



Introduction to intellectual property rights in Public Procurement of Innovation

www.innovation-procurement.org

Supported by the



Contents

Introduction	3
Why consider Intellectual Property rights?	3
Background	4
Different types of Intellectual property rights	4
Ownership and sharing of Intellectual Property rights	5
Approaches to sharing IP rights	5
Royalties	6
When to consider sharing Intellectual Property rights?	6
Step by step guide for procurement officers	7
Step 1: Needs and Risk assessment	7
Step 2: Decide on the approach to take	7
Step 3: Work out terms and agreements (or use standard clauses)	8
Free non-exclusive licence	8
Exclusive licence	8
Open licence under payment of royalties	8
Legal framework	9
Example clauses	9
Example 1: Standard Public Private Partnership clause from Ireland	9
Example 2: CHARM-PCP, a regional approach	9
Example 3: Approaches outside of the EU	10
Appendix 1: CHARM-PCP	11
Appendix 2: ARVODI	13

Introduction

When procuring innovation, new findings, insights, and potentially new technology are possible - and indeed expected - outcomes. As a result, determining who owns the Intellectual Property (IP) Rights to these outcomes can be very important. If a public authority retains the intellectual property rights, the involved companies' incentive to innovate and search for new solutions can be too limited. It can also result in a public authority paying too much for intellectual property rights that it does not (or cannot) exploit. If a public authority leaves the intellectual property rights with the involved economic operator, vendor lock in looms: the authority is tied to the vendor for a specific service or product it has paid to develop.

This guide aims to introduce the subject of Intellectual Property Rights to public procurement officers, an important aspect when procuring innovation. The guide explains the kind of problems that careful consideration and management of intellectual property rights can prevent. Using real-life examples, the guide illustrates the different options for allocation of intellectual property rights and their respective advantages and risks. Finally, it provides an overview of applied approaches and corresponding sets of 'standard terms and conditions'. The relation between Standards and Intellectual Property Rights is excluded from this guide. More information on this topic can be found in the STEPPIN handbook¹

Why consider Intellectual Property rights?

When regular pencils are procured and delivered, it is clear to both buyer and supplier what the buyer will own: the pencils according to the agreed specifications. The purchasing public authority

would typically focus on spending as little effort as possible in the procurement process, and there is little worry from the supplier whether they should protect their intellectual property applied in the pencils, as similar pencils can easily be brought from another supplier. However, it is not always this easy when procuring innovations. The following two examples will clarify.

Vendor lock-in: *The impact of vendor lock-in is characterised by the following case. A local public authority prepares a tender for the replacement of the radar-module in a marine (vessel) traffic control system. This system consists of a radar-module, and an IT system featuring an application to show vehicle locations on screen. This IT system also manages the data-interface from the radar-module to the user application.*

In the original tender for this marine traffic control system, the contracting authority did not work out specific conditions with respect to ownership and administration of intellectual property rights. Although the public authority could claim ownership of intellectual property rights, there were no clear and complete specifications regarding the data—communication-interface between the radar-module and the rest of the system developed and delivered to the public authority.

So when preparing the tender for replacement of the radar-module, the public authority was not able to provide the required interface specifications necessary to integrate the radar within the existing marine vessel traffic control system. This resulted in the public authority being forced to involve the original supplier of the IT system to manage the integration. For the integration, this supplier charged a price that is equal to the budget for the entire tender. This resulted in a doubling of the estimated cost. The public authority decided to discontinue the tender process.

Although in this example the legal ownership of the intellectual property is not the core of the debate, the public authority did not possess the required knowledge. A requirement specifying a detailed description of the data—communication-interface in the initial tender might have prevented the public authority from depending entirely on the expertise of the original supplier.

¹ <http://www.steppin.eu/handbook/website.html>

Vendor back-out: To obtain an innovative yet cost-effective mobile traffic management system, the government of Austria, together with the Austrian motorway operator ASFINAG, chose a pre-commercial procurement approach in three phases. In the first phase, companies were invited to provide proposals. In the second phase five companies were to be selected for a feasibility study at € 50,000 each. In the third stage, two to three of the five companies would then be selected to develop a prototype at € 250,000 each. The final goal was to identify the best solutions for a mobile traffic management system, provide the specifications developed during the pre-commercial procurement to the market, and through a new tender select the best offer for the development of the final system.

During this approach, two out of the three companies selected to work out a prototype backed out due to the terms and agreements in the contract for development of the prototype, although they were already published when opening the call. They were not prepared to develop an innovative solution against the fixed price and consequently share the ownership of the design. In the end, the consortia ranked fourth for their feasibility study accepted the terms, so that two groups of experts started into phase three of the pre-commercial procurement to develop their ideas of a mobile traffic management system.

This second example illustrates how taking away ownership of intellectual property from the market removes the incentive to innovate. The public authority lost two out of the three most promising solutions because of the approach to make the best solution public and tender the final development².

The two examples clarify the need to consider how to handle Intellectual Property and the rights to intellectual property in public procurement of innovations. The next section provides background information from a legal perspective to the most relevant types of intellectual property rights.

Background

Modern Intellectual Property Rights are the result of the Renaissance, a period which saw an increased number of innovations developed. To protect the developers of these innovations, the idea of patents was conceived. However, there is more to Intellectual Property Law than patents.

By default, governmental contractors used to leave intellectual property rights with the contracted supplier, resulting in Vendor lock-in. In reaction, most public authorities decided to retain all intellectual property rights. This solved the previous problem but resulted in higher costs and less innovation. If the public authority retains intellectual property rights the supplier has less incentive to innovate, since it has no possibility to exploit the intellectual property rights with third parties. As a consequence a supplier will not invest its own resources and the authority pays for all of the necessary Research & Development.

Different types of Intellectual property rights

There are many different kinds of intellectual property rights. Though at first sight, they may not all seem equally relevant, public purchasers can come across any of these rights. The most common forms of intellectual property rights are:

- copyrights
- related rights or neighbouring rights
- patent rights
- trademarks/brands
- protection of company/trade secrets
- database rights
- design rights
- chip topography rights
- breeders rights
- portrait rights
- domain name rights

Of these different forms of intellectual property rights three types are most relevant in the public procurement

² In the eyes of the public authority, the two companies that did not agree to the terms for making the prototype should not have participated in the first place. This example is used to clarify the effect of limiting the IP rights of suppliers.

of innovation: patent rights, protection of trade secrets and copyrights.

A patent³ is a common method of legally protecting inventions (products or processes). In Europe it is regulated by European patent law. It is an exclusive right to make, use, import and sell an invention. It is granted for a limited time. A result of a patent is that the exact details of the invention are disclosed to the general public. An innovation can only be patented if it is new and non-obvious to an expert.

A more common method of intellectual property is trade secrets. The innovation is protected by keeping it a secret, which can be legally supported through a Non-Disclosure Agreement (NDA) between the public authority and the supplier. Trade secrets lend themselves specifically to processes that are applied in a 'closed' environment. Maybe the best known trade secret is the recipe for Coca Cola⁴. Trade secrets are not disclosed publically, and can last indefinitely, unlike patents which have an expiry date. Intellectual property rights provide the supplier with no additional protection once the information of the trade secret is uncovered, such as through the reverse engineering of an innovation.

A copyright⁵ gives the creator of an original work exclusive rights to it, usually for a limited time. Copyright may apply to a wide range of creative, intellectual, or artistic forms or "works". Copyright does not cover information and ideas themselves, only the form or manner in which they are expressed.

Ownership and sharing of Intellectual Property rights

The two extremes of ownership of intellectual property rights – ownership with the purchasing authority and ownership with the developing supplier – both have potential negative effects for the public authority, such as vendor lock-in or an overpayment for the innovation. Section 1.2 describes these negative effects and provides two examples.

The most successful approaches avoid disadvantages by 'dividing' or sharing the intellectual property rights. The goal of sharing is to ensure a public authority can use and apply the intellectual property, while leaving intellectual property rights and the opportunities to commercialise it with the developing companies. The public authority is protected from a vendor lock-in due to intellectual property rights and there is a strong incentive in the market to innovate. The overview below illustrates different approaches to this end – which we refer to as sharing intellectual property rights.

Approaches to sharing IP rights

Licences

Licensing is the solution for keeping intellectual property rights with the supplier that develops the innovation, while protecting the public authority (or client in general) against vendor lock-in and consequent high costs when vendors exploit their 'monopoly position'. A licence⁶ is an agreement between the holder of intellectual property rights (the licensor) and a second party (the licensee). It is important that the licensor remains owner of the intellectual property rights. The terms are described under which the licensee can use the intellectual property rights. The terms can contain a wide range of conditions such as the timeframe in which the licence is valid, the conditions for renewal, and the geographic area or industry in which the licence applies. This results in multiple types of licences. Below, different types of licences are described:

- An exclusive licence is a licence that gives the licensee the sole right to use the intellectual property rights. The licence will not be given to any other party. A non-exclusive licence on the contrary can be given to multiple licensees.
- Cross licensing occurs in industry. Companies swap licences to use certain intellectual property rights. This type is of little relevance for public procurement.
- An open licence is a licence that will be provided to anybody that requests it. This could be for free or for a reasonable fee (or other conditions). Open licences

³ <http://www.oecd.org/sti/sci-tech/37569498.pdf>

⁴ Leon Stafford for The Atlanta Journal-Constitution Dec. 8, 2011 [Coke hides its secret formula in plain sight in World of Coca-Cola move](#)

⁵ The economics of Patents and Copyrights, F. Lévéque, Y. Ménière, 2004

⁶ <http://www.oecd.org/regreform/sectors/2376087.pdf>



are best known for (all but) technical standards in the electronics industry such as CDs.

- An open source software licence is a licence that allows the licensee a lot of freedom. It is often used in open source software projects. The most commonly known is the GNU General Public Licence⁷. There is also an open software licence approved by the EU: EUPL⁸. Open licences can be of interest to public authorities if they wish to ensure that:
 - The intellectual property rights developed are accessible to all;
 - The original developer (or the authority) receives the credit for the development.

Different combinations can also be made. There are exclusive regional licences for example.

Example: Open licences in Dutch civil engineering¹⁰

An example of the application of open licences is the general agreement to use open licenses for innovations in civil engineering works in the Netherlands.

Organisations representing Dutch suppliers in civil engineering, the main contracting authority, and independent knowledge centres agreed in 2007 to use open licenses as a means to increase innovation in the (Dutch) civil engineering sector.

The general agreement is that through open licences, public authorities have the freedom to:

- maintain, fix, modify, and demolish the delivered work*
- apply the innovation in new works under payment of royalties*
- contract other suppliers for works using the intellectual property, again under the payment of royalties to the intellectual property owner*

The supplier that owns the intellectual property has the freedom to earn back investments and commercialise the intellectual property through:

- application in works for other public authorities*
- application in new works for the original public authorities*
- receiving royalties whenever the original public authority requires use of the innovation in new works that are contracted to other suppliers*

Royalties

Royalties⁹ are payments from the ‘licensee’ to the ‘licensor’ for the use of intellectual property. Section 1.5 discusses different structures for licences and royalties in greater detail.

When to consider sharing Intellectual Property rights?

Considering how to share intellectual property rights is most relevant when:

- New intellectual property rights will result from a collaboration between the public and private organisations, and;
- Both the public and private organisations have a stake in the application of the intellectual property rights (either directly or in the future).

An obvious case is where a public authority tenders for R&D to develop a product it requires (for instance in pre-commercial procurement). However, intellectual property rights management is also relevant in a case where a public authority allows for innovation in a tender through a functional specification of the product, if the tender does not include future work or maintenance. Future work may include, for example, building another bridge to the same specifications and design as a current one, or adding a new module to an existing software system.

⁷ <http://www.gnu.org/copyleft/gpl.html>

⁸ <https://joinup.ec.europa.eu/software/page/eupl>

⁹ <http://stats.oecd.org/glossary/detail.asp?ID=2365>

¹⁰ CROW – Samen werken aan innovatie – open licenties in de gww, 2009

Step by step guide for procurement officers

Step 1: Needs and Risk assessment

When dealing with intellectual property rights in a tender it is important for the public authority to identify their needs and risks.

The checklist below may help with this assessment:

Could new intellectual property be developed as part of the tender?	<ul style="list-style-type: none">• Does the public authority aim for an innovative solution?• Does the tender allow for innovative solutions?• Is a custom, tailor-made solution required, or will a standard solution also be sufficient?• Will the public authority invest in the R&D for innovations?• Will the supplier itself invest in the R&D for innovations?
Is there a risk of vendor-lock-in?	<ul style="list-style-type: none">• Is maintenance included in the tender?• Is the ability to perform maintenance affected by ownership of intellectual property?• Is there a (potential) wish to standardise?• To what extent does the public authority become dependent on the supplier?• Are there alternatives available in the market?
Is there market opportunity to commercialise intellectual property?	<ul style="list-style-type: none">• Is there a commercial market for the solution as a whole, or for application of the new/innovative components of the solution?• Will the public authority require a solution with the same/similar intellectual property rights in the near future?
Are there other risks for keeping the intellectual property rights with the public authority?	<ul style="list-style-type: none">• Are the intellectual property rights transferrable? Would other market parties be able to carry out maintenance, advance the current solution, and/or create new versions of the solution based on specifications and knowledge that is transferrable to the public authority?• Can intellectual property rights relevant to the public authority be 'separated' from other overall intellectual property rights?
Are there any other risks for the public authority not retaining intellectual property rights?	<ul style="list-style-type: none">• Will society in general benefit from sharing the intellectual property rights as public knowledge?

Step 2: Decide on the approach to take

In procurement, the following options are open when it comes to intellectual property rights:

- Claim the full rights to new intellectual property
- Claim no rights to new intellectual property
- Share intellectual property rights between public authority and supplier.

Based on needs and risks, the public authority decides on the best strategy to follow.

In general:

- The more innovation and investment expected from the market, the more intellectual property rights should be left with the market.
- The more opportunities for commercialisation of the intellectual property rights by the market, the more intellectual property rights should be left with the market.

- The more 'after-sales' improvement and development are expected on the innovation, the more reason there is to leave the intellectual property rights with the market. For example, companies selling standardised software packages typically provide regular updates and develop improvements for groups of customers.
- The larger the risk of vendor lock-in, the larger the necessity to retain intellectual property rights (e.g. through a licence-structure).
- The more uncertain the future is, the larger the necessity to retain intellectual property.

In most cases the adverse of the above statements is true as well. For example, when only limited investment for innovation is necessary, there is limited opportunity in the market for commercial exploitation, and/or the product or service concerned is a specific one-off solution, the public authority should claim intellectual property rights.

Step 3: Work out terms and agreements (or use standard clauses)

The last step in the process depends on the outcome of step 2.

Leave IP rights with the economic operator (supplier)

In the case that the public authority decides to leave the intellectual property rights entirely with the economic operator, the public authority most likely does not have to include additional conditions in its contracts. The intellectual property rights resides where it was created. So without further action it resides with the economic operator.

Retain IP rights at public authority

As claiming full ownership of intellectual property rights is still the 'default' option for many public authorities, often there are national standard contract terms and conditions readily available for this option. Refer to these standard terms and conditions in the tender process. As an example, appendix 2 features the Dutch General Government Terms and Conditions for Public Service Contracts. Most countries have a similar set of standard terms and conditions.

Share IP rights between public authority and economic operator

When preparing the terms and conditions in the case where the goal is to share intellectual property rights, standard clauses for terms and conditions may not exist or fit the specific needs of the public authority for the tender at hand.

When sharing the intellectual property rights the aim is:

- To arrange sufficient rights for the public authority to ensure that their processes are not hindered in any way
- To ensure the public authority agrees an equitable remuneration for the supplier for using the intellectual property rights
- To provide the economic operator involved the (maximum) possibility to exploit the intellectual property rights in other business opportunities

Free non-exclusive licence

The most common approach for a public authority in sharing intellectual property rights is to require a free

non-exclusive licence for its own use, free meaning without any future payment being required. Non-exclusive means that the intellectual property rights holder (the licensor) can use the intellectual property rights itself or licence others as well.

Variants to this agreement can require a free non-exclusive licence for a certain region.

Exclusive licence

With an exclusive license only the licensee is allowed to use the licensed intellectual property. The intellectual property rights holder is not allowed to commercialise the intellectual property in other business opportunities. Therefore, the exclusive licence is generally not suitable for sharing intellectual property rights with the market.

Open licence under payment of royalties

In the example of open licences in Dutch civil engineering, a public authority requires open licenses for the intellectual property rights, such that the public authority can use the intellectual property for new projects and even provide sublicenses to other companies. However, the intellectual property rights remain with the supplier and the public authority is obliged to pay royalties to the intellectual property rights holder for every use.

The party that owns the intellectual property rights is entitled to demand payment of royalties when providing licences. This raises the question of who is best able to manage this administration. One risk is that companies may try to get out of paying royalties by making minor changes. This often requires an attentive legal department with ample time to follow up on royalties, or the ability to outsource administration and monitoring to a third party.

For more details on licensing see the Fact Sheet Commercialising Intellectual Property: licence agreements from the Intellectual Property Rights helpdesk from the European Commission: (http://www.iprhelpdesk.eu/sites/default/files/newsdocuments/Licence_agreements_o.pdf).

Legal framework

Provisions on intellectual property rights should be included in the procurement documents and made available for all interested economic operators in advance of the procurement procedure. This is required for pre-commercial procurement and the public procurement of innovation. In the case of a pre-commercial procurement, sharing of the intellectual property rights is conditioned. If an economic operator obtains the intellectual property rights through a pre-commercial procurement, the operator is required to grant the public authority unlimited access to those results free of charge, and is required to grant access to third parties, by way of, for example, non-exclusive licenses, under market conditions. For more details on the legal framework of Intellectual Property Rights and public procurement see Framework for State Aid for research and development and innovation (2014/C 198/01) and the procurement directives.

Example clauses

Two examples clauses are provided that can be used for sharing intellectual property rights. Based on these examples you can draft a contract clause that meets your needs. It is recommended that you involve your legal department for further expert advice.

Important: Conflicts may arise when a public authority has default intellectual property rights clauses by within its trade agreements, while other contracting parties have their own clauses by default. An agreement must be made on which of the default agreements to accept. This can still lead to complications however, for instance when a new project specific technology is combined with earlier innovative technologies from the supplier.

Example 1: Standard Public Private Partnership clause from Ireland.

The following example is a set of standard clauses used in Ireland for Public Private Partnerships: http://ppp.gov.ie/wp/files/documents/DBFOM_Contract/clause-26.pdf. Intellectual property rights are left with the contractor. The authority acquires a “perpetual, transferable, non-exclusive, royalty-free licence (carrying

the right to grant sub-licences) to use for any purpose”.

Example 2: CHARM-PCP, a regional approach.

The relevant clauses of the CHARM-PCP contract are provided in appendix 1. The CHARM-PCP is a **pre-commercial procurement**. A consortium of five government parties from the UK, the Netherlands and Belgium challenged companies to develop innovative traffic management technology. Since the road authorities involved have no interest in intellectual property rights outside of their own countries, they have limited the licence they are acquiring to the three countries involved.

According to these clauses, in order to enable sharing of intellectual property rights, it is required to:

- Know what intellectual property was present at the start (clause 17.2)
- Keep track of the development of intellectual property rights during the project (clause 17.3)
- Take into account the background information that is required for the application of the intellectual property rights created in the project (clause 17.5)

Of course, this is necessary irrespective of who owns the intellectual property rights. In addition, this example provides the public authority the possibility to claim any intellectual property rights that are developed in the project but not used for three years (clause 18.5).

Example 3: Approaches outside of the EU

A very similar approach is used outside of the EU. Links to examples from Canada and Australia are listed below:

Canadian approach:

- <http://www.ic.gc.ca/eic/site/o68.nsf/eng/oooo3.html>
- <http://www.tpsgc-pwgsc.gc.ca/app-acq/sp-ps/clients/achats-procurement-eng.html#a23>
- [http://www.ic.gc.ca/eic/site/o68.nsf/vwapj/IP_Design_EN_web.pdf/\\$FILE/IP_Design_EN_web.pdf](http://www.ic.gc.ca/eic/site/o68.nsf/vwapj/IP_Design_EN_web.pdf/$FILE/IP_Design_EN_web.pdf)

Australian approach:

- www.ag.gov.au/RightsAndProtections/.../Samplemodelcontractclauses.doc
- <http://bit.ly/1yAKqux>

Appendix 1

Example regional licence in the CHARM-PCP

Below, the relevant excerpts from the [CHARM-PCP](#) framework agreement are presented. The CHARM-PCP is a [pre-commercial procurement](#) executed under English law.

Definitions

“Background Intellectual Property”

means Intellectual Property owned or controlled by either of the Parties at the date of this Framework Agreement or which shall at any time thereafter become so owned or controlled otherwise than as a result of the Project under this Framework Agreement;

“Copyright”

has the meaning ascribed to it by the Copyright, Designs and Patent Act 1988;

“Foreground Intellectual Property”

means any intellectual property created by either Party as a result of their involvement in this Framework Agreement;

“Intellectual Property”

means patents, inventions (whether or not patentable or capable of registration), trademarks, service marks, copyrights, topography rights, design rights and database rights, (whether or not any of them are registered or registerable and including applications for registration, renewal or extension of any of them), trade secrets and rights of confidence, trade or business names and domain names and all rights or forms of protection of a similar nature which have an equivalent effect to any of them which may now or in the future exist anywhere in the world;

17. Intellectual Property Rights

17.1

All Background Intellectual Property used or supplied under this Framework Agreement in connection with the Project shall remain the property of the Party introducing the same and nothing contained in this Framework Agreement or any licence agreement pertaining or pursuant to the Project shall affect the rights of either Party in its Background Intellectual Property.

17.2

The Contractor shall within two weeks of the signing of this Framework Agreement provide the Authority with full information in writing about what Background Intellectual Property it (or any of its subcontractors) holds at the date of this Framework Agreement that pertains or may pertain to the Project or any part thereof.

17.3

If the Contractor (or any of its subcontractors) generates Foreground Intellectual Property, whether the Contractor (or subcontractor) intends to file for protection of it or not, the Contractor shall within one Month from such generation inform the Authority about the contents of such Intellectual Property.

17.4

Subject to clauses 17.5 and 18.5, the Intellectual Property rights, generated by the Contractor or any of its subcontractors, arising out of Foreground Intellectual Property shall, in relation to the Authority, belong to the Contractor.

17.5

The Contractor gives the Authority and RWS and MOW a free and non-exclusive licence to use the Foreground Intellectual Property and if necessary the Background Intellectual Property and any relevant open source licences for internal use within the UK, The Netherlands and Belgium with protection of claims of third parties and upon request offers licences to third parties at a fair market price with consideration of the rights of other third parties that do not accrue to the Contractor.

18. Exploitation of Intellectual Property

18.1 The Contractor shall inform the Authority of any Results which are capable of exploitation whether patentable or not.

18.2 The Contractor shall, as appropriate, devise, publish, implement and maintain procedures for the management of Foreground Intellectual Property in the Results and in particular, but without limitation, shall use all reasonable endeavours to ensure that:

18.2.1 the Results of the Project are identified, recorded and carefully distinguished from the outputs of other research and development activities not covered by the Project;

18.2.2 prior to any publication of the Results of the Project, patentable inventions arising from the Results are identified, duly considered for patentability and, where it is reasonable so to do, patent applications in respect thereof are filed at the British or European Patent Office; and

18.2.3 all such patent applications are diligently executed having regard to all relevant circumstances.

18.2 The Contractor shall permit the Authority to monitor the operation and effectiveness of the Contractor's procedures for the management of Foreground Intellectual Property in such a way as the Authority considers reasonably necessary.

18.3 Consistent with the good management of Foreground Intellectual Property and the agreement of the Authority, the Contractor shall use its best endeavours to:

18.3.1 promote the dissemination of the Results of the Project; and

18.3.2 where reasonable and practicable, exploit commercially such Results to generate either capital or revenue or both.

18.4 The Contractor may exploit commercially any publications arising from the Project.

18.5 If, within three years of its creation, any Foreground Intellectual Property has not been commercially exploited by the Contractor (and/or any potential subcontractors), and the Contractor (and/or any potential subcontractors) is not using its best endeavours to do so, or the Contractor (and/or any potential Subcontractor) is using the Foreground Intellectual Property to the detriment of public interest, the Contractor (and any potential subcontractors) shall if requested by the Authority assign the Foreground Intellectual Property rights to the Authority and the group of contracting authorities in the CHARM-PCP.

Appendix 2:

Example of keeping all intellectual property rights:
ARVODI 2011 (Dutch General Government Terms and Conditions for Public Service Contracts 2011)¹¹.

23. Intellectual property

- 23.1** The Contracting Authority is the owner of all intellectual property rights that may be exercised now or in the future in relation to the results of the Services performed by the Contractor, irrespective of where and when they may be exercised. In pursuance of the Contract, the Contractor assigns these rights to the Contracting Authority as soon as they arise. The Contracting Authority hereby accepts the assignment of these rights.
- 23.2** In so far as the results referred to in paragraph 1 are achieved using existing intellectual property rights that do not accrue to the Contracting Authority, the Contractor grants the Contracting Authority a non-exclusive right of use for an indefinite period. In such an event, the Contractor guarantees that it is entitled to grant the aforesaid right of use.
- 23.3** In so far as a separate instrument needs to be executed for the assignment of the rights referred to in paragraph 1, the Contractor irrevocably authorises the Contracting Authority to draft such an instrument and sign it on the Contractor's behalf, without prejudice to the Contractor's obligation to cooperate in the assignment of these rights as soon as the Contracting Authority requests it to do so, without attaching any conditions to its cooperation. In consequence, the Contractor irrevocably authorises the Contracting Authority to have the assignment of these intellectual property rights registered in so far as is necessary in the appropriate registers.
- 23.4** If there is a difference of opinion between the Parties on intellectual property rights in relation to the results of the Services performed, it will

be assumed, in the absence of proof to the contrary, that the rights rest with the Contracting Authority. In all cases, the Contracting Authority may use the results for the purposes specified in the Contract.

- 23.5** The Contractor renounces vis-à-vis the Contracting Authority any moral rights vested in it, i.e. the Contractor, as referred to in the Copyright Act, in so far as the relevant regulations allow it to do so. Acting both in its own capacity and on behalf of the members of its Staff working on the Contract, and as authorised to this end, the Contractor renounces vis-à-vis the Contracting Authority any moral rights vested in these members of its Staff, in so far as the relevant regulations allow it to do so.
- 23.6** The Contractor may not make the results of the Services performed available to third parties in any form, or give third parties any information about them, unless the Contracting Authority has given its express consent. The Contracting Authority may attach conditions to its consent.
- 23.7** The Contractor indemnifies the Contracting Authority against all claims brought by third parties in respect of any breach of their intellectual property rights, including equivalent claims relating to knowledge, unlawful competition and suchlike. The Contractor is obliged to take any action that may help to prevent stagnation and to limit the additional costs or losses incurred as a result of such breaches, and to do so at its own expense.
- 23.8** Without prejudice to the above provisions, the Contracting Authority may, if a third party holds the Contractor liable for a breach of its intellectual property rights, dissolve the Contract in writing, in full or in part, out of court. The Contracting Authority will not exercise its right to dissolve the Contract until it has first consulted the Contractor.

¹⁰ The Dutch General Government Terms and Conditions for Public Service Contracts have been updated in 2014. However, no English translation of these updated terms and conditions is available for this guide yet.



Imprint

Guidance for public authorities on Public Procurement of Innovation, 1st Edition

Publisher: Procurement of Innovation Platform

Project Coordinator: ICLEI – Local Governments for Sustainability

Commissioning Editor: PIANOo – Dutch Public Procurement Expertise Centre

Design: Rebekka Dold, Freiburg, Germany | www.rebekkadold.de

Layout: Vijfkeerblauw

Copyright: Public Procurement of Innovation Platform consortium, c/o ICLEI – Local Governments for Sustainability. All rights reserved. No part of this publication may be reproduced or copied in any form or by any means without written permission of the project coordinator.

Disclaimer: The sole responsibility for any errors or omissions made lies with the editor. The content does not necessarily reflect the opinion of the European Commission. The European Commission is also not responsible for any use that may be made of the information contained therein.

Acknowledgements: This publication has been produced as part of the Procurement of Innovation Platform project, supported by the Directorate General for Enterprise and Industry of the European Commission.

Please share any comments or observations on this publication with us. We are keen to hear your views. Contact us at info@innovation-procurement.org