

Contracts on ownership: Main issues and pitfalls

Senior Consultant Anette Poulsen Miltoft,
The Legal Team for Research and IP

UNIVERSITY OF COPENHAGEN



Contracts on ownership: Main issues and pitfalls

- Under what circumstances do academics and/or the university hold ownership (and to what)?
- Under what circumstances may academics agree to secrecy obligations?
- Main points and details in contracts on research collaborations

The Danish legal framework – patentable inventions

Act no. 210 of 17 March 2009 Consolidating Act on inventions at public-sector research institutions - [final-lov-om-opfindelser-ved-offentlige-forskningsinstitutioner-eng.pdf](#)

Purpose:

..to ensure that research outcomes generated using public funding are exploited commercially to the benefit of the Danish society.

Distribution of the right to inventions

§ 7 The right to **inventions made by an employee** of an institution shall belong to the employee with the restrictions following from this Act

§8.-(1) Where the employee has made an invention **as part of their work**, the institution shall be entitled to have the rights associated with the invention transferred to the institution

Distribution of the right to inventions

Section 11, (6) If the rights associated with an invention have been transferred to the institution with the purpose of commercial exploitation, cf. section 8, then the institution is also **obliged to take active steps to exploit the rights**.

Section 12, (1) If the right to an invention that has been transferred to the institution pursuant to section 8 is exploited commercially, the employee who made the invention shall be **entitled to fair payment from the institution**.

Legal framework - Software

Act on Copyright

Special Provisions on Computer Programs Produced in the Course of Employment

Section 59. Where a computer program is created by an employee in the execution of his duties or following the instructions given by his employer the copyright in such a computer program shall pass to the employer.

KU LIGHTHOUSE

UCPH Lighthouse – University of Copenhagen

Research collaborations with third parties – not covered by the act

Section 9. In situations involving collaboration projects with, or funded in full or in part by, a party that is not covered by this Act, the institution may on its own behalf and on the behalf of its employees and following prior agreement with the party in question waive its right in full or in part to the inventions created through the project.

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Under what circumstances may academics agree to secrecy obligations?

Act on Inventions section 10 (3) The employee may not publish or utilize an invention before the institution has confirmed in writing its receipt of the notification mentioned in subsection (1). The institution shall send said confirmation as soon as possible.

Section 11 (2) In conjunction with its confirmation pursuant to section 10(3), the institution may order the employee not to publish or utilize an invention for up to two months from receipt of the notification [of the invention].

Confidentiality and secrecy obligations in research collaborations

Relevant in two different situations:

- 1) Third party confidential information
- 2) Results from research projects

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- 1) Third party confidential information – Background Knowledge
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Relevant in two different situations:

- 1) Third party confidential information – Background Knowledge – **YES**
- 2) Results from research projects – Foreground Knowledge - **NO**

Definition of Confidential Information

Any Background Knowledge, not comprised by the agreed exceptions, Foreground Knowledge and any other information of a confidential nature including without limitation information in or relating to technical data, know-how, experience, techniques, Inventions, manufacturing processes, formulas, recipes, specifications, analyses, customer and pricing information and any other technical, commercial or financial information related to the businesses, products or research activities of a Party and disclosed in connection with the Project by either of the Parties and/or by its Associated Third Parties another Party and marked "Confidential" or the like or which is of obvious confidential nature for the receiving Party.

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Results from research projects

Foreground Knowledge: All information – including any data and/or results, regardless of form and regardless of whether it is or can be protected and intellectual property rights derived thereof, which originates from the Project and which is generated by an employee of one of the Parties.

Results from research projects – Foreground Knowledge

Each Party shall be entitled to publish its own Foreground Knowledge. Foreground Knowledge jointly owned by two or more Parties can be published jointly by those Parties, or, in the case that one or more of the Parties does not wish to participate in the publication, the remaining Party or Parties shall be entitled to publish said Foreground Knowledge on their own, such publication to be carried out in accordance with academic customs. Authorship shall follow the rules laid down in the Danish Code of Conduct for Research Integrity. Substantial contributions to the work shall always be disclosed accordingly whether or not a Party wishes to participate in the publication.

Results from research projects – Foreground Knowledge

Any Party who wishes to publish Foreground Knowledge generated under this Collaboration Agreement shall notify the other Parties at least thirty (30) days prior to the intended time of submission of such publication ("Notification Date") and forward a copy of such publication to the other Parties.

Within thirty (30) days from the Notification Date, the other Party can request 1) its own Confidential Information removed from the publication, or 2) that the publication is postponed by up to ninety (90) days from the Notification Date, provided that the postponement is important for that Party's prospects of acquiring intellectual property rights protection of the knowledge the other Party wishes to publish.

Irrespective of the above, the publishing Party alone shall decide the final wording and content of the publication.

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Main points and details in contracts on research collaborations

1. **List of definitions**
2. **Background and purpose**
3. **Performance and Financial Obligations**
4. **Governance - Organisation and Management**
5. **Human Material/GDPR – if relevant**
6. **Rights - ownership of Background and Foreground Knowledge**
7. **Transfer of Rights – option for license for commercial use**
8. **Reporting of inventions**
9. **Equipment**
10. **Assignment of Rights and Obligations**
11. **Confidentiality**
12. **Publication of Foreground Knowledge**
13. **Transparency**
14. **Termination and Breach**
15. **Liability**
16. **Duration of the project**
17. **Dispute resolution**
18. **Signatures**