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# Session #4

Webinar

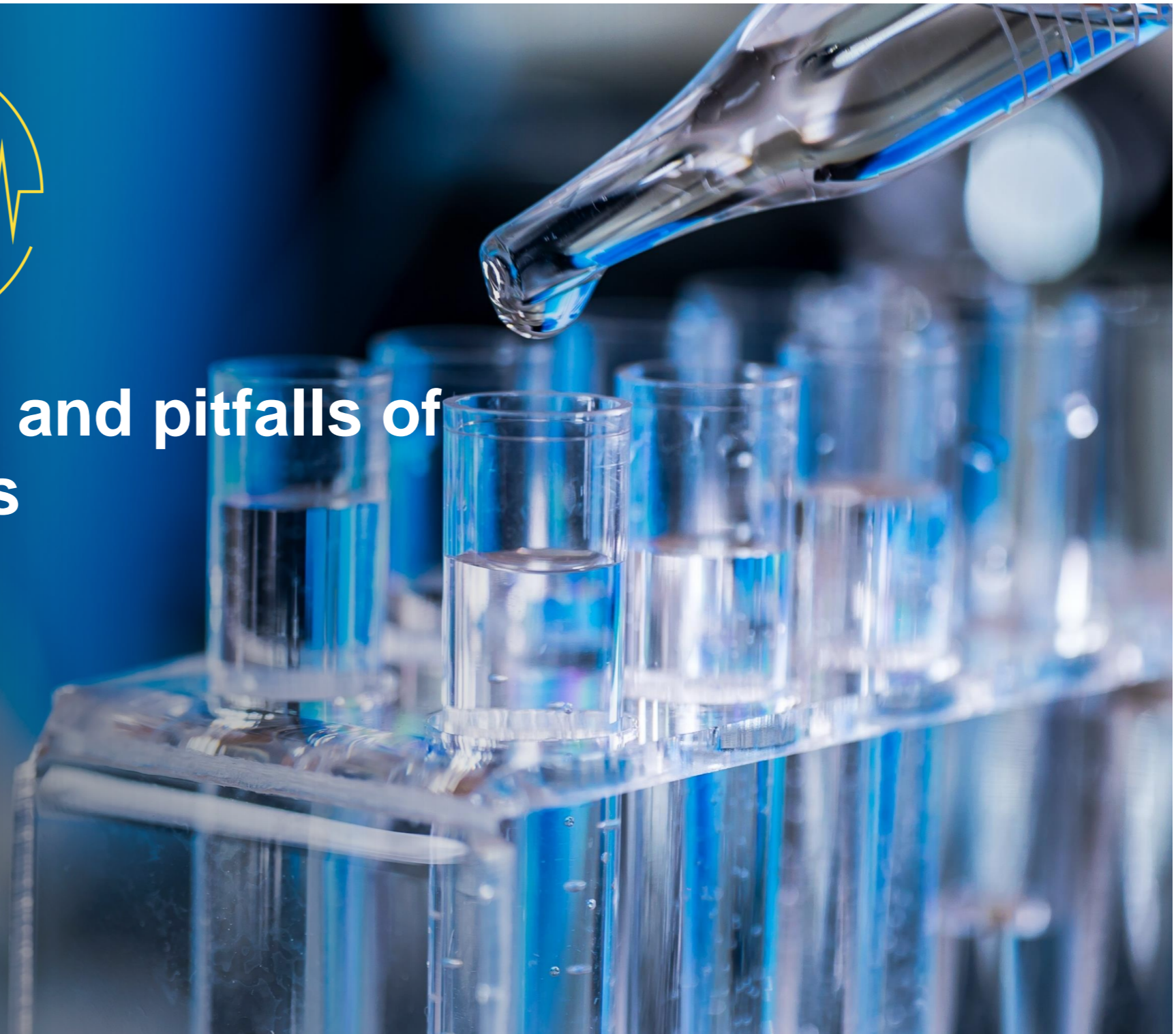
17 April 2024



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# Importance, set-up and pitfalls of R&D collaborations

14 April 2024 | Dr. Stefanie Greifeneder | Irina Rebin



# Agenda/ Hot Topics

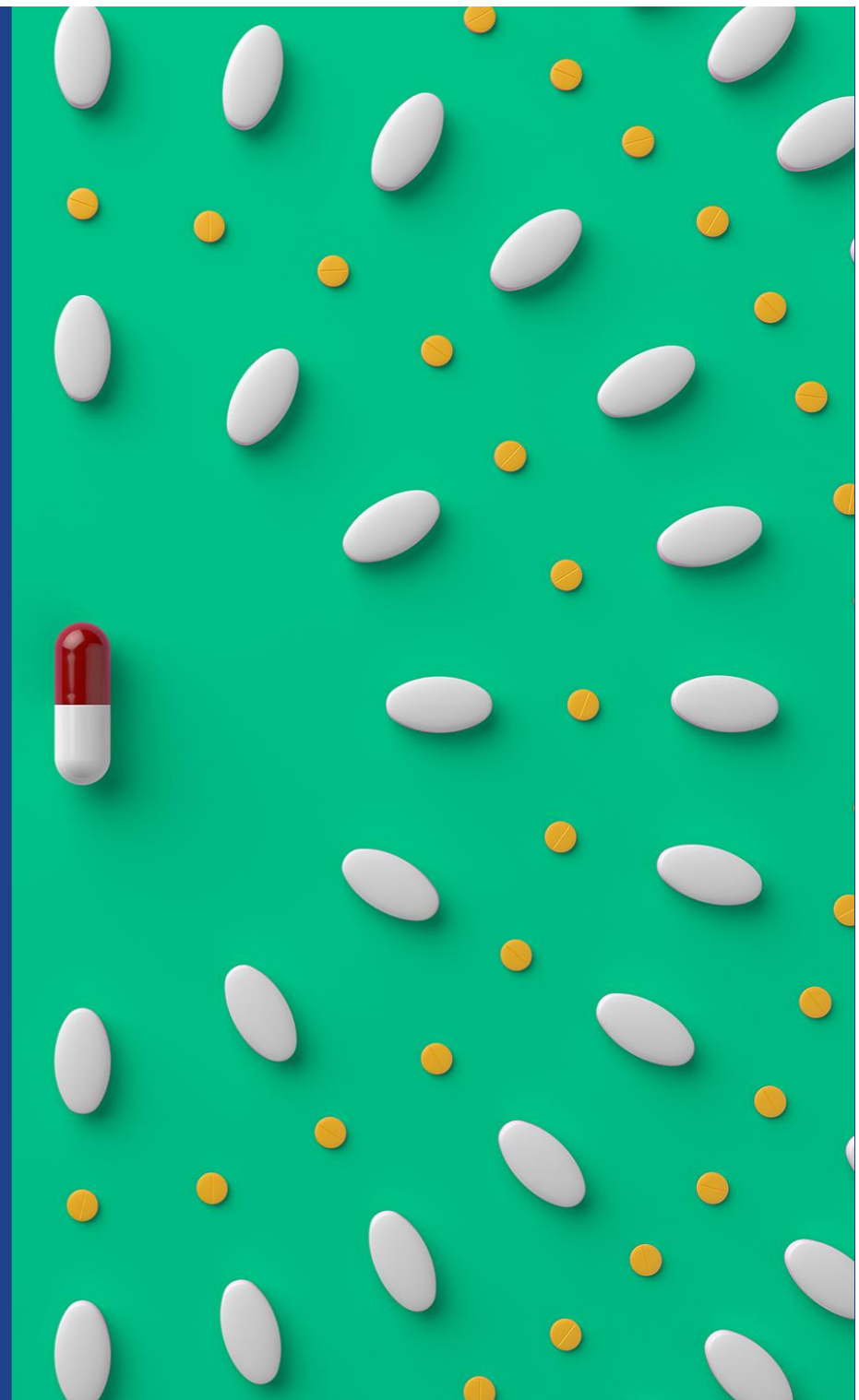
- 1 Why are R&D collaborations so important?
- 2 Different set-ups for R&D collaborations
- 3 Five most important tips and tricks for R&D collaboration agreements
- 4 Further important contractual clauses in R&D collaboration agreements
- 5 Conclusion





# 1. Why are R&D collaborations so important?

- Start-ups usually require R&D support from third parties, e.g. universities, other Life Sciences companies, service providers
- Access to IP provided under and allocation of IP generated during R&D collaborations must be ensured

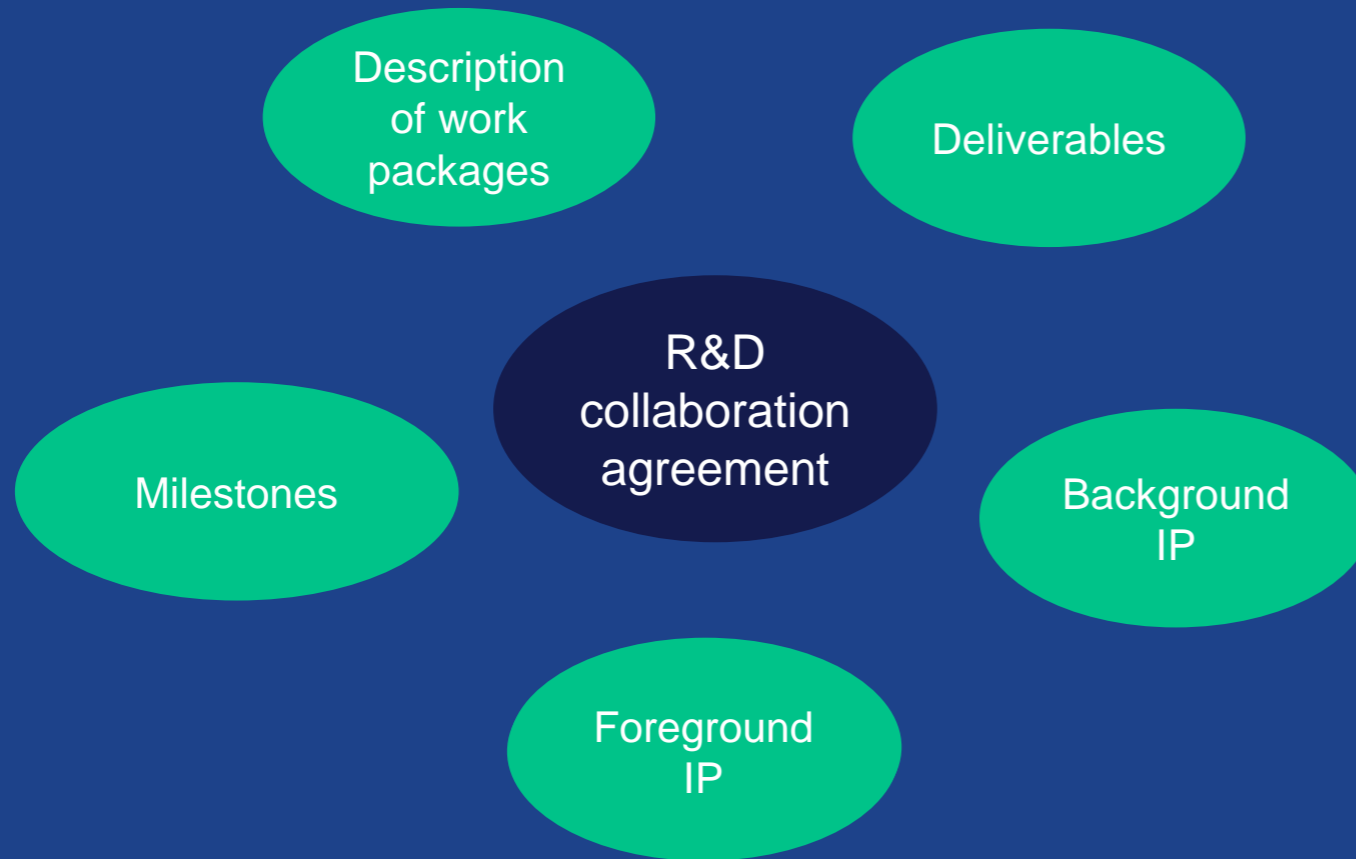


## 2. Different set-ups for R&D collaborations

- Fees for services (contract research)
  - ↔ “real” collaboration where both parties render services
- Framework agreement and work orders
  - ↔ single agreements
- Questions beforehand: CDA in place? Term sheets?
- Use of templates?



### 3. Five most important tips and tricks for R&D collaboration agreements





### 3. Five most important tips and tricks for R&D collaboration agreements

- **Work packages:**
  - Detailed description of work packages in the project plan.
- **Deliverables:**
  - Clear definition of deliverables
- **Milestones:**
  - Generally defined in a project plan attached to the R&D agreement.
  - Payment obligations to be linked to achievement of milestones.
  - Need of a Joint Steering Committee?



### 3. Five most important tips and tricks for R&D collaboration agreements

- **Background IP**
  - Define as precisely as possible both parties Background IP used within the collaboration.
  - Consider listing Background IP in an attachment.
  - Use of Background IP for purpose of commercialization after completion of Project: agreement on respective license.
- **Foreground IP:**
  - General rule: document throughout the collaboration what was contributed, especially by collecting and archiving:
    - all emails/chat correspondence,
    - meeting agendas and meeting minutes,
    - presented papers/slides, etc.
  - Allocation of Foreground IP obtained through use of Background IP and/or confidential information.
  - Clear definition of Foreground IP and results.





### 3. Five most important tips and tricks for R&D collaboration agreements

- **Foreground IP:**
  - Payments: covered by the budget agreed on vs. additional payments
  - German Employee Inventions Act – “*Arbeitnehmererfindungsgesetz*”
    - Obligation of employer to pay its employees for service inventions
    - Reimbursement: provisions in R&D agreement vs. separate agreement
    - Sec. 42 ArbNErfG: right not to disclose service inventions (“*negatives Publikationsrecht*”)
    - System in place for reporting service inventions and time frames for claiming service inventions
  - Publication of results: alignment vs. principal’s sole discretion
    - essential to prevent disclosure of inventions prior to patent application
    - detrimental to novelty
  - Back-licensing for contracting parties own research and teaching activities



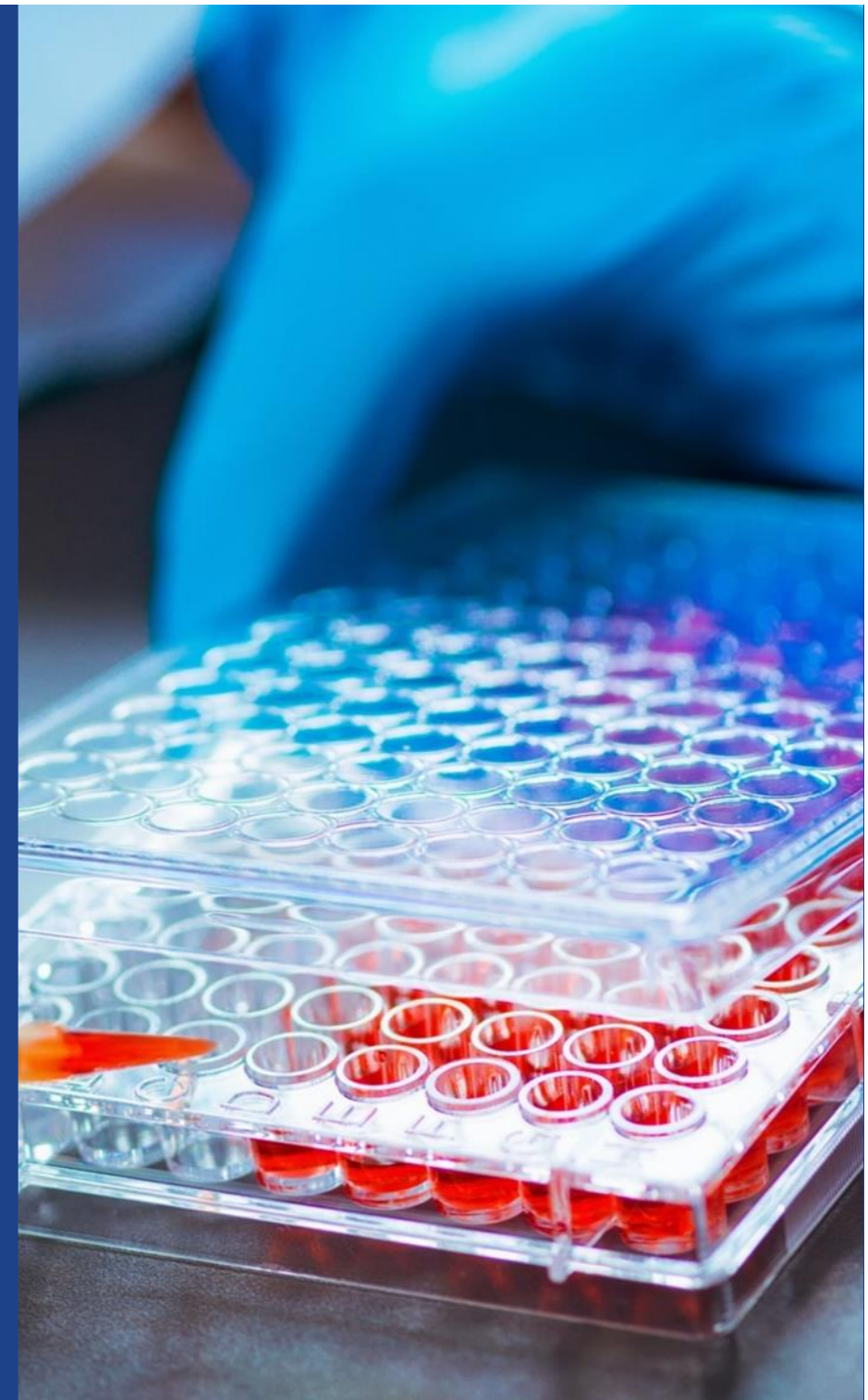
## 4. Further important clauses in R&D collaboration agreements

- Confidentiality (reference to CDA or own set of confidentiality provisions?)
- Governing law and place of jurisdiction:
  - Make a choice of law to define which law should apply with respect to the inventions made in the course of the collaboration, and a matching agreement on the place of jurisdiction.
  - Consider arbitration clause to resolve disputes (as company secrets may be involved).
- Subcontracting
- Term and termination
  - Consider impact on payment obligations (for services performed/non-cancellable costs)



## 5. Conclusion

- Scope of the R&D agreement depends on the intended collaboration (contract research vs. “real” collaboration)
- Clear definition of Background IP and allocation of Foreground IP essential!
- Confidentiality (and provisions on publications) to protect trade secrets and IP
- Provisions on payment (for work packages, achievement of milestones)





**Any questions?**



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