

Horizon Results Platform & European IP Helpdesk

19/09/2023 IP Commercialisation and licensing

Upcoming:

- 13/11/2023 IP in Business Collaboration for SMEs and Start-ups*
- 13/12/2023 Thinking international – International Business Opportunities*

19 September 2023

Horizon Results Platform (HRP)

An introduction

- The **Commission's corporate platform** promoting **Key Exploitable Results (KERs)**
 - Hosted on the F&T Portal
- **Programmes** on HRP to date:
 - FP7, Horizon 2020, **Horizon Europe***, European Maritime & Fisheries Fund (EMFF), Research for Coal & Steel (RFCS), EIT-KICS
- **Key information per result:**
 - Target Audience / Needs / R&D maturity / Investor Readiness flags drive the match-making process / contribution to Horizon Europe Missions, ...
- HRP encompasses both the:
 - **Supply** side: beneficiaries' KERs, and
 - **Demand** side: industries, SMEs, investors, policy makers, etc.

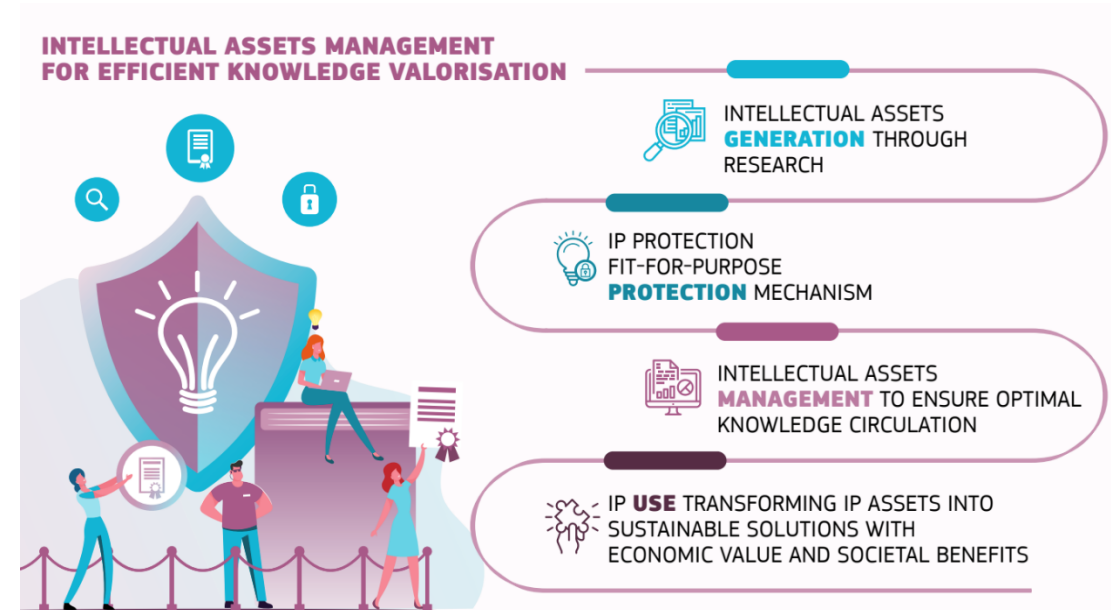


Training: IP Commercialisation/Valorisation

The training series addresses IP related aspects in four areas, introducing the main aspects of IP management with a view to commercialising/valorising intellectual assets:

- I. IP Assessment - 12/09/2023
- II. **IP Commercialisation and Licensing** - 19/09/2023
- III. IP in Business Collaboration for SMEs and Start Ups - 13/11/2023
- IV. Thinking international - International business Opportunities 13/12/2023

NB: By registering for one session participants will automatically register for all sessions within the series.





Horizon Results Platform Team

Email: EC-HORIZON-RESULTS-PLATFORM@ec.europa.eu

Thank you,
we look forward to hearing from you!



European IP Helpdesk

Stay ahead of the innovation game.

European IP Helpdesk an HRP -
Intellectual Property Training course

19 09 2023





European IP Helpdesk

- Service initiative of the European Commission
- Addressing **current and potential beneficiaries of EU-funded projects, researchers and EU SMEs**
- Free-of-charge first-line support on intellectual property (IP)
- Hands-on IP and innovation management support
- International pool of IP experts from various thematic fields
- Unique cooperation scheme with the Enterprise Europe Network: 44 ambassadors from 27 EU countries





The EC IP Helpdesks





- www.ec.europa.eu/ip-helpdesk
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European IP Helpdesk

Stay ahead of the innovation game.

European IP Helpdesk Webinar:
IP (External) Commercialization and Licensing
(Basic)

Dr. Christian Hackl

Senior IP Advisor

September 19, 2023



Today's speaker

Dr. Christian Hackl



- Managing Director of TUM-Tech GmbH (for 20 years)
- Assistant Professor at the Chair for Technology and Innovation Management (Technical University of Munich: TUM)
- Regular lecturer for the European Patent Office (EPO) / European Patent Academy and the EU-IP Helpdesk
- Author of several publications, e.g. case studies on usage of IPR by companies
- Co-Founder of a start-up (renewable energy)



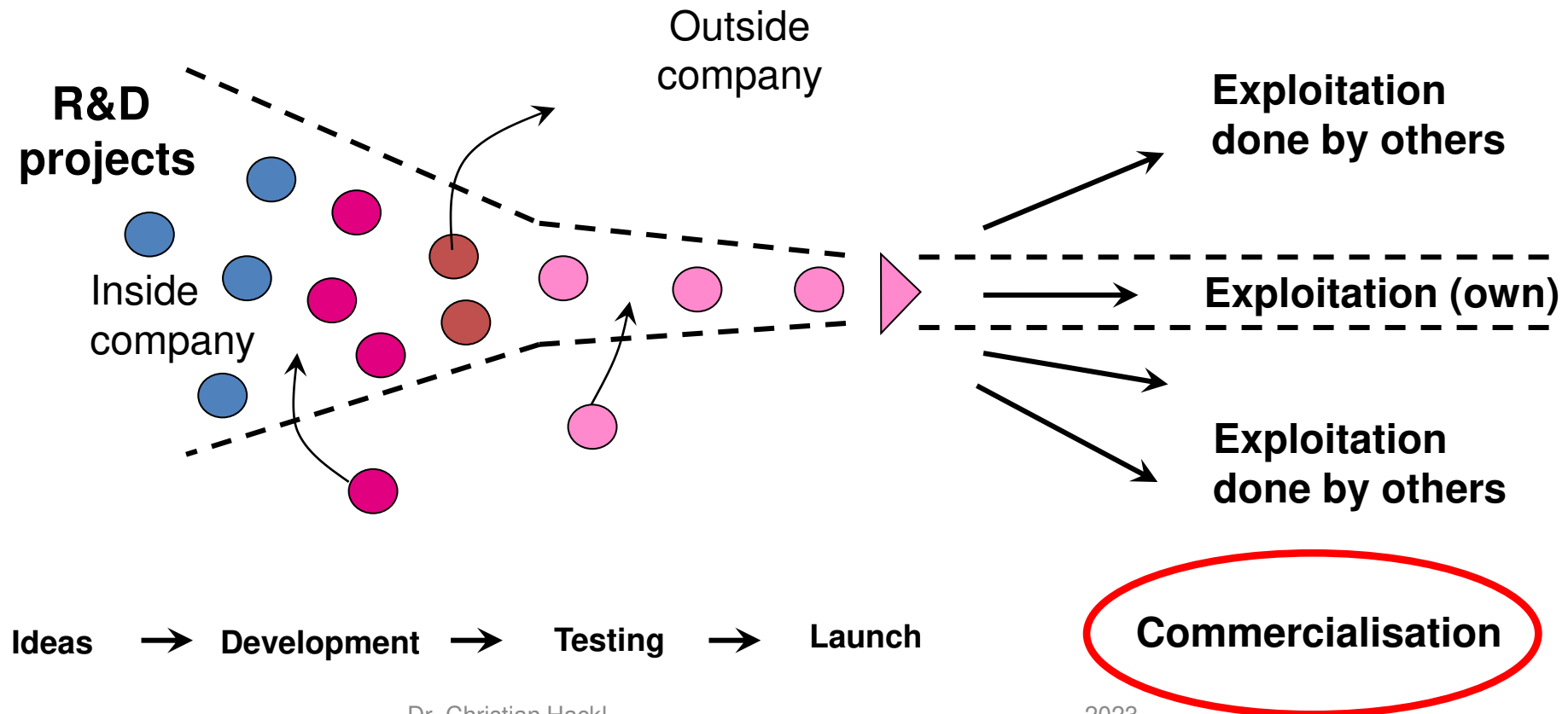
Overview

- Introduction European IP Helpdesk
- Open innovation / Commercialisation
- What and why (license)
- Before negotiating
- Core content (licensing agreements)
- Case study
- The negotiation



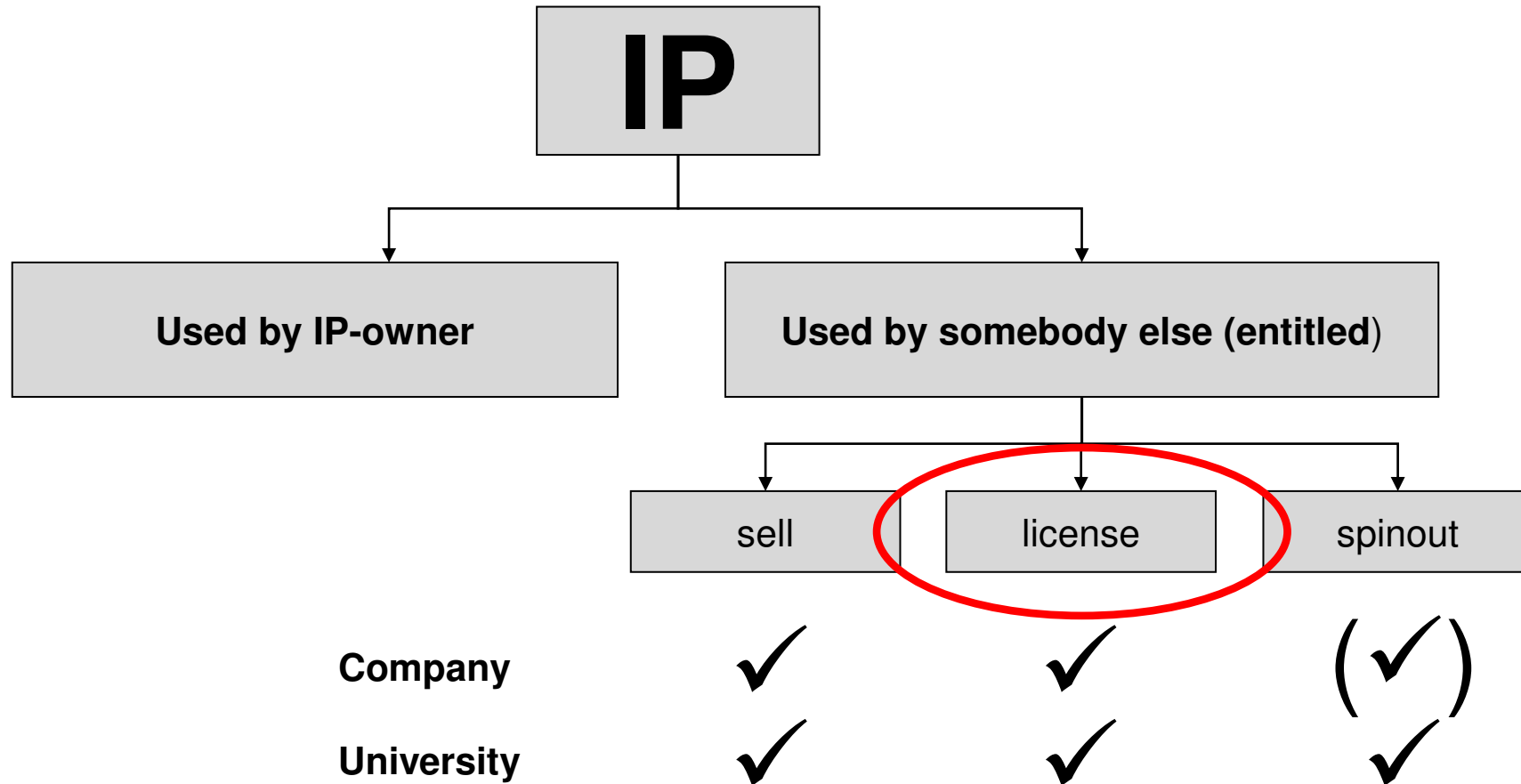


Open Innovation





IP Commercialisation



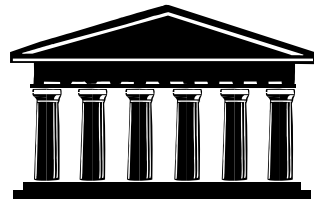


An IP license

- Indirect exploitation of intellectual property
- Licensing agreement: the owner of IP (Licensor) grants the Licensee the right to use the IP
- The Licensor maintains the ownership of the IP



What is a license?



Licensor
IP owner (e.g.
university,
company,
individual)

Permission to use IP

Payments



Licensee
(e.g.
company)



Which IP rights can be licensed?

Registered IP

- Patents
- Utility models
- Registered trade marks
- Registered designs

Unregistered IP

- Copyright
- Database right
- Unregistered trade marks
- Unregistered designs

Soft IP

- Know-how
- Trade secrets
- Confidential information



When to use a license agreement

- **If you are giving someone else the right to use your intellectual property (IP)**
 - E.g. the right for a publisher to make and sell copies of your copyright work, e.g. software or novels
 - E.g. the right for a manufacturer to make and sell products covered by your patents or designs
 - Others, e.g. trade mark licences, know-how licences



When is a license agreement less likely to be needed?

- **If you are selling (assigning) the IP outright**
- **If you are just selling products or services**
 - Even if those products are protected by your IP
 - (But if you want to stop the purchaser from using the product freely, a licence may be required to set out the limits of permitted use)



Contrasting types of agreement

- **IP assignment**
 - Outright sale of the IP (e.g. software developer outright selling of software)
- **License agreement**
 - Permission to use IP; ownership remains with licensor
 - patents
 - software (e.g. software developer might want to license end users; EULA: End User License Agreement)
- **Distribution agreement**
 - E.g. software developer appoints distributor who will sell or license products protected by the IP

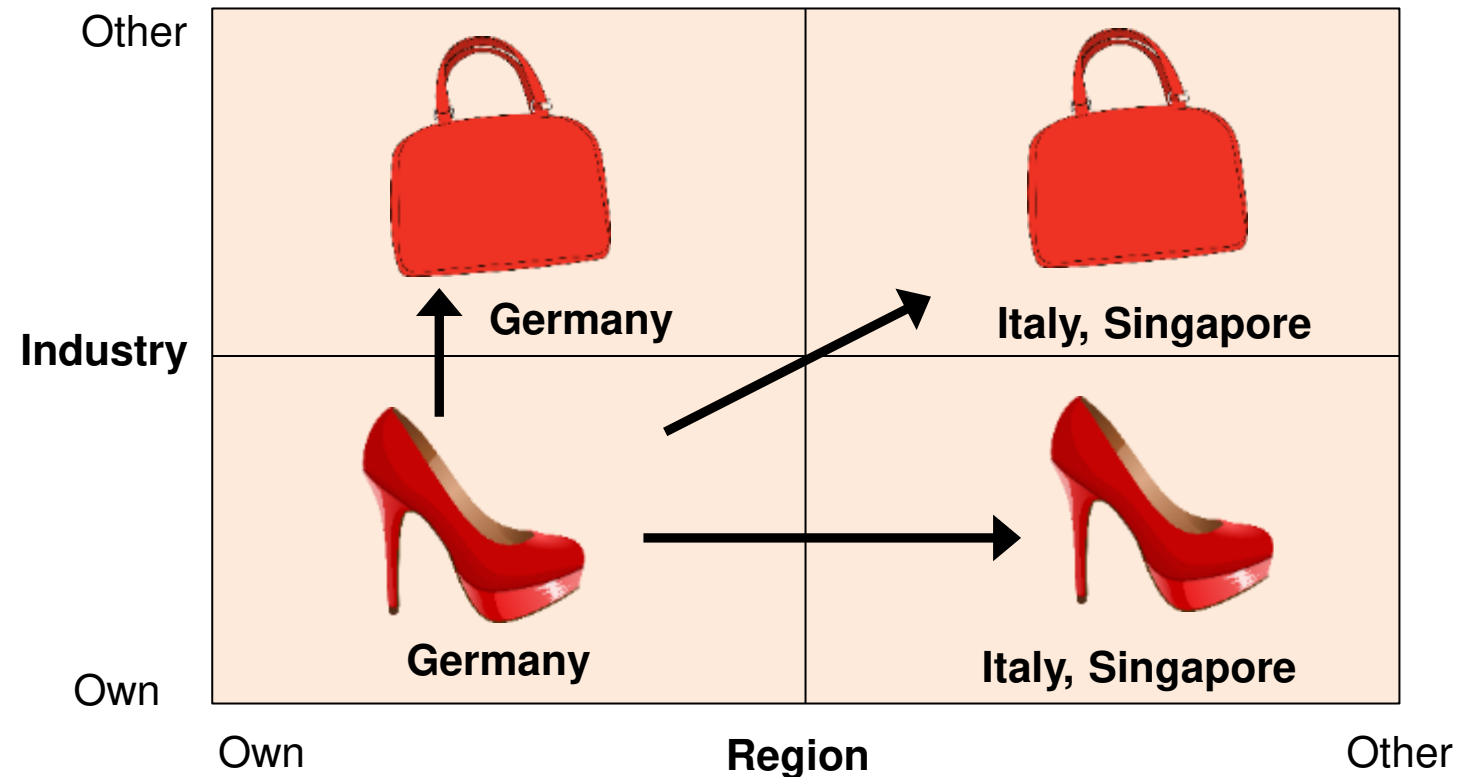


When does external commercialisation make sense?

- Different geographical region
- Different application / industry
- No strategic fit
- Platform technology



Some reasons for external commercialisation – new markets





Some reasons for external commercialisation – platform technology



Dr. Christian Hackl

BioShield-S1 for improved implants and SanaSilk OTC wound care products	Implant Coatings & Medical Devices
Medical Devices for OTC Wound Care	Medical Devices for OTC Wound Care
Cosmetics products with functional silk for improved skin care	Functional Cosmetics
High-performance fibers for technical and medical textiles	Biosteel Spidersilk Fibers

Picture: Amsilk



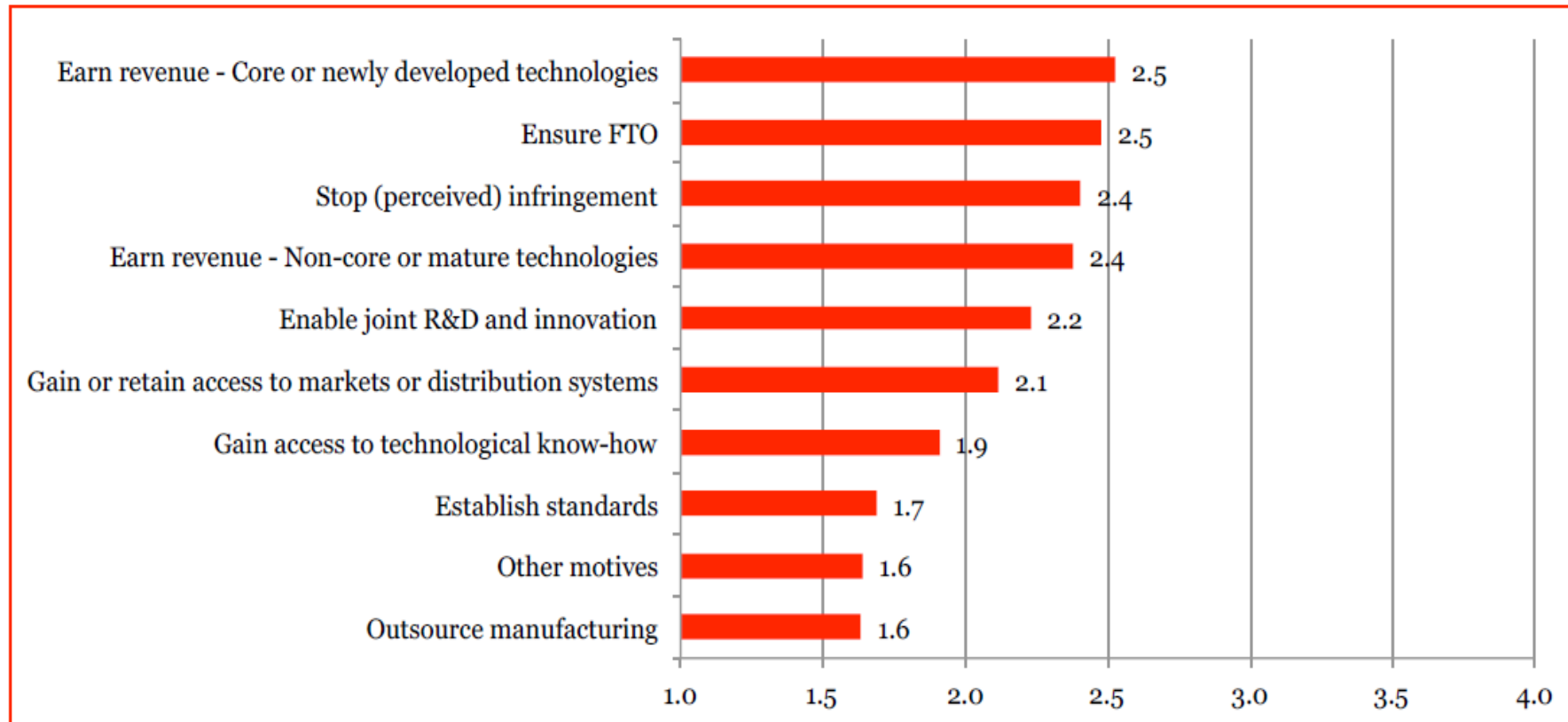
Some more reasons for licensing

- Access new markets
- Generate profit
- Share risk
- Accessing technology (faster, cheaper)
- Ensure Freedom-to-Operate
- Enter into an R&D collaboration
- Settle an infringement claim
- Cross licensing

Out-licensing
and
In-licensing



Motives for outlicensing patents

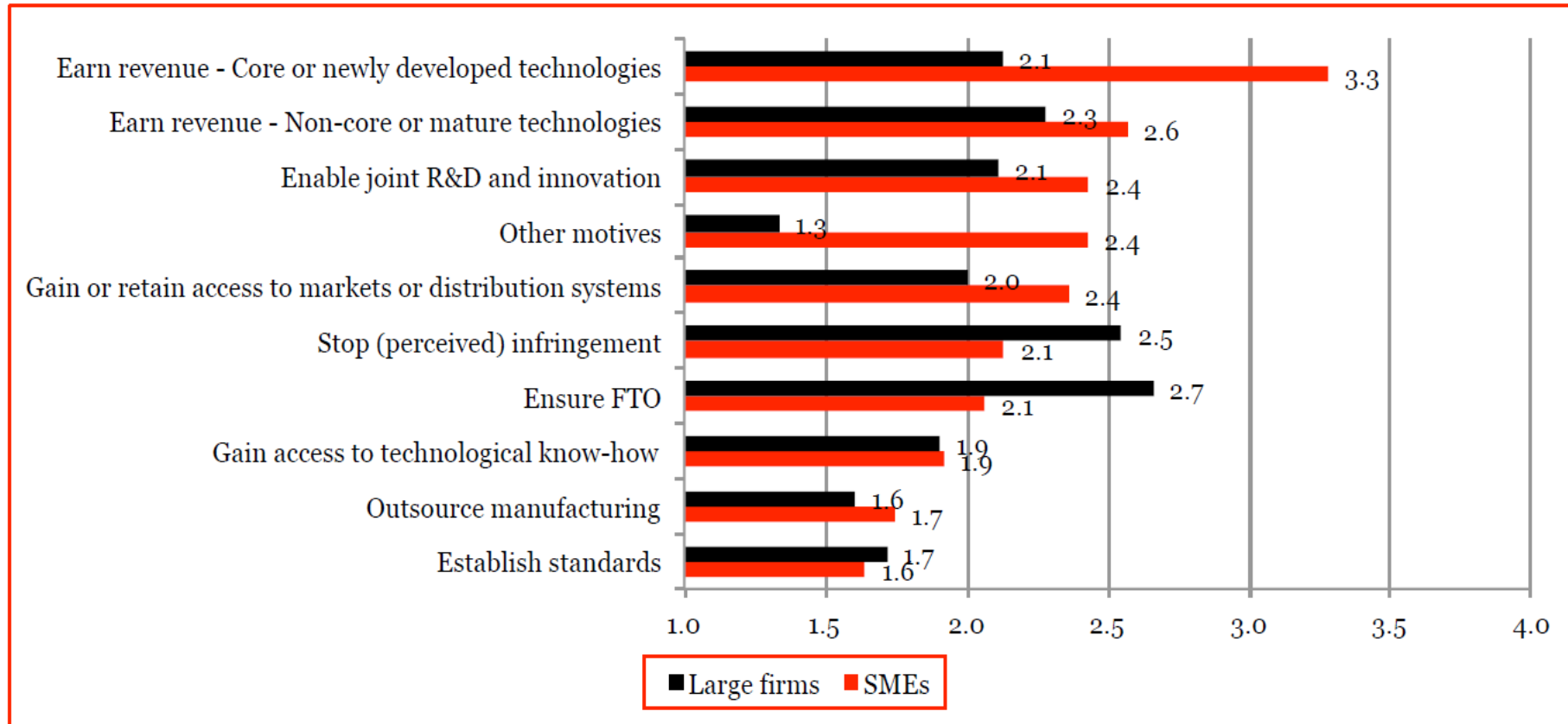


Arithmetic means on a scale from 1='unimportant motive' to 4= 'very important motive'

Source: PATLICE Survey (Survey on patent licensing activities by patenting firms), European Commission



Motives for outlicensing patents (size)

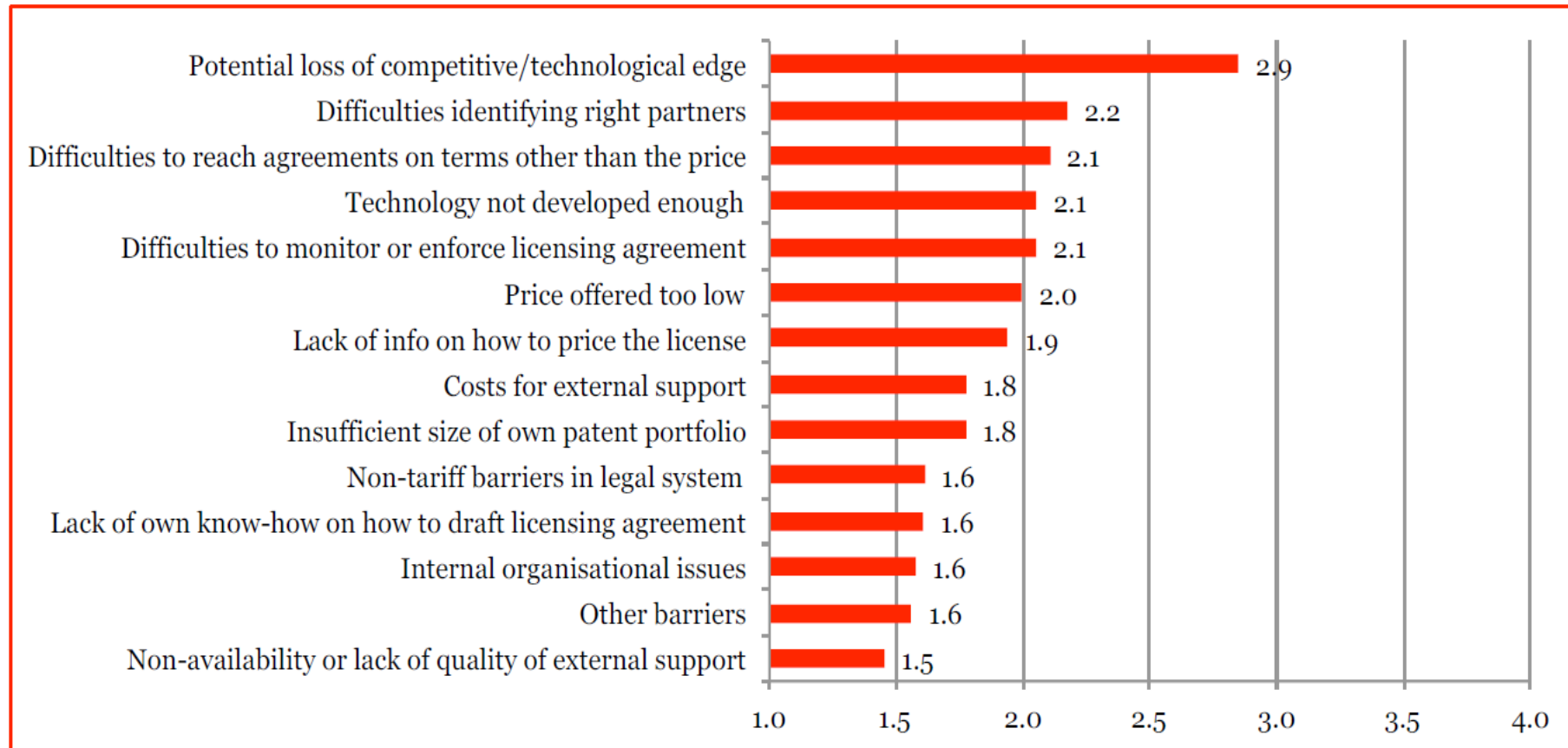


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Source: PATLICE Survey (Survey on patent licensing activities by patenting firms), European Commission



Barriers to outlicensing patents

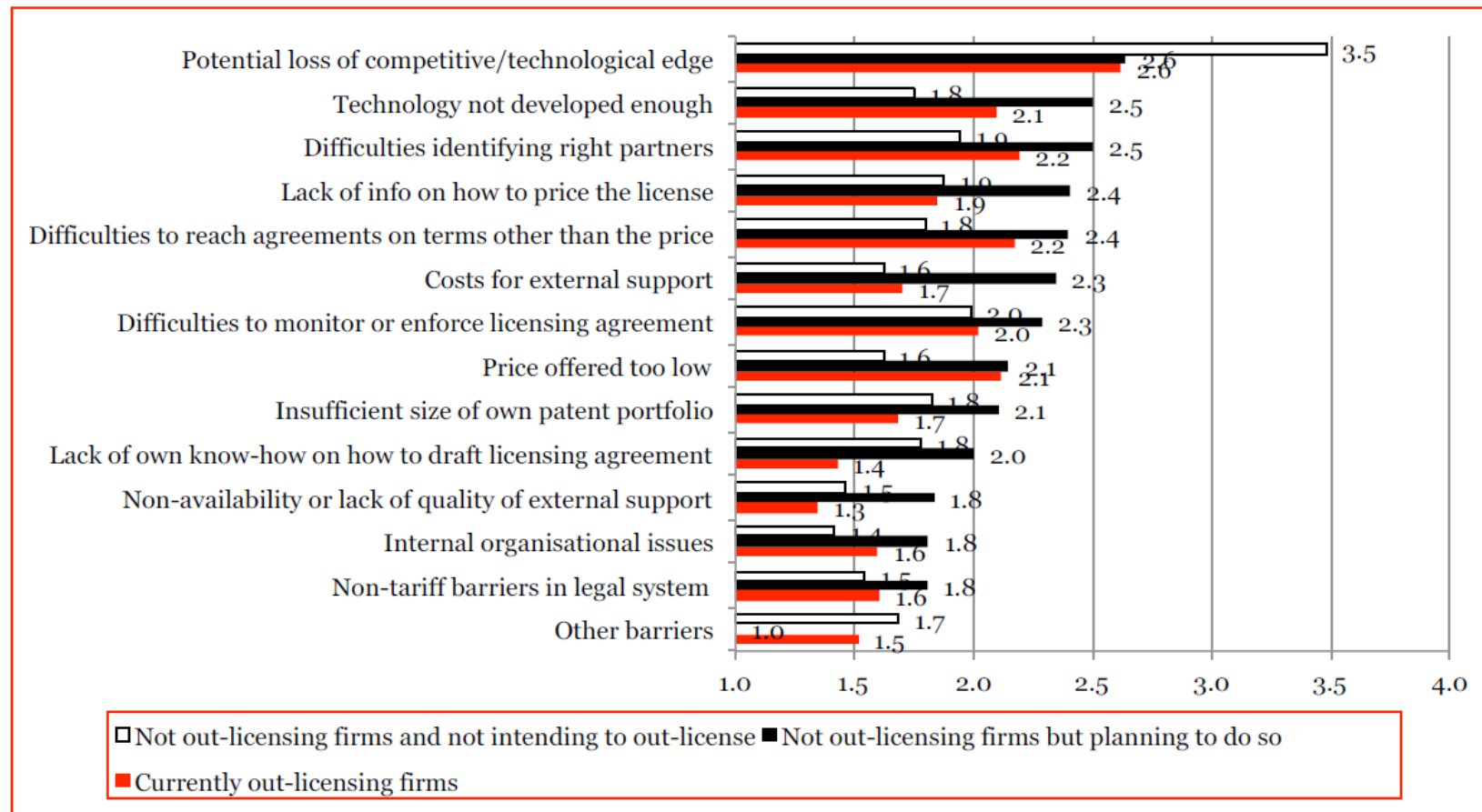


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Barriers to outlicensing patents

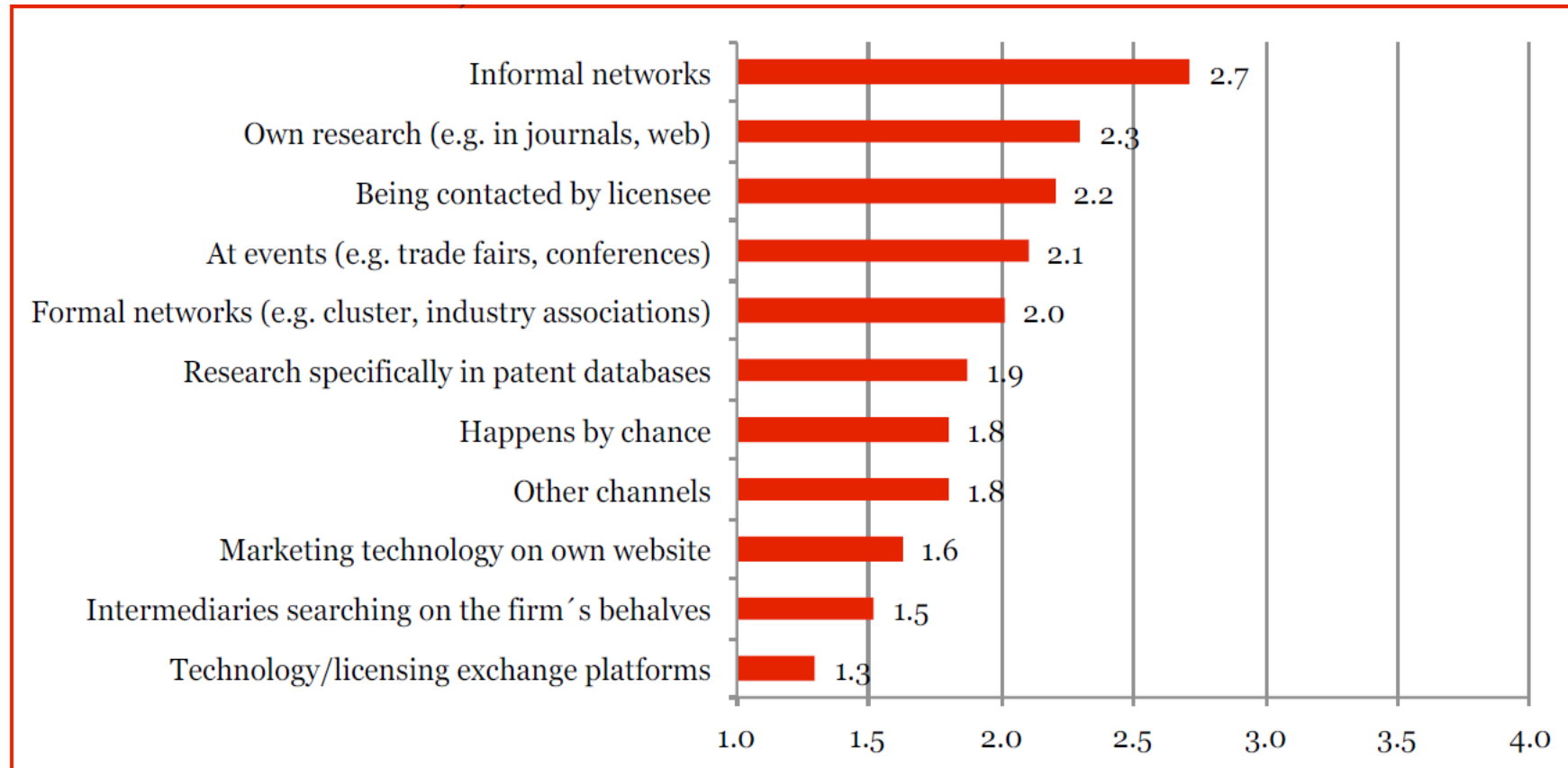


Arithmetic means on a scale from 1='unimportant motive' to 4= 'very important motive'

Source: PATLICE Survey (Survey on patent licensing activities by patenting firms), European Commission



Channels to find potential licensees

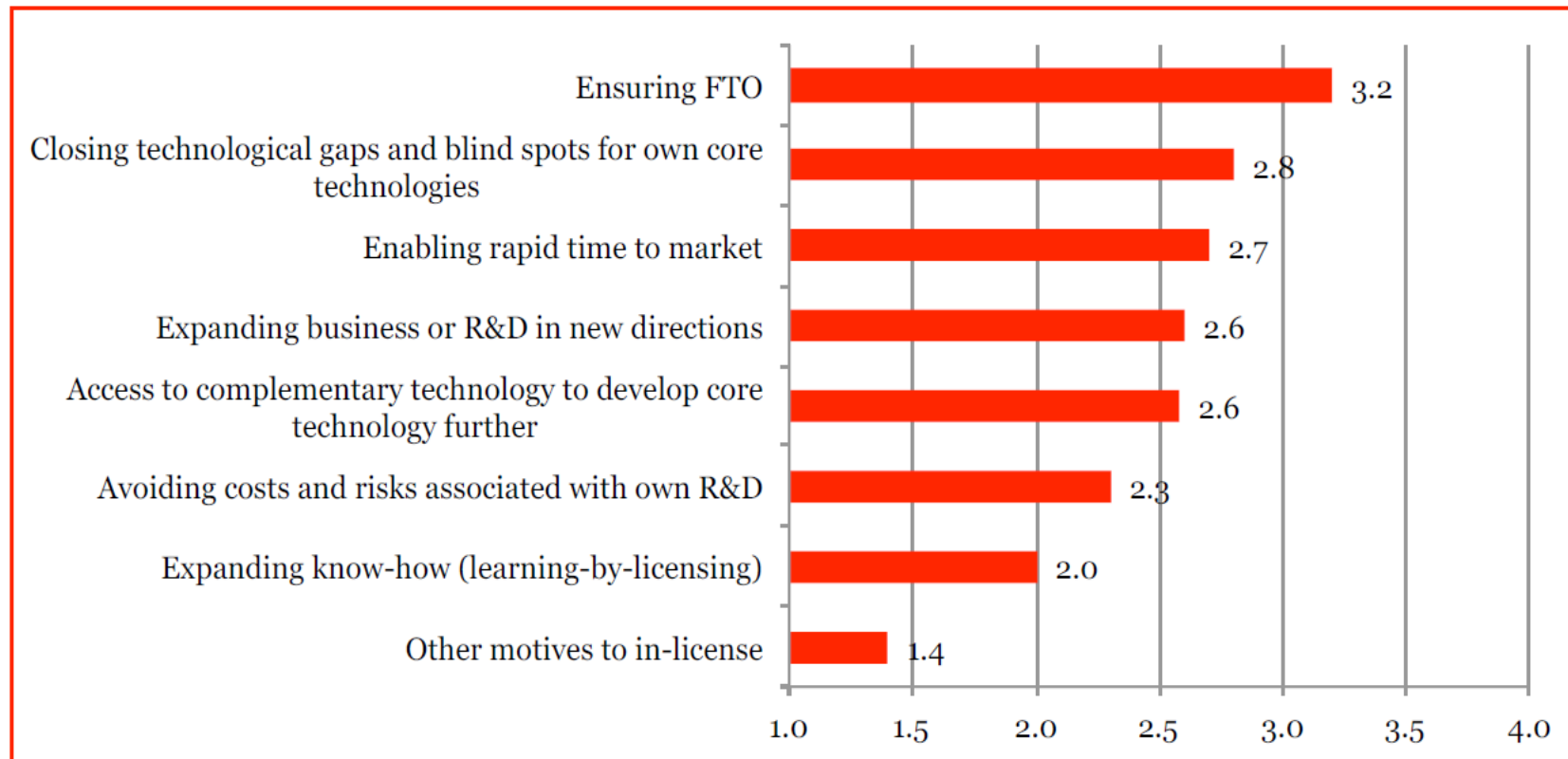


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Source: PATLICE Survey (Survey on patent licensing activities by patenting firms), European Commission



Motives for inlicensing patents

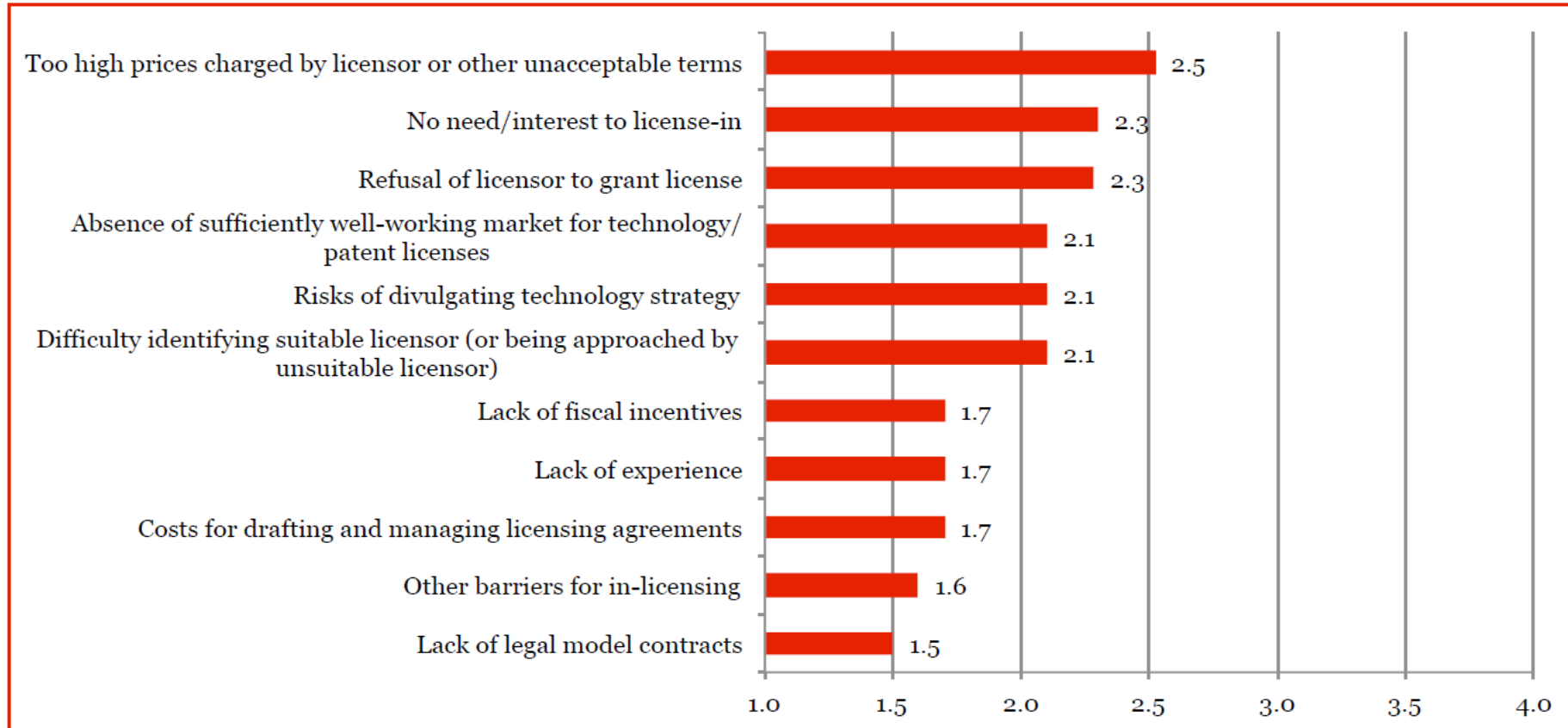


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Barriers to inlicensing patents



Arithmetic means on a scale from 1='unimportant motive' to 4= 'very important motive'

Source: PATLICE Survey (Survey on patent licensing activities by patenting firms), European Commission



Before the negotiation

- You learnt about a new technology and – according to the first preliminary information – it might be an interesting technology for you (licensing-in)
- *Question: What do you do before sitting down with the licensor to negotiate?*





Before the negotiation

- Information regarding the licensor (licensee)
- Information regarding the technology and its context
- Information regarding the legal status of rights
- Information regarding the business environment
- (NDA)



Due Diligence (example)

- A new industrial process for leather dyeing (water soluble dyestuff)
- Protected by patent
- Supported by secret know-how

What due diligence for the patent and know-how?



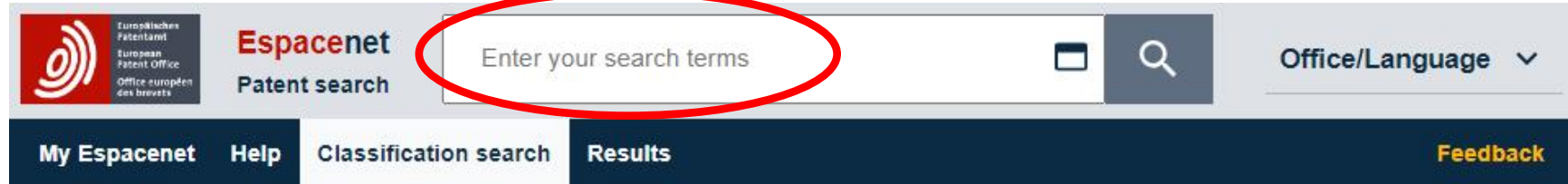
Due diligence in patents

- Ownership, legal status, geographical scope
- Patented technology and its context



The Espacenet database (over 140 million docs)

<https://worldwide.espacenet.com>



Espacenet: free access to over 140 million patent documents

**Also for identifying
potential partners**





The Espacenet database (over 140 million docs)

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Priority number: [i](#) WO1995US15925

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Applicant(s): [i](#) Institut Pasteur

Inventor(s): [i](#) Smith

Quick access

Discussion forum

Classic Espacenet



The Espacenet (n docs)

The screenshot shows the Espacenet Patent search interface. At the top, there is a search bar with the text "Enter your search" and a red circle around the "Results" and "Advanced search" buttons. Below the search bar, there are navigation tabs: "My Espacenet", "Help", "Classification search", "Results", and "Advanced search". The "Results" tab is selected. Below the navigation tabs, there is a breadcrumb trail: "Home > Results". The main content area shows the search results configuration. It starts with "Query language: en de fr" and "AND" as the search operator. There are two main sections for search criteria:

- AND Section:**
 - Field: Title, All (dropdown), → Group
 - Field: Title or abstract, All (dropdown), → Group
- OR Section:**
 - Field: Publication number, Any (dropdown), → Group
 - Field: Application number, Any (dropdown), → Group
 - Field: Priority number, Any (dropdown), → Group

The "Priority number" field has the value "2023" entered. The "Results" and "Advanced search" buttons are highlighted with a red circle.



The Espacenet (on docs)

Logo: Bundespatentamt, Espacenet Patent search, European Patent Office, Office européen des brevets

Enter your search

My Espacenet Help Classification search **Results** Advanced

Home > Search

Query language: en de fr

OR + Field

OR + Field

- Title or abstract All → Group
- Title or abstract All → Group

AND + Field

- Description Proximity → Group
- < 3 words away from
- Description Any → Group



Due diligence in trade secrets

- Licensor trade secret policy
- Confidentiality agreements with employees
- Other licensees in possession of the secret



Licensing agreements

- No standard
- Large flexibility
- Adjust to business needs

- In the following: overview of main topics

(no substitute for professional advice)



License agreement – Overview I

1. Definitions/Subject

- Purpose
- The parties (licensor and licensee)
- Technology/IP
- Ownership
- Definition of terms

New training: „Licensing -
Advanced“

2. Grant

- Scope
- Territory
- Exclusivity



License agreement – Overview II

3. Financials

- Upfront payment
- Ongoing payments
- Milestone payments
- Minimum / adjustments

New training: „Licensing -
Advanced“

4. Further topics

- Improvements
- Know-how and training
- Confidentiality
- Reporting
- Warranties and liabilities
- IP protection and infringement
- Term and termination



Case study: Orcan Energy

<https://www.epo.org/learning/materials/sme/sme-case-studies.html>

EPO SME CASE STUDIES | ORCAN ENERGY

Recycling waste heat to cool down the planet

A renewable energy company founded in 2008, Orcan Energy offers standard components for heat power generators that recycle waste heat by turning it into electricity, using the Organic Rankine Cycle (ORC), a process similar to that used in steam engines. Having started as a spin-off from the Technical University of Munich (TUM) in Germany, Orcan now has 65 employees. Patents are important, because the risk of Orcan's standard components being copied is high. Eight early patents were filed by the TUM and then subsequently acquired by Orcan. Ownership of these patents was vital in order to attract funding. Orcan co-operates with other companies, but simplifies patent management by avoiding joint ownership. It has a detailed patent protection strategy and understands when to file a patent application and where to file it.





Waste Heat

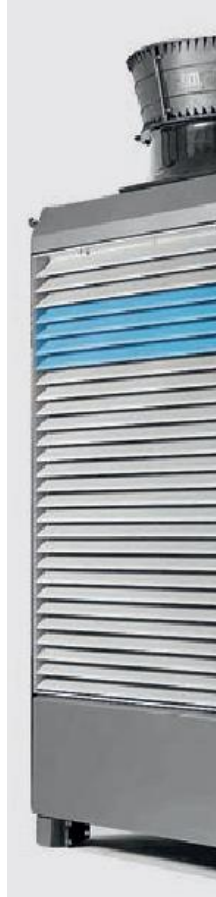
Sources:

- Industrial applications
- Stationary and marine power systems
- Combined heat and power (CHP) units
- Renewable power plants (biogas, solarthermal, geothermal)

Waste Heat: equivalent of 100 mio liters of diesel produced every hour across the globe!



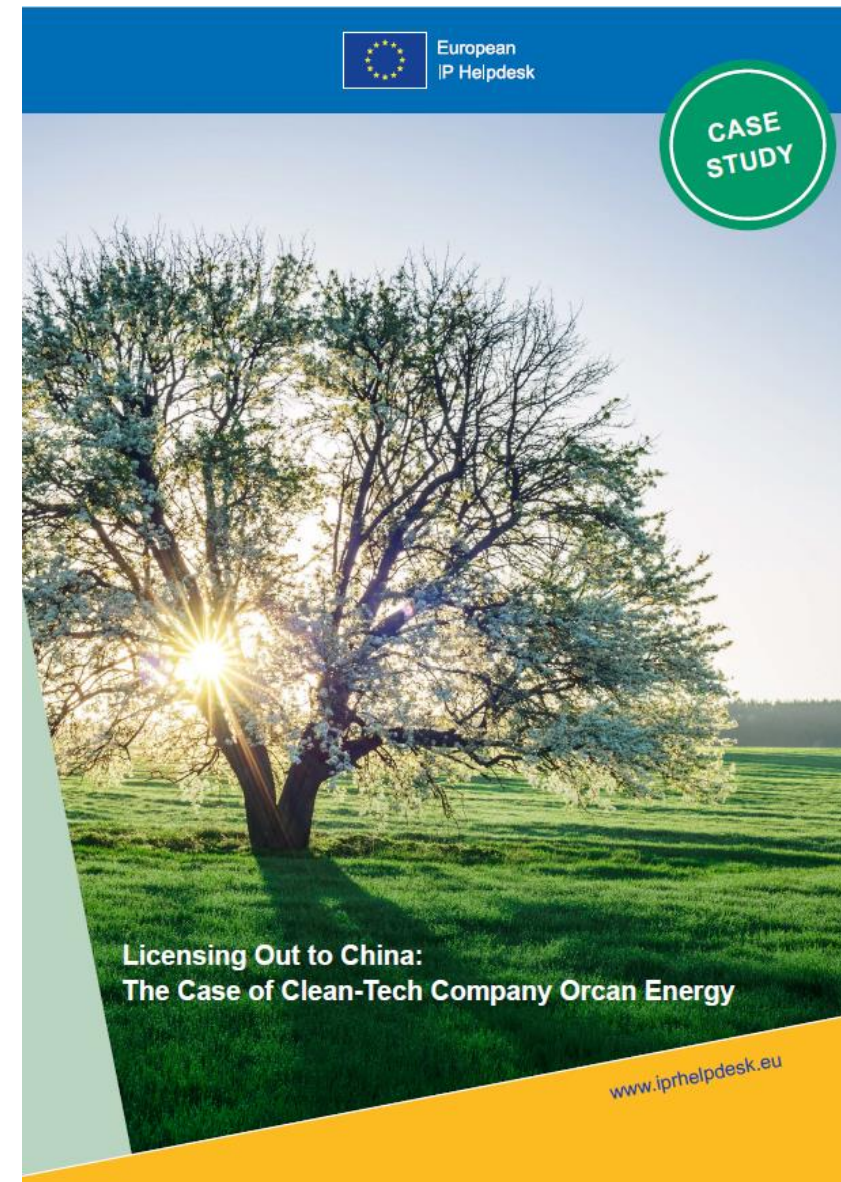
Update





Case study II: Orcan Energy

https://intellectual-property-helpdesk.ec.europa.eu/regional-helpdesks/european-ip-helpdesk/europe-case-studies_en





Licensing agreement negotiation

- A strategic choice
- A long standing relationship
- Legal, technical and financial aspects



Negotiating licensing agreements

- Search for a win-win agreement
- Seek “objective” criteria
- Be sufficiently prepared to negotiate
- Discuss the agreement as a whole
- Time is always important



Contact:

- Website: ec.europa.eu/ip-helpdesk
- helpline@iprhelpdesk.eu
- Twitter [@iprhelpdesk](https://twitter.com/iprhelpdesk)
- LinkedIn [/european-ipr-helpdesk](https://www.linkedin.com/company/european-ipr-helpdesk)





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