, Employment Law and Applied Contract law from the University of Bristol and a first degree from the University of Sheffield.

### **JUDITH SCHALLNAU,**

#### **LEGAL STAFF, WIPO ARBITRATION AND MEDIATION CENTER, WORLD INTELLECTUAL PROPERTY ORGANIZATION, GENEVA**

Judith Schallnau is a lawyer from Germany specialized in intellectual property law. In addition to her German qualifications, she holds a master's degree from the College of Europe in Bruges. Before joining WIPO in 2008, she worked in her home country, most recently in the public sector on cross-border technology transfer.

### **TANJA SCHÖPKE, LEGAL COUNSEL, FRAUNHOFER-GESELLSCHAFT, GERMANY**

Tanja Schöpke studied law in Berlin and Bordeaux (France) and is member of the German Bar Association. She recently obtained her Master of Business Administration (MBA) from TiasNimbas Business School in Utrecht, Netherlands. Tanja has been working for Fraunhofer headquarters in Munich since August 2003 where she is responsible for the legal administration of national and international funded research projects with expertise in EU funding. She has joined the DESCA group during its start-up phase and has been the group's co-ordinator since May 2008. Tanja is currently working on an expert paper for the European Commission regarding options for European-wide model agreements for collaborative research.

### **KLAUS UCKEL,**

#### **HEAD OF DIVISION, FEDERAL MINISTRY OF EDUCATION AND RESEARCH (BMBF), GERMANY**

Klaus Uckel became a fully qualified lawyer and attorney for Labour and Social Law in 1990. In 1991 he joined the Ministry of Defence as desk officer in the Department for Economical and Social Affairs and occupied during 1993-2002 various positions as Assistant Head of Division in different directorate-generals of the Federal Ministry of Education and Research, namely: European and International Cooperation, Central Services (Budget and Organization), Lifelong Learning. He was in charge of redrafting the German rules for better Innovation (1997-1998) concerning IP-Policy in research programmes of the Federal Government. He was dealing with the preparation of FP 6 and the rules of participation before he became Director for the directorate-general Lifelong learning from 2002 until the end of 2005. Since October 2005, Mr Uckel has been Director for EU-Research Policy and EUREKA and is the central coordinator for EU-Research Policy in the Federal Government and counterpart of the Federal Council. In this function he was also in charge of the preparation of the German EU-Presidency especially concerning the content on Research, such as the IP-Charta, EIT and Structural Funds.

# PROGRAMME DAY 1

## IP Management in European Research Co-operations

7<sup>th</sup> September 2009

8.00-9.00

Registration and handout of conference documents

9.00-9.05

Opening remarks from the European Academy for Taxes, Economics & Law

9.05-9.15

**Welcome Note from the Chair:**  
**Dr. Lorenz Kaiser, Division Director for Legal Affairs and Contracts, Fraunhofer Gesellschaft, Germany**

9.15-9.55

**Managing IP at the European Commission – a perspective from the Joint Research Centre**

- Knowledge/Technology transfer
- IP issues within joint R&D collaborations
- KT initiatives at EC level
- A successful example from JRC

**Dr. Olivier Eulaerts, Licensing Manager Unit IP and Scientific-Collaboration, DG Joint Research Centre, European Commission**

9.55-10.10

Q&A

10.10-10.50

**International Challenges for European Research Cooperations**

- Knowledge Sharing in the ERA
- Exploitation of the Research Potential of Science for Economic Development
- Building Successful Partnerships, Innovation through Cooperation
- The New European Research Area, the European Institute of Innovation and Technology
- Patent Piracy, Improvement to the Patent System in Europe

**Prof. Dr. Arno Basedow, Managing Director Technologie-Lizenz-Büro (Technology Licensing Office), Germany**

10.50-11.00

Q&A

11.00-11.30

Coffee Break

11.30-12.10

**The European IP-Charta Initiative and the Communication on Knowledge Transfer - Better Management of IP in Universities, Research Centers and Industry**

- How to achieve better knowledge transfer between universities, research centers and industry
- Professional KT as a key factor of global competitiveness
- The international dimension
- Knowledge about IP frameworks as an important success factor in international collaborations
- Political dimension of the European IP-Charta

**Klaus Uckel, Head of Division, Federal Ministry of Education and Research (BMBF), Germany**

12.10-12.20

Q&A

12.20-14.00

Lunch Break

14.00-14.45

**IP Handling in M&A Transactions**

- Importance of intellectual property assets in M&A transactions
- Due diligence process (structure of the transaction, IP portfolio review, exclusivity)
- Considerations for the contractual framework

**Bettina Carr-Allinson, Counsel, DLA Piper UK LLP, Germany**

14.45-15.00

Q&A

15.00-15.30

Coffee Break

15.30-16.30

**IP challenges in Strategic Alliances, Joint Ventures and other R&D Projects**

- IP in the preparation phase of R&D projects
- Impact of IP in different forms of cooperation in R&D
- Challenges of strategic alliances and joint ventures
- Risks of Know-how loss, i.e. revised Patent law in China

**Dr. Lorenz Kaiser, Division Director for Legal Affairs and Contracts, Fraunhofer Gesellschaft, Germany**

16.30-17.00

Q&A

17:00

End of day one



## PROGRAMME DAY 2

### IP Management in European Research Co-operations

8<sup>th</sup> September 2009

9:00-9:05

**Welcome Note from the Chair:**  
**Dr. Robertson, Director of Business Development and Regional Affairs, University of Newcastle upon Tyne, United Kingdom**

9:05-9:45

**IP Management in the European Institute of Innovation and Technology**

- IP management in a decentralised structure
- IP as a legal issue
- IP as a business issue
- Central vs. decentral solutions
- Central guidelines
- Decentral flexibility

**Christopher John Hull, Secretary General, EARTO**

9:45-10:00

Q&A

10:00-10:45

**What do large Multinational Companies, particularly large Pharmaceutical Companies, wish to see in Prospective in-licensing Opportunities?**

- Pre-licensing issues: The due diligence process
- Licensing issues: How does IP due diligences translate in the licensing process
- Post-licensing issues

**Kevin Nachtrab, Senior Patent Attorney, Johnson & Johnson**

10:45-11:00

Q&A

11:00-11:30

Coffee Break

11:30-12:15

**Spin-out Companies – the right Model for Commercialising University Research?**

- An overview of the history of university spin-out company activity in the UK
- The challenges of spin-out company development
- Issues relating to intellectual property rights and spin-outs companies
- Spin-out companies in an economic development context
- Spin-outs and licensing in the context of open innovation and EU framework programmes

**Dr. Robertson, Director of Business Development and Regional Affairs, University of Newcastle upon Tyne, United Kingdom**

12:15-12:30

Q&A

12:30-14:00

Lunch Break

14:00-14:30

**Alternative Dispute Resolution in Research and Development Collaborations**

- Introduction to WIPO arbitration, mediation and expert determination services
- Potential benefits of using such services, in particular for research collaborations
- Costs, procedure, timescale
- Types of cases we have administered with specific focus on R&D and technology transfer
- WIPO recommended clauses

**Judith Schallnau, Legal Staff, WIPO Arbitration and Mediation Center, World Intellectual Property Organization, Geneva**

14:30-14:45

Q&A

14:45-15:15

Coffee Break

15:15-15:45

**The Lambert Tool Kit – The Rationale for the IP Provisions in the Lambert Model Agreements**

- The origins / rationale for Lambert
- The IP framework from other 'IP protocols'
- The Process of Developing the Toolkit and Team
- The Components
- The Impact and Feedback in use
- The Future

**Brian McCaul, Director of Commercialisation Enterprise & Innovation Office University of Leeds, United Kingdom**

15:45-16:00

Q&A

16:00-16:45

**The DESCA Consortium Agreement**

- Selection and use of model-agreements in general
- FP7 IP-related rules and practice
- DESCA IPR provisions
- Comparison with other FP7 consortium agreement models
- Use in practice, controversial issues
- Critical success factors

**Gerrit R. Bornemann, Helmholtz-Gemeinschaft, Germany**

**Tanja Schöpke, Legal Counsel, Fraunhofer-Gesellschaft, Germany**

16:45-17:00

Q&A

17:00

End of conference and distribution of certificates

# ORGANISATIONAL MATTERS

## IP Management in European Research Co-operations

### BOOKING NUMBER

K-77

### DATE OF EVENT

7<sup>th</sup> and 8<sup>th</sup> September 2009

### EVENT LOCATION

Maritim Hotel Berlin  
Stauffenbergstraße 26  
10785 Berlin, Germany  
Phone: +49 (0)30 2065-0  
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E-mail: [info.ber@maritim.de](mailto:info.ber@maritim.de)  
Internet: [www.maritim.de](http://www.maritim.de)

Please contact the hotel directly and refer to the "European Academy for Taxes, Economics & Law" in order to benefit from a limited room contingent at a special price. Please book as soon as possible. Of course you can always look for an alternative hotel accommodation.

### EVENT LANGUAGE

The event language will be English.

### EVENT PRICE

**Early booking contingent until the 5<sup>th</sup> of June 2009:**

**899,- Euro, excl. German VAT (19%)**

Normal price from the 6<sup>th</sup> of June 2009:

949,- Euro, excl. German VAT (19%)

The above price covers the following:

- Entrance for the event day
- Hand-out documents
- Soft drinks and coffee/tea
- Lunch on both days

### BOOKING

Fax: +49 (0)30 802080-250

E-mail: [booking@euroacad.eu](mailto:booking@euroacad.eu)

Phone: +49 (0)30 802080-230

For online booking please visit our internet site under:

[www.euroacad.eu](http://www.euroacad.eu)

### YOUR CONTACT PERSON FOR THE PROGRAMME:

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(Program is subject to alterations)

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### CANCELLATION TERMS

Pre-payment of the fee is a condition for participation. The time of booking does not affect the cancellation regulations. Cancellations shall be in writing. For cancellations received four weeks prior to the event or earlier: a € 80,00 (excl. German VAT) administrative fee will be charged. The event fee will be reimbursed in full. For cancellations two to four weeks prior to the event the fee will be reimbursed at 50%, up to two weeks prior to the event or no-show: event fee will not be reimbursed. We reserve the right to change or cancel the event. In the event that the European Academy for Taxes, Economics & Law has to cancel or postpone an event, payments received will be reimbursed in full. We herewith inform you that we exclude the liability for any damages in connection with the event. Personal data provided by attendees (name, company/organisation) will be used during the organisation of the event and distributed to other attendees. With your signature, you agree that we can contact you by fax, email or telephone and that we can use and distribute the provided data in professional terms. If you do not agree, please delete the respective part(s) of the sentence(s) or contact us. You can withdraw your agreement at any point in time. This agreement shall be governed by German law, the courts of Berlin shall have exclusive jurisdiction.

**NOTE**

Please note, you can register as many delegates as you wish (except, the conference is fully booked). You only need to copy this formular for as many persons you wish.



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for Taxes, Economics & Law

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# BOOKING

BOOKING NUMBER: K-77(KB)

DATE: 7<sup>TH</sup> - 8<sup>TH</sup> SEPTEMBER 2009

Herewith we register the following persons for the European Conference: "IP Management in European Research Co-operations":

**Delegate 1**
 Mr.  Ms.

First name \_\_\_\_\_ Last name \_\_\_\_\_ Phone \_\_\_\_\_  
 Department \_\_\_\_\_ Fax \_\_\_\_\_  
 Job position \_\_\_\_\_ E-mail \_\_\_\_\_  
 Your organisation \_\_\_\_\_  
 Street \_\_\_\_\_  
 Postcode / City \_\_\_\_\_  
 Country \_\_\_\_\_

**Delegate 2**
 Mr.  Ms.

First name \_\_\_\_\_ Last name \_\_\_\_\_ Phone \_\_\_\_\_  
 Department \_\_\_\_\_ Fax \_\_\_\_\_  
 Job position \_\_\_\_\_ E-mail \_\_\_\_\_  
 Your organisation \_\_\_\_\_  
 Street \_\_\_\_\_  
 Postcode / City \_\_\_\_\_  
 Country \_\_\_\_\_

**Delegate 3**
 Mr.  Ms.

First name \_\_\_\_\_ Last name \_\_\_\_\_ Phone \_\_\_\_\_  
 Department \_\_\_\_\_ Fax \_\_\_\_\_  
 Job position \_\_\_\_\_ E-mail \_\_\_\_\_  
 Your organisation \_\_\_\_\_  
 Street \_\_\_\_\_  
 Postcode / City \_\_\_\_\_  
 Country \_\_\_\_\_

**Invoice organisation**

To the attention of \_\_\_\_\_ Internal Number \_\_\_\_\_  
 Street \_\_\_\_\_ Phone \_\_\_\_\_  
 Postcode / City \_\_\_\_\_ Fax \_\_\_\_\_  
 Country \_\_\_\_\_ E-mail \_\_\_\_\_

In case of registration of more than one delegate - do you prefer:  single invoice?  collective invoice?

\_\_\_\_\_  
Place, Date

\_\_\_\_\_  
Authorised Signature / Stamp