Guidelines for IPR interest declaration and negotiation process for Communal Results made within a Programme Area of ProNova Stage II

BACKGROUND
As specified in the ProNova Main Agreement for Stage II, any Communal Results generated as a Result of the Scientific Programme activities within a certain Programme Area may be used by all Active Parties within the Programme Area in question [See Section 11.4 in the ProNova Main Agreement]. However, it should be negotiated between the Active Parties which Party shall step forward and become the formal owner of the patent application, and which other Active parties shall become licensees to the owning Party, and on which terms this shall apply.

In the following, some guidelines have been collected concerning how to proceed when Results appear which may be patentable and of value for the Parties of the Centre.

GUIDELINES
• When potentially patentable Results appear within a ProNova project, such Results should not be made public, for example by publishing or by poster or oral presentations, before IP right issues have been properly discussed with all Active Parties active in the same Programme Area. In these discussions, KTH Holding AB should be the Party representing individuals employed by KTH.

• To initiate these discussions, the inventor(s) shall in writing inform the ProNova Centre Management about the Results and their nature, typically via the submission of a draft scientific manuscript (see Figure 1). The ProNova Centre Management shall then use this information and contact all other Active Parties in the Programme Area in question, as well as KTH Holding AB, via their official contact persons and ask them to declare to the ProNova Centre Management their interest in the described Results (IPR) according to two answer alternatives (30 days notice. If no answer is received, it is interpreted as the Party is not interested):

(a) Interested to participate in discussions/negotiations concerning the exploitation of the invention, incl. submission of a possible patent application, IPR ownership and licensing issues, etc.
(b) Not interested in the invention (no reply needed)

• After the 30-days-notice period, the ProNova Centre Management will collect the responses from the Parties, and distribute the result of the interest declaration to all Parties in the Programme area in question. The Parties which have declared to be interested to participate in discussions/negotiations concerning the exploitation of the Results should then meet and discuss how to proceed with filings of patent applications, including responsibilities for both the writing of the applications and for the costs associated with their filing and maintenance. It should be noted that the “... publication may be delayed for a maximum of four months from the date when the draft was reported.” [See Section 9.4 in the ProNova Main Agreement], indicating that these negotiations, and the writing and submission of a potential patent application, should be completed within a time period of three months after the initial 30-days-notice period.
**ProNova IPR Guidelines**

### IPR Reporting and Interest Declaration

1. Inventor(s) informs the ProNova Management about the invention and its nature. KTH employed inventors shall also inform KTH Holding AB. Likewise, inventors from industrial Parties may according to company policies be obliged to internally inform their own organizations about the invention.

2. The ProNova management informs the official contact persons in all active Parties in the Programme Area in question, including KTH Holding AB, about the invention and its nature and asks them to declare to the ProNova Management their potential interest in the IPR (two answers alternatives, 30 days notice).

   **Answer alternatives from active Parties:**
   
   (a) Interested to participate in discussions/ negotiations concerning the exploitation of the invention, incl. submission of a possible patent application, IPR ownership and licensing issues, etc.
   
   (b) Not interested in the invention (no reply needed)

3. The ProNova management collects the answers and distributes the results to all active Parties in the Programme Area in question. Parties having declared an interest arrange a meeting.

**Figure 1.** Graph illustrating the process of reporting potentially patentable Results obtained within the ProNova Centre activities to the Centre Management and how the involved Parties within the same Programme Area shall respond to this information.

- A sole owning Party of the Results should preferably be assigned, such Party paying the major costs associated with the filing and maintenance of the patent application. Other Parties may acquire licenses to the Results, e.g. for particular Fields of use and on conditions to be negotiated (potentially including paying a certain fraction of the costs for filing and maintenance of the patent application). The commercial terms for exploitation of a granted patent in own businesses and/or for licensing purposes to a third party should be negotiated between the Parties. Inventors employed by KTH shall in these discussions be represented by KTH Holding AB.

**Figure 2.** Graph illustrating the results from a hypothetical negotiation between involved ProNova Centre Parties concerning agreements around IPR ownership, IPR licensing, patent application filing costs and compensation to inventors (in this case, KTH researchers represented by KTH Holding AB, a Party which in this example does not become licensee to exploit the invention on its own).